

# **Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement**

(as in force on September 1, 2008)

## **Chapter 1 General Provisions**

### **Rule 1 Abbreviated Expressions**

For the purposes of these Regulations,

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

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

(iii) “Contracting Party” means any country party to the Agreement or any State or intergovernmental organization party to the Protocol;

(iv) “Contracting State” means a Contracting Party that is a State;

(v) “Contracting Organization” means a Contracting Party that is an intergovernmental organization;

(vi) “international registration” means the registration of a mark effected under the Agreement or the Protocol or both, as the case may be;

(vii) “international application” means an application for international registration filed under the Agreement or the Protocol or both, as the case may be;

(viii) “international application governed exclusively by the Agreement” means an international application whose Office of origin is the Office

- of a State bound by the Agreement but not by the Protocol, or
- of a State bound by both the Agreement and the Protocol, where only States are designated in the international application and all the designated States are bound by the Agreement but not by the Protocol;

(ix) “international application governed exclusively by the Protocol” means an international application whose Office of origin is the Office

- of a State bound by the Protocol but not by the Agreement, or
- of a Contracting Organization, or
- of a State bound by both the Agreement and the Protocol where the international application does not contain the designation of any State bound by the Agreement but not by the Protocol;

(x) “international application governed by both the Agreement and the Protocol” means an international application whose Office of origin is the Office of a State bound by both the Agreement and the Protocol and which is based on a registration and contains the designations

- of at least one State bound by the Agreement but not by the Protocol, and
- of at least one State bound by the Protocol whether or not that State is also bound by the Agreement or of at least one Contracting Organization;

(xi) “applicant” means the natural person or legal entity in whose name the international application is filed;

(xii) “legal entity” means a corporation, association or other group or organization which, under the law applicable to it, is capable of acquiring rights, assuming obligations and suing or being sued in a court of law;

(xiii) “basic application” means the application for the registration of a mark that has been filed with the Office of a Contracting Party and that constitutes the basis for the international application for the registration of that mark;

(xiv) “basic registration” means the registration of a mark that has been effected by the Office of a Contracting Party and that constitutes the basis for the international application for the registration of that mark;

(xv) “designation” means the request for extension of protection (“territorial extension”) under Article 3<sup>ter</sup>(1) or (2) of the Agreement or under Article 3<sup>ter</sup>(1) or (2) of the Protocol, as the case may be; it also means such extension as recorded in the International Register;

(xvi) “designated Contracting Party” means a Contracting Party for which the extension of protection (“territorial extension”) has been requested under Article 3<sup>ter</sup>(1) or (2) of the Agreement or under Article 3<sup>ter</sup>(1) or (2) of the Protocol, as the case may be, or in respect of which such extension has been recorded in the International Register;

(xvii) “Contracting Party designated under the Agreement” means a Contracting Party for which the extension of protection (“territorial extension”) has been requested under Article 3*ter*(1) or (2) of the Agreement;

(xviii) “Contracting Party designated under the Protocol” means a Contracting Party for which the extension of protection (“territorial extension”) has been requested under Article 3*ter*(1) or (2) of the Protocol;

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

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

(xx) “Gazette” means the periodical gazette referred to in Rule 32;

(xxi) “holder” means the natural person or legal entity in whose name the international registration is recorded in the International Register;

(xxii) “International Classification of Figurative Elements” means the Classification established by the Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks of June 12, 1973;

(xxiii) “International Classification of Goods and Services” means the Classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of June 15, 1957, as revised at Stockholm on July 14, 1967, and at Geneva on May 13, 1977;

(xxiv) “International Register” means the official collection of data concerning international registrations maintained by the International Bureau, which data the Agreement, the Protocol or the Regulations require or permit to be recorded, irrespective of the medium in which such data are stored;

(xxv) “Office” means the Office of a Contracting Party in charge of the registration of marks, or the common Office referred to in Article 9*quater* of the Agreement or Article 9*quater* of the Protocol, or both, as the case may be;

(xxvi) “Office of origin” means the Office of the country of origin defined in Article 1(3) of the Agreement or the Office of origin defined in Article 2(2) of the Protocol, or both, as the case may be;

(xxv*bis*) “Contracting Party of the holder” means

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

(xxvii) “official form” means a form established by the International Bureau or any form having the same contents and format;

(xxviii) “prescribed fee” means the applicable fee set out in the Schedule of Fees;

(xxix) “Director General” means the Director General of the World Intellectual Property Organization;

(xxx) “International Bureau” means the International Bureau of the World Intellectual Property Organization.

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

### **Rule 1bis**

#### **Designations Governed by the Agreement and Designations Governed by the Protocol**

(1) [*General Principle and Exceptions*] The designation of a Contracting Party shall be governed by the Agreement or by the Protocol depending on whether the Contracting Party has been designated under the Agreement or under the Protocol. However,

(i) where, with regard to a given international registration, the Agreement ceases to be applicable in the relations between the Contracting Party of the holder and a Contracting Party whose designation is governed by the Agreement, the designation of the latter shall become governed by the Protocol as of the date on which the Agreement so ceases to be applicable, insofar as, on that date, both the Contracting Party of the holder and the designated Contracting Party are parties to the Protocol, and

(ii) where, with regard to a given international registration, the Protocol ceases to be applicable in the relations between the Contracting Party of the holder and a Contracting Party whose designation is governed by the Protocol, the designation of the latter shall become governed by the Agreement as of the date on which the Protocol so ceases to be applicable, insofar as, on that date, both the Contracting Party of the holder and the designated Contracting Party are parties to the Agreement.

(2) *[Recording]* The international Bureau shall record in the International Register an indication of the treaty governing each designation.

## **Rule 2**

### **Communication with the International Bureau**

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

## **Rule 3**

### **Representation Before the International Bureau**

(1) *[Representative; Number of Representatives]*

- (a) The applicant or the holder may have a representative before the International Bureau.
- (b) The applicant or the holder may have one representative only. Where the appointment indicates several representatives, only the one indicated first shall be considered to be a representative and be recorded as such.
- (c) Where a partnership or firm composed of attorneys or patent or trademark agents has been indicated as representative to the International Bureau, it shall be regarded as one representative.

(2) *[Appointment of the Representative]*

- (a) The appointment of a representative may be made in the international application, or in a subsequent designation or a request under Rule 25.
- (b) The appointment of a representative may also be made in a separate communication which may relate to one or more specified international applications or international registrations of the same applicant or holder. The said communication shall be presented to the International Bureau
  - (i) by the applicant, the holder or the appointed representative, or
  - (ii) by the Office of the Contracting Party of the holder.

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

(3) *[Irregular Appointment]*

(a) Where the International Bureau considers that the appointment of a representative under paragraph (2) is irregular, it shall notify accordingly the applicant or holder, the purported representative and, if the sender or transmitter is an Office, that Office.

(b) As long as the relevant requirements under paragraph (2) are not complied with, the International Bureau shall send all relevant communications to the applicant or holder himself.

*(4) [Recording and Notification of Appointment of a Representative; Effective Date of Appointment]*

(a) Where the International Bureau finds that the appointment of a representative complies with the applicable requirements, it shall record the fact that the applicant or holder has a representative, as well as the name and address of the representative, in the International Register. In such a case, the effective date of the appointment shall be the date on which the International Bureau received the international application, subsequent designation, request or separate communication in which the representative is appointed.

(b) The International Bureau shall notify the recording referred to in subparagraph (a) to both the applicant or holder and the representative. Where the appointment was made in a separate communication presented through an Office, the International Bureau shall also notify the recording to that Office.

*(5) [Effect of Appointment of a Representative]*

(a) Except where these Regulations expressly provide otherwise, the signature of a representative recorded under paragraph (4)(a) shall replace the signature of the applicant or holder.

(b) Except where these Regulations expressly require that an invitation, notification or other communication be addressed to both the applicant or holder and the representative, the International Bureau shall address to the representative recorded under paragraph (4)(a) any invitation, notification or other communication which, in the absence of a representative, would have to be sent to the applicant or holder; any invitation, notification or other communication so addressed to the said representative shall have the same effect as if it had been addressed to the applicant or holder.

(c) Any communication addressed to the International Bureau by the representative recorded under paragraph (4)(a) shall have the same effect as if it had been addressed to the said Bureau by the applicant or holder.

*(6) [Cancellation of Recording; Effective Date of Cancellation]*

(a) Any recording under paragraph (4)(a) shall be cancelled where cancellation is requested in a communication signed by the applicant, holder or representative. The recording shall be cancelled *ex officio* by the International Bureau where a new representative is appointed or,

in case a change in ownership has been recorded, where no representative is appointed by the new holder of the international registration.

(b) Subject to subparagraph (c), the cancellation shall be effective from the date on which the International Bureau receives the corresponding communication.

(c) Where the cancellation is requested by the representative, it shall be effective from the earlier of the following:

(i) the date on which the International Bureau receives a communication appointing a new representative;

(ii) the date of the expiry of a period of two months counted from the receipt of the request of the representative that the recording be cancelled.

Until the effective date of the cancellation, all communications referred to in paragraph (5)(b) shall be addressed by the International Bureau to both the applicant or holder and the representative.

(d) The International Bureau shall, upon receipt of a request for cancellation made by the representative, notify accordingly the applicant or holder, and add to the notification copies of all communications sent to the representative, or received by the International Bureau from the representative, during the six months preceding the date of the notification.

(e) The International Bureau shall, once the effective date of the cancellation is known, notify the cancellation and its effective date to the representative whose recording has been cancelled, to the applicant or holder and, where the appointment of the representative had been presented through an Office, to that Office.

#### **Rule 4** **Calculation of Time Limits**

(1) [*Periods Expressed in Years*] Any period expressed in years shall expire, in the relevant subsequent year, in the month having the same name and on the day having the same number as the month and the day of the event from which the period starts to run, except that, where the event occurred on February 29 and in the relevant subsequent year February ends on the 28th, the period shall expire on February 28.

(2) [*Periods Expressed in Months*] Any period expressed in months shall expire, in the relevant subsequent month, on the day which has the same number as the day of the event from which the period starts to run, except that, where the relevant subsequent month has no day with the same number, the period shall expire on the last day of that month.

(3) [*Periods Expressed in Days*] The calculation of any period expressed in days shall start with the day following the day on which the relevant event occurred and shall expire accordingly.

(4) [*Expiry on a Day on Which the International Bureau or an Office Is Not Open to the Public*] If a period expires on a day on which the International Bureau or the Office concerned is not open to the public, the period shall, notwithstanding paragraphs (1) to (3), expire on the first subsequent day on which the International Bureau or the Office concerned is open to the public.

(5) [*Indication of the Date of Expiry*] The International Bureau shall, in all cases in which it communicates a time limit, indicate the date of the expiry, according to paragraphs (1) to (3), of the said time limit.

## **Rule 5**

### **Irregularities in Postal and Delivery Services**

(1) [*Communications Sent Through a Postal Service*] Failure by an interested party to meet a time limit for a communication addressed to the International Bureau and mailed through a postal service shall be excused if the interested party submits evidence showing, to the satisfaction of the International Bureau,

(i) that the communication was mailed at least five days prior to the expiry of the time limit, or, where the postal service was, on any of the ten days preceding the day of expiry of the time limit, interrupted on account of war, revolution, civil disorder, strike, natural calamity, or other like reason, that the communication was mailed not later than five days after postal service was resumed,

(ii) that the mailing of the communication was registered, or details of the mailing were recorded, by the postal service at the time of mailing, and

(iii) in cases where all classes of mail do not normally reach the International Bureau within two days of mailing, that the communication was mailed by a class of mail which normally reaches the International Bureau within two days of mailing or by airmail.

(2) [*Communications Sent Through a Delivery Service*] Failure by an interested party to meet a time limit for a communication addressed to the International Bureau and sent through a delivery service shall be excused if the interested party submits evidence showing, to the satisfaction of the International Bureau,

(i) that the communication was sent at least five days prior to the expiry of the time limit, or, where the delivery service was, on any of the ten days preceding the day of expiry of the time limit, interrupted on account of war, revolution, civil disorder, strike, natural calamity,

or other like reason, that the communication was sent not later than five days after the delivery service was resumed, and

(ii) that details of the sending of the communication were recorded by the delivery service at the time of sending.

(3) [*Limitation on Excuse*] Failure to meet a time limit shall be excused under this Rule only if the evidence referred to in paragraph (1) or (2) and the communication or a duplicate thereof are received by the International Bureau not later than six months after the expiry of the time limit.

(4) [*International Application and Subsequent Designation*] Where the International Bureau receives an international application or a subsequent designation beyond the two-month period referred to in Article 3(4) of the Agreement, in Article 3(4) of the Protocol and in Rule 24(6)(b), and the Office concerned indicates that the late receipt resulted from circumstances referred to in paragraph (1) or (2), paragraph (1) or (2) and paragraph (3) shall apply.

## **Rule 6** **Languages**

(1) [*International Application*]

The international application shall be in English, French or Spanish according to what is prescribed by the Office of origin, it being understood that the Office of origin may allow applicants to choose between English, French and Spanish.

(2) [*Communications Other Than the International Application*]

Any communication concerning an international application or an international registration shall, subject to Rule 17(2)(v) and (3), be

(i) in English, French or Spanish where such communication is addressed to the International Bureau by the applicant or holder, or by an Office;

(ii) in the language applicable under Rule 7(2) where the communication consists of the declaration of intention to use the mark annexed to the international application under Rule 9(5)(f) or to the subsequent designation under Rule 24(3)(b)(i);

(iii) in the language of the international application where the communication is a notification addressed by the International Bureau to an Office, unless that Office has notified the International Bureau that all such notifications are to be in English, or are to be

in French or are to be in Spanish; where the notification addressed by the International Bureau concerns the recording in the International Register of an international registration, the notification shall indicate the language in which the relevant international application was received by the International Bureau;

(iv) in the language of the international application where the communication is a notification addressed by the International Bureau to the applicant or holder, unless that applicant or holder has expressed the wish that all such notifications be in English, or be in French or be in Spanish.

*(3) [Recording and Publication]*

(a) The recording in the International Register and the publication in the Gazette of the international registration and of any data to be both recorded and published under these Regulations in respect of the international registration shall be in English, French and Spanish. The recording and publication of the international registration shall indicate the language in which the international application was received by the International Bureau.

(b) Where a first subsequent designation is made in respect of an international registration that, under previous versions of this Rule, has been published only in French, or only in English and French, the International Bureau shall, together with the publication in the Gazette of that subsequent designation, either publish the international registration in English and Spanish and republish the international registration in French, or publish the international registration in Spanish and republish it in English and French, as the case may be. That subsequent designation shall be recorded in the International Register in English, French and Spanish.

*(4) [Translation]*

(a) The translations needed for the notifications under paragraph (2)(iii) and (iv), and recordings and publications under paragraph (3), shall be made by the International Bureau. The applicant or the holder, as the case may be, may annex to the international application, or to a request for the recording of a subsequent designation or of a change, a proposed translation of any text matter contained in the international application or the request. If the proposed translation is not considered by the International Bureau to be correct, it shall be corrected by the International Bureau after having invited the applicant or the holder to make, within one month from the invitation, observations on the proposed corrections.

(b) Notwithstanding subparagraph (a), the International Bureau shall not translate the mark. Where, in accordance with Rule 9(4)(b)(iii) or Rule 24(3)(c), the applicant or the holder gives a translation or translations of the mark, the International Bureau shall not check the correctness of any such translations.

**Rule 7**  
**Notification of Certain Special Requirements**

(1) [Deleted]

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

(3) *[Notification]*

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

(b) Any notification made under paragraph (1), as in force before October 4, 2001<sup>1</sup>, or paragraph (2) may be withdrawn at any time. The notice of withdrawal shall be addressed to the Director General. The withdrawal shall have effect upon receipt of the notice of withdrawal by the Director General or at any later date indicated in the notice.

**Chapter 2**  
**International Applications**

**Rule 8**  
**Several Applicants**

(1) *[Two or More Applicants Applying Exclusively Under the Agreement or Applying Under Both the Agreement and the Protocol]* Two or more applicants may jointly file an international application governed exclusively by the Agreement or governed by both the Agreement and the Protocol if the basic registration is jointly owned by them and if the country of origin, as defined in Article 1(3) of the Agreement, is the same for each of them.

(2) *[Two or More Applicants Applying Exclusively Under the Protocol]* Two or more applicants may jointly file an international application governed exclusively by the Protocol

if the basic application was jointly filed by them or the basic registration is jointly owned by them, and if each of them qualifies, in relation to the Contracting Party whose Office is the Office of origin, for filing an international application under Article 2(1) of the Protocol.

## **Rule 9**

### **Requirements Concerning the International Application**

(1) [*Presentation*] The international application shall be presented to the International Bureau by the Office of origin.

(2) [*Form and Signature*]

(a) The international application shall be presented on the official form in one copy.

(b) The international application shall be signed by the Office of origin and, where the Office of origin so requires, also by the applicant. Where the Office of origin does not require the applicant to sign the international application but allows that the applicant also sign it, the applicant may do so.

(3) [*Fees*] The prescribed fees applicable to the international application shall be paid as provided for in Rules 10, 34 and 35.

(4) [*Contents of the International Application*]

(a) The international application shall contain or indicate

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

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

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

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

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

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

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

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

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

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

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

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

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

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

of one or more designated Contracting Parties; the limitation in respect of each Contracting Party may be different,

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

(xv) the designated Contracting Parties.

(b) The international application may also contain,

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

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

(iii) where the mark consists of or contains a word or words that can be translated, a translation of that word or those words into English, French and Spanish, or in any one or two of those languages;

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

(ii) be included in the international application.

(g) Where an international application contains the designation of a Contracting Organization, it may also contain the following indications:

(i) where the applicant wishes to claim, under the law of that Contracting Organization, the seniority of one or more earlier marks registered in, or for, a Member State of that Organization, a declaration to that effect, stating the Member State or Member States in or for which the earlier mark is registered, the date from which the relevant registration was effective, the number of the relevant registration and the goods and services for which the earlier mark is registered. Such indications shall be on an official form to be annexed to the international application;

(ii) where, under the law of that Contracting Organization, the applicant is required to indicate a second working language before the Office of that Contracting Organization, in addition to the language of the international application, an indication of that second language.

## **Rule 10**

### **Fees Concerning the International Application**

(1) *[International Applications Governed Exclusively by the Agreement]* An international application governed exclusively by the Agreement shall be subject to the payment of the basic fee, the complementary fee and, where applicable, the supplementary fee, specified in item 1 of the Schedule of Fees. Those fees shall be paid in two instalments of ten years each. For the payment of the second instalment, Rule 30 shall apply.

(2) *[International Applications Governed Exclusively by the Protocol]* An international application governed exclusively by the Protocol shall be subject to the payment of the basic fee, the complementary fee and/or the individual fee and, where applicable, the supplementary fee, specified or referred to in item 2 of the Schedule of Fees. Those fees shall be paid for ten years.

(3) *[International Applications Governed by Both the Agreement and the Protocol]* An international application governed by both the Agreement and the Protocol shall be subject to the payment of the basic fee, the complementary fee and, where applicable, the individual fee and the supplementary fee, specified or referred to in item 3 of the Schedule of Fees. As far as the Contracting Parties designated under the Agreement are concerned, paragraph (1) shall apply. As far as the Contracting Parties designated under the Protocol are concerned, paragraph (2) shall apply.

### **Rule 11** **Irregularities Other Than Those Concerning the** **Classification of Goods and Services or Their Indication**

(1) *[Premature Request to the Office of Origin]*

(a) Where the Office of origin received a request to present to the International Bureau an international application governed exclusively by the Agreement before the mark which is referred to in that request is registered in the register of the said Office, the said request shall be deemed to have been received by the Office of origin, for the purposes of Article 3(4) of the Agreement, on the date of the registration of the mark in the register of the said Office.

(b) Subject to subparagraph (c), where the Office of origin receives a request to present to the International Bureau an international application governed by both the Agreement and the Protocol before the mark which is referred to in that request is registered in the register of the said Office, the international application shall be treated as an international application governed exclusively by the Protocol, and the Office of origin shall delete the designation of any Contracting Party bound by the Agreement but not by the Protocol.

(c) Where the request referred to in subparagraph (b) is accompanied by an express request that the international application be treated as an international application governed by both the Agreement and the Protocol once the mark is registered in the register of the Office of origin, the said Office shall not delete the designation of any Contracting Party bound by the Agreement but not by the Protocol and the request to present the international application shall be deemed to have been received by the said Office, for the purposes of Article 3(4) of the Agreement and Article 3(4) of the Protocol, on the date of the registration of the mark in the register of the said Office.

(2) *[Irregularities to Be Remedied by the Applicant]*

(a) If the International Bureau considers that the international application contains irregularities other than those referred to in paragraphs (3), (4) and (6) and in Rules 12 and 13, it shall notify the applicant of the irregularity and at the same time inform the Office of origin.

(b) Such irregularities may be remedied by the applicant within three months from the date of the notification of the irregularity by the International Bureau. If an irregularity is not remedied within three months from the date of the notification of that irregularity by the International Bureau, the international application shall be considered abandoned and the International Bureau shall notify accordingly and at the same time the applicant and the Office of origin.

*(3) [Irregularity to Be Remedied by the Applicant or by the Office of Origin]*

(a) Notwithstanding paragraph (2), where the fees payable under Rule 10 have been paid to the International Bureau by the Office of origin and the International Bureau considers that the amount of the fees received is less than the amount required, it shall notify at the same time the Office of origin and the applicant. The notification shall specify the missing amount.

(b) The missing amount may be paid by the Office of origin or by the applicant within three months from the date of the notification by the International Bureau. If the missing amount is not paid within three months from the date of the notification of the irregularity by the International Bureau, the international application shall be considered abandoned and the International Bureau shall notify accordingly and at the same time the Office of origin and the applicant.

*(4) [Irregularities to Be Remedied by the Office of Origin]*

(a) If the International Bureau

(i) finds that the international application does not fulfill the requirements of Rule 2 or was not presented on the official form prescribed under Rule 9(2)(a),

(ii) finds that the international application contains any of the irregularities referred to in Rule 15(1),

(iii) considers that the international application contains irregularities relating to the entitlement of the applicant to file an international application,

(iv) considers that the international application contains irregularities relating to the declaration by the Office of origin referred to in Rule 9(5)(d),

(v) [Deleted]

(vi) finds that the international application is not signed by the Office of origin, or

(vii) finds that the international application does not contain the date and number of the basic application or basic registration, as the case may be, it shall notify the Office of origin and at the same time inform the applicant.

(b) Such irregularities may be remedied by the Office of origin within three months from the date of notification of the irregularity by the International Bureau. If an irregularity is not remedied within three months from the date of the notification of that irregularity by the International Bureau, the international application shall be considered abandoned and the International Bureau shall notify accordingly and at the same time the Office of origin and the applicant.

(5) *[Reimbursement of Fees]* Where, in accordance with paragraphs (2)(b), (3) or (4)(b), the international application is considered abandoned, the International Bureau shall refund any fees paid in respect of that application, after deduction of an amount corresponding to one-half of the basic fee referred to in items 1.1.1, 2.1.1 or 3.1.1 of the Schedule of Fees, to the party having paid those fees.

(6) *[Other Irregularity With Respect to the Designation of a Contracting Party Under the Protocol]*

(a) Where, in accordance with Article 3(4) of the Protocol, an international application is received by the International Bureau within a period of two months from the date of receipt of that international application by the Office of origin and the International Bureau considers that a declaration of intention to use the mark is required according to Rule 9(5)(f) but is missing or does not comply with the applicable requirements, the International Bureau shall promptly notify accordingly and at the same time the applicant and the Office of origin.

(b) The declaration of intention to use the mark shall be deemed to have been received by the International Bureau together with the international application if the missing or corrected declaration is received by the International Bureau within the period of two months referred to in subparagraph (a).

(c) The international application shall be deemed not to contain the designation of the Contracting Party for which a declaration of intention to use the mark is required if the missing or corrected declaration is received after the period of two months referred to in subparagraph (b). The International Bureau shall notify accordingly and at the same time the applicant and the Office of origin, reimburse any designation fee already paid in respect of that Contracting Party and indicate that the designation of the said Contracting Party may be effected as a subsequent designation under Rule 24, provided that such designation is accompanied by the required declaration.

(7) *[International Application Not Considered as Such]* If the international application is presented direct to the International Bureau by the applicant or does not comply with the requirement applicable under Rule 6(1), the international application shall not be considered as such and shall be returned to the sender.

**Rule 12**  
**Irregularities With Respect to the**  
**Classification of Goods and Services**

(1) [*Proposal for Classification*]

(a) If the International Bureau considers that the requirements of Rule 9(4)(a)(xiii) are not complied with, it shall make a proposal of its own for the classification and grouping and shall send a notification of its proposal to the Office of origin and at the same time inform the applicant.

(b) The notification of the proposal shall also state the amount, if any, of the fees due as a consequence of the proposed classification and grouping.

(2) [*Opinion Differing From the Proposal*] The Office of origin may communicate to the International Bureau an opinion on the proposed classification and grouping within three months from the date of the notification of the proposal.

(3) [*Reminder of the Proposal*] If, within two months from the date of the notification referred to in paragraph (1)(a), the Office of origin has not communicated an opinion on the proposed classification and grouping, the International Bureau shall send to the Office of origin and to the applicant a communication reiterating the proposal. The sending of such a communication shall not affect the three-month period referred to in paragraph (2).

(4) [*Withdrawal of Proposal*] If, in the light of the opinion communicated under paragraph (2), the International Bureau withdraws its proposal, it shall notify the Office of origin accordingly and at the same time inform the applicant.

(5) [*Modification of Proposal*] If, in the light of the opinion communicated under paragraph (2), the International Bureau modifies its proposal, it shall notify the Office of origin and at the same time inform the applicant of such modification and of any consequent changes in the amount indicated under paragraph (1)(b).

(6) [*Confirmation of Proposal*] If, notwithstanding the opinion referred to in paragraph (2), the International Bureau confirms its proposal, it shall notify the Office of origin accordingly and at the same time inform the applicant.

(7) [*Fees*]

(a) If no opinion has been communicated to the International Bureau under paragraph (2), the amount referred to in paragraph (1)(b) shall be payable within four months from the date of the notification referred to in paragraph (1)(a), failing which the international application shall be considered abandoned and the International Bureau shall notify the Office of origin accordingly and at the same time inform the applicant.

(b) If an opinion has been communicated to the International Bureau under paragraph (2), the amount referred to in paragraph (1)(b) or, where applicable, paragraph (5) shall be payable within three months from the date of the communication by the International Bureau of the modification or confirmation of its proposal under paragraph (5) or (6), as the case may be, failing which the international application shall be considered abandoned and the International Bureau shall notify the Office of origin accordingly and at the same time inform the applicant.

(c) If an opinion has been communicated to the International Bureau under paragraph (2) and if, in the light of that opinion, the International Bureau withdraws its proposal in accordance with paragraph (4), the amount referred to in paragraph (1)(b) shall not be due.

(8) [*Reimbursement of Fees*] Where, in accordance with paragraph (7), the international application is considered abandoned, the International Bureau shall refund any fees paid in respect of that application, after deduction of an amount corresponding to one-half of the basic fee referred to in items 1.1.1, 2.1.1 or 3.1.1 of the Schedule of Fees, to the party having paid those fees.

(9) [*Classification in the Registration*] Subject to the conformity of the international application with the other applicable requirements, the mark shall be registered with the classification and grouping that the International Bureau considers to be correct.

### **Rule 13** **Irregularities With Respect to the** **Indication of Goods and Services**

(1) [*Communication of Irregularity by the International Bureau to the Office of Origin*] If the International Bureau considers that any of the goods and services is indicated in the international application by a term that is too vague for the purposes of classification or is incomprehensible or is linguistically incorrect, it shall notify the Office of origin accordingly and at the same time inform the applicant. In the same notification, the International Bureau may suggest a substitute term, or the deletion of the term.

(2) [*Time Allowed to Remedy Irregularity*]

(a) The Office of origin may make a proposal for remedying the irregularity within three months from the date of the notification referred to in paragraph (1).

(b) If no proposal acceptable to the International Bureau for remedying the irregularity is made within the period indicated in subparagraph (a), the International Bureau shall include in the international registration the term as appearing in the international application, provided that the Office of origin has specified the class in which such term should be classified; the international registration shall contain an indication to the effect that, in the

opinion of the International Bureau, the specified term is too vague for the purposes of classification or is incomprehensible or is linguistically incorrect, as the case may be. Where no class has been specified by the Office of origin, the International Bureau shall delete the said term *ex officio* and shall notify the Office of origin accordingly and at the same time inform the applicant.

### **Chapter 3** **International Registrations**

#### **Rule 14** **Registration of the Mark in the International Register**

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

(2) [*Contents of the Registration*] The international registration shall contain

(i) all the data contained in the international application, except any priority claim under Rule 9(4)(a)(iv) where the date of the earlier filing is more than six months before the date of the international registration,

(ii) the date of the international registration,

(iii) the number of the international registration,

(iv) where the mark can be classified according to the International Classification of Figurative Elements, and unless the international application contains a declaration to the effect that the applicant wishes that the mark be considered as a mark in standard characters, the relevant classification symbols of the said Classification as determined by the International Bureau,

(v) an indication, with respect to each designated Contracting Party, as to whether it is a Contracting Party designated under the Agreement or a Contracting Party designated under the Protocol.

(vi) indications annexed to the international application in accordance with Rule 9(5)(g)(i) concerning the Member State or Member States in or for which an earlier mark, for which seniority is claimed, is registered, the date from which the registration of that earlier mark was effective and the number of the relevant registration.

**Rule 15**  
**Date of the International Registration**

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

(i) indications allowing the identity of the applicant to be established and sufficient to contact the applicant or his representative, if any,

(ii) the Contracting Parties which are designated,

(iii) a reproduction of the mark,

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

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

**Chapter 4**  
**Facts in Contracting Parties**  
**Affecting International Registrations**

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

(1) [*Information Relating to Possible Oppositions*]

(a) Subject to Article 9*sexies*(1)(b) of the Protocol, where a declaration has been made by a Contracting Party pursuant to Article 5(2)(b) and (c), first sentence, of the Protocol, the Office of that Contracting Party shall, where it has become apparent with regard to a given international registration designating that Contracting Party that the opposition period will expire too late for any provisional refusal based on an opposition to be notified to the

International Bureau within the 18-month time limit referred to in Article 5(2)(b), inform the International Bureau of the number, and the name of the holder, of that international registration.

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

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

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

## **Rule 17**

### **Provisional Refusal and Statement of Grant of Protection**

(1) [*Notification of Provisional Refusal*]

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

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

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

(i) the Office making the notification,

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

(iii) [Deleted]

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

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

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

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

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

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

(5) *[Confirmation or Withdrawal of Provisional Refusal]*

(a) An Office which has sent to the International Bureau a notification of provisional refusal shall, once all procedures before the said Office relating to the protection of the mark have been completed, send to the International Bureau a statement indicating either

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

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

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

(b) Where, following the sending of a statement in accordance with subparagraph (a), a further decision affects the protection of the mark, the Office shall, to the extent that it is aware of that decision, send to the International Bureau a further statement indicating the goods and services for which the mark is protected in the Contracting Party concerned.<sup>2</sup>

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

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

(i) any provisional refusal that has been notified to the International Bureau is subject to review by the said Office, whether or not such review has been requested by the holder, and

(ii) the decision taken on the said review may be the subject of a further review or appeal before the Office.

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

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

(6) [*Statement of Grant of Protection*]

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

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

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

(iii) where a statement in accordance with item (ii) has been sent, a further statement to the effect that the opposition period has expired without any opposition or observations being filed and that the Office has therefore decided to grant protection to the mark that is the subject of the international registration.<sup>3</sup>

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

## **Rule 18**

### **Irregular Notifications of Provisional Refusal**

(1) [*Contracting Party Designated Under the Agreement*]

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

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

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

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

(b) Where subparagraph (a) applies, the International Bureau shall nevertheless transmit a copy of the notification to the holder, shall inform, at the same time, the holder and the

Office that sent the notification that the notification of provisional refusal is not regarded as such by the International Bureau, and shall indicate the reasons therefor.

(c) If the notification

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

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

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

(iv) does not comply with the requirements of Rule 17(2)(vii), or

(v) [Deleted]

(vi) does not contain, where applicable, the name and address of the opponent and the indication of the goods and services on which the opposition is based (Rule 17(3)), the International Bureau shall, except where subparagraph (d) applies, nonetheless record the provisional refusal in the International Register. The International Bureau shall invite the Office that communicated the provisional refusal to send a rectified notification within two months from the invitation and shall transmit to the holder copies of the irregular notification and of the invitation sent to the Office concerned.

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

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

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

(2) [*Contracting Party Designated Under the Protocol*]

(a) Paragraph (1) shall also apply in the case of a notification of provisional refusal communicated by the Office of a Contracting Party designated under the Protocol, it being understood that the time limit referred to in paragraph (1)(a)(iii) shall be the time limit applicable under Article 5(2)(a)

or, subject to Article 9*sexies*(1)(b) of the Protocol, under Article 5(2)(b) or (c)(ii) of the Protocol.

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

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

## **Rule 19**

### **Invalidations in Designated Contracting Parties**

(1) [*Contents of the Notification of Invalidation*] Where the effects of an international registration are invalidated in a designated Contracting Party under Article 5(6) of the Agreement or Article 5(6) of the Protocol and the invalidation is no longer subject to appeal, the Office of the Contracting Party whose competent authority has pronounced the invalidation shall notify the International Bureau accordingly. The notification shall contain or indicate

(i) the authority which pronounced the invalidation,

(ii) the fact that the invalidation is no longer subject to appeal,

(iii) the number of the international registration,

(iv) the name of the holder,

(v) if the invalidation does not concern all the goods and services, those in respect of which the invalidation has been pronounced or those in respect of which the invalidation has not been pronounced, and

(vi) the date on which the invalidation was pronounced and, where possible, its effective date.

(2) *[Recording of the Invalidation and Information to the Holder and the Office Concerned]*

(a) The International Bureau shall record the invalidation in the International Register, together with the data contained in the notification of invalidation, and shall inform accordingly the holder. The International Bureau shall also inform the Office that communicated the notification of invalidation of the date on which the invalidation was recorded in the International Register if that Office has requested to receive such information.

(b) The invalidation shall be recorded as of the date of receipt by the International Bureau of a notification complying with the applicable requirements.

**Rule 20**  
**Restriction of the Holder's Right of Disposal**

(1) *[Communication of Information]*

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

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

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

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

(3) *[Recording]*

(a) The International Bureau shall record the information communicated under paragraphs (1) and (2) in the International Register and shall inform accordingly the holder, the Office of the Contracting Party of the holder and the Offices of the designated Contracting Parties concerned.

(b) The information communicated under paragraphs (1) and (2) shall be recorded as of the date of its receipt by the International Bureau, provided that the communication complies with the applicable requirements.

**Rule 20bis**  
**Licenses**

(1) [*Request for the Recording of a License*]

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

(b) The request shall indicate

(i) the number of the international registration concerned,

(ii) the name of the holder,

(iii) the name and address of the licensee, given in accordance with the Administrative Instructions,

(iv) the designated Contracting Parties with respect to which the license is granted,

(v) that the license is granted for all the goods and services covered by the international registration, or the goods and services for which the license is granted, grouped in the appropriate classes of the International Classification of Goods and Services.

(c) The request may also indicate

(i) where the licensee is a natural person, the State of which the licensee is a national,

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

(iii) that the license concerns only a part of the territory of a specified designated Contracting Party,

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

(v) where the license is an exclusive license or a sole license, that fact,<sup>4</sup>

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

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

(2) *[Irregular Request]*

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

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

(3) *[Recording and Notification]*

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

(b) The license shall be recorded as of the date of receipt by the International Bureau of a request complying with the applicable requirements.

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

(5) *[Declaration That the Recording of a Given License Has No Effect]*

(a) The Office of a designated Contracting Party which is notified by the International Bureau of the recording of a license in respect of that Contracting Party may declare that such recording has no effect in the said Contracting Party.

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

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

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

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

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

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

(d) The International Bureau shall record in the International Register any declaration made in accordance with subparagraph (c) and shall notify accordingly the party (holder or Office) that presented the request to record the license. The declaration shall be recorded as of the date of receipt by the International Bureau of a communication complying with the applicable requirements.

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

*(6) [Declaration That the Recording of Licenses in the International Register Has No Effect in a Contracting Party]*

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

(b) The Office of a Contracting Party the law of which provides for the recording of trademark licenses may, before the date on which this Rule comes into force or the date on which the said Contracting Party becomes bound by the Agreement or the Protocol, notify the Director General that the recording of licenses in the International Register has no effect in that Contracting Party. Such notification may be withdrawn at any time.<sup>5</sup>

**Rule 21**  
**Replacement of a National or Regional Registration**  
**by an International Registration**

(1) *[Notification]* Where, in accordance with Article 4*bis*(2) of the Agreement or Article 4*bis*(2) of the Protocol, the Office of a designated Contracting Party has taken note in its Register, following a request made direct by the holder with that Office, that a national or a regional registration has been replaced by an international registration, that Office shall notify the International Bureau accordingly. Such notification shall indicate

(i) the number of the international registration concerned,

(ii) where the replacement concerns only one or some of the goods and services listed in the international registration, those goods and services, and

(iii) the filing date and number, the registration date and number, and, if any, the priority date of the national or regional registration which has been replaced by the international registration.

The notification may also include information relating to any other rights acquired by virtue of that national or regional registration, in a form agreed between the International Bureau and the Office concerned.

(2) *[Recording]*

(a) The International Bureau shall record the indications notified under paragraph (1) in the International Register and shall inform the holder accordingly.

(b) The indications notified under paragraph (1) shall be recorded as of the date of receipt by the International Bureau of a notification complying with the applicable requirements.

**Rule 21bis**  
**Other Facts Concerning Seniority Claim**

(1) *[Final Refusal of Seniority Claim]* Where a claim of seniority has been recorded in the International Register in respect of the designation of a Contracting Organization, the Office of that Organization shall notify the International Bureau of any final decision refusing, in whole or in part, the validity of such claim.

(2) *[Seniority Claimed Subsequent to the International Registration]* Where the holder of an international registration designating a Contracting Organization has, under the law of such Contracting Organization, claimed directly with the Office of that Organization the seniority of one or more earlier marks registered in, or for, a Member State of that Organization, and where such claim has been accepted by the Office concerned, that Office shall notify that fact to the International Bureau. Such notification shall indicate:

(i) the number of the international registration concerned, and

(ii) the Member State or Member States in or for which the earlier mark is registered, together with the date from which the registration of that earlier mark was effective and the number of the relevant registration.

(3) *[Other Decisions Affecting Seniority Claim]* The Office of a Contracting Organization shall notify the International Bureau of any further final decision, including withdrawal and cancellation, affecting a claim to seniority which has been recorded in the International Register.

(4) *[Recording in the International Register]* The International Bureau shall record in the International Register the information notified under paragraphs (1) to (3).

**Rule 22**  
**Ceasing of Effect of the Basic Application,**  
**of the Registration Resulting Therefrom,**  
**or of the Basic Registration**

(1) *[Notification Relating to Ceasing of Effect of the Basic Application, of the Registration Resulting Therefrom, or of the Basic Registration]*

(a) Where Article 6(3) and (4) of the Agreement or Article 6(3) and (4) of the Protocol, or both, apply, the Office of origin shall notify the International Bureau accordingly and shall indicate

(i) the number of the international registration,

(ii) the name of the holder,

(iii) the facts and decisions affecting the basic registration, or, where the international registration concerned is based on a basic application which has not resulted in a registration, the facts and decisions affecting the basic application, or, where the international registration is based on a basic application which has resulted in a registration, the facts and decisions affecting that registration, and the effective date of those facts and decisions, and

(iv) where the said facts and decisions affect the international registration only with respect to some of the goods and services, those goods and services which are affected by the facts and decisions or those which are not affected by the facts and decisions.

(b) Where a judicial action referred to in Article 6(4) of the Agreement, or a proceeding referred to in item (i), (ii) or (iii) of Article 6(3) of the Protocol, began before the expiry of the five-year period but has not, before the expiry of that period, resulted in the final decision referred to in Article 6(4) of the Agreement, or in the final decision referred to in the second sentence of Article 6(3) of the Protocol or in the withdrawal or renunciation referred to in the third sentence of Article 6(3) of the Protocol, the Office of origin shall, where it is aware thereof and as soon as possible after the expiry of the said period, notify the International Bureau accordingly.

(c) Once the judicial action or proceeding referred to in subparagraph (b) has resulted in the final decision referred to in Article 6(4) of the Agreement, in the final decision referred to in the second sentence of Article 6(3) of the Protocol or in the withdrawal or renunciation referred to in the third sentence of Article 6(3) of the Protocol, the Office of origin shall, where it is aware thereof, promptly notify the International Bureau accordingly and shall give the indications referred to in subparagraph (a)(i) to (iv).

*(2) [Recording and Transmittal of the Notification; Cancellation of the International Registration]*

(a) The International Bureau shall record any notification referred to in paragraph (1) in the International Register and shall transmit a copy of the notification to the Offices of the designated Contracting Parties and to the holder.

(b) Where any notification referred to in paragraph (1)(a) or (c) requests cancellation of the international registration and complies with the requirements of that paragraph, the International Bureau shall cancel, to the extent applicable, the international registration in the International Register.

(c) Where the international registration has been cancelled in the International Register in accordance with subparagraph (b), the International Bureau shall notify the Offices of the designated Contracting Parties and the holder of the following:

(i) the date on which the international registration was cancelled in the International Register;

(ii) where the cancellation concerns all goods and services, that fact;

(iii) where the cancellation concerns only some of the goods and services, the goods and services indicated under paragraph (1)(a)(iv).

**Rule 23**

**Division or Merger of the Basic Applications,  
of the Registrations Resulting Therefrom,  
or of the Basic Registrations**

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

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

(ii) the name of the holder or applicant,

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

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

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

## **Chapter 5** **Subsequent Designations; Changes**

### **Rule 24** **Designation Subsequent to the International Registration**

(1) *[Entitlement]*

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

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

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

(2) *[Presentation; Form and Signature]*

(a) A subsequent designation shall be presented to the International Bureau by the holder or by the Office of the Contracting Party of the holder; however,

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

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

(iii) where paragraph (7) applies, the subsequent designation resulting from conversion must be presented by the Office of the Contracting Organization.

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

(3) *[Contents]*

(a) Subject to paragraph (7)(b), the subsequent designation shall contain or indicate

(i) the number of the international registration concerned,

(ii) the name and address of the holder,

(iii) the Contracting Party that is designated,

(iv) where the subsequent designation is for all the goods and services listed in the international registration concerned, that fact, or, where the subsequent designation is for only part of the goods and services listed in the international registration concerned, those goods and services,

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

(vi) where the subsequent designation is presented by an Office, the date on which it was received by that Office.

(b) Where the subsequent designation concerns a Contracting Party that has made a notification under Rule 7(2), that subsequent designation shall also contain a declaration of intention to use the mark in the territory of that Contracting Party; the declaration shall, as required by the said Contracting Party,

(i) be signed by the holder himself and be made on a separate official form annexed to the subsequent designation, or

(ii) be included in the subsequent designation.

(c) The subsequent designation may also contain

(i) the indications and translation or translations, as the case may be, referred to in Rule 9(4)(b),

(ii) a request that the subsequent designation take effect after the recording of a change or a cancellation in respect of the international registration concerned or after the renewal of the international registration,

(iii) where the subsequent designation concerns a Contracting Organization, the indications referred to in Rule 9(5)(g)(i), which shall be on a separate official form to be annexed to the subsequent designation, and in Rule 9(5)(g)(ii).

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

(4) *[Fees]* The subsequent designation shall be subject to the payment of the fees specified or referred to in item 5 of the Schedule of Fees.

(5) *[Irregularities]*

(a) If the subsequent designation does not comply with the applicable requirements, and subject to paragraph (10), the International Bureau shall notify that fact to the holder and, if the subsequent designation was presented by an Office, that Office.

(b) If the irregularity is not remedied within three months from the date of the notification of the irregularity by the International Bureau, the subsequent designation shall be considered abandoned, and the International Bureau shall notify accordingly and at the same time the holder and, if the subsequent designation was presented by an Office, that Office, and refund any fees paid, after deduction of an amount corresponding to one-half of the basic fee referred to in item 5.1 of the Schedule of Fees, to the party having paid those fees.

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

(6) *[Date of Subsequent Designation]*

(a) A subsequent designation presented by the holder direct to the International Bureau shall, subject to subparagraph (c)(i), bear the date of its receipt by the International Bureau.

(b) A subsequent designation presented to the International Bureau by an Office shall, subject to subparagraph (c)(i), (d) and (e), bear the date on which it was received by that Office, provided that the said designation has been received by the International Bureau

within a period of two months from that date. If the subsequent designation has not been received by the International Bureau within that period, it shall, subject to subparagraph (c)(i), (d) and (e), bear the date of its receipt by the International Bureau.

(c) Where the subsequent designation does not comply with the applicable requirements and the irregularity is remedied within three months from the date of the notification referred to in paragraph (5)(a),

(i) the subsequent designation shall, where the irregularity concerns any of the requirements referred to in paragraph (3)(a)(i), (iii) and (iv) and (b)(i), bear the date on which that designation is put in order, unless the said designation was presented to the International Bureau by an Office and the irregularity is remedied within the period of two months referred to in subparagraph (b); in the latter case, the subsequent designation shall bear the date on which it was received by the said Office;

(ii) the date applicable under subparagraph (a) or (b), as the case may be, shall not be affected by an irregularity concerning requirements other than those which are referred to in paragraph (3)(a)(i), (iii) and (iv) and (b)(i).

(d) Notwithstanding subparagraphs (a), (b) and (c), where the subsequent designation contains a request made in accordance with paragraph (3)(c)(ii), it may bear a date which is later than that resulting from subparagraph (a), (b) or (c).

(e) Where a subsequent designation results from conversion in accordance with paragraph (7), that subsequent designation shall bear the date on which the designation of the Contracting Organization was recorded in the International Register.

*(7) [Subsequent Designation Resulting From Conversion]*

(a) Where the designation of a Contracting Organization has been recorded in the International Register and to the extent that such designation has been withdrawn, refused or has ceased to have effect under the law of that Organization, the holder of the international registration concerned may request the conversion of the designation of the said Contracting Organization into the designation of any Member State of that Organization which is party to the Agreement and/or the Protocol.

(b) A request for conversion under subparagraph (a) shall indicate the elements referred to in paragraph (3)(a)(i) to (iii) and (v), together with:

(i) the Contracting Organization whose designation is to be converted, and

(ii) where the subsequent designation of a Contracting State resulting from conversion is for all the goods and services listed in respect of the designation of the Contracting Organization, that fact, or, where the designation of that Contracting State is for only part of the goods and services listed in the designation of that Contracting Organization, those goods and services.

(8) *[Recording and Notification]* Where the International Bureau finds that the subsequent designation conforms to the applicable requirements, it shall record it in the International Register and shall notify accordingly the Office of the Contracting Party that has been designated in the subsequent designation and at the same time inform the holder and, if the subsequent designation was presented by an Office, that Office.

(9) *[Refusal]* Rules 16 to 18 shall apply *mutatis mutandis*.

(10) *[Subsequent Designation Not Considered as Such]* If the requirements of paragraph (2)(a) are not complied with, the subsequent designation shall not be considered as such and the International Bureau shall inform the sender accordingly.

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

(1) *[Presentation of the Request]*

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

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

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

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

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

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

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

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

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

(2) *[Contents of the Request]*

(a) The request for the recording of a change or the request for the recording of a cancellation shall, in addition to the requested change or cancellation, contain or indicate

(i) the number of the international registration concerned,

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

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

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

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

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

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

(b) The request for the recording of a change in the ownership of the international registration may also contain,

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

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

(c) The request for recording of a change or a cancellation may also contain a request that it be recorded before, or after, the recording of another change or cancellation or a subsequent designation in respect of the international registration concerned or after the renewal of the international registration.

(3) [*Request Not Admissible*] A change in the ownership of an international registration may not be recorded in respect of a given designated Contracting Party if that Contracting Party

(i) is bound by the Agreement but not by the Protocol, and the Contracting Party indicated under paragraph (2)(a)(iv) is not bound by the Agreement, or none of the Contracting Parties indicated under that paragraph is bound by the Agreement;

(ii) is bound by the Protocol but not by the Agreement, and the Contracting Party indicated under paragraph (2)(a)(iv) is not bound by the Protocol, or none of the Contracting Parties indicated under that paragraph is bound by the Protocol.

(4) [*Several Transferees*] Where the request for the recording of a change in the ownership of the international registration mentions several transferees, that change may not be recorded in respect of a given designated Contracting Party if any of the transferees does not fulfill the conditions to be holder of the international registration in respect of that Contracting Party.

## **Rule 26**

### **Irregularities in Requests for Recording of a Change and for Recording of a Cancellation**

(1) [*Irregular Request*] If the request for the recording of a change, or the request for the recording of a cancellation, referred to in Rule 25(1)(a) does not comply with the applicable requirements, and subject to paragraph (3), the International Bureau shall notify that fact to the holder and, if the request was made by an Office, to that Office.

(2) [*Time Allowed to Remedy Irregularity*] The irregularity may be remedied within three months from the date of the notification of the irregularity by the International Bureau. If the irregularity is not remedied within three months from the date of the notification of the irregularity by the International Bureau, the request shall be considered abandoned, and the International Bureau shall notify accordingly and at the same time the holder and, if the request for the recording of a change or the request for the recording of a cancellation was

presented by an Office, that Office, and refund any fees paid, after deduction of an amount corresponding to one-half of the relevant fees referred to in item 7 of the Schedule of Fees, to the party having paid those fees.

(3) *[Requests Not Considered as Such]* If the requirements of Rule 25(1)(b) or (c) are not complied with, the request shall not be considered as such and the International Bureau shall inform the sender accordingly.

**Rule 27**  
**Recording and Notification of a Change or of a Cancellation;**  
**Merger of International Registrations; Declaration That a Change in Ownership or a**  
**Limitation Has No Effect**

(1) *[Recording and Notification of a Change or of a Cancellation]*

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

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

(2) [Deleted]

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

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

(a) The Office of a designated Contracting Party which is notified, by the International Bureau, of a change in ownership affecting that Contracting Party may declare that the change in ownership has no effect in the said Contracting Party. The effect of such a declaration shall be that, with respect to the said Contracting Party, the international registration concerned shall remain in the name of the transferor.

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

(i) the reasons for which the change in ownership has no effect,

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

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

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

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

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

(5) *[Declaration That a Limitation Has No Effect]*

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

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

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

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

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

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

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

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

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

## **Rule 28**

### **Corrections in the International Register**

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

(2) [*Notification*] The International Bureau shall notify accordingly the holder and, at the same time, the Offices of the designated Contracting Parties in which the correction has effect. In addition, where the Office that has requested the correction is not the Office of a designated Contracting Party in which the correction has effect, the International Bureau shall also inform that Office.

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

(4) [*Time Limit for Correction*] Notwithstanding paragraph (1), an error which is attributable to an Office and the correction of which would affect the rights deriving from

the international registration may be corrected only if a request for correction is received by the International Bureau within nine months from the date of publication of the entry in the International Register which is the subject of the correction.

## **Chapter 6 Renewals**

### **Rule 29 Unofficial Notice of Expiry**

The fact that the unofficial notice referred to in Article 7(4) of the Agreement and Article 7(3) of the Protocol is not received shall not constitute an excuse for failure to comply with any time limit under Rule 30.

### **Rule 30 Details Concerning Renewal**

#### *(1) [Fees]*

(a) The international registration shall be renewed upon payment, at the latest on the date on which the renewal of the international registration is due, of

(i) the basic fee,

(ii) where applicable, the supplementary fee, and,

(iii) the complementary fee or individual fee, as the case may be, for each designated Contracting Party for which no refusal or invalidation is recorded in the International Register in respect of all the goods and services concerned, as specified or referred to in item 6 of the Schedule of Fees. However, such payment may be made within six months from the date on which the renewal of the international registration is due, provided that the surcharge specified in item 6.5 of the Schedule of Fees is paid at the same time.

(b) If any payment made for the purposes of renewal is received by the International Bureau earlier than three months before the date on which the renewal of the international registration is due, it shall be considered as having been received three months before the date on which renewal is due.

#### *(2) [Further Details]*

(a) Where the holder does not wish to renew the international registration in respect of a designated Contracting Party for which no refusal is recorded in the International Register in

respect of all the goods and services concerned, payment of the required fees shall be accompanied by a statement that the renewal of the international registration is not to be recorded in the International Register in respect of that Contracting Party.

(b) Where the holder wishes to renew the international registration in respect of a designated Contracting Party notwithstanding the fact that a refusal is recorded in the International Register for that Contracting Party in respect of all the goods and services concerned, payment of the required fees, including the complementary fee or individual fee, as the case may be, for that Contracting Party, shall be accompanied by a statement that the renewal of the international registration is to be recorded in the International Register in respect of that Contracting Party.

(c) The international registration may not be renewed in respect of any designated Contracting Party in respect of which an invalidation has been recorded for all goods and services under Rule 19(2) or in respect of which a renunciation has been recorded under Rule 27(1)(a). The international registration may not be renewed in respect of any designated Contracting Party for those goods and services in respect of which an invalidation of the effects of the international registration in that Contracting Party has been recorded under Rule 19(2) or in respect of which a limitation has been recorded under Rule 27(1)(a).

(d) The fact that the international registration is not renewed in respect of all of the designated Contracting Parties shall not be considered to constitute a change for the purposes of Article 7(2) of the Agreement or Article 7(2) of the Protocol.

### (3) *[Insufficient Fees]*

(a) If the amount of the fees received is less than the amount of the fees required for renewal, the International Bureau shall promptly notify at the same time both the holder and the representative, if any, accordingly. The notification shall specify the missing amount.

(b) If the amount of the fees received is, on the expiry of the period of six months referred to in paragraph (1)(a), less than the amount required under paragraph (1), the International Bureau shall not, subject to subparagraph (c), record the renewal, and shall reimburse the amount received to the party having paid it and notify accordingly the holder and the representative, if any.

(c) If the notification referred to in subparagraph (a) was sent during the three months preceding the expiry of the period of six months referred to in paragraph (1)(a) and if the amount of the fees received is, on the expiry of that period, less than the amount required under paragraph (1) but is at least 70% of that amount, the International Bureau shall proceed as provided in Rule 31(1) and (3). If the amount required is not fully paid within three months from the said notification, the International Bureau shall cancel the renewal, notify accordingly the holder, the representative, if any, and the Offices which had been notified of the renewal, and reimburse the amount received to the party having paid it.

(4) *[Period for Which Renewal Fees Are Paid]* The fees required for each renewal shall be paid for ten years, irrespective of the fact that the international registration contains, in the list of designated Contracting Parties, only Contracting Parties whose designation is governed by the Agreement, only Contracting Parties whose designation is governed by the Protocol, or both Contracting Parties whose designation is governed by the Agreement and Contracting Parties whose designation is governed by the Protocol. As regards payments under the Agreement, the payment for ten years shall be considered to be a payment for an instalment of ten years.

### **Rule 31** **Recording of the Renewal; Notification and Certificate**

(1) *[Recording and Effective Date of the Renewal]* Renewal shall be recorded in the International Register with the date on which renewal was due, even if the fees required for renewal are paid within the period of grace referred to in Article 7(5) of the Agreement and in Article 7(4) of the Protocol.

(2) *[Renewal Date in the Case of Subsequent Designations]* The effective date of the renewal shall be the same for all designations contained in the international registration, irrespective of the date on which such designations were recorded in the International Register.

(3) *[Notification and Certificate]* The International Bureau shall notify the Offices of the designated Contracting Parties concerned of the renewal and shall send a certificate to the holder.

(4) *[Notification in Case of Non-Renewal]*

(a) Where an international registration is not renewed, the International Bureau shall notify accordingly the Offices of all of the Contracting Parties designated in that international registration.

(b) Where an international registration is not renewed in respect of a designated Contracting Party, the International Bureau shall notify the Office of that Contracting Party accordingly.

## **Chapter 7** **Gazette and Data Base**

### **Rule 32** **Gazette**

(1) *[Information Concerning International Registrations]*

(a) The International Bureau shall publish in the Gazette relevant data concerning

(i) international registrations effected under Rule 14;

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

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

(iv) renewals recorded under Rule 31(1);

(v) subsequent designations recorded under Rule 24(8);

(vi) continuation of effects of international registrations under Rule 39;

(vii) changes in ownership, limitations, renunciations and changes of name or address of the holder recorded under Rule 27;

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

(ix) corrections effected under Rule 28;

(x) invalidations recorded under Rule 19(2);

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

(xii) international registrations which have not been renewed.

(b) The reproduction of the mark shall be published as it appears in the international application. Where the applicant has made the declaration referred to in Rule 9(4)(a)(vi), the publication shall indicate that fact.

(c) Where a color reproduction of the mark is furnished under Rule 9(4)(a)(v) or (vii), the Gazette shall contain both a reproduction of the mark in black and white and the reproduction in color.

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

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

(ii) any declarations made under Article 5(2)(b) or Article 5(2)(b) and (c), first sentence, of the Protocol;

(iii) any declarations made under Article 8(7) of the Protocol;

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

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

*(3) [Number of Copies for Offices of Contracting Parties]*

(a) The International Bureau shall send to the Office of each Contracting Party copies of the Gazette. Each Office shall be entitled, free of charge, to two copies and, where during a given calendar year the number of designations recorded with respect to the Contracting Party concerned has exceeded 2,000, in the following year one additional copy and further additional copies for every 1,000 designations in excess of 2,000. Each Contracting Party may purchase every year, at half of the subscription price, the same number of copies as that to which it is entitled free of charge.

(b) If the Gazette is available in more than one form, each Office may choose the form in which it wishes to receive any copy to which it is entitled.

**Rule 33**  
**Electronic Data Base**

(1) *[Contents of Data Base]* The data which are both recorded in the International Register and published in the Gazette under Rule 32 shall be entered in an electronic data base.

(2) *[Data Concerning Pending International Applications and Subsequent Designations]* If an international application or a designation under Rule 24 is not recorded in the International Register within three working days following the receipt by the International Bureau of the international application or designation, the International Bureau shall enter in the electronic data base, notwithstanding any irregularities that may exist in the international application or designation as received, all the data contained in the international application or designation.

(3) *[Access to Electronic Data Base]* The electronic data base shall be made accessible to the Offices of the Contracting Parties and, against payment of the prescribed fee, if any, to the public, by on-line access and through other appropriate means determined by the International Bureau. The cost of accessing shall be borne by the user. Data entered under paragraph (2) shall be accompanied by a warning to the effect that the International Bureau has not yet made a decision on the international application or on the designation under Rule 24.

## **Chapter 8 Fees**

### **Rule 34 Amounts and Payment of Fees**

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

(2) [*Payments*]

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

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

(3) [*Individual Fee Payable in Two Parts*]

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

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

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

(i) the number of the international registration concerned,

(ii) the name of the holder,

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

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

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

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

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

(i) before international registration, of the name of the applicant, the mark concerned and the purpose of the payment;

(ii) after international registration, of the name of the holder, the number of the international registration concerned and the purpose of the payment.

(6) [*Date of Payment*]

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

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

(7) [*Change in the Amount of the Fees*]

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

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

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

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

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

## **Rule 35**

### **Currency of Payments**

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

(2) [*Establishment of the Amount of Individual Fees in Swiss Currency*]

(a) Where a Contracting Party makes a declaration under Article 8(7)(a) of the Protocol that it wants to receive an individual fee, the amount of the individual fee indicated to the International Bureau shall be expressed in the currency used by its Office.

(b) Where the fee is indicated in the declaration referred to in subparagraph (a) in a currency other than Swiss currency, the Director General shall, after consultation with the Office of the Contracting Party concerned, establish the amount of the individual fee in Swiss currency on the basis of the official exchange rate of the United Nations.

(c) Where, for more than three consecutive months, the official exchange rate of the United Nations between the Swiss currency and the other currency in which the amount of an individual fee has been indicated by a Contracting Party is higher or lower by at least 5% than the last exchange rate applied to establish the amount of the individual fee in Swiss currency, the Office of that Contracting Party may ask the Director General to establish a new amount of the individual fee in Swiss currency according to the official exchange rate

of the United Nations prevailing on the day preceding the day on which the request is made. The Director General shall proceed accordingly. The new amount shall be applicable as from a date which shall be fixed by the Director General, provided that such date is between one and two months after the date of the publication of the said amount in the Gazette.

(d) Where, for more than three consecutive months, the official exchange rate of the United Nations between the Swiss currency and the other currency in which the amount of an individual fee has been indicated by a Contracting Party is lower by at least 10% than the last exchange rate applied to establish the amount of the individual fee in Swiss currency, the Director General shall establish a new amount of the individual fee in Swiss currency according to the current official exchange rate of the United Nations. The new amount shall be applicable as from a date which shall be fixed by the Director General, provided that such date is between one and two months after the date of the publication of the said amount in the Gazette.

### **Rule 36 Exemption From Fees**

Recording of the following shall be exempt from fees:

- (i) the appointment of a representative, any change concerning a representative and the cancellation of the recording of a representative,
- (ii) any change concerning the telephone and telefacsimile numbers of the holder,
- (iii) the cancellation of the international registration,
- (iv) any renunciation under Rule 25(1)(a)(iii),
- (v) any limitation effected in the international application itself under Rule 9(4)(a)(xiii) or in a subsequent designation under Rule 24(3)(a)(iv),
- (vi) any request by an Office under Article 6(4), first sentence, of the Agreement or Article 6(4), first sentence, of the Protocol,
- (vii) the existence of a judicial proceeding or of a final decision affecting the basic application, or the registration resulting therefrom, or the basic registration,
- (viii) any refusal under Rule 17, Rule 24(9) or Rule 28(3), any statement under Rule 17(5) or (6) or any declaration under Rule 20*bis*(5) or Rule 27(4) or (5),
- (ix) the invalidation of the international registration,
- (x) information communicated under Rule 20,

- (xi) any notification under Rule 21 or Rule 23,
- (xii) any correction in the International Register.

**Rule 37**  
**Distribution of Supplementary Fees**  
**and Complementary Fees**

(1) The coefficient referred to in Article 8(5) and (6) of the Agreement and Article 8(5) and (6) of the Protocol shall be as follows:

for Contracting Parties which examine only for absolute grounds of refusal..... two for Contracting Parties which also examine for prior rights:

(a) following opposition by third parties..... three

(b) *ex officio*..... four

(2) Coefficient four shall also be applied to Contracting Parties which carry out *ex officio* searches for prior rights with an indication of the most significant prior rights.

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

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

**Chapter 9**  
**Miscellaneous**

**Rule 39**  
**Continuation of Effects of International Registrations**  
**in Certain Successor States**

(1) Where any State (“the successor State”) whose territory was, before the independence of that State, part of the territory of a Contracting Party (“the predecessor Contracting Party”) has deposited with the Director General a declaration of continuation the effect of which is that the Agreement, the Protocol, or both the Agreement and the Protocol are applied by the successor State, the effects in the successor State of any international registration with a territorial extension to the predecessor Contracting Party which is effective from a date prior to the date fixed under paragraph (2) shall be subject to

(i) the filing with the International Bureau, within six months from the date of a notice addressed for that purpose by the International Bureau to the holder of the international registration concerned, of a request that such international registration continue its effects in the successor State, and

(ii) the payment to the International Bureau, within the same time limit, of a fee of 41 Swiss francs, which shall be transferred by the International Bureau to the Office of the successor State, and of a fee of 23 Swiss francs for the benefit of the International Bureau.

(2) The date referred to in paragraph (1) shall be the date notified by the successor State to the International Bureau for the purposes of this Rule, provided that such date may not be earlier than the date of independence of the successor State.

(3) The International Bureau shall, upon receipt of the request and the fees referred to in paragraph (1), notify the Office of the successor State and make the corresponding recording in the International Register.

(4) With respect to any international registration concerning which the Office of the successor State has received a notification under paragraph (3), that Office may only refuse protection if the applicable time limit referred to in Article 5(2) of the Agreement or in Article 5(2)(a), (b) or (c) of the Protocol has not expired with respect to the territorial extension to the predecessor Contracting Party and if the notification of refusal is received by the International Bureau within that time limit.

(5) This Rule shall not apply to the Russian Federation, nor to a State which has deposited with the Director General a declaration according to which it continues the legal personality of a Contracting Party.

#### **Rule 40** **Entry into Force; Transitional Provisions**

(1) [*Entry into Force*] These Regulations shall enter into force on April 1, 1996, and shall, as of that date, replace the Regulations under the Agreement as in force on March 31, 1996 (hereinafter referred to as “the Regulations under the Agreement”).

*(2) [General Transitional Provisions]*

(a) Notwithstanding paragraph (1),

(i) an international application the request for presentation to the International Bureau of which was received, or is deemed to have been received under Rule 11(1)(a) or (c), by the Office of origin before April 1, 1996, shall, to the extent that it conforms to the requirements of the Regulations under the Agreement, be deemed to conform to the applicable requirements for the purposes of Rule 14;

(ii) a request for the recording of a change under Rule 20 of the Regulations under the Agreement sent by the Office of origin or by another interested Office to the International Bureau before April 1, 1996, or, where such date can be identified, whose date of receipt by the Office of origin or by another interested Office for presentation to the International Bureau is earlier than April 1, 1996, shall, to the extent that it conforms to the requirements of the Regulations under the Agreement, be deemed to conform to the applicable requirements for the purposes of Rule 24(7) or to be in order for the purposes of Rule 27;

(iii) an international application, or a request for the recording of a change under Rule 20 of the Regulations under the Agreement, that, before April 1, 1996, has been the subject of any action by the International Bureau under Rules 11, 12, 13 or 21 of the Regulations under the Agreement, shall continue to be processed by the International Bureau under the said Rules; the date of the resulting international registration or recording in the International Register shall be governed by Rule 15 or 22 of the Regulations under the Agreement;

(iv) a notification of refusal or a notification of invalidation sent by the Office of a designated Contracting Party before April 1, 1996, shall, to the extent that it conforms to the requirements of the Regulations under the Agreement, be deemed to conform to the applicable requirements for the purposes of Rule 17(4) and (5) or of Rule 19(2).

(b) For the purposes of Rule 34(7), the fees valid at any date before April 1, 1996, shall be the fees prescribed by Rule 32 of the Regulations under the Agreement.

(c) Notwithstanding Rule 10(1), where, in accordance with Rule 34(7)(a), the fees paid in respect of the filing of an international application are the fees prescribed for 20 years by Rule 32 of the Regulations under the Agreement, no second instalment shall be due.

(d) Where, in accordance with Rule 34(7)(b), the fees paid in respect of a subsequent designation are the fees prescribed by Rule 32 of the Regulations under the Agreement, paragraph (3) shall not apply.

*(3) [Transitional Provisions Applicable to International Registrations for Which Fees Have Been Paid for 20 Years]*

(a) Where an international registration for which the required fees had been paid for 20 years is the subject of a subsequent designation under Rule 24 and where the current

term of protection of that international registration expires more than ten years after the effective date of the subsequent designation as determined in accordance with Rule 24(6), the provisions of subparagraphs (b) and (c) shall apply.

(b) Six months before the expiry of the first period of ten years of the current term of protection of the international registration, the International Bureau shall send to the holder and his representative, if any, a notice indicating the exact date of expiry of the first period of ten years and the Contracting Parties which were the subject of subsequent designations referred to in subparagraph (a). Rule 29 shall apply *mutatis mutandis*.

(c) Payment of complementary and individual fees corresponding to the fees referred to in Rule 30(1)(iii) shall be required for the second period of ten years in respect of the subsequent designations referred to in subparagraph (a). Rule 30(1) and (3) shall apply *mutatis mutandis*.

(d) The International Bureau shall record in the International Register the fact that payment has been made to the International Bureau for the second period of ten years. The date of recording shall be the date of expiry of the first period of ten years, even if the fees required are paid within the period of grace referred to in Article 7(5) of the Agreement and in Article 7(4) of the Protocol.

(e) The International Bureau shall notify the Offices of the designated Contracting Parties concerned of the fact that payment has or has not been made for the second period of ten years and shall at the same time inform the holder.

(4) [*Transitional Provisions Concerning Languages*]

(a) Rule 6 as in force before April 1, 2004, shall continue to apply to any international application filed before that date and to any international application governed exclusively by the Agreement filed between that date and August 31, 2008, inclusively, to any communication relating thereto and to any communication, recording in the International Register or publication in the Gazette relating to the international registration resulting therefrom, unless

(i) the international registration has been the subject of a subsequent designation under the Protocol between April 1, 2004, and August 31, 2008; or

(ii) the international registration is the subject of a subsequent designation on or after September 1, 2008; and

(iii) the subsequent designation is recorded in the International Register.

(b) For the purposes of this paragraph, an international application is deemed to be filed on the date on which the request to present the international application to the International Bureau is received, or deemed to have been received under Rule 11(1)(a) or (c), by the Office of origin, and an international registration is deemed to be the

subject of a subsequent designation on the date on which the subsequent designation is presented to the International Bureau, if it is presented directly by the holder, or on the date on which the request for presentation of the subsequent designation is filed with the Office of the Contracting Party of the holder if it is presented through the latter.

## **Rule 41**

### **Administrative Instructions**

(1) *[Establishment of Administrative Instructions; Matters Governed by Them]*

(a) The Director General shall establish Administrative Instructions. The Director General may modify them. Before establishing or modifying the Administrative Instructions, the Director General shall consult the Offices which have a direct interest in the proposed Administrative Instructions or their proposed modification.

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

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

(3) *[Publication and Effective Date]*

(a) The Administrative Instructions and any modification thereof shall be published in the Gazette.

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

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

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<sup>1</sup> Paragraph (1) of Rule 7 read:

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

<sup>2</sup> Interpretative statement endorsed by the Assembly of the Madrid Union:

“The reference in Rule 17(5)(b) to a further decision that affects the protection of the mark includes also the case where that further decision is taken by the Office, for example in the case of *restitutio in integrum*, notwithstanding the fact that the Office has already stated that the procedures before the Office have been completed.”

<sup>3</sup> Interpretative statement endorsed by the Assembly of the Madrid Union:

“The references in Rule 17(6)(a)(ii) and (iii) to observations by third parties apply only to those Contracting Parties whose legislation provides for such observations.”

<sup>4</sup> Interpretative statement endorsed by the Assembly of the Madrid Union:

“Where a request to record a license does not include the indication, provided for in Rule 20*bis*(1)(c)(v), that the license is exclusive or sole, it may be considered that the license is non-exclusive.”

<sup>5</sup> Interpretative statement endorsed by the Assembly of the Madrid Union:

“Subparagraph (a) of Rule 20*bis*(6) deals with the case of a notification by a Contracting Party whose law does not provide for the recording of trademark licenses; such a notification may be made at any time; subparagraph (b) on the other hand deals with the case of a notification by a Contracting Party whose law does provide for the recording of trademark licenses but which is unable at present to give effect to the recording of a license in the International Register; this latter notification, which may be withdrawn at any time, may only be made before this Rule has come into force or before the Contracting Party has become bound by the Agreement or the Protocol.”