

WIPO



MM/WG/2/6

ORIGINAL: English

DATE: June 15, 2001

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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**

REPORT

adopted by the Working Group

I. INTRODUCTION

1. The 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 (hereinafter “the Working Group”) held its second session in Geneva from June 11 to 15, 2001.

2. The following member States of the Madrid Union were represented at the session: Australia, Austria, Bulgaria, China, Croatia, Democratic People’s Republic of Korea, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Italy, Japan, Latvia, Lithuania, Norway, Portugal, Romania, Russian Federation, Slovakia, Slovenia, Spain, Sweden, Switzerland, The former Yugoslav Republic of Macedonia, Turkey, Ukraine, United Kingdom (30).

3. The following member States of the Paris Union were represented by observers: Canada, Indonesia, Iran (Islamic Republic of), Ireland, Republic of Korea, United States of America (6).
4. Representatives of the following intergovernmental organizations took part in the session in an observer capacity: Benelux Trademark Office (BBM), Commission of the European Communities (CEC) (2).
5. Representatives of the following international non-governmental organizations took part in the session in an observer capacity: European Brands Association (AIM), International Association for the Protection of Intellectual Property (AIPPI), International Chamber of Commerce (ICC), International Federation of Industrial Property Attorneys (FICPI), International Trademark Association (INTA), Licensing Executives Society (International) (LES) (6).
6. The list of participants is given in Annex I to this report.
7. Mr. François Curchod, Deputy Director General, opened the session and welcomed the participants on behalf of the Director General of WIPO.
8. The Working Group unanimously elected Mrs. Debbie Rønning (Norway) as Chair, and Mrs. Duan Chuane (China) and Mr. Tibor Ivanovic (Croatia) as Vice-Chairs. Mr. Malcolm Todd (WIPO) acted as Secretary of the Working Group.
9. Discussions were based on the following documents drawn up by the International Bureau: “Proposals for the modification of the Common Regulations under the Madrid Agreement and Protocol – (1) Proposals approved in the first session of the Working Group” (document MM/WG/2/2), “Proposals for the modification of the Common Regulations under the Madrid Agreement and Protocol – (2) New and revised proposals” (document MM/WG/2/3), “Proposals for the modification of the Common Regulations under the Madrid Agreement and Protocol – (2) New and revised proposals: addendum” (document MM/WG/2/3 Add.), “Notes on new and revised proposals for modification of the Common Regulations under the Madrid Agreement and Protocol” (document MM/WG/2/4), “Draft Administrative Instructions for the application of the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating Thereto” (document MM/WG/2/5) and “Draft Administrative Instructions for the application of the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating Thereto: addendum” (document MM/WG/2/5 Add.).
10. The Secretariat noted the interventions and recorded them on tape. This report summarizes the discussions without necessarily reproducing all the comments that were made.

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

11. The text of the amended provisions of the Common Regulations as approved by the Working Group is given in Annex II. Changes are indicated (in bold and ~~strikeout~~) by reference to the proposals as submitted to the Working Group. This includes a few purely editorial changes introduced by the Secretariat. In general, the discussion concerning a given provision is recorded in this report only where the text of the provision as approved differs from that contained in the documents submitted to the Working Group (MM/WG/2/2, 3 and 3 Add.).

Rule 1 (i), (xvii~~bis~~), (xviii~~bis~~), (xix), (xix~~bis~~), (xxvii~~bis~~), and (xxxi)

12. The Delegation of the United States of America asked why the definition of “notification of provisional refusal” in the proposed amended version of Rule 1(xix) referred only to a declaration under paragraph(1) of Article 5 of the Agreement and the Protocol, in view of the fact that there was a reference in paragraph(5) to a provisional refusal. The Secretariat replied that the purpose of this definition was to make clear that the notification of a provisional refusal under Rule 17 was the exercise of “the right to declare that protection cannot be granted” mentioned in Article 5(1) of the Agreement which, unlike the corresponding provision of the Protocol, did not use the words “notification” or “refusal.”

13. The Secretariat drew attention to the fact that item (xviii~~bis~~) was redundant since the expressions defined therein were not used in the Regulations. Further, the word “also” should be omitted from item (xvii~~bis~~) as it was unnecessary and could be misinterpreted.

Rule 3(2)

14. Further to a suggestion by the Secretariat, it was agreed that the words “if such subsequent designation or request is made through an Office” at the end of Rule 3(2)(a) would be deleted, as it appeared unnecessary to require a separate communication where the form is already signed either by the holder or by an Office under Rule 24 or 25.

Rule 7

15. The Delegations of Germany, Italy, Lithuania, Slovakia and Sweden—countries having made the notification under Rule 7(1)—supported the proposed deletion of that provision.

16. As regards the setting of a date by which a notification already made should be withdrawn, the Delegation of Sweden expressed doubts since such withdrawal depended, as far as Sweden was concerned, on the outcome of the process for amending the corresponding provision in its national law. It was therefore agreed that any reference to a date by which the notification should be withdrawn be omitted from Rule 7(3)(b) and instead that the issue be addressed by the Assembly of the Madrid Union in the form of a recommendation stating in substance that notifications under Rule 7(1) should be withdrawn as soon as possible by the Contracting Parties concerned. The Secretariat indicated that the text of the deleted paragraph (1) would be given in a footnote in the published text of the Regulations.

Rule 9(4) and (5)

Rule 9(4)(a)(viibis)

17. Having noted that several national legislations provided for the possibility that a mark consist of a color or a combination of colors, it was agreed that paragraph (4)(a)(viibis) would be modified to read: “where the mark that is the subject of the basic application or the basic registration consists of a color or combination of colors as such, an indication to that effect.”

Rule 9(4)(b)(v)

18. Following a proposal by the Delegation of the Russian Federation, supported by the Delegation of Hungary and the Representatives of AIPPI and INTA, it was agreed that the words “non-distinctive” would be deleted from paragraph (4)(b)(v).

19. Further to a question by the Delegation of the United States of America, the Secretariat confirmed that the intention of paragraph (4)(b)(v) was to leave it to the applicant’s discretion whether or not to include a disclaimer in the international application.

20. In reply to a question by the Delegations of Japan and Hungary concerning the possibility for an applicant to disclaim protection in respect of some Contracting Parties only, the Secretariat explained that this would raise both legal and practical difficulties.

21. Replying to a question by the Delegation of Spain, the Secretariat, noting that Rule 32(1) referred to the publication in the Gazette of “relevant data,” said that it considered that disclaimers were part of the relevant data to be published.

22. Finally, further to a suggestion of the Delegation of Spain, supported by the Delegation of the United States of America, it was agreed that the wording “where the applicant wishes to disclaim protection for *an* element of the mark” be replaced by “where the applicant wishes to disclaim protection for *any* element of the mark.”

Rule 9(5)(a)

23. The Working Group agreed to amend items (ii) and (iii) of that provision in order to take account of the “cascade” (Article 1(3) of the Agreement). These items will now read respectively: “where the applicant has no such establishment in any Contracting State of the Agreement, that he has a domicile in the territory of the State whose Office is the Office of origin,” and “where the applicant has no such establishment or domicile in the territory of any Contracting State of the Agreement, that he is a national of the State whose Office is the Office of origin.”

24. Subject to the changes mentioned in the foregoing paragraphs, Rule 9(4) and (5) as set out in documents MM/WG/2/2 and 3 was approved by the Working Group.

Rule 14(1)

25. This provision was approved by the Working Group as proposed in document MM/WG/2/3 Add.

Rule 15

26. This provision was approved by the Working Group as proposed in document MM/WG/2/2.

Rule 16

27. This provision was approved by the Working Group as proposed in document MM/WG/2/3.

Rule 17

Rule 17(1)

28. Further to a discussion as to the possibility to find a better term to refer to a provisional refusal based on objections raised by an Office on its own initiative (as a counterpart to a “provisional refusal based on an opposition”), it was eventually agreed to maintain the term “*ex officio* provisional refusal” in paragraph (1)(a), since it seemed to be clearly understood in all Contracting Parties. The Secretariat pointed out that the term “*ex officio* examination” was already used in Rule 17(6)(a)(ii).

Rule 17(2)(vi)

29. The Delegation of Japan asked whether, considering in particular the last sentence of paragraph 15 of the Notes (document MM/WG/2/4), the new wording of Rule 17(2)(vi) would require a modification of the Japanese law, under which, even where the grounds on which a refusal was based affected only a part of the goods and services, an action by the holder before the Japan Patent Office was necessary (for example, the limitation of the list of goods and services) in order for the remaining goods and services to be accorded protection. The Secretariat replied that the proposed provision did not differ in substance from the current wording of Rule 17(2)(vi) insofar as it could be interpreted as allowing an indication that all goods and services were affected by the provisional refusal and insofar as it was up to each Contracting Party to make that interpretation. The Secretariat further noted that the overwhelming majority of Offices did notify partial refusals and did not require any action from the holder in order to assure protection to those goods and services which were not affected by the grounds for refusal; this was greatly in the interest of users.

30. Replying to a question raised by the Delegation of Hungary, the Secretariat stated that the wording of paragraph (2)(vi) allowed for the indication of the goods and services by reference to the class number, without requiring that the names of the goods and services be spelled out.

Rule 17(2)(vii)

31. The Delegation of Germany noted that, under German law, the holder of an international registration was not invited to file a response to a provisional refusal based on an opposition, but to request the review of such refusal. Further to this explanation, and taking also into account suggestions by the Delegations of Hungary and the United States of America, it was agreed to amend Rule 17(2)(vii) to read as follows: “the time limit, reasonable under the circumstances, for filing a request for review of, or appeal against, the *ex officio* provisional refusal or the provisional refusal based on an opposition and, as the case may be, for filing a response to the opposition....”

32. Replying to a question raised by the Representative of INTA, the Secretariat stated that the adverb “preferably” in Rule 17(2)(vii) referred to the indication of the *actual date* on which the time limit expired (i.e. the day, the month and the year). Although it was desirable to give this date, it was not obligatory. However, the indication of the time limit to lodge a request for review or an appeal (e.g. in terms of a time period counted from the receipt of the notification of refusal) remained mandatory.

33. The Delegation of Australia expressed concern as regards the requirement under Rule 17(2)(vii) that the time limit for filing a response to a provisional refusal based on an opposition be indicated; under Australian law, the time limit to respond to an opposition started to run from the date on which the opponent submitted evidence supporting the opposition; at the time at which the provisional refusal was notified, such date was still unknown. The Secretariat stated that nothing in the provision prevented an Office from indicating a time limit whose starting point would be an event in the future whose date was yet undetermined.

Rule 17(3) and (4)

34. There were no comments on these provisions as proposed in document MM/WG/2/3.

Rule 17(5)

35. The Delegation of Germany said that it favored a system whereby the decision (whether administrative or judicial) that would be notified to the International Bureau would be truly final; in the case of Germany, the Office awaited the outcome of any appeal to the Federal Patent Court against the decision of the Office. Likewise, the Delegation of Finland, noting that under the proposed paragraph (a) the International Register would not necessarily reflect the final status of protection of a mark, suggested that those Offices which were in a position to send genuinely final decisions should be allowed to do so. The Secretariat said that an Office was able to notify a final decision resulting from proceedings outside the Office under subparagraph (b).

36. The Delegations of Austria and Hungary and the Representative of AIPPI supported the proposals contained in subparagraphs (a) and (b), the latter commenting that it was useful for holders and third parties for a decision of the Office to be recorded and published as soon as possible, without having to wait for the outcome of any appeal. This position was supported by the Representative of ICC and FICPI.

37. Further to a request for clarification from the Delegation of Japan concerning the procedures that should be covered by the terms “once all procedures before the said Office relating to the protection of the mark have been completed” in subparagraph (a), the Secretariat said that this was a matter to be determined by each Contracting Party.

38. The Delegation of Switzerland stated that in the particular case of *restitutio in integrum*, the Swiss Federal Institute of Intellectual Property took a decision after all procedures before the said Institute had been considered as completed. In order therefore to reflect the possibility that the “further decision” mentioned in subparagraph (b) covered the case of a decision by the Office which followed the ordinary closing of procedures before that Office, the said subparagraph was amended to read as follows: “Where, following the sending of a statement in accordance with subparagraph (a), a further decision affects the protection of the mark, the Office shall, to the extent that it is aware of that decision, send to the International Bureau a further statement indicating the goods and services for which the mark is protected in the Contracting Party concerned.”

39. The Working Group agreed that the Notes accompanying the proposals to be submitted to the Assembly of the Madrid Union would expressly mention the fact that the wording of subparagraph (b) covered the case of a further decision by the Office as explained in the foregoing paragraph. It was further suggested that the Offices could provide information for publication in the *Guide to the International Registration of Marks Under The Madrid Agreement and the Madrid Protocol* concerning the actual procedures which were covered by subparagraphs (a) and (b) in the respective Contracting Parties.

40. Summarizing the discussion, the Chair noted that there was a consensus that Offices should send information to the International Bureau once a situation had been reached where what was in practice likely to be a final decision had been taken. It was up to each Office to decide when this stage had been reached and in particular to determine whether the proceedings of a Trial and Appeal Board amounted to “procedures before the Office.”

41. Further to a proposal by the Delegation of the Russian Federation to replace the word “statement” by “notification” in paragraph (b), the Secretariat stated that word “notification” was used in connection with a communication from which stemmed a legal consequence, whereas the word “statement” was used in connection with a piece of information furnished by an Office on the status of the mark.

42. As regards paragraph (5)(d), the Delegations of Spain and Portugal declared that they fully agreed with the proposal made by the International Bureau in document MM/WG/2/3 Add.

43. As regards paragraph (5)(e), the Delegation of China declared that it fully agreed with the proposal made by the International Bureau in document MM/WG/2/3 Add.

Rule 17(6)

44. Further to a proposal by the Delegation of Ireland, supported by the Representative of AIPPI, it was agreed that items (ii) and (iii) of paragraph (6)(a) would be amended to take account of the fact that the protection of the mark could still be subject, not only to opposition, but also to observations by third parties.

45. Following a suggestion by the Representative of AIPPI, the Working Group agreed that the Notes accompanying the proposals to be submitted to the Assembly of the Madrid Union would make it clear that the reference to “observations by third parties” in items (ii) and (iii) would apply only to those Contracting Parties whose national or regional legislation provided for such possibility.

Rule 18

Rule 18(1)

46. The Secretariat noted that, in Rule 18(1)(c)(i), the reference to Rule 2(1)(a) should be replaced by a reference to Rule 2 only. It further indicated that Rule 18(1)(d) should be aligned with Rule 17(2)(vii) as amended during this session.

47. In reply to a question raised by the Delegation of the United Kingdom, the Secretariat explained that the word “should” in draft Rule 18(1)(d) made it clear that the indication of the new time limit mentioned in that provision was not a compulsory requirement. The Delegation of the United States of America indicated that its practice was to set long time limits initially, thereby rendering a new time limit unnecessary. It was agreed to replace, in what is now Rule 18(1)(e), “should” by “shall, where the applicable law so permits.”

48. The Delegations of Japan, Denmark and the Russian Federation supported alternative A relating to Rule 18(1) insofar as it provided for a time limit for the Office to send a rectified notification and clearly set out the consequences in case of an irregular notification of provisional refusal.

49. The Delegations of Hungary, the United Kingdom and Germany, as well as the Representative of ICC and FICPI, declared their support for alternative B.

50. The Representative of AIPPI, while favoring alternative B, said that the absence of any legal consequence if an Office failed to send a rectified notification within the prescribed time limit did not create a proper balance between the interests of users and those of Offices.

51. With a view to accommodating the various observations made by the Working Group, the Secretariat suggested to retain alternative B with the following amendments: firstly, the two-month time limit for an Office to send a rectified notification would be maintained, and, secondly, where the irregularity consisted in failure to indicate the remedies against the provisional refusal (as provided for in Rule 18(1)(c)(iv)), the provisional refusal would not be recorded in the International Register and would not be considered as such unless it was rectified within this time limit.

Rule 18(2)

52. There were no comments on this provision as proposed in document MM/WG/2/3.

Rule 20

53. The Secretariat, after recalling that Rule 20(1) allowed for the information relating to a restriction of the holder's right of disposal to be sent either by the Contracting Party of the holder or by the holder himself, suggested that the removal of such a restriction, as provided for in paragraph (2), should also be allowed to be requested by the holder having requested the recording of the said restriction. It was agreed to amend Rule 20(2) accordingly.

54. The Representative of INTA suggested to specify in Rule 20(1) the possibility of a partial restriction of the holder's right of disposal (i.e. in respect of only some of the designated Contracting Parties).

55. In reply to observations made by the Delegations of the United States of America and Austria, as well as the Representative of AIPPI, the Secretariat explained that, under the proposed wording of Rule 20, just as the under current version of that provision, a third party was entitled to request the recording of a restriction, or its removal, but only insofar as the corresponding request was presented to the International Bureau through the intermediary of an Office (since that third party was unknown to the International Bureau).

56. The Representative of AIM was of the opinion that third parties should not be entitled to request the recording of a restriction of the holder's right of disposal.

57. The Delegation of Hungary noted that a general concern was that no documentary evidence was required for the recording of a restriction of the holder's right of disposal and wondered to what extent the furnishing of such documents was necessary. The absence of control could prove problematic in particular in the case of a request made by a third party.

58. The Secretariat replied that a request made by a third party for recording a restriction would necessarily be presented through an Office; it would be up to that Office to check the legitimacy of the request. The International Bureau did not have the competence for carrying out such an examination.

59. The Delegation of Finland suggested to complete paragraph (3) in order to provide that the information relating to a restriction be also transmitted to the designated Contracting Parties concerned.

60. The Chair, taking into account the observations made by the Working Group, proposed to add at the end of paragraph (1)(a) the words "and, if appropriate, indicate the Contracting Parties concerned" and to replace in paragraph (3) the words "the holder accordingly" by "accordingly the holder, the designated Contracting Parties concerned and, where the recording has been requested by an Office, that Office." It was so agreed.

61. The Secretariat finally pointed out that the recording of a restriction of the holder's right of disposal was at this stage exempted from fees, given in particular the small number of requests for recording currently received. However, the payment of such a fee could be provided for in the future if the new provision increased significantly the number of requests for recording presented to the International Bureau.

Rule 20bis

62. The Delegation of the Russian Federation asked what was the legal basis for providing in the Regulations for the recording of licenses. The Secretariat referred to Article 9bis(v) of the Protocol, which provides for the recording of “any other relevant fact, identified in the Regulations, concerning the rights in a mark that is the subject of an international registration.”

63. The Delegation of Japan, noting that a modification of Japanese law would be required before its country could recognize the effects of the recording of licenses in the International Register, stated that it considered Rule 20bis(6) to be essential.

Rule 20bis(1)

64. Further to an intervention by the Delegation of Germany stating that the German Patent and Trademark Office did not want to be obliged to present requests to record licenses to the International Bureau, it was agreed that the words “if such Office admits such presentation” would be added to Rule 20bis(1)(a).

65. Replying to a question by the Delegation of the Republic of Korea, the Secretariat said that it would not be possible for a licensee to present a request for recording a sub-license directly to the International Bureau. The Secretariat also drew attention to the fact that the question of sub-licenses had been deliberately left out of the Joint Recommendation Concerning Trademark Licenses, adopted by the General Assembly of WIPO and the Assembly of the Paris Union in September 2000, and suggested that this was an issue which should similarly be left out of Rule 20bis.

66. Following a proposal by the Delegation of Japan, it was agreed that item (v) in Rule 20bis(1)(b) would include an indication of the classes of the International Classification of Goods and Services.

67. With respect to item (vi) of draft Rule 20bis(1)(b), it was agreed, further to a proposal by the Delegation of the Republic of Korea, that the Notes accompanying the proposals to be submitted to the Assembly of the Madrid Union would make it clear that, where there was no indication that a license was exclusive or sole, it could be considered that the license was non-exclusive.

68. The Delegation of Switzerland, supported by the Delegation of Hungary and the Representative of AIPPI, suggested that items (vi) and (vii) of subparagraph (b) be transferred to subparagraph (c), so that the information referred to in such items be optional. Although the Delegations of Spain, Portugal, Italy and the Republic of Korea were initially of the opinion that the aforementioned items should be treated as compulsory information, a consensus was reached on the transfer of items (vi) and (vii) from subparagraph (b) to subparagraph (c).

69. Further to a proposal by the Delegation of Italy and the Representative of FICPI, it was agreed that an indication of the name and address of the representative of the licensee would be added to Rule 20bis(1) as a new item in subparagraph (c).

Rule 20bis(2) and (3)

70. The Delegation of Japan proposed that the “applicable requirements” mentioned in paragraphs (2) and (3) be explicitly identified in those provisions. It was so agreed.

Rule 20bis(4)

71. There were no comments on this provision as proposed in document MM/WG/2/3.

Rule 20bis(5)

72. The Secretariat drew the Working Group’s attention to the fact that the intention of this provision was to enable an Office to declare that the recording of a license was without effect, not the license itself, and that the text would be modified accordingly.

73. Further to a proposal by the Delegation of Spain, supported by the Delegations of the United States of America and Italy, it was agreed to provide for a time limit for the Office of a designated Contracting Party to declare that the recording of a license had no effect in that Contracting Party. Following a suggestion by the Representative of AIPPI, supported by the Delegations of Sweden and Spain, an 18-month time limit was agreed upon.

74. In reply to a question by the Delegation of Hungary with respect to Rule 20bis(5)(b)(i), which pointed out that, under Hungarian law, a license could not be recorded if it was likely to entail confusion for the consumers, the Secretariat stated that the grounds on which the recording of a license could be denied effects in a Contracting Party were a matter left entirely to the law of that Contracting Party.

75. The Representative of AIM commented that a refusal on purely formal grounds to recognize the effects of a license should not be final. The Representative of AIPPI asked that it be made clear in the Notes that would accompany the proposal that such a refusal on formal grounds should always be open to re-examination.

Rule 20bis(6)

76. The Delegation of China noted that this paragraph excluded the possibility for a Contracting Party to make the declaration referred to therein after the date on which this rule came into force or after the date on which the said Contracting Party became bound by the Agreement or the Protocol. The Representative of AIPPI, noting that, as evidenced by paragraph 43 of document MM/WG/2/4, the proposed Rule 20bis(6) was conceived as a “no-roll-back” provision, drew attention to the fact that a Contracting Party whose legislation provided for the recording of licenses could, as a result of a change in its law, subsequently cease to provide for such recording and could therefore wish to make a declaration under this paragraph at a later date.

77. Taking the foregoing observations into account, and also in order to make it clear that Contracting Parties whose law did not provide for the recording of licenses could declare that the recording of licenses in the International Register had no effect on their territory, it was agreed that paragraph (6) would be re-drafted (as reflected in Annex I) in order to cover all situations. The Working Group also agreed that the intent and scope of paragraph (6) would be clarified in the Notes accompanying Rule 20*bis* in the document to be submitted to the Assembly of the Madrid Union.

78. The Representative of ICC and FICPI and the Representative of INTA and LES expressed support for Rule 20*bis* since it would greatly simplify the procedures to record licenses with effect in several countries. The Representative of AIM asked that it be made clear in the Notes that would accompany these proposals that the sole purpose of Rule 20*bis* was to enable holders or licensees to record licenses if they so wished and did not introduce any obligation to do so.

Rule 24

79. The Secretariat drew attention to the fact that the terminology of Rule 24(1)(a) would be aligned with that of Rules 1(xx*vibis*) and 25(2)(a)(iv) and that the wording of the final sentence of paragraph 5(c) would be reviewed.

Rule 25(1)(c)

80. This provision was approved by the Working Group as proposed in document MM/WG/2/3.

Rule 27(4) and (5)

Rule 27(4)

81. The Working Group agreed to provide for an 18-month time limit for an Office to declare that a change in ownership had no effect.

Rule 27(5)

82. Following a suggestion made by the Delegation of Japan, it was agreed to add at the end of paragraph (5)(a) a new sentence explaining the effects of a declaration under this provision.

83. The Working Group agreed to provide for an 18-month time limit for the Office of a designated Contracting Party to declare that a limitation had no effect.

Rule 28

84. Regarding the time limit for correction provided for in Rule 28(4), the Delegations of Hungary, France, Germany, Spain, Portugal and Greece favored or declared that they could accept a time limit of nine months, while the Delegations of Japan, Denmark, the United Kingdom, Australia, the Republic of Korea and the Representative of AIPPI favored a time limit of six months and the Delegation of Italy a time limit of 12 months.

85. Taking all views into account, the Working Group agreed that a time limit of nine months would be retained on the understanding that the International Bureau would keep the matter under review with a view to proposing a reduction of the time limit to six months in the future if experience showed that six months were sufficient.

Rule 32(1) and (2)

86. This provision was revised to take account of additional matter to be published and changes in the numbering of provisions.

Rule 34

87. The Delegation of Australia thanked the Secretariat for its proposal in paragraph (3). This would enable Australia to set amounts of individual fees which ensured parity of treatment between applicants designating Australia through the international system and applicants for national registration. It was Australia's intention in taking the initiative of this proposal to encourage the use of the Madrid Protocol.

88. In reply to a question from the Delegation of Ireland, which mentioned that its country was in the final stages of ratification of the Protocol, the Secretariat indicated that a notification under Rule 34(3)(a) would take effect immediately unless a later date was specified in the notification or, if made before the date of entry into force of the Protocol, with respect to the Contracting Party concerned, on that date.

89. Following a suggestion by the Delegation of the United States of America, it was agreed to transfer paragraph (4) of Rule 34, concerning the modes of payment of fees, to the Administrative Instructions in order to allow account to be taken of more modern methods of payment when that became practicable.

Rule 38

90. This provision was approved by the Working Group as proposed in document MM/WG/2/3.

Schedule of Fees (item 7)

91. This item was approved by the Working Group as proposed in document MM/WG/2/3.

General

92. It was also agreed that, throughout the English version of the Regulations, the words “recordal” and “recordals” would be replaced by “recording” or “recordings.”

III. DRAFT ADMINISTRATIVE INSTRUCTIONS FOR THE APPLICATION OF THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS AND THE PROTOCOL RELATING THERETO

93. The provisions as proposed in documents MM/WG/2/5 and MM/WG/2/5 Add. and approved by the Working Group appear in Annex III.

IV. FUTURE ACTION: ENTRY INTO FORCE

94. The Secretariat stated that the proposals approved by the Working Group would be submitted for adoption by the Assembly of the Madrid Union in September 2001. The document for the Assembly would propose that the entry into force of the amendments to the Common Regulations be fixed for April 1, 2002, so that the International Bureau, the Offices and the users would have sufficient time to prepare for the implementation of the changes.

95. As exceptions, however, the document submitted to the Assembly would propose that the amendments to Rule 34 concerning the amounts and payment of fees, and in particular the insertion therein of paragraph (3) relating to the individual fees payable in two parts, as well as the amendments to Rule 7, could enter into force immediately after the adoption of those amendments by the Assembly of the Madrid Union.

96. This report was unanimously adopted by the Working Group on June 15, 2001.

[Annexes follow]

ANNEXE I/ANNEX I

LISTE DES PARTICIPANTS/LIST OF PARTICIPANTS

I. MEMBRES/MEMBERS

(dans l'ordre alphabétique des noms français des États/
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VI. BUREAU INTERNATIONAL DE L'ORGANISATION MONDIALE
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[Annex II follows]

ANNEX II

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

Amended Rules as Approved by the Working Group*

Rule 1
Abbreviated Expressions

For the purposes of these Regulations,

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

.....

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

.....

~~——(xviii**bis**) “Contracting Party whose designation is governed by the Protocol” means a
Contracting Party designated under the Protocol or, where a change of ownership has been
recorded and the Contracting Party of the holder is bound by the Protocol, a designated
Contracting Party which is also bound by the Protocol, provided that the said Contracting Parties
are not both bound by the Agreement;~~

.....

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

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

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

(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;

.....

(xxvibis) “Contracting Party of the holder” means

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

.....

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

Rule 2
Communication with the International Bureau

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

Rule 3
Representation Before the International Bureau

.....

(2) [Appointment of the Representative] (a) The appointment of a representative may be made in the international application, or in a subsequent designation or a request under Rule 25 ~~if such subsequent designation or request is made through an Office.~~

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

- (i) by the applicant, the holder or the appointed representative, or
- (ii) by the Office of the Contracting Party of the holder.

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

.....

Rule 7
Notification Of Certain Special Requirements

(1) [Deleted]

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

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

(b) Any notification made under paragraph (1), as in force before ~~date~~ October 4, 2001^{*}, ~~or shall be withdrawn by, at the latest, [date]. Any notification made under~~ paragraph (2) may be withdrawn at any time. The notice of withdrawal shall be addressed to the Director General. The withdrawal shall have effect upon receipt of the notice of withdrawal by the Director General or at any later date indicated in the notice.

* Paragraph (1) of Rule 7 read:

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

Rule 9
Requirements Concerning the International Application

.....

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

(xv) the designated Contracting Parties.

(b) The international application may also contain,

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

(ii) be included in the international application.

Rule 14
Registration of the Mark in the International Register

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

.....

Rule 15
Date of the International Registration

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

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

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

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

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

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

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

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

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

Rule 17
Provisional Refusal and Statement of Grant of Protection

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

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

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

(i) the Office making the notification,

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

(iii) [Deleted]

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

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

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

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

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

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

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

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

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

(iii) the ~~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 ~~affects affecting~~ the protection of the mark, the Office shall, [to the extent that it is aware of that decision](#), send to the International Bureau a further statement indicating the goods and services for which the mark is protected in the Contracting Party concerned.

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

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

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

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

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

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

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

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

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

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

Rule 18
Irregular Notifications of Provisional Refusal

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

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

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

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

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

(c) If the notification

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

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

(iv) does not comply with the requirements of ~~indicate the authority with which a request for review, an appeal or a response to an opposition may be filed and the applicable time limit for lodging such a request, appeal or response~~ (Rule 17(2)(vii)), or

(v) [Deleted]

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

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

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

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

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

Alternative A

~~the International Bureau shall invite the Office which communicated the refusal to send a rectified notification within two months from the invitation. The International Bureau 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 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 of the rectified notification 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 send a rectified notification 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) As soon as it receives the rectified notification, the International Bureau shall transmit a copy thereof to the holder.~~

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

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

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

Rule 19

Invalidations in Designated Contracting Parties

.....

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

Rule 20
Restriction of the Holder's Right of Disposal

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

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

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

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

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

Rule 20bis
Licenses

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

(b) The request shall ~~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 covered by the international registration, or the goods and services for which the license is granted, grouped in the appropriate classes of the International Classification of Goods and Services.

~~(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;

~~(iv) where the licensee has a representative, the name and address of the representative, given in accordance with the Administrative Instructions,~~

~~(v) where the license is an exclusive license or a sole license, that fact,~~

~~(vi) where applicable, the duration of the license.~~

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

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

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

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

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

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

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

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

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

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

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

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

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

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

Rule 23
Division or Merger of the Basic Applications,
of the Registrations Resulting Therefrom,
or of the Basic Registrations

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

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

(ii) the name of the holder or applicant,

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

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

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

Rule 24
Designation Subsequent to the International Registration

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

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

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

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

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

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

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

(3) *[Contents]*

.....

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

.....

(5) *[Irregularities]*

.....

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

.....

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

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

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

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

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

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

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

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

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

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

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

(i) the number of the international registration concerned,

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

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

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

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

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

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

.....

Rule 27

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

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

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

(2) [Deleted]

(3) *[Recording of Merger of International Registrations]* Where the same natural person or legal entity has been recorded as the holder of two or more international registrations resulting from a partial change in ownership ~~under paragraph (2)~~, the registrations shall be merged at the request of the said person or entity, made either direct or through the Office of the Contracting Party of the holder. The International Bureau shall notify accordingly the Offices of the designated Contracting Parties affected by the change and shall inform at the same time the holder and, if the request was presented by an Office, that Office.

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

.....

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

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

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

~~(e) The International Bureau shall record in the International Register any declaration referred to in subparagraph (a) 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.~~

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

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

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

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

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

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

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

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

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

~~(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).~~

Rule 28
Corrections in the International Register

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

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

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

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

Rule 32
Gazette

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

.....

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

.....

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

.....

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

.....

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

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

.....

(iv) any notification made under Rule 34(~~4~~2)(b) or (3)(a);

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

.....

Rule 34
Amounts and Payment Of Fees

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

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

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

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

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

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

(i) the number of the international registration concerned,

(ii) the name of the holder,

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

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

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

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

~~(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.~~

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

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

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

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

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

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

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

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

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

Rule 35
Currency of Payments

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

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

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

Rule 41
Administrative Instructions

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

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

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

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

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

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

SCHEDULE OF FEES

Swiss francs

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7. *Miscellaneous recordings*

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7.5 Recording of a license in respect of an international registration	177
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[Annex III follows]

ANNEX III

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

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Part One

Definitions

Section 1: Abbreviated Expressions

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

Part Two

Forms

Section 2: International Application

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

Section 3: Designation Subsequent to the International Registration

A subsequent designation shall be made on form MM4.

Section 4: Other Official Forms

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

Section 5: Unofficial Forms

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

Part Three

Communications with the International Bureau; Signature

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

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

Section 7: Signature

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

Section 8: Communications by Telefacsimile

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

Section 9: The Original Reproduction or Reproductions of the Mark

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

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

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

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

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

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

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

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

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

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

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

Part Four

Requirements Concerning Names and Addresses

Section 12: Names and Addresses

(a) In the case of a natural person, the name to be indicated is the family or principal name and the given or secondary name(s) of the natural person.

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

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

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

Section 13: Address for Correspondence

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

Part Five

Notification of Provisional Refusals

Section 14: Date of Sending of Notification of Provisional Refusal

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

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

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

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

Part Six

Numbering of International Registrations

Section 16: Numbering Following Partial Change in Ownership

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

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

Section 17: Numbering Following Merger of International Registrations

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

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

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

Part Seven

Payment of Fees

Section 19: Modes of Payment

Fees may be paid to the International Bureau

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

[End of Annex III and of document]