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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 9sexies(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 9sexies(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

[...]

