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MADRID AGREEMENT AND MADRID PROTOCOL CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

Amendment to the Common Regulations: Inclusion of Spanish as an Additional Language of the Madrid System

1. At its Thirty-fifth session, which took place in September 2003, the Assembly of the Madrid Union adopted a number of amendments to the Common Regulations under the Madrid Agreement and Protocol, in order to provide for the inclusion of Spanish as an additional language of the Madrid system.
2. Under Rules 6, 7(2), 9(4)(b)(iii) and 40(4), as amended and reproduced in the annex to the present Notice, Spanish has been put on the same footing as English. This implies in general terms that, as for English, the use of Spanish will be allowed in respect only of international applications governed exclusively by the Protocol, or by both the Agreement and the Protocol, and in respect of international registrations resulting therefrom.
3. The Assembly of the Madrid Union decided that the amendments to the Common Regulations relating to the inclusion of Spanish as an additional language of the Madrid system will enter into force on **April 1, 2004**. Therefore, the attention of users of the Madrid system is drawn to the following consequences.

Language of the International Application

4. An international application received by an Office of origin *as from April 1, 2004*, and governed exclusively by the Protocol, or by both the Agreement and the Protocol, may be filed in Spanish (or in English, or in French). This, however, is subject to what may be prescribed by the Office of origin. In other words, the Office of origin will be entitled to restrict the choice of the applicant to one particular language, or to two given languages, or may permit the applicant to choose between any of the three languages.
5. International applications governed *exclusively by the Agreement* must continue to be filed in French only.

Languages for Recording and Publication of International Registrations

6. International registrations resulting from applications referred to in paragraph 4 above will be recorded in the International Register and published in the WIPO Gazette in English, French *and* Spanish. The required translations will be made by the International Bureau.

7. International registrations resulting from applications governed exclusively by the Agreement will continue to be recorded in the International Register and published in the WIPO Gazette in French only.

Language of Communications Addressed to the International Bureau Relating to an International Application or Registration

8. Communications relating to international applications referred to in paragraph 4 above, and to international registrations resulting therefrom (such as notifications of refusals of protection, requests for the recording of changes in ownership, limitations, licenses, etc.), may be filed in English, French or Spanish, at the sender's option. Also in this respect it should be understood that, where the communication is presented to the International Bureau through the intermediary of an Office, that Office will remain entitled to restrict the choice of the applicant or holder, as described in paragraph 4 above.

9. Communications relating to international applications governed exclusively by the Agreement, and to international registrations resulting therefrom, must continue to be filed in French only (except in the case of a first subsequent designation made under the Protocol as from April 1, 2004, which may be filed in any of the three languages; see also paragraph 13 below).

Language for Notifications Addressed by the International Bureau to Offices, Applicants and Holders

10. In respect of international applications referred to in paragraph 4 above, and international registrations resulting therefrom:

– notifications addressed by the International Bureau *to an Office* will be in the language in which the international application was filed, unless the Office concerned has notified the International Bureau that any such notifications are to be in English, in French or in Spanish (depending on the choice of the Office);

– notifications addressed by the International Bureau *to an applicant or holder* will be in the language in which the international application was filed, unless that applicant or holder has requested (by ticking the appropriate box in item 2(e) of the international application form) that all such notifications are to be in English, or in French or in Spanish.

11. In respect of international applications governed exclusively by the Agreement, and international registrations resulting therefrom, notifications addressed by the International Bureau to an Office, an applicant or holder will continue to be in French only.

Language Regime Concerning International Applications Filed Prior to April 1, 2004, International Registrations Resulting Therefrom and Communications Relating Thereto

12. Communications relating to international applications filed *prior* to April 1, 2004, and to international registrations resulting therefrom, will remain governed by the language regime as in force prior to April 1, 2004. In other words, such communications may not be filed in Spanish, but will have to be filed either in French (where the international registration concerned is governed exclusively by the Agreement) or in English or French (where the international registration concerned is governed exclusively or partly by the Protocol).

13. However, this principle will cease to apply where, in respect of any such registration, a subsequent designation made *under the Protocol* is filed directly with the International Bureau or through the intermediary of an Office *as from April 1, 2004*. In such case:

- that subsequent designation may be filed in English, French or Spanish (at the holder's option). If that subsequent designation is presented to the International Bureau through the intermediary of an Office, that Office may however restrict the choice of the holder in the same way as that described in paragraph 4 above;

- that subsequent designation will be recorded and published in English, French and Spanish (irrespective of the language in which it was filed), and

- the corresponding international registration (which will have already been published in French and, where applicable, in English) will also be published in Spanish.

14. Thereafter, *any* communication relating to such registration may be filed in English, French or Spanish, in the same way as that described in paragraph 8, and such communications will be recorded and published in all three languages of the Madrid system.

Spanish Version of the Forms

15. The Spanish version of all forms established by the International Bureau will be available as from March 2004 on the International Marks page on WIPO's website, at the following address: *www.wipo.int*.

ANNEX

**RULES 6, 7(2), 9(4)(b)(iii) AND 40(4) OF THE COMMON REGULATIONS
UNDER THE MADRID AGREEMENT AND PROTOCOL
AS AMENDED WITH EFFECT FROM APRIL 1, 2004**

*Rule 6
Languages*

(1) *[International Application]* (a) An international application governed exclusively by the Agreement shall be in French.

(b) An international application governed exclusively by the Protocol or governed by both the Agreement and the Protocol 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]* (a) Any communication concerning an international application governed exclusively by the Agreement or the international registration resulting therefrom shall, subject to Rule 17(2)(v) and (3), be in French, except that, where the international registration resulting from an international application governed exclusively by the Agreement is or has been the subject of a subsequent designation under the Protocol, the provisions of subparagraph (b) shall apply.

(b) Any communication concerning an international application governed exclusively by the Protocol or governed by both the Agreement and the Protocol, or the international registration resulting therefrom, 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 any such notifications are to be in English, in French or 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 are to be in English, or in French or in Spanish.

(3) *[Recording and Publication]* (a) Where the international application is governed exclusively by the Agreement, the recording in the International Register and the publication in the Gazette of the international registration resulting therefrom and of any data to be both recorded and published under these Regulations in respect of that international registration shall be in French.

(b) Where the international application is governed exclusively by the Protocol or is governed by both the Agreement and the Protocol, the recording in the International Register and the publication in the Gazette of the international registration resulting therefrom and of any data to be both recorded and published under these Regulations in respect of that 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.

(c) Where a first subsequent designation is made under the Protocol in respect of an international registration that 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. Thereafter, the recording in the International Register and the publication in the Gazette of any data to be both recorded and published under these Regulations in respect of the international registration concerned shall be in English, French and Spanish.

(4) *[Translation]* (a) The translations needed for the notifications under paragraph (2)(b)(iii) and (iv), and recordings and publications under paragraph (3)(b) and (c), 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

[...]

(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.

[...]

Rule 9
Requirements Concerning the International Application

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

[...]

(b) The international application may also contain,

[...]

(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 French if the international application is governed exclusively by the Agreement, or into English, French and/or Spanish if the international application is governed exclusively by the Protocol or is governed by both the Agreement and the Protocol;

[...]

Rule 40
Entry into Force; Transitional Provisions

[...]

(4) *[Transitional Provisions Concerning Languages]* Rule 6 as in force before April 1, 2004, shall continue to apply to any international application which was received, or in accordance with Rule 11(1)(a) or (c) is deemed to have been received, by the Office of origin before that date, to any international registration resulting therefrom and to any communication relating thereto. Rule 6 as in force before April 1, 2004, shall cease to apply where a subsequent designation under the Protocol is filed directly with the International Bureau or is filed with the Office of the Contracting Party of the holder on or after that date, provided that the subsequent designation is recorded in the International Register.

November 24, 2003