



WIPO | MADRID

The International
Trademark System



Notifications under Rule 22

Madrid Working Group Roundtable

**Geneva
June 21,
2017**

Juan Rodriguez
Senior Legal Officer

Independence

Article 6(2)

Upon the expiry of a period of five years from the date of the international registration, such registration shall become independent of the basic application or the registration resulting therefrom, or of the basic registration, as the case may be, subject to the following provisions.

PROTECTION MAY NO LONGER BE INVOKED – ARTICLE 6(3)

FACTS AND DECISIONS BEFORE THE EXPIRY OF THE DEPENDENCY PERIOD

Before the expiry of the dependency period

The basic application is

withdrawn

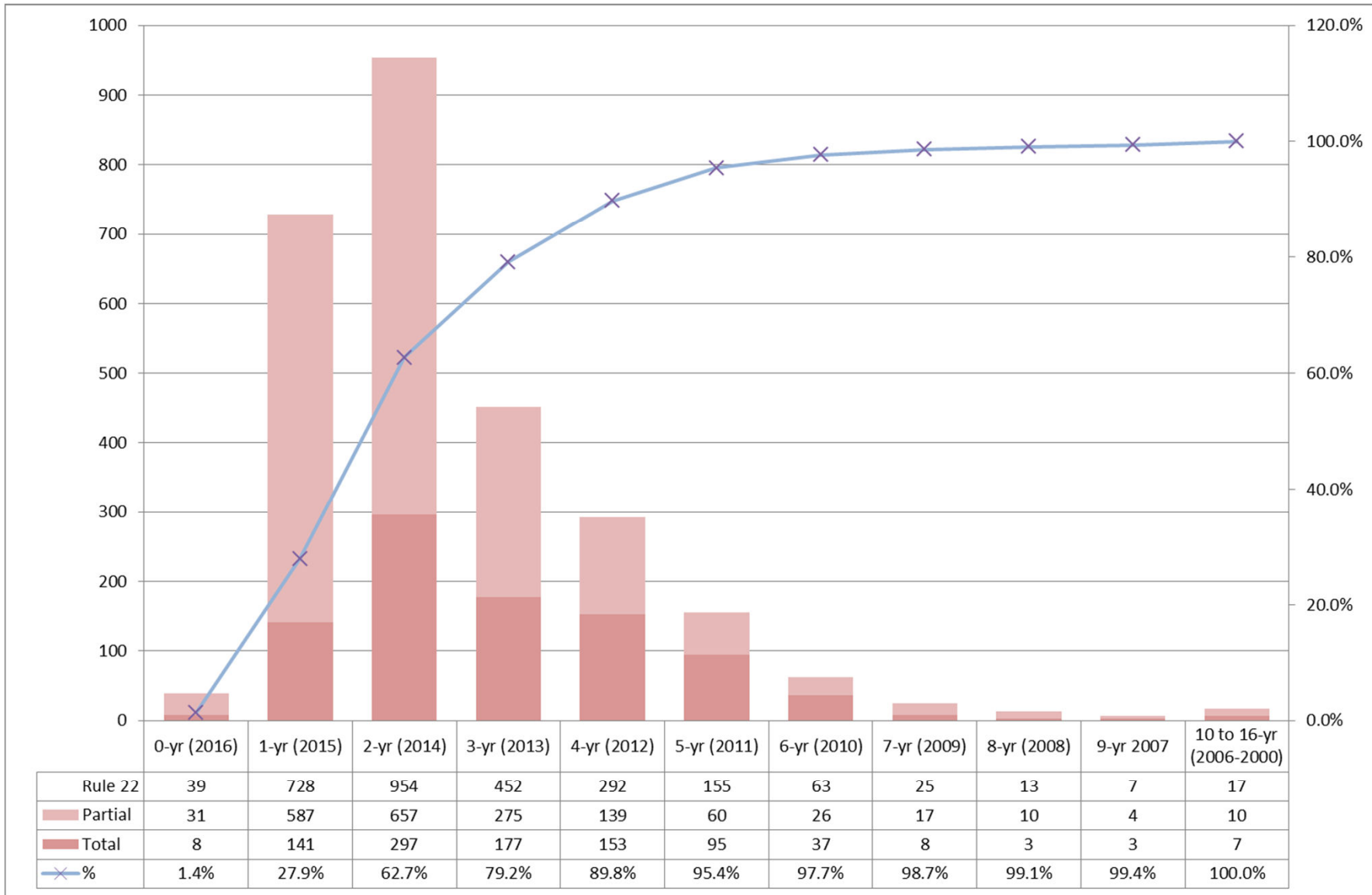
the subject of a final decision of rejection

The basic or resulting registration

lapses

is renounced

is the subject of a final decision of revocation, cancellation or invalidation



PROTECTION MAY NO LONGER BE INVOKED – ARTICLE 6(3)

FACTS AND DECISIONS AFTER THE EXPIRY OF THE DEPENDENCY PERIOD

Basic application

After the expiry of the dependency period, the basic application is

the subject of a final decision of rejection resulting from

an appeal against a decision refusing the effects of the basic application which begun before the expiry of such period

an opposition to the basic application which begun before the expiry of such period

the subject of a final decision ordering its withdrawal resulting from an action requesting such withdrawal which begun before the expiry of such period

withdrawn while being still the subject of a proceeding in the above-mentioned appeal, opposition or action

Basic or resulting registration

After the expiry of the dependency period, the registration (basic or resulting) is

the subject of a final decision of revocation, cancellation or invalidation resulting from an action requesting such revocation, cancellation or invalidation which begun before the expiry of such period

renounced while being still the subject of a proceeding in the above-mentioned action.

NOTIFICATION UNDER ARTICLE 6(4)

Article 6(4)

The Office
of origin
must

notify the International Bureau the facts and
decisions relevant under paragraph (3)

request the International Bureau to cancel, to the
extent applicable, the international registration

The
International
Bureau
must

notify interested parties and publish

cancel the international registration to the extent
requested by the Office of origin

Rule 22(1)(a)

Contents of the notification

- International registration number
- Name of the holder
- Facts and decisions relevant under Article 6(3)
- Effective date of those facts and decisions
- Goods and services which are affected or those which are not affected

Model form 9

| |
|--|
| I. Office making the notification: |
| II. Number of the international registration: |
| III. Name of the holder: |
| IV. Facts and decisions affecting the basic application, the registration resulting therefrom, or the basic registration and their effective date: <i>Please briefly state these facts and decisions:</i> Voluntary information: <input type="checkbox"/> Not resulting from an action brought by a third party <input type="checkbox"/> Resulting from an action brought by a third party, for example, an opposition or a request for cancellation ("central attack"). |
| V. Effective date of these facts and decisions: |

| |
|--|
| VI. Goods and services affected by the facts and decisions: <i>Please choose only one of the following options and, where applicable, list the goods and/or services:</i> Total cancellation: <input type="checkbox"/> The facts and decisions affect all the goods and/or services of the international registration Partial cancellation: <input type="checkbox"/> The facts and decisions affect only the goods and/or services of the international registration listed below <input type="checkbox"/> The facts and decisions do not affect the goods and/or services of the international registration listed below List of goods and /or services: |
| VII. Request for the cancellation of the international registration: In accordance with Article 6(4) of the Madrid Protocol, the undersigned Office hereby requests the cancellation of the international registration to the extent indicated under item VI. |
| VIII. Signature or official seal of the Office making the notification: |
| IX. Date of notification to the International Bureau: |

Rule 22(1)(b)

Ongoing proceeding

At the expiry of the dependency period, the following has begun but there is not yet a final decision

An appeal against a decision refusing the effects of a basic application

An opposition to the basic application

An action requesting the withdrawal of the basic application or the revocation, cancellation or invalidation of the basic or resulting registration

Rule 22

Future changes

November
1, 2017

Amendment to paragraph (1)(c) will require that Offices always notify the outcome –the final decision– of an ongoing proceeding notified under paragraph (1)(b)

Amendment to paragraph (2)(b) will require the International Bureau to cancel –to the applicable extent– international registrations resulting from partial change in ownership recorded under a registration cancelled due to ceasing of effect, and those from their merger

February
1, 2019

Amendment to paragraph (2)(b) will require the International Bureau to also cancel –to the applicable extent– international registrations resulting from division recorded under a registration cancelled due to ceasing of effect, and those from their merger

Thank you

juan.rodriguez@wipo.int

