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MADRID AGREEMENT AND PROTOCOL CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

Amendment to Article 9sexies of the Madrid Protocol, to the Common Regulations under the Madrid Agreement and Protocol and to the Schedule of Fees Annexed to the Common Regulations

Repeal of the Safeguard Clause

1. At its thirty-eighth (17th ordinary) session, which took place in Geneva from September 24 to October 3, 2007, the Assembly of the Madrid Union approved an amendment to Article 9sexies of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks along with a number of consequential and related amendments to the Common Regulations under the Madrid Agreement and Protocol, and a number of amendments to the Schedule of Fees annexed to the Common Regulations.
2. These amendments will come into effect on September 1, 2008.
3. This information notice is intended to serve as a preliminary notification of the amendments and will, in due course, be followed by further information as to the scope and implications of the amendments.

Amendment to Article 9sexies of the Madrid Protocol

4. As it currently stands, Article 9sexies(1) of the Protocol, commonly known as the “safeguard clause”, provides that where, with regard to a given international application or international registration, the country of origin is party to both the Protocol and the Agreement, the provisions of the Protocol shall have no effect in the territory of any other State that is also party to both the Protocol and the Agreement.
5. The Assembly of the Madrid Union has approved an amendment to Article 9sexies, the effect of which is to repeal the safeguard clause. This amendment consists in a new paragraph (1)(a), replacing existing paragraph (1) of Article 9sexies and establishing the principle that the Protocol, and the Protocol alone, will (as from September 1, 2008), in all aspects, apply between States bound by both the Agreement and the Protocol.

6. Paragraph (1)(a) is accompanied by a new paragraph (1)(b) that renders inoperative a declaration under Article 5(2)(b), Article 5(2)(c) or Article 8(7) of the Protocol, in the mutual relations between States bound by both treaties. As a result, the standard regime of Article 5(2)(a) and of Articles 7(1) and 8(2) of the Protocol will continue to apply between such States – that is, the time limit of one year for the notification of a provisional refusal, and the payment of supplementary and complementary fees.

7. Paragraph (2) of Article 9*sexies* has also been amended. This provision now requires the Assembly to review the application of new paragraph (1)(b) after a period of three years from September 1, 2008. Following this review, the Assembly will then have the power to repeal paragraph (1)(b), or to restrict its scope.

8. The text of amended Article 9*sexies* of the Protocol is reproduced in Part I of the Annex hereto.

Amendments to the Common Regulations and to the Schedule of Fees Consequential or Relating to the Repeal of the Safeguard Clause

Rule 1, items (viii) to (x): Abbreviated Expressions

9. The amendment to these items is consequent on the repeal of the safeguard clause. Following the amendment of Article 9*sexies* of the Protocol, the designation of a Contracting Party bound by both treaties will, where the country of origin is also bound by both treaties, be made under the Protocol, as opposed to being made under the Agreement, as at present. The purpose of the amendments to items (viii) to (x) of Rule 1 is, therefore, to redefine what, consequently, is to be considered “an international application governed exclusively by the Agreement”, “an international application governed exclusively by the Protocol”, and “an international application governed by both the Agreement and the Protocol”.

Rule 6: Languages

10. The amendment to Rule 6 will implement a full trilingual (English, French and Spanish) regime under the Madrid system – i.e., even in situations where an international application is governed exclusively by the Madrid Agreement.

Rule 9(4)(b)(iii): Contents of the International Application

11. The amendment to Rule 9(4)(b)(iii) is consequent on the amendment to Rule 6 since, as from September 1, 2008, it will be possible to file an international application in any of the three languages of the Madrid system (irrespective of the treaty, or treaties, governing it).

Rules 11(1)(b) and (c): Premature Request to the Office of Origin

12. It is recalled that one of the fundamental differences between the Agreement and the Protocol is that, under the former, an international application needs to be based on a registration. Thus, if in an international application based on a mere application, a Contracting Party is designated under the Agreement, the request to present such international application to the International Bureau is currently to be considered premature and the Office of origin should handle that international application as provided for under paragraph (1) of Rule 11.

13. Following the amendment of Article 9*sexies* leading to the repeal of the safeguard clause, the designation of a Contracting Party bound by both treaties will, where the country of origin is also bound by both treaties, be made under the Protocol, as opposed to being made under the Agreement, as at present. Such a designation could thus be made before the basic mark is registered, without the request to present the international application being considered premature. As a consequence, Rules 11(1)(b) and (c) will no longer need to encompass the case of such a designation. Rules 11(1)(b) and (c), as amended, will therefore take into account only the case of the designation of a State that is party *only* to the Agreement.

Rule 16(1): Information Relating to Possible Oppositions

14. The amendment of this Rule is merely for the sake of clarity, in order to avoid an apparent conflict with new Article 9*sexies*(1)(b) of the Protocol.

15. Rule 16(1) provides that where the combined declarations under Articles 5(2)(b) and 5(2)(c) of the Protocol have been made by a Contracting Party, the Office of that Contracting Party must, within the 18-month time limit, provide information relating to possible oppositions taking place beyond this 18-month time limit. However, under Article 9*sexies* as amended, there may be situations where the Office of such a Contracting Party would still have to comply with the standard time limit of one year to notify a provisional refusal, even though that Contracting Party is designated under the Protocol. The addition of the words “Subject to Article 9*sexies*(1)(b) of the Protocol”, in Rule 16, aims at acknowledging this situation.

Rule 18(2): Irregular Notifications of Provisional Refusal – Contracting Party Designated under the Protocol

16. This amendment is also merely for the sake of clarity, in order to avoid an apparent conflict with new Article 9*sexies*(1)(b) of the Protocol, which will, of course, prevail.

Rule 24(1)(b) and (c): Designation Subsequent to the International Registration – Entitlement

17. These amendments are consequential to the amendment of Article 9*sexies* of the Protocol repealing the safeguard clause.

18. Rule 24(1) deals with the entitlement to make a subsequent designation, and it does so by specifying under what treaty a holder is allowed to designate a Contracting Party, depending on whether the Contracting Party of the holder and the designated Contracting Party are linked by a single common treaty or two common treaties.

19. Following the amendment of Article 9*sexies*, the designation of a Contracting Party bound by both treaties will, where the country of origin is also bound by both treaties, be made under the Protocol, as opposed to being made under the Agreement, as at present. As a consequence, subparagraph (b) of Rule 24(1) needed to be amended in order to specify that a subsequent designation will be made under the Agreement only if the Protocol *is not* a common treaty between the Contracting Party of the holder and the designated Contracting Party. Subparagraph (c) of Rule 24(1) also needed to be amended in order to specify that a subsequent designation will be made under the Protocol in all situations where the Protocol is a common treaty between the Contracting Party of the holder and the designated Contracting Party.

Rule 40(4): Transitional Provisions Concerning Languages

20. These amendments follow as part of the implementation of a full trilingual regime under the Madrid system.

21. As a consequence of the amendments to Rule 6, an *additional* transitional provision was required for the purposes of maintaining the monolingual regime for international registrations resulting from international applications governed exclusively by the Agreement filed between April 1, 2004, and August 31, 2008 (that is, the day before the date of entry into force of Rule 40(4) as amended), inclusively, to the extent, of course, that such international registrations have not, in the meantime, moved to the trilingual regime as a result of a subsequent designation under the Protocol.

22. Besides, whereas under Rule 6 as it currently stands, only subsequent designations made under the Protocol trigger a change to the trilingual regime, under amended Rule 6, *any* subsequent designation will trigger that change. As a result, Rule 40(4) had to be restructured and substantially reworded for the sake of clarity.

Text of Sub-items 2.4, 3.3, 3.4, 5.2, 5.3 and 6.2 to 6.4 of the Schedule of Fees

23. These amendments are consequential to the amendment of Article 9*sexies* of the Protocol.

24. Following the repeal of the safeguard clause, the designation of a Contracting Party bound by both treaties will, where the country of origin is also bound by both treaties, be made under the Protocol, as opposed to being made under the Agreement, as at present. As a result, when that Contracting Party has made the declaration relating to individual fees under Article 8(7)(a), its initial designation and the renewal of that designation should entail the payment of those individual fees. However, new paragraph (1)(b) of amended Article 9*sexies* will, precisely, preserve the application of the complementary fees in such situations.

25. The amendment to the text of sub-items 2.4, 5.3 and 6.4 aims at reflecting the effect of new paragraph (1)(b) of Article 9*sexies* and follows the language already found in sub-item 3.4. The amendments to the text of sub-items 3.3, 5.2, 6.2 and 6.3 are merely for the sake of clarity, with a further amendment of a purely editorial nature to the text of sub-item 5.2. Finally, the amendment to the text of sub-item 3.4 is also of a purely editorial nature.

Amounts of the Supplementary and Complementary Fees

26. In conjunction with the amendment of Article 9^{sexies} of the Protocol, the Assembly also approved an amendment of sub-items 1.2, 1.3, 2.2, 2.3, 3.2, 3.3, 5.2, 6.2 and 6.3 of the Schedule of Fees annexed to the Common Regulations, setting the amounts of the supplementary and complementary fees at 100 Swiss francs, also with effect from September 1, 2008.

27. The amended text of the rules referred to above, along with the amendments to the Schedule of Fees, are reproduced in Part II of the Annex hereto.

November 16, 2007

ANNEX

Part I

**Protocol Relating to
the Madrid Agreement Concerning
the International Registration
of Marks**

[...]

Article 9^{sexies}

**Relations Between States Party to both this Protocol
and the Madrid (Stockholm) Agreement**

(1) (a) This Protocol alone shall be applicable as regards the mutual relations of States party to both this Protocol and the Madrid (Stockholm) Agreement.

(b) Notwithstanding subparagraph (a), a declaration made under Article 5(2)(b), Article 5(2)(c) or Article 8(7) of this Protocol, by a State party to both this Protocol and the Madrid (Stockholm) Agreement, shall have no effect in the relations with another State party to both this Protocol and the Madrid (Stockholm) Agreement.

(2) The Assembly shall, after the expiry of a period of three years from September 1, 2008, review the application of paragraph (1)(b) and may, at any time thereafter, either repeal it or restrict its scope, by a three-fourths majority. In the vote of the Assembly, only those States which are party to both the Madrid (Stockholm) Agreement and this Protocol shall have the right to participate.

ANNEX

Part II

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,

[...]

(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;

[...]

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 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 English, French and Spanish, or in any one or two of those languages;

[...]

Chapter 2
International Applications

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

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

(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.

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.

[...]

Rule 18

Irregular Notifications of Provisional Refusal

[...]

(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.

[...]

Chapter 5
Subsequent Designations; Changes

Rule 24
Designation Subsequent to the International Registration

(1) *[Entitlement]* [...]

(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.

[...]

Chapter 9
Miscellaneous

Rule 40
Entry into Force; Transitional Provisions

[...]

(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.

[...]

SCHEDULE OF FEES

(in force on September 1, 2008)

Swiss francs

1. *International applications governed exclusively by the Agreement*

[...]

1.2 Supplementary fee for each class of goods and services beyond three classes (Article 8(2)(b) of the Agreement) 100

1.3 Complementary fee for the designation of each designated Contracting State (Article 8(2)(c) of the Agreement) 100

2. *International applications governed exclusively by the Protocol*

[...]

2.2 Supplementary fee for each class of goods and services beyond three classes (Article 8(2)(ii) of the Protocol), except if only Contracting Parties in respect of which individual fees (see 2.4, below) are payable are designated (see Article 8(7)(a)(i) of the Protocol) 100

2.3 Complementary fee for the designation of each designated Contracting Party (Article 8(2)(iii) of the Protocol), except if the designated Contracting Party is a Contracting Party in respect of which an individual fee is payable (see 2.4, below) (see Article 8(7)(a)(ii) of the Protocol) 100

2.4 Individual fee for the designation of each designated Contracting Party in respect of which an individual fee (rather than a complementary fee) is payable (see Article 8(7)(a) of the Protocol) except where the designated Contracting Party is a State bound (also) by the Agreement and the Office of origin is the Office of a State bound (also) by the Agreement (in respect of such a Contracting Party, a complementary fee is payable): the amount of the individual fee is fixed by each Contracting Party concerned

3. *International applications governed by both the Agreement and the Protocol*

[...]

3.2 Supplementary fee for each class of goods and services beyond three classes 100

3.3 Complementary fee for the designation of each designated Contracting Party in respect of which an individual fee is not payable (see 3.4, below) 100

3.4 Individual fee for the designation of each designated Contracting Party in respect of which an individual fee is payable (see Article 8(7)(a) of the Protocol), except where the designated Contracting Party is a State bound (also) by the Agreement and the Office of origin is the Office of a State bound (also) by the Agreement (in respect of such a Contracting Party, a complementary fee is payable): the amount of the individual fee is fixed by each Contracting Party concerned

[...]

5. *Designation subsequent to international registration*

The following fees shall be payable and shall cover the period between the effective date of the designation and the expiry of the then current term of the international registration:

[...]

5.2 Complementary fee for each designated Contracting Party indicated in the same request where an individual fee is not payable in respect of such designated Contracting Party (see 5.3, below) 100

5.3 Individual fee for the designation of each designated Contracting Party in respect of which an individual fee (rather than a complementary fee) is payable (see Article 8(7)(a) of the Protocol) except where the designated Contracting Party is a State bound (also) by the Agreement and the Office of the Contracting Party of the holder is the Office of a State bound (also) by the Agreement (in respect of such a Contracting Party, a complementary fee is payable): the amount of the individual fee is fixed by each Contracting Party concerned

6. *Renewal*

[...]

- | | |
|--|-----|
| 6.2 Supplementary fee, except if the renewal is made only for designated Contracting Parties in respect of which individual fees are payable (see 6.4, below) | 100 |
| 6.3 Complementary fee for each designated Contracting Party in respect of which an individual fee is not payable (see 6.4, below) | 100 |
| 6.4 Individual fee for the designation of each designated Contracting Party in respect of which an individual fee (rather than a complementary fee) is payable (see Article 8(7)(a) of the Protocol) except where the designated Contracting Party is a State bound (also) by the Agreement and the Office of the Contracting Party of the holder is the Office of a State bound (also) by the Agreement (in respect of such a Contracting Party, a complementary fee is payable): the amount of the individual fee is fixed by each Contracting Party concerned | |

[...]

[End of Annex]