

Division and merger of international registrations

Juan Rodriguez
Senior Legal Officer
Legal Division
Madrid Registry

Working Group Roundtable Geneva, July 2018

DIVISION



Request (Rule 27bis(1)(a))

Request must be

- in respect of one designated Contracting Party only
- in respect of some only of the goods and services
- filed through the intermediary of the Office of the designated Contracting Party concerned
- presented to the International Bureau by that Office
- presented on the official form



Request (Rule 27bis(1)(a))

Office may:

- examine the request
- determine whether it meets the [relevant] requirements of its applicable law
- require the payment of a fee directly to the Office



Prescribed requirements (Rule 27bis(1)(b) and (c))

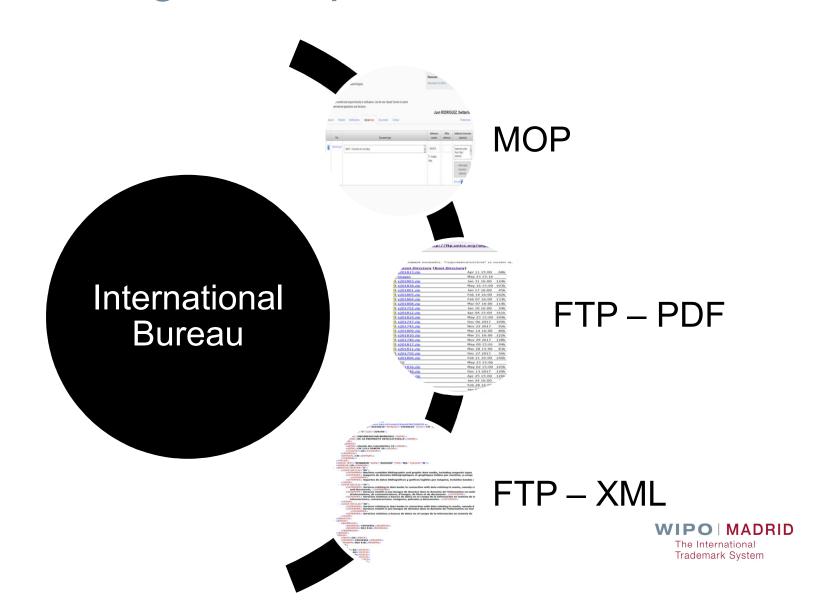
- the Contracting Party of the Office presenting the request,
- the name of the Office presenting the request,
- the number of the international registration,
- the name of the holder,
- the names of the goods and services to be set apart, grouped in the appropriate classes
- method of payment or <u>instructions</u> to debit from a current account and party making the payment
- signed by the Office presenting the request and, where the Office so requires, also by the holder
 WIPO MADRIE The International Trademark System

MM**(E)

REQUEST FOR THE DIVISION OF AN INTERNATIONAL REGISTRATION

						MM**(E), page 2
	For the holder This request contains the following number of continuation sheets: Office's reference:		7		senting the request) emational registration, the statement indicated below goods and services listed in item 5 (please, check only	
Holde	er's reference:			A statement of interim status of the ma	ark in accordance with Rule 18bis(1) of the Common	Regulations
1	CONTRACTING PARTY OF THE OFFICE PRESENTING TO (name of the Contracting Party in respect of which the internal		<u>_</u>	A statement of grant of protection in ac	ccordance with Rule 18ter of the Common Regulation	ns
			8	SIGNATURE BY THE OFFICE PRESENTI		
2	NAME OF THE OFFICE PRESENTING THE REQUEST (must be the Office of the Contracting Party indicated in item	1)		By signing this form, I declare that I am enti	,	
3	INTERNATIONAL REGISTRATION NUMBER (international registration to be divided in respect of the Cont				erson in the Office:	
_						
4	NAME OF THE HOLDER (as recorded in the International Register)					MM**(E), page 3
					PAYMENT INFORMATION	
5	GOODS AND SERVICES FOR WHICH DIVISION IS TO BE (names of the goods the goods and services to be set apart appropriate classes)		(a)	AMOUNT OF FEE		177 Swiss francs
			(1	NSTRUCTIONS TO DEBIT FROM A CURR If the holder wants to debit the required amo he box below and indicate the following)	RENT ACCOUNT ount from a current account opened with the Internation	onal Bureau, please, tick
				The International Bureau is hereby instructenternational Bureau	ed to debit the required amount of fees from a curre	nt account opened with the
			Holder	of the account:	Account number:	
			Identity	y of the party giving the instructions:		
						1
	If the space provided above is not sufficient, check the bo	ox and use a continuation sheet		IETHOD OF PAYMENT f the holder has already transferred the requ	uired amount to a WIPO bank or postal account, plea	se, indicate the following)
6	SIGNATURE BY THE HOLDER		Identity	y of the party effecting the payment:	WIPO receipt number	
	(only when the Office presenting the request requires the hol	der to do so)	Payme	ent received and acknowledged by WIPO		
	Holder) (as recorded in the International Register)	Representative of the holder (before the Office presenting the request)		ent made to WIPO bank account	Payment identification	dd/mm/yyyy
	By signing this form, I declare that I am entitled to sign it under the applicable law:	By signing this form, I declare that I am entitled to sign it under the applicable law:	Crédit Swift/B	No. CH51 0483 5048 7080 8100 0 Suisse, CH-1211 Geneva 70 BIC: CRESCHZZ80A		
	Name:	Name:	(within IBAN N	ent made to WIPO postal account Europe only) No. CH03 0900 0000 1200 5000 8 BIC: POFICHBE	Payment identification	ddimmiyyyy
	Signature:	Signature:	Swille	NO. 1 OF TOTIBE		

Presenting the request to the IB



Request not considered as such (Rule 27bis(5))

- IB will not process requests where
 - international registration is no longer in force, or
 - Contracting Party was not designated, has been renounced or notified total invalidation, or
 - classes have been cancelled, limited or invalidated
- IB will simply inform the Office and the holder and reimburse any amount paid



G&S listed in the request

The IB will not examine the G&S listed in the request to determine whether they are:

- properly classified, or
- covered by the list of G&S for which the international registration has effects in the Contracting Party



Irregularities (Rule 27bis(3)(a))

- IB to examine for requirements prescribed in Rule 27bis(1)(b), (c) and (2)
- Requirements in Rule 27bis(1)(b) and (c) must be remedied by the Office
- In principle, the fee (Rule 27*bis*(2)) should be paid by the holder



Possible irregularities

- not in a working language
- not on official form
- missing Contracting Party, name of the Office, IRN, holder's name, G&S or payment information
- IRN and holder's name do not agree
- G&S not grouped in classes
- not signed by the Office
- filed directly by the holder
- insufficient payment



Abandonment (Rule 27bis(3)(b))

The IB must:

- notify the Office, inform the holder,
- keep, at least, CHF 88.50 and reimburse the rest to the party that made the payment, and,
- disregard any statement in or sent with the request



Recording and notification (Rule 27bis(3))

- Recording of division modeled after the recording of a partial change in ownership
- Division itself will be recorded in the parent international registration with the date on which the request was received or remedied
- The IB will create a divisional international registration, notify the Office and inform the holder



Ma 225 672 et 225 673 14 novembre 1959

KNOLL & CIE AKTIENGESELLSCHAFT, fabrication et commerce 65. Oristalstrasse, LIESTAL (Suisse)

Nº 225 672

MODENOL

Médicaments, produits chimiques pour usages médicinaux et hygiéniques, drogues et préparations pharmaceutiques, emplâtres, articles de pansement, produits chimiques à usages industriels, scientifiques et photographiques, substances alimentaires diététiques. (Cl. 1, 5)

Enregistrement au pays d'origine (Suisse): 9 mai 1945, № 110 839.

Enregistrements internationaux antérieurs: 17 décembre 1919, № 21 397, et 23 novembre 1939, № 102 333.

Nº 225 673

ASTONIN

Médicaments, produits chimiques pour usages médicinaux et hygiéniques, drogues et préparations pharmaceutiques, emplâtres, articles de pansement, produits chimiques à usages industriels, scientifiques et photographiques, substances alimentaires diététiques. (Cl. 1, 5)

Enregistrement au pays d'origine (Suisse): 9 mai 1945, № 110 840.

Enregistrements internationaux antérieurs: 17 décembre 1919, № 21 398, et 23 novembre 1939, № 102 334.

Emolument payé pour 20 ans.

14 novembre 1979

20 ans

R 225 673

E. MERCK (firme)

250, Frankfurter Strasse, D-6100 DARMSTADT (République fédérale d'Allemagne)

ASTONIN

Cl. 1: Produits chimiques à usages industriels, scientifiques et photographiques

Cl. 5: Médicaments, produits chimiques pour usages médicinaux et hygiéniques, drogues et préparations pharmaceutiques, emplâtres, articles de pansement, substances alimentaires diététiques.

Pays intéressés: Allemagne, République fédérale d'; Autriche; Benelux; Égypte; Espagne; France; Hongrie; Italie; Liechtenstein; Maroc; Monaco; République démocratique allemande; Roumanie; Saint-Marin; Tchécoslovaquie; Tunisie; Viet Nam; Yougoslavie.





21397	Knoll z 6º, fahuatum et semmone, Gestal Knoll z 6º, diktringvillishaft,	Aciduamenti, producti chemiques peur usages médici- reaux et, brysiscique, droques et paparation pharma- cutiques, emplatus, carticles de pansement, producti chimiques à usages inclusives, securitiques et phologra- phiques, subotances alimentaries destiliques.	Pays d'origine: Seeldell Energistré le: 1º prevensku 1914	Enregistré le 17 décembre 1019. Notifié aux États le 18 DÉC 1010 Publié dans le journal du 31 DÉC 1919 Notifications et publications ultérieures Objet Notifié le Publié le	16 jane: 1996 Feys - Bes The hydre the	Je mai 1925 TRANSMISSION	MODENOL	NOS CONSTRUCT LE REPUMELIBRAT SPRINGER 23 Mai 119 Nouvel enregistrement international affectué le 23 aoré 1989. Januar de la Novissa.
21398	- Gd.	Jd.	Pays d'origine: Suisse Enregistré le:	Enregistré le 17 décembre 1919. Notifié aux Etats le 18 DEC, 1918. Publié dans le journal du 31 DEC, 1919. Notifications et publications ultéricares Objet Notific le Publié le		14 mai 1415 TRANSMISSION	ASTONIN	AND CONSIDERS IN SECURIORIES SECURIORIES OF THE SEC



Ma 225 672 et 225 673 14 novembre 1959

KNOLL & CIE AKTIENGESELLSCHAFT, fabrication et commerce 65. Oristalstrasse, LIESTAL (Suisse)

Nº 225 672

MODENOL

Médicaments, produits chimiques pour usages médicinaux et hygiéniques, drogues et préparations pharmaceutiques, emplâtres, articles de pansement, produits chimiques à usages industriels, scientifiques et photographiques, substances alimentaires diététiques. (Cl. 1, 5)

Enregistrement au pays d'origine (Suisse): 9 mai 1945, № 110 839.

Enregistrements internationaux antérieurs: 17 décembre 1919, № 21 397, et 23 novembre 1939, № 102 333.

Nº 225 673

ASTONIN

Médicaments, produits chimiques pour usages médicinaux et hygiéniques, drogues et préparations pharmaceutiques, emplâtres, articles de pansement, produits chimiques à usages industriels, scientifiques et photographiques, substances alimentaires diététiques. (Cl. 1, 5)

Enregistrement au pays d'origine (Suisse): 9 mai 1945, № 110 840.

Enregistrements internationaux antérieurs: 17 décembre 1919, № 21 398, et 23 novembre 1939, № 102 334.

Emolument payé pour 20 ans.

14 novembre 1979

20 ans

R 225 673

E. MERCK (firme)

250, Frankfurter Strasse, D-6100 DARMSTADT (République fédérale d'Allemagne)

ASTONIN

Cl. 1: Produits chimiques à usages industriels, scientifiques et photographiques * Cl. 5: Médicaments, produits chimiques pour usages médicinaux et hygiéniques, drogues et préparations pharmaceutiques, emplâtres, articles de pansement, substances alimentaires diététiques.

Pays intéressés: Allemagne, République fédérale d'; Autriche; Benelux; Égypte; Espagne; France; Hongrie; Italie; Liechtenstein; Maroc; Monaco; République démocratique allemande; Roumanie; Saint-Marin; Tchécoslovaquie; Tunisie; Viet Nam; Yougoslavie.



MMO(5), pagina 5

6	ΑL	CAN	CE D	EL CAMBIO EN LA TITULARIDAD (marque a) o h))
	a)		Con	ABIO TOTAL EN LA TITULARIDAD (el cambio en la titularidad ha de inscribirse respecto de todas las Partes tratantes designadas en el registro o los registros internacionales indicados en el punto 1, y para todos los productos y icios a los que se refieren dichos registros internacionales)
	b)	\checkmark	CAN	/BIO PARCIAL EN LA TITULARIDAD (antes de marcar esta casilla, léase la nota N.º 3 en la portada)
			i)	el cambio en la titularidad ha de inscribirse respecto de las Partes Contratantes designadas indicadas a continuación (si no se indica Parte Contratante alguna, se entenderá que el cambio en la titularidad ha de inscribirse respecto de todas las Partes Contratantes designadas); y/o España
			ii)	el cambio en la titularidad ha de inscribirse respecto de los productos y servicios indicados a continuación (agrupados en las clases correspondientes); si no se indican productos y servicios, se entenderá que el cambio en la titularidad ha de inscribirse para todos los productos y servicios.
				En el Gestor de productos y servicios de Madrid (MGS) se puede hallar la lista de indicaciones válidas de la Oficina Internacional, en la siguiente dirección: www.wipo.int/angs/ .
				Por favor, emplee el punto y coma (;) para separar claramente las indicaciones de productos y servicios de su lista. Por ejemplo: 9 Aparatos e instrumentos científicos y ópticos; tramas de fotograbado; ordenadores. 35 Publicidad; recopilación de estadísticas; agencias de información comercial.
				Sirvase utilizar el tipo de letra "Courier New" o "Times New Roman", tamaño 12 pt, o superior.
				Cl. 5: Médicaments, produits chimiques pour usages médicinaux et hygiéniques, drogues
				et préparations pharmaceutiques, emplâtres, articles de pansement, substances alimentaires
				diététiques.
		Si	el es	pacio proporcionado no es suficiente, marque esta casilla y utilice una hoja complementaria
77	IN:	DIC	CIO	NES VARIAS
u				
	a)			nes relativas al nuevo titular (cesionario) (según lo exijan ciertas Partes Contratantes designadas): uevo titular (cesionario) es una persona natural, sirvase indicar su nacionalidad.
				nuevo titular (cesionario) es una persona natural, sirvase mulcar su nacionandad.
				aturaleza jurídica de dicha persona jurídica: S. A.
			- E	stado y, en su caso, unidad territorial dentro de ese Estado, al amparo de cuya legislación se ha constituido dicha persona tridica:
				España
	b)	Elm		titular (cesionario) puede escoger qué idioma prefiere para la correspondencia:
		\checkmark	esp	añol francés inglés
				- Company of the Comp

14 novembre 1979

20 ans

R 225673

E. MERCK (firme)

250, Frankfurter Strasse, D-6100 DARMSTADT (République fédérale d'Allemagne)

ASTONIN

Cl. 1: Produits chimiques à usages industriels, scientifiques et photographiques

Cl. 5: Médicaments, produits chimiques pour usages médicinaux et hygiéniques, drogues et préparations pharmaceutiques, emplâtres, articles de pansement, substances alimentaires diététiques.

Pays intéressés: Allemagne, République fédérale d'; Autriche; Benelux; Égypte; Espagne; France; Hongrie; Italie; Liechtenstein; Maroc; Monaco; République démocratique allemande; Roumanie; Saint-Marin; Tchécoslovaquie; Tunisie; Viet Nam; Yougoslavie.



Cessions partielles



NOTIFICATION CPN/2018/18

Reproduction de la marque ASTONIN

Numéro d'enregistrement 225 673 (ASTONIN)

Nom et adresse MERCK Kommanditgesellschaft auf Aktien

de l'ancien titulaire Frankfurter Strasse 250, 64293 Darmstadt (Allemagne)

Numéro de l'enregistrement issu 225 673 B

de la cession

Date d'inscription 12 mars 2018 au registre international

Numéro d'enregistrement 225 673 B

Date d'enregistrement 14 novembre 1959 Date du renouvellement 14 novembre 2009

Date d'échéance 14 novembre 2019

Nom et adresse LABORATORIOS ERN. S. A. du nouveau titulaire C. de Pere IV, 499, E-08020 Barcelona (Espagne)

Forme juridique du titulaire S. A., España

(personne morale) et lieu de constitution

Nom et adresse du mandataire Joan SALVÀ FERRER, C. del Consell de Cent, 322, E-08007

Barcelona (Espagne)

Liste des produits et services 5 Médicaments, produits chimiques pour usages médicinaux et hygiéniques, drogues et préparations pharmaceutiques. emplatres, articles de pansement, substances alimentaires diététiques.

Enregistrements internationaux 17.12.1919, 021398 antérieurs

Enregistrements internationaux 23.11.1939, 102334

antérieurs

Désignations selon Espagne

le Protocole de Madrid en vertu de l'article 9sexies

14 novembre 1979

20 ans

R 225 673

E. MERCK (firme)

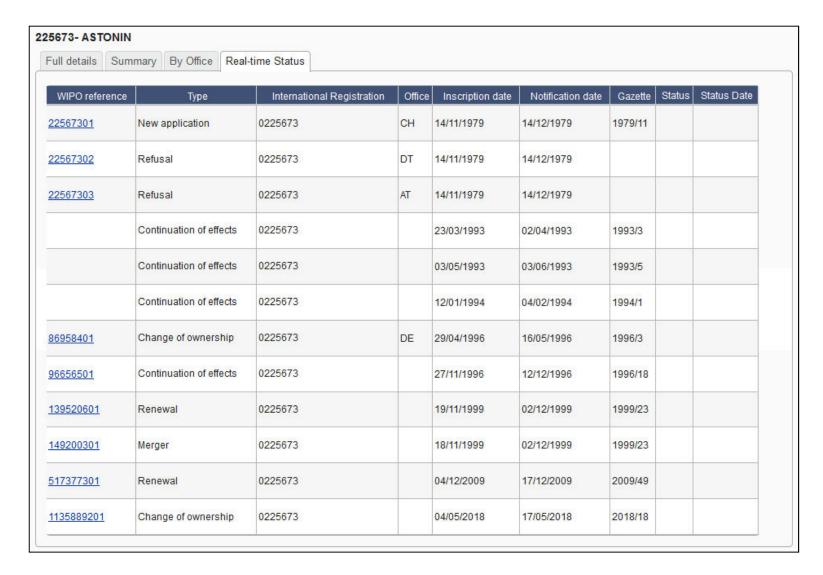
250, Frankfurter Strasse, D-6100 DARMSTADT (République fédérale d'Allemagne)

ASTONIN

Cl. 1: Produits chimiques à usages industriels, scientifiques et photographiques ★ Cl. 5: Médicaments, produits chimiques pour usages médicinaux et hygiéniques, drogues et préparations pharmaceutiques, emplâtres, articles de pansement, substances alimentaires diététiques.

Pays intéressés: Allemagne, République fédérale d'; Autriche; Benelux; Egypte; Espagne; France; Hongrie; Italie; Liechtenstein; Maroc; Monaco; République démocratique allemande; Roumanie; Saint-Marin; Tchécoslovaquie; Tunisie; Viet Nam; Yougoslavie.







Statement (Rule 27bis(1)(d))

- Office may
 - include a statement of either interim status or final disposition of the mark
 - send that statement, along with the form, in a separate document
- The statement <u>must</u> be for the G&S listed in the request



Statement (Rule 27bis(1)(d))

STATEMENT
(optional, to be filled only by the Office presenting the request)

After the recording of the division of the international registration, the statement indicated below shall be recorded under the divisional international registration for the goods and services listed in item 5 (please, check only one box)

A statement of interim status of the mark in accordance with Rule 18bis(1) of the Common Regulations

A statement of grant of protection in accordance with Rule 18ter of the Common Regulations



Trademark System

Recording the statement

- Statements recorded under divisional registration
- When the statement is made by ticking a box in item 7, the IB, after the divisional registration has been created, will record a statement under:
 - Rule 18bis(1)(a) or (2), subject to whether a notification of provisional refusal has been recorded
 - Rule 18*ter*(1) where no decision has been recorded
 - Rule 18*ter*(2)(i) where the most recently recorded decision is a notification provisional refusal
 - Rule 18*ter*(4) where the most recently recorded decision is a statement with a final decision with

Statements that cannot be recorded

- The IB will not record statements not meeting the applicable requirements (e.g. unclear, listing G&S, 18bis after tacit acceptance)
- Such would not prevent the recording of division
- Office can send a new statement after division has been recorded



MERGER



Subject: 4

Date: 2018-03-20 13:40:25

Submission Time: Mar 20, 2018 1:39 PM

I am: a trademark holder, representative or any other interested party

My request general information on the Madrid System (e.g. how to register a trademark, fees,

Concerns: etc.)

IRN (Yes/No): Yes

IRN:

Your request:

Is it possible to merge/combine the designations that are registered under the number

with those that are registered under the number. If so, which form

do I use please?



Merger of IRs resulting from division (Rule 27*ter*(2)(a))

- Request must be:
 - If ited through the intermediary of the Office of the Contracting Party concerned
 - presented to the International Bureau by that Office
 - presented on the official form
- Office may:
 - examine the request
 - determine whether it meets the [relevant] requirements of its applicable law
 - require the payment of a fee directly to the Office





REQUEST FOR THE MERGER OF AN INTERNATIONAL REGISTRATION RESULTING FROM THE RECORDING OF DIVISION

	For the holder	For the Office				
This request contains the following number of continuation sheets:		Office's reference:				
Holde	r's reference:					
1	NAME OF THE HOLDER (as recorded in the International Register; all international registrations to be merged must be in the name of the same person)					
2	2 INTERNATIONAL REGISTRATION NUMBER (please indicate below the number of the international registration resulting from the recording of division to be merged with its parent international registration)					
3	SIGNATURE BY THE HOLDER OR THE RECORDED REPRESENTATIVE (where required or allowed by the Office presenting the request)					
	<u>Holder</u> (as recorded in the International Register)	Representative of the holder (before the Office presenting the request)				
	By signing this form, I declare that I am entitled to sign it under the applicable law:	By signing this form, I declare that I am entitled to sign it under the applicable law:				
	Name:	Name:				
	Signature:	Signature:				
4	OFFICE PRESENTING THE REQUEST (Office of the Contracting Party in respect of which the international registration was divided) Name of the Office:					
	Name and signature of the official signing on behalf of the Office:					
	By signing this form, I declare that I am entitled to sign it under the applicable law:					
	Name and e-mail address of the contact person in the Office:					



Merger will not be recorded when

For all merger requests

- not on official form
- IRNs not in the name of the same person
- one or more IRNs no longer in force

Rule 27ter(2)(a) requests

- not signed by the Office
- filed directly by the holder



Recording and notification Rule 27*ter*(2)(a) merger

- The IB will record the merger in both the divisional and parent international registrations
- The divided part will be merged into the parent international registration
- The IB will notify the Office and inform the holder
- The divisional registration will become an empty shell



626176A- GRUNDIG made for you Full details Summary By Office Real-time Status Gazette Status Туре International Registration Inscription date Status Date WIPO reference Office Notification date Change of ownership 0626176A 07/03/2016 24/03/2016 2016/11 951772501 1140914601 Merger 0626176A 18/04/2018 03/05/2018 2018/16

626176- GRUNDIG made for you

Full details Summary By Office Real-time Status WIPO reference International Registration | Office | Inscription date | Notification date | Gazette Status Status Date Type New application DE 15/08/1994 02/12/1994 1994/11 62617601 0626176 81981301 Refusal 0626176 CZ 23/11/1995 24/11/1995 120449601 Final Decision 0626176 CZ 09/06/1998 10/06/1998 1998/11 Change of holder name and/or 2001/2 172856201 0626176 16/01/2001 01/02/2001 address Change of ownership 0626176 238832701 DE 16/05/2003 29/05/2003 2003/10 Change of ownership 0626176 2016/11 951772501 07/03/2016 24/03/2016 Rectification 0626176 CN Abandoned 21/03/2016 969081601 0626176 Rectification 969081602 29/09/2016 13/10/2016 2016/40 1140914601 Merger 0626176 18/04/2018 03/05/2018 2018/16

Fusions d'enregistrements internationaux

Partie contractante désignée : Chine



NOTIFICATION FUN/2018/16

Numéro d'enregistrement 626 176, 626 176 A (GRUNDIG made for you)

Enregistrement 626 176

résultant de la fusion

Nom et adresse Grundig Multimedia AG

du nouveau titulaire Rotzbergstrasse 1, Stansstad (Suisse)

Date d'inscription 20 mars 2018

au registre international



DECLARATIONS, NOTIFICATION



Declaration under Rule 27bis(6)

- Law does not provide for division of applications or registrations.
- Contracting Parties must send, at the latest, by January 31, 2019.
- New Contracting Parties must send before Protocol enters into force in respect to them.



Model declaration under Rule 27bis(6)

[The applicable law of the Contracting Party] does not provide [for division of applications for the registration of a mark] [or] [for division of registrations of a mark]; therefore, [Contracting Party] will not, in accordance with paragraph (6) of new Rule 27bis of the Common Regulations, present to the International Bureau requests under paragraph (1) of this Rule.



Declaration under Rule 27ter(2)(b)

- Law does not provide for merger of registrations.
- Contracting Parties must send, at the latest, by January 31, 2019.
- New Contracting Parties must send before Protocol enters into force in respect to them.



Model declaration under Rule 27ter(2)(b)

[The applicable law of the Contracting Party] does not provide for the merger of registrations of a mark; therefore, [Contracting Party] will not, in accordance with paragraph (2)(b) of new Rule 27ter of the Common Regulations, present to the International Bureau requests under paragraph (2)(a) of this Rule.



Notification under Rule 40(6)

- New Rules are not compatible with the applicable law.
- May refer to Rule 27*bis*(1) or 27*ter*(2)(a) or both.
- Contracting Parties must send, at the latest, by January 31, 2019.
- New Contracting Parties must send before Protocol enters into force in respect to them.



Model notification under Rule 40(6)

[Paragraph (1) of Rule 27bis] [and] [paragraph (2)(a) of Rule 27ter] of the Common Regulations [is] [are] not compatible with [the applicable law of the Contracting Party]; therefore, the said paragraph[s] shall not apply in respect to [Contracting Party] for as long as [it] [they] continue[s] to be incompatible with [the applicable law of the Contracting Party]



Thank you for your attention

juan.rodriguez@wipo.int

