

# ACCESSION KIT: THE MADRID SYSTEM FOR THE INTERNATIONAL REGISTRATION OF MARKS

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## THE MADRID SYSTEM FOR THE INTERNATIONAL REGISTRATION OF MARKS

### ADVANTAGES OF THE MADRID SYSTEM

1. The Madrid system for international registration of marks has advantages for the trademark owner, for national economies and governments, as well as for professionals, like agents and attorney in the field of trademarks.

#### Benefits for the Trademark Owner

2. The Madrid system allows companies and individuals to obtain and maintain protection for their marks in an ever-increasing number of countries by means of a simple and economical procedure.

3. International registration has several advantages for the owner of the mark. After registering the basic mark, or filing an application for registration, with the Office of origin, he has only to file one international application, in one language, and pay one fee, in one currency. This simple procedure takes place instead of filing separately in the trademark Offices of the various Contracting Parties, in different languages and paying fees to each Office, in different currencies. Different national/regional procedures, involving different languages and fees payable in different currencies, give rise to translation and exchange-related expenses. Where trademark protection is sought by filing direct to national/regional Offices, most of these Offices require the applicant to appoint a local representative to act on his behalf before the Office, at the time of filing of the application. With the Madrid system, the designated Contracting Parties may only require that the holder appoints a local representative in case the holder has received a notification of a provisional refusal and the holder intends to contest this decision before the Office concerned.

4. The main advantages for trademark owners consist of the simplicity of the international registration system and the financial savings made (expenses related to translation, exchange-related fees and fees for local representatives) when obtaining and maintaining the protection of their marks abroad.

5. The companies most affected by the considerable cost involved in registering and maintaining marks abroad are Small and Medium Enterprises (SMEs). While a large company may afford to devote considerable funds to protect its marks abroad, an SME can ill-afford the registration of marks abroad, due to the high procedural costs. The Madrid system is used by one-third of worldwide applicants seeking protection of their marks through the Madrid system. Of these, about 80 per cent may be categorized as an SME, having a small portfolio of one or two marks.

6. In the current economic context, the possibility of providing easy, low-cost protection for marks provides a welcome advantage for companies and individuals as a factor that will favor exports.

7. Moreover, the holder does not have to wait for the Office of each Contracting Party in which protection is sought to take a positive decision to protect the mark. If no refusal is notified by an Office within the applicable time limit, the mark is automatically protected in the Contracting Party concerned. In some cases, the holder does not even have to wait until the expiry of this time limit in order to know that the mark is protected in a Contracting Party, since he may, before the expiry of the time limit, receive a statement of grant of protection from the Office of that Contracting Party.

8. A further important advantage is that changes subsequent to registration, such as a change in the name or address of the holder, or a change (total or partial) in ownership or a limitation of the list of goods and services may be recorded with effect for several designated Contracting Parties through a single, simple and centralized procedure with the International Bureau of the World Intellectual Property Organization (WIPO) (the International Bureau) and with the payment of a single fee. Moreover, there is only one expiry date and only one registration to renew, which makes for easy portfolio management.

#### Benefits for the National Economy, the Government and Trademark Offices

9. The Madrid system may also be seen as benefiting the national/regional economy in general, and the government's finances, in particular.

10. The Madrid system supports the country's exports to the extent that it simplifies protecting trademarks abroad. Furthermore, it allows individuals and companies established in other Contracting Parties of the Madrid system to have easier access to the protection of their marks in the country/regional territory, since they can seek protection of the mark in any of the applicable Contracting Parties by merely designating these in the international application, or in a subsequent designation. This facility helps to strengthen the climate for foreign investment.

11. International registration is also to the advantage of trademark Offices. The Offices do not need to examine for compliance with formal requirements, or to classify the goods or services, or publish the marks, as such formalities will have already been undertaken by the International Bureau, and they can focus on their substantive examination. Moreover, they are compensated for the work that they perform; the individual fees collected by the International Bureau are transferred to the Contracting Parties in respect of which they have been paid, while the complementary and supplementary fees are distributed annually among the Contracting Parties not receiving individual fees, in proportion to the number of designations made of each of them.

#### Benefits for Professionals Active in the Field of Marks

12. The Madrid system provides an optional, alternative procedure that does not dismantle the traditional route of direct filing. Experience shows that companies and individuals may have a variety of reasons to seek protection for a mark alternatively through a direct national/regional application or through an international application. It is also relevant that applications of foreign origin proceed both from Contracting Parties to the Madrid system and countries that are not members of the Madrid system and that applications originating in Contracting Parties to the Madrid system may continue to be filed directly through a local agent or representative.

13. The overall volume of work for local trademark agents should not be expected to decrease by accession to the Madrid system. The effects of the international registration of a mark, as well as all the procedures to exercise and enforce the rights deriving from that registration, are governed by national or regional law. Trademark agents can expect to engage, in addition to tasks ensuing from the filing of applications, in tasks like searches, responses to objections, raising of objections, requests for annulment or cancellation, dispute settlements, license and assignment contracts, among others. Bearing in mind that the number of marks protected locally would gradually increase as a result of accession to the Madrid system, the overall volume of work for agents should also increase commensurately.

14. Accession to the Madrid system will normally offer local agents novel lines of activity, including advisory and representation work for their clients, in conjunction with the filing of international applications originating locally, as well as representing them thereafter in dealings with the International Bureau for the purposes of the international registration.

#### GENERAL OVERVIEW OF THE MADRID SYSTEM; ITS OBJECTIVES AND MAIN FEATURES

15. The Madrid system for the international registration of marks is governed by two treaties: the Madrid Agreement Concerning the International Registration of Marks (“Agreement”), which dates from 1891, and the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (“Protocol”), which was adopted in 1989, entered into force on December 1, 1995, and came into operation on April 1, 1996. The implementation of the Protocol and the Agreement is governed by Common Regulations and Administrative Instructions, which are updated periodically.

16. The Protocol is a treaty independent of the Agreement. In order to be a party to the Protocol, it is not necessary to be party also to the Agreement.

17. The Protocol and the Agreement govern the system of international registration of marks known as “the Madrid system”. Both treaties have a similar structure and a common aim: to facilitate the protection of marks for goods and services, at the international level, through a simple and economical system of registration.

18. The Madrid system is administered by the International Bureau, whose headquarters are in Geneva. The International Bureau maintains the International Register and publishes the *WIPO Gazette of International Marks* (Gazette).

19. Any State which is a party to the Paris Convention for the Protection of Industrial Property (“Paris Convention”) may become a party to the Agreement or the Protocol, or both. In addition, an intergovernmental organization may become a party to the Protocol (but not the Agreement); see more on “Accession” below (paragraphs 63 to 68).

20. States party to the Agreement and/or the Protocol and intergovernmental organizations party to the Protocol are referred to collectively as Contracting Parties. As of January 2013, the Madrid system has 89 Contracting Parties, of which 88 (87 countries and one intergovernmental organization (the European Union)) are members of the Protocol, and only one country is party to the Agreement alone. For a complete list of Contracting Parties, see: [http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/madrid\\_marks.pdf](http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/madrid_marks.pdf).

21. Together, these Contracting Parties constitute the Madrid Union, which is a Special Union under Article 19 of the Paris Convention. Every member of the Madrid Union is a member of its Assembly. Among the most important tasks of the Assembly are the adoption of the program and budget of the Union and the adoption and modification of the implementing regulations, including the fixing of fees connected with the use of the Madrid system.

### Objectives of the Madrid System

22. The objectives of the Madrid system are two-fold. Firstly, it facilitates the obtaining of international protection for marks (trademarks and service marks). The registration of a mark in the International Register produces, in the Contracting Parties designated by the applicant, the effects described below (see paragraphs 47 to 49). Further Contracting Parties may be designated subsequently. Secondly, since an international registration is equivalent to a bundle of national registrations, the subsequent management of that protection is made much easier. There is only one registration to renew, and changes, such as a change in ownership or in the name or address of the holder, or a limitation of the list of goods and services, can be recorded in the International Register through a single simple procedural step. On the other hand, if it is desired to transfer the registration for some only of the designated Contracting Parties, or for some only of the goods or services, or to limit the list of goods and services with respect to some only of the designated Contracting Parties, the system is flexible enough to accommodate this.

### Who May Use the Madrid System?

23. An application for international registration (an “international application”) may be filed only by a natural person or a legal entity which has a real and effective industrial or commercial establishment in, or is domiciled in, or is a national of, a country which is party to the Agreement or the Protocol, or who has such an establishment in, or is domiciled in, the territory of an intergovernmental organization which is a party to the Protocol, or is a national of a member State of such an organization.

24. The Madrid system cannot be used by a person or legal entity which does not have the necessary connection, through establishment, domicile or nationality, with a member of the Madrid Union. Nor can it be used to protect a mark in the territory of a country outside the Madrid Union.

### The International Application

25. A mark may be the subject of an international application only if it has already been registered (“basic registration”), or if registration has been applied for (“basic application”) in the Trademark Office of the Contracting Party with which the applicant has the necessary connection, through establishment, domicile or nationality. This Office is referred to as the Office of origin. The basic registration or basic application is often referred to as the basic mark.

26. An international application must be presented to the International Bureau through the Office of origin. An international application which is presented direct to the International Bureau by the applicant will not be considered as such and will be returned to the sender.

27. The international application must contain, *inter alia*, a reproduction of the mark (which must be identical with that in the basic registration or basic application) and a list of the goods and services for which protection is sought, classified in accordance with the International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Classification).

28. An international application may claim priority under Article 4 of the Paris Convention, whether from the basic application with the Office of origin, or from a prior application filed with the Office of another country party to the Paris Convention, or with the Office of a Member of the World Trade Organization (WTO).
29. An international application must designate the Contracting Parties in which the mark is sought to be protected. The Contracting Party whose Office is the Office of origin cannot be designated in an international application.
30. The designation of a given Contracting Party is made under that treaty (Agreement or Protocol) which is common to the designated Contracting Party and the Contracting Party whose Office is the Office of origin. Where both Contracting Parties are party to both the Agreement and the Protocol, it is the Protocol which governs the designation.
31. An international application can be filed in any one of the three languages of the Madrid system, namely, English, French or Spanish. The Office of origin may, however, restrict the applicant's choice to one only, or to two of those languages, or may permit the applicant to choose between any of the three languages.
32. The international application is subject to the payment of the following fees:
- a basic fee;
  - a complementary fee in respect of each designated Contracting Party for which no individual fee is payable;
  - a supplementary fee in respect of each class of goods and services beyond the third; no supplementary fee is payable however where all the designations are ones in respect of which an individual fee has to be paid.
33. Article 8(7) of the Protocol provides that a Contracting Party may declare that, instead of a share in the revenue produced by the supplementary and complementary fees, it wishes to receive an individual fee. The amount of the individual fee is determined by each Contracting Party; it may not be higher than the amount that would be payable for the registration of a mark at the national level in the Office of that Contracting Party. The amounts of the respective individual fees are published in the Gazette and are also available on the WIPO website.
34. Nevertheless, Article 9*sexies*(1)(b) renders inoperative a declaration under Article 8(7) in the mutual relations between Contracting Parties which are both party to both the Agreement and the Protocol. In other words, where the designated Contracting Party having made the declaration is a party to both the Agreement and the Protocol and the Contracting Party whose Office is the Office of origin is also a party to both treaties, despite the fact that the designated Contracting Party in question has made the declaration requiring payment of individual fee, the supplementary and complementary fees are payable.
35. For international applications filed by applicants whose country of origin is a Least Developed Country (LDC), in accordance with the list established by the United Nations, the basic fee is reduced to 10%.
36. These fees may be paid direct to the International Bureau or, where the Office of origin accepts to collect and forward such fees, through that Office.

37. The Office of origin must certify that the mark being applied for is the same as that in the basic registration or basic application, that any indications, such as a description of the mark or a claim to color as a distinctive feature of the mark, are the same as those contained in the basic registration or basic application, and that the goods and services indicated in the international application are covered by the list of goods and services in the basic registration or basic application.

38. The Office of origin must also certify the date on which it received the international application. This date is important since it will become also the date of the international registration, if the International Bureau receives the international application within two months (and provided that certain crucial elements are not missing).

39. The International Bureau checks that the international application complies with the requirements of the Agreement or the Protocol and the Common Regulations, including requirements relating to the indication of goods and services and their classification, and that the required fees have been paid. The International Bureau will inform the Office of origin and the applicant of any irregularities, which must be remedied within three months; otherwise the international application will be considered abandoned.

40. Where the international application complies with the applicable requirements, the mark is registered and recorded in the International Register and published in the Gazette. The International Bureau then notifies each Contracting Party in which protection has been requested.

#### Examination by the Office of a Designated Contracting Party; Refusal of Protection

41. The Office of a designated Contracting Party examines the international registration in exactly the same way as an application filed directly. If grounds for objection are found during the *ex officio* examination, or if an opposition is filed, the Office has the right to declare that protection cannot be granted to the mark in that Contracting Party. This is referred to as the notification of provisional refusal.

42. Any provisional refusal must be notified to the International Bureau by the Office of the Contracting Party concerned within the time limit specified in the Agreement or Protocol. The standard time limit is 12 months. A Contracting Party may however declare that, when it is designated under the Protocol, this time limit shall be replaced by 18 months. A Contracting Party that has made this declaration may further declare that a provisional refusal based on an opposition may be notified even after the expiry of this 18-month period.

43. Notwithstanding the general principle that the Protocol applies between States both bound by both the Agreement and the Protocol, paragraph (1)(b) of Article 9*sexies* of the Protocol renders inoperative a declaration extending the refusal period in the mutual relations between States both bound by both treaties. What this means, in effect, is that in the case of an international application where the Office of origin is the Office of a Contracting Party bound by both treaties, a designation of a Contracting Party also bound by both treaties will, while being governed by the Protocol, and not the Agreement, nevertheless be subject to the standard refusal regime – that is, the time limit of 12 months for the notification of a provisional refusal, notwithstanding that the designated Contracting Party in question may have declared an extended period for notifying a provisional refusal.

44. The provisional refusal is recorded in the International Register and published in the Gazette and a copy is transmitted to the holder of the international registration.

45. Any procedure subsequent to the refusal, such as review, appeal or response to an opposition, is carried out directly between the holder of the international registration and the Office concerned, without any involvement on the part of the International Bureau. However, once all the procedures before that Office have been completed, the Office must send to the International Bureau a final statement. Depending upon the outcome of the case, such statement will confirm either that protection for the mark has been totally refused (Confirmation of Total Provisional Refusal), or that protection has been partially or totally granted to the mark, as the case may be (Statement of Grant of Protection Following a Provisional Refusal). This statement is recorded in the International Register and published in the Gazette and a copy is transmitted to the holder of the international registration.

46. Where, before the expiry of the refusal period, all the procedures before an Office have been completed and the Office has found no grounds to refuse protection, the Office shall, as soon as possible, and before the expiry of the refusal period, send to the International Bureau a statement to the effect that protection is granted to the mark (Statement of Grant of Protection where no Notification of Provisional Refusal has been Communicated). Such statement is recorded in the International Register and published in the Gazette and a copy is transmitted to the holder of the international registration. However, in the absence of communication of a notification of a provisional refusal, and of a statement of grant of protection, the principle remains that a mark is automatically protected in the Contracting Party concerned, for all the goods and services in question, once the refusal period has expired without a notification of provisional refusal having been issued by the Office in question.

#### Effects of the International Registration

47. From the date of the international registration, or in the case of a Contracting Party designated subsequently, from the date of that subsequent designation, the protection of the mark in each of the designated Contracting Parties is the same as if the mark had been the subject of an application for registration filed direct with the Office of that Contracting Party. If no provisional refusal is notified to the International Bureau within the relevant time limit, or if a refusal has been notified and has been subsequently withdrawn, the protection of the mark in each designated Contracting Party is the same as if it had been registered by the Office of that Contracting Party.

48. An international registration is equivalent to a bundle of national registrations. Although it is a single registration recorded in the International Register, protection may be refused by some of the designated Contracting Parties, or protection may be limited or renounced with respect to some only of the designated Contracting Parties. Likewise an international registration may be transferred to a new owner with respect to some only of the designated Contracting Parties. An international registration may also be invalidated (for example, for non-use of the mark) with respect to one or more of the designated Contracting Parties. Moreover, any action for infringement of an international registration must be brought separately in each of the Contracting Parties concerned.

49. This is in contrast to a unitary regional right, such as the Community Trade Mark in the European Union (CTM), which cannot be refused, limited or transferred with effect for a part only of the territory covered by the right, and which may be enforced by a single legal action covering infringement occurring anywhere in that territory.

### Dependence on the Basic Mark and Transformation

50. For a period of five years from the date of its registration, an international registration remains dependent on the basic mark registered or applied for in the Office of origin. If, and to the extent that, the basic registration ceases to have effect, whether through cancellation following a decision of the Office of origin or a court, through voluntary cancellation or through non-renewal, within this five-year period, the international registration will no longer be protected. Similarly, where the international registration was based on an application in the Office of origin, it will be cancelled if, and to the extent that, that basic application is refused or withdrawn within the five-year period, or if, and to the extent that, the registration resulting from that application ceases to have effect within that period.

51. The Office of origin is required to notify the International Bureau of facts and decisions concerning such ceasing of effect or refusal and, where appropriate, to request the cancellation (to the extent applicable) of the international registration. The cancellation is published in the Gazette and notified to the designated Contracting Parties.

52. It is possible, under the Protocol, to avoid further loss of rights by such ceasing of effect as mentioned above, by transforming the rights of an international registration into national/regional applications. If, within three months of such cancellation, the holder files an application for registration with the Office of a Contracting Party that had been designated under the Protocol, that application will be treated as if it had been filed on the date of the international registration, or as the case may be the date of the subsequent designation of the Contracting Party concerned. This option is not available in the case of a Contracting Party designated under the Agreement. This is referred to as transformation.

53. After the expiry of the period of five years from the date of the international registration, the international registration becomes independent of the basic registration or basic application.

### Replacement of a National or Regional Registration by an International Registration

54. An international registration is deemed to replace a national or regional registration for the same mark and the same goods and services recorded in the name of the same person in a designated Contracting Party. The effect of replacement is that, if the national or regional registration is not renewed, the holder of the international registration may continue to benefit from the earlier rights acquired by reason of that national or regional registration. Although replacement takes place automatically, the holder of the international registration may request the Office of the Contracting Party in which the national or regional registration is recorded to take note in its register of the international registration.

### Subsequent Designation

55. The effects of an international registration can be extended to a Contracting Party not covered by the international application by filing a subsequent designation. Thus, the holder of an international registration can expand the geographical scope of the protection of his mark in line with his business needs. This feature of the Madrid system is, perhaps in particular, beneficial to small and medium-sized enterprises (SMEs). Moreover, a subsequent designation may be made in order to extend the protection of the mark to a Contracting Party which was not a party to the Agreement or Protocol at the time of the international application. The principles that determine whether such a designation can be made are as described above (see paragraphs 25 and 26).

Changes in the International Register; Cancellation; Licenses

56. A change in the name or address of the holder or his representative may be recorded in the International Register upon request.

57. Likewise, a change in the ownership of an international registration may be recorded, in respect of all or some of the goods and services and all or some of the designated Contracting Parties. A person may not, however, be recorded as the new owner of an international registration in respect of a given Contracting Party if he would not be entitled (in accordance with the principles set out, above in paragraphs 25 and 26), to designate that Contracting Party in an international application. Thus, for example, a person who does not have a connection with a country which is a party to the Agreement may not be recorded as the new owner of an international registration in respect of a designated Contracting Party which is a party only to the Agreement.

58. The following may also be recorded in the International Register:

- a limitation of the list of goods and services in respect of all or some of the designated Contracting Parties;
- a renunciation in respect of some of the designated Contracting Parties for all the goods and services;
- a cancellation of the international registration in respect of all the designated Contracting Parties for all or some of the goods and services;
- a license granted in respect of all or some of the designated Contracting Parties, and for all or some of the goods and services.

59. Information concerning such changes, cancellations and licenses is recorded in the International Register, published in the Gazette and notified to the designated Contracting Parties concerned.

60. No change may be made in the mark that is the subject of an international registration, either on renewal or at any other time. Nor may the list of goods and services be changed in a way that would extend the scope of protection.

Duration of Registration; Renewal

61. An international registration is effective for 10 years. It may be renewed for further periods of 10 years on payment of the prescribed fees. The International Bureau sends a reminder to the holder and to his representative, if any, six months before renewal is due.

62. The international registration may be renewed in respect of all the designated Contracting Parties or in respect of some only of them. It may not, however, be renewed in respect of some only of the goods and services recorded in the International Register. If the holder wishes, at the time of renewal, to remove some of the goods and services from the international registration, he must separately request cancellation in respect of those goods and services, or request the recording of a limitation, prior to the renewal of the registration.

## ACCESSION TO THE MADRID SYSTEM

### Accession Procedures

63. Any State which is a party to the Paris Convention may become a party to the Agreement or the Protocol, or both. In addition, an intergovernmental organization may become a party to the Protocol (but not the Agreement), where the following conditions are fulfilled: at least one of the member States of the organization is a party to the Paris Convention and the organization maintains a regional office for the purposes of registering marks with effect in the territory of the organization.

64. A State or intergovernmental organization may become a party to the Madrid Protocol by depositing an instrument of accession.

65. The instrument of accession must be signed by the Head of State or Government, or by the Minister of Foreign Affairs, in accordance with the country's legal system, and deposited with the Director General of WIPO. Annex I contains a model instrument of accession.

66. The treaty will enter into force three months after the date of deposit of the instrument of accession.

67. The instrument of accession may contain certain declarations. Some declarations can be made only at the time of accession while others may be submitted after the accession. It would therefore be very useful for the potential member of the Madrid system to discuss possible declarations with the International Bureau prior to acceding to the system. For a complete list of possible declarations a Contracting Party may make in connection with accession, please see:

<http://www.wipo.int/madrid/en/madridgazette/remarks/declarations.html>.

68. The most frequently made declarations are, in particular, the following:

- a declaration that, with respect to each international registration in which the Contracting Party is designated and with respect to the renewal of an international registration, it wishes to receive an individual fee. The amount of that fee, in local currency, must be stated in the declaration, but may be amended by a subsequent declaration.
- a declaration that, for international registrations in which the Contracting Party has been designated, the period of one year during which its Office must give notification of a provisional refusal of protection will be replaced by a period of 18 months.

### Domestic Legislative or Regulatory Implications

69. The main substantive obligation deriving from accession to the Madrid system will be to give effect to Article 4(1) of the Agreement and the Protocol. Under this provision, a mark registered in the International Register, in which the Contracting Party has been designated, must be protected from the date of international registration (or, in the case of a Contracting Party designated subsequently, from the date of that subsequent designation), in the same way as if that mark had been applied for directly with the national or regional trademark

Office. That Office is, however, fully entitled to carry out a substantive examination of the mark and may, within the period stipulated, refuse to grant protection to the mark (either totally or partially). If the Office does not issue a provisional refusal within the applicable period, the mark is deemed to be protected in the same way as if it had been registered directly with that Office.

70. When acceding to the Madrid system, the country must also be in a position to give full effect to the provisions of the relevant treaty. The International Bureau will provide any necessary advice and technical assistance required for that purpose. One service that is offered to potential members of the Madrid system is to analyze the domestic legislation and provide comments on its compatibility with the Madrid system. Model Provisions have been established to provide information and assistance to these potential members. See Annex II for such Model Provisions.

### Effects of Accession

71. Statistics show that the accession of a country to the Madrid system will gradually produce an increase in the total number of marks for which protection is requested in the country (resulting from combining the number of applications received at the national level and the designations received internationally). This can be explained by the fact that it is relatively easy and economical for the owner of a mark to designate a country/regional territory in an international application.

72. As regards the workload of the national trademark Office, accession to the Madrid system has been seen not to bring an overwhelming number of new applications, but rather a gradual increase in registration activity. Moreover, although the Office should carry out, in respect of the marks filed through the Madrid system, the usual substantive examination, it will not need to carry out the formalities examination, or to publish the mark, since those procedures will already have been conducted by the International Bureau.

## MAIN ACTIONS TO BE UNDERTAKEN BY AN OFFICE AS PART OF THE INTERNATIONAL PROCEDURE UNDER THE MADRID SYSTEM<sup>1</sup>

### Introduction

73. With regard to an international application or international registration, an Office may serve, on the one hand, as the Office of origin, the definition of which includes the Office of the Contracting Party of the holder<sup>2</sup>, or, on the other hand, as the Office of a designated Contracting Party.

74. The information below is set out in three parts; Part I concerns an Office as Office of origin, Part II deals with an Office as the Office of a designated Contracting Party, while Part III relates to an Office as the Office of the Contracting Party of the holder.

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<sup>1</sup> The procedures explained in this note are described in detail in Chapter III of Part B “The International Procedure” in the *Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol* (WIPO Publication N° 455). The Guide is also available on the WIPO web site at: <http://www.wipo.int/madrid/en/guide/index.html>.

<sup>2</sup> The “Contracting Party of the holder” is defined as the Contracting Party whose Office is the Office of origin, or where a change in ownership has been recorded, the Contracting Party in respect of which the new holder has the required connection (by means of a real and effective industrial or commercial establishment, domicile or nationality).

## PART I: MAIN ACTIONS TO BE UNDERTAKEN BY THE OFFICE OF ORIGIN

### Overview

75. An international application must be based on a basic application or basic registration (“the basic mark”) filed with or registered by the Office of origin, and must be presented to the International Bureau through the Office of origin, of which there can be only one. Moreover, since the international registration is dependent on the basic mark for the first five years of its existence, the Office of origin is required to notify the International Bureau of any relevant changes affecting the basic mark during that period. In addition, various requests may (or, in some cases, must) be presented through the Office of origin.

### Status of “Office of Origin”

76. The Office with which the applicant files an international application must check that it is the correct “Office of origin” within the meaning of Article 1(3) of the Agreement or Article 2(2) of the Protocol. This means ensuring that the necessary connection (by means of a real and effective industrial or commercial establishment, domicile or nationality) has been established, at least on its face, by the applicant, with respect to the Contracting Party concerned. The Office of origin may require the applicant to submit evidence.

### “Basic Mark” in the Country/Regional Territory of Origin

77. The Office of origin must check for the existence of a basic mark, i.e., that the national or regional mark which is the subject of international application has already been filed with it or registered in its national or regional register. If so, the Office of origin must verify that the number of the basic application or basic registration, as the case may be, has been indicated correctly by the applicant in item 5 of the international application form.

### Certification

78. Through comparison between the basic mark and the international application, the Office of origin must certify (in item 13 of the international application form) that the particulars appearing in an international application correspond to the particulars of the basic mark (in particular, that the applicant named in the international application is the same as the applicant or the holder named in the basic mark, that the mark which is the subject of the international application is the same as the basic mark and that the goods and/or services listed in the international application are covered by the goods and/or services appearing in the basic mark).

79. Should there be a discrepancy between the international application and the basic mark in relation to one of the above-mentioned matters, the Office of origin must require the applicant to amend the international application accordingly.

80. The Office of origin must sign this certification in item 13(b) of the international application form.

#### Indication of Date: Forwarding the International Application to the International Bureau

81. The Office of origin must indicate the date on which it received the international application and, in principle, transmit it to the International Bureau within two months from that date. The presentation of the international application to the International Bureau may be made:

- either by postal mail, or
- by fax<sup>3</sup>, or
- by electronic means (provided that such a mode of communication has previously been agreed upon between the Office of origin and the International Bureau).

#### Irregularities in the International Application Other Than Those Concerning the List of Goods and/or Services

82. These irregularities are of three types: those which the Office of origin must remedy, those which the applicant must remedy and those which either the Office of origin or the applicant must remedy. Any and all communications concerning the remedying of irregularities must be forwarded to the International Bureau by the Office of origin or the applicant, as the case may be, within three months of the date of notification of the irregularity by the International Bureau.

#### Irregularities Concerning the Goods and/or Services

83. If the International Bureau finds that the classification of the goods and/or services listed in an international application is incorrect or that a term used in the list of goods and/or services is too vague, is incomprehensible, or is linguistically incorrect, it notifies an irregularity to the Office of origin and, at the same time, informs the applicant. The Office of origin may attempt to resolve any disagreement with the International Bureau with a view to remedying that irregularity. In the course of this process, the Office of origin may seek the views of the applicant.

#### Ceasing of Effect of the Basic Mark

84. If, within a period of five years following the date of the international registration (the so-called “dependency period”), the basic mark ceases, for any reason, to have effect, the Office of origin must inform the International Bureau and request the cancellation of the international registration in respect of the goods and services affected.

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<sup>3</sup> Where the international application has been sent by fax, the *original* of the page of the form bearing the reproduction of the mark, signed by the Office of origin, must be sent to the International Bureau by postal mail.

## PART II: MAIN ACTIONS TO BE UNDERTAKEN BY THE OFFICE OF A DESIGNATED CONTRACTING PARTY

### Overview

85. An international registration is notified to the Office of each Contracting Party that has been designated by the applicant. Each such Office may notify the International Bureau, within the time limits set in the Agreement and Protocol (i.e., 12 months, 18 months or more than 18 months, in the case of a provisional refusal based upon an opposition, as the case may be), if it considers that protection cannot be granted in the Contracting Party concerned. It may also notify to the International Bureau a number of matters pertaining to international registrations.

### Examination of the International Registration; Provisional Refusal of Protection

86. The Office of a designated Contracting Party which is notified of an international registration, or a subsequent designation, should examine it in the same way as it would examine an application for registration on its own register. Following such an examination, it may notify to the International Bureau a provisional refusal of protection if it considers that the international registration does not comply with the provisions of its legislation.

87. Such a refusal (*ex officio* provisional refusal) must be sent within a prescribed time limit (i.e., 12 or 18 months, as the case may be). It may relate to all or only some of the goods and/or services for which protection is sought. A refusal may also be based on an opposition filed by a third party who objects to the mark being protected in the Contracting Party concerned (provisional refusal based on an opposition) within the prescribed time limits (i.e., 12 months, 18 months or more than 18 months, as the case may be).

88. If the Office takes no action within the relevant time limit, the mark stands protected, i.e., a mark that is the subject of an international registration is protected automatically in a designated Contracting Party unless protection is actually refused by the Office of that Contracting Party.

### Confirmation or Withdrawal of Provisional Refusal

89. An Office which has sent to the International Bureau a notification of provisional refusal must, 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 whether the provisional refusal has been confirmed, or totally or partially reversed by that Office. Where an Office has totally or partially reversed the provisional refusal, that Office shall then send a "Statement of Grant of Protection Following a Provisional Refusal", specifying whether the protection is total or partial. Where the Office confirms a total refusal, it shall send a "Statement of Confirmation of Total Provisional Refusal".

### Further Decision Concerning the Protection of the Mark

90. Where, following the sending of the above statement, a further decision (stemming, for example, from an appeal to a body outside the Office) affects the protection of the mark, the Office must, to the extent that it is aware of that decision, send to the International Bureau a further statement indicating the goods and/or services for which the mark is protected in the Contracting Party concerned.

### Statement of Grant of Protection Where no Notification of Provisional Refusal Has Been Communicated

91. Where, before the expiry of the refusal period, all the procedures before an Office have been completed and the Office has found no grounds to refuse protection, the Office shall, as soon as possible, and before the expiry of the refusal period, send to the International Bureau a statement to the effect that protection is granted to the mark. Such statement is recorded in the International Register and published in the Gazette and a copy is transmitted to the holder of the international registration.

### Declaration That a Limitation Has no Effect

92. Following the international registration, the holder may request the recording of a limitation of the list of goods and/or services. Where such a limitation replaces one term by a different term which (in the opinion of the holder) is narrower than the first term, the Office of a designated Contracting Party may consider that the new term is in fact broader than the original term, so that the change is not a limitation but rather a broadening of the list of goods and/or services. In such a case, the Office may declare that the limitation has no effect in its territory. Any such declaration must be sent to the International Bureau before the expiry of 18 months from the date on which the limitation was notified to the Office concerned.

### Restriction on the Holder's Right of Disposal

93. The Office of a designated Contracting Party may inform the International Bureau that the right of the holder of an international registration to dispose of that international registration has been restricted with respect to the territory of that Contracting Party. Such information should consist of a summary statement of the main facts concerning the restriction, for example, that it results from a court order concerning the disposal of the assets of the holder. Copies of court decisions or deeds should not be sent to the International Bureau.

### Replacement of National or Regional Registration by an International Registration

94. In accordance with Article 4*bis* of the Agreement and the Protocol, the holder may request the Office of a designated Contracting Party to take note in its register that a national/regional registration has been replaced by the corresponding international registration by virtue of the holder's designation of that Contracting Party. The international registration and the national/regional registration must be for the same mark and must be in the same name; the goods and/or services listed in the national/regional registration must also be listed in the international registration with regard to the designated Contracting Party in question; and the designation must take effect after the date of the national/regional registration. The Office must notify the International Bureau accordingly.

### Invalidation of Effects of International Registration

95. A mark which is protected in a Contracting Party may subsequently be invalidated by the competent authorities (for example, in proceedings brought by a third party, or in a counterclaim in infringement proceedings). The Office of the Contracting Party concerned must notify the International Bureau where it is aware of a final decision invalidating the effects of an international registration in its territory.

### Transformation of an International Registration Into a National/Regional Application

96. Following a cancellation of an international registration at the request of the Office of origin under Article 6(4) of the Protocol (i.e., following a ceasing of effect during the five years dependency period), the holder may file a national/regional application for the same mark with the Office of a designated Contracting Party.

97. If the required formalities are complied with, the application shall be treated by the Office concerned as though it had been filed on the date of the international registration, or where the Contracting Party was designated subsequently to the international registration, the date of the subsequent designation.

98. It is up to each Contracting Party to determine the modalities for giving effect to such transformation into a national or regional application. It may require that such an application comply with all requirements that apply to national or regional applications filed with its Office, including requirements concerning fees. That is, it may require that the full amount of application and other fees be paid; alternatively, and in particular where the Office concerned has already received individual fees in respect of the international registration concerned, it may decide to provide for reduced fees in the case of such an application.

## PART III: MAIN ACTIONS TO BE UNDERTAKEN BY AN OFFICE AS OFFICE OF THE CONTRACTING PARTY OF THE HOLDER

### Overview

99. A Contracting Party may also undertake actions in the capacity of being the Office of the Contracting Party of the holder.

100. According to Rule 1(xxvibis) “Contracting Party of the Holder” means the Contracting Party whose Office is the Office of origin, or where a change in ownership has been recorded, the Contracting Party, or one of the Contracting Parties, in respect of which the holder fulfils 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.

### Presentation of Subsequent Designations to the International Bureau

101. The Office of the Contracting Party of the holder may be requested by the holder to present to the International Bureau a subsequent designation. That Office must indicate the date on which it received the subsequent designation, sign the request and send it to the International Bureau before the expiry of two months.

### Presentation of Other Requests to the International Bureau

102. The Office of the Contracting Party of the holder may be requested by the holder to present to the International Bureau a request for the recording of a change in ownership, a limitation of the list of goods and/or services, a renunciation, a change in the name and/or address of the holder or a cancellation of the international registration.

103. In each case, the Office should make sure that it may in fact serve as the Office of the Contracting Party of the holder. It should also check that the correct official form is used. The Office must sign the request and send it promptly to the International Bureau (without, however, any time-limit being provided for).

### Restriction on the Holder's Right of Disposal

104. The Office of the Contracting Party of the holder may inform the International Bureau that the right of the holder of an international registration to dispose of that international registration has been restricted with respect to the international registration as a whole or in respect of one or more designated Contracting Parties. Such information should consist of a summary statement of the main facts concerning the restriction (for example, that it results from a court order concerning the disposal of the assets of the holder). In addition, the optional form MM19 may be used to request the recording in the International Register of a restriction of the holder's right of disposal. Copies of court decisions or deeds should not be sent to the International Bureau.

[Annexes follow]

ANNEX I

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Model

INSTRUMENT OF ACCESSION TO THE  
PROTOCOL RELATING TO THE MADRID AGREEMENT  
CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

(To be deposited with the Director General of WIPO in Geneva)

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The Government of [name of State] hereby declares that [name of State] accedes to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted at Madrid on June 27, 1989.

Done at ....., [date] .....

(Signature)\*  
(Capacity)

[Annex II follows]

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\* This instrument must bear the signature of the Head of State, Head of Government or Minister of Foreign Affairs.

ANNEX II

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**THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING  
THE INTERNATIONAL REGISTRATION OF MARKS (THE MADRID PROTOCOL)**

**MODEL PROVISIONS FOR IMPLEMENTATION  
OF THE MADRID PROTOCOL  
AND  
INFORMATION CONCERNING DECLARATIONS**

Table of Contents

Part I	Model Provisions
Part II	Notes on the Model Provisions
Part III	Principal Declarations that May Be Made in Connection with Accession to the Madrid Protocol
Part IV	Model Forms

**PART I – MODEL PROVISIONS**

The provisions below, proposed for inclusion in domestic legislation, relate to the principal obligations imposed by the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (“the Madrid Protocol”).

It is suggested that the proposed implementing provisions be incorporated in a separate chapter or schedule in the national law on trademarks. That chapter or schedule could be entitled, for example, “International Registration of Trademarks under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks”.

Further details may, from time to time, be dealt with in the corresponding national regulations or in administrative instructions issued by the national industrial property authority (“the Registrar”).

1. DEFINITIONS

For the purpose of this Law:

(a) “Madrid Protocol” means the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted in Madrid on June 27, 1989;

(b) “Madrid Agreement” means the Madrid Agreement Concerning the International Registration of Marks of April 14, 1891;

(c) “Common Regulations” means the Common Regulations under the Madrid Agreement and Madrid Protocol;

(d) “international application” means an application to obtain registration of a mark under the Madrid Protocol;

(e) “International Bureau” means the International Bureau of the World Intellectual Property Organization;

(f) “International Register” means the official collection of data concerning international registrations of marks maintained by the International Bureau;

(g) “basic application” means an application for registration of a mark, filed with the Registrar under the present Law, and which is used as a basis for the filing of an international application under the Madrid Protocol;

(h) “basic registration” means a mark registered by the Registrar under the present Law, and which is used as the basis for the filing of an international application under the Madrid Protocol.

#### **(A) INTERNATIONAL APPLICATIONS ORIGINATING FROM [COUNTRY]**

##### **2. LANGUAGE**

Any communication, including an international application, for transmittal to the International Bureau through the intermediary of the Registrar shall be in [LANGUAGE].

##### **3. EXAMINATION OF INTERNATIONAL APPLICATIONS IN RESPECT OF WHICH [COUNTRY] IS THE COUNTRY OF ORIGIN**

Where an international application is filed with the Registrar for transmittal to the International Bureau, the Registrar shall verify that [COUNTRY] may be considered as the country of origin in respect of that application, and that the relevant particulars appearing in the international application correspond to the relevant particulars appearing in the basic application or basic registration, as the case may be, in accordance with the provisions of the Madrid Protocol and the Common Regulations.

##### **4. CERTIFICATION BY THE REGISTRAR**

(1) Where the international application complies with the prescribed requirements, the Registrar shall so certify in the international application, indicating also the date on which the international application was received, and shall forward the international application to the International Bureau.

(2) Where the international application does not meet the prescribed requirements, the Registrar shall not forward it to the International Bureau, and shall inform the applicant accordingly.

5. HANDLING FEE

The prescribed handling fee shall be due and payable to the Registrar for the certification and transmittal to the International Bureau an international application originating in [COUNTRY].

6. CEASING OF EFFECT OF THE BASIC APPLICATION OR BASIC REGISTRATION

Where, in accordance with Article 6 of the Madrid Protocol, the basic application, the registration resulting from such application, or the basic registration, ceases to have effect, the Registrar shall inform the International Bureau accordingly and shall request the cancellation of the international registration in respect of the goods and services affected.

**(B) INTERNATIONAL REGISTRATIONS IN RESPECT OF WHICH [COUNTRY] IS A DESIGNATED CONTRACTING PARTY**

7. NO GROUNDS FOR REFUSAL – STATEMENT OF GRANT OF PROTECTION

Where all procedures before the Registrar have been completed and there is no ground for the Registrar to refuse protection, the Registrar shall, as soon as possible and before the expiry of the refusal period applicable under Article 5 of the Madrid Protocol, send to the International Bureau a statement to the effect that protection is granted to the mark in [COUNTRY].

8. *EX OFFICIO* PROVISIONAL REFUSAL OF PROTECTION

Where the Registrar finds that, in accordance with the law of [COUNTRY], the mark that is the subject of an international registration designating [COUNTRY] cannot be protected, the Registrar shall, before the expiry of the refusal period applicable under Article 5 of the Madrid Protocol, notify to the International Bureau a provisional refusal of protection, complying with the requirements of the Madrid Protocol and the Common Regulations. The holder of that international registration shall enjoy the same remedies as if the mark had been filed for registration directly with the Registrar.

9. ADVERTISEMENT OF APPLICATION; OPPOSITION

Where [COUNTRY] has been designated in an international application, the Registrar shall advertise the international registration as provided in the Law. Opposition to the international registration shall be governed by the provisions of this Law regarding opposition, *mutatis mutandis*.

## 10 PROVISIONAL REFUSAL BASED ON AN OPPOSITION

Where an opposition is filed with the Registrar in respect of an international registration designating [COUNTRY], the Registrar shall, before the expiry of the refusal period applicable under Article 5 of the Madrid Protocol, notify that fact to the International Bureau as a provisional refusal based on an opposition, in accordance with the provisions of the Madrid Protocol and the Common Regulations. The holder of the international registration concerned shall enjoy the same remedies as if the mark had been filed for registration directly with the Registrar.

## 11. FINAL DECISION FOLLOWING THE NOTIFICATION OF A PROVISIONAL REFUSAL

### (a) Statement of Grant of Protection

Where the Registrar has notified to the International Bureau a provisional refusal of protection in accordance with paragraph 8 or paragraph 9, and all the procedures before the Office having been completed, such provisional refusal has been either totally or partially withdrawn, the Registrar shall send to the International Bureau either

(i) a statement to the effect that the provisional refusal is withdrawn and that protection of the mark is granted in [COUNTRY] for all the goods and services for which protection has been requested, or

(ii) a statement indicating the goods and services for which protection of the mark is granted in [COUNTRY].

### (b) Confirmation of Total Refusal

Where the Registrar has sent to the International Bureau a notification of total provisional refusal in accordance with paragraph 8 or paragraph 9, and all the procedures before the Office having been completed, the Registrar has decided to confirm such refusal of protection of the mark in [COUNTRY] for all the goods and services for which protection has been requested, the Registrar shall send to the International Bureau a statement to that effect.

## 12. FURTHER DECISION AFFECTING PROTECTION OF A MARK

Where, following the sending of a statement in accordance with subparagraphs (a) or (b) of paragraph 11, there is a further decision which affects the protection of a mark in [COUNTRY], the Registrar shall, to the extent that the Registrar 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 [COUNTRY].

### 13. EFFECTS OF AN INTERNATIONAL REGISTRATION

(1) An international registration designating [COUNTRY] shall have the same effects, as from the date of the international registration, as if an application for the registration of the mark had been filed directly with the Registrar under the Law.

(2) If no refusal is notified by the Registrar to the International Bureau in accordance with the Madrid Protocol and the Common Regulations, or if a refusal has been so notified but has been subsequently withdrawn, or if a statement of grant of protection is sent by the Registrar, the protection of the mark in [COUNTRY] shall be the same as if the mark had been registered directly by the Registrar on the date of the international registration.

### 14. INVALIDATION

Where the effects of an international registration are invalidated in [COUNTRY] and the invalidation is no longer subject to appeal, the Registrar shall, provided that the Registrar is aware of that decision, notify the International Bureau in accordance with the relevant provisions of the Madrid Protocol and the Common Regulations.

### 15. RECORDINGS IN THE INTERNATIONAL REGISTER

Any recording made in the International Register in respect of an international registration, shall, to the extent that it applies to [COUNTRY] as a designated Contracting Party, have the same effect as if it had been recorded by the Registrar in the register of marks.

### 16. COLLECTIVE AND CERTIFICATION MARKS

Where an international registration designating [COUNTRY] is a collective mark or a certification mark, the regulations governing the use of such collective mark or certification mark shall be submitted directly, by the holder of that international registration, to the Registrar, within the prescribed time limit.

### 17. REPLACEMENT

(1) (a) Where:

(i) a mark registered in [COUNTRY] is also the subject of an international registration, and the protection resulting therefrom extends to [COUNTRY], and

(ii) the same person is recorded as holder of the registration in [COUNTRY] and of the international registration, and

(iii) all the goods and services listed in the registration in [COUNTRY] are also listed in the international registration in respect of [COUNTRY], and

(iv) the extension of that international registration to [COUNTRY] took effect after the date of registration of the mark in [COUNTRY],

the holder of the international registration may request the Registrar to take note of that international registration in the register.

(b) A request filed with the Registrar in accordance with paragraph (a), shall be made on Form [...] and [shall be subject to the payment of the prescribed fee] [shall not be subject to the payment of a fee].

(2) Where the Registrar has taken note of an international registration in accordance with paragraph (1)(a), the Registrar shall notify the International Bureau accordingly. Such notification shall indicate the following:

- (i) the number of the international registration in question,
- (ii) where some only of the goods and services listed in the international registration are concerned, those goods and services,
- (iii) the filing date and number of the application for registration of the mark in [COUNTRY],
- (iv) the registration date and number of the registration in [COUNTRY],
- (v) the priority date, if any, of the registration in [COUNTRY], and
- (vi) [information relating to other rights acquired by virtue of the registration in [COUNTRY]]

## 18. TRANSFORMATION

(1) (a) Where an international registration designating [COUNTRY] is cancelled at the request of the Office of origin, in accordance with Article 6(4) of the Madrid Protocol, in respect of all or some of the goods and services listed in the international registration, an application may be made to the Registrar, within three months from the date on which the international registration was cancelled, by the person who was the holder of the international registration at the date of its cancellation, for registration of the same trademark (“an application resulting from transformation”), in respect of goods and services covered by the list of goods and services contained in the international registration.

(b) Subject to paragraphs (2) and (3), the provisions applicable to a trademark application filed directly with the Registrar shall apply *mutatis mutandis* to an application resulting from transformation.

(2) (a) An application resulting from transformation shall be made on Form [...] and shall, in addition, include the following:

- (i) a statement that the application is made by way of transformation,
- (ii) the international registration number of the international registration which has been cancelled,

(iii) the date of the said international registration, or the date of recording of the territorial extension made subsequently to the international registration, as appropriate,

(iv) the date on which the cancellation of the international registration was recorded,

(v) where applicable, the date of any priority claimed in the international application and recorded in the International Register.

(b) An application resulting from transformation [shall be subject to the payment of the prescribed [transformation] fee[s]] [shall not be subject to the payment of [a] [the standard application] fee].

(3) (a) Where an international mark has become protected in [COUNTRY] on or before the date on which the international registration was cancelled and, provided that all the requirements relating to an application resulting from transformation have been met, that trademark shall be registered by the Registrar. The date of registration shall be the date of the cancelled international registration, or the date of recording of the territorial extension to [COUNTRY] made subsequently to the international registration, as appropriate, and that registration shall enjoy any priority enjoyed by the cancelled international registration.

(b) Where an international mark has not yet become protected in [COUNTRY] on or before the date on which the international registration was cancelled, any procedures or measures already undertaken on or before the date on which an application resulting from transformation is filed for the purpose of the international registration shall be considered as having been undertaken for the purposes of the application resulting from transformation. The filing date of the application resulting from transformation shall be the date of the international registration or the date of recording of the territorial extension to [COUNTRY] made subsequently to the international registration, as appropriate.

## 19. FURTHER DETAILS CONCERNING INTERNATIONAL REGISTRATIONS

Further details concerning international registrations may be included in the implementing regulations or instructions issued by the Registrar.

## **PART II – NOTES ON THE MODEL IMPLEMENTING PROVISIONS**

### 1. MODEL PROVISION 1: DEFINITIONS

For the sake of legal certainty, it is advisable to include a provision defining a number of expressions used in the context of the international procedure, those expressions being defined as having the same meanings as in the Protocol and the Common Regulations.

**(A) INTERNATIONAL APPLICATIONS ORIGINATING FROM [COUNTRY]**

**2. MODEL PROVISION 2: LANGUAGE**

Under Rule 6 of the Common Regulations, an international application, and other communications relating thereto, may be filed in English, French or Spanish, according to what is prescribed by the Office of origin. The implementing legislation of [COUNTRY] should therefore state that international applications, and other communications relating thereto, are required to be filed through the Registrar in the language, or languages, indicated in this provision.

For further information, reference should be made to Rule 6 of the Common Regulations and to the *Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol*.

**3. MODEL PROVISION 3: EXAMINATION OF INTERNATIONAL APPLICATIONS IN RESPECT OF WHICH [COUNTRY] IS THE COUNTRY OF ORIGIN**

This provision defines the principal role of the Office of [COUNTRY] as Office of origin, namely the fact that the Registrar is required, before transmitting an international application to the International Bureau, to check that [COUNTRY] may be considered as country of origin and that the relevant particulars appearing in the international application correspond to the particulars appearing in the basic application or basic registration, as the case may be. The Registrar is required also to indicate the date on which the Registrar received the international application (which will become, in principle, the date of the international registration).

If the international application does not meet the applicable requirements (either because [COUNTRY] cannot be considered as Office of origin, or because the particulars appearing in the international application, and requiring certification, do not correspond to the particulars appearing in the basic application or basic registration), the Registrar may not transmit the international application to the International Bureau.

For further information, reference should be made primarily to Rule 9 of the Common Regulations and to the *Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol*.

**4. MODEL PROVISION 4: CERTIFICATION BY THE REGISTRAR**

If the Registrar is satisfied that [COUNTRY] may be considered as country of origin and that the relevant particulars appearing in the international application correspond to the particulars appearing in the basic application or basic registration, as the case may be, then the Registrar is required to certify accordingly in item 13 of the international application form.

Under Article 8(1) of the Madrid Protocol, it is possible for the Registrar to establish and collect a fee to cover the cost of the work involved in certification and transmittal to the International Bureau of an international application. This provision aims at providing for such payment. Please note, however, that this is an optional item.

#### 5. MODEL PROVISION 5: HANDLING FEE

Under Article 8(1) of the Madrid Protocol, it is possible for the Registrar to establish and collect a fee to cover the cost of the work involved in certification and transmittal to the International Bureau of an international application. This provision aims at providing for such payment. Please note, however, that this is an optional item.

#### 6. MODEL PROVISION 6: CEASING OF EFFECT OF THE BASIC APPLICATION OR BASIC REGISTRATION

Model Provision 6 deals with the so-called “ceasing of effect” of the basic application or basic registration during the five-year dependency referred to in Article 6 of the Protocol<sup>1</sup>.

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<sup>1</sup> Article 6 of the Protocol provides as follows:

***“Period of Validity of International Registration;  
Dependence and Independence of International Registration*”**

“(1) Registration of a mark at the International Bureau is effected for ten years, with the possibility of renewal under the conditions specified in Article 7.

“(2) Upon 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.

“(3) The protection resulting from the international registration, whether or not it has been the subject of a transfer, may no longer be invoked if, before the expiry of five years from the date of the international registration, the basic application or the registration resulting therefrom, or the basic registration, as the case may be, has been withdrawn, has lapsed, has been renounced or has been the subject of a final decision of rejection, revocation, cancellation or invalidation, in respect of all or some of the goods and services listed in the international registration. The same applies if

“(i) an appeal against a decision refusing the effects of the basic application,

“(ii) an action requesting the withdrawal of the basic application or the revocation, cancellation or invalidation of the registration resulting from the basic application or of the basic registration, or

“(iii) an opposition to the basic application

“results, after the expiry of the five-year period, in a final decision of rejection, revocation, cancellation or invalidation, or ordering the withdrawal, of the basic application, or the registration resulting therefrom, or the basic registration, as the case may be, provided that such appeal, action or opposition had begun before the expiry of the said period. The same also applies if the basic application is withdrawn, or the registration resulting from the basic application or the basic registration is renounced, after the expiry of the five-year period, provided that, at the time of the withdrawal or renunciation, the said application or registration was the subject of a proceeding referred to in item (i), (ii) or (iii) and that such proceeding had begun before the expiry of the said period.

“(4) The Office of origin shall, as prescribed in the Regulations, notify the International Bureau of the facts and decisions relevant under paragraph (3), and the International Bureau shall, as prescribed in the Regulations, notify the interested parties and effect any publication accordingly. The Office of origin shall, where applicable, request the International Bureau to cancel, to the extent applicable, the international registration, and the International Bureau shall proceed accordingly.”

Under paragraph (4) of that Article, where the basic application or basic registration ceases to have effect within that period, the Registrar is required to inform the International Bureau accordingly and request the cancellation of the international registration in respect of the goods and services affected.

**(B) INTERNATIONAL REGISTRATIONS IN RESPECT OF WHICH [COUNTRY] IS A DESIGNATED CONTRACTING PARTY**

**7. MODEL PROVISION 7: NO GROUNDS FOR REFUSAL – STATEMENT OF GRANT OF PROTECTION**

Model Provision 7 deals with what might be said to be the first step in the examination hierarchy and is intended to ensure compliance with Rule 18ter of the Common Regulations.

Rule 18ter(1) of the Common Regulations<sup>2</sup> provides that the issuing by a designated Office of a statement of grant of protection is obligatory where:

- (a) all the procedures before an Office have been completed;
- (b) the refusal period has not yet expired, and
- (c) the Office has not found any grounds to notify a refusal of protection for the mark.

That is to say, the mark has been examined and accepted by the Registrar, the mark has then been published for opposition purposes, no opposition has been filed, and the period for the filing of an opposition has expired – all of this before the applicable Madrid Protocol refusal period has expired – presumably, 18 months, assuming that the Registrar makes the necessary declaration to that effect.

The benefit of the sending of such a statement of protection, as far as the holder is concerned, is that in a situation where the mark has been fully cleared for protection in advance of the expiry of the refusal period, the holder does not have to wait for the expiry of that period in order to know that his mark is protected in [COUNTRY]. This latter situation is often referred to as “tacit acceptance”, according to which, under Article 5, paragraphs (1) and (2) and Article 5(5) of the Madrid Protocol, a mark that is not refused within the applicable refusal period in a designated Contracting Party is deemed automatically to be protected.

Please note that if it happens that conditions (a), (b) and (c), above, have been complied with and a statement of grant of protection has not been sent to the International Bureau before the expiry of the refusal period, it is not appropriate that such a statement be

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<sup>2</sup> Rule 18ter(1) reads as follows:

*“Rule 18ter  
“Final Disposition on Status of a Mark in a Designated Contracting Party*

“(1) [Statement of Grant of Protection Where No Notification of Provisional Refusal Has Been Communicated] When, before the expiry of the period applicable under Article 5(2) of the Agreement or Article 5(2)(a), (b) or (c) of the Protocol, all procedures before an Office have been completed and there is no ground for that Office to refuse protection, that Office shall, as soon as possible and before the expiry of that period, send to the International Bureau a statement to the effect that protection is granted to the mark that is the subject of the international registration in the Contracting Party concerned.”

sent to the International Bureau after the expiry of that period. In such situation, the mark will be *deemed* anyway to have become protected in [COUNTRY] and the statement in question will be superfluous.

The International Bureau has made available model forms for the convenience of Offices (see Part IV of this document). **Model Form 4** may be used for the purpose of sending a statement of grant of protection under Model Provision 7.

#### 8. MODEL PROVISION 8: *EX OFFICIO* PROVISIONAL REFUSAL OF PROTECTION

In the context of the Madrid system, a “refusal” by the Registrar does not mean that a final determination must have been reached in respect of the protection of a mark that is the subject of an international registration. What is required is that, within the applicable refusal period, the Office of a designated Contracting Party notify to the International Bureau of WIPO a provisional objection, indicating the grounds which may eventually lead to a definitive refusal.

While the Madrid system requires that a provisional refusal must be notified to the International Bureau within the applicable refusal period, there is no time limit on the eventual communication to the International Bureau of the final outcome once the prosecution of the filing has been concluded. However, the Office *is* required to communicate to the International Bureau the particulars of any such “final decision”, once all the procedures before the Office have been completed.

International registrations designating [COUNTRY] will be subject to examination as to substantive grounds for refusal in the same way as applications filed directly with the Registrar. Where the Registrar finds an objection relating to the protection of the mark (based on absolute or relative grounds), the Registrar must notify to the International Bureau a provisional refusal of protection. In such case, holders of international registrations shall have the same means of recourse and remedies as provided in respect of regular applications filed directly with the Registrar.

The International Bureau has made available model forms for the convenience of Offices (see Part IV of this document). **Model Form 3** may be used for the purpose of notifying an *ex officio* provisional refusal.

#### 9. MODEL PROVISION 9: ADVERTISEMENT OF APPLICATION; OPPOSITION

Where the trademark system of [COUNTRY] provides for an opposition procedure, it may be provided that a publication of the international registration – additional to the publication undertaken by WIPO in accordance with the Protocol – be effected *ex officio* in order to initiate the opposition period. In such case, the implementing provision should normally specify that the opposition period will be computed from the date of that national publication. To this effect, the Model Provision provides that opposition procedures shall be governed by the law of [COUNTRY].

10. MODEL PROVISION 10: PROVISIONAL REFUSAL BASED ON OPPOSITION

If it occurs that, following advertisement in accordance with Model Provision 7, an opposition is filed within the refusal period provided for under the Protocol, then the Registrar is required to so notify the International Bureau, and Model Provision 10 provides accordingly. Such notification must be communicated to the International Bureau within the applicable refusal period, in the same way as the notification under Model Provision 8.

The International Bureau has made available model forms for the convenience of Offices (see Part IV of this document). As with the notification of an *ex officio* provisional (see above), **Model Form 3** may be used for the purpose of notifying a provisional refusal based on opposition.

11. MODEL PROVISION 11: FINAL DECISION, FOLLOWING THE NOTIFICATION OF A PROVISIONAL REFUSAL

(a) Refusal – Statement of Grant of Protection

When a provisional refusal has been notified to the International Bureau within the applicable refusal period, whether such provisional refusal was *ex officio* or followed the filing of an opposition, then in due course the Registrar is required to communicate to the International Bureau the outcome, as far as the protection of the mark is concerned. This is often referred to as the “final decision”, to the extent that it is required to be sent to the International Bureau only after all the procedures before the Office have been completed. Such final decision may take a number of forms.

*Model Provision 11(a)(i): Provisional Refusal Withdrawn / Protection Granted to all of the Goods and Services*

If, following the notification of a provisional refusal, all the procedures before the Office have been completed and the mark is finally protected in [COUNTRY] for *all* the goods and services for which protection has been requested, then the Registrar is required to send to the International Bureau a Statement of Grant of Protection to that effect. This is in accordance with Rule 18ter(2)(i) of the Common Regulations<sup>3</sup>.

The International Bureau has made available model forms for the convenience of Offices (see Part IV of this document). **Model Form 5** may be used for the purpose of notifying a statement of grant of protection under either Model Provision 11(a)(i) or 11(a)(ii).

<sup>3</sup> Rule 18ter(2)(i) of the Common Regulations reads as follows:

*“Rule 18ter*

*“Final Disposition on Status of a Mark in a Designated Contracting Party*

“(2) [Statement of Grant of Protection Following a Provisional Refusal] Except where it sends a statement under paragraph (3), an Office which has communicated 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 [...]

“(i) a statement to the effect that the provisional refusal is withdrawn and that protection of the mark is granted, in the Contracting Party concerned, for all goods and services for which protection has been requested, [...]”

*Model Provision 11(a)(ii): Provisional Refusal Withdrawn / Protection Granted to Some of the Goods and Services*

If, on the other hand, following the notification of a provisional refusal, all the procedures before the Office have been completed and the refusal has been partially withdrawn, with the result that there is then residual protection in [COUNTRY] for some of the goods and services, then the Registrar is required to send to the International Bureau a Statement of Grant of Protection to that effect. This is in accordance with Rule 18ter(2)(ii) of the Common Regulations<sup>4</sup>.

The International Bureau has made available model forms for the convenience of Offices (see Part IV of this document). **Model Form 5** may be used for the purpose of notifying a statement of grant of protection under either Model Provision 11(a)(i) or 11(a)(ii).

(b) Confirmation of Total Refusal

If, following the notification of a total provisional refusal, all the procedures before the Office have been completed and the Registrar has decided to confirm such total provisional refusal of protection of the mark in [COUNTRY], then the Registrar is required to send to the International Bureau a statement of confirmation of total refusal. This is in accordance with Rule 18ter(3) of the Common Regulations<sup>5</sup>.

The International Bureau has made available model forms for the convenience of Offices (see Part IV of this document). **Model Form 6** may be used for the purpose of notifying a confirmation of total refusal under Model Provision 11(b).

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<sup>4</sup> Rule 18ter(2)(ii) of the Common Regulations reads as follows:

*“Rule 18ter  
“Final Disposition on Status of a Mark in a Designated Contracting Party*

“(2) [Statement of Grant of Protection Following a Provisional Refusal] Except where it sends a statement under paragraph (3), an Office which has communicated 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 [...]

“[...]

“(ii) a statement indicating the goods and services for which protection of the mark is granted in the Contracting Party concerned.”

<sup>5</sup> Rule 18ter(3) of the Common Regulations reads as follows:

*“Rule 18ter  
“Final Disposition on Status of a Mark in a Designated Contracting Party*

“[...]

“(3) [Confirmation of Total Provisional Refusal] An Office which has sent to the International Bureau a notification of a total provisional refusal shall, once all procedures before the said Office relating to the protection of the mark have been completed and the Office has decided to confirm refusal of the protection of the mark in the Contracting Party concerned for all goods and services, send to the International Bureau a statement to that effect.”

## 12. MODEL PROVISION 12: FURTHER DECISION AFFECTING PROTECTION OF A MARK

This provision implements the requirement under Rule 18*ter*(3) of the Common Regulations for the Registrar to communicate to the International Bureau the particulars of any further decision affecting the protection of the mark in [COUNTRY].

This is to be distinguished from the “final” decision covered by Model Provisions 11(a) and (b). Those communications follow the earlier sending by the Registrar of a notification of provisional refusal and are required to be sent to the International Bureau once all the procedures before the Office have been completed.

The communication contemplated by Model Provision 12 would be more in the nature of, for example, the decision by a court or other authority external to the Office, of which the Registrar may, or may not, be aware. The Registrar should communicate any such further statement to the International Bureau, but, only to the extent that the Registrar is aware of any such decision, and, only to the extent that any such decision actually affects the status of protection of the mark.

The International Bureau has made available model forms for the convenience of Offices (see Part IV of this document). **Model Form 7** be used for the purpose of communicating a further decision under Model Provision 12.

## 13. MODEL PROVISION 13: EFFECTS OF AN INTERNATIONAL REGISTRATION

It is advisable to include in the Law a provision that states the effects in [COUNTRY] of an international registration, by transposing the substance of Article 4(1)(a) of the Madrid Protocol. Model Provision 13 provides that a mark that has been registered on the international register shall be protected in [COUNTRY] as if the mark had been the subject of an application for registration filed directly with the Registrar (subsection (1)) and that, if no refusal of protection has been issued – or if a refusal has been notified to the International Bureau but has been withdrawn subsequently – the protection of the mark will be the same as if it had been directly registered by the Registrar (subsection (2)).

## 14. MODEL PROVISION 14: INVALIDATION

In the Common Regulations, the term “invalidation” is intended to mean any decision by a competent authority in [COUNTRY] revoking or cancelling the effects in [COUNTRY] of an international registration with respect to all of the goods and services.

This provision requires the Registrar, where the Registrar is aware of a decision to terminate in [COUNTRY] the protection of the international registration (for example a decision taken by a court), to notify the International Bureau accordingly.

15. MODEL PROVISION 15: RECORDINGS IN THE INTERNATIONAL REGISTER

This provision implements the principle whereby any recording made in the International Register in respect of an international registration, and affecting [COUNTRY] as a designated Contracting Party, shall have the same effect as if it had been made directly in the trademark register of [COUNTRY].

16. MODEL PROVISION 16: COLLECTIVE AND CERTIFICATION MARKS

This model provision relates to a requirement under the law of [COUNTRY] that applications to register collective and certification marks be accompanied by regulations governing the use of such marks. To the extent that such regulations may not be filed with the International Bureau, it should be specified that the holders of those marks are required to submit those regulations directly to the Registrar within the prescribed time limit.

17. MODEL PROVISION 17: REPLACEMENT

Article 4*bis* of the Madrid Protocol provides that where an international registration relates to a mark that is already registered in a designated country for the same goods or services in the name of the same person, the international registration is deemed to replace the national registration, and that the Registrar should, upon request, take note of the international registration.

In order to implement that Article, the Law should provide that, where the holder of the international registration so requests, the Registrar will take note of the international registration in connection with the record of the national registration.

However, the fact that the holder requests the Registrar to take note of the international registration should not entail an automatic cancellation of the corresponding national registration of the mark. Both registrations should be allowed to co-exist, and cancellation or limitation of the national registration should only be effected upon express request from the holder of that registration.

18. MODEL PROVISION 18: TRANSFORMATION

Paragraph (1)(a) of this Model Provision is based on Article 9*quinquies* of the Protocol. Paragraph (1)(b) establishes the principle that an application resulting from transformation is, to all intents and purposes, the same as a standard national trademark application, subject to the special provisions of this section.

Paragraph (2) provides for the furnishing of additional information to enable the Registrar to confirm compliance with the conditions for transformation under Article 9*quinquies*. Applications resulting from transformation may be filed using the same official form as for the filing of ordinary applications, or a special form for transformation, although such form might not be necessary.

Paragraph (3)(a) provides that where, by virtue of an international registration, a mark had already become protected in [COUNTRY], an application resulting from transformation should automatically lead to the registration of the mark in question (if all formal requirements have been met).

Paragraph (3)(b) provides that, where the international mark had not yet become protected in [COUNTRY] on the date of cancellation of the international registration, but certain steps have already been taken by the Registrar with regard to the substantive examination of an international mark, the benefit of those steps should accrue to the application resulting from transformation and the remaining procedure should continue thereafter as for a standard application. This approach avoids unnecessary duplication of work and expense, both for the holder and the Registrar.

#### 19. MODEL PROVISION 19: FURTHER DETAILS CONCERNING INTERNATIONAL REGISTRATIONS

For purposes of flexibility, it may be useful to introduce a general provision in accordance with which further provisions to facilitate procedures concerning international registrations may be included in the trademark regulations or in Office administrative instructions.

### **PART III – PRINCIPAL DECLARATIONS THAT MAY BE MADE IN CONNECTION WITH ACCESSION TO THE MADRID PROTOCOL**

Note: A detailed explanation of all declarations provided for in the Madrid system may be found in the *Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol* (a WIPO publication).

The declarations that are usually considered the most important for Contracting Parties concern the extension of the refusal period and the requirement of an individual fee.

#### 1. EXTENSION OF THE REFUSAL PERIOD (ARTICLE 5(2)(B) OF THE PROTOCOL)

A country acceding to the Protocol may declare that, in connection with an international registration in which it is designated, the time limit for the Registrar to notify a provisional refusal of protection to the International Bureau shall be 18 months, instead of 12 months.

#### 2. FURTHER EXTENSION OF THE REFUSAL PERIOD WHERE THE REFUSAL IS BASED ON AN OPPOSITION (ARTICLE 5(2)(C) OF THE PROTOCOL)

A country may further declare that, in the case of refusals based on an opposition, such refusals may be notified after the expiry of the 18-month time limit.

#### 3. INDIVIDUAL FEES (ARTICLE 8(7) OF THE PROTOCOL)

A country acceding to the Protocol may declare that, in connection with each international registration in respect of which it is designated, and in connection with the renewal of such international registration, it wishes to receive an individual fee.

The amount of the individual fee must not be higher than the fees that would be payable for registering the mark by means of an application made directly to the Registrar, and should be lower than those fees by an amount reflecting the savings resulting from the international procedure.

The amount of the individual fees should be expressed in the national currency. The Director General of WIPO will, in consultation with the Registrar, establish the amount of the fees in Swiss currency on the basis of the official exchange rate of the United Nations.

#### 4. LICENSING (RULE 20B/S)

The Office of a Contracting Party may make certain declarations concerning licensing, depending upon the legislation in that regard at the national level. This should be discussed with the International Bureau in advance of accession by a Contracting Party.

### **PART IV – MODEL FORMS**

The International Bureau makes available to Offices a number of model forms for use in connection with Madrid procedures.

Copies of the model forms are set out hereunder and the forms are available on the Madrid website at the following address:

[http://www.wipo.int/madrid/en/contracting\\_parties/model\\_forms.html](http://www.wipo.int/madrid/en/contracting_parties/model_forms.html)

The model forms are as follows:

- Model Form 1: Madrid Protocol – Information Relating to Possible Oppositions (Rule 16(1)(a))
- Model Form 2: Madrid Protocol – Dates on Which Opposition Period Begins and Ends (Rule 16(1)(b))
- Model Form 3: Madrid Agreement and Protocol – Provisional Refusal of Protection (Rule 17(1))
- Model Form 4: Madrid Agreement and Protocol – Statement of Grant of Protection (Rule 18*ter*(1))
- Model Form 5: Madrid Agreement and Protocol – Statement of Grant of Protection Following a Provisional Refusal (Rule 18*ter*(2))
- Model Form 6: Madrid Agreement and Protocol – Confirmation of Total Provisional Refusal (Rule 18*ter*(3))
- Model Form 7: Madrid Agreement and Protocol – Further Decision Affecting the Protection of a Mark (Rule 18*ter*(4))
- Model Form 8: Madrid Agreement and Protocol – Interim Status of a Mark (Rule 18*bis*(1)(a) and (b))
- Model Form 9: Madrid Agreement and Protocol – Ceasing of Effect of the Basic Application, of the Registration Resulting Therefrom, or of the Basic Registration (Rule 22(1)(a) and (c))

*Model Form 1***MADRID PROTOCOL****INFORMATION RELATING TO POSSIBLE OPPOSITIONS****Rule 16(1)(a)**

*This form is for use by those Offices that have declared an extended refusal period of 18 months and the possibility of notifying a provisional refusal based on an opposition later than 18 months, in certain cases (Article 5(2)(b) and (c) of the Protocol). The form should be sent to the International Bureau where it has become apparent, with regard to a given international registration, that the opposition period will expire too late for the notifying of a provisional refusal based on an opposition within the period of 18 months.*

*Where, at the time of this communication, the dates on which the opposition period begins and ends are known, those dates shall be indicated (Rule 16(1)(b)). If those dates are not yet known, they shall be communicated to the International Bureau as soon as they are known (by using Model Form 2). If the opposition period is extendable, the Office may communicate only the date on which the opposition period begins.*

I.	Office communicating the information:
II.	Number of the international registration:
III.	Name of the holder (or other information enabling the identity of the international registration to be confirmed):
IV.	<input type="checkbox"/> Dates on which the opposition period begins and ends known: <ul style="list-style-type: none"> <li>– Date on which the opposition period begins:</li> <li>– Date on which the opposition period ends:</li> </ul> <input type="checkbox"/> Opposition period extendable and date on which the opposition period begins known: <ul style="list-style-type: none"> <li>– Date on which the opposition period begins:</li> </ul> <input type="checkbox"/> Dates on which the opposition period begins and ends not known.
V.	Signature or official seal of the Office communicating the information:
VI.	Date:

*Model Form 2*

**MADRID PROTOCOL**

**DATES ON WHICH OPPOSITION PERIOD BEGINS AND ENDS**

**Rule 16(1)(b)**

*This form is to be used when an Office has previously sent to the International Bureau information relating to possible oppositions (Model Form 1), at a time when the dates of the opposition period were not known. The Office now communicates those dates to the International Bureau.*

I.	Office communicating the information:
II.	Number of the international registration:
III.	Name of the holder (or other information enabling the identity of the international registration to be confirmed):
IV.	<input type="checkbox"/> Dates on which the opposition period begins and ends: – Date on which the opposition period begins: – Date on which the opposition period ends:  <input type="checkbox"/> Opposition period extendable and date on which the opposition period begins: – Date on which the opposition period begins:
V.	Signature or official seal of the Office communicating the information:
VI.	Date:

*Model Form 3*

**MADRID AGREEMENT AND PROTOCOL**  
**PROVISIONAL REFUSAL OF PROTECTION**

**Rule 17(1)**

*This form is to be used in the following situation: the Office considers that protection cannot be granted in the Contracting Party concerned (ex officio provisional refusal) or protection cannot be granted in the Contracting Party concerned because an opposition has been filed, or both. In due course, once all the procedures before the Office have been completed, the Office shall send to the International Bureau a statement regarding the final disposition on the status of the mark, using Model Forms 5 or 6, as the case may be.*

I.	Office making the notification:
II.	Number of the international registration:
III.	Name of the holder (or other indication enabling the identity of the international registration to be confirmed):
IV.	<input type="checkbox"/> Provisional refusal based on an <i>ex officio</i> examination <input type="checkbox"/> Provisional refusal based on an opposition <sup>1</sup> <input type="checkbox"/> Provisional refusal based on both an <i>ex officio</i> examination and an opposition <sup>1</sup>
V.	<input type="checkbox"/> Provisional refusal for all the goods and/or services <input type="checkbox"/> Provisional refusal for some of the goods and/or services: [followed by an indication of the goods and/or services which are affected or are not affected] <sup>2</sup>
VI.	Grounds for refusal [(where applicable, see item VII)]:

<sup>1</sup> The name and address of the opponent should also be provided.

<sup>2</sup> Where all the goods or services included in a given class are to be mentioned, the indication should read "all goods (or all services) in class X". In all cases, a clear indication should be given as to whether those goods and/or services are affected, or are NOT affected.

VII. Information relating to an earlier mark<sup>3</sup> :

- (i) Filing date and number, and, if any, priority date:
- (ii) Registration date and number (if available):
- (iii) Name and address of the owner:
- (iv) Reproduction of the mark:
  
- (v) List of all or relevant goods and/or services:

VIII. Corresponding essential provisions of the applicable Act [(see text under XII)]:

IX. Information relating to subsequent procedure:

- (i) Time limit for requesting review or appeal:
- (ii) Authority to which such request for review or appeal should be made:
- (iii) Indications concerning the appointment of a representative:

X. Date of the notification of provisional refusal:

XI. Signature or official seal of the Office making the notification:

<sup>3</sup> Where the grounds on which the provisional refusal is based relate to an earlier mark, as indicated under item VI. The indication required under this item may be given by annexing a printout from the register or database.

XII. Corresponding essential provisions of the applicable Act:

*Model Form 4*

**MADRID AGREEMENT AND PROTOCOL**  
**FINAL DISPOSITION ON STATUS OF A MARK**  
**– STATEMENT OF GRANT OF PROTECTION –**

**Rule 18ter(1)**

*This form is to be used in the following situation: before the expiry of the refusal period applicable under Article 5(2) of the Agreement or Article 5(2)(a), (b) or (c) of the Protocol, all procedures before the Office have been completed and there is no ground for the Office to refuse protection.*

I. Office sending the statement:
II. Number of the international registration:
III. Name of the holder (or other information enabling the identity of the international registration to be confirmed):
IV. Protection is granted to the mark that is the subject of this international registration for all the goods and/or all the services requested.
V. Signature or official seal of the Office sending the statement:
VI. Date:

*Model Form 5*

**MADRID AGREEMENT AND PROTOCOL**  
**FINAL DISPOSITION ON STATUS OF A MARK**  
**– STATEMENT OF GRANT OF PROTECTION**  
**FOLLOWING A PROVISIONAL REFUSAL –**

**Rule 18ter(2)**

*This form is to be used in the following situation: the Office has already communicated a notification of total or partial provisional refusal and, all procedures before the Office being completed, protection is now granted to some or all of the goods and/or services. (If total refusal is being confirmed, please use Model Form 6.)*

I.	Office sending the statement:
II.	Number of the international registration:
III.	Name of the holder (or other information enabling the identity of the international registration to be confirmed):
IV.	<input type="checkbox"/> Protection for all the goods and/or services <i>(This box should be ticked where a notification of provisional refusal has previously been communicated but, eventually, protection is granted to <u>all</u> the goods and/or services.)</i>  All procedures before the Office have been completed; protection is granted to the mark that is the subject of this international registration for <u>all</u> the goods and/or <u>all</u> the services requested (Rule 18ter(2)(i))  <input type="checkbox"/> Protection for some only of the goods and/or services <i>(This box should be ticked where a notification of provisional refusal has previously been communicated and protection is now granted to <u>some</u> only of the goods and/or services – giving an indication of the goods and/or services protected. <b>NOTE:</b> Where all the goods or services included in a given class are to be mentioned, the indication should read “all goods (or, all services) in class X”. In all other cases, the goods and/or services should be clearly indicated.)</i>  All procedures before the Office have been completed; protection is granted to the mark that is the subject of this international registration for the following goods and/or services (Rule 18ter(2)(ii)) (please use a continuation sheet if necessary):

IVbis.  Disclaimers or Reservation

Please specify the element(s) of the mark for which exclusive protection cannot be granted:

Please also specify whether the disclaimer or reservation applies to:

All of the goods and/or services

Only the following goods and/or services:

V. Signature or official seal of the Office sending the statement:

VI. Date:

*Model Form 6*

**MADRID AGREEMENT AND PROTOCOL**

**FINAL DISPOSITION ON STATUS OF A MARK**

**– CONFIRMATION OF TOTAL PROVISIONAL REFUSAL –**

**Rule 18ter(3)**

*This form is to be used in the following situation: the Office has sent to the International Bureau a notification of a total provisional refusal and, all procedures before the Office being completed, the Office now confirms refusal of protection of the mark for all goods and/or services.*

I. Office sending the statement:
II. Number of the international registration:
III. Name of the holder (or other information enabling the identity of the international registration to be confirmed):
IV. Protection of the mark is refused for <u>all</u> the goods and/or services.
V. Signature or official seal of the Office sending the statement:
VI. Date:

*Model Form 7*

**MADRID AGREEMENT AND PROTOCOL**

**FURTHER DECISION AFFECTING THE PROTECTION OF A MARK**

**Rule 18ter(4)**

*This form is to be used where, following the communication of a statement of grant of protection (Rule 18ter(2)(i) and (ii) – Model Form 5) or the sending of confirmation of total provisional refusal for all the goods and/or services (Rule 18ter(3) – Model Form 6), a further decision affects the protection of the mark – for example, a subsequent decision resulting from an appeal to an authority outside the Office, or a case where, following the completion of the regular Office procedures, there has nevertheless been a further decision by the Office, such as restitutio in integrum.*

*This form should not be used for the communication of invalidations under Rule 19 of the Common Regulations.*

I. Office sending the statement:
II. Number of the international registration:
III. Name of the holder (or other information enabling the identity of the international registration to be confirmed):
IV. Please indicate here the goods and/or services that are now protected (a continuation sheet may be used, if necessary):
V. Signature or official seal of the Office sending the statement:
VI. Date:

*Model Form 8*

**MADRID AGREEMENT AND PROTOCOL**  
**COMPLETION OF *EX OFFICIO* EXAMINATION**  
**– INTERIM STATUS OF A MARK –**

**Rule 18bis(1)(a) and (b)**

*This form is to be used in the following situation: the Office confirms that ex officio examination has been completed, but protection of the mark is still subject to possible opposition or observations by third parties.*

**NOTE:** *This statement may optionally be sent by an Office following ex officio examination, including in situations where the Office had notified a provisional refusal, but ex officio procedure has been completed favorably for the holder.*

*If, following the present statement, opposition is filed, or observations leading to a refusal are filed, a Provisional Refusal of Protection (Model Form 3) should be sent in due course.*

*If no opposition is filed or no observations leading to a refusal are filed, the present statement should be followed by a Statement of Grant of Protection (Model Form 4 or, where the mark had first been the subject of an ex officio provisional refusal, but the ex officio procedure has been completed favorably for the holder, Model Form 5).*

I.	Office sending the statement:
II.	Number of the International Registration:
III.	Name of the holder (or other information enabling the identity of the international registration to be confirmed):
IV.	A notification of provisional refusal: <input type="checkbox"/> has not been communicated by the Office (Rule 18bis(1)(a)) <input type="checkbox"/> has been communicated by the Office (Rule 18bis(1)(b))
V.	(a) Date on which the opposition period, or the period for the filing of observations, begins:  (b) Date on which the opposition period, or the period for the filing of observations, ends:
VI.	Signature or official seal of the Office sending the statement:
VI.	Date:

*Model Form 9*

**MADRID AGREEMENT AND PROTOCOL**

**CEASING OF EFFECT OF THE BASIC APPLICATION, OF THE REGISTRATION  
RESULTING THEREFROM, OR OF THE BASIC REGISTRATION**

Notified to the International Bureau of the World Intellectual Property Organization (WIPO)  
in accordance with Rule 22(1)(a) or (c) of the Common Regulations  
under the Madrid Agreement and Protocol

I.	Office making the notification:
II.	Number of the international registration:
III.	Name of the holder (or other indication enabling the identity of the international registration to be confirmed):
IV.	<input type="checkbox"/> The notification is sent in accordance with Rule 22(1)(a) <input type="checkbox"/> The notification is sent in accordance with Rule 22(1)(c)
V.	Facts and decisions affecting the basic application, the registration resulting therefrom, or the basic registration (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: <input type="checkbox"/> an opposition to the basic application <input type="checkbox"/> a request of revocation of the basic registration or the registration resulting from the basic application <input type="checkbox"/> a request of invalidation of the basic registration or the registration resulting from the basic application <input type="checkbox"/> a request of cancellation of the basic registration or the registration resulting from the basic application <input type="checkbox"/> other (please specify):

VI.	<input type="checkbox"/>	These facts and decisions affect all the goods and/or services of the international registration
VII.		These facts and decisions affect some of the goods and/or services <sup>1</sup> Please choose option a) or b) and list the applicable goods and/or services
	<input type="checkbox"/>	a) These facts and decisions affect only the following goods and/or services of the international registration:
	<input type="checkbox"/>	b) These facts and decisions does not affect the following goods and/or services of the international registration:
VIII.	<input type="checkbox"/>	The cancellation of the international registration is requested to the extent indicated under item VI and VII
IX.		Effective date of those facts and decisions:
X.		Signature or official seal of the Office making the notification:

[End of Annex II and of document]

<sup>1</sup> The goods and/or services to be indicated here are as follows:

- those goods and/or services in the **international registration concerned** which are affected by the facts and decisions, or
- if there has already been a partial cancellation, those, out of the remaining goods and/or services, which are affected by the facts and decisions.

Where all the goods or services included in a given class are to be mentioned, the indication should read “all goods (or all services) in class X”. In all cases, a clear indication should be given as to whether those goods and/or services are affected, or are NOT affected.