

# **[COUNTRY]: Model Provisions for the Implementation of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks**

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**PART II. MODEL PROVISIONS FOR THE IMPLEMENTATION OF THE MADRID PROTOCOL IN [COUNTRY]**

**CHAPTER I. PRELIMINARY**

**1. Definitions**

For the purpose of these Rules, the following expressions shall have the meanings ascribed thereto hereunder, unless the context otherwise requires:

- (i) “Law” means the Law on Marks;
- (ii) “Madrid Protocol” means the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted in Madrid on June 27, 1989, as amended;
- (iii) “Regulations under the Protocol” means the Regulations under the Madrid Protocol;
- (iv) “International Bureau” means the International Bureau of the World Intellectual Property Organization;
- (v) “International Register” means the register of the International Bureau;
- (vi) “international application” means an application for the registration of a mark in the International Register;
- (vii) “applicant” means the person in whose name an international application is filed;
- (viii) “Office” means the administration in charge of registering marks in [COUNTRY];
- (ix) “basic registration” means the registration of a mark, made by the Office under the Law, which is used as the basis to file an international application;
- (x) “basic application” means an application for the registration of a mark, filed with the Office under the Law, which is used as the basis to file an international application;
- (xi) “Office of origin” means the Office through which the international application is filed in accordance with Article 2(2) of the Madrid Protocol;
- (xii) “international registration” means the registration of a mark in the International Register;
- (xiii) “holder” means the person in whose name the international registration is recorded in the International Register;
- (xiv) “Contracting Party” means any country or intergovernmental organization party to the Madrid Protocol;

- (xv) “Contracting Party of the holder” means the Contracting Party of the Office of origin or, where a change in ownership has been recorded in the International Register, the Contracting Party in respect of which the new holder meets the requirements under Article 2 of the Madrid Protocol;
- (xvi) “designation”, with its grammatical variations, means a request for the extension of protection under Article 3<sup>ter</sup>(1) or (2) of the Madrid Protocol, as the case may be; it also means such extension as recorded in the International Register;
- (xvii) “designated Contracting Party” means a Contracting Party for which an extension of protection has been requested under Article 3<sup>ter</sup>(1) or (2) of the Madrid Protocol, as the case may be, or in respect of which such extension has been recorded in the International Register;
- (xviii) “invalidation” means a final decision by a competent authority revoking or invalidating the effects of an international registration in [COUNTRY] in respect of all or some of the goods or services covered by the designation of [COUNTRY].

## **2. General**

- (1) The provisions of the Law shall apply, *mutatis mutandis*, to marks in international registrations in which [COUNTRY] is a designated Contracting Party.
- (2) In case of conflict between, on the one hand, the provisions in the Law and, on the other hand, the provisions in the Madrid Protocol or in the Regulations under the Protocol, the provisions in the Madrid Protocol and in the Regulations under the Protocol shall prevail.

## **3. Language**

- (1) International applications filed through the Office shall be in [LANGUAGE].
- (2) Any communication concerning an international application or an international registration between the International Bureau and the Office shall be in [LANGUAGE].

## **4. Fees**

Any fee to be paid by the applicant to the Office shall be specified in [...].

## **5. Calculation of Time Limits**

Any time limit afforded to the holder of an international registration in which [COUNTRY] is a designated Contracting Party and indicated or specified in a communication from the Office to the International Bureau shall be counted from the date on which the International Bureau transmits such communication to the holder.

## **6. Further Details**

Further details concerning international applications filed through the intermediary of the Office and international registrations in which [COUNTRY] is a designated Contracting Party may be included in instructions issued by the Office.

## CHAPTER II. INTERNATIONAL APPLICATIONS

### **7. International Applications**

- (1) The person in whose name is the basic registration or basic application, as the case may be, is entitled to file an international application through the intermediary of the Office, acting as the Office of origin, provided such person:
  - (i) has a real and effective industrial or commercial establishment in [COUNTRY]; or,
  - (ii) is domiciled in [COUNTRY]; or,
  - (iii) is a national of [COUNTRY].
- (2) [An international application filed through the intermediary of the Office shall be subject to the payment of a certification and transmittal fee.]

### **8. Examination of International Applications**

The Office shall examine the international application to confirm that, in accordance with the provisions of the Madrid Protocol and the Regulations under the Protocol:

- (1) it may be considered as the Office of origin in respect of that international application; and,
- (2) the relevant particulars appearing in the international application correspond to those appearing in the basic registration or basic application, as the case may be.

### **9. Certification and Transmittal**

- (1) Where the international application complies with the prescribed requirements, the Office shall certify the international application, indicate the date on which it received the international application and transmit it to the International Bureau.
- (2) Where the international application does not comply with the prescribed requirements, the Office shall not transmit the international application to the International Bureau and shall notify the applicant accordingly.
- (3) The international application shall be deemed abandoned if the applicant fails to remedy any of the deficiencies notified under paragraph (2) within [X] months from the date of their notification.

### **10. Irregularities in International Applications**

Where the International Bureau notifies the Office of an irregularity in an international application that the Office must remedy, it shall respond to the notification in accordance with the Regulations under the Protocol and, where applicable, remedy the irregularity in consultation with the applicant.

## **11. Ceasing of Effect of the Basic Registration or Basic Application**

Where Article 6(3) and (4) of the Madrid Protocol apply, the Office shall notify the International Bureau, in the manner prescribed in the Madrid Protocol and in the Regulations under the Protocol, and request that the International Bureau cancel, to the extent applicable, the international registration concerned.

### CHAPTER III. INTERNATIONAL REGISTRATIONS IN WHICH [COUNTRY] IS A DESIGNATED CONTRACTING PARTY

## **12. International Registrations**

- (1) As from the date of the international registration or of the recording of the designation of [COUNTRY] under Article 3ter(2) of the Madrid Protocol, as the case may be, a mark that is the subject of an international registration in which [COUNTRY] is a designated Contracting Party shall have the same protection as a mark that is the subject of an application made with the Office under the Law.
- (2) A[s from the same date referred to in paragraph (1), a] mark that is the subject of an international registration in which [COUNTRY] is a designated Contracting Party shall have the same protection as a mark registered under the Law where the Office has
  - (i) informed the International Bureau that the mark has been granted protection in [COUNTRY], in the manner prescribed in the Regulations under the Protocol;
  - (ii) failed to notify the International Bureau a refusal against that mark in accordance with Article 5(1) and (2) of the Madrid Protocol; or,
  - (iii) withdrawn a refusal against that mark notified to the International Bureau in accordance with Article 5(1) and (2) of the Madrid Protocol.
- (3) Marks in international registrations in which [COUNTRY] is a designated Contracting Party shall enjoy the right of priority provided for in Article 4 of the Paris Convention and are exempt from the need to comply with the formalities prescribed in Section D of that Article.
- (4) Where, in accordance with the Law, documentary evidence of the legitimate use of certain elements of a mark that is the subject of an international registration in which [COUNTRY] is a designated Contracting Party is required, such documentary evidence shall be exempt from any legalization or certification, other than that of the Office of origin.

## **13. Ex Officio Provisional Refusal**

- (1) Where, in accordance with the Law, the Office declines to grant protection to the mark that is the subject of an international registration in which [COUNTRY] is a designated Contracting Party or suspends proceedings for such mark pending the satisfaction of a given condition, the Office shall notify the International Bureau a provisional refusal of protection, in the manner prescribed in the Madrid Protocol and in the Regulations under the Protocol, before the period specified in Article 5(2)(b) of the Madrid Protocol expires.
- (2) The holder of the international registration concerned shall enjoy the same remedies as if the mark had been the subject of an application made with the Office under the Law.

**14. Publication of Marks in International Registrations: Opposition**

- (1) Where the Office has accepted a mark that is the subject of an international registration in which [COUNTRY] is a designated Contracting Party, it shall publish such mark *ex officio*, in the manner prescribed in the Law.
- (2) Opposition to a mark that is the subject of an international registration in which [COUNTRY] is a designated Contracting Party shall be governed by the provisions of the Law regarding opposition, *mutatis mutandis*.

**15. Possible Notification of Provisional Refusal Based on Opposition in Accordance with Article 5(2)(c) of the Madrid Protocol**

The Office shall inform the International Bureau, in the manner prescribed in the Madrid Protocol and in the Regulations under the Protocol, where the period to submit an opposition against a mark that is the subject of an international registration in which [COUNTRY] is a designated Contracting Party will end either

- (i) after the period specified in Article 5(2)(b) of the Madrid Protocol; or,
- (ii) too late for the Office to send a notification under Section 16(1) of these Rules within that period.

**16. Provisional Refusal Based on an Opposition**

Where an interested party submits a grounded opposition to the Office against a mark that is the subject of an international registration in which [COUNTRY] is a designated Contracting Party and a notification under Section 13(1) of these Rules has not been inscribed in the International Register, the Office shall, before the period specified in Article 5(2)(b) of the Madrid Protocol expires or in accordance with Article 5(2)(c) of the Madrid Protocol, as the case may be, notify that fact to the International Bureau as a provisional refusal based on an opposition, in the manner prescribed in the Madrid Protocol and in the Regulations under the Protocol.

**17. No Grounds for Refusal; Statement of Grant of Protection**

Where the Office has accepted a mark that is the subject of an international registration in which [COUNTRY] is a designated Contracting Party and no opposition has been submitted against that mark within the prescribed period, the Office shall, as soon as possible and before the period applicable specified in Article 5(2)(b) of the Madrid Protocol expires, send to the International Bureau a statement to the effect that protection is granted to the mark in [COUNTRY], in the manner prescribed in the Regulations under the Madrid Protocol.

**18. Final Decision by the Office Following the Recording of a Notification of Provisional Refusal**

- (1) Where a notification sent by the Office under Section 13(1) or Section 16 of these Rules has been inscribed in the International Register and, after all the procedures before the Office have been completed, the Office has decided to grant protection to the mark, it shall, in the manner prescribed in the Regulations under the Protocol, send to the International Bureau either
  - (i) a statement to the effect that the provisional refusal is withdrawn and that protection is granted in [COUNTRY] for all the goods and services for which such protection had been requested, or,

- (ii) where protection has been granted for some goods and services only, a statement indicating the goods and services for which protection is granted in [COUNTRY].
- (2) Where a notification sent by the Office under Sections 13(1) or Section 16 of these Rules refusing protection to the mark in [COUNTRY] for all goods and services concerned has been inscribed in the International Register and, after all the procedures before the Office have been completed, the Office has decided to confirm such refusal, it shall send to the International Bureau a statement to that effect, in the manner prescribed in the Regulations under the Protocol.

## 19. Appeals

Any concerned party may appeal decisions made by the Office in respect of marks in international registrations in which [COUNTRY] is a designated Contracting Party before the competent court. The provisions of the Law regarding appeals shall apply *mutatis mutandis*.

## 20. Further Decision Affecting Protection of a Mark

Where

- (i) a notification of provisional refusal has not been recorded in the International Register and the period specified in Article 5(2)(b) of the Madrid Protocol has expired; or,
- (ii) following the recording in the International Register of a statement sent by the Office in accordance with Sections 17 or 18 of these Rules,

a further decision, taken by the Office or other competent authority, affects the protection of a mark in an international registration in which [COUNTRY] is a designated Contracting Party, the Office shall, to the extent that it is aware of such decision and without prejudice to Section 21 of these Rules, send to the International Bureau a further statement indicating the status of the mark and, where applicable, the goods and services for which the mark is protected in [COUNTRY], in the manner prescribed in the Regulations under the Protocol.

## 21. Invalidation

Where a decision by the Office or other competent authority, pronounced with the holder having been afforded, in good time, the opportunity to defend his rights, revokes or invalidates the effects of an international registration in [COUNTRY] in respect of all or some of the goods and services concerned and this decision is no longer subject to appeal, the Office shall, provided it is aware of such decision, notify the International Bureau of such decision, in the manner prescribed in the Madrid Protocol and the Regulations under the Protocol.

## 22. Renewal of International Registrations in Which [Country] is a Designated Contracting Party; Recordings in the International Register

- (1) International registrations that, in accordance with Article 7 of the Madrid Protocol, have been renewed in respect of [COUNTRY] as a designated Contracting Party shall continue to have effect in [COUNTRY].
- (2) Any recording made in the International Register in respect of an international registration shall, to the extent that it applies to [COUNTRY] as a designated Contracting Party, have the same effect as if it had been recorded by the Office.



- (3) Where, under the laws of [COUNTRY], the Office considers that the recording referred to in paragraph (2) has no effect in [COUNTRY], the Office shall, where so provided for in the Regulations under the Protocol, send to the International Bureau a statement to this effect, in the manner prescribed in the Regulations under the Protocol.
- (4) Where there is a final decision concerning a statement sent under paragraph (3), the Office, provided it is aware of such final decision, shall send to the International Bureau a notification either confirming or withdrawing that statement, in the manner prescribed in the Regulations under the Protocol.

### **23. Collective Marks; Certification Marks**

- (1) Collective marks and certification marks that are the subject of international registrations in which [COUNTRY] is a designated Contracting Party shall be governed by the provisions in the Law regarding such marks, *mutatis mutandis*.
- (2) Where an international registration in which [COUNTRY] is a designated Contracting Party is for a collective mark or a certification mark, the holder of that international registration shall submit the regulations governing the use of such mark directly to the Office within the prescribed time limit.

### **24. Division and Merger of International Registrations**

- (1) The holder of an international registration in which [COUNTRY] is a designated Contracting Party may present a request for the division of that international registration in respect of [COUNTRY] through the intermediary of the Office.
- (2) The holder of an international registration that resulted from the recording of division following a request sent by the Office under paragraph (1), may present a request for the merger of that international registration with the international registration it was divided from through the intermediary of the Office.
- (3)
  - (a) [A request presented under paragraphs (1) or (2) shall be subject to the payment of the fee, as may be prescribed.]
  - (b) The Office shall verify that a request presented under paragraph (1) or (2) complies with the requirements prescribed in the Law [, including the payment of the fee].
  - (c) The Office shall forward to the International Bureau requests presented under paragraph (1) or (2) that comply with the prescribed requirements.
  - (d) The Office shall not forward to the International Bureau requests presented under paragraph (1) or (2) that do not comply with the prescribed requirements, and shall notify the holder accordingly.
  - (e) A request presented under paragraph (1) or (2) shall be deemed abandoned if the applicant fails to remedy any of the deficiencies notified under subparagraph (d) within [X] months from the date of their notification.

- (f) Where the International Bureau notifies the Office of an irregularity in a request presented under paragraph (1) or (2) and which the Office must remedy, it shall do so, in consultation with the holder, in the manner prescribed in the Regulations under the Protocol.

## **25. Replacement**

Where Article 4*bis*(1) of the Madrid Protocol applies, the international registration in which [COUNTRY] is a designated Contracting Party is deemed to have replaced, to the applicable extent, the registration effected under the Law as from the date of the international registration or of the recording of the designation of [COUNTRY] under Article 3*ter*(2) of the Madrid Protocol, as the case may be.

## **26. Request to Take Note Under Article 4*bis*(2) of the Madrid Protocol**

- (1) (a) Where:
- (i) a mark registered in [COUNTRY] under the Law is also the subject of an international registration designating [COUNTRY], and
  - (ii) the same person is recorded as the holder of the registration in [COUNTRY] and of the international registration in which [COUNTRY] is a designated Contracting Party, and
  - (iii) the date of the international registration or of the recording of the designation of [COUNTRY] under Article 3*ter*(2) of the Madrid Protocol, as the case may be, is later than the date of the registration in [COUNTRY], and
  - (iv) all or some of the goods and services listed in the registration in [COUNTRY] are equivalent to those for which the international registration has effects [COUNTRY],
- the holder of the international registration may request the Office to take note of that international registration in its Register.
- (b) A request filed with the Office in accordance with paragraph (a) shall be made in writing.
- (2) Where the Office has taken note of an international registration in accordance with paragraph (1)(a), the Office shall notify the International Bureau accordingly, in the manner prescribed in the Regulations under the Protocol.
- (3) [A request made under Article 4*bis*(2) of the Madrid Protocol shall be subject to the payment of a fee.]

## **27. Transformation**

- (1) (a) An application in accordance with Article 9*quinquies* of the Madrid Protocol, hereinafter referred to as an application resulting from transformation, may be made with the Office provided such application is made
- (i) within three months from the date on which the international registration was cancelled in accordance with Article 6(4) of the Madrid Protocol;

- (ii) by the person who was the holder of the international registration on the day on which the international registration was cancelled;
    - (iii) for the mark that was the subject of the cancelled international registration; and,
    - (iv) for the goods and services affected by the cancellation and for which the international registration had effects in [COUNTRY].
  - (b) Subject to paragraphs (2) and (3), the provisions applicable to an application for the registration of a mark made directly with the Office shall apply *mutatis mutandis* to an application resulting from transformation.
- (2) (a) An application resulting from transformation shall be made in the form, as set out in Form [...] and shall, in addition, include the following:
- (i) a statement that the application is made by way of transformation,
  - (ii) the number of the international registration which has been cancelled,
  - (iii) the date of the said international registration or of the recording of the designation of [COUNTRY] under Article 3<sup>ter</sup>(2) of the Madrid Protocol, as the case may be,
  - (iv) the date on which the international registration was cancelled,
  - (v) where applicable, the date of any priority claimed in the international application and recorded in the International Register.
- (b) [An application resulting from transformation shall be subject to the payment of the prescribed fee for an application for the registration of a mark made with the Office.]
- (3) (a) Where a mark that is the subject of an international registration has become protected in [COUNTRY] on or before the date on which the international registration was cancelled and, provided that all the requirements relating to an application resulting from transformation have been met, that mark shall be registered by the Office. The date of registration shall be the date of the cancelled international registration or of the recording of the designation of [COUNTRY] under Article 3<sup>ter</sup>(2) of the Madrid Protocol, as the case may be, and that registration shall enjoy any priority enjoyed by the cancelled international registration.
- (b) Where a mark that is the subject of an international registration has not yet become protected in [COUNTRY] on or before the date on which the international registration was cancelled, any procedures or measures already undertaken for the purpose of the international registration on or before the date on which an application resulting from transformation is filed shall be considered as having been undertaken for the purposes of the application resulting from transformation. The filing date of the application resulting from transformation shall be the date of the cancelled international registration or of the recording of the designation of [COUNTRY] under Article 3<sup>ter</sup>(2) of the Madrid Protocol, as the case may be.

## CHAPTER IV. FINAL PROVISIONS

**28. Irregularities in Communications Sent by the Office to the International Bureau**

Without prejudice to Section 10 of the Rules, where the International Bureau notifies the Office that a communication sent in accordance with these Rules is irregular or cannot be considered as such, the Office shall either remedy that communication or, where possible, send a new communication to the International Bureau in the manner prescribed in the Regulations under the Protocol.

**29. Restriction of the Holder's Right of Disposal**

- (1) At the request of the holder or of any person concerned or when so ordered by the Court, the Office may present to the International Bureau a request for the recording in the International Register of a restriction of the holders' right of disposal, in the manner prescribed in the Regulations under the Protocol, where [COUNTRY] is:
  - (i) the Contracting Party of the holder of an international registration; or,
  - (ii) a designated Contracting Party in an international registration for a mark that has been the subject of a restriction in respect of [COUNTRY] only.
- (2) At the request of the holder or of any person concerned or when so ordered by the Court, the Office shall present to the International Bureau, in the manner prescribed in the Regulations under the Protocol, a request for the removal, to the extent applicable, of a restriction recorded in the International Register following a request presented by the Office under paragraph (1).

**30. Extracts from the International Register**

- (1) Extracts from the International Register issued by the International Bureau shall be exempt from any legalization in [COUNTRY].
- (2) In all legal proceedings relating to a mark in an international registration in which [COUNTRY] is a designated Contracting Party, the fact that a person is recorded as proprietor thereof in the International Register shall be *prima facie* evidence of the validity of the international registration of the mark and of all subsequent assignments and transmissions thereof.

## **PART III. EXPLANATORY NOTES ON THE MODEL PROVISIONS ON THE IMPLEMENTATION OF THE MADRID PROTOCOL IN [COUNTRY]**

The provisions in these draft rules relate to the principal obligations imposed by the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (“the Madrid Protocol”).

### **CHAPTER I. PRELIMINARY**

#### **1. Definitions**

For the sake of legal certainty, it is useful to have a provision defining a number of expressions used in the context of the international procedure. Those expressions are defined as having the same meaning as in the Madrid Protocol and in the Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (“the Regulations under the Protocol”). In addition, a reference is made to the national legislation on marks.

#### **2. General**

Similarly, for the sake of legal certainty, it is useful to have a provision along the lines of what is proposed in Section 2 of these draft rules to establish that, for substantive and procedural matters in connection with international registrations in which [COUNTRY] is a designated Contracting Party, the national law applies.

#### **3. Language**

Under Rule 6 of the Regulations under the Protocol, an international application, and other communications relating thereto, may be filed in English, French or Spanish, according to what is prescribed by the Office of origin. The implementing legislation of [COUNTRY] should therefore state the language in which the international applications should be filed, and in which other communications under the Madrid Protocol should be exchanged.

For further information, please refer to Rule 6 of the Regulations under the Protocol.

#### **4. Fees**

Under Article 8(1) of the Madrid Protocol, it is possible for the Office to establish and collect a fee to cover the cost of the work involved in certification and transmittal to the International Bureau of an international application. The Office may also require the payment of a fee in connection with certain requests that must be filed with the Office, such as, for example, a request to take note of replacement. Please note, however, that this is an optional provision.

#### **5. Calculation of Time Limits**

Certain communications sent under the Madrid Protocol indicate the time-limit by which the holder of an international registration must reply or remedy an irregularity, such as, for example, a notification of provisional refusal. Those communications must be sent through the International Bureau. To avoid placing holders of international registrations in an unfavorable position, the above-mentioned time-limits should be counted as from the date on which the International Bureau transmits the communication to the holder.

## **6. Further Details**

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

## CHAPTER II. INTERNATIONAL APPLICATIONS

### **7. International Applications**

This provision defines who is entitled to file an international application through the Office as Office of origin, in accordance with Article 2 of the Madrid Protocol.

Nationality and domicile are legal concepts that are likely to be defined in the laws of [COUNTRY]. The Office may apply the corresponding legal definitions found in the applicable laws of [COUNTRY] to determine whether a person is entitled to file an international application through the Office as Office of origin. Real and effective industrial or commercial establishment is a legal concept found in the Paris Convention. The Office may apply the same standard applied in connection with the Paris Convention for the purposes of the international procedure under the Madrid Protocol.

In accordance with its practice, the Office may either require that the applicant provide evidence supporting the entitlement claim or accept the veracity of the claim.

### **8. Examination of International Applications**

Section 8 of these draft rules further defines the principal role of the Office as Office of origin. Before transmitting an international application to the International Bureau, the Office is required to confirm that it can be considered as the Office of origin and that the relevant particulars appearing in the international application correspond to the particulars appearing in the basic application or basic registration, as the case may be. The Office is also required to indicate the date on which it received the international application (which will become, in principle, the date of the international registration) – in this regard, please refer to Article 3(4) of the Madrid Protocol.

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

For further information, please refer to Rule 9(5)(d) of the Regulations under the Protocol.

### **9. Certification and Transmittal**

Where the Office has confirmed that it can be considered as the Office of origin and that the relevant particulars appearing in the international application correspond to the particulars appearing in the basic application or basic registration, as the case may be, then it is required to certify the international application.

Where the Office considers that the application cannot be certified or transmitted to the International Bureau, it must inform the applicant indicating the reasons. The provision may establish a time-limit for the holder to reply to the Office or remedy the international application and determine that the application would be deemed abandoned otherwise.

The administrative time-limit established in these draft rules to remedy an international application would be independent from the period established in Article 3(4) of the Madrid Protocol. According to this Article, a mark is registered with the date on which the Office of origin received the international application, provided the International Bureau receives such application within two months from that date.

The Office may require the payment of a fee for the certification and transmittal of the international application, independent from the fees the applicant would have to pay to the International Bureau for the international application and for the designations made therein. The Office may withhold transmittal of the application until the applicant has paid the certification and transmittal fee. However, late payment of the above-mentioned fee has no negative impact on the date of receipt of the international application by the Office.

## **10. Irregularities in International Applications**

The International Bureau performs a formal examination of the international application to ensure that the application meets the requirements prescribed in the Madrid Protocol and in the Regulations under the Protocol. In particular, the International Bureau ensures that the goods and services listed in the international application are classified according to the edition and version of the Nice Classification in force when the Office of origin received the application.

The International Bureau will notify the Office of origin where the international application does not meet requirements that concern elements which have been certified by the Office of origin, such as, for example, the list of goods and services. In such case, the Office of origin must remedy the irregularity and the International Bureau would disregard any communication sent directly by the applicant. While the International Bureau will also inform the applicant of the irregularity, the applicant cannot respond directly to the International Bureau.

On the other hand, the International Bureau will notify the applicant where the international application does not meet requirements that concern elements not certified by the Office of origin, such as, for example, insufficient payment of the fees. In such case, the applicant must remedy the irregularity. While the International Bureau will also inform the Office of origin of the irregularity, the Office is not required to take any action.

Section 10 of these draft rules requires that the Office, in consultation with the applicant, respond to a notification in which the International Bureau has informed the Office that it must remedy an irregularity, as the Office of origin of the international application. However, an opinion from the applicant is not strictly required and, in the absence of such opinion, the Office could still respond to the notification or choose not to do so.

For further information, please refer to Rules 11, 12 and 13 of the Regulations under the Protocol.

## 11. Ceasing of Effect of the Basic Registration or Basic Application

Section 11 of these draft rules deals with the so-called “ceasing of effect” of the basic application or basic registration during the five-year dependency period specified in Article 6 of the Madrid Protocol<sup>1</sup>. Under paragraph (4) of that Article, where the basic application or basic registration ceases, either totally or partially, to have effect within that period (or as a result of actions that started during that period) the Office of origin must inform the International Bureau accordingly. The Office of origin must also request the cancellation of the international registration in respect of the goods and services affected.

**Model Form 9** can be used to notify the ceasing of effect of the basic mark and request the cancellation of the international registration.

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

**“Article 6  
Period of Validity of International Registration; Dependence and Independence of International Registration**

- (1) Registration of a mark at the International Bureau is effected for ten years, with the possibility of renewal under the conditions specified in Article 7.
- (2) Upon expiry of a period of five years from the date of the international registration, such registration shall become independent of the basic application or the registration resulting therefrom, or of the basic registration, as the case may be, subject to the following provisions.
- (3) The protection resulting from the international registration, whether or not it has been the subject of a transfer, may no longer be invoked if, before the expiry of five years from the date of the international registration, the basic application or the registration resulting therefrom, or the basic registration, as the case may be, has been withdrawn, has lapsed, has been renounced or has been the subject of a final decision of rejection, revocation, cancellation or invalidation, in respect of all or some of the goods and services listed in the international registration. The same applies if
  - (i) an appeal against a decision refusing the effects of the basic application,
  - (ii) an action requesting the withdrawal of the basic application or the revocation, cancellation or invalidation of the registration resulting from the basic application or of the basic registration, or
  - (iii) an opposition to the basic application

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

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



## CHAPTER III. INTERNATIONAL REGISTRATIONS IN WHICH [COUNTRY] IS A DESIGNATED CONTRACTING PARTY

### 12. International Registrations

It is advisable to have a provision that states the effects of an international registration in [COUNTRY], by transposing the substance of Article 4(1)(a) of the Madrid Protocol. Section 12 of these draft rules provides that a mark in an international registration in which [COUNTRY] is a designated Contracting Party shall be protected as if the mark had been the subject of an application for registration filed directly with the Office (subsection (1)). The provision also states that, where no refusal of protection has been issued – or if a refusal has been notified to the International Bureau but has been withdrawn subsequently – the protection of the mark will be the same as if it had been directly registered by the Office (subsection (2)).

This provision also transposes the exemptions provided for in Articles 4(2) and 5*bis* of the Madrid Protocol. Section 12(3) indicates that the Office must accept priority claims made in respect of a mark in an international registration without requiring the holder to comply with any further formality. When [COUNTRY] is subsequently designated in accordance with Article 3*ter*(2) of the Madrid Protocol, the Office must just confirm that the date of the recording of the subsequent designation falls within the priority period (i.e., six months from the date of the application on which the priority claim is based).

Moreover, where documentary evidence of the legitimate use of a mark or of certain elements of a mark is required (e.g., the image or name of a person), such evidence is exempt from any legalization or certification, except for the certification made by the Office of origin.

### 13. Ex Officio Provisional Refusal

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

Section 13 of these rules refers to the refusal period specified in Article 5(2)(b) of the Madrid Protocol. For that period to apply, [COUNTRY] will have to make the declaration provided for in the said Article, which extends the refusal period to 18 months from the date in which the International Bureau notifies [COUNTRY] of the international registration.

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

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

**Model Form 3A** can be used to notify a total *ex officio* provisional refusal.

**Model Form 3B** can be used to notify a partial *ex officio* provisional refusal.

#### **14. Publication of Marks in International Registrations; Opposition**

Since the Law of [COUNTRY] provides for an opposition procedure, these Rules may provide that a publication of the international registration – additional to the publication undertaken by the International Bureau in accordance with the Madrid Protocol – be effected *ex officio* in order to initiate the opposition period. To this effect, Section 14 of these draft rules also provides that the law of [COUNTRY] shall govern opposition procedures.

#### **15. Possible Notification of Provisional Refusal Based on Opposition in Accordance with Article 5(2)(c) of the Madrid Protocol**

Provided [COUNTRY] makes the declaration in Article 5(2)(c) of the Madrid Protocol, the Office would be allowed to notify a provisional refusal based on opposition after the 18-month period specified in Article 5(2)(b) of the Madrid Protocol has expired.

Where the Office considers that the period to give notice of opposition will expire too late for the Office to notify, in accordance with Section 15 of these draft rules, a provisional refusal based on opposition, it must inform the International Bureau of this fact. In this communication, or as soon as possible, the Office must also indicate the start and end dates of the opposition period. When the opposition period is extendable, the Office can communicate the start-date of the opposition period only.

Under Article 5(2)(c) of the Madrid Protocol, the Office would then have one month from the end-date of the opposition period, if this date has been communicated, or, at the most, seven months from the start-date of the opposition period to send a notification of provisional refusal based on opposition to the International Bureau.

**Model Form 1** can be used to communicate that the Office of a designated Contracting Party may send a provisional refusal based on opposition after the expiry of the 18 month refusal period.

**Model Form 2** can be used to communicate the start and end dates of the opposition period when those dates were not specified in the communication sent using Model Form 1.

#### **16. Provisional Refusal Based on an Opposition**

If, following advertisement in accordance with Section 14 of these draft rules, an opposition is filed within the refusal period provided for under the Madrid Protocol, then the Office is required to so notify the International Bureau, and Section 16 of these draft rules provides accordingly. The Office must send that notification to the International Bureau within the refusal period, presumably 18 months, or, where the Office has sent a communication under Section 15 of these draft rules, within the extended period provided for in Article 5(2)(c) of the Madrid Protocol.

**Model Form 3A** can be used to notify a total provisional refusal based on opposition.

**Model Form 3B** can be used to notify a partial provisional refusal based on opposition.

## 17. No Grounds for Refusal; Statement of Grant of Protection

Section 17 of these draft rules is intended to ensure compliance with Rule 18~~ter~~ of the Regulations under the Protocol<sup>2</sup>, which provides that the Office of a designated Contracting Party must issue a statement of grant of protection where:

- (a) all the procedures before that Office have been completed;
- (b) the refusal period has not yet expired, and
- (c) the Office has found no grounds to notify a refusal of protection of the mark and no opposition has been filed.

That is to say, the mark has been examined and accepted by the Office, the mark has then been published but no opposition has been filed and the period for filing such opposition has expired – all of this before the applicable refusal period under the Madrid Protocol expires – presumably, 18 months, assuming that [COUNTRY] makes the necessary declaration to that effect.

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

Please note that where conditions (a), (b) and (c), above, have been complied with but a statement of grant of protection has not been sent to the International Bureau before the refusal period has expired, the mark will be *deemed* anyway to have become protected in [COUNTRY] and the statement in question will be superfluous. However, for the sake of legal certainty, the Office is encouraged to send the statement even if the mark is deemed tacitly accepted.

**Model Form 4** can be used to send a statement of grant of protection under Section 17.

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<sup>2</sup> Rule 18~~ter~~(1) of the Regulations under the Protocol reads as follows:

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

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

## 18. Final Decision by the Office Following the Recording of a Notification of Provisional Refusal

### (1) Statement of Grant of Protection

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

#### *Section 18(1)(i): Provisional Refusal Withdrawn / Protection Granted to All of the Goods and Services*

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

#### *Section 18(1)(ii): Provisional Refusal Withdrawn / Protection Granted to Some of the Goods and Services*

If, on the other hand, following the notification of a provisional refusal, all the procedures before the Office have been completed and the refusal has been partially withdrawn, with the result that there is then residual protection in [COUNTRY] for some of the goods and services, then the Office is required to send to the International Bureau a Statement of Grant of Protection to that effect. This is in accordance with Rule 18ter(2)(ii) of the Regulations under the Protocol<sup>3</sup>.

**Model Form 5** can be used to send a Statement of Grant of Protection under either Section 18(1)(i) or (ii).

<sup>3</sup> Rule 18ter(2)(i) and (ii) of the Regulations under the Protocol reads as follows:

**“Rule 18ter**

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

- (2) *[Statement of Grant of Protection Following a Provisional Refusal]* Except where it sends a statement under paragraph (3), an Office which has communicated a notification of provisional refusal shall, once all procedures before the said Office relating to the protection of the mark have been completed, send to the International Bureau either
- (i) a statement to the effect that the provisional refusal is withdrawn and that protection of the mark is granted, in the Contracting Party concerned, for all goods and services for which protection has been requested, or
  - (ii) a statement indicating the goods and services for which protection of the mark is granted in the Contracting Party concerned.”

(2) Confirmation of Total Provisional Refusal

If, following the notification of a total provisional refusal, all the procedures before the Office have been completed and the Office has decided to confirm such total provisional refusal of protection of the mark in [COUNTRY], then the Office is required to send to the International Bureau a statement of confirmation of total refusal. This is in accordance with Rule 18ter(3) of the Regulations under the Protocol<sup>4</sup>.

**Model Form 6** may be used to send a Statement Confirming a Total Provisional Refusal under Section 18(2).

**19. Appeals**

For the sake of legal certainty, it is advisable to include a provision stating that decisions by the Office concerning international registrations designating [COUNTRY] are subject to review or appeal in accordance with the laws of [COUNTRY].

**20. Further Decision Affecting Protection of a Mark**

This provision implements the requirement under Rule 18ter(4) of the Regulations under the Protocol<sup>5</sup> for the Office to communicate to the International Bureau the particulars of any further decision affecting the protection of the mark in [COUNTRY].

A further decision is to be distinguished from the “final” decision covered by Section 18 of these rules. The final decisions covered by Section 18 above follows the earlier sending by the Office of a notification of provisional refusal, which the Office is required to send once all the procedures before the Office have been completed.

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<sup>4</sup> Rule 18ter(3) of the Regulations under the Protocol reads as follows:

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

[...]

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

<sup>5</sup> Rule 18ter(4) of the Regulations under the Protocol reads as follows:

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

[...]

- (4) *[Further Decision]* Where a notification of provisional refusal has not been sent within the applicable time limit under Article 5(2) of the Protocol, or, where following the sending of a statement under paragraph (1), (2) or (3), a further decision, taken by the Office or other authority, affects the protection of the mark, the Office shall, to the extent that it is aware of that decision, without prejudice to Rule 19, send to the International Bureau a further statement indicating the status of the mark and, where applicable, the goods and services for which the mark is protected in the Contracting Party concerned.”

The further decision contemplated by Section 20 of these rules would be more in the nature of, for example, a later decision by the Office, the court or other authority, of which the Office may, or may not, be aware. The Office should communicate any such further decision to the International Bureau, but only to the extent that it is aware of any such decision, and, only to the extent that any such decision actually affects the status of protection of the mark in [COUNTRY].

**Model Form 7** can be used to communicate a further decision under Section 20.

## 21. Invalidation

In the Regulations under the Protocol, the term “invalidation” is intended to mean any decision, no longer subject to appeal, by a competent authority in [COUNTRY] revoking or cancelling the effects in [COUNTRY] of an international registration with respect to all or some of the goods and services.

Section 21 of these draft rules requires the Office, where it is aware of a decision to terminate in [COUNTRY] the protection of the international registration (for example, a decision taken by a court), to notify the International Bureau accordingly.

## 22. Renewal of International Registrations in Which [Country] is a Designated Contracting Party; Recordings in the International Register

Section 22 of these draft rules implements the principle whereby renewal and any recording made in the International Register in respect of an international registration, and affecting [COUNTRY] as a designated Contracting Party, shall have the same effect as if it had been made directly in the Register of [COUNTRY].

The Office may declare that the recording of a change in ownership, a limitation or a given license has no effect in [COUNTRY]. In such case, the Office must send a communication to the International Bureau. The International Bureau will record that communication, notify the parties concerned and, where appropriate, make the necessary changes in the International Register. Moreover, where there is a final decision, the Office must send a further communication either confirming or withdrawing such declaration.

**Model Form 11** can be used to communicate a declaration that a change in ownership has no effect.

**Model Form 12** can be used to communicate a final decision regarding a previously recorded declaration that a change in ownership has no effect.

**Model Form 13** can be used to communicate a declaration that a limitation has no effect.

**Model Form 14** can be used to communicate a final decision concerning a previously recorded declaration that a limitation has no effect.

## 23. Collective Marks; Certification Marks

Section 23 of these draft rules relates to a requirement under the law of [COUNTRY] that applications to register collective and certification marks be accompanied by regulations governing the use of such marks. To the extent that such regulations may not be filed with the International Bureau, it should be specified that the holders of those marks are required to submit the said regulations directly to the Office within the prescribed time limit.

## 24. Division of an International Registration in Respect of [Country]

Provided [COUNTRY] has not communicated a declaration under Rule 27bis(6) or a notification under Rule 40(6) of the Regulations under the Protocol, holders of international registrations designating [COUNTRY] may wish to divide the international registration in respect of [COUNTRY]. This could be the case where, for example, the Office has refused protection for some of the goods and services only.

Under Rule 27bis(1)(a) of the Regulations under the Protocol<sup>6</sup>, a request for division must be presented through the Office of the designated Contracting Party in respect of which the international registration is to be divided. This Office may examine the request to make sure it complies with the requirements of its national law regarding division and, in such case, must present the request to the International Bureau.

Once the International Bureau records the division, it will notify the Office of this recording and of the creation of a divisional international registration for the goods and services that had been set-apart with [COUNTRY] as its sole designated Contracting Party.

For example, the Office may require that the holder divide the good and services affected by a provisional refusal from the international registration concerned. In such case, after the divisional registration has been created, the Office may then send a final decision, under Section 18(1) of these draft rules, granting protection to the goods and services remaining in the original international registration. The holder may continue prosecution of the goods and services set-apart in the divisional registration until the Office reaches a final decision.

Provided [COUNTRY] has not communicated a declaration under Rule 27ter(2)(b) or a notification under Rule 40(6) of the Regulations under the Protocol, holders may also wish to merge a divisional international registration with the registration it was divided from. Under Rule 27ter(2)(a)<sup>7</sup>, that request must be presented through the Office of the designated

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<sup>6</sup> Rule 27bis(1)(a) of the Regulations under the Protocol reads as follows:

**“Rule 27bis  
Division of an International Registration**

(1) *[Request for the Division of an International Registration]*

- (a) A request by the holder for the division of an international registration for some only of the goods and services in respect of a designated Contracting Party shall be presented to the International Bureau on the relevant official form by the Office of that designated Contracting Party, once the latter is satisfied that the division whose recording is requested meets the requirements of its applicable law, including the requirements concerning fees.”

<sup>7</sup> Rule 27ter(2)(a) of the Regulations under the Protocol reads as follows:

**“Rule 27ter  
Merger of International Registrations**

[...]

(2) *[Merger of International Registrations Resulting from the Recording of the Division of an International Registration]*

- (a) An international registration resulting from division shall be merged into the international registration it was divided from at the request of the holder, presented through the Office that presented the request referred to in paragraph (1) of Rule 27bis, provided that the same natural person or legal entity is the recorded holder in both aforementioned international registrations and the Office concerned is satisfied that the request meets the requirements of its applicable law, including the requirements concerning fees. The request shall be presented to the International Bureau on the relevant official form. The International Bureau shall record the merger, notify accordingly the Office that presented the request and shall inform at the same time the holder.”

Contracting Party that presented the request for division. This Office may also examine the request for merger to make sure it complies with the requirements of its national law, before presenting the request to the International Bureau.

Before the Madrid Protocol enters into force in respect of [COUNTRY], the Office may declare, under, correspondingly, Rules 27*bis*(6) or 27*ter*(2)(b) of the Regulations under the Protocol, that it will not present requests under those rules because the laws of [COUNTRY] do not provide for division or merger. As an alternative, where the laws of [COUNTRY] provide for division or merger, the Office may notify in accordance with Rule 40(6) of the Regulations under the Protocol that it needs further time to implement Rule 27*bis* or 27*ter*, or both.

## **25. Replacement**

Section 25 of these draft rules is based on Article 4*bis*(1) of the Madrid Protocol which provides that, where an international registration relates to a mark that is already registered in a designated Contracting Party for the same goods or services and in the name of the same holder, the international registration is deemed to replace the national registration, and that the Office of that designated Contracting Party must take note of the international registration in its register upon request.

Where replacement has occurred, that is, where the conditions of Article 4*bis*(1) of the Madrid Protocol have been met, the Office may not refuse protection in [COUNTRY] to the mark in an international registration based on the existence of a previous national registration. Moreover, the Office may not require that the holder cancel or renounce to the national registration nor that the holder present a request under Article 4*bis*(2) of the Madrid Protocol.

For replacement to occur, the goods and services listed in the international registration must be equivalent but not identical to those listed in the national registration. Moreover, replacement can occur in respect of some goods and services only.

## **26. Request to Take Note Under Article 4*bis*(2) of the Madrid Protocol**

To implement Article 4*bis*(2) of the Madrid Protocol, Section 26 of these draft rules provide that, where the holder of the international registration so requests, the Office must take note of the international registration the national register. Such request may be subject to the payment of a fee or not.

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

When the Office has taken note in its register in accordance with Article 4*bis* of the Madrid Protocol, it must notify the International Bureau accordingly. Where replacement is for some goods and services only, it must list those goods and services in the notification.



## **27. Transformation**

Paragraph (1)(a) of Section 27 of these draft rules is based on Article 9*quinquies* of the Madrid Protocol. Paragraph (1)(b) establishes the principle that an application resulting from transformation is, for all intents and purposes, the same as a standard application for the domestic registration of a mark, subject to the special provisions of this section.

Paragraph (2) provides for the furnishing of additional information which will enable the Office to confirm compliance with the conditions for transformation under Article 9*quinquies*. Applications resulting from transformation may be filed using the same official form used for filing national applications, or the Office may provide for a special form for transformation.

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

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

## CHAPTER IV. FINAL PROVISIONS

### **28. Irregularities in Communications Sent by the Office to the International Bureau**

The International Bureau will examine all the communications sent by the Office under the Madrid Protocol. The International Bureau will inform the Office of any irregularity in those communications that prevents their recording in the International Register. Where possible, the International Bureau will invite the Office to remedy those irregularities or send a new communication. Section 28 of these draft rules requires the Office to do so, to the extent possible.

### **29. Restriction of the Holder's Right of Disposal**

The holder, an interested party or the courts may request that the Office present to the International Bureau a request to record a restriction of the holder's right of disposal. That restriction can be based on, for example, a security granted by the holder or on a court ordered restriction. The Office can present those requests to the International Bureau for international registrations in which it is the Office of the holder, regardless of the territorial scope of the restriction, or for those in which [COUNTRY] is a designated Contracting Party, where the restriction concerns [COUNTRY] only.

The Office must request that the International Bureau record in the International Register the removal of the above-mentioned restriction, where appropriate.

### **30. Extracts from the International Register**

Under Article 5*ter* of the Madrid Protocol, extracts from the International Register produced by the International Bureau are exempt from any legalization with a view to their production in the Contracting Parties of this treaty.

**PART IV. MODEL INSTRUMENT OF ACCESSION WITH DECLARATIONS TO  
EXTEND THE REFUSAL PERIOD AND TO RECEIVE INDIVIDUAL FEES**

(To be deposited with the Director General of WIPO)

The Government of [COUNTRY] hereby declares that [COUNTRY] accedes to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted at Madrid on June 27, 1989, as amended, hereinafter referred to as the "Protocol".

Furthermore, in respect of international registrations in which [COUNTRY] is mentioned under Article 3~~ter~~ of the Protocol, the Government of [COUNTRY] declares that

- in accordance with Article 5(2)(b) of the Protocol, the time limit of one year referred to in Article 5(2)(a) of the Madrid Protocol is replaced by 18 months;
- in accordance with Article 5(2)(c) of the Protocol, when a refusal of protection may result from an opposition, such refusal may be notified after the expiry of the aforesaid 18-month time-limit; and,
- in accordance with Article 8(7)(a) of the Protocol, [COUNTRY] wishes to receive an individual fee whose amounts are the following<sup>\*</sup>:
  - (i) [AMOUNT IN LOCAL CURRENCY] per class of the *International Classification of Goods and Services for the Purposes of the Registration of Marks* ("Nice Classification"), for a designation of [COUNTRY] in an international application or subsequent to the international registration; and,
  - (ii) [AMOUNT IN LOCAL CURRENCY] per class of the Nice Classification, for the renewal of an international registration in which [COUNTRY] is designated.

Done at [CITY] on [date]

(Signature)<sup>\*</sup>

(Title, Capacity)

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\* Fees must be declared in the currency used by the Office, cannot be higher than what the Office would receive for a 10-year registration and for the 10-year renewal of such registration and may reflect the schedule of fees for marks filed directly (e.g. per class, a different amount for collective and certification marks).

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

## **PART V. MODEL FORMS**

The International Bureau makes available to Offices a number of Model Forms for use in connection with Madrid System procedures.

Copies of the Model Forms are reproduced below and these are available on the Madrid System website at the following address:

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

- Model Form 1: Information Relating to Possible Oppositions (Rule 16 of the Regulations under the Protocol)
- Model Form 2: Dates on which Opposition Period Begins and Ends (Rule 16(1)(b) of the Regulations under the Protocol)
- Model Form 3A: Total Provisional Refusal of Protection (Rule 17(1) of the Regulations under the Protocol)
- Model Form 3B: Partial Provisional Refusal of Protection (Rule 17(1) of the Regulations under the Protocol)
- Model Form 4: Final Disposition on Status of a Mark – Statement of Total Grant of Protection (Rule 18*ter*(1) of the Regulations under the Protocol)
- Model Form 5: Final Disposition on Status of a Mark – Statement of Total or Partial Grant of Protection Following a Provisional Refusal (Rule 18*ter*(2) of the Regulations under the Protocol)
- Model Form 6: Final Disposition on Status of a Mark –Confirmation of Total Provisional Refusal (Rule 18*ter*(3) of the Regulations under the Protocol)
- Model Form 7: Further Decision Affecting the Protection of a Mark (Rule 18*ter*(4) of the Regulations under the Protocol)
- Model Form 8: Completion of *Ex Officio* Examination – Interim Status of a Mark (Rule 18*bis* of the Regulations under the Protocol)
- Model Form 9: Ceasing of Effect of the Basic Application, of the Registration Resulting Therefrom, or of the Basic Registration, and Request for Cancellation of the International Registration (Rule 22(1)(a) or (c) and (2)(b) of the Regulations under the Protocol)
- Model Form 10: Invalidation (Rule 19 of the Regulations under the Protocol)
- Model Form 11: Declaration That a Change in Ownership Has No Effect (Rule 27(4) of the Regulations under the Protocol)
- Model Form 12: Final Decision That a Change in Ownership Has No Effect (Rule 27(4)(e) of the Regulations under the Protocol)
- Model Form 13: Declaration That a Limitation Has No Effect (Rule 27(5) of the Regulations under the Protocol)
- Model Form 14: Final Decision Stating That a Limitation Has No Effect (Rule 27(5)(e) of the Regulations under the Protocol)

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