

**Indonesia dan Upaya Pendaftaran Merek  
Secara Internasional  
dengan Sistem Madrid Protocol**

**TESIS**

**Diajukan sebagai salah satu syarat untuk  
memperoleh gelar Magister Hukum**

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JAKARTA  
JANUARI 2009**

## HALAMAN PERNYATAAN ORISINALITAS

Tesis ini adalah hasil karya saya sendiri,  
dan semua sumber baik yang dikutip maupun dirujuk  
telah saya nyatakan dengan benar.

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**Telah berhasil dipertahankan di hadapan Dewan Penguji dan diterima sebagai bagian persyaratan yang diperlukan untuk memperoleh gelar Magister Hukum pada Program Studi Magister Ilmu Hukum, Fakultas Hukum, Universitas Indonesia.**

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## KATA PENGANTAR

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Topik ini penulis angkat guna memberi gambaran tentang sistem Madrid Protocol bagi Indonesia dikaitkan dengan kondisi pendaftaran merek di Indonesia karena pendaftaran merek telah dipandang oleh para pelaku bisnis sebagai hal esensial yang menunjang kegiatan usaha. Pendaftaran merek yang terjadi selama ini memiliki beberapa permasalahan yang dapat mengakibatkan inefisiensi waktu dan biaya bagi pelaku usaha yang memasarkan barang dan jasanya secara lintas negara. Dalam hal sistem pendaftaran merek, ide untuk membentuk suatu harmonisasi prosedur pendaftaran merek secara internasional telah tertuang dalam *Madrid Protocol*. Penggunaan sistem madrid memberikan kemudahan prosedural bagi pemilik merek untuk mendaftarkan mereknya secara internasional. Kemudahan sistem yang demikian juga “menyerupai” sistem *PCT*.

Berdasarkan hal tersebut, dalam tesis ini dipaparkan bagaimana dampak penggunaan sistem madrid bagi Indonesia, bagaimana hubungannya dengan merek terkenal serta perbandingan antara sistem *Madrid Protocol* dan *Patent Cooperation Treaty (PCT)*.

Tesis ini merupakan salah satu persyaratan untuk menyelesaikan studi Program Magister Hukum pada Pascasarjana Universitas Indonesia. Saya menyadari sepenuhnya bahwa tanpa bantuan moril maupun materiil dari berbagai pihak, saya tidak dapat menyelesaikan Tesis ini. Oleh karena itu, pada kesempatan ini dengan segala kerendahan hati ijin saya mengucapkan terima kasih yang sebesar-besarnya kepada :

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Saya menyadari keterbatasan kemampuan dan pengetahuan dalam penulisan tesis ini, maka oleh karena itu setiap kritik dan saran yang bersifat membangun dan bermaksud menyempurnakan tesis ini disambut dengan gembira.

Semoga tesis ini dapat bermanfaat baik bagi saya (penulis) sendiri maupun bagi semua pihak dan dapat memberikan sumbangan bagi perkembangan ilmu hukum.

Jakarta, Januari 2009

Berliana Purwani

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## ABSTRAK

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Seiring dengan arus globalisasi di bidang ekonomi yang sangat berpengaruh terhadap kegiatan perdagangan barang dan jasa, perlindungan merek secara internasional menjadi suatu kebutuhan yang sangat mendesak bagi para pelaku usaha yang hendak memasarkan produknya ke luar negeri. Selama ini, bila pengusaha Indonesia ingin mendapatkan perlindungan hukum atas merek dagang atau merek jasa di luar negeri, mereka harus mengajukan aplikasi ke masing-masing negara yang dituju. Untuk itu pendaftaran merek internasional melalui sistem *Madrid Protocol* dengan sistem yang lebih sederhana dan biaya yang lebih murah akan sangat membantu para pemilik merek untuk mendapatkan perlindungan hukum atas mereknya di beberapa negara hanya dengan satu permohonan. Hal tersebut menjadi bahan pertimbangan bagi kita akan perlunya Indonesia menjadi anggota *Madrid Protocol*. Kemudahan untuk melakukan pendaftaran merek sebagaimana yang ditawarkan melalui sistem *Madrid Protocol*, tentu akan sangat bermanfaat bagi pemilik merek atau para pelaku usaha, apalagi bila merek yang dimiliki pengusaha merupakan merek terkenal, tentu dengan diadopsinya sistem ini di Indonesia akan memotivasi para pengusaha untuk menggunakan sistem ini dan melakukan ekspor. Sistem pendaftaran merek dengan *Madrid Protocol* ini juga ‘menyerupai’ pendaftaran melalui *Patent Corporate Treaty (PCT)*, yaitu dengan mengajukan satu permohonan perlindungan paten melalui *PCT*, inventor bisa mendapatkan perlindungan hukum atas patennya di banyak negara. Memang sistem pendaftaran merek secara internasional dengan sistem *Madrid Protocol* sangat baik dan perlu diadopsi di suatu negara, termasuk Indonesia.

Kata Kunci:

*Madrid Protocol*, pendaftaran merek, internasional.

## **ABSTRACT**

**Name : BERLIANA PURWANI**  
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**Title : Indonesia and International Registration Effort with Protocol Madrid System**

Nowadays, in the economic globalization era that have brought a lot of impact to the products and services international trading, the international protection of marks have becoming an urgent need for the bussiness people that want to market that products and services in the foreign countries. Currently, if the Indonesian bussiness people want to have protection of mark in the another country, they have to send application to each country they intend to apply. Therefore, the registration of mark through the Madrid Protocol with the simple system and cheaper fee is really helping the mark owner to get the protection of his mark in that country with only one application. The above condition can be our consideration to be the member of Madrid Protocol. The simplicity of mark registration in the Madrid Protocol system surely bring benefits to the mark owner and the bussiness people, especially if the mark that is being registered is the wellknown mark. By adopting this system, the bussiness people will be encourage to use this system and to do international trading. Mark registration with this system is also similar with Patent Cooperation System (PCT). By sending one application in PCT system, inventor can have the patent protection in many countries. The mark protection of Madrid Protocol is very good and should be adopt in all country.

**Key word:**

**Madrid Protocol, mark registration, international**



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*Protocol Relating To The Madrid Agreement Concerning The International  
Registration of Marks*

*Common Regulations Under The Madrid Agreement Concerning The  
International Registration of Marks and The Protocol Relating To The Madrid  
Agreement*

## BAB I

### PENDAHULUAN

#### 1.1. Latar Belakang

Perlindungan terhadap Hak Kekayaan Intelektual (HKI) merupakan suatu keharusan. Hal ini sangat penting guna mendukung pengembangan sistem merek di Indonesia pada khususnya dalam pembangunan hukum di bidang HKI secara luas hingga akhirnya dapat menunjang laju pembangunan ekonomi di Indonesia<sup>1</sup>.

Merek merupakan salah satu bidang HKI, sebagai komponen penting dalam kegiatan perdagangan barang dan jasa. Melalui merek suatu produk barang dan jasa menjadi dikenal oleh para konsumen dan melalui merek pula kelangsungan usaha dapat dipertahankan<sup>2</sup>. Sistem perlindungan merek harus menjadi daya tarik bagi investor di luar negeri sehingga meningkatkan pendaftaran merek asing. Merek dagang tidak lagi dilihat sekadar pembeda antara produk yang satu dengan produk yang lain, tetapi juga menjadi bagian dari strategi pemasaran guna mendapat pasar.

Seiring dengan arus globalisasi di bidang ekonomi yang sangat berpengaruh terhadap kegiatan perdagangan barang dan jasa, perlindungan merek secara internasional menjadi suatu kebutuhan yang sangat mendesak bagi para pelaku usaha yang hendak memasarkan produknya ke luar negeri. Untuk itu pendaftaran merek internasional melalui sistem *Madrid Protocol* akan sangat membantu para pemilik merek untuk mendapatkan perlindungan hukum atas mereknya di semua negara anggota *Madrid Protocol* tersebut hanya dengan satu permohonan<sup>3</sup>. Hal tersebut menjadi bahan pertimbangan bagi kita akan perlunya Indonesia menjadi anggota *Madrid Protocol*. Kemudahan untuk melakukan pendaftaran merek

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<sup>1</sup> Lihat dalam artikel *Protocol Madrid Upaya Perlindungan Merek secara Internasional*, website: <http://www.depkmham.go.id/xDepkmhamWeb/xBerita/xUmum/protocol+madrid.i:tm>, diakses tanggal 23 Mei 2008.

<sup>2</sup> Ibid.

<sup>3</sup> Ibid.

sebagaimana yang ditawarkan melalui sistem *Madrid Protocol*<sup>4</sup> tentu akan sangat bermanfaat bagi pemilik merek atau para pelaku usaha<sup>5</sup>.

Sistem pendaftaran merek dengan sistem *Madrid Protocol* kelihatannya ‘menyerupai’ pendaftaran melalui *Patent Corporate Treaty (PCT)*, yaitu dengan mengajukan satu permohonan perlindungan internasional paten melalui *PCT*, inventor atau kalangan industri bisa mendapatkan perlindungan hukum atas patennya di banyak negara. Misalnya, inventor (penemu) atau perusahaan A ingin mendapatkan perlindungan paten di Jerman, Inggris, Amerika Serikat, Korea Selatan atau Jepang, maka dia hanya cukup mengajukan satu permohonan melalui *PCT*, tidak perlu lagi mengajukan permohonan perlindungan paten ke masing-masing negara tersebut<sup>6</sup>.

Terlepas dari kedua sistem tersebut yang kelihatannya “menyerupai”, perlu diketahui sistem pendaftaran merek yang terjadi selama ini di Indonesia. Selama ini, bila pengusaha Indonesia ingin mendapatkan perlindungan hukum atas merek dagang atau merek jasa di luar negeri, mereka harus mengajukan aplikasi ke masing-masing negara yang dituju. Misalnya, bila pengusaha Indonesia menginginkan perlindungan hukum terhadap merek di Amerika Serikat, Jerman, Swiss atau Jepang, maka aplikasi diajukan langsung ke masing-masing negara tersebut. Cara seperti itu dinilai tidak efisien dan efektif lagi karena akan menghabiskan waktu lama dan biaya yang relatif besar bila dibandingkan dengan menggunakan fasilitas Sistem *Madrid Protocol*<sup>7</sup>.

Hal tersebut dibenarkan oleh T. Didik Taryadi, S.H. Di samping itu, Didik menambahkan bahwa pemohon harus menggunakan jasa konsultan hukum (*lawyer*) dan membayarnya cukup mahal, jika pemohon akan melakukan pendaftaran merek di beberapa negara. Pada tiap negara pemohon harus menunjuk

<sup>4</sup> *Madrid Protocol* adalah sistem aplikasi merek secara internasional dalam satu permohonan yang bisa berlaku untuk semua negara anggota.

<sup>5</sup> Lihat dalam artikel *Madrid System, Perlindungan Merek secara Internasional*, website: <http://disperindag-jabar.go.id/?pilih=lihat&id=1999>, diakses tanggal 14 Februari 2007.

<sup>6</sup> Suwantin Oemar, *HaKI Kian Berperan dalam Persaingan Global*, website: [www.bisnis.com](http://www.bisnis.com), diakses 14 November 2007.

<sup>7</sup> Lihat dalam artikel, *Madrid System, Perlindungan Merek secara Internasional*, website: <http://disperindag-jabar.go.id/?pilih=lihat&id=1999>, diakses tanggal 14 Februari 2007.

konsultan HKI (Hak Kekayaan Intelektual) / *Trademark Attorney* untuk mendaftarkan merek ke masing-masing negara<sup>8</sup>.

Kondisi proses pendaftaran merek ke luar negeri yang demikian tentu akan merepotkan dan tentu menghabiskan biaya yang tidak sedikit bagi pemohon pendaftar lokal, apalagi banyak produk lokal yang dapat dipasarkan ke luar negeri untuk tujuan ekspor. Apabila proses pendaftaran merek ke luar negeri seperti itu tentu dapat mematahkan semangat pemilik merek lokal untuk memasarkan produknya di luar negeri, padahal pendaftaran merek di luar negeri penting untuk dapat berkompetisi dalam pasar regional dan memperoleh reputasi internasional. Jika mereknya tidak dilindungi tentu akan merugikan pemilik merek Indonesia.

Tujuan *Madrid Protocol* adalah untuk mempermudah pemilik merek mendaftarkan perlindungannya di negara-negara anggota *Madrid Protocol* secara utuh dan membantu pemilik merek untuk mendapat perlindungan merek di negara-negara yang dituju. Sistem pendaftaran merek sekarang yang diterapkan di Indonesia tidak efisien dan tidak sederhana karena jika pemilik merek lokal akan mendaftarkan mereknya harus datang ke masing-masing negara. Dengan sistem *Madrid Protocol*, orang Indonesia selaku pemilik merek lokal dapat mendaftarkan mereknya melalui kantor Direktorat Jenderal (Ditjen) HKI untuk ditujukan ke beberapa negara<sup>9</sup>. Dengan sistem ini hanya perlu satu aplikasi yang diajukan untuk masuk ke sejumlah negara anggota *Madrid Protocol*, menggunakan satu bahasa untuk mendaftar ke semua negara tujuan merek produk. Selain itu, dalam proses pendaftaran merek, pada protokol ini hanya dilakukan satu kali pemeriksaan formal dan pengumumannya untuk sejumlah negara. Dengan begitu biaya pendaftaran dapat direduksi<sup>10</sup> dibandingkan harus mendaftarkan merek ke masing-masing negara yang tentunya lebih menghabiskan banyak biaya. Jadi, intinya jika Indonesia mengadopsi sistem *Madrid Protocol* adalah kesederhanaan prosedur pendaftaran merek secara internasional dan penghematan biaya.

<sup>8</sup> T. Didik Taryadi, S.H., Kasubdit Pelayanan Hukum Direktorat Merek, Ditjen Hak Kekayaan Intelektual Departemen Hukum dan HAM R.I, wawancara dilakukan oleh penulis, rekaman kaset, Jakarta, 25 September 2008.

<sup>9</sup> Ibid.

<sup>10</sup> Lihat dalam artikel *Pendaftaran Merek Indonesia Perlu Jadi Anggota Protokol Madrid*, website: [www.kompas.com](http://www.kompas.com), diakses tanggal 25 April 2007.

Selain untuk efisiensi prosedur dan mengurangi biaya pendaftaran merek Gunawan Suryomurcito, S.H<sup>11</sup> juga melihat dari sisi pemerintah mengapa Indonesia perlu mengadopsi sistem *Madrid Protocol*. Ada dua faktor yang melatarbelakangi, yaitu faktor umum dan khusus. Faktor umum, pemerintah ingin agar Indonesia sama dengan negara lain yang sudah menjadi anggota *Madrid Protocol*. Misalnya, sesama anggota *ASEAN* saja, seperti Singapura dan Vietnam sudah menjadi anggota *Madrid Protocol*, kita pun seharusnya juga ikut serta. Kita harus sama dengan negara lain, jangan sampai ketinggalan. Faktor khusus, Indonesia ada tekanan dari Jepang karena dalam perjanjian *IJ-EPA* antara Indonesia dengan Jepang dinyatakan bahwa Indonesia akan segera menjadi anggota *Madrid Protocol*<sup>12</sup>. Selain itu, menurut T. Didik Taryadi, SH, ada pula kesepakatan di antara negara anggota *ASEAN* bahwa semua negara anggota *ASEAN* paling lambat pada tahun 2015 harus menjadi anggota *Madrid Protocol*, termasuk Indonesia. Jadi, dapat dikatakan bahwa Indonesia ‘mau tidak mau’ atau dalam kondisi ‘siap atau tidak siap’ akan menjadi anggota *Madrid Protocol* dan mengadopsi sistemnya.

Ditambahkan oleh Gunawan Suryomurcito, S.H, bahwa ada satu pandangan lain yang cenderung mendukung agar Indonesia ikut *Madrid Protocol* segera. Dengan adanya fasilitas sistem pendaftaran merek melalui *Madrid Protocol* yang memudahkan pendaftar dengan biaya yang lebih murah untuk mendaftarkan ke beberapa negara akan mendorong para pelaku usaha Indonesia untuk “melihat keluar.” “Melihat keluar” di sini maksudnya ialah agar pengusaha Indonesia termotivasi untuk meningkatkan ekspor melalui merek yang dimiliki, sehingga mereknya tidak hanya dipasarkan di dalam negeri saja. Melihat hal ini hendaknya tidak mematahkan semangat Indonesia untuk maju, sehingga tidak terus-menerus melihat kekurangan atau ketidaksiapan yang ada di negeri ini dalam hal pendaftaran merek secara internasional. Diharapkan dengan diadopsinya sistem *Madrid Protocol* dapat dimanfaatkan oleh pengusaha Indonesia karena kalau tidak ada fasilitas ini mungkin saja pengusaha Indonesia tidak termotivasi untuk

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<sup>11</sup> Gunawan Suryomurcito, S.H, wawancara dilakukan oleh penulis, rekaman kaset, Jakarta, pada tanggal 17 Oktober 2008.

<sup>12</sup> *IJ-EPA (Indonesia Japan- Economic Partnership Agreement)* .



mendaftarkan mereknya keluar atau *go international*. Jadi, dengan adanya pandangan yang demikian harus ada peran pendukung.

Departemen Perdagangan (Depdag) merupakan salah satu instansi pemerintah yang dapat mendorong peningkatan ekspor melalui Badan Pengembangan Ekspor Nasional (BPEN). Melalui BPEN ekspor didorong peningkatannya. Badan ini harus membantu pengusaha dengan memberi suatu kemudahan atau insentif untuk membuat suatu daya saing. BPEN diharapkan dapat membuat kegiatan-kegiatan pendukung guna meningkatkan ekspor agar merek Indonesia semakin dikenal di luar negeri, sehingga dapat memotivasi pengusaha Indonesia untuk menggunakan fasilitas pendaftaran *Madrid Protocol* pada nantinya. Dengan demikian, merek nasional diharapkan dapat bersaing dengan merek asing di pasar global.

Sehubungan dengan produk barang yang diekspor ke luar negeri, dalam hal ini tentu berkaitan dengan merek yang telah digunakan pada produk tersebut karena jika hanya mengekspor barang tanpa menggunakan merek, penggunaan sistem *Madrid Protocol* ini kurang bermanfaat. Lain halnya bila sudah ada merek pada produk tersebut, apalagi merek yang sudah dikenal masyarakat luas pasti sistem ini akan sangat bermanfaat.

Emmawati Yunus<sup>13</sup> memperkirakan sistem aplikasi merek secara internasional itu akan berdampak positif terhadap peningkatan jumlah permohonan dari luar negeri karena *fee* ke Indonesia relatif murah, hanya US\$50.

"Indonesia akan menjadi negara tujuan pendaftaran merek secara internasional karena pasarnya besar. Ketika China bergabung ke *Madrid Protocol*, jumlah permohonan merek dari luar negeri menuju negeri Tirai Bambu itu meningkat," ujarnya. Hingga kini, katanya, jumlah permohonan merek dari luar negeri hanya 25% dari total permohonan. "Merek lokal masih mendominasi permohonan di dalam negeri." Menurut data, pada 2005 jumlah permohonan dan perpanjangan merek asing tercatat 10.082 buah, lalu meningkat menjadi 16.005 pada tahun berikutnya. Sedangkan total permohonan merek lokal pada 2005 tercatat 30.739, dan meningkat menjadi 36.644 pada 2006<sup>14</sup>. (lihat tabel). Jika permohonan dari luar negeri

<sup>13</sup> Emmawati Yunus adalah mantan Direktur Merek di Direktorat Merek, Ditjen Hak Kekayaan Intelektual, Departemen Hukum dan HAM RI.

<sup>14</sup> Suwantin Oemar, *Untung Rugi Masuk Madrid Protocol*, website: <http://www.bisnis.com>, diakses 2 Mei 2007.

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<sup>14</sup> Suwantin Oemar, *Untung Rugi Masuk Madrid Protocol*, website: <http://www.bisnis.com>, diakses 2 Mei 2007.

meningkat, ujaninya, maka Penerimaan Negara Bukan Pajak (PNBP) juga akan bertambah.

Praktik proses pendaftaran merek di Indonesia menghadapi banyak kendala, terutama dalam penyelesaian sertifikat. Kondisi ini diungkapkan oleh Didik Taryadi, SH, Kasubdit Pelayanan Hukum, Ditjen Merek, Departemen Hukum dan Hak Asasi Manusia (HAM) Republik Indonesia (RI) pada wawancara yang dilakukan oleh penulis pada tanggal 25 September 2008. UU Merek memang mengatur sampai dengan penerbitan sertifikat, namun di *Madrid Protocol* tidak ada. Hal ini yang membuat berbeda dengan proses pendaftaran merek nasional. Dalam proses pendaftaran merek menurut UU No.15 Tahun 2001 ada pemeriksaan formalitas<sup>15</sup>, pemeriksaan substantif<sup>16</sup> dan penerbitan sertifikat<sup>17</sup>. Banyaknya tahapan yang harus dilalui hingga memperoleh sertifikat tersebut membuat proses pendaftaran merek menjadi lama. Lain halnya jika pendaftaran merek melalui sistem *Madrid Protocol*, Ditjen HKI tidak perlu membuat sertifikat. Sertifikat dan pemeriksaan substantif dilakukan oleh negara yang dituju oleh pemohon.

Kendala lain dalam pendaftaran merek dinyatakan oleh Didik Taryadi, yaitu sistem otomasi yang ada di Ditjen HKI belum sempurna. Sistem otomasi masih lambat, sehingga masih perlu dikembangkan. Dari segi administrasi yang menjadi kendala, yaitu *entry data* yang kurang dan mekanismenya masih separuh. Separuh *database*, separuh lagi dengan manual. *Database* belum bisa diakses secara langsung, kalau pun bisa *database* masih belum lengkap masih harus divalidasi. Sistem manual masih digunakan di Ditjen HKI karena otomasinya belum lengkap.

Berdasarkan praktik pendaftaran merek seperti tersebut di atas, pemerintah tengah berupaya mengharmonisasikan Undang-Undang Merek Nomor 15 Tahun 2001 (UU No.15/2001) dengan sistem madrid, khususnya dalam hal pendaftaran ke luar negeri. Harmonisasi tersebut merupakan langkah awal bagi pemerintah

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<sup>15</sup> Indonesia, *Undang-Undang Merek*, UU No.15, LN No.110 tahun 2001, TLN No. 4131, Ps. 13 ayat 1.

<sup>16</sup> Ibid., Ps. 18-20.

<sup>17</sup> Ibid., Ps. 27.

Indonesia untuk bergabung ke dalam *Madrid Protocol*<sup>18</sup>. Pembahasan mengenai pencantuman 'sistem pendaftaran merek secara internasional dengan *Madrid Protocol*' dalam revisi Undang-Undang Merek sedang 'digodok oleh Ditjen HKI. Saat ini pembahasannya berada di tingkat interdep<sup>19</sup>, Ditjen Peraturan Perundang-undangan Departemen Hukum dan HAM R.I. Pengaturan secara teknis mengenai sistem *Madrid Protocol* ini akan diatur lebih lanjut dalam PP. Pencantuman atau tidaknya sistem madrid dalam revisi Undang-Undang Merek ini lah yang kini menjadi perdebatan, apakah sistem itu perlu diadop oleh Indonesia atau tidak karena diadopnya sistem ini berkaitan dengan beberapa pemangku kepentingan.

Dengan akan adanya pengaturan mengenai sistem pendaftaran merek dengan sistem *Madrid Protocol* pada Undang-Undang Merek berarti peran kuasa hukum Indonesia dalam hal pendaftaran merek yang berasal dari luar negeri/asing tidak dibutuhkan lagi karena pendaftaran sudah dapat dilakukan langsung oleh pemohon. Hal ini dapat diartikan bahwa pasal 10 Undang-Undang Nomor 15 Tahun 2001 tidak lagi berlaku<sup>20</sup>. Revisi itu membuka peluang permohonan merek internasional melalui satu pintu atau langsung ke Ditjen Hak Kekayaan Intelektual (HKI) Depkum HAM tanpa harus melalui konsultan<sup>21</sup>.

Ada beberapa pertimbangan yang menyebabkan pemerintah ingin agar Indonesia mengadop sistem *Madrid Protocol* dan menjadi anggota *Madrid Protocol*, yakni<sup>22</sup>:

1. Indonesia wilayah strategis untuk perdagangan;
2. Indonesia pasar terbesar di Asia;
3. Aplikasi lokal jauh lebih banyak dari aplikasi luar negeri;
4. Banyaknya produk lokal untuk tujuan ekspor;

<sup>18</sup> Suwantin Oemar, *Madrid System, Perlindungan Merek secara Internasional*, website: <http://disperindag-jabar.go.id/?pilih=lihat&id=1999>, diakses 14 Februari 2007.

<sup>19</sup> Berdasarkan wawancara dengan Didik Taryadi.

<sup>20</sup> Pasal 10 ayat 1 Undang-Undang Nomor 15 Tahun 2001 menyatakan bahwa permohonan yang diajukan oleh Pemohon yang bertempat tinggal atau berkedudukan tetap di luar wilayah Negara Republik Indonesia wajib diajukan melalui Kuasanya di Indonesia.

<sup>21</sup> Suwantin Oemar, *Revisi Undang-Undang Merek Untuk Siapa*, website: [www.bisnis.com](http://www.bisnis.com), diakses 19 Mei 2008.

<sup>22</sup> Lihat dalam makalah Emawati Yunus, *The Role of National Intellectual Property Office in the Protection of Trademarks*, yang disampaikan pada acara seminar *The Madrid Protocol for International Registration of Marks the Benefits and Challenges for Indonesia*, di Hotel J.W. Marriot Jakarta, 24 April 2007.

5. Banyaknya user untuk melakukan pendaftaran di luar negeri;
6. Keinginan produk lokal berkompetisi dalam pasar global dan memperoleh reputasi internasional;
7. Meningkatkan PNBPN;
8. Delapan belas bulan pemberitahuan penolakan;
9. Memudahkan memasuki proses global bagi user;

Selain pertimbangan tersebut di atas, ada beberapa peran dan tantangan merek di masa depan yang menjadi faktor pendukung agar Indonesia menjadi anggota *Madrid Protocol*, yaitu<sup>23</sup>:

1. Menciptakan iklim perdagangan dan investasi yang kompetitif;
2. Mendukung perdagangan dan dunia usaha yang kompetitif dan spesifik di pasar global;
3. Memberikan reputasi internasional untuk ekspor produk dan berkarakter yang memiliki tradisi kebudayaan daerah;
4. Memasuki keanggotaan pada *Madrid Protocol* akan meningkatkan sistem operasional yang berstandar internasional dan menjadikan sistem perlindungan merek yang *attractive* bagi para investor di luar negeri dan meningkatkan pendaftaran sekaligus penambahan jumlah PNBPN.

Sebelum melakukan ratifikasi terhadap Protocol tersebut, ada baiknya pemerintah Indonesia melakukan riset mengenai untung ruginya pengratifikasian ini dengan melihat pada negara-negara lain yang telah maupun belum meratifikasi Protocol ini, sebagaimana yang dilakukan oleh beberapa negara di bawah ini.

Praktisi HKI di Pakistan berani menentang pengratifikasian *Madrid Protocol*, seperti dinyatakan berikut ini:

*...Government of Pakistan has still not decided signing the said Protocol, as there is certain kind of pressure domestically as the practitioners community firmly believes that this would greatly effect the economic and revenue activities of the local attorneys...<sup>24</sup>*

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<sup>23</sup> Lihat dalam artikel *Madrid Protocol: Untung Rugi Meratifikasi*, website: <http://www.belindarosalina.wordpress.com>, diakses tanggal 21 Mei 2008.

<sup>24</sup> Ibid.

Demikian pula di New Zealand,"...*The ministry of Economic Development is conducting preliminary research into the benefits of New Zealand acceding to the Protoco*<sup>25</sup>l."

Berdasarkan pendapat dari beberapa negara tersebut hendaknya membuat Indonesia lebih hati-hati dan bersiap-siap terhadap pengratifikasian *Madrid Protocol*.

Menurut Dr. Freddy Harris, SH., LLM., ACCS<sup>26</sup>, pendaftaran merek melalui sistem *Madrid Protocol* memang baik, namun yang perlu diperhatikan ialah seberapa jauh keuntungan sistem itu bila kita adopsi di Indonesia. Jangan sampai kita sudah meratifikasi untuk mengadopsi sistem tersebut, tapi kita tidak tahu apa yang harus diperbuat. Dengan kata lain, Indonesia tidak perlu terburu-buru mengadopsi sistem pendaftaran tersebut jika belum siap. Perlu diketahui bahwa negara Amerika Serikat (AS) saja, negara yang sudah demikian maju, memerlukan waktu sekitar 7 tahun, hingga akhirnya memutuskan untuk mengadopsi sistem *Madrid Protocol*<sup>27</sup>. Negara AS melakukan penelitian terlebih dahulu, baik di dalam maupun di luar, sosialisasi, menghitung *cost and lost benefit*, hingga akhirnya siap untuk meratifikasi dan menjadi anggota *Madrid Protocol*<sup>28</sup>. Contoh lain adalah negara Singapura. Singapura memerlukan waktu 4 tahun untuk menimbang-nimbang keikutsertaannya dalam sistem tersebut<sup>29</sup>.

Memang sistem pendaftaran merek secara internasional dengan sistem *Madrid Protocol* sangat baik dan perlu diadopsi di suatu negara, termasuk Indonesia. Berkaitan dengan hal tersebut, sejauh mana kesiapan dan kondisi Indonesia saat ini bila akan mengadopsi sistem tersebut dan kapan saat yang tepat Indonesia mulai mengaplikasikan sistem tersebut perlu dikaji.

<sup>25</sup> Ibid.

<sup>26</sup> Dr. Freddy Harris, SH., LLM., ACCS adalah Direktur Teknologi Informasi, Ditjen HKI. Dulu pernah bertugas di Komisi Banding Merek.

<sup>27</sup> Dr. Freddy Harris, SH., LLM, wawancara dilakukan oleh penulis, rekaman kaset, Jakarta, 24 September 2008.

<sup>28</sup> Ibid.

<sup>29</sup> Lihat dalam artikel *Protocol Madrid Upaya Perlindungan Merek Secara Internasional*, website: <http://www.depukumham.go.id/xDepkumhamWeb/xBerita/xUmum/protocol+madrid.htm>, diakses, 20 September 2008.

Bila pemerintah sudah melakukan ratifikasi terhadap *Madrid Protocol*, maka terbuka bagi pengusaha dari Indonesia untuk mencari perlindungan secara internasional atas merek dagang atau merek jasa di banyak negara.

### 1.2. Rumusan Masalah

Untuk lebih memfokuskan penulisan dalam penelitian ini dan berdasarkan latar belakang di atas, maka beberapa hal yang akan menjadi pokok permasalahan, yaitu:

1. Apakah keuntungan (*benefit*) jika Indonesia mengadopsi sistem *Madrid Protocol* bagi pendaftar merek lokal?
2. Bagaimana dengan pendaftar asing ke Indonesia, apakah akan mempermudah pemeriksaan karena dilakukan oleh lembaga yang berkredibilitas?
3. Bagaimana hubungan antara sistem *Madrid Protocol* dan merek terkenal?
4. Bagaimana perbandingan antara pendaftaran paten melalui sistem *PCT* dan pendaftaran merek melalui sistem *Madrid Protocol*?

### 1.3. Tujuan Penelitian

Berdasarkan pokok permasalahan yang ada, maka tujuan dari penelitian ini, yaitu untuk:

1. menganalisis keuntungan (*benefit*) jika Indonesia mengadopsi sistem *Madrid Protocol* bagi pendaftar merek lokal;
2. mengetahui bagaimana pemeriksaan terhadap pendaftar merek asing yang melakukan pendaftaran merek di Indonesia bila sistem *Madrid Protocol* diadopsi di Indonesia;
3. mengetahui hubungan antara sistem *Madrid Protocol* dan merek terkenal?
4. mengetahui perbandingan antara pendaftaran paten melalui sistem *PCT* dan pendaftaran merek melalui sistem *Madrid Protocol*.

#### 1.4. Kegunaan Penelitian

Kegunaan dari penelitian ini, yakni:

1. dapat memberi sumbangan pikiran dan pengetahuan bagi praktisi hukum, pemerintah, dan pelaku perdagangan mengenai penerapan sistem pendaftaran merek melalui sistem *Madrid Protocol*;
2. dapat memberikan kontribusi bagi pengembangan literatur hukum Hak Kekayaan Intelektual terutama berhubungan dengan pendaftaran merek dengan sistem *Madrid Protocol*.





## BAB II

### SISTEM PENDAFTARAN MEREK DAN PERLINDUNGAN MEREK TERKENAL

Berkaitan dengan sistem pendaftaran merek, dalam hal ini dihubungkan dengan beberapa pengaturan sistem pendaftaran merek. Ada beberapa alasan yang menyebabkan orang akan mendaftarkan mereknya, yakni:

1. Hak eksklusif dalam pasar/ekspor
2. Posisi market yang kuat
3. Pengembalian investasi
4. Kesempatan untuk melisensi atau menjual
5. Meningkatkan kekuatan dalam posisi pasar
6. Memberikan image yang positif bagi perusahaan
7. Meningkatkan kesempatan untuk memperoleh konsumen dari produk dan jasa<sup>25</sup>.

Paparan mengenai sistem pendaftaran merek di bawah ini akan dilihat dari pengaturan yang ada di *Trade Related Aspects on Intellectual Property Rights (TRIPs)*, Undang-Undang Merek Nomor 15 Tahun 2001 (UU No.15/2001) dan *Madrid Protocol*. Selain membahas mengenai sistem pendaftaran akan dijelaskan pula mengenai keuntungan dan kerugian apabila mengadopsi sistem *Madrid Protocol*.

Pengaturan yang ada di *TRIPs* untuk melihat hubungannya dengan perdagangan internasional karena merek merupakan salah satu bidang HKI yang dapat diperdagangkan, apalagi pembahasan mengenai sistem pendaftaran merek secara internasional erat kaitannya dengan produk ekspor. Produk ekspor ini tentu dapat diperdagangkan secara internasional.

HKI semakin erat kaitan dan pengaruhnya dalam perdagangan internasional pada dewasa ini<sup>26</sup>, terlebih sejak ditandatanganinya *Agreement Establishing the*

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<sup>25</sup> Yunus, op.cit.

*World Trade Organization (WTO)* beserta lampiran-lampirannya: Annex 1A, B, C; 2, 3 dan 4<sup>27</sup>. HKI menjadi semakin penting mengingat perannya yang begitu besar bagi kehidupan industri dan perdagangan internasional.

Bambang Kesowo berpendapat bahwa sisi perdagangan internasional memiliki arti yang sangat penting bagi Indonesia. Era di mana pembangunan di bidang ekonomi akan semakin ditumpukan pada sektor industri, terutama yang berorientasi ekspor memerlukan pengamanan bagi pemasarannya. Akses pasar internasional hanya akan aman apabila di sektor HKI kita mengikuti kesepakatan bersama, yaitu memberikan perlindungan hukum yang sama, cukup dan efektif.<sup>28</sup>

Memasuki milenium baru, HKI menjadi isu yang sangat penting, baik dalam forum nasional maupun internasional<sup>29</sup>. Hubungan antara perdagangan internasional dan hak kekayaan intelektual oleh ekonom, Keith E. Maskus menyimpulkan dalam bukunya<sup>30</sup>:

*I claim that IPRs can play an important and positive role in economic advancement, with the role becoming larger as economies grow richer. Even among poor economies, however, IPRs can be an important condition for bussiness development, so long as they are well structured and accompanied by appropriate collateral policies. This is the essential challenge as economies adopt stronger IPRs under the new global system<sup>31</sup>.*

## 2.1. Sistem Pendaftaran Merek

### 2.1.1. Berdasarkan *Trade Related Aspects on Intellectual Property Rights (TRIPs) Agreement*

Indonesia sebagai negara berkembang sudah menjadi anggota dan secara sah ikut dalam *TRIPs* melalui ratifikasi *WTO Agreement* dengan Undang-

<sup>26</sup> Cita Citrawinda Priapantja, *Hak Kekayaan Intelektual Tantangan Masa Depan*, cetakan I, (Jakarta: Fakultas Hukum Universitas Indonesia, 2003), 3.

<sup>27</sup> Tim Lindsey, *et al.*, *Hak Kekayaan Intelektual Suatu Pengantar*, cetakan .V, (Bandung: Alumni, 2006), 23.

<sup>28</sup> Priapantja, 8.

<sup>29</sup> *Ibid.*, hlm. 37.

<sup>30</sup> Keith E. Maskus, *Intellectual Property Rights in The Global Economy*, (Washington DC: Institute for International Economics, 2000), 170.

<sup>31</sup> Achmad Zen Umar Purba, *Hak Kekayaan Intelektual Pasca TRIPS*, cet. I, ed I, (Bandung: Alumni, 2005), 7.

Undang Nomor 7 Tahun 1994<sup>32</sup>. Dimasukkannya Kesepakatan *TRIPs (Trade Related on Intellectual Property Rights)*<sup>33</sup> dalam Paket Persetujuan *WTO* di tahun 1994 menandakan dimulainya era baru perkembangan HKI di seluruh dunia.

Adapun latar belakang pengaturan mengenai *TRIPs* adalah sebagai berikut<sup>34</sup>:

- a. Bahwa di era perdagangan global sejalan dengan konvensi-konvensi internasional yang telah diratifikasi Indonesia, peranan merek menjadi sangat penting, terutama dalam menjaga persaingan usaha yang sehat;
- b. Bahwa untuk hal tersebut di atas diperlukan pengaturan yang memadai tentang merek guna memberikan peningkatan layanan bagi masyarakat.

*TRIPs Agreement* dimaksudkan untuk memaksimalkan kontribusi sistem HKI terhadap pertumbuhan ekonomi melalui perdagangan dan investasi<sup>35</sup>. Di samping itu, *TRIPs Agreement* juga dimaksudkan untuk lebih meningkatkan perlindungan yang efektif dan menjamin prosedur dan langkah-langkah dalam perlindungan HKI agar tidak menjadi hambatan dalam hubungan perdagangan internasional<sup>36</sup>.

*TRIPs* mulai berlaku pada 1 Januari 1995, tetapi untuk negara berkembang seperti Indonesia diberikan waktu transisi selama lima tahun untuk penyesuaian hukum nasionalnya, sehingga akan berlaku efektif untuk Indonesia pada 1 Januari 2000.

Persetujuan *TRIPs* merupakan salah satu dari 15 topik yang dirundingkan dalam rangka Putaran Uruguay. Persetujuan *TRIPs* mengakui tentang adanya kebutuhan khusus negara-negara berkembang yang tidak mungkin dapat

<sup>32</sup> Ibid.

<sup>33</sup> Ketentuan-ketentuan tentang HKI diatur dalam Annex IC berjudul *Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS Agreement)*.

<sup>34</sup> Rachmadi Usman, *Hukum atas Hak Kekayaan Intelektual, Perlindungan dan Dimensi Hukumnya di Indonesia*, Cet.1, (Bandung: P.T. Alumni, 2003), 318-319.

<sup>35</sup> Priapantja, 37.

<sup>36</sup> Rusnadi, *Perjanjian Internasional Trade Related Aspects of Intellectual Property Rights (TRIPs) dan Kaitannya dengan Perlindungan HaKI Khususnya Hak Cipta dan Merek atas Barang Ekspor dan Impor di Indonesia*, Tesis Pasca Sarjana (Jakarta: Universitas Indonesia, 2004), 36.

sepenuhnya mengikuti standar-standar internasional yang ditetapkan oleh perjanjian yang berlaku secara umum, sehingga dalam beberapa hal tertentu perlu diberi kekhususan tertentu<sup>37</sup>.

Mengenai pendaftaran merek di dalam *TRIPs* dapat digambarkan dalam *article 16.1* yang menyatakan bahwa:

*Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.*

Pendaftaran merek dihubungkan dengan *article 16 TRIPs* ialah bahwa pemilik merek terdaftar akan mempunyai hak eksklusif untuk melarang pihak ketiga yang tidak mempunyai persetujuan daripadanya untuk memakai merek yang sama atau serupa untuk barang-barang atau jasa-jasa yang adalah sama atau menyerupai dengan barang-barang dan jasa-jasa untuk mana merek dagang bersangkutan telah terdaftar.

#### Dampak terhadap Pembentukan Hukum Indonesia

*TRIPs Agreement* mengharuskan tiap negara anggota menyediakan perangkat kerangka kerja hukum yang *effective* untuk melindungi hak-hak kekayaan intelektual. Perangkat peraturan baru yang dipersyaratkan *TRIPs* dalam pembentukan hukum nasional meliputi:

- (i) Pemberlakuan prinsip *GATT* 1994 dan konvensi-konvensi internasional mengenai hak kekayaan intelektual;
- (ii) Pengaturan tentang standar lingkup dan penggunaan *TRIPs*;
- (iii) Ketentuan hukum bagi pemberlakuan *TRIPs* dalam sistem hukum nasional;

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<sup>37</sup> Ibid.

- (iv) Ketentuan hukum yang memberi landasan bagi penyelesaian efektif bagi sengketa mengenai hak-hak kekayaan intelektual antarpemerintah; dan
- (v) Pengaturan transisi bagi pemberlakuan sepenuhnya dari *TRIPs*<sup>38</sup>.

Standar yang dikehendaki masuk dalam substansi hukum nasional meliputi:

- (i) *Copy right and related rights*;
- (ii) *Trademarks*;
- (iii) *Geographical indication*;
- (iv) *Industrial design*
- (v) *Patents*
- (vi) *Protection of undisclosed information*; dan
- (vii) *Control of anti competitive practices in contractual licences*.

Penerapan standar ini mengacu pada “*intellectual property convention*” serta prinsip “*national treatment*” dan “*most favoured nation*”<sup>39</sup>.

Dampaknya di bidang HKI, khususnya merek, yaitu penyempurnaan peraturan, meliputi tata cara pendaftaran merek, penghapusan merek terdaftar, perlindungan hukum merek terkenal, dan sanksi pidana. Di samping itu terdapat juga penambahan dan perubahan yang meliputi lingkup pengaturan perlindungan dan pengalihan merek jasa terdaftar.

Selain itu pemerintah juga mengeluarkan 5 Keputusan Presiden (Keppres). Keppres itu merupakan keputusan politik bangsa Indonesia untuk meratifikasi sejumlah konvensi dan perjanjian internasional di bidang HKI. Kelima keppres itu ialah Keppres No.15/1997 tentang Perubahan Keppres No.24/1979 (tentang pengesahan *Konvensi Paris for the Protection of Industrial Property dan Convention Establishing The World Intellectual Property Organization*, Keppres No.16/1997 tentang Pengesahan *Patent Cooperation Treaty (PCT)*, Keppres No.17/1997 tentang Pengesahan *Trademark Law Treaty*, Keppres No.18/1997 tentang Pengesahan *Berne*

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<sup>38</sup> Rusnadi, 58.

<sup>39</sup> Ibid, 59.

*Convention for the Protection of Literary and Artistic Works*), dan Keppres No.19/1997 (tentang Pengesahan *WIPO Copyrights Treaty*)<sup>40</sup>.

Lahirnya perangkat hukum di bidang HKI menandai keputusan hukum di bidang HKI, menandai keputusan bangsa Indonesia untuk secara resmi melangkah menuju era HKI. Dengan produk hukum itu berarti secara prinsip Indonesia telah mengikat diri pada ketentuan internasional yang mengatur tiga kelompok besar HKI, yaitu soal Hak Cipta, Paten, Merek.

Dampak di luar Indonesia, semua karya seni dan karya pemikiran orang Indonesia pun akan dilindungi di luar Indonesia. Orang-orang di luar Indonesia yang ingin menggunakan karya orang Indonesia harus mematuhi ketentuan yang telah disepakati, mulai dari sekedar mencantumkan siapa pencipta aslinya sampai membayar uang tertentu yang populer disebut royalti. Hal yang sama juga berlaku untuk merek dan paten<sup>41</sup>.

### **2.1.2. Berdasarkan Undang-Undang Nomor 15 Tahun 2001 tentang Merek (UU No.15/2001)**

Sebelum memaparkan tentang sistem pendaftaran merek yang diatur dalam peraturan ini, terlebih dahulu dijelaskan mengenai “Cara Memperoleh Hak atas Merek”. Caranya ialah dengan mengajukan permohonan pendaftaran merek ke Direktorat Merek, Ditjen HKI, Departemen Hukum dan HAM R.I.

Yang dimaksud dengan hak atas merek diatur dalam Pasal 3 UU No.15/2001 yang berbunyi:

Hak atas merek adalah hak eksklusif yang diberikan oleh negara kepada pemilik merek yang terdaftar dalam Daftar Umum Merek untuk jangka waktu tertentu dengan menggunakan sendiri merek tersebut atau memberikan izin kepada pihak lain untuk menggunakannya.

<sup>40</sup> Ibid, 61

<sup>41</sup> Jurnal Hukum Bisnis: *Pokok-pokok Kebijakan pembangunan Sistem HaKI Nasional* (Jakarta: Yayasan Pengembangan Hukum Bisnis, Volume 13 April 2001), 5.

Merek tidak dapat didaftar atas dasar permohonan yang diajukan oleh pemohon yang beritikad tidak baik<sup>42</sup>. Di samping itu, merek tidak dapat didaftar apabila merek tersebut mengandung salah satu unsur di bawah ini<sup>43</sup>:

- a. bertentangan dengan peraturan perundang-undangan yang berlaku, moralitas agama, kesusilaan, atau ketertiban umum;
- b. tidak memiliki daya pembeda;
- c. telah menjadi milik umum; atau
- d. merupakan keterangan atau berkaitan dengan barang atau jasa yang dimohonkan pendaftarannya.

Hak atas merek berupa sistem. Ada beberapa sistem hak atas merek, namun sistem hak atas merek pada umumnya yang dianut negara-negara di dunia, yakni:

1. Sistem Konstitutif
2. Sistem Deklaratif.

Ad.1 Undang-Undang Merek menganut sistem konstitutif, yang artinya hak atas merek timbul karena adanya pendaftaran. Seseorang yang ingin memperoleh hak atas merek diwajibkan untuk mengajukan permintaan pendaftaran kepada Ditjen HKI terlebih dahulu, kemudian diberikan haknya oleh Ditjen HKI<sup>44</sup>. Dengan adanya sistem konstitusi ini, maka dengan adanya pendaftaran akan memberi perlindungan terhadap suatu merek. Perlindungan hukum atas merek hanya akan berlangsung apabila hak tersebut dimintakan pendaftarannya. Oleh karena itu, pendaftaran merupakan suatu hak mutlak untuk terjadinya hak atas merek. Tanpa pendaftaran tidak ada hak atas merek, sehingga tidak ada perlindungan. Apabila telah didaftarkan dan memperoleh sertifikat merek, maka ia akan dilindungi dan orang lain tidak akan memakai merek yang sama. Dengan kata lain, ada hak eksklusif bagi pendaftar merek tersebut<sup>45</sup>.

<sup>42</sup> Indonesia, Undang-Undang Merek, UU No.15, LN No.110 tahun 2001, TLN No. 4131, ps.4.

<sup>43</sup> Ibid, ps.5.

<sup>44</sup> Mustahdi, *Implementasi Persetujuan Trade Related Aspects of Intellectual Property Rights (TRIPs) dalam Undang-Undang Merek di Indonesia*, Tesis Program Pasca Sarjana (Jakarta:Universitas Indonesia, 2001), 131.

<sup>45</sup> Ibid.



Kebaikan dari sistem konstitutif ialah lebih menjamin kepastian hukum karena dengan terdaftarnya merek seseorang di Ditjen HKI, maka pendaftar dianggap sebagai pemilik merek yang sah<sup>46</sup>.

Ad.2 Sistem deklaratif adalah suatu sistem di mana hak atas merek timbul karena pemakaian pertama oleh pihak pemilik merek, walaupun merek tersebut tidak didaftarkan oleh pemilik merek.

Sistem ini memiliki kelemahan karena tidak diketahui kapan suatu merek dipakai seseorang, sehingga bila terjadi sengketa dua pihak, yaitu bila suatu pihak meng-klaim bahwa dia adalah pertama kali memakai merek tersebut, sedangkan pihak lain juga mengklaim hal yang sama, hal ini akan menyulitkan pembuktiannya<sup>47</sup>.

Tata cara pengajuan permohonan pendaftaran merek diatur pada Pasal 7 UU No.15/2001. Dalam Undang-undang tersebut diatur antara lain, permohonan harus diajukan secara tertulis dalam bahasa Indonesia kepada Direktorat Jenderal dengan mencantumkan identitas dan persyaratan lain yang diatur pada Pasal tersebut. Permohonan harus ditandatangani Pemohon atau Konsultan HKI selaku kuasanya dengan disertai lampiran bukti pembayaran biaya.

Tahap kedua adalah Pemeriksaan Formalitas. Dalam tahap ini, apabila persyaratan pendaftaran merek dinyatakan kurang lengkap pemohon harus memenuhi persyaratan tersebut dalam tempo maksimal 2 bulan. Apabila hal tersebut berkaitan dengan hak prioritas, maka pemohon harus memenuhi persyaratan dalam waktu maksimal 3 bulan. Apabila setelah 3 bulan tidak terpenuhi, maka permohonan dianggap ditarik kembali. Apabila persyaratan administratif telah terpenuhi, maka permohonan tersebut diberikan Tanggal Penerimaan.

Tahap ketiga, yaitu Pemeriksaan Substantif dilakukan paling lama 30 hari terhitung sejak tanggal penerimaan permohonan dan memakan waktu paling lama 9 bulan.<sup>48</sup>

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<sup>46</sup>Iman Sjahputra Tunggal, Heri Herjandono dan Parjio, *Hukum Merek di Indonesia*, (Jakarta: Harvarindo, 2005), 53.

<sup>47</sup> Ibid., 55.

<sup>48</sup> Indonesia, ps. 18.

Apabila Permohonan dapat didaftar, atas persetujuan Direktur Jenderal maka Permohonan tersebut diumumkan dalam Berita Resmi Merek. Apabila Permohonan tidak dapat didaftar, maka harus diberitahukan kepada Pemohon dengan menyebutkan alasannya dan dalam waktu maksimal 30 hari pemohon dapat menyampaikan keberatan atau tanggapannya dengan menyebutkan alasan. Apabila tidak terdapat keberatan dari pemohon, maka Direktorat Jenderal menetapkan keputusan tentang penolakan Permohonan tersebut. Apabila keberatan yang disampaikan oleh pemohon dapat diterima oleh pemeriksa, maka atas persetujuan Direktur Jenderal, permohonan tersebut dapat diumumkan dalam Berita Resmi Merek, begitupun sebaliknya apabila keberatan tidak dapat diterima, maka ditetapkan keputusan tentang penolakan permohonan tersebut, dengan menyebutkan alasan yang diberitahukan secara tertulis kepada pemohon atau kuasanya.

Pada Pasal 21, disebutkan bahwa 10 hari terhitung sejak tanggal disetujuinya permohonan untuk didaftar, Direktorat Jenderal mengumumkan permohonan tersebut dalam Berita Resmi Merek. Pengumuman tersebut berlangsung selama 3 bulan.<sup>49</sup>

Selama jangka waktu 3 bulan pengumuman, setiap pihak dapat mengajukan keberatan secara tertulis dengan dikenakan biaya, kepada Direktorat Jenderal.<sup>50</sup> Keberatan tersebut dapat diajukan bila, terdapat alasan yang cukup dan disertai bukti bahwa merek yang dimohon pendaftarannya, berdasarkan UU Merek tidak dapat didaftar.<sup>51</sup> Dan apabila terjadi hal demikian, Direktorat Jenderal dalam waktu paling lama 14 hari terhitung sejak tanggal penerimaan keberatan harus mengirimkan salinan surat yang berisikan keberatan tersebut kepada pemohon merek atau kuasanya.<sup>52</sup>

Pasal 25 memberikan hak pada pemohon merek atau kuasanya untuk mengajukan keberatan tersebut paling lama 2 bulan sejak tanggal penerimaan salinan keberatan kepada Direktorat Jenderal.

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<sup>49</sup> Ibid., ps .22.

<sup>50</sup> Ibid., ps. 24(1).

<sup>51</sup> Ibid., ps. 24(2).

<sup>52</sup> Ibid., ps. 24(3).

Terhadap keberatan tersebut lalu diadakan pemeriksaan kembali dalam tempo paling lama 2 bulan terhitung sejak berakhirnya jangka waktu pengumuman. Kemudian hasil dari pemeriksaan kembali tersebut diberitahukan kepada pihak yang mengajukan keberatan. Apabila keberatan tersebut dapat diterima, maka diberitahukan secara tertulis kepada pemohon bahwa permohonan tidak dapat didaftar atau ditolak, dan dalam hal demikian pemohon atau kuasanya dapat mengajukan banding. Dalam hal ternyata keberatan tidak dapat diterima, maka atas dasar persetujuan Direktur Jenderal, permohonan dapat didaftar dalam Daftar Umum Merek<sup>53</sup>.

Apabila tidak ada keberatan dari pihak manapun, Direktorat Jenderal mengeluarkan Sertifikat Merek kepada pemohon atau kuasanya paling lama 30 hari terhitung sejak tanggal berakhirnya jangka waktu pengumuman.

Apabila keberatan tidak dapat diterima, maka Direktorat Jenderal menerbitkan dan memberikan Sertifikat Merek kepada pemohon atau kuasanya dalam waktu paling lama 30 hari terhitung sejak tanggal permohonan tersebut disetujui untuk didaftar dalam Daftar Umum Merek. (Lihat Lampiran 1, Prosedur Pendaftaran Merek Menurut UU No.15/2001).

Pengaturan mengenai permohonan untuk 2 (dua) kelas barang atau lebih dan/atau jasa dapat diajukan dalam satu permohonan. Permohonan tersebut harus menyebutkan jenis barang dan/atau jasa yang termasuk dalam kelas yang dimohonkan pendaftarannya<sup>54</sup>.

Permohonan pendaftaran merek yang diajukan ke Ditjen HKI tidak hanya berasal dari dalam negeri (domestik), namun adapula pendaftaran merek yang diajukan oleh pemohon dari luar negeri (asing) ke Indonesia. Pengajuan permohonan pendaftaran merek yang berasal dari luar negeri perlu melalui Kuasanya di Indonesia. Permohonan yang demikian diatur dalam Pasal 10 ayat (1), yang menyatakan bahwa "Permohonan yang diajukan oleh Pemohon yang bertempat tinggal atau berkedudukan tetap di luar wilayah Negara Republik Indonesia wajib diajukan melalui Kuasanya di Indonesia."

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<sup>53</sup> Ibid., ps. 26.

<sup>54</sup> Ibid., ps. 8 ayat (1) dan (2).

Sehubungan dengan pendaftaran merek ke luar negeri atau pun berasal dari luar negeri, dikenal adanya hak prioritas. Yang dimaksud dengan hak prioritas, seperti tersebut di bawah ini.

Hak prioritas adalah hak pemohon untuk mengajukan permohonan yang berasal dari negara yang tergabung dalam *Konvensi Paris for the Protection of Industrial Property* atau *Agreement Establishing the World Trade Organization* untuk memperoleh pengakuan bahwa tanggal penerimaan di negara asal merupakan tanggal prioritas di negara tujuan yang juga anggota salah satu dari kedua perjanjian itu selama pengajuan tersebut dilakukan dalam kurun waktu yang telah ditentukan berdasarkan *Konvensi Paris for the Protection of Industrial Property*<sup>55</sup>.

Permohonan Pendaftaran Merek dengan Hak prioritas diatur dalam Pasal 11 UU No.15/2001, yaitu:

Permohonan dengan menggunakan Hak prioritas harus diajukan dalam waktu paling lama 6 (enam) bulan terhitung sejak tanggal penerimaan permohonan pendaftaran merek yang pertama kali diterima di negara lain, yang merupakan anggota *Konvensi Paris for the Protection of Industrial Property* atau anggota *Agreement Establishing the World Trade Organization*.

Pemohon terlebih dahulu menyerahkan persyaratan administratif, kemudian Ditjen melakukan pemeriksaan terhadap kelengkapan persyaratan pendaftaran merek (lihat Pasal 7 sampai Pasal 12 Undang-Undang Merek).

Masalah pendaftaran merek ini tentu berkaitan dengan biaya pendaftaran. Untuk setiap pengajuan permohonan atau permohonan perpanjangan merek, permohonan petikan Daftar Umum Merek, pencatatan pengalihan hak, perubahan nama dan/atau alamat pemilik merek terdaftar, pencatatan perjanjian lisensi, keberatan terhadap permohonan, permohonan banding serta lain-lainnya yang ditentukan dalam Undang-Undang Merek wajib dikenai biaya yang besarnya ditetapkan dengan Peraturan Pemerintah.

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<sup>55</sup> Ibid, ps.1 angka 14.

### 2.1.3. Berdasarkan *Madrid Protocol*

Sistem pendaftaran merek secara internasional diatur berdasarkan dua peraturan, yakni *Madrid Agreement Concerning the International Registration of Marks*, dan *the Protocol Relating to the Madrid Agreement*<sup>56</sup>. Sistemnya diadministrasikan oleh *International Bureau of WIPO (World Intellectual Property Organization)*<sup>57</sup>.

*Madrid Agreement* yang ditandatangani pada tanggal 14 April 1891 telah direvisi sebanyak enam kali dari tahun 1900 hingga 1967 untuk menambah jumlah negara-negara anggota. Berdasarkan *Agreement* ini *International Application* hanya dapat didasarkan pada merek nasional yang telah terdaftar. Berangkat dari *Madrid Agreement* ini maka dibuat *Madrid Protocol*, dengan kata lain *Madrid Protocol* dibuat sebagai tindak lanjut dari *Agreement* atau protokol yang menyempurnakan beberapa hal substansial dari *Madrid Agreement*.

*Protocol* ini berlaku sejak 1 April 1996 dengan memperkenalkan inovasi-inovasi pada sistem madrid dengan tujuan untuk memperluas cakupan geografis dari pendaftaran merek atau melakukan harmonisasi sistem pendaftaran merek. Hingga saat ini anggota dari Madrid Union telah berjumlah kurang lebih delapan puluh negara, dimana yang meratifikasi *Madrid Protocol* saja berjumlah 23 negara dan sisanya adalah negara yang meratifikasi baik *Madrid Agreement* maupun *Madrid Protocol*<sup>58</sup>. (Lihat Lampiran 2, Negara Anggota Madrid).

Beberapa negara seperti India, Argentina, Brazil serta Thailand saat ini juga sedang melakukan kajian mengenai urgensi untuk meratifikasi *Madrid*

<sup>56</sup> *The Madrid Agreement Concerning the International Registration of Marks, which dates from 1891, and the Protocol Relating to the Madrid Agreement, which was adopted in 1989, entered into force on December 1, 1995, and came into operation on April 1, 1996.*

<sup>57</sup> *The Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement.*

<sup>58</sup> Lihat dalam makalah Alan M. Datri (b), *International Registration of Marks uUnder the Madrid Agreement and the Madrid Protocol: Latest Development and Advantages for Developing Countries*, yang disampaikan pada seminar *The Madrid Protocol for International Registration of Marks the Benefits and Challenges for Indonesia*, Hotel J.W. Marriot Jakarta, 24 April 2007.

negara yang merupakan anggota dari *Madrid Protocol*, dengan cara mengajukan permohonan internasional (*international application*) di Kantor Merek negara asal (*office of origin*).<sup>63</sup>

Adapun yang harus dipenuhi dalam pendaftaran antara lain harus menyertakan nama dan alamat pemohon,<sup>64</sup> serta keterangan apakah yang bersangkutan merupakan warga negara atau badan hukum,<sup>65</sup> serta nama dan alamat dari perwakilan pemohon di negara tujuan (*designated country*) bila ada<sup>66</sup>. Permohonan yang terdiri atas berbagai macam warna sebagai keistimewaan pada mereknya, berdasarkan Pasal 3 ayat (3) terdapat beberapa persyaratan yang harus disertakan pada aplikasi pendaftaran internasionalnya, yaitu:

1. Pernyataan atas fakta pada aplikasi internasionalnya yang menyebutkan spesifikasi warna atau kombinasi warna yang diklaim;
2. Melampirkan dalam aplikasi internasionalnya kopi warna yang tertera pada mereknya yang akan dilampirkan dalam notifikasi yang diberikan kepada *IB*. Jumlah kopi akan ditentukan berdasarkan peraturan.

Apabila pemohon hendak menggunakan hak prioritasnya sesuai *Konvensi Paris* maka harus menyertakan pernyataan menyangkut hak prioritas tersebut beserta nama Kantor Merek tempat pendaftaran yang menghasilkan hak prioritas tersebut serta nomornya.<sup>67</sup> Contoh merek (*reproduction of mark*) yang jelas,<sup>68</sup> serta klasifikasi dari merek tersebut.<sup>69</sup> Juga harus disertakan deskripsi mengenai permohonan pendaftaran merek (*basic application*) atau pendaftaran awal (*basic registration*) dalam bahasa yang sama dengan bahasa

<sup>63</sup> Article 2, *Madrid Protocol*; lihat John Murphy, *Demystifying Madrid Protocol*, *Northwestern Journal of Technology and Intellectual Property*, (Volume 2, No. 2, Spring 2004), 24.

<sup>64</sup> *Common Regulations Under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to That Agreement (Common Regulations)*, Rule 9(a)(i).

<sup>65</sup> *Ibid.*, Rule 9(b)(i), (ii).

<sup>66</sup> *Ibid.*, Rule 9(a)(iii).

<sup>67</sup> *Ibid.*, Rule 9(a)(iv).

<sup>68</sup> *Ibid.*, Rule 9(a)(v).

<sup>69</sup> *Ibid.*, Rule 9(a)(viii), (ix), (x).

yang digunakan dalam permohonan internasional,<sup>70</sup> dan klasifikasi mengenai kelas barang dan jasa mengacu pada *Nice Agreement*, sesuai klasifikasi yang diakui di negara asal.<sup>71</sup>

Kantor merek tersebut harus memberikan pernyataan bahwa informasi yang dimuat pada aplikasi internasional cocok dengan informasi yang ada di dalam aplikasi dasar atau pendaftaran kemudian mengirimkannya kepada IB<sup>72</sup>. Pada saat permohonan internasional diterima oleh Kantor Merek, maka kepada pemohon, diberikan tanggal penerimaan (*date of international application*).<sup>73</sup>

Permohonan internasional akan diajukan ke *WIPO* apabila dianggap memenuhi persyaratan oleh Kantor Merek negara asal.<sup>74</sup> Selanjutnya permohonan internasional akan diperiksa oleh *WIPO* selaku *International Bureau*. Pemeriksaan di tahap ini hanyalah pemeriksaan formalitas, apakah terhadap permohonan internasional tersebut, *WIPO* dapat mengeluarkan pendaftaran internasional (*international registration*) atau tidak. Dalam tahap ini *WIPO* tidak memeriksa unsur pembeda maupun deskripsi dari merek tersebut secara lebih lanjut, mengenai pemeriksaan tersebut diserahkan kepada Kantor Merek negara tujuan (*designated office*), dengan menggunakan Undang-undang maupun regulasi merek negaranya masing-masing.<sup>75</sup> Yang dilakukan *WIPO* dalam tahap ini hanya memeriksa klasifikasi barang dan jasa yang tertera di permohonan internasional tersebut, apakah sudah memenuhi standar internasional yang disebutkan di *Nice Agreement* atau belum.<sup>76</sup> Apabila belum memenuhi kriteria, maka *WIPO* akan melengkapi klasifikasi atas barang dan jasa, atau dapat meminta bantuan kepada pemohon (atau perwakilannya) untuk mengubah atau menambahkan keterangan terhadap detail klasifikasi

<sup>70</sup> Ibid., Rule 9(a)(xi).

<sup>71</sup> Ibid., Rule 9(a)(xiii).

<sup>72</sup> *Madrid Protocol*, article 3 (1).

<sup>73</sup> *Madrid Protocol*, Article 3(1)(i)(ii).

<sup>74</sup> Agar tanggal yang tercantum pada pendaftaran internasional (*date of international registration*) sama dengan tanggal yang tercantum pada permohonan internasional (*date of international application*), permohonan internasional harus diajukan ke *WIPO* paling lambat dua bulan setelah tanggal permohonan internasional. Lewat dari dua bulan, tanggal yang tercantum pada pendaftaran internasional adalah tanggal di mana *WIPO* menerima permohonan internasional tersebut, lihat Article 3 (4), *Madrid Protocol*.

<sup>75</sup> David Tatham, *The International Registration System: Practising Law Institute Patents, Copyrights, Trademarks, and Literary Property Course Handbook Series (488 PLI/Pat 43) 4*, diakses 16 November 2008.

<sup>76</sup> Ibid.

barang dan jasa yang dianggap bias, salah atau kurang lengkap.<sup>77</sup> Bila sudah benar *IB* akan mendaftarkan merek tersebut pada International Registration, memberitahukan kantor merek negara asal dan mengirim sertifikat pendaftaran pada pemegang

Terhadap ketidaksesuaian prosedur permohonan internasional tersebut, *WIPO* dapat mengeluarkan “*notice of irregularity*”, yang mengharuskan pemohon untuk memperbaharui permohonan internasional tersebut dalam waktu 3 bulan.<sup>78</sup> Namun bila permohonan internasional tersebut dinyatakan memenuhi persyaratan untuk didaftar, maka *WIPO* akan menetapkan tanggal dan nomor pendaftaran internasional, melakukan pencatatan merek tersebut dalam *international register* dan memberitahukan Kantor Merek negara tujuan atas pendaftaran internasional tersebut.<sup>79</sup> *WIPO* juga akan memuat pendaftaran internasional di dalam *WIPO Gazette*.

Kantor Merek negara tujuan lalu akan memeriksa pendaftaran internasional tersebut berdasarkan Undang-undang maupun regulasi mereknya masing-masing. Negara tujuan berhak menolak pendaftaran internasional tersebut di negaranya atas dasar regulasi merek nasionalnya.<sup>80</sup> Apabila merek tersebut tidak dapat didaftar di negara tersebut, maka Kantor Merek negara tujuan akan menyampaikan penolakan, atau yang lebih dikenal dengan “*provisional refusal*” kepada *WIPO* agar mencatat penolakan tersebut di *international register* dan *WIPO Gazette*, serta diberitahukan ke pihak pemohon terkait dengan tidak dapat didaftarkannya merek di negara tersebut. Periode pemeriksaan dapat berlangsung maksimal 12 hingga 18 bulan.<sup>81</sup>

Penyelesaian terhadap penolakan tersebut lalu akan diteruskan melalui bantuan Konsultan HKI lokal di negara tersebut.<sup>82</sup> Apabila dalam tempo

<sup>77</sup> Ibid.

<sup>78</sup> *Common Regulations, Rule 11 (2)(b)*.

<sup>79</sup> David Tatham, loc.cit., hal. 3.

<sup>80</sup> *Madrid Protocol, Article 5(1)*.

<sup>81</sup> *Summary of the Madrid Agreement Concerning the International Registration of Marks (1891) and the Protocol Relating to that Agreement (1989)*, website: [http://www.WIPO.int/treaties/en/registration/madrid\\_protocol/summary/](http://www.WIPO.int/treaties/en/registration/madrid_protocol/summary/), diakses 15 November 2008.

<sup>82</sup> Roya Ghafele, “*SMEs or Micromultinationals (Leveraging the Madrid System for International Branding)*”, website: [http://www.WIPO.int/sme/en/documents/madrid\\_system\\_branding.htm](http://www.WIPO.int/sme/en/documents/madrid_system_branding.htm), diakses 22 November 2008.



hingga 12 atau 18 bulan, tergantung jangka waktu maksimal pemeriksaan di negara tersebut, pemeriksa merek di negara tujuan tidak menyampaikan “*provisional refusal*” maupun pemberitahuan terkait kemungkinan adanya penolakan dari pihak ketiga terkait dengan didaftarkannya merek tersebut, maka merek tersebut wajib untuk dilindungi,<sup>83</sup> sama halnya dengan merek yang didaftarkan secara langsung di negara tersebut.<sup>84</sup> (Lihat Lampiran 3, Prosedur Pendaftaran Merek dengan Sistem *Madrid Protocol*).

Mengenai biaya ada 3 macam biaya yang harus dibayar oleh pemohon apabila menggunakan sistem madrid, yaitu:

- a. *Basic Fee* yang dibayar kepada Kantor Merek negara asal, sebesar 653 Swiss Francs (Sekitar US\$ 590);
- b. *Supplementary Fee*, sebesar 73 Swiss Francs (sekitar US\$ 66), untuk setiap kelas barang dan jasa, mengacu pada klasifikasi *Nice Agreement*, dihitung setelah klasifikasi ketiga dari kelas barang atau jasa tersebut<sup>85</sup>;
- c. *Complimentary Fee* mengacu pada *Madrid Protocol* sebesar 73 Swiss Francs (sekitar US\$ 66), dibayar pemohon pendaftaran kepada kantor merek negara asal atau kantor merek setempat untuk setiap pendaftaran ke satu negara tujuan. Misalnya, apabila pemohon hendak mendaftarkan mereknya di 10 negara, maka *complimentary fee* yang harus dibayarkan ialah sebesar  $US\$66 \times 10 = US\$660$ .

Biaya *complimentary fee* ke setiap negara tidaklah sama, namun dapat dipastikan lebih murah daripada biaya melakukan pendaftaran merek secara langsung di negara tersebut.<sup>86</sup>

<sup>83</sup> Ibid.

<sup>84</sup> Jangka waktu perlindungan yang diberikan melalui *Madrid System* adalah 10 tahun, lihat *Article 6(1) Madrid Protocol*.

<sup>85</sup> Setiap tahunnya, “*complementary fee*” dan “*supplementary fee*” yang terkumpul akan dijumlahkan dan dibagikan kepada negara-negara anggota berdasarkan jumlah Negara yang dituju; lebih lanjut lihat David Tatham, loc.cit., hal. 3.

<sup>86</sup> Paul Sputnik, “*Protecting Trademarks Under the Madrid Protocol*”, *Los Angeles Lawyer* (27-APR L.A. Law. 26, April 2004): 2; lebih lanjut mengenai biaya pendaftaran ke setiap negara yang tergabung dalam *Madrid Union*, pemohon atau kuasanya dapat melihat *WIPO Fee Calculator*, website: <http://www.WIPO.int/madrid/en/fees/calculator.jsp>, diakses 15 November 2008.

Biaya-biaya ini dapat dibayarkan langsung kepada *IB* atau kantor asal menyetujui untuk menerima dan meneruskan biaya-biaya tersebut melalui Kantor tersebut. Biaya individual ditransfer oleh *IB* kepada pihak-pihak yang terikat mengingat telah dibayarkan, dimana biaya pelengkap dan biaya tambahan dibagikan di antara pihak-pihak yang terikat yang tidak menerima biaya-biaya individual sesuai proporsi angka yang diatur untuk masing-masing.

Pendaftaran internasional berlaku selama 10 tahun. Dapat diperbaharui untuk periode 10 tahun selanjutnya dalam hal telah adanya pembayaran biaya-biaya yang dipersyaratkan.

## **2.2. Prosedur Pendaftaran Merek di Indonesia Dikaitkan dengan Prosedur Pendaftaran Merek Sistem Madrid**

Sebagai konsekuensi masuknya Indonesia kedalam *Madrid Union*, maka Indonesia harus melakukan adopsi dan sinkronisasi peraturan di bidang pendaftaran merek yang ada saat ini, dengan prosedur pendaftaran merek dalam *Madrid Protocol*.

Dengan menggunakan sistem madrid, pelaku usaha asing yang hendak mendaftarkan mereknya di Indonesia, tidak lagi harus mengajukan permohonan tertulis kepada Kantor Merek Indonesia melalui jasa Konsultan HKI, sebagaimana yang tertera pada Pasal 7 UU Merek. Terkait dengan hal tersebut, Indonesia harus tunduk pada ketentuan *Article 2(1)* serta *Article 3 bis* yang menyebutkan bahwa pemohon merek dapat mengajukan permohonan internasional melalui Kantor Merek negara asal pemohon.

Terkait prosedur pencatatan pengalihan hak serta lisensi atas merek juga menjadi hal yang harus disesuaikan dengan ketentuan sistem madrid. Apabila Indonesia bergabung ke dalam *Madrid Union*, Pasal 39 UU Merek mengenai perubahan nama dan/atau alamat pada merek terdaftar, Pasal 40 ayat 2 UU Merek mengenai pencatatan pengalihan hak atas merek dan Pasal 43 ayat 3 UU merek mengenai pencatatan perjanjian lisensi menjadi tidak berlaku lagi, karena pemilik baru tidak perlu mencatatkan perubahan tersebut ke Direktorat Jenderal.<sup>87</sup>

<sup>87</sup> Mengacu pada ketentuan *Madrid Protocol*, bila pemilik pendaftaran internasional hendak mengalihkan hak mereknya kepada pihak lain, maka pengalihan hak tersebut dicatat melalui WIPO, lihat *Madrid Protocol Article 9*.

Sementara di sisi pelaku usaha asing, dengan semakin mudahnya prosedur untuk mendaftarkan merek di Indonesia, maka jumlah pendaftaran internasional yang diperiksa kantor merek juga akan meningkat. Apabila jumlah pendaftaran internasional meningkat, maka jumlah *provisional refusal* yang terjadi juga dapat meningkat.<sup>90</sup> Apabila terdapat *provisional refusal* atau oposisi, maka peran Konsultan HKI tetap diperlukan, bahkan ada kemungkinan untuk meningkat seiring dengan penggunaan sistem madrid di Indonesia.<sup>91</sup>

### 2.3.2. Kerugian bila Indonesia Mengadopsi Sistem *Madrid Protocol*

Ada beberapa kerugian yang mungkin dihadapi sehubungan dengan diadopsinya sistem *Madrid Protocol* di negara kita, di antaranya:

#### 2.3.2.1. Bagi Pelaku Usaha/Pemilik Merek

Walaupun sekilas *Sistem madrid* memberikan kemudahan bagi pelaku usaha dari segi prosedural, *Sistem madrid* juga memiliki kelemahan, apabila dalam waktu 5 tahun pertama masa pendaftaran internasional, permohonan pendaftaran atau pendaftaran awal dari suatu merek dibatalkan atau ditolak di negara asal maka hal tersebut akan berakibat pada ditolaknya pendaftaran internasional di semua negara tujuan.<sup>92</sup> Hal tersebut lebih dikenal dengan konsekuensi "*central attack*".

Apabila "*central attack*" terjadi dan pendaftaran internasional dari suatu merek dibatalkan di negara tujuan, maka pemilik merek dapat melakukan "*transformation*" untuk merubah pendaftaran internasional tersebut menjadi pendaftaran nasional. Terkait dengan tanggal prioritas merek tersebut yang timbul dari adanya hak prioritas, pendaftaran nasional akan tetap memiliki tanggal prioritas maupun tanggal pendaftaran yang

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Practising Law Institute Patents, Copyrights, Trademarks, and Literary Property Course Handbook Series, (Practising Law Institute: September, 1997): 4.

<sup>90</sup> Charles Prat, *Why The Madrid Protocol Can Benefit Practicioners*, website: <http://www.managingip.com>, (Managing Intell. Prop. 24, Juli-Agustus 2003),25.

<sup>91</sup> Edwin Wallis, *The Madrid Protocol: Will This International System Succeed in The United States*, UCLA Journal of Law & Technology, 2004, 5.

<sup>92</sup> John Murphy, *Demystifying The Madrid protocol*, Northwestern Journal Of Technology and Intellectual Property, Vol.2, number 2, 247.

sama seperti yang tercantum pada pendaftaran internasional.<sup>93</sup> Agar “*transformation*” tersebut berlaku di setiap negara tujuan, maka dalam waktu tiga bulan sejak tanggal pembatalan maupun penolakan, pemilik merek harus mengajukan permohonan pendaftaran merek secara langsung di setiap negara tujuan. Walaupun “*transformation*” dapat dilakukan untuk menanggulangi “*central attack*”, pemilik merek tidak dapat memperoleh efisiensi biaya pendaftaran, karena selain biaya yang digunakan untuk melakukan pendaftaran melalui *Sistem madrid* terbuang percuma karena pada akhirnya perlindungan dibatalkan, pemilik merek juga harus mengeluarkan biaya ekstra untuk mengajukan permohonan pendaftaran merek secara langsung di setiap negara tujuan agar mereknya tetap dapat dilindungi.<sup>94</sup>

#### 2.3.2.2. Bagi Konsultan HKI

Dengan diratifikasinya *Madrid Protocol* maka tentunya Pasal yang menyatakan bahwa semua pendaftaran HKI harus melalui Konsultan HKI akan dikesampingkan, maka pendaftaran melalui *Madrid Protocol* dapat dilakukan langsung ke kantor merek melalui *IB*. Tentunya Konsultan HKI akan kehilangan pendapatan melalui pendaftaran secara *significant* mengingat negara yang telah meratifikasi *Madrid Protocol* sudah cukup banyak yakni lebih dari 80 negara, termasuk juga hilangnya pemasukan dari *service renewal*. Apabila dikatakan bahwa Konsultan HKI akan mendapatkan kenaikan melalui proses litigasi belum tentu dapat terbukti benar mengingat sejauh ini penolakan terhadap merek tidak terlalu banyak dibandingkan dengan pendaftaran yang masuk sebagaimana digambarkan dalam data statistic 2001, 2002, 2003 dimana total penolakan adalah sebesar 10% dari permohonan pendaftaran merek yang masuk.

<sup>93</sup> *Madrid Protocol, Article 9 Quinquies.*

<sup>94</sup> Oleh karena itu, apabila “*central attack*” terjadi maka pada akhirnya biaya pendaftaran merek yang harus dikeluarkan justru menjadi jauh lebih mahal.

### 2.3.2.3. Bagi Kantor Merek

Kantor Merek tidak terlalu mengalami kerugian kecuali angka pendaftaran merek menjadi turun. Karena apabila pendaftaran tetap jumlahnya, biaya juga tidak lebih besar dibandingkan permohonan melalui nasional. Yang pasti pekerjaan kantor merek menjadi jauh lebih banyak karena harus langsung berkorespondensi dan meresponse secara lebih cepat kepada *IB*.

### 2.3.2.4. Bagi Pemerintah

Tentunya dengan pendapatan yang berkurang pada Konsultan HKI akan berdampak pada penerimaan pajak oleh pemerintah.

### 2.3.2.5. Bagi Indonesia

Penggunaan *Madrid System* di Indonesia berpotensi untuk mengurangi devisa negara yang berasal dari pajak yang dibayarkan pemohon merek baik secara langsung maupun melalui Konsultan HKI dalam mengajukan permohonan pendaftaran merek di Indonesia.

## 2.4. Pengaturan Mengenai Merek Terkenal

Pengaturan tentang perlindungan bagi merek terkenal dapat didasarkan pada ketentuan *article 6 bis Konvensi Paris*, *article 16 TRIPs Agreement*, . Tujuannya untuk mewujudkan iklim perdagangan yang tertib dan sehat, terutama dalam era globalisasi.

### 2.4.1. Berdasarkan Konvensi Paris

Pasal 6 bis Konvensi Paris mengatur mengenai merek terkenal adalah sebagai berikut:

Negara-negara Uni melakukan *ex officio* jika perundang-undangan mereka mengizinkan demikian atau atas permintaan suatu pihak yang berkepentingan untuk menolak atau membatalkan pendaftaran tersebut dan melarang penggunaan atas suatu merek dagang yang merupakan suatu pembuatan ulang, suatu tiruan atau suatu terjemahan yang dapat menyesatkan atas suatu merek yang dianggap oleh pihak berwenang negara pendaftaran atau menggunakan untuk menjadi terkenal dalam

negara itu sebagaimana merek seseorang yang berhak atas manfaat konvensi ini dan digunakan untuk barang yang sama dan serupa. Ketentuan-ketentuan ini juga berlaku ketika bagian terpenting dari merek tersebut merupakan satu permintaan ulang merek terkenal tersebut atau suatu tiruan yang dapat menyesatkan.

Diatur pula mengenai pentingnya itikad baik dalam hal pendaftaran merek, seperti yang diatur dalam Pasal 6 bis ayat 3 Konvensi Paris juga menerapkan prinsip itikad baik. Bunyi Pasal tersebut, yaitu:

Apabila pendaftaran dilakukan dengan itikad buruk, maka tidak ada batas waktu untuk memintakan pembatalan. Jangka waktu permintaan pembatalan setidaknya lima tahun dihitung sejak tanggal pendaftaran (merek yang menyerupai merek terkenal tersebut).

Sebagai bentuk kewajiban untuk pelaksanaan ketentuan Konvensi Paris, maka ketentuan perundang-undangan nasional dan tindakan-tindakan pemerintah negara Uni harus mencerminkan dan menerapkan ketentuan Konvensi Paris.

#### 2.4.2. Berdasarkan *TRIPS Agreement*

Dalam *TRIPS Agreement*, mengenai merek terkenal diatur dalam Pasal 16 ayat (2) dan (3).

Dalam Pasal 16 ayat (2) *TRIPS Agreement* disebutkan bahwa Pasal 6 bis Konvensi Paris berlaku secara *mutatis mutandis* untuk barang atau jasa yang sejenis dari merek terkenal. Untuk menentukan apakah suatu merek adalah merek terkenal harus diperhitungkan pengetahuan publik atas merek tersebut, termasuk pengetahuan yang diperoleh di negara bersangkutan akibat promosi yang telah dilakukan.

Pasal 16 ayat (3) *TRIPS Agreement* mengatur pendaftaran merek terkenal untuk barang atau jasa yang tidak sejenis. Dalam hal ini Pasal 6 bis Konvensi Paris juga berlaku secara *mutatis mutandis*, apabila penggunaan merek yang bersangkutan memberikan indikasi keterkaitan antara barang atau jasa dari

dianggap hanya membonceng ketenaran merek terkenal, memanfaatkan promosi merek terkenal untuk keuntungan dirinya sendiri secara cuma-cuma.

#### **2.4.3. Berdasarkan Undang-Undang Nomor 15 Tahun 2001 tentang Merek**

Pengaturan mengenai merek terkenal dalam UU ini ialah dalam Pasal 6 ayat (1) b. Isi Pasal tersebut ialah, "Permohonan harus ditolak oleh Direktorat Jenderal apabila merek tersebut mempunyai persamaan pada pokoknya atau keseluruhannya dengan merek yang sudah terkenal milik pihak lain untuk barang dan/atau sejenisnya. Di dalam penjelasannya dinyatakan:

Penolakan Permohonan yang mempunyai persamaan pada pokoknya atau keseluruhan dengan Merek terkenal untuk barang dan/atau jasa yang sejenis dilakukan dengan memperhatikan pengetahuan umum masyarakat mengenai Merek tersebut di bidang usaha yang bersangkutan. Di samping itu diperhatikan pula reputasi Merek terkenal yang diperoleh karena promosi yang gencar dan besar-besaran, investasi di beberapa negara di dunia yang dilakukan oleh pemiliknya dan disertai bukti pendaftaran Merek tersebut di beberapa negara. Apabila hal-hal di atas belum dianggap cukup, Pengadilan Niaga dapat memerintahkan lembaga yang bersifat mandiri untuk melakukan survei guna memperoleh kesimpulan mengenai terkenal atau tidaknya Merek yang menjadi dasar penolakan.

#### **2.4.4. Pengaturan Lain Mengenai Merek Terkenal**

##### **2.4.4.1. Menurut *World Intellectual Property Rights (WIPO)***

Sebagai salah satu badan internasional yang berkecimpung dalam masalah HKI, dimana Indonesia merupakan salah satu anggotanya, mengeluarkan Rekomendasi Bersama mengenai Ketentuan atas Perlindungan Merek Terkenal (*Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks*) pada tahun 1999.

Dalam Pasal 2 ayat (1) huruf b Rekomendasi bersama tersebut terdapat enam kriteria untuk menentukan apakah suatu merek adalah merek terkenal, yaitu:

1. Tingkat pengetahuan atau pengakuan suatu merek di bagian dari masyarakat yang berusaha dalam bidang tersebut;

2. Jangka waktu, tingkat dan daerah geografis penggunaan merek tersebut;
3. Jangka waktu, tingkat dan daerah geografis kegiatan promosi merek, termasuk advertensi atau pemberitaan dan presentasi, di pameran atau pertunjukan dari barang dan/atau jasa yang berhubungan dengan merek tersebut;
4. Jangka waktu, tingkat dan daerah geografis dari registrasi dan/atau pendaftaran dari merek tersebut sejauh mereka menunjukkan penggunaan atau pengakuan merek tersebut;
5. Pencatatan atas keberhasilan penegakan hukum terhadap merek tersebut, khususnya sejauh pengakuan atas ketenaran merek tersebut oleh pihak yang berwenang;
6. Nilai yang berhubungan dengan merek tersebut<sup>95</sup>.

#### **2.4.4.2. Putusan Mahkamah Agung Republik Indonesia No. 220 PK/Pdt/1986 tanggal 16 Desember 1986.**

Putusan ini mendukung perlindungan atas merek terkenal, yang berbunyi sebagai berikut:

Bahwa Republik Indonesia sebagai suatu negara yang merdeka dan turut serta dalam pergaulan bangsa-bangsa wajib pula memelihara hubungan internasional dengan menghormati antara lain merek-merek warga negara asing. Hal ini juga berarti warga negara Indonesia yang memproduksi barang-barang buatan Indonesia wajib menggunakan nama-nama merek yang jelas menampakkan identitas nasional Indonesia dan sejauh mungkin menghindari menggunakan nama merek yang mirip apalagi menjiplak nama merek asing.

#### **2.4.4.3. Penafsiran Hakim dalam Lembaga Peradilan.**

Di dalam lembaga peradilan pun penafsiran hakim tentang merek terkenal berbeda-beda. Menurut salah satu pengacara HaKI di Jakarta, Sani Effendy, "Dalam pelbagai kasus-kasus perkara merek dagang, baik yang telah diputus di Pengadilan Negeri Jakarta Pusat, Pengadilan Niaga maupun

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<sup>95</sup> *Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks*, website: [http://www.WIPO.int/about-ip/en/development\\_iplaw/pdf/pub833.pdf](http://www.WIPO.int/about-ip/en/development_iplaw/pdf/pub833.pdf), diakses tanggal 11 Mei 2003.



2. Jangka waktu, tingkat dan daerah geografis penggunaan merek tersebut;
3. Jangka waktu, tingkat dan daerah geografis kegiatan promosi merek, termasuk advertensi atau pemberitaan dan presentasi, di pameran atau pertunjukan dari barang dan/atau jasa yang berhubungan dengan merek tersebut;
4. Jangka waktu, tingkat dan daerah geografis dari registrasi dan/atau pendaftaran dari merek tersebut sejauh mereka menunjukkan penggunaan atau pengakuan merek tersebut;
5. Pencatatan atas keberhasilan penegakan hukum terhadap merek tersebut, khususnya sejauh pengakuan atas ketenaran merek tersebut oleh pihak yang berwenang;
6. Nilai yang berhubungan dengan merek tersebut<sup>95</sup>.

#### **2.4.4.2. Putusan Mahkamah Agung Republik Indonesia No. 220 PK/Pdt/1986 tanggal 16 Desember 1986.**

Putusan ini mendukung perlindungan atas merek terkenal, yang berbunyi sebagai berikut:

Bahwa Republik Indonesia sebagai suatu negara yang merdeka dan turut serta dalam pergaulan bangsa-bangsa wajib pula memelihara hubungan internasional dengan menghormati antara lain merek-merek warga negara asing. Hal ini juga berarti warga negara Indonesia yang memproduksi barang-barang buatan Indonesia wajib menggunakan nama-nama merek yang jelas menampakkan identitas nasional Indonesia dan sejauh mungkin menghindari menggunakan nama merek yang mirip apalagi menjiplak nama merek asing.

#### **2.4.4.3. Penafsiran Hakim dalam Lembaga Peradilan.**

Di dalam lembaga peradilan pun penafsiran hakim tentang merek terkenal berbeda-beda. Menurut salah satu pengacara HaKI di Jakarta, Sani Effendy, "Dalam pelbagai kasus-kasus perkara merek dagang, baik yang telah diputus di Pengadilan Negeri Jakarta Pusat, Pengadilan Niaga maupun

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<sup>95</sup> *Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks*, website: [http://www.WIPO.int/about-ip/en/development\\_iplaw/pdf/pub833.pdf](http://www.WIPO.int/about-ip/en/development_iplaw/pdf/pub833.pdf), diakses tanggal 11 Mei 2003.

yang telah diajukan kasasi ke Mahkamah Agung ada ketidakseragaman akan kriteria merek terkenal yang telah dipakai oleh para hakim dalam pertimbangan hukum putusannya mengenai kriteria merek terkenal tergantung pada tingkat pemahaman hakim yang bersangkutan. Akibatnya, pelbagai putusan pengadilan yang telah dijatuhkan terdapat pelbagai penafsiran yang tidak seragam. Ada hakim yang memandang suatu pendaftaran merek dagang itu harus dilandasi itikad baik, bila terdapat itikad buruk maka pendaftaran merek dagang itu harus dibatalkan. Adapula hakim yang hanya memeriksa eksepsi yang diajukan oleh para tergugat mengenai jangka waktu pengajuan gugatan, sedangkan pokok perkara tidak dipertimbangkan sama sekali.<sup>96</sup>

Dalam praktek kita saksikan sebagai kriteria berkenaan pendaftaran merek terkenal ini dan pada umumnya pembuktian di muka pengadilan di Indonesia di Jakarta Pusat dalam perkara-perkara yang dipakai sebagai pegangan untuk menentukan apakah suatu merek tersebut terkenal atau tidak adalah bahwa merek ini sudah terdaftar di dalam negeri, negara asalnya serta juga didaftarkan di lain-lain negara peserta konvensi-konvensi yang mengatur tentang merek terkenal. Kita saksikan apabila ada kurang lebih (sepuluh) negara misalnya di mana diperhatikan telah didaftarkan merek tertentu ini, menjadi pegangan bagi hakim Indonesia bahwa merek sudah cukup terkenal baik di dunia internasional maupun di Indonesia. Juga dapat diperhatikan dari bukti-bukti bahwa karena promosi yang gencar dari si pemilik merek ini dan lama dipakainya merek bersangkutan sudah dianggap sebagai cukup terkenal<sup>97</sup>.

Penolakan permohonan tersebut dilakukan dengan memperhatikan pengetahuan umum masyarakat mengenai merek tersebut di bidang usaha yang bersangkutan. Mengenai reputasi merek terkenal tersebut juga perlu diperhatikan perolehannya apakah karena promosi yang gencar dan besar-besaran, invensi di beberapa negara di dunia yang dilakukan oleh pemiliknya,

<sup>96</sup> Sandra Salim, *Perlindungan atas Merek Terkenal Berdasarkan Peraturan Perundang-undangan*, Skripsi Sarjana, (Depok: Fakultas Hukum Universitas Indonesia, 2003), 64-65.

<sup>97</sup> Sudargo Gautama dan Rizawanto Winata, *Undang-Undang Merek Baru Tahun 2001*, (Bandung: Citra Aditya Bakti, 2002), hlm.115.

dan disertai bukti pendaftaran merek tersebut di beberapa negara. Apabila hal-hal di atas belum dianggap cukup, Pengadilan Niaga dapat memerintahkan lembaga yang bersifat mandiri untuk melakukan survei guna memperoleh kesimpulan mengenai terkenal atau tidaknya merek yang menjadi dasar penolakan atau tidak.

Kriteria atas merek terkenal memang multidimensi. Di Indonesia, kriteria merek terkenal dikatakan selain memperhatikan pengetahuan umum masyarakat, penentuannya juga ditentukan berdasarkan reputasi merek yang bersangkutan yang diperoleh karena promosi yang dilakukan oleh pemiliknya yang disertai dengan bukti pendaftaran merek tersebut di beberapa negara (jika ada). Apabila hal-hal di atas belum dianggap cukup, maka hakim dapat memerintahkan lembaga yang bersifat mandiri (*independen*) untuk melakukan survei guna memperoleh simpulan mengenai terkenal atau tidaknya merek yang bersangkutan. Dengan demikian dapat disimpulkan bahwa merek terkenal adalah suatu merek yang sudah dikenal meluas oleh masyarakat didasarkan pada reputasi yang diperolehnya karena promosi yang terus menerus oleh pemiliknya yang diikuti dengan bukti pendaftaran merek di berbagai negara<sup>98</sup>.

Perlindungan merek terkenal dalam perkembangannya mempunyai ciri yang didasarkan pada pertimbangan sebagai berikut:

- a. Merek telah dipromosikan secara luas oleh pemiliknya sehingga menjadi terkenal luas di lingkungan bisnis dan konsumen;
- b. Bermutu baik dan banyak digemari oleh masyarakat konsumen;
- c. Tidak dapat didaftar oleh orang lain yang bukan pemilik merek tersebut, baik untuk barang atau jasa sejenis maupun tidak sejenis.

Sebenarnya perlindungan merek terkenal sudah terlebih dahulu digariskan Mahkamah Agung melalui putusan-putusannya sebelum ada *TRIPs Agreement* dan Undang-Undang No.14/1997 tentang Merek. Dalam kasus Surjit Kaur No. 2913K/Pdt/1993, Mahkamah Agung berpendirian bahwa perlindungan merek terkenal sudah mengikat pemerintah Indonesia

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<sup>98</sup>Iman Sjahputra Tunggal, Heri Herjandono dan Parjio, *Hukum Merek di Indonesia*, (Jakarta: Harvarindo, 2005), 44.

karena Indonesia telah meratifikasi Konvensi Paris dan *Stockholm Act* tahun 1967 yang menekankan adanya harmonisasi dan perlakuan sama dari setiap negara penandatanganan untuk memberikan perlindungan atas merek-merek terkenal dari mana saja. Merek-merek terkenal adalah merek-merek yang mempunyai reputasi yang tinggi dalam dunia perdagangan yang diakui secara internasional atau setidaknya regional<sup>99</sup>.



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<sup>99</sup> Primastuti Purnamasari, *Perlindungan Merek Terkenal Berdasarkan Peraturan Perundang-undangan Nasional Termasuk Konvensi Internasional*, Skripsi Sarjana, (Depok: Universitas Indonesia, 2003), 40.

## BAB III METODOLOGI PENELITIAN

### 3.1. Metode Penelitian

Metode penelitian hukum (*Legal Research Methods*) pada mulanya mengikuti metode dalam ilmu sosial, yang dimasukkan dalam metode penelitian masyarakat *Social Research Methods*<sup>98</sup>.

Penelitian hukum sebenarnya adalah merupakan kegiatan penyelesaian masalah. Dalam hal ini peneliti dituntut untuk menjalankan kegiatan pemecahan masalah, dengan jalan menggali dan mengkualifikasi fakta-fakta (sebagai “*legal materials*”), dan menemukan norma hukum yang berlaku, untuk kemudian mengambil kesimpulan berdasarkan kedua hal tersebut.<sup>99</sup>

Untuk memperoleh informasi atau data-data yang diperlukan guna menjawab permasalahan yang telah dikemukakan sebelumnya, maka Penulis menggunakan metode penelitian<sup>100</sup> yaitu penelitian kepustakaan (*library research*) dan wawancara. Studi kepustakaan dilakukan untuk dapat mengetahui sebanyak mungkin pendapat dan atau konsep para ahli yang telah melakukan

<sup>98</sup> *Metode Penelitian Hukum: Buku A*, disusun oleh Tim Pengajar Metode Penelitian Hukum, (Depok: Fakultas Hukum Universitas Indonesia, 2000), hlm.19.

<sup>99</sup> Agus Brotosusilo (1), Bahan Kuliah: *Pergulatan Ideologis dalam Metodologi kajian hukum*, Jakarta, 2007, 3.

<sup>100</sup> *Metodologi* berasal dari kata “*metode*” yang berarti “*jalan ke*”. Lihat Soerjono Soekanto, *Pengantar Penelitian Hukum*, (Jakarta: UI Press, 1981), hal. 5. Metode, menurut Fuad Hasan, secara *etimologis* berasal dari bahasa Yunani, yakni kata “*methodos*, yang berarti “*cara atau jalan*”, sedangkan *metodologi*, yaitu *pengetahuan tentang berbagai cara kerja yang disesuaikan dengan objek studi (penelitian) ilmu yang bersangkutan*. Lihat pula Fuad Hasan dan Koentjaraningrat, “Beberapa Azas Metodologi Ilmiah”, dalam Koentjaraningrat (Ed.), *Metode-metode Penelitian Masyarakat*, (Jakarta: PT. Gramedia Jakarta, 1989), hal. 7-8. Sementara itu, *metode penelitian*, menurut C.F.G. Sunaryati Hartono, ialah *cara atau jalan atau proses pemeriksaan atau penyeledikan yang menggunakan cara penalaran dan berpikir yang logis-analitis (logika), berdasarkan dalil-dalil, rumus-rumus dan teori-teori suatu ilmu (atau beberapa cabang ilmu) tertentu, untuk menguji kebenaran (atau mengadakan verifikasi) suatu hipotesis atau teori tentang gejala-gejala atau peristiwa alamiah, peristiwa sosial atau peristiwa hukum tertentu*. Lihat C. F. G. Sunaryati Hartono, *Penelitian Hukum Di Indonesia Pada Akhir Abad Ke-20, Cet.1.*, (Bandung: Alurni, 1994), hal. 10.

penelitian atau penulisan terlebih dahulu mengenai sistem *Madrid Protocol* tentang pendaftaran merek.

Peneliti melakukan pemecahan masalah dengan jalan mengidentifikasi, mengkualifikasi data, menghubungkannya dengan Undang-Undang Merek No. 15 tahun 2001 tentang Merek, *Madrid Protocol, Common Regulations Under The Madrid Agreement Concerning The International Registration of Marks and The Protocol Relating to That Agreement*, RUU Merek, kemudian menganalisis data dan norma hukum tersebut untuk memperoleh kesimpulan.

Penelitian ini menggunakan pendekatan/metode normatif untuk memahami norma hukum yang ada. Dalam hal ini akan dianalisis kesesuaian peraturan domestik UU No.15 Tahun 2001 kemudian dilakukan perbandingan dengan *Madrid Protocol*, khususnya mengenai pendaftaran merek. Kajian ini memusatkan perhatian pada kajian tentang norma-norma hukum yang terdapat pada peraturan perundang-undangan, peraturan internasional (peraturan TRIPs Agreement-WTO), traktat, serta norma-norma yang hidup dalam masyarakat.

Untuk melihat apakah Indonesia perlu mengadopsi sistem *Madrid Protocol* atau tidak, perlu dikaji keuntungan dan kerugiannya serta dampak yang mungkin timbul bila kita mengadopsi sistem ini. Untuk mendukung analisis dilakukan wawancara dengan pemangku kepentingan yang berkaitan dengan sistem ini melalui wawancara.

Penelitian ini menggunakan pendekatan kualitatif untuk mengetahui:

1. keuntungan (*benefit*) jika Indonesia mengadopsi sistem *Madrid Protocol* bagi pendaftar merek lokal;
2. bagaimana dengan pendaftar asing ke Indonesia, apakah akan mempermudah pemeriksaan karena dilakukan oleh lembaga yang berkredibilitas;
3. hubungan antara sistem *Madrid Protocol* dan merek terkenal;
4. perbandingan antara pendaftaran paten melalui sistem *PCT* dan pendaftaran merek melalui sistem *Madrid Protocol*.

Bahan yang digunakan dalam penelitian diperoleh dari sumber resmi pada instansi terkait pada Direktorat Jenderal HKI (Direktorat Merek, Direktorat Paten, Departemen Perdagangan, beberapa Konsultan HKI, para pengusaha yang diperoleh melalui wawancara dengan narasumber dari instansi tersebut. Data lain

yang dibutuhkan, antara lain mencakup dokumen-dokumen resmi, buku-buku, hasil penelitian yang berwujud laporan dan sebagainya<sup>101</sup>.

Pengumpulan data dalam penelitian ini dilakukan dengan cara studi kepustakaan dan wawancara.

a. Studi kepustakaan

Pengumpulan data dilakukan dengan studi kepustakaan hukum berkaitan dengan hak kekayaan intelektual, khususnya merek dan hukum perdagangan internasional. Data tersebut diperoleh dari bahan-bahan hukum terutama terdiri dari:

- (1) Bahan hukum primer, yaitu bahan-bahan hukum yang mengikat dan terdiri dari peraturan perundang-undangan dan peraturan yang setingkat dan relevan, terutama berkenaan dengan hak kekayaan intelektual di bidang merek, yakni Undang-Undang Nomor 15 Tahun 2001 tentang Merek, Persetujuan *TRIPs*, *Protocol Relating to The Madrid Agreement Concerning The International Registration of Marks*, *The Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement*.
- (2) Bahan hukum sekunder, yaitu bahan hukum yang memberikan penjelasan mengenai bahan hukum primer, seperti Rancangan Undang-Undang Merek, hasil-hasil penelitian, berupa buku, jurnal, artikel, makalah dalam seminar yang berkaitan dengan topik penelitian;
- (3) Bahan Hukum Tertier, yaitu bahan-bahan hukum yang berisi penjelasan terhadap bahan hukum primer dan bahan hukum sekunder. Misalnya kamus dan ensiklopedi hukum<sup>102</sup>.

Tipe penelitian yang digunakan adalah penelitian normatif, yakni penelitian yang difokuskan untuk mengkaji penerapan kaidah-kaidah atau norma-norma dalam hukum positif.<sup>103</sup> Kajian hukum normatif akan menghasilkan kajian yang preskriptif – kritis yang merumuskan dan mengajukan pedoman-pedoman dan

<sup>101</sup> Asikin.

<sup>102</sup> Amiruddin dan Zainal Asikin, *Pengantar Metode Penelitian Hukum*, (Jakarta: Raja Grafindo Persada, 2004), 31-32.

<sup>103</sup> Johnny Ibrahim, *Teori dan Metodologi Penelitian Hukum Normatif*, (Malang Bayumedia Publishing, 2005), 295.

kaidah-kaidah yang harus dipatuhi oleh praktek hukum dan dogmatik hukum, serta bersifat kritis.<sup>104</sup> Di akhir penulisan tidak lupa diberikan saran-saran yang bermanfaat.

#### b. Wawancara

Yaitu pengumpulan data dengan cara mengadakan wawancara terhadap pihak yang terkait dalam penelitian ini. Dalam penelitian empiris ini alat pengumpulan data yang digunakan adalah pedoman wawancara (*interview guide*) dengan menggunakan metode pertanyaan-pertanyaan yang dikembangkan dalam hubungan yang bersifat antarpribadi dengan responden diambil secara random/acak (tanpa suatu pertimbangan). Perihal wawancara dan penggunaannya dalam penelitian hukum perlu dicatat pendapat Allpot yang dikutip oleh Selltiz. Bilamanakah wawancara digunakan? Tentang hal ini Allpot menyatakan bahwa *“If we want to know how people feel, what they experience and what they remember, what their emotions and motives are like, and the reason for acting as they do-why not ask them?”*<sup>105</sup>

Data dianalisis secara preskriptif analitis dengan menganalisis data yang diperoleh dari hasil penelitian kepustakaan berupa bahan-bahan hukum primer, sekunder dan tertier dalam rangka menjawab pokok permasalahan.

### 3.2. Landasan Teori

Dalam penelitian ini, analisis terhadap permasalahan digunakan teori utilitarian. Sebelum membahas mengenai teori utilitarian, terlebih dulu dibahas mengenai teori hukum. Teori hukum dalam ilmu hukum didefinisikan oleh Van Hoেকে sebagai sistem pernyataan (klaim), pandangan dan pengertian yang berkaitan secara logikal berkenaan dengan sistem hukum tertentu atau suatu bagian dari sistem hukum itu yang dirumuskan sedemikian rupa sehingga

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<sup>104</sup> Agus Brotosusilo (2), *Materi Kuliah Filsafat Hukum dan Teori Hukum bidang Hukum Ekonomi*, Program Pascasarjana Ilmu Hukum, (Jakarta: FH-UI, 2005), 1.

<sup>105</sup> Rusnadi, 52.



berdasarkan dimungkinkan untuk menjabarkan interpretasi aturan hukum atau pengertian dalam hukum (konsep hukum) yang terbuka bagi pengujian<sup>106</sup>.

Utilitarianisme secara utuh dirumuskan oleh Jeremy Bentham dan dikembangkan secara lebih luas oleh James Mill dan John Stuart Mill. Utilitarianisme terkadang disebut dengan Teori Kebahagiaan Terbesar yang mengajarkan tiap manusia untuk meraih kebahagiaan (kenikmatan) terbesar untuk orang terbanyak karena, kenikmatan adalah satu-satunya kebaikan intrinsik dan penderitaan adalah satu-satunya kejahatan intrinsik. Bagi Bentham, moralitas bukanlah persoalan menyenangkan Tuhan atau masalah kesetiaan pada aturan-aturan abstrak, melainkan tidak lain adalah upaya untuk mewujudkan sebanyak mungkin kebahagiaan di dunia ini. Oleh karena itu, Bentham memperkenalkan prinsip moral tertinggi yang disebutnya dengan 'Asas Kegunaan atau Manfaat' (*the principle of utility*).

Teori utilitarianisme Bentham tentang hukum menyatakan bahwa *the ultimate end of legislation is the greatest happiness of the greatest number*<sup>107</sup>. Teori utilitarian ini menyatakan bahwa pada hakikatnya hukum dibentuk untuk mencapai kebahagiaan dari sebagian terbesar warga masyarakat.

Singkatnya, Utilitarianisme Klasik yang diusung oleh Jeremy Bentham, James Mill dan, anaknya, John Stuart Mill, dapat diringkas dalam tiga proposisi berikut: Pertama, semua tindakan harus dinilai benar/baik atau salah/jelek semata-mata berdasarkan konsekuensi-konsekuensi atau akibat-akibatnya. Kedua, dalam menilai konsekuensi-konsekuensi atau akibat-akibat itu, satu-satunya hal yang penting adalah jumlah kebahagiaan atau penderitaan yang dihasilkannya. Jadi, tindakan-tindakan yang benar adalah yang menghasilkan surplus kebahagiaan terbesar ketimbang penderitaan. Ketiga, dalam mengkalkulasi kebahagiaan atau penderitaan yang dihasilkan, tidak boleh kebahagiaan seseorang dianggap lebih

<sup>106</sup> Bernard Arief Sidharta, *Refleksi tentang Struktur Ilmu Hukum Sebuah Penelitian tentang Fundasi Filsafat dan Sifat Keilmuan Ilmu Hukum sebagai Landasan Pengembangan Ilmu Hukum Nasional Indonesia*, (Bandung: Mandar Maju, 2000), 154.

<sup>107</sup> Jeremy Bentham dalam W. Friedmann, *Legal Theory*, (New York: Columbia University Press, 1967), p.313. Dikutip dalam Agus Sardjono, *Hak Kekayaan Intelektual dan Pengetahuan Tradisional*, cet. I, (Bandung: Alumni, 2006), 32

penting daripada kebahagiaan orang lain. Kesejahteraan tiap orang sama penting dalam penilaian dan kalkulasi untuk memilih tindakan<sup>108</sup>.

Mengacu pada teori utilitarian ini dapat disimpulkan bahwa Indonesia dapat saja mengadopsi sistem *Madrid Protocol* dan mencantumkan pengaturannya pada Undang-Undang Merek yang saat ini sedang direvisi, namun perlu diperhatikan terlebih dahulu apakah dengan diadopsinya sistem *Madrid Protocol* akan memberikan dampak yang positif atau dapat dikatakan banyak hal-hal yang menguntungkan dapat diperoleh oleh bangsa ini. Apabila banyak hal-hal positif, menguntungkan atau kemanfaatan terbesar bagi bangsa ini tentu akan membawa dampak dan hasil yang membahagiakan bagi bangsa Indonesia.

Ukuran rasional yang objektif dari kemanfaatan tersebut adalah jika hukum yang dimaksud secara ekonomis mampu menciptakan kesejahteraan bagi sebagian terbesar warga masyarakatnya<sup>109</sup>. Kemanfaatan terbesar bagi bangsa ini dengan diadopsinya sistem *Madrid Protocol* pada Undang-Undang Merek harus dikaji terlebih dahulu keuntungan dan kerugiannya bagi bangsa ini. Hal ini tentu berpengaruh terhadap banyak pemangku kepentingan (*stake holders*). Dilihat pula dampaknya penggunaan sistem ini di masa yang akan datang dan apa saja yang harus dipersiapkan atau didukung oleh hal-hal apa saja untuk menciptakan kebahagiaan dan kemanfaatan terbesar bagi bangsa ini.

Dihubungkan dengan pernyataan tersebut, jika dilihat dari pendaftaran menggunakan sistem madrid, maka prosedur pendaftaran akan lebih sederhana dan biaya yang dikeluarkan pun tidak banyak. Jadi, secara ekonomis pun lebih murah pendaftaran dengan sistem tersebut. Dengan satu aplikasi (*one document*) pemohon dapat mendaftarkan mereknya ke beberapa negara. Selain itu, tidak diperlukan lagi jasa konsultan HKI dalam hal pendaftaran dengan sistem madrid ini. Dari segi biaya, semakin sedikit lagi biaya yang harus dikeluarkan.

Hal lain yang dilihat baik apabila sistem madrid di Indonesia ialah dapat memotivasi para pelaku usaha di Indonesia untuk mendaftarkan mereknya ke luar negeri. Hal ini juga berpengaruh bagi pengusaha untuk melakukan ekspor. Oleh karena itu sistem ini sungguh berpengaruh terhadap banyak pihak, terutama

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<sup>108</sup> Utilitarianisme Penjelasan Singkat, EAST-LAM.

<sup>109</sup> Agus Sardjono, *Hak Kekayaan Intelektual dan Pengetahuan Tradisional*, cet. I, (Bandung: Alumni, 2006), hlm. 33.

### 3.3. Kerangka Konsepsional

Untuk menghindari perbedaan persepsi, pengertian dan istilah yang dipakai dalam penulisan ini, ada beberapa definisi dari istilah-istilah yang sering dijumpai berikut ini.

Merek adalah tanda yang berupa gambar, nama, kata, huruf-huruf, angka-angka, susunan warna, atau kombinasi dari unsur-unsur tersebut yang memiliki daya pembeda dan digunakan dalam kegiatan perdagangan barang atau jasa<sup>113</sup>.

Merek dagang adalah Merek yang digunakan pada barang yang diperdagangkan oleh seseorang atau beberapa orang secara bersama-sama atau badan hukum untuk membedakan dengan barang-barang sejenis lainnya<sup>114</sup>.

Permohonan adalah pihak yang mengajukan Permohonan<sup>115</sup>.

Tanggal Penerimaan adalah tanggal penerimaan Permohonan yang telah memenuhi persyaratan administratif<sup>116</sup>.

Konsultan Hak Kekayaan Intelektual adalah orang yang memiliki keahlian di bidang hak kekayaan intelektual dan secara khusus memberikan jasa di bidang pengajuan dan pengurusan Permohonan Paten, Merek, Desain Industri serta bidang-bidang hak kekayaan intelektual lainnya dan terdaftar sebagai Konsultan Hak Kekayaan Intelektual di Direktorat Jenderal<sup>117</sup>.

*Madrid Protocol* adalah protocol aplikasi merek secara internasional dalam satu permohonan yang berlaku untuk semua negara anggota, dimana aplikasinya cukup diajukan di kantor merek setempat<sup>118</sup>.

Sistem Madrid adalah *One Application, One number of registration, One Renewal, One Currency, and One Document* atau dapat dikatakan sistem pendaftaran merek secara internasional di sejumlah negara melalui satu aplikasi, satu bahasa, satu pemeriksaan formal dan satu kali pengumuman<sup>119</sup>.

<sup>113</sup> Indonesia, ps.1 angka 1.

<sup>114</sup> Ibid., angka 2.

<sup>115</sup> Ibid., angka 6.

<sup>116</sup> Ibid., angka 11.

<sup>117</sup> Ibid., angka 12.

<sup>118</sup> *Madrid Protocol Relating to the The Madrid Agreement Concerning the International Registration of Marks*, 2006, article 3 about International Application.

<sup>119</sup> Belinda Rosalina, "Madrid Protocol: Untung dan Ruginya Meratifikasi," website:<http://www.belindarosalina-wordpress.com>, diakses tanggal 21 Mei 2008.

Negara anggota / *Contracting State* adalah negara yang menjadi anggota dari *Madrid Protocol*<sup>120</sup>.

*International Application* adalah permohonan pendaftaran internasional yang ditujukan oleh pemohon kepada Kantor Merek negara asal, guna mendapatkan pendaftaran internasional<sup>121</sup>.

*International Registration* adalah pendaftaran merek yang dihasilkan dari permohonan pendaftaran merek melalui *Madrid Agreement* atau *Madrid Protocol* atau keduanya<sup>122</sup>.

Permohonan Pendaftaran Merek / *Basic Application* adalah permohonan atas pendaftaran merek yang telah dimohonkan kepada Kantor Merek di negara peserta, yang menjadi dasar dapat diajukannya permohonan internasional<sup>123</sup>.

Pendaftaran Awal / *Basic Registration* adalah pendaftaran merek yang telah dilakukan di Kantor Merek di negara peserta, yang menjadi dasar dapat dilakukannya permohonan internasional<sup>124</sup>.

Negara Tujuan / *Designated Contracting Party / Designated Country* adalah negara anggota *Madrid Union* yang merupakan tujuan dari permohonan pendaftaran merek secara internasional.

*Gazette* ("WIPO Gazette") adalah buletin yang diterbitkan periodik, memuat status pendaftaran internasional atas suatu merek di negara-negara yang tergabung dalam *Madrid Union*<sup>125</sup>.

*International Register* adalah kumpulan data mengenai pendaftaran internasional yang dihimpun oleh *World Intellectual Property Organization (WIPO)*<sup>126</sup>.

*International Bureau* adalah penyelenggara bagi pendaftaran internasional, yakni berhubungan dengan hal-hal administratif yang menjadi syarat pendaftaran internasional melalui *Madrid Protocol*<sup>127</sup>.

<sup>120</sup> *Common Regulations, Rule 1 (iv)*.

<sup>121</sup> *Ibid., Rule 1 (vii)*.

<sup>122</sup> *Ibid., Rule 1 (vi)*.

<sup>123</sup> *Ibid., Rule 1 (xiii)*.

<sup>124</sup> *Ibid., Rule 1 (xiv)*.

<sup>125</sup> *Ibid., Rule 1 (xx)*.

<sup>126</sup> *Ibid., Rule 1 (xxiv)*.

<sup>127</sup> *Madrid, Protocol Relating to The Madrid Agreement Concerning The International Registration of Marks, 1989, Article 11*.

*Trade Related on Intellectual Property Rights (TRIPs)* adalah Hak-hak atas kekayaan intelektual yang berkaitan dengan perdagangan. Perjanjian *TRIPs-WTO* menetapkan tingkat perlindungan minimum yang harus diberikan setiap pemerintah terhadap kekayaan intelektual anggota-anggota lain dalam *WTO*. Perjanjian ini dimasukkan dalam perundingan perdagangan global selama Putaran Uruguay (*Uruguay Round*) 1986-1994 yang diakhiri dengan pembentukan *WTO*. *TRIPs* berlaku untuk semua anggota *WTO*<sup>128</sup>.



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<sup>128</sup>Baca dalam *Oxfam Briefing Paper*, "Resiko Kesehatan Umum, di website: [www.oxfam.org](http://www.oxfam.org).

## **BAB IV**

### **INDONESIA DAN UPAYA PENDAFTARAN MEREK SECARA INTERNASIONAL DENGAN SISTEM MADRID PROTOCOL**

#### **4.1. Keuntungan Bila Indonesia Mengadopsi Sistem *Madrid Protocol* bagi Pendaftar Merek Lokal**

##### **4.1.1. Kesederhanaan Prosedur dan Penghematan Biaya**

Apabila sistem madrid ini diadopsi di Indonesia tentu pendaftaran merek berkaitan dengan pendaftar merek lokal maupun asing. Untuk bagian ini khusus dibahas lebih dulu berkaitan dengan pendaftar lokal.

Keuntungan (*benefit*) jika Indonesia mengadopsi sistem *Madrid Protocol* bagi pendaftar merek lokal ialah bahwa pendaftar merek akan makin mudah bila akan mendaftarkan mereknya di beberapa negara di luar negeri. Pemohon tidak harus mendaftar ke semua negara/pergi ke banyak negara di luar negeri, melainkan cukup dengan satu aplikasi/permohonan, pemohon mendaftar melalui Ditjen HKI (satu tempat *office of origin*). Pemohon cukup menyatakan dengan memberi tanda pada formulir, ke negara mana mereknya akan didaftarkan. Setelah itu Ditjen HKI akan meneruskan ke *IB*, lalu *IB* akan meneruskan ke beberapa negara yang menjadi tujuan pendaftaran. Penjelasan lebih lanjut mengenai kesederhanaan dan hematnya biaya dengan sistem madrid dijelaskan di bawah ini.

##### **4.1.1.1. Satu Dokumen dan Satu Permohonan**

Hal utama yang memudahkan dari sistem madrid ialah prinsip “*one document and one application*”. Cukup dengan satu dokumen dan permohonan pendaftaran, merek dapat dilindungi di negara-negara yang

tergabung dalam *Madrid Union*. Dengan kemudahan tersebut, pemohon dapat menghemat biaya administratif<sup>123</sup>.

Oleh karena pelaku usaha dapat mendaftarkan mereknya secara bersamaan di tiap negara tujuan yang merupakan anggota dari *Madrid Union*, maka pelaku usaha juga akan menikmati efisiensi waktu. Hal tersebut dapat memperkecil kemungkinan mereknya untuk didahului didaftar di negara tujuan dengan itikad buruk oleh pihak ketiga atau pesaing usahanya.

#### 4.1.1.2. Satu Bahasa

Salah satu persyaratan yang umum ditetapkan oleh masing-masing negara untuk dipenuhi oleh pemohon pendaftaran merek, yakni permohonan pendaftaran harus diajukan dalam bahasa resmi negara tersebut<sup>124</sup>.

Permohonan pendaftaran merek dengan sistem Madrid dapat diajukan dalam tiga bahasa, yakni Bahasa Inggris, Perancis maupun Spanyol<sup>125</sup>. Dengan adanya pilihan penggunaan bahasa tersebut tentu akan memudahkan proses pendaftaran merek secara internasional<sup>126</sup>.

#### 4.1.1.3. Satu Biaya

Seperti telah dikemukakan sebelumnya bahwa apabila suatu negara mengadopsi sistem Madrid pemohon dapat menghemat biaya pendaftaran merek.<sup>127</sup>

<sup>123</sup> Charles Samuels, *A Big Push toward E-Government: The United States Patent and Trademark Office and The Implementation of The Madrid Protocol*, Albany Law Journal of Science and Technology (14 Alb. L...J. Sci & Tech 535, 2004), 4.

<sup>124</sup> Contoh, apabila pemohon merek hendak mengajukan permohonan pendaftaran di Filipina, maka permohonan pendaftaran harus diajukan dalam Bahasa Tagalog sebagai persyaratan formalitas. Demikian pula halnya di Indonesia dalam hal pemenuhan persyaratan formalitas pemeriksaan merek, setiap permohonan pendaftaran merek harus diajukan dalam Bahasa Indonesia, Pasal 7(1), UU Merek.

<sup>125</sup> *Common Regulations, Rule 6(b)*.

<sup>126</sup> Oleh karena permohonan pendaftaran dapat diajukan dalam satu macam bahasa dan diajukan ke semua negara anggota *Madrid Union*, apabila pemilik merek Indonesia hendak melakukan pendaftaran merek di negara yang berbahasa selain Inggris, seperti misalnya Filipina, maka permohonan pendaftaran harus diterjemahkan ke dalam Bahasa Inggris terlebih dahulu, sebelum akhirnya diterjemahkan ke dalam Bahasa Tagalog.

<sup>127</sup> Clark Lackert, 6.

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<sup>123</sup> Charles Samuels, *A Big Push toward E-Government: The United States Patent and Trademark Office and The Implementation of The Madrid Protocol*, Albany Law Journal of Science and Technology (14 Alb. L.J. Sci & Tech 535, 2004), 4.

<sup>124</sup> Contoh, apabila pemohon merek hendak mengajukan permohonan pendaftaran di Filipina, maka permohonan pendaftaran harus diajukan dalam Bahasa Tagalog sebagai persyaratan formalitas. Demikian pula halnya di Indonesia dalam hal pemenuhan persyaratan formalitas pemeriksaan merek, setiap permohonan pendaftaran merek harus diajukan dalam Bahasa Indonesia, Pasal 7(1), UU Merek.

<sup>125</sup> *Common Regulations, Rule 6(b)*.

<sup>126</sup> Oleh karena permohonan pendaftaran dapat diajukan dalam satu macam bahasa dan diajukan ke semua negara anggota *Madrid Union*, apabila pemilik merek Indonesia hendak melakukan pendaftaran merek di negara yang berbahasa selain Inggris, seperti misalnya Filipina, maka permohonan pendaftaran harus diterjemahkan ke dalam Bahasa Inggris terlebih dahulu, sebelum akhirnya diterjemahkan ke dalam Bahasa Tagalog.

<sup>127</sup> Clark Lackert, 6.



Contoh pendaftaran merek yang menggunakan sistem madrid dan menghemat biaya adalah sebagai berikut<sup>128</sup>:

Pemohon akan melakukan perlindungan merek dengan mendaftarkan mereknya di negara Korea, Jepang, China dan Vietnam. Perhitungan ekonomisnya, yaitu:

a. Pendaftaran secara Individual

- \$56 (registration) + \$139 (1 class) + \$610 (issuance fee) untuk Jepang
- \$110 untuk Vietnam
- 66,000 Won (\$56) untuk Korea
- \$130 untuk China
- $4(\$600) + 4(\$250) = \text{attorney's fees}$
- Total = \$4,501

b. Pendaftaran dengan Sistem Madrid

- $653 \text{ (basic fee)} + 73 \text{ (Vietnam)} + 310 \text{ (China)} + 226 \text{ (Japan 1st part)}$   
 $+297 \text{ (Korea)} = 1486 \text{ Swiss Francs } (\$1,276)$
- \$610 Japan 2nd part
- \$250 attorney's fees
- Approximately \$2,136

Berdasarkan perhitungan tersebut di atas menunjukkan bahwa pendaftaran merek dengan sistem madrid dapat menghemat biaya.

Selain penghematan biaya, ketentuan lain mengenai biaya ialah bahwa pendaftaran merek dengan sistem konvensional mengharuskan pemohon melakukan pembayaran biaya pendaftaran sesuai dengan ketentuan dan mata uang setiap negara tujuan, tetapi dengan sistem madrid biaya pendaftaran hanya perlu dibayarkan dalam satu jenis mata uang. Mata uang yang dimaksud yaitu mata uang dari negara di mana pemohon mengajukan permohonan internasional<sup>129</sup>.

<sup>128</sup> Lihat Schultz & Associates, P.C. The Madrid Protocol website: <http://www.grspc.com>, diakses 17 Oktober 2008.

<sup>129</sup> *Common Regulations, Rule 35 (1)*.

#### **4.1.2. Stimulan/Memotivasi Pelaku Usaha Indonesia untuk Melakukan Ekspor**

Sistem madrid akan sangat berpengaruh di Indonesia apabila banyak pengusaha Indonesia yang melakukan ekspor produknya dengan menggunakan merek. Meskipun Indonesia sering melakukan ekspor, namun jika kegiatan ekspor itu tidak menggunakan merek tentu sistem ini tidak akan berpengaruh bagi bangsa Indonesia.

Berdasarkan data statistik pendaftaran merek asing dan domestik yang masuk ke kantor merek Ditjen HKI dari tahun 2001 hingga bulan Juni tahun 2008<sup>130</sup> menggambarkan bahwa pendaftaran merek domestik tetap lebih unggul dibandingkan dengan pendaftaran merek asing. Hal ini menunjukkan bahwa respon pelaku usaha Indonesia untuk melindungi mereknya cukup tinggi. Ditambah lagi dengan adanya fasilitas yang memudahkan dengan biaya yang hemat dengan menggunakan sistem madrid, tentu dapat menstimulasi para pelaku usaha indonesia untuk melindungi mereknya bahkan mendaftarkan mereknya di luar negeri. Respon demikian sangat baik untuk bangsa Indonesia. Selain pendaftaran merek lokal yang sangat banyak, pendaftaran merek asing pun tidak kalah banyaknya, namun menurut informasi yang penulis dari Ditjen HKI, pendaftar merek lokal ke luar negeri tidak ada datanya di Ditjen HKI. Hal itu terjadi karen a pendaftaran merek ke luar negeri tidak perlu melalui Ditjen HKI. Kalau pun ada yang melalui Ditjen HKI itu karena menggunakan hak priorita, dan hal itu pun tidak pernah dicatat oleh Ditjen HKI. Pendaftaran merek terbanyak, baik asing maupun domestik terjadi di tahun 2006. Pendaftaran merek domestik mencapai jumlah 36.644, sedangkan pendaftaran merek asing berjumlah 16.005. (Lihat Lampiran 4, Pendaftaran Merek Per Januari-Juni 2008)

Berkaitan dengan sistem madrid yang akan diadop di Indonesia dengan dicantulkannya pengaturan sistem madrid pada revisi Undang-Undang Merek atau bergabungnya Indonesia dalam Madrid Union tentu berkaitan dengan pelaku usaha Indonesia yang telah memiliki merek dan akan melakukan ekspor, selain itu pendaftaran merek asing juga dapat mempengaruhi.

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<sup>130</sup> Lihat tabel.

jika mendaftarkan mereknya ke lebih dari 5 negara<sup>134</sup>. Kapasitas secara simultan untuk melakukan ekspansi pasar ke lebih dari 5 negara umumnya dimiliki oleh pelaku usaha dari negara-negara maju, sementara mayoritas pelaku usaha di negara-negara berkembang seperti Indonesia masih belum memiliki kemampuan ekspor sekuat pelaku usaha dari negara maju<sup>135</sup>. Umumnya, pelaku UKM melakukan ekspansi pasar secara bertahap dari satu negara ke negara lainnya dengan tidak simultan. Melihat kondisi tersebut, pelaku usaha dari negara maju dapat lebih memaksimalkan keuntungan dari penggunaan sistem madrid apabila dibandingkan dengan pelaku usaha Indonesia<sup>136</sup>.

Terkait dengan hal kedua, apakah memang pengusaha Indonesia telah berorientasi ekspor dengan menggunakan mereknya sendiri atau hanya sekedar memenuhi permintaan importir. Misalnya pada industri garmen, apakah mayoritas pelaku usaha garmen berani untuk melakukan ekspansi pasar dengan menggunakan mereknya sendiri atau hanya melakukan ekspor produknya tanpa merek<sup>137</sup>. Mengingat saat ini, banyak perusahaan multinasional yang melakukan proses produksinya di negara-negara berkembang<sup>138</sup> dengan pertimbangan rendahnya biaya produksi, terutama upah buruh, kemudian

<sup>134</sup> Clark Lackert, 6; Apabila pendaftaran dilakukan kurang dari 5 negara, efisiensi biaya yang diperoleh tidaklah signifikan daripada mendaftarkan merek secara langsung ke setiap negara yang dituju.

<sup>135</sup> Menurut Cita Citrawinda, UKM yang merupakan mayoritas pelaku usaha Indonesia belum memiliki kemampuan maksimal untuk melakukan ekspansi pasar ke mancanegara. Pelaku usaha berbasis UKM ini masih tidak dimungkinkan untuk dapat mengajukan permohonan internasional ke minimum 5 negara tujuan, di mana setelah itu produk-produk yang bersangkutan juga harus dipasarkan di negara-negara tersebut.

<sup>136</sup> Pengusaha dari negara maju seperti Amerika Serikat dapat memperoleh efisiensi total biaya pendaftaran sebesar 62%, apabila pemohon merek asal Amerika Serikat hendak mendaftarkan mereknya di Amerika Serikat dan 10 negara asing lainnya, membutuhkan biaya sekitar %15.000, namun dengan menggunakan *Madrid Protocol*, hanya membutuhkan biaya sekitar %5.800, lihat, Bruce Macpherson, *The Bumpy Road to Madrid*, website: [www.managingip.com](http://www.managingip.com) (Managing Intell. Prop 69, September 2001-2002), 69.

<sup>137</sup> Saat ini, ekspor produk UKM Indonesia banyak dilakukan tanpa merek namun negara pengimporlah yang memberi merek, *Soal Aturan Pembuatan Merek, Apindo 'Lupakan' UKM*, website: [http://www.kapanlagi.com/h/0000221398\\_print.html](http://www.kapanlagi.com/h/0000221398_print.html), diakses 24 Mei 2008.

<sup>138</sup> Menurut Belinda Rosalina, beberapa perusahaan Indonesia yang sukses memasarkan produknya secara internasional, pemegang saham mayoritas seringkali adalah pihak asing, lihat Belinda Rosalina, *Madrid Protocol: Untung dan Ruginya Meratifikasi*, website: <http://www.belindarosalina-wordpress.com>, diakses tanggal 21 Mei 2008.

barang yang dihasilkan tadi diekspor ke negara asal perusahaan tersebut guna diberi merek<sup>139</sup>.

Menurut penulis, kedua alasan tersebut di atas dapat menimbulkan dua respon dari pelaku usaha Indonesia, yakni menjadi bumerang atau justru menimbulkan motivasi ke arah yang lebih baik bagi pengusaha Indonesia. Bila pelaku usaha Indonesia belum memenuhi kedua hal tersebut, kebijakan untuk menggunakan sistem madrid dapat menjadi bumerang bagi pelaku usaha Indonesia karena dengan semakin banyaknya merek asing yang beredar di Indonesia dan semakin mudahnya pelaku usaha asing mendaftarkan mereknya<sup>140</sup>, maka hal tersebut dapat mengakibatkan semakin ketatnya persaingan usaha di pasar domestik tanpa disertai dengan kemampuan pelaku usaha Indonesia untuk melakukan ekspansi pasar ke manca negara. Apabila hal tersebut terjadi, maka penggunaan sistem madrid akan merugikan pelaku usaha Indonesia<sup>141</sup>. Sebaliknya, mengacu pendapat Gunawan Suryomurcito, SH pada bab I bahwa dengan didopnya kelak sistem madrid di Indonesia memungkinkan pula bagi pengusaha Indonesia untuk termotivasi melindungi produknya dengan merek sendiri dan pada akhirnya produk tersebut akan diekspor, sehingga sistem madrid akan berdampak maksimal bagi pelaku usaha di Indonesia. Dengan kata lain diharapkan pelaku usaha Indonesia dapat melihat keuntungan dan keefektifan sistem madrid ini, sehingga pengusaha Indonesia tidak tertinggal dengan pengusaha asing yang maju.

<sup>139</sup> Manalu, *Hukum Dagang Internasional: Pengaruh Globalisasi Ekonomi Terhadap Hukum Nasional, Khususnya Hukum Hak Atas Kekayaan Intelektual*, (Jakarta: Novindo Pustaka Mandiri, 2000), 38.

<sup>140</sup> Dengan atau tanpa sistem madrid, Indonesia tetap merupakan negara tujuan pendaftaran favorit, karena pelaku usaha asing memandang Indonesia sebagai salah satu pasar potensial bagi produk-produk dari negara mereka, lihat Sam Mamudi, James Nurton, *Ten Key Jurisdictions Not Covered By Madrid Protocol: Welcome to Madrid*, website: [www.managingip.com](http://www.managingip.com), (Managing Intell. Prop 18, 2002-2003, November 2003), 20.

<sup>141</sup> Pelaku usaha Indonesia yang menghasilkan produk dengan memiliki pangsa pasar lebih besar di skala internasional dibandingkan dengan domestik, penggunaan sistem madrid akan sangat menguntungkan. Menurut Henry Soelistyo Budi, kemudahan prosedur pendaftaran melalui sistem madrid terintegrasinya sistem madrid dengan *Community Trade Mark System* yang digunakan negara-negara Uni Eropa, pelaku usaha Indonesia yang memiliki pangsa pasar lebih besar di skala internasional dibandingkan dengan domestik akan sangat dimudahkan untuk memasuki pasar internasional, khususnya Eropa. Contohnya: pengrajin perak di Indonesia mempunyai pangsa pasar lebih kecil dibandingkan dengan pengrajin emas, namun pada skala internasional memiliki pangsa pasar yang sangat luas dan merupakan hasil kerajinan yang menjadi primadona ekspor.

Tidak jauh berbeda dengan pendapat Gunawan, dua pendapat dari wakil pengusaha di Indonesia berikut pun menyatakan setuju bila Indonesia mengadopsi sistem Madrid. Pertama, pendapat Aryanto Jati, SH., MH, bahwa sistem Madrid baik diadopsi di Indonesia karena menguntungkan pengusaha untuk melakukan perlindungan merek ke beberapa negara dengan lebih efektif dan biaya yang lebih murah. Hal ini dikemukakan olehnya terlepas dari pelaku usaha dari perusahaan Mustika Ratu sudah melakukan ekspor atau belum<sup>142</sup>. Kedua, pendapat dikemukakan oleh Teguh Suparyadi<sup>143</sup>, bahwa Teguh setuju jika Indonesia mengadopsi sistem Madrid supaya Indonesia bisa berkompetisi dengan negara luar. Hal ini sangat memotivasinya untuk mau mengenakan merek pada produknya untuk didaftarkan karena selama ini produk usahanya belum menggunakan merek. Dengan adanya sistem ini beliau termotivasi untuk melindungi produknya dengan merek bahkan tersirat dari penuturannya kepada penulis melalui wawancara agar produknya pun dapat bersaing pula dengan produk dari negara lain melalui ekspor. Baik Aryanto maupun Teguh, semula tidak mengerti sistem pendaftaran merek dengan sistem Madrid, namun setelah penulis kemukakan bagaimana sistem tersebut kepada yang bersangkutan dalam wawancara, mereka langsung antusias mendukung diadopsinya sistem tersebut di Indonesia.

Seperti yang dinyatakan oleh Aksamil di muka bahwa produk Indonesia masih banyak yang belum menggunakan merek sendiri dan tindakan ekspor dari Indonesia kebanyakan adalah pesanan dari importir, maka keuntungan dari penggunaan sistem Madrid belum dapat dimaksimalkan oleh pelaku usaha Indonesia. Dengan kata lain, apabila sistem Madrid digunakan saat ini akan lebih menguntungkan pelaku usaha asing daripada pelaku usaha Indonesia karena pelaku usaha asing lebih siap dalam memaksimalkan keuntungan dari penggunaan sistem Madrid ini. Hal tersebut terkait dengan kemampuan mayoritas pelaku usaha Indonesia dalam melakukan ekspansi pasar sekarang masih kalah jika dibandingkan dengan pelaku usaha asing.

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<sup>142</sup> Aryanto Jati, SH., MH, *Corporate Legal Manager* P.T. Mustika Ratu, Tbk, wawancara dilakukan oleh penulis, rekaman kaset, Jakarta, 19 November 2008.

<sup>143</sup> Pemilik perusahaan komponen otomotif P.T. Tassha Multindo Karsa.

Lain halnya pendapat pengusaha dengan konsultan HKI dalam melihat pentingnya Indonesia masuk Madrid Union saat ini. Pengusaha cenderung setuju dan mendukung diadopsinya sistem madrid di Indonesia, sedangkan konsultan HKI ada yang menyatakan tidak setuju karena mereka seperti kehilangan 'lahan' untuk memperoleh pemasukan jika Indonesia mengadopsi sistem madrid. Konsultan HKI, Gunawan Suryomurcito setuju dengan diadopsinya sistem madrid seperti yang telah dikemukakan sebelumnya. Gunawan juga melihat pentingnya sistem ini bagi kepentingan nasional dibandingkan kepentingan segelintir konsultan HKI. Pendapat yang sama juga dikemukakan oleh Irma Rachmawati<sup>144</sup> yang setuju akan diadopsinya sistem madrid ini di Indonesia. Pendapat yang berbeda dikemukakan oleh Belinda Rosalina bahwa Indonesia dilihat belum siap untuk masuk dalam Madrid Union. Menurutnya, perbaiki dan siapkan dahulu segala hal yang mendukung sistem ini. Jadi, Belinda tidak setuju pencantuman Pasal mengenai sistem madrid dalam revisi Undang-Undang Merek saat ini<sup>145</sup>.

#### **4.2. *Madrid Protocol* dan Kaitannya dengan Pemeriksaan Pendaftaran Merek Asing di Indonesia**

Apabila ada pendaftar merek asing yang menjadikan Indonesia sebagai negara tujuan pendaftaran mereknya di Indonesia, maka dengan diadopsinya sistem madrid di Indonesia tentu akan mempermudah proses pemeriksaan di Indonesia karena sebelum permohonan masuk ke Indonesia sebagai negara tujuan, dengan sistem madrid pemeriksaan awal sudah dilakukan di negara asal dan oleh *IB*.

Sebelum mengetahui apa saja yang diperiksa di negara tujuan pendaftaran (dalam hal ini Indonesia sebagai negara tujuan), perlu diketahui hal-hal yang diperiksa di negara asal maupun di *IB*.

Adapun yang harus dipenuhi dalam pendaftaran dan diperiksa di negara asal, yaitu:

<sup>144</sup> Konsultan HKI yang bekerja di *Law Firm HHP*, Jakarta.

<sup>145</sup> Soewantin Oemar, *Revisi Undang-Undang Merek untuk Siapa*, website: <http://www.bisnis.com>, diakses tanggal 19 Mei 2008.

- klasifikasi barang dan jasa yang tertera di permohonan internasional tersebut, apakah sudah memenuhi standar internasional yang disebutkan di *Nice Agreement* atau belum<sup>155</sup>;
- apabila belum memenuhi kriteria, maka *WIPO* akan melengkapi klasifikasi atas barang dan jasa atau dapat meminta bantuan kepada pemohon (atau perwakilannya) untuk mengubah atau menambahkan keterangan terhadap detail klasifikasi barang dan jasa yang dianggap bias, salah atau kurang lengkap<sup>156</sup>;
- apabila terjadi ketidaksesuaian prosedur permohonan internasional, *WIPO* dapat mengeluarkan “*notice of irregularity*” yang mengharuskan pemohon untuk memperbaharui permohonan internasional tersebut dalam waktu 3 bulan<sup>157</sup>;
- apabila permohonan internasional tersebut memenuhi persyaratan untuk didaftar, maka *WIPO* akan menetapkan tanggal dan nomor pendaftaran internasional, melakukan pencatatan merek tersebut dalam *international register* dan memberitahukan Kantor Merek negara tujuan atas pendaftaran internasional tersebut<sup>158</sup>;
- *WIPO* juga akan memuat pendaftaran internasional di dalam *WIPO Gazette*.

Yang dilakukan Kantor Merek negara tujuan (Indonesia), yakni memeriksa:

- pendaftaran internasional tersebut berdasarkan Undang-Undang maupun regulasi mereknya masing-masing;
- unsur pembeda maupun deskripsi dari merek tersebut secara lebih lanjut, dengan menggunakan Undang-Undang maupun regulasi merek negaranya masing-masing (negara tujuan)<sup>159</sup>;

Negara tujuan berhak menolak pendaftaran internasional tersebut di negaranya atas dasar regulasi merek nasionalnya<sup>160</sup>. Apabila merek tersebut tidak dapat didaftar di negara tersebut, maka Kantor Merek negara tujuan akan

<sup>155</sup> Ibid.

<sup>156</sup> Ibid.

<sup>157</sup> *Common Regulations, Rule 11 (2)(b)*.

<sup>158</sup> David Tatham, 3.

<sup>159</sup> David Tatham, 4.

<sup>160</sup> *Madrid Protocol, Article 5(1)*,

menyampaikan penolakan atau yang lebih dikenal dengan “*provisional refusal*” kepada *WIPO* agar mencatat penolakan tersebut di *international register* dan *WIPO Gazette* serta diberitahukan ke pihak pemohon terkait dengan tidak dapat didaftarkanya merek di negara tersebut. Periode pemeriksaan dapat berlangsung maksimal 12 hingga 18 bulan<sup>161</sup>.

Pemeriksaan yang dilakukan lebih dari 18 bulan tanpa adanya pemberitahuan bahwa pendaftaran internasional tersebut dapat diajukan keberatan oleh pihak ketiga, merek tersebut wajib dilindungi di Indonesia, sama halnya dengan merek lain yang didaftarkan secara langsung.

Pemeriksaan substantif dalam sistem madrid protokol hanya dilakukan terhadap permohonan merek asing yang ditujukan ke Indonesia. Adapun sistem pemeriksaan substantifnya tetap didasarkan pada UU Nasional yang berlaku. Jadi tidak ada perbedaan dalam sistem pemeriksaan substantif baik terhadap permohonan merek asing melalui sistem *Madrid Protocol* maupun terhadap permohonan merek biasa (*national system*).

Dikaitkan dengan pemeriksaan substantif, Didik Taryadi berpendapat bahwa antara peraturan nasional kita dalam Undang-Undang Merek No.15/2001 dan sistem madrid, pada prinsipnya tidak ada perbedaan, baik secara teknis maupun substansi pemeriksaannya. Oleh karena permohonan itu dilakukan dengan menggunakan sistem madrid, mekanisme pemeriksaan substantifnya tetap dilakukan berdasarkan UU Nasional negara tujuan. Kantor Merek Ditjen HKI hanya sebagai media untuk menerima administrasi pendaftaran merek dari pemohon yang ada di Indonesia, kemudian berkas administrasi diteruskan ke *IB*. Selanjutnya, *IB* menyampaikan kepada negara tujuan untuk dilakukan pemeriksaan. Hasil dari pemeriksaan yang dilakukan oleh negara tujuan disampaikan kembali ke *IB* untuk selanjutnya *IB* memberikan laporan kepada pemohon pendaftaran merek mengenai hasil pemeriksaan yang telah dilakukan oleh negara tujuan, apakah merek tersebut diterima atau ditolak.

Perbedaannya hanya dalam jangka waktu penyelesaian pemeriksaan substantifnya. Dimana menurut sistem *Madrid Protocol* bisa paling lama 12 atau

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<sup>161</sup> *Summary of the Madrid Agreement Concerning the International Registration of Marks (1891) and the Protocol Relating to that Agreement (1989)*, website: [http://www.WIPO.int/treaties/en.registration/madrid\\_protocol/summary/](http://www.WIPO.int/treaties/en.registration/madrid_protocol/summary/), diakses 14 Maret 2008.



18 bulan tergantung yang dipilih oleh negara anggota, sedangkan dalam UU No. 15/2001 paling lama 9 bulan. Dengan demikian jangka waktu pemeriksaan substantif kita masih dalam tenggang waktu yang ditentukan dalam sistem *Madrid Protocol* (tidak melampaui 12 atau 18 bulan). Dalam tenggang waktu pemeriksaan tersebut, paling lama 18 bulan harus sudah ada hasil pemeriksaan apakah permohonan tersebut diterima atau ditolak<sup>162</sup>.

Pemeriksaan substantif dalam sistem madrid protokol hanya dilakukan terhadap permohonan merek asing yang ditujukan ke Indonesia. Adapun pemeriksaan substantif dalam sistem madrid protokol hanya dilakukan terhadap permohonan merek asing yang ditujukan ke Indonesia. Sistem pemeriksaan substantifnya tetap didasarkan pada UU Nasional yang berlaku. Jadi, tidak ada perbedaan dalam sistem pemeriksaan substantif, baik terhadap permohonan merek asing melalui sistem *Madrid Protocol* maupun terhadap permohonan merek biasa (*national system*).

Proses pendaftaran merek di Indonesia seringkali masih memerlukan waktu lebih lama dari yang ditentukan dalam Undang-Undang. Hal ini juga dikemukakan oleh Anggoro Dasananto<sup>163</sup>. Disampaikannya kepada penulis dalam wawancara pada 3 Desember 2008 bahwa pemeriksa merek dan jumlah permohonan yang akan diperiksa tidaklah seimbang. Menurut penulis, kebijakan Pemerintah untuk menggunakan sistem madrid tanpa terlebih dahulu memberikan kepastian bagi pemohon merek terkait dengan jangka waktu pendaftaran akan menimbulkan permasalahan bagi Indonesia.

Dilihat dari jangka waktu normal pendaftaran merek di Indonesia menurut Undang-undang adalah antara 14 hingga 15 bulan<sup>164</sup>. Kenyataannya seringkali pendaftaran suatu merek membutuhkan waktu hingga lebih dari 1 atau 2 tahun, bahkan lebih.

Rasio pemeriksa merek dengan jumlah permohonan yang akan diperiksa dituturkan oleh Anggoro bahwa pemeriksa merek di Kantor Ditjen HKI kurang.

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<sup>162</sup> T. Didik Taryadi, S.H, Kasubdit Pelayanan Hukum Direktorat Merek, Ditjen Hak Kekayaan Intelektual, Departemen Hukum dan HAM R.I, wawancara dilakukan oleh penulis, rekaman kaset, Jakarta, 25 September 2008.

<sup>163</sup> Anggoro Dasananto adalah Kepala Bagian Pemeriksa Merek pada Direktorat Merek, Ditjen HKI, Departemen Hukum dan HAM R.I.

akan bertambah pemohon dari asing atau paling tidak seimbang antara pemohon lokal maupun pemohon asing yang akan mendaftar ke Indonesia.

#### **4.3. Madrid Protocol dan Kaitannya dengan Merek Terkenal**

Pengaturan mengenai merek terkenal akan dianalisis dari beberapa peraturan, diantaranya: Konvensi Paris, *TRIPs Agreement*, UU No.15/2001, kemudian dikaitkan dengan *Madrid Protocol*.

##### **4.3.1. Berdasarkan Konvensi Paris**

Dasar hukum pengaturan mengenai merek terkenal menurut Konvensi Paris ialah Pasal 6 bis. Pengaturannya adalah sebagai berikut:

Negara-negara Uni melakukan *ex officio* jika perundang-undangan mereka mengizinkan demikian atau atas permintaan suatu pihak yang berkepentingan untuk menolak atau membatalkan pendaftaran tersebut dan melarang penggunaan atas suatu merek dagang yang merupakan suatu pembuatan ulang, suatu tiruan atau suatu terjemahan yang dapat menyesatkan atas suatu merek yang dianggap oleh pihak berwenang negara pendaftaran atau menggunakan untuk menjadi terkenal dalam negara itu sebagaimana merek seseorang yang berhak atas manfaat konvensi ini dan digunakan untuk barang yang sama dan serupa. Ketentuan-ketentuan ini juga berlaku ketika bagian terpenting dari merek tersebut merupakan satu permintaan ulang merek terkenal tersebut atau suatu tiruan yang dapat menyesatkan.

Berdasarkan Pasal 6bis Konvensi Paris, negara peserta diminta menolak permintaan pendaftaran atau pembatalan pendaftaran dan melarang penggunaan merek yang sama dengan, atau merupakan tiruan dan/atau dapat menimbulkan kebingungan dari suatu merek yang:

- (a) Menurut pertimbangan pihak yang berwenang di negara penerima pendaftaran merupakan merek terkenal atau telah dikenal luas sebagai merek milik seseorang yang berhak memperoleh perlindungan sebagaimana diatur dalam konvensi;
- (b) Digunakan pada produk yang sama atau sejenis.

Penolakan atau pembatalan pendaftaran pendaftaran dan pelarangan penggunaan merek yang dianggap sama tersebut dilakukan baik berdasarkan perundang-undangan merek yang dimiliki atau permintaan pihak yang berkepentingan.

Penolakan suatu perlindungan merek diperbolehkan oleh Konvensi Paris apabila pendaftaran di negara yang bersangkutan melanggar hak-hak pihak ketiga juga bila merek yang bersangkutan tidak memiliki karakter pembeda atau secara eksklusif mengandung syarat-syarat deskriptif atau apabila merek tersebut bertentangan dengan prinsip-prinsip moralitas atau ketertiban umum yang diterima masyarakat.

Pasal tersebut juga merekomendasikan untuk mengatur tidak saja atas permintaan dari yang berkepentingan, tetapi juga secara *ex officio* untuk menolak atau membatalkan terhadap merek yang mempunyai persamaan pada pokoknya atau keseluruhannya dengan merek yang sudah terkenal dalam legislasi perundang-undangan nasional dari negara-negara Union (negara peserta penandatanganan Konvensi Paris)<sup>166</sup>.

Prosedur pengajuan HKI bidang kekayaan industri konvensi ini menganut prinsip hak prioritas, berarti bahwa pemohon yang berasal dari negara peserta harus dapat menggunakan tanggal permohonan pertama kali dilakukan sebagai tanggal efektif di negara peserta lainnya dengan ketentuan bahwa pengajuan tersebut dilakukan 6 bulan (desain industri dan merek) atau 12 bulan (paten dan paten sederhana) dari tanggal permohonan pertama<sup>167</sup>.

Pasal 6 bis ayat 3 Konvensi Paris juga menerapkan prinsip itikad baik. Apabila pendaftaran dilakukan dengan itikad buruk, maka tidak ada batas waktu untuk memintakan pembatalan. Jangka waktu permintaan pembatalan setidaknya lima tahun dihitung sejak tanggal pendaftaran (merek yang menyerupai merek terkenal tersebut).

Walaupun konsep merek terkenal diwujudkan dalam Pasal 6bis, Konvensi Paris tidak memberikan definisi apapun atau kriteria mengenai merek yang dikualifikasi sebagai merek terkenal.

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<sup>166</sup> Rusnadi, 100.

<sup>167</sup> Konvensi Paris, ps. 4.

#### 4.3.2. Berdasarkan *TRIPs Agreement*

Pengaturan dalam Pasal 6 bis Konvensi Paris diadopsi oleh *TRIPs Agreement* dalam article 16 (2) dan (3). Article 16 (2) *TRIPs Agreement* disebutkan bahwa:

*Article 6bis of the Paris Convention (1967) shall apply, mutatis mutandis, to services. In determining whether a trademark is well-known, Members shall take account of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Member concerned which has been obtained as a result of the promotion of the trademark;*

sedangkan article 16 (3) *TRIPs Agreement* dinyatakan sebagai berikut:

*Article 6bis of the Paris Convention (1967) shall apply, mutatis mutandis, to goods or services which are not similar to those in respect of which a trademark is registered, provided that use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered trademark and provided that the interests of the owner of the registered trademark are likely to be damaged by such use.*

Article 16 (2) *TRIPs Agreement* menetapkan kewajiban bagi institusi pemerintah yang berwenang dari negara-negara anggota pada saat mengevaluasi apakah suatu merek itu terkenal atau tidak. Negara anggota harus mempertimbangkan unsur-unsur kumulatif, yaitu:

- a. pengetahuan mengenai merek itu dalam sektor yang relevan bagi masyarakat;
- b. pengetahuan di negara anggota yang bersangkutan yang telah diperoleh sebagai hasil promosi dari merk yang bersangkutan.

Article 16 (3) *TRIPs Agreement* mengatur bentuk perlindungan bagi para pemilik merek terkenal yang diperluas hingga menjangkau merek-merek terkenal yang terdaftar. Intinya, perlindungan merek terkenal menurut pasal 6 bis Konvensi Paris harus diterapkan terhadap barang-barang dan jasa yang tidak sejenis dengan merek-merek terkenal yang terdaftar. Pemilik merek terkenal dapat memperoleh manfaat perlindungan apabila dua kondisi yang bersifat kumulatif dipenuhi, yaitu:

- a. sepanjang pemakai merek yang bersangkutan dalam kaitannya dalam barang-barang atau jasa yang tidak sejenis akan mengindikasikan adanya hubungan antara barang-barang atau jasa tersebut dan pemilik merek terkenal yang terdaftar;
- b. sepanjang kepentingan-kepentingan pemilik merek terkenal terdaftar kemungkinan dirugikan karena penggunaan merek yang bersangkutan.

Pada dasarnya, perlindungan HKI, khususnya merek telah tersirat dalam *TRIPs Agreement*, yakni pada ketentuan tentang *national treatment*. Yang dimaksud dengan *national treatment* adalah setiap anggota wajib memberikan perlindungan yang sama terhadap kekayaan intelektual warga anggota lain seperti perlindungan yang diberikan kepada warganya sendiri<sup>168</sup>. *National treatment* dalam *TRIPs Agreement* pada intinya membuka kesempatan seluas-luasnya kepada perusahaan asing untuk mendaftarkan merek dagangnya pada kantor-kantor merek di setiap negara peserta. Kesepakatan ini juga mempersyaratkan setiap negara peserta untuk memberikan perlindungan kepada merek terkenal (*well-known mark*).

Syarat ini dapat dilihat pada *Pasal 4 Perjanjian TRIPs* yang menyatakan bahwa segala keuntungan, kemurahan, kemudahan atau perlindungan yang diberikan kepada warga dari suatu negara harus diberikan juga secara dan tanpa syarat kepada warga dari negara anggota lainnya. Dengan sendirinya, merek terkenal milik warga negara Indonesia di luar negeri juga wajib memenuhi kriteria merek terkenal yang tercantum dalam *TRIPs Agreement* sebelum dapat disebut merek terkenal di luar negeri.

Dalam permohonan merek terkenal, adanya unsur itikad buruk perlu dipertimbangkan sebab si pendaftar yang bukan pemilik merek yang sah dapat dianggap hanya membonceng ketenaran merek terkenal, memanfaatkan promosi merek terkenal untuk keuntungan dirinya sendiri secara cuma-cuma. Kerugian yang diderita oleh pemilik merek yang asli mungkin bukan merupakan kerugian materi yang langsung, misalnya penurunan omzet penjualan, melainkan penggerogotan citra atau *image* yang khas dari merek

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<sup>168</sup> *Trade Related Intellectual Property Rights (TRIPs) Agreement*, art.3.

terkenal tersebut. Demikian pula dalam hal merek terkenal tersebut digunakan oleh pihak lain untuk barang yang tidak sejenis, maka yang menjadi ukuran adalah apakah konsumen akan mengasosiasikan barang-barang tersebut dengan pemilik merek terkenal dan apakah pengasosiasian ini dapat merugikan pemilik merek terkenal tersebut.

Sampai saat ini, sebenarnya tidak ada definisi merek terkenal yang dapat diterima secara luas. Selama perundingan Putaran Uruguay di bidang *TRIPs* berlangsung sampai berakhir dan ditandatanganinya Persetujuan Pembentukan *WTO*, tidak satu negarapun mampu membuat dan mengusulkan definisi merek terkenal tersebut<sup>169</sup>.

#### 4.3.3. Berdasarkan Undang-Undang Nomor 15 Tahun 2001 tentang Merek

Selain pengaturan mengenai merek terkenal ada dalam Konvensi Paris dan *TRIPs Agreement*, Indonesia juga mengatur hal tersebut. Pengaturannya ialah berdasarkan Pasal 6 ayat (1) b. Isi Pasal tersebut adalah sebagai berikut:

Permohonan harus ditolak oleh Direktorat Jenderal apabila merek tersebut mempunyai persamaan pada pokoknya atau keseluruhannya dengan merek yang sudah terkenal milik pihak lain untuk barang dan/atau sejenisnya.

Maksud pasal tersebut dikaitkan dengan penjelasan Pasal 6 ayat (1) UU No.15/2001 disebutkan bahwa penolakan permohonan yang sudah terkenal milik pihak lain untuk barang dan/atau jasa sejenis dilakukan dengan memperhatikan:

- a. pengetahuan umum masyarakat mengenai merek tersebut di bidang usaha yang bersangkutan;
- b. reputasi merek terkenal yang diperoleh karena promosi yang gencar dan besar-besaran;
- c. adanya investasi di beberapa negara di dunia yang dilakukan oleh pemiliknya; dan

<sup>169</sup> Prasetyo Hadi Purwandoko, *Problematika Perlindungan Merek di Indonesia*, website: <http://prasetyohp.wordpress.com/problematika-perlindungan-merek-di-indonesia>, diakses 19 Desember 2008.

d. adanya bukti pendaftaran merek tersebut di beberapa negara.

Apabila hal-hal di atas belum dianggap cukup, Pengadilan Niaga dapat memerintahkan lembaga yang bersifat mandiri untuk melakukan survei guna memperoleh kesimpulan mengenai terkenal atau tidaknya merek yang menjadi dasar penolakan.

#### 4.3.4. Berdasarkan *Madrid Protocol*

Menganut prinsip hak prioritas<sup>170</sup> sesuai Konvensi Paris (Common Regulation, Rule 9(a)(iv)). Sistem madrid memungkinkan pemilik merek terkenal untuk mendaftarkan mereknya dengan hak prioritas dalam satu dokumen dan satu pendaftaran yang berlaku ke semua negara anggota *Madrid Union*<sup>171</sup>.

Tujuan utama pemberian hak prioritas kepada pemilik orang asing memperoleh pendaftaran, yaitu melindungi merek orang asing di Indonesia dari pembajakan atau pemboncengan<sup>172</sup>.

Perlindungan tersebut hanya bisa efektif dengan jalan memberi hak prioritas kepada pemilik merek orang asing tersebut. Dengan demikian, dalam hal terjadi persaingan untuk memperoleh pendaftaran antara pemilik merek orang asing dan pemilik merek domestik mengenai merek dari jenis barang dan kelas yang sama harus diberi rangka utama kepada orang asing.

*Berdasarkan Common Regulation, Rule 9(a)(iv) berarti pengaturan mengenai merek terkenal mengacu pada ketentuan Pasal 6bis Konvensi Paris.* Sedangkan pengaturan hak prioritas berdasarkan Konvensi Paris dapat diartikan, yakni:

a. Perlakuan pemberian perlindungan hukum yang sama.

Hukum merek suatu negara harus memberi perlindungan yang sama terhadap pemilik merek orang asing, sebagaimana perlakuan

<sup>170</sup> Common Regulation, Rule 9(a)(iv).

<sup>171</sup> *Madrid Protocol*, 4(2), Apabila pemilik merek terkenal lebih cepat dan mudah mendapatkan perlindungan atas mereknya tersebut di setiap negara yang dikehendaki, maka jumlah sengketa merek terkenal yang akan terjadi juga dapat menurun.

<sup>172</sup> Imran Nating, *Merek Terkenal Dihubungkan dengan Pasal 6 bis Konvensi Paris*, website: <http://www.solusihukum.com/artikel/artikel15.php>, diakses pada 19 Desember 2008.

perlindungan yang diberikan kepada pemilik merek warga negara sendiri.

b. Berdasarkan asas Resiprositas.

Memberi perlindungan yang sama terhadap pelayanan permintaan pendaftaran dengan hak prioritas terhadap pemilik merek orang asing harus berdasarkan asas timbal balik.

Asas Resiprositas dengan sendirinya bercorak multilateral terhadap semua negara anggota peserta Konvensi Paris, artinya jika pemohon bukan dari negara anggota peserta Konvensi Paris, kantor mereka harus menolak pendaftaran dengan alasan tidak ditegakkan asas Resiprositas<sup>173</sup>.

Di samping mengenai hak prioritas, apabila Indonesia menggunakan sistem madrid, sengketa merek terkenal yang terjadi di masa yang akan datang dapat semakin berkurang karena pemilik merek yang berasal dari negara anggota dari Konvensi Paris dapat dengan lebih mudah melakukan pendaftaran merek di berbagai yurisdiksi negara yang berbeda sesama anggota Konvensi Paris<sup>174</sup>. Hal tersebut akan menjadi preseden positif bagi Indonesia di mata pelaku usaha asing<sup>175</sup> yang dapat mendukung investasi dan kelancaran perdagangan antara Indonesia dengan negara lain<sup>176</sup>.

Seringkali pemilik merek terkenal yang hendak mendaftarkan mereknya di Indonesia harus bersengketa dengan pelaku usaha lokal karena mereknya telah didaftarkan oleh pihak ketiga yang beritikad buruk<sup>177</sup>; bahkan pada banyak

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<sup>174</sup> Konvensi Paris, *Article 4*, lebih spesifik pada *Article 6 bis*, terdapat kewajiban bagi semua negara anggota untuk memberikan perlindungan terhadap merek terkenal.

<sup>175</sup> Salah satu tujuan Cina dalam hal menggunakan Sistem madrid adalah untuk memberikan perlindungan bagi merek terkenal, lebih lanjut lihat Jessica Wong, *The Challenges Multinational Corporations Face in Protection Their Well-Known Marks in China*, Brooklyn Journal of International Law (31 Brook. J. Int'l L. 937, 2006), 5.

<sup>176</sup> HKI juga merupakan salah satu modal yang dibawa oleh investor asing, maka cukup beralasan apabila mereka mengharap adanya perlindungan hukum terhadap HKI, yang merupakan salah satu dari komponen modal mereka, lebih lanjut lihat Sentosa Sembiring, *Hukum Investasi*, (Bandung: Penerbit Nuansa Aulia, 2007), 25.

<sup>177</sup> Merupakan hal yang seringkali dikeluhkan oleh pelaku usaha Amerika Serikat, terkait dengan pendaftaran merek pada negara yang menggunakan "*first to file system*", lihat Frank Curci, *Protecting Your Intellectual Property Right Overseas*, *Transnational Lawyer* (15 *Transnat'l Law*. 15, Winter 2002), 2.



kasus, pelaku usaha lokal tersebut justru menjadi pihak yang dimenangkan oleh Pengadilan Niaga<sup>178</sup>. Kekalahan pemilik merek terkenal yang berasal dari negara asing membawa konsekuensi pada buruknya stigma penegakan HKI Indonesia dimata dunia internasional<sup>179</sup>.

#### 4.4. Perbandingan antara Pendaftaran Paten Sistem *Patent Cooperation Treaty (PCT)* dan Pendaftaran Merek Sistem *Madrid Protocol*

Pendaftaran paten sistem *PCT* dengan pendaftaran merek sistem *Madrid Protocol*, keduanya merupakan sistem pendaftaran (HKI) internasional. Oleh karena itu akan dilakukan perbandingan di antara kedua sistem tersebut, khususnya dari segi pendaftaran.

##### 4.4.1 *PCT*

###### 4.4.1.1. Sistem Pendaftaran

*PCT* adalah suatu bentuk kerjasama dari negara-negara anggota *WIPO*, khususnya di bidang paten. *PCT* merupakan *international filing system* (sistem pendaftaran internasional) atau sistem permohonan internasional, namun kerja sama ini tidak mencakup *granted*. Sistem ini menyederhanakan suatu sistem permohonan yang mencakup penetapan tanggal penerimaan dan tanggal publikasi. Perlindungan tersebut berada di tiap negara yang dituju. Sebagai contoh pendaftaran paten dengan menggunakan sistem *PCT* adalah seperti dipaparkan di bawah ini.

Seorang inventor mendaftarkan patennya di kantor paten Indonesia pada 1 Januari 2008. Bila inventor tersebut akan mengajukan pendaftaran patennya ke luar, maka selambat-lambatnya 12 bulan sejak tanggal pendaftarannya di Indonesia, yaitu pada 1 Januari 2009 harus didaftarkan di

<sup>178</sup> Lihat *Intel Corporation vs. PT. Panggung Electric Corporation*, Perkara Nomor 74/PDT.G/BTH/PLW/1993/PN.JKT.PST (Kasus *Intel*), *Davidoff & Cie SA v. NV Sumatera Tobacco Trading Company*, Perkara Nomor 167/PDT.G/1989/PN.JKT.PST (Kasus *Davidoff*).

<sup>179</sup> Secara tidak langsung, hal tersebut membawa akibat negatif bagi iklim investasi di Indonesia, dalam Kasus *Davidoff*, Duta Besar Swiss untuk Indonesia, Georges Martin berpendapat bahwa kasus *Davidoff* merupakan suatu kesempatan bagi lembaga peradilan Indonesia untuk menyampaikan pesan kepada para investor asing untuk merasa yakin bahwa Hak Kekayaan Intelektualnya akan selalu ditegakkan demi hukum, lihat *Dubes Swiss: Keputusan Yang Adil Menjadi Bukti Bagi Investor*, website: <http://hukumonline.com/detail.asp?id=8061&cl=Berita>, diakses pada 20 Agustus 2008.

Biro Internasional (di negara-negara tujuan lainnya. Misal, Singapura, Malaysia, Filipina, Indonesia). Yang mendaftarkan ialah si pemohon sendiri.

Sebelum permohonan didaftarkan dengan menggunakan sistem *PCT*, permohonan masuk ke fase internasional. Apabila permohonan yang diajukan telah masuk ke *IB WIPO* dan memenuhi persyaratan, maka tanggal 1 Januari 2009 ini dapat ditetapkan sebagai *international filing date* (tanggal penerimaan internasional). *International filing date* (tanggal penerimaan internasional yang merupakan salah satu keunggulan *PCT*) merupakan tanggal dimulainya perlindungan, proses perlindungan sudah dimulai saat itu. Penetapan tanggal penerimaan internasional merupakan *starting*.

Apabila persyaratan administrasi sudah memenuhi, dilakukan penelusuran internasional. Penelusuran dilakukan untuk menentukan kelas klasifikasi barang. Misalnya bidang teknik kimia, farmasi, mekanik<sup>180</sup>. Dari segi sistem administrasi, hasil penelusuran disertai dengan laporan (*report*) yang diberikan oleh *IB* kepada pemohon. Hal ini merupakan kewajiban *IB* untuk menyampaikan laporan kepada pemohon. Dalam laporan tersebut terlihat klasifikasi permohonan paten tersebut dan kategorinya. Apabila invensi pemohon paten mendekati paten yang sudah ada akan diinformasikan kepada pemohon untuk melakukan antisipasi perbaikan terhadap paten tersebut. Ini merupakan salah satu keuntungan bagi pemohon sebelum masuk ke negara tersebut.

Setelah dilakukan penelusuran internasional *IB* menentukan untuk masuk tahapan publikasi atau dengan kata lain dalam waktu 18 bulan sejak tanggal pengajuan permohonan, permohonan tersebut harus sudah dipublikasi, yaitu pada 1 Juni 2009 (publikasi internasional/publikasi di fase internasional). Semua tahapan publikasi di berbagai negara berlangsung sama, yaitu 18 bulan. Jadi selama 18 bulan itu dipublikasi oleh *IB*. Publikasi internasional ini berlaku efektif di tiap negara anggota.

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<sup>180</sup> Pada sistem pendaftaran merek disebut penentuan kelas barang/jasa. Misalnya, klasifikasi kimia murni pada paten. Klasifikasi di bidang paten lebih rumit dan banyak karena ditentukan oleh standar internasional.

Pada bulan ke-19 atau ke-20 merupakan kesempatan bagi pemohon untuk melakukan amandemen klaim untuk melakukan perbaikan. Di bulan ke-22, pemohon diberi kesempatan melakukan pemeriksaan awal internasional (masih internasional yang melakukan proses), yang disebut *demand* atau dalam *PCT* disebut *request*. Dari proses awal sampai tahap publikasi disebut *request*. Tahap pemeriksaan disebut *demand*. Memasuki bulan ke-26 atau ke-27, pemohon memperoleh laporan (*report*) pemeriksaan awal (*international preeleminary report*). Dalam waktu 1-2 minggu pemohon diberi kesempatan untuk melakukan amandemen terhadap permohonan yang pernah diajukan.

Pada bulan ke-30 pemohon masuk ke negara-negara dimana dimintakan perlindungan patennya. Tahap ini disebut fase nasional. Berbeda dengan sistem tradisional, bila pada 1 Januari 2008 *filing date* di Indonesia, maka dalam waktu 12 bulan sejak *filing date*, yaitu 1 Januari 2009 permohonan harus sudah masuk ke negara-negara yang dituju. Sistem ini masih berlaku hingga sekarang<sup>181</sup>. (Lihat Lampiran 5, Prosedur Pendaftaran Paten menurut *PCT*).

#### 4.4.1.2. Keuntungan Menggunakan Sistem *PCT*

Pendaftaran paten dengan sistem *PCT* juga memiliki keuntungan, khususnya bagi pemohon dan pemerintah.

Bagi pemohon, ketika sudah melakukan *filing* sudah mendapat perlindungan. Di sisi lain, pemohon dapat melakukan semua perbaikan sebelum masuk ke negara tujuan. Perbaikan ini dapat sejalan dengan hasil pemeriksaan dan hasil penelusuran.

Bagi pemerintah (dalam hal ini di Indonesia), sistem *PCT* ini bisa lebih cepat. Oleh karena pemeriksa paten ada di tiap negara, termasuk juga di Indonesia, maka pemeriksa di tiap negara yang dituju tidak perlu lagi melakukan penelusuran awal karena sudah dilakukan oleh *IB*.

<sup>181</sup> Hariadi Handoyo, Kasubag Pelayanan Teknis Direktorat Paten, Ditjen HKI, Departemen hukum dan HAM R.I, wawancara dilakukan oleh penulis, rekaman kaset, Jakarta, 26 September 2008.

#### 4.4.1.3. Biaya

Sistem *PCT* biasanya digunakan oleh perusahaan besar (*big company*) karena biaya yang dikeluarkan dengan menggunakan sistem ini besar. Pada saat perlindungan paten akan masuk ke negara-negara yang akan dimintakan perlindungannya akan dikenakan biaya pendaftaran sistem *PCT*, di mana tiap negara memiliki pengaturan sendiri mengenai biaya pendaftaran dengan menggunakan sistem *PCT*. Ada *national law* masing-masing negara yang berbeda-beda. Oleh karena itu, bila ingin melakukan pendaftaran dengan sistem *PCT* lebih baik diajukan ke banyak negara, maka biayanya tidak sedikit dengan sistem ini. (Lihat Tabel 6, Pendaftaran *PCT*).

Menggunakan sistem *PCT* juga ada *reduction fee* yang dapat diperoleh pemohon. Perolehannya kini dapat mencapai 90%<sup>182</sup>, namun hal itu hanya diberikan pada *natural person*, artinya pemohon ialah nama pribadi tidak berbentuk perusahaan. Jadi, *reduction fee* ini hanya dapat diperoleh oleh inventor pribadi. Dapat dikatakan bahwa yang disepakati oleh negara-negara anggota *PCT* ialah mengenai *filing date* secara internasional, publikasi dan penelusuran (*search*). Mengenai biaya pendaftaran, tiap negara mengatur berbeda. Hukum nasional masing-masing negara mengatur hal-hal yang tidak sama.

#### 4.4.2. Madrid Protocol

##### 4.4.2.1. Sistem Pendaftaran

Pemohon mengajukan permohonan internasional (*international application*) di Kantor Merek negara asal (*office of origin*)<sup>183</sup>. Apabila pemohon hendak menggunakan hak prioritasnya sesuai Konvensi Paris maka harus menyertakan pernyataan menyangkut hak prioritas tersebut beserta nama Kantor Merek tempat pendaftaran yang menghasilkan hak prioritas tersebut serta nomornya<sup>184</sup>. Pada saat permohonan internasional

<sup>182</sup> Hal ini merupakan kebijakan yang ditetapkan oleh WIPO, dapat dilihat di website: <http://www.wipo.int>.

<sup>183</sup> *Madrid Protocol*, Article 2, lihat John Murphy, *Demystifying Madrid Protocol*, *Northwestern Journal of Technology and Intellectual Property*, (Volume 2, No. 2, Spring 2004), 241.

<sup>184</sup> *Common Regulations*, Rule 9(a)(iv).

diterima oleh Kantor Merek, maka kepada pemohon diberikan tanggal penerimaan (*date of international application*)<sup>185</sup>.

Permohonan internasional akan diajukan ke *WIPO* apabila dianggap memenuhi persyaratan oleh Kantor Merek negara asal<sup>186</sup>. Selanjutnya permohonan internasional akan diperiksa secara formalitas oleh *WIPO* selaku *IB*, apakah terhadap permohonan internasional tersebut *WIPO* dapat mengeluarkan pendaftaran internasional (*international registration*) atau tidak.

Pemeriksaan unsur pembeda maupun deskripsi dari merek tersebut diserahkan kepada Kantor Merek negara tujuan (*designated office*) dengan menggunakan Undang-undang maupun regulasi merek negaranya masing-masing<sup>187</sup>. Yang dilakukan *WIPO* dalam tahap ini hanya memeriksa klasifikasi barang dan jasa yang tertera di permohonan internasional tersebut, apakah sudah memenuhi standar internasional yang disebutkan di *Nice Agreement* atau belum<sup>188</sup>. Apabila belum memenuhi kriteria, maka *WIPO* akan melengkapi klasifikasi atas barang dan jasa, atau dapat meminta bantuan kepada pemohon (atau perwakilannya) untuk mengubah atau menambahkan keterangan terhadap detail klasifikasi barang dan jasa yang dianggap bias, salah atau kurang lengkap<sup>189</sup>.

Terhadap ketidaksesuaian prosedur permohonan internasional tersebut, *WIPO* dapat mengeluarkan "*notice of irregularity*", yang mengharuskan pemohon untuk memperbaharui permohonan internasional tersebut dalam waktu 3 bulan<sup>190</sup>. Namun bila permohonan internasional tersebut dinyatakan memenuhi persyaratan untuk didaftar, maka *WIPO* akan menetapkan tanggal dan nomor pendaftaran internasional, melakukan

<sup>185</sup> *Madrid Protocol*, Article 3(1)(i)(ii).

<sup>186</sup> Agar tanggal yang tercantum pada pendaftaran internasional (*date of international registration*) sama dengan tanggal yang tercantum pada permohonan internasional (*date of international application*), permohonan internasional harus diajukan ke *WIPO* paling lambat dua bulan setelah tanggal permohonan internasional. Lewat dari dua bulan, tanggal yang tercantum pada pendaftaran internasional adalah tanggal di mana *WIPO* menerima permohonan internasional tersebut, lihat *Madrid Protocol*, Article 3 (4),

<sup>187</sup> David Tatham, 4.

<sup>188</sup> *Ibid*

<sup>189</sup> *Ibid*.

<sup>190</sup> *Common Regulations*, Rule 11 (2)(b).

pencatatan merek tersebut dalam *international register* dan memberitahukan Kantor Merek negara tujuan atas pendaftaran internasional tersebut<sup>191</sup>. *WIPO* juga akan memuat pendaftaran internasional di dalam *WIPO Gazette*.

Kantor Merek negara tujuan lalu akan memeriksa pendaftaran internasional tersebut berdasarkan Undang-undang maupun regulasi mereknya masing-masing. Negara tujuan berhak menolak pendaftaran internasional tersebut di negaranya atas dasar regulasi merek nasionalnya<sup>192</sup>. Apabila merek tersebut tidak dapat didaftar di negara tersebut, maka Kantor Merek negara tujuan akan menyampaikan penolakan, atau yang lebih dikenal dengan “*provisional refusal*” kepada *WIPO* agar mencatat penolakan tersebut di *international register* dan *WIPO Gazette* serta diberitahukan ke pihak pemohon terkait dengan tidak dapat didaftarkannya merek di negara tersebut. Periode pemeriksaan dapat berlangsung maksimal 12 hingga 18 bulan<sup>193</sup>.

Penyelesaian terhadap penolakan tersebut lalu akan diteruskan melalui bantuan Konsultan HKI lokal di negara tersebut<sup>194</sup>. Apabila dalam tempo hingga 12 atau 18 bulan, tergantung jangka waktu maksimal pemeriksaan di negara tersebut, pemeriksa merek di negara tujuan tidak menyampaikan “*provisional refusal*” maupun pemberitahuan terkait kemungkinan adanya penolakan dari pihak ketiga terkait dengan didaftarkannya merek tersebut, maka merek tersebut wajib untuk dilindungi<sup>195</sup>, sama halnya dengan merek yang didaftarkan secara langsung di negara tersebut<sup>196</sup>.

<sup>191</sup> David Tatham, 3.

<sup>192</sup> *Madrid Protocol*, Article 5(1),

<sup>193</sup> *Summary of the Madrid Agreement Concerning the International Registration of Marks (1891) and the Protocol Relating to that Agreement (1989)*, website: [http://www.WIPO.int/treaties/en/registration/madrid\\_protocol/summary/](http://www.WIPO.int/treaties/en/registration/madrid_protocol/summary/), terakhir diakses 14 Maret 2008.

<sup>194</sup> Roya Ghafele, *SMEs or Micromultinationals (Leveraging the Madrid System for International Branding)*, [http://www.WIPO.int/sme/en/documents/madrid\\_system\\_branding.htm](http://www.WIPO.int/sme/en/documents/madrid_system_branding.htm), terakhir diakses 26 Mei 2008.

<sup>195</sup> *Ibid.*

<sup>196</sup> Jangka waktu perlindungan yang diberikan melalui *Madrid System* adalah 10 tahun, lihat *Madrid Protocol*, Article 6(1).

#### 4.4.2.2. Biaya

Biaya untuk melakukan pendaftaran merek secara internasional dengan *Madrid System*, ada 3 macam biaya yang harus dibayar oleh pemohon, yaitu "*Basic Fee*" yang dibayar kepada Kantor Merek negara asal, sebesar 653 Swiss Francs (Sekitar US\$ 590). "*Supplementary Fee*", sebesar 73 Swiss Francs (sekitar US\$ 66), untuk setiap kelas barang dan jasa, mengacu pada klasifikasi *Nice Agreement*, dihitung setelah klasifikasi ketiga dari kelas barang atau jasa tersebut.<sup>197</sup> "*Complimentary Fee*" mengacu pada *Madrid Protocol* sebesar 73 Swiss Francs (sekitar US\$ 66), dibayar pemohon pendaftaran kepada Kantor Merek negara asal atau kantor merek setempat untuk setiap pendaftaran ke satu negara tujuan. Apabila pemohon hendak mendaftarkan mereknya di 10 negara.

Misalnya, maka "*complimentary fee*" yang harus dibayarkan adalah sebesar  $US\$66 \times 10 = US\$660$ .

Biaya "*complimentary fee*" ke setiap negara tidaklah sama, namun dapat dipastikan lebih murah daripada biaya melakukan pendaftaran merek secara langsung di negara tersebut<sup>198</sup>

Berikut adalah rangkuman biaya-biaya terkait dengan pendaftaran merek sesuai dengan *Madrid Protocol*.<sup>199</sup>

Tabel 1. Biaya Pendaftaran Merek Menurut *Madrid Protocol*

Application	5fr	US\$
Biaya <i>Basic Application</i> (tanpa warna)	653	497
Biaya <i>Basic Application</i> (dengan warna)	903	688
<i>Supplementary Fee</i> untuk setiap kelas, dihitung setelah tiga kelas pertama	73	56

<sup>197</sup> Setiap tahunnya, "*complementary fee*" dan "*supplementary fee*" yang terkumpul akan dijumlahkan dan dibagikan kepada negara-negara anggota berdasarkan jumlah Negara yang dituju; lebih lanjut lihat David Tatham, loc.cit., hal. 3.

<sup>198</sup> Paul Sputnik, *Protecting Trademarks Under the Madrid Protocol*, Los Angeles Lawyer (27-APR L.A. Law. 26, April 2004), 2; lebih lanjut mengenai biaya pendaftaran ke setiap negara yang tergabung dalam *Madrid Union*, pemohon atau kuasanya dapat melihat *WIPO Fee Calculator*, website: <http://www.WIPO.int/madrid/en/fees/calculator.jsp>, diakses terakhir 23 April 2008.

<sup>199</sup> Sam Mamudi, James Nurton, 21

<i>Complementary Fee</i> untuk setiap tujuan (beberapa negara menetapkan <i>individual fee</i> yang berbeda)	73	56
<b>Pendaftaran Merek Setelah diperolehnya International Registration/Designation Subsequent to Registration</b>		
<i>Basic fee</i>	300	228
<i>Complementary Fee</i> untuk setiap tujuan (beberapa negara menetapkan <i>individual fee</i> yang berbeda)	73	56

Tabel 2. Perbandingan antara Sistem *PCT* dan Sistem *Madrid Protocol*

No	Unsur	<i>PCT</i>	<i>Madrid Protocol</i>
1	Pemohon	Penduduk atau warga negara yang mengadakan perjanjian ( <i>PCT</i> ) (art.9)	Warganegara, badan hukum atau organisasi internasional yang berkedudukan di negara yang merupakan anggota dari <i>Madrid Protocol</i> .
2	Permohonan Internasional	Berisi satu permintaan, satu deskripsi, satu klaim/lebih, satu gambar/lebih, satu deskripsi (Art.3 (2)).	<ul style="list-style-type: none"> <li>• menyertakan nama dan alamat pemohon (<i>Rule 9(a)(i)Common Regulation</i>);</li> <li>• keterangan apakah pemohon warga negara atau badan hukum (<i>Rule 9(b)(i), (ii)</i>);</li> <li>• nama dan alamat perwakilan pemohon di negara tujuan (<i>Rule 9(a)(iii)</i>);</li> <li>• deskripsi mengenai permohonan pendaftaran merek (<i>basic application</i>) atau pendaftaran awal (<i>basic registration</i>)( <i>Rule 9(a)(xi)</i>);</li> <li>• klasifikasi kelas barang dan jasa mengacu pada <i>Nice Agreement</i>, sesuai klasifikasi yang diakui di negara asal (<i>Rule 9(a)(xi)</i>).</li> </ul>
3.	Filing date	Kantor penerima sebagai tanggal penerimaan (Art. 11 (1))	<i>Article 3(1)(i)(ii), Madrid Protocol</i>
4.	Bahasa	Menurut yang ditetapkan	Inggris, Perancis, atau Spanyol ( <i>Rule 6</i> )
4.	Kantor Penerima (negara tujuan)	Permohonan internasional ditujukan pada kantor penerima yang ditentukan tujuan (Art. 10).	Melakukan pemeriksaan substantif.
5.	Pengiriman permohonan internasional kepada biro internasional	Permohonan dikirim ke biro internasional apabila telah memenuhi persyaratan administratif (art.12)	Permohonan dikirim ke biro internasional (WIPO) apabila telah memenuhi persyaratan oleh kantor merek negara asal ( <i>Article 3(1)(i)(ii), Madrid Protocol</i> )
6.	Penelusuran	• Bertujuan untuk menemukan teknologi	Tidak ada penelusuran internasional.



- sistem hanya boleh diaplikasikan oleh negara-negara yang telah meratifikasi peraturan tersebut;
- ada unsur amandemen apabila ada hal-hal yang kurang dan perlu diperbaharui. Hal yang membedakan adalah pada unsur penelusuran internasional yang ada pada *PCT*, tidak ada dalam *Madrid Protocol*;
- biro internasional WIPO sebagai organisasi yang menerima permohonan dari negara asal apabila telah memenuhi persyaratan administratif;
- fase nasional merupakan istilah dalam *PCT*, dimana pendaftaran paten telah masuk ke negara yang dituju; sedangkan dalam *Madrid Protocol* tidak ada istilah itu, namun ketika sudah masuk ke wilayah nasional merupakan negara tujuan pendaftaran.

Yang membedakan dari kedua sistem tersebut, yaitu:

- adanya unsur penelusuran internasional dalam *PCT*, sedangkan di sistem *Madrid Protocol* tidak ada;
- sistem *PCT* biaya belum tentu hemat karena ditentukan oleh masing-masing negara tujuan, sedangkan biaya menurut *Madrid Protocol* sudah diatur dalam *Protocol* tersebut.

## BAB V

### PENUTUP

#### 5.1. Kesimpulan

Kesimpulan yang dapat diambil dari penulisan ini, yaitu:

1. Keuntungan bila Indonesia mengadopsi sistem *Madrid Protocol* bagi pendaftar merek lokal, yakni:
  - a. Kesederhanaan prosedur dan penghematan biaya. Pemohon tidak harus mendaftarkan ke semua negara tujuan pendaftaran (seperti sistem konvensional), melainkan cukup dengan satu aplikasi/permohonan, pemohon mendaftarkan melalui Ditjen HKI (satu tempat *office of origin*). Pemohon menyatakan dengan memberi tanda pada formulir ke negara mana mereknya akan didaftarkan. Setelah itu Ditjen HKI akan meneruskan ke International Bureau (*IB*), lalu *IB* akan meneruskan ke beberapa negara yang menjadi tujuan pendaftaran. Pendaftaran merek dengan sistem konvensional mengharuskan pemohon melakukan pembayaran biaya pendaftaran sesuai dengan ketentuan dan mata uang setiap negara tujuan, tetapi dengan sistem Madrid biaya pendaftaran hanya perlu dibayarkan dalam satu jenis mata uang. Mata uang yang dimaksud yaitu mata uang dari negara di mana pemohon mengajukan permohonan internasional.
  - b. Stimulan/Memotivasi Pelaku Usaha Indonesia untuk Melakukan Ekspor Dengan diadopsinya sistem *Madrid Protocol* akan memotivasi para pelaku usaha di Indonesia untuk melindungi produknya dengan merek, kemudian dapat didaftarkan dengan di beberapa negara dengan sistem Madrid ini, yang pada akhirnya barang tersebut akan diorientasikan untuk tujuan ekspor.

2. *Madrid Protocol* dan kaitannya dengan pemeriksaan pendaftaran merek asing di Indonesia ialah Apabila ada pendaftar merek asing yang menjadikan Indonesia sebagai negara tujuan pendaftaran mereknya di Indonesia, maka dengan diadopsinya sistem madrid di Indonesia tentu akan mempermudah proses pemeriksaan di Indonesia karena sebelum permohonan masuk ke Indonesia sebagai negara tujuan, dengan sistem madrid pemeriksaan awal sudah dilakukan di negara asal dan oleh *International Bureau (IB)*
3. *Madrid Protocol* dan kaitannya dengan merek terkenal.
  - Sistem madrid memungkinkan pemilik merek terkenal untuk mendaftarkan mereknya dengan hak prioritas dalam satu dokumen dan satu pendaftaran yang berlaku ke semua negara anggota *Madrid Union*;
  - *Madrid Protocol, TRIPs Agreement* dan UU No.15/2001 pengaturan mereknya berkaitan dengan Konvensi Paris, maka dikaitkan dengan hak prioritas dimana ketiganya mengatur hal itu, acuan penerapan pendaftaran mereknya, yakni:
    - a. Perlakuan pemberian perlindungan hukum yang sama.
    - b. Berdasarkan asas Resiprositas.

Asas Resiprositas dengan sendirinya bercorak multilateral terhadap semua negara anggota peserta Konvensi Paris, artinya jika pemohon bukan dari negara anggota peserta Konvensi Paris, kantor mereka harus menolak pendaftaran dengan alasan tidak ditegakkan asas Resiprositas
  - Apabila Indonesia menggunakan sistem madrid, sengketa merek terkenal yang terjadi di masa yang akan datang dapat semakin berkurang karena pemilik merek yang berasal dari negara anggota dari Konvensi Paris dapat dengan lebih mudah melakukan pendaftaran merek di berbagai yurisdiksi negara yang berbeda sesama anggota Konvensi Paris.

4. Berdasarkan perbandingan antara sistem *PCT* dan *Madrid Protocol* yang telah penulis buat, terdapat persamaan dan perbedaan diantara keduanya. Adapun persamaan dari kedua sistem ini, yakni:

- sistem hanya boleh diaplikasikan oleh negara-negara yang telah meratifikasi peraturan tersebut;
- ada unsur amandemen apabila ada hal-hal yang kurang dan perlu diperbaharui. Hal yang membedakan adalah pada unsur penelusuran internasional yang ada pada *PCT*, tidak ada dalam *Madrid Protocol*;
- biro internasional *WIPO* sebagai organisasi yang menerima permohonan dari negara asal apabila telah memenuhi persyaratan administratif;
- fase nasional merupakan istilah dalam *PCT*, dimana pendaftaran paten telah masuk ke negara yang dituju; sedangkan dalam *Madrid Protocol* tidak ada istilah itu, namun ketika sudah masuk ke wilayah nasional merupakan negara tujuan pendaftaran.

Unsur-unsur yang membedakan dari kedua sistem tersebut, yaitu:

- adanya unsur penelusuran internasional dalam *PCT*, sedangkan di sistem *Madrid Protocol* tidak ada;
- adanya prinsip *one application, one document* yang menyebabkan efisiensi prosedur dan biaya, sedangkan di sistem *PCT* biaya belum tentu hemat karena ditentukan oleh masing-masing negara tujuan.

## 5.2. Saran

Kebijakan Indonesia untuk mengadopsi baik untuk diterapkan karena sistem ini sangat baik bagi kepentingan nasional, khususnya untuk mendukung para pemilik merek atau pelaku usaha dalam meningkatkan kegiatan ekspor. Dengan meningkatnya ekspor tentu akan berpengaruh terhadap devisa negara. Sehubungan dengan hal tersebut pemerintah perlu melakukan pembenahan dan mempersiapkan hal-hal sebagai berikut:

- a. infrastruktur pendukung yang berbasis teknologi informasi yang handal dalam *search*, pemeriksaan substantif dan *electronic communication*;

- b. sumber daya manusia yang cakap berbahasa Inggris karena proses koordinasi terkait dengan pendaftaran merek secara internasional dilakukan langsung antara Kantor Merek Indonesia selaku Kantor Merek negara asal dan *WIPO* selaku “*international bureau*”;
- c. jangka waktu pendaftaran merek agar sesuai dengan yang ditetapkan dalam Undang-undang Merek dan menyelesaikan tunggakan pekerjaan (pemeriksaan merek, penerbitan sertifikat, dll);
- d. pelaku usaha berani melakukan ekspor dengan menggunakan mereknya sendiri, bukan sekedar memenuhi pesanan importir. Dengan demikian, melalui sistem madrid akan lebih banyak merek Indonesia yang beredar di pasar global di masa yang akan datang;
- e. melakukan seminar, *workshop*, serta kegiatan sosialisasi untuk pemahaman masyarakat tentang *Madrid Protocol*;
- f. melakukan pelatihan bagi pemeriksa formal dan pemeriksa substantif dalam kerangka madrid;
- g. harus terdapat satu divisi khusus di dalam Direktorat Merek yang menangani pendaftaran merek melalui sistem madrid guna menjamin kelancaran pendaftaran secara internasional.
- h. masuknya Indonesia ke dalam *Madrid Union* membawa konsekuensi terhadap proses adopsi substansi *Madrid Protocol* ke dalam UU Merek. Oleh sebab itu, kelak harus terdapat satu pasal dalam UU Merek yang mengindikasikan mengenai pendelegasian lebih lanjut ketentuan pendaftaran merek melalui sistem madrid ke dalam bentuk Peraturan Pemerintah. Peraturan Pemerintah yang dimaksud berfungsi untuk mengatur hal-hal teknis yang lebih mendetail mengenai prosedur pendaftaran merek melalui sistem madrid. Substansi mengenai pendaftaran merek melalui sistem madrid juga dapat dicantumkan dalam satu bab tersendiri di dalam UU Merek, agar dapat dengan jelas terlihat perbedaan pengaturan antara pendaftaran merek secara langsung dan pendaftaran merek secara internasional melalui sistem madrid.

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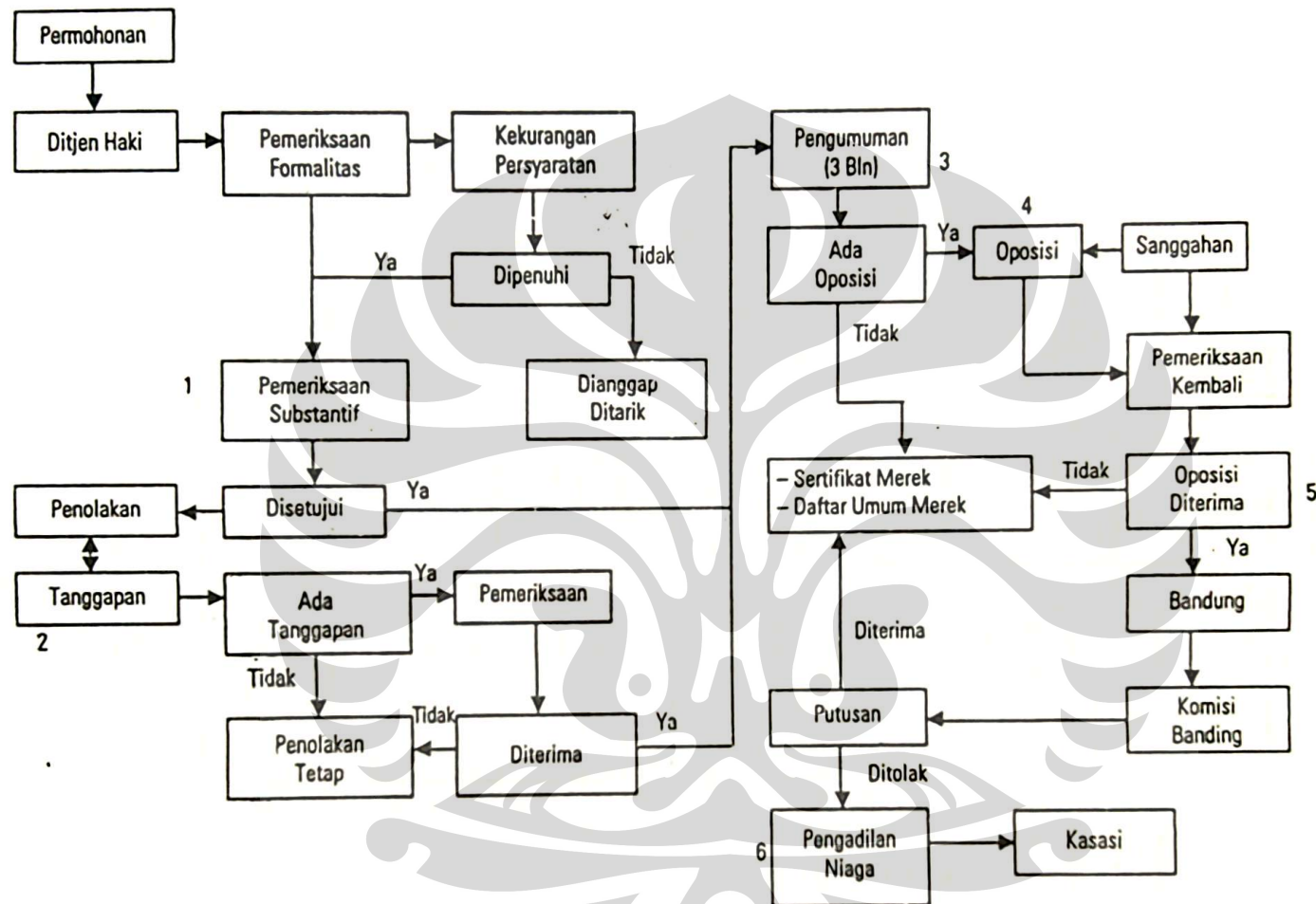
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## PROSEDUR PENGAJUAN PENDAFTARAN MEREK (MENURUT UU MEREK NO. 15 TAHUN 2001)



1. Berlangsung paling lama 9 bulan.
2. Paling lama 30 hari sejak tanggal surat pemberitahuan penolakan.
3. Berlangsung selama 3 bulan terhitung paling lama 10 hari sejak tanggal disetujuinya permohonan untuk didaftar.
4. Oposisi dapat dilakukan selama jangka waktu pengumuman.
5. Jika oposisi diterima pemohon dapat mengajukan banding ke komisi banding, jika tidak Ditjen Hakl menerbitkan Sertifikat Merek paling lama 30 hari sejak tanggal permohonan disetujui untuk didaftar.
6. Gugatan diajukan paling lama 3 bulan sejak diterimanya keputusan penolakan banding.

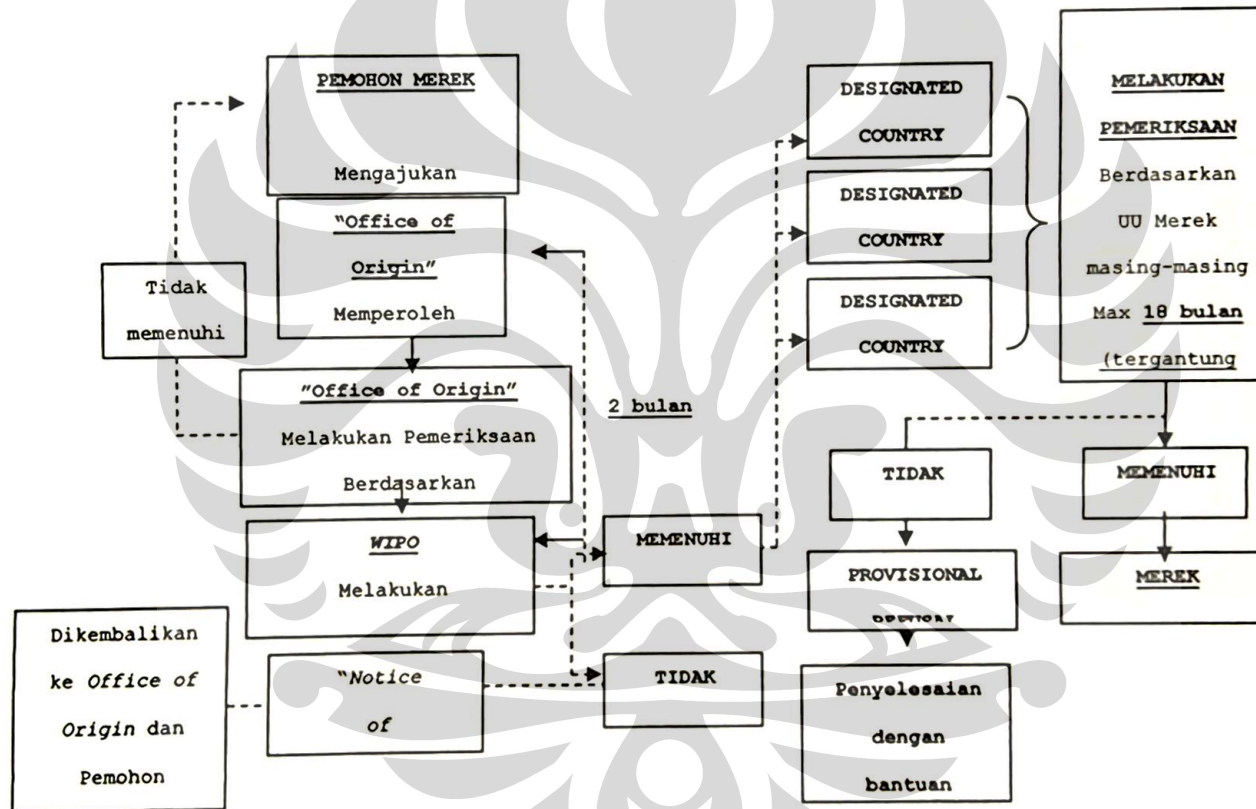
## Lampiran 2

### DAFTAR NEGARA ANGGOTA MADRID

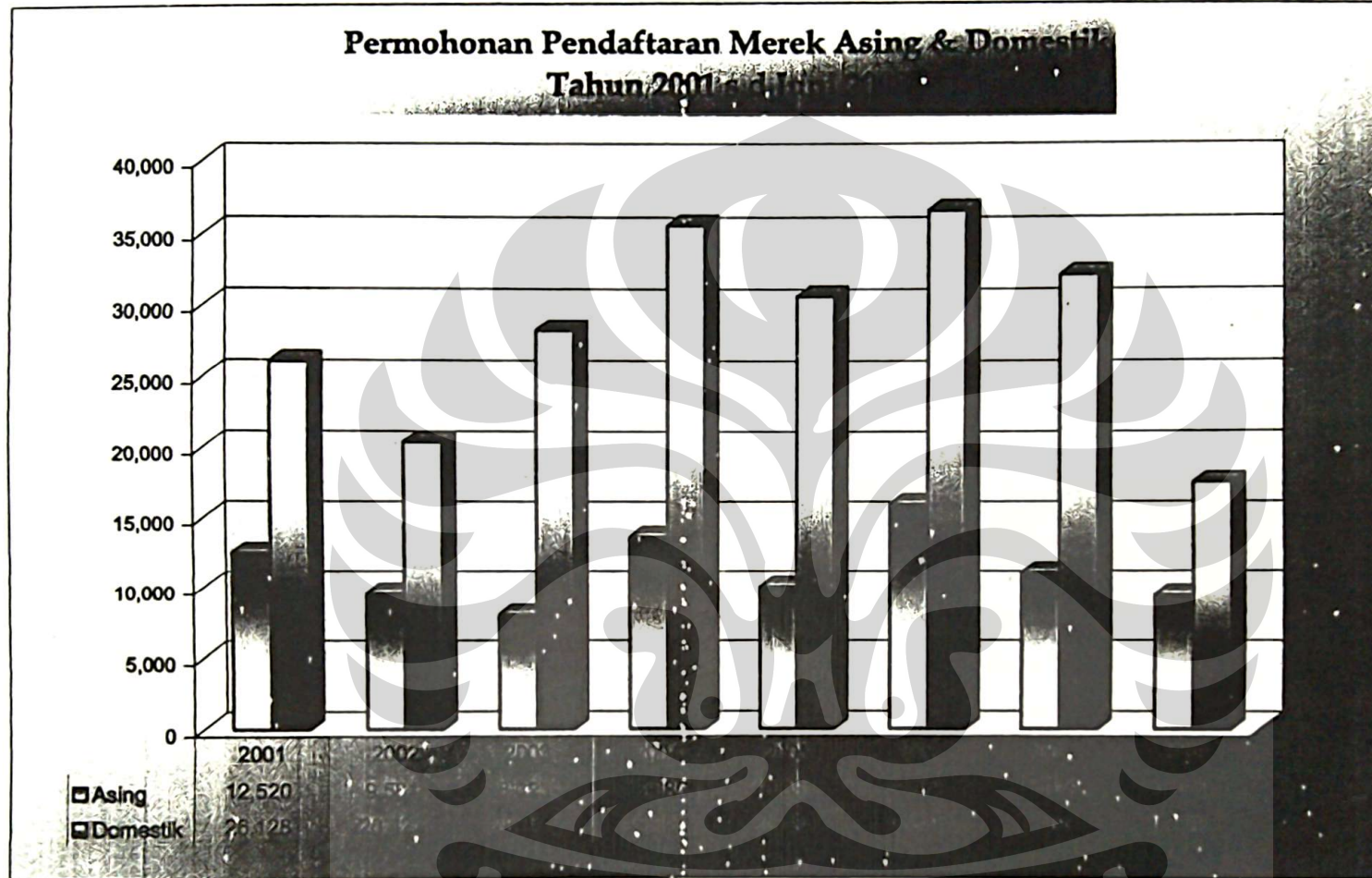
AGREEMENT				PROTOCOL			
NO	NEGARA	NO	NEGARA	NO	NEGARA	NO	NEGARA
1	Albania	31	Macedonia	1	Albania	32	Kyrgyzstan
2	Algeria	32	Moldova	2	Antigua & Barbuda	33	Latvia
3	Armenia	33	Monaco	3	Armenia	34	Lesotho
4	Austria	34	Mongolia	4	Australia	35	Liechtenstein
5	Azerbaijan	35	Morocco	5	Austria	36	Lithuania
6	Belarus	36	Mozambique	6	Belarus	37	Macedonia (a/o 8/30/02)
7	Belgium (Benelux)	37	Namibia	7	Benelux	38	Moldova
8	Bhutan	38	Netherlands (Benelux)	8	Bhutan	39	Monaco
9	Bosnia & Herzegovina	39	Poland	9	Bulgaria	40	Mongolia
10	Bulgaria	40	Portugal	10	China (PRC)	41	Morocco
11	China (PRC)	41	Roumania	11	Croatia	42	Mozambique
12	Croatia	42	Russian Federation	12	Cuba	43	Namibia
13	Cuba	43	San Marino	13	Cyprus	44	Norway
14	Cyprus	44	Serbia & Montenegro	14	Czech Republic	45	Poland
15	Czech Republic	45	Sierra Leone	15	Denmark	46	Portugal
16	Egypt	46	Slovak Republic	16	Estonia	47	Roumania
17	France (inc. Overseas Dept. & Terr.)	47	Slovenia	17	European Union	48	Serbia & Montenegro
18	Germany	48	Spain	18	Finland	49	Sierra Leone
19	Hungary	49	Sudan	19	France (incl. Overseas Dept. & Territories)	50	Singapore
20	Iran	50	Swaziland	20	Georgia	51	Slovak Republic
21	Italy	51	Switzerland	21	Germany	52	Slovenia
22	Kazakhstan	52	Syria	22	Grocco	53	Spain
23	Kenya	53	Tajikistan	23	Hungary	54	Swaziland
24	Korea (North)	54	Ukraine	24	Iceland	55	Sweden
25	Kyrgyzstan	55	Uzbekistan	25	Iran	56	Switzerland
26	Latvia	56	Vietnam	26	Ireland	57	Turkey
27	Lesotho			27	Italy	58	Turkmenistan
28	Liberia			28	Japan	59	Ukraine
29	Liechtenstein			29	Kenya	60	United Kingdom
30	Luxembourg (Benelux)			30	Korea (North)	61	United States of America
				31	Korea (South)	62	Zambia

Sumber : [www.ladaperry.com](http://www.ladaperry.com)

Lampiran 3

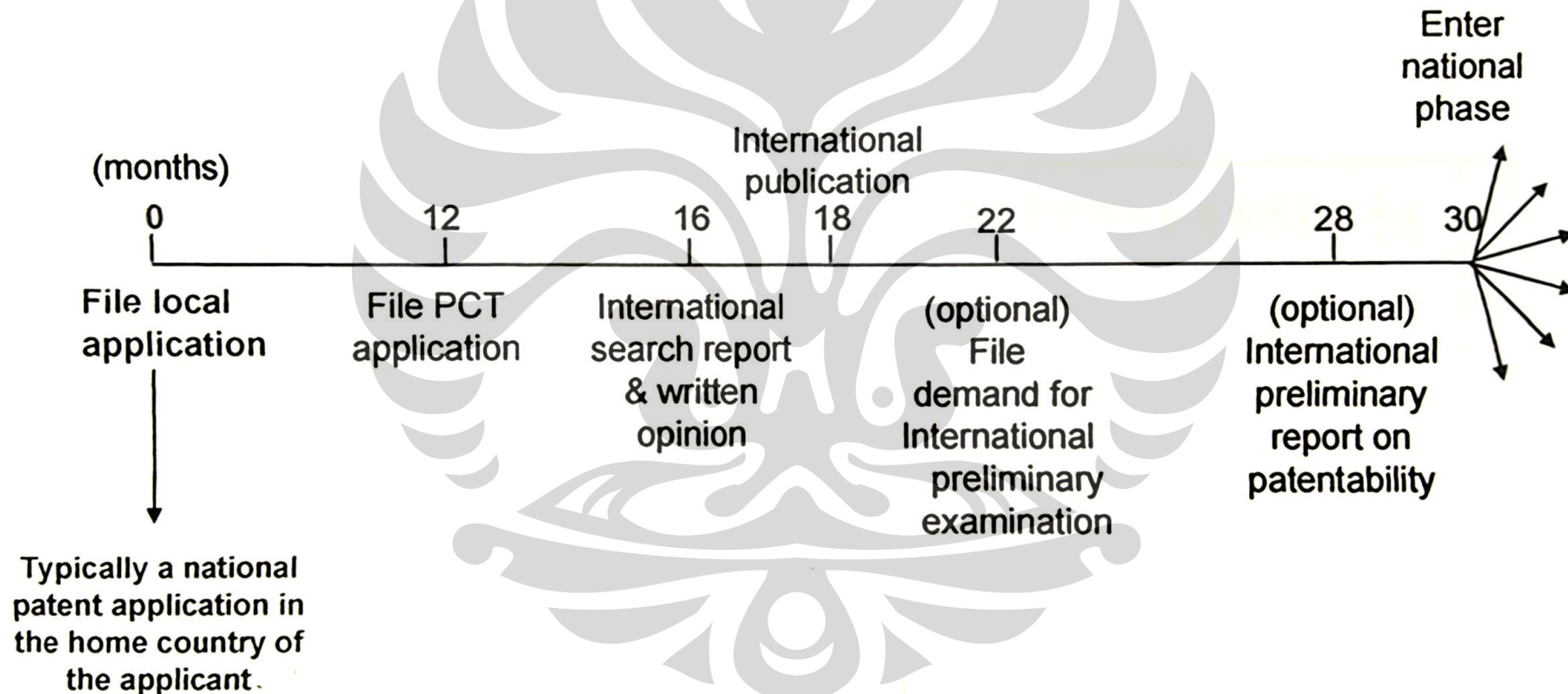


Lampiran 4



# The PCT System --typical use, in more detail

Lampiran 5





## Lampiran 6

**JUMLAH PERMOHONAN PATEN**

TAHUN/BULAN	PATEN				PATEN SEDERHANA		JUMLAH
	DALAM	PCT	LUAR	PCT	DALAM	LUAR	
1991	34		1280		19	3	1336
1992	67		3905		12	43	4027
1993	38		2031		28	43	2140
1994	29		2305		33	60	2427
1995	61		2813		61	71	3006
1996	40		3957		59	76	4132
1997	79		3939		80	80	4178
1998	93		1608	145	109	32	1987
1999	152		1051	1733	168	19	3123
2000	156	1	983	2750	213	38	4141
2001	208	4	813	2901	197	24	4147
2002	228	6	633	2976	157	48	4048
2003	201		479	2620	163	29	3492
2004	226	1	452	2989	177	32	3877
2005	234	1	533	3536	163	32	4499
2006	282	6	519	3805	242	26	4880
2007	279	5	493	4357	209	34	5377
<b>2008</b>							
JANUARI	12		42	373	17	1	445
FEBRUARI	17	2	49	343	19	2	432
MARET	14	2	50	324	16	5	411
APRIL	22	2	26	361	11	1	423
MEI							
JUNI							
JULI							
AGUSTUS							
SEPTEMBER							
OKTOBER							
NOVEMBER							
DESEMBER							
<b>JUMLAH</b>	<b>2472</b>	<b>30</b>	<b>27961</b>	<b>29213</b>	<b>2153</b>	<b>699</b>	<b>62528</b>
<b>%</b>	<b>3.95%</b>	<b>0.05%</b>	<b>44.72%</b>	<b>46.72%</b>	<b>3.44%</b>	<b>1.12%</b>	<b>100.00%</b>

Tangerang, Mei 2008

Direktorat Paten  
Direktorat Jenderal HKI  
Departemen Kehakiman dan HAM RI

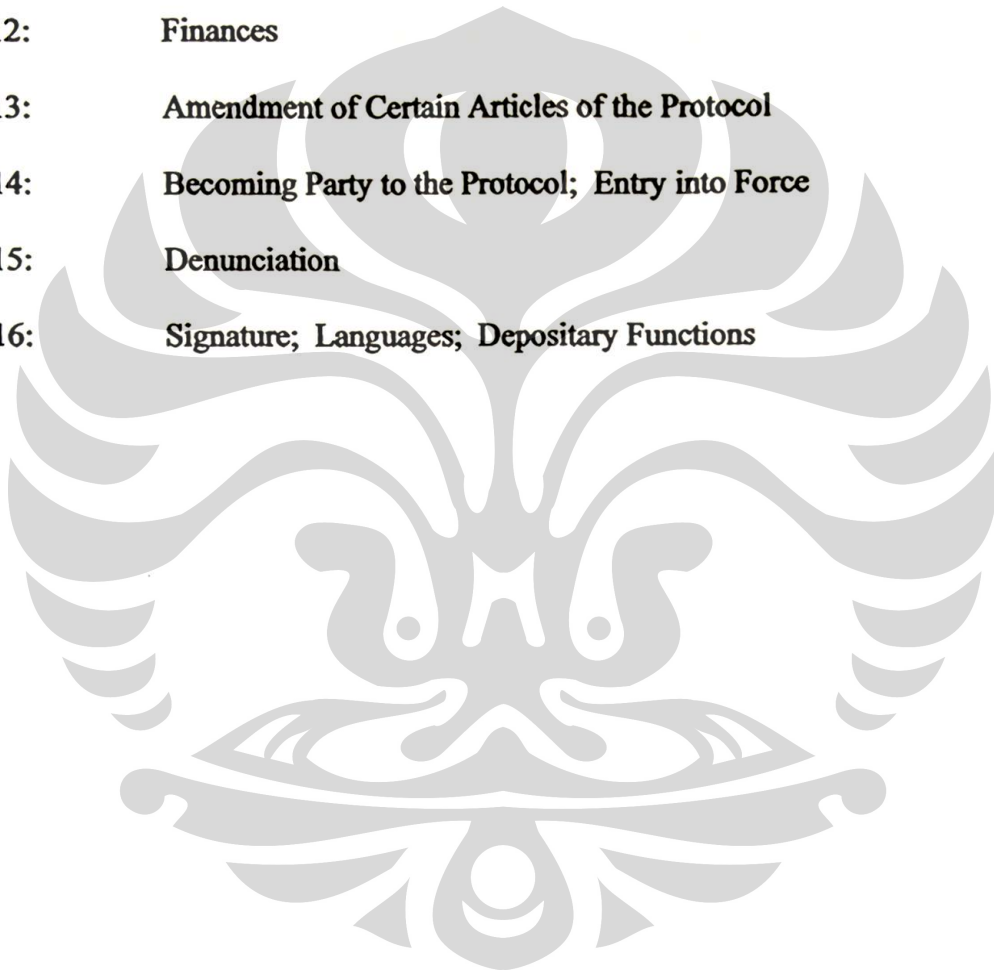
**PROTOCOL  
RELATING TO THE MADRID AGREEMENT  
CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS**

Adopted at Madrid on June 27, 1989  
and amended on October 3, 2006

**List of the Articles of the Protocol**

- Article 1: Membership in the Madrid Union
- Article 2: Securing Protection through International Registration
- Article 3: International Application
- Article 3*bis*: Territorial Effect
- Article 3*ter*: Request for “Territorial Extension”
- Article 4: Effects of International Registration
- Article 4*bis*: Replacement of a National or Regional Registration by an International Registration
- Article 5: Refusal and Invalidation of Effects of International Registration in Respect of Certain Contracting Parties
- Article 5*bis*: Documentary Evidence of Legitimacy of Use of Certain Elements of the Mark
- Article 5*ter*: Copies of Entries in International Register; Searches for Anticipations; Extracts from International Register
- Article 6: Period of Validity of International Registration; Dependence and Independence of International Registration
- Article 7: Renewal of International Registration
- Article 8: Fees for International Application and Registration
- Article 9: Recordal of Change in the Ownership of an International Registration
- Article 9*bis*: Recordal of Certain Matters Concerning an International Registration
- Article 9*ter*: Fees for Certain Recordals

- Article 9<sup>quater</sup>:** Common Office of Several Contracting States
- Article 9<sup>quinqies</sup>:** Transformation of an International Registration into National or Regional Applications
- Article 9<sup>sexies</sup>:** Safeguard of the Madrid (Stockholm) Agreement
- Article 10:** Assembly
- Article 11:** International Bureau
- Article 12:** Finances
- Article 13:** Amendment of Certain Articles of the Protocol
- Article 14:** Becoming Party to the Protocol; Entry into Force
- Article 15:** Denunciation
- Article 16:** Signature; Languages; Depositary Functions



## Article 1

### Membership in the Madrid Union

The States party to this Protocol (hereinafter referred to as “the Contracting States”), even where they are not party to the Madrid Agreement Concerning the International Registration of Marks as revised at Stockholm in 1967 and as amended in 1979 (hereinafter referred to as “the Madrid (Stockholm) Agreement”), and the organizations referred to in Article 14(1)(b) which are party to this Protocol (hereinafter referred to as “the Contracting Organizations”) shall be members of the same Union of which countries party to the Madrid (Stockholm) Agreement are members. Any reference in this Protocol to “Contracting Parties” shall be construed as a reference to both Contracting States and Contracting Organizations.

## Article 2

### Securing Protection through International Registration

(1) Where an application for the registration of a mark has been filed with the Office of a Contracting Party, or where a mark has been registered in the register of the Office of a Contracting Party, the person in whose name that application (hereinafter referred to as “the basic application”) or that registration (hereinafter referred to as “the basic registration”) stands may, subject to the provisions of this Protocol, secure protection for his mark in the territory of the Contracting Parties, by obtaining the registration of that mark in the register of the International Bureau of the World Intellectual Property Organization (hereinafter referred to as “the international registration,” “the International Register,” “the International Bureau” and “the Organization,” respectively), provided that,

- (i) where the basic application has been filed with the Office of a Contracting State or where the basic registration has been made by such an Office, the person in whose name that application or registration stands is a national of that Contracting State, or is domiciled, or has a real and effective industrial or commercial establishment, in the said Contracting State,
- (ii) where the basic application has been filed with the Office of a Contracting Organization or where the basic registration has been made by such an Office, the person in whose name that application or registration stands is a national of a State member of that Contracting Organization, or is domiciled, or has a real and effective industrial or commercial establishment, in the territory of the said Contracting Organization.

(2) The application for international registration (hereinafter referred to as “the international application”) shall be filed with the International Bureau through the intermediary of the Office with which the basic application was filed or by which the basic registration was made (hereinafter referred to as “the Office of origin”), as the case may be.

(3) Any reference in this Protocol to an “Office” or an “Office of a Contracting Party” shall be construed as a reference to the office that is in charge, on behalf of a Contracting Party, of the registration of marks, and any reference in this Protocol to “marks” shall be construed as a reference to trademarks and service marks.

(4) For the purposes of this Protocol, “territory of a Contracting Party” means, where the Contracting Party is a State, the territory of that State and, where the Contracting Party is an intergovernmental organization, the territory in which the constituting treaty of that intergovernmental organization applies.

### Article 3

#### International Application

(1) Every international application under this Protocol shall be presented on the form prescribed by the Regulations. The Office of origin shall certify that the particulars appearing in the international application correspond to the particulars appearing, at the time of the certification, in the basic application or basic registration, as the case may be. Furthermore, the said Office shall indicate,

- (i) in the case of a basic application, the date and number of that application,
- (ii) in the case of a basic registration, the date and number of that registration as well as the date and number of the application from which the basic registration resulted.

The Office of origin shall also indicate the date of the international application.

(2) The applicant must indicate the goods and services in respect of which protection of the mark is claimed and also, if possible, the corresponding class or classes according to the classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks. If the applicant does not give such indication, the International Bureau shall classify the goods and services in the appropriate classes of the said classification. The indication of classes given by the applicant shall be subject to control by the International Bureau, which shall exercise the said control in association with the Office of origin. In the event of disagreement between the said Office and the International Bureau, the opinion of the latter shall prevail.

(3) If the applicant claims color as a distinctive feature of his mark, he shall be required

- (i) to state the fact, and to file with his international application a notice specifying the color or the combination of colors claimed;
- (ii) to append to his international application copies in color of the said mark, which shall be attached to the notifications given by the International Bureau; the number of such copies shall be fixed by the Regulations.

## Article 4

### Effects of International Registration

(1)(a) From the date of the registration or recordal effected in accordance with the provisions of Articles 3 and 3*ter*, the protection of the mark in each of the Contracting Parties concerned shall be the same as if the mark had been deposited direct with the Office of that Contracting Party. If no refusal has been notified to the International Bureau in accordance with Article 5(1) and (2) or if a refusal notified in accordance with the said Article has been withdrawn subsequently, the protection of the mark in the Contracting Party concerned shall, as from the said date, be the same as if the mark had been registered by the Office of that Contracting Party.

(b) The indication of classes of goods and services provided for in Article 3 shall not bind the Contracting Parties with regard to the determination of the scope of the protection of the mark.

(2) Every international registration shall enjoy the right of priority provided for by Article 4 of the Paris Convention for the Protection of Industrial Property, without it being necessary to comply with the formalities prescribed in Section D of that Article.

## Article 4*bis*

### Replacement of a National or Regional Registration by an International Registration

(1) Where a mark that is the subject of a national or regional registration in the Office of a Contracting Party is also the subject of an international registration and both registrations stand in the name of the same person, the international registration is deemed to replace the national or regional registration, without prejudice to any rights acquired by virtue of the latter, provided that

- (i) the protection resulting from the international registration extends to the said Contracting Party under Article 3*ter*(1) or (2),
- (ii) all the goods and services listed in the national or regional registration are also listed in the international registration in respect of the said Contracting Party,
- (iii) such extension takes effect after the date of the national or regional registration.

(2) The Office referred to in paragraph (1) shall, upon request, be required to take note in its register of the international registration.

## Article 5

### **Refusal and Invalidation of Effects of International Registration in Respect of Certain Contracting Parties**

(1) Where the applicable legislation so authorizes, any Office of a Contracting Party which has been notified by the International Bureau of an extension to that Contracting Party, under Article 3<sup>ter</sup>(1) or (2), of the protection resulting from the international registration shall have the right to declare in a notification of refusal that protection cannot be granted in the said Contracting Party to the mark which is the subject of such extension. Any such refusal can be based only on the grounds which would apply, under the Paris Convention for the Protection of Industrial Property, in the case of a mark deposited direct with the Office which notifies the refusal. However, protection may not be refused, even partially, by reason only that the applicable legislation would permit registration only in a limited number of classes or for a limited number of goods or services.

(2)(a) Any Office wishing to exercise such right shall notify its refusal to the International Bureau, together with a statement of all grounds, within the period prescribed by the law applicable to that Office and at the latest, subject to subparagraphs (b) and (c), before the expiry of one year from the date on which the notification of the extension referred to in paragraph (1) has been sent to that Office by the International Bureau.

(b) Notwithstanding subparagraph (a), any Contracting Party may declare that, for international registrations made under this Protocol, the time limit of one year referred to in subparagraph (a) is replaced by 18 months.

(c) Such declaration may also specify that, when a refusal of protection may result from an opposition to the granting of protection, such refusal may be notified by the Office of the said Contracting Party to the International Bureau after the expiry of the 18-month time limit. Such an Office may, with respect to any given international registration, notify a refusal of protection after the expiry of the 18-month time limit, but only if

- (i) it has, before the expiry of the 18-month time limit, informed the International Bureau of the possibility that oppositions may be filed after the expiry of the 18-month time limit, and
- (ii) the notification of the refusal based on an opposition is made within a time limit of one month from the expiry of the opposition period and, in any case, not later than seven months from the date on which the opposition period begins.

(d) Any declaration under subparagraphs (b) or (c) may be made in the instruments referred to in Article 14(2), and the effective date of the declaration shall be the same as the date of entry into force of this Protocol with respect to the State or intergovernmental organization having made the declaration. Any such declaration may also be made later, in which case the declaration shall have effect three months after its receipt by the Director General of the Organization (hereinafter referred to as "the Director General"), or at any later date indicated in the declaration, in respect of any international registration whose date is the same as or is later than the effective date of the declaration.

(e) Upon the expiry of a period of ten years from the entry into force of this Protocol, the Assembly shall examine the operation of the system established by subparagraphs (a) to (d). Thereafter, the provisions of the said subparagraphs may be modified by a unanimous decision of the Assembly.

(3) The International Bureau shall, without delay, transmit one of the copies of the notification of refusal to the holder of the international registration. The said holder shall have the same remedies as if the mark had been deposited by him direct with the Office which has notified its refusal. Where the International Bureau has received information under paragraph (2)(c)(i), it shall, without delay, transmit the said information to the holder of the international registration.

(4) The grounds for refusing a mark shall be communicated by the International Bureau to any interested party who may so request.

(5) Any Office which has not notified, with respect to a given international registration, any provisional or final refusal to the International Bureau in accordance with paragraphs (1) and (2) shall, with respect to that international registration, lose the benefit of the right provided for in paragraph (1).

(6) Invalidation, by the competent authorities of a Contracting Party, of the effects, in the territory of that Contracting Party, of an international registration may not be pronounced without the holder of such international registration having, in good time, been afforded the opportunity of defending his rights. Invalidation shall be notified to the International Bureau.

#### **Article 5bis**

##### **Documentary Evidence of Legitimacy of Use of Certain Elements of the Mark**

Documentary evidence of the legitimacy of the use of certain elements incorporated in a mark, such as armorial bearings, escutcheons, portraits, honorary distinctions, titles, trade names, names of persons other than the name of the applicant, or other like inscriptions, which might be required by the Offices of the Contracting Parties shall be exempt from any legalization as well as from any certification other than that of the Office of origin.

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Interpretative statement adopted by the Assembly of the Madrid Union:

“Article 5(2)(e) of the Protocol is understood as allowing the Assembly to keep under review the operation of the system established by subparagraphs (a) to (d), it being also understood that any modification of those provisions shall require a unanimous decision of the Assembly.”



**Article 5ter****Copies of Entries in International Register;  
Searches for Anticipations;  
Extracts from International Register**

(1) The International Bureau shall issue to any person applying therefor, upon the payment of a fee fixed by the Regulations, a copy of the entries in the International Register concerning a specific mark.

(2) The International Bureau may also, upon payment, undertake searches for anticipations among marks that are the subject of international registrations.

(3) Extracts from the International Register requested with a view to their production in one of the Contracting Parties shall be exempt from any legalization.

**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.

## **Article 7**

### **Renewal of International Registration**

(1) Any international registration may be renewed for a period of ten years from the expiry of the preceding period, by the mere payment of the basic fee and, subject to Article 8(7), of the supplementary and complementary fees provided for in Article 8(2).

(2) Renewal may not bring about any change in the international registration in its latest form.

(3) Six months before the expiry of the term of protection, the International Bureau shall, by sending an unofficial notice, remind the holder of the international registration and his representative, if any, of the exact date of expiry.

(4) Subject to the payment of a surcharge fixed by the Regulations, a period of grace of six months shall be allowed for renewal of the international registration.

## **Article 8**

### **Fees for International Application and Registration**

(1) The Office of origin may fix, at its own discretion, and collect, for its own benefit, a fee which it may require from the applicant for international registration or from the holder of the international registration in connection with the filing of the international application or the renewal of the international registration.

(2) Registration of a mark at the International Bureau shall be subject to the advance payment of an international fee which shall, subject to the provisions of paragraph (7)(a), include,

- (i) a basic fee;
- (ii) a supplementary fee for each class of the International Classification, beyond three, into which the goods or services to which the mark is applied will fall;
- (iii) a complementary fee for any request for extension of protection under Article 3<sup>ter</sup>.

(3) However, the supplementary fee specified in paragraph (2)(ii) may, without prejudice to the date of the international registration, be paid within the period fixed by the Regulations if the number of classes of goods or services has been fixed or disputed by the International Bureau. If, upon expiry of the said period, the supplementary fee has not been paid or the list of goods or services has not been reduced to the required extent by the applicant, the international application shall be deemed to have been abandoned.

(4) The annual product of the various receipts from international registration, with the exception of the receipts derived from the fees mentioned in paragraph (2)(ii) and (iii), shall be divided equally among the Contracting Parties by the International Bureau, after deduction of the expenses and charges necessitated by the implementation of this Protocol.

(5) The amounts derived from the supplementary fees provided for in paragraph (2)(ii) shall be divided, at the expiry of each year, among the interested Contracting Parties in proportion to the number of marks for which protection has been applied for in each of them during that year, this number being multiplied, in the case of Contracting Parties which make an examination, by a coefficient which shall be determined by the Regulations.

(6) The amounts derived from the complementary fees provided for in paragraph (2)(iii) shall be divided according to the same rules as those provided for in paragraph (5).

(7)(a) Any Contracting Party may declare that, in connection with each international registration in which it is mentioned under Article 3<sup>ter</sup>, and in connection with the renewal of any such international registration, it wants to receive, instead of a share in the revenue produced by the supplementary and complementary fees, a fee (hereinafter referred to as "the individual fee") whose amount shall be indicated in the declaration, and can be changed in further declarations, but may not be higher than the equivalent of the amount which the said Contracting Party's Office would be entitled to receive from an applicant for a ten-year registration, or from the holder of a registration for a ten-year renewal of that registration, of the mark in the register of the said Office, the said amount being diminished by the savings resulting from the international procedure. Where such an individual fee is payable,

- (i) no supplementary fees referred to in paragraph (2)(ii) shall be payable if only Contracting Parties which have made a declaration under this subparagraph are mentioned under Article 3<sup>ter</sup>, and

- (ii) no complementary fee referred to in paragraph (2)(iii) shall be payable in respect of any Contracting Party which has made a declaration under this subparagraph.

(b) Any declaration under subparagraph (a) may be made in the instruments referred to in Article 14(2), and the effective date of the declaration shall be the same as the date of entry into force of this Protocol with respect to the State or intergovernmental organization having made the declaration. Any such declaration may also be made later, in which case the declaration shall have effect three months after its receipt by the Director General, or at any later date indicated in the declaration, in respect of any international registration whose date is the same as or is later than the effective date of the declaration.

### **Article 9**

#### **Recordal of Change in the Ownership of an International Registration**

At the request of the person in whose name the international registration stands, or at the request of an interested Office made ex officio or at the request of an interested person, the International Bureau shall record in the International Register any change in the ownership of that registration, in respect of all or some of the Contracting Parties in whose territories the said registration has effect and in respect of all or some of the goods and services listed in the registration, provided that the new holder is a person who, under Article 2(1), is entitled to file international applications.

### **Article 9bis**

#### **Recordal of Certain Matters Concerning an International Registration**

The International Bureau shall record in the International Register

- (i) any change in the name or address of the holder of the international registration,
- (ii) the appointment of a representative of the holder of the international registration and any other relevant fact concerning such representative,
- (iii) any limitation, in respect of all or some of the Contracting Parties, of the goods and services listed in the international registration,
- (iv) any renunciation, cancellation or invalidation of the international registration in respect of all or some of the Contracting Parties,
- (v) any other relevant fact, identified in the Regulations, concerning the rights in a mark that is the subject of an international registration.

## **Article 9ter**

### **Fees for Certain Recordals**

Any recordal under Article 9 or under Article 9bis may be subject to the payment of a fee.

## **Article 9quater**

### **Common Office of Several Contracting States**

- (1) If several Contracting States agree to effect the unification of their domestic legislations on marks, they may notify the Director General
- (i) that a common Office shall be substituted for the national Office of each of them, and
  - (ii) that the whole of their respective territories shall be deemed to be a single State for the purposes of the application of all or part of the provisions preceding this Article as well as the provisions of Articles 9quinquies and 9sexies.
- (2) Such notification shall not take effect until three months after the date of the communication thereof by the Director General to the other Contracting Parties.

## **Article 9quinquies**

### **Transformation of an International Registration into National or Regional Applications**

Where, in the event that the international registration is cancelled at the request of the Office of origin under Article 6(4), in respect of all or some of the goods and services listed in the said registration, the person who was the holder of the international registration files an application for the registration of the same mark with the Office of any of the Contracting Parties in the territory of which the international registration had effect, that application shall be treated as if it had been filed on the date of the international registration according to Article 3(4) or on the date of recordal of the territorial extension according to Article 3ter(2) and, if the international registration enjoyed priority, shall enjoy the same priority, provided that

- (i) such application is filed within three months from the date on which the international registration was cancelled,

- (ii) the goods and services listed in the application are in fact covered by the list of goods and services contained in the international registration in respect of the Contracting Party concerned, and
- (iii) such application complies with all the requirements of the applicable law, including the requirements concerning fees.

### **Article 9sexies**

#### **Safeguard of the Madrid (Stockholm) Agreement**

(1) Where, with regard to a given international application or a given international registration, the Office of origin is the Office of a State that is party to both this Protocol and the Madrid (Stockholm) Agreement, the provisions of this Protocol shall have no effect in the territory of any other State that is also party to both this Protocol and the Madrid (Stockholm) Agreement.

(2) The Assembly may, by a three-fourths majority, repeal paragraph (1), or restrict the scope of paragraph (1), after the expiry of a period of ten years from the entry into force of this Protocol, but not before the expiry of a period of five years from the date on which the majority of the countries party to the Madrid (Stockholm) Agreement have become party to this Protocol. In the vote of the Assembly only those States which are party to both the said Agreement and this Protocol shall have the right to participate.

### **Article 10**

#### **Assembly**

(1)(a) The Contracting Parties shall be members of the same Assembly as the countries party to the Madrid (Stockholm) Agreement.

(b) Each Contracting Party shall be represented in that Assembly by one delegate, who may be assisted by alternate delegates, advisors, and experts.

(c) The expenses of each delegation shall be borne by the Contracting Party which has appointed it, except for the travel expenses and the subsistence allowance of one delegate for each Contracting Party, which shall be paid from the funds of the Union.

(2) The Assembly shall, in addition to the functions which it has under the Madrid (Stockholm) Agreement, also

- (i) deal with all matters concerning the implementation of this Protocol;
- (ii) give directions to the International Bureau concerning the preparation for conferences of revision of this Protocol, due account being taken of any comments made by those countries of the Union which are not party to this Protocol;

- (iii) adopt and modify the provisions of the Regulations concerning the implementation of this Protocol;
- (iv) perform such other functions as are appropriate under this Protocol.

(3)(a) Each Contracting Party shall have one vote in the Assembly. On matters concerning only countries that are party to the Madrid (Stockholm) Agreement, Contracting Parties that are not party to the said Agreement shall not have the right to vote, whereas, on matters concerning only Contracting Parties, only the latter shall have the right to vote.

(b) One-half of the members of the Assembly which have the right to vote on a given matter shall constitute the quorum for the purposes of the vote on that matter.

(c) Notwithstanding the provisions of subparagraph (b), if, in any session, the number of the members of the Assembly having the right to vote on a given matter which are represented is less than one-half but equal to or more than one-third of the members of the Assembly having the right to vote on that matter, the Assembly may make decisions but, with the exception of decisions concerning its own procedure, all such decisions shall take effect only if the conditions set forth hereinafter are fulfilled. The International Bureau shall communicate the said decisions to the members of the Assembly having the right to vote on the said matter which were not represented and shall invite them to express in writing their vote or abstention within a period of three months from the date of the communication. If, at the expiry of this period, the number of such members having thus expressed their vote or abstention attains the number of the members which was lacking for attaining the quorum in the session itself, such decisions shall take effect provided that at the same time the required majority still obtains.

(d) Subject to the provisions of Articles 5(2)(e), 9*sexies*(2), 12 and 13(2), the decisions of the Assembly shall require two-thirds of the votes cast.

(e) Abstentions shall not be considered as votes.

(f) A delegate may represent, and vote in the name of, one member of the Assembly only.

(4) In addition to meeting in ordinary sessions and extraordinary sessions as provided for by the Madrid (Stockholm) Agreement, the Assembly shall meet in extraordinary session upon convocation by the Director General, at the request of one-fourth of the members of the Assembly having the right to vote on the matters proposed to be included in the agenda of the session. The agenda of such an extraordinary session shall be prepared by the Director General.

## **Article 11**

### **International Bureau**

(1) International registration and related duties, as well as all other administrative tasks, under or concerning this Protocol, shall be performed by the International Bureau.

(2)(a) The International Bureau shall, in accordance with the directions of the Assembly, make the preparations for the conferences of revision of this Protocol.

(b) The International Bureau may consult with intergovernmental and international non-governmental organizations concerning preparations for such conferences of revision.

(c) The Director General and persons designated by him shall take part, without the right to vote, in the discussions at such conferences of revision.

(3) The International Bureau shall carry out any other tasks assigned to it in relation to this Protocol.

## **Article 12**

### **Finances**

As far as Contracting Parties are concerned, the finances of the Union shall be governed by the same provisions as those contained in Article 12 of the Madrid (Stockholm) Agreement, provided that any reference to Article 8 of the said Agreement shall be deemed to be a reference to Article 8 of this Protocol. Furthermore, for the purposes of Article 12(6)(b) of the said Agreement, Contracting Organizations shall, subject to a unanimous decision to the contrary by the Assembly, be considered to belong to contribution class I (one) under the Paris Convention for the Protection of Industrial Property.

## **Article 13**

### **Amendment of Certain Articles of the Protocol**

(1) Proposals for the amendment of Articles 10, 11, 12, and the present Article, may be initiated by any Contracting Party, or by the Director General. Such proposals shall be communicated by the Director General to the Contracting Parties at least six months in advance of their consideration by the Assembly.

(2) Amendments to the Articles referred to in paragraph (1) shall be adopted by the Assembly. Adoption shall require three-fourths of the votes cast, provided that any amendment to Article 10, and to the present paragraph, shall require four-fifths of the votes cast.



(3) Any amendment to the Articles referred to in paragraph (1) shall enter into force one month after written notifications of acceptance, effected in accordance with their respective constitutional processes, have been received by the Director General from three-fourths of those States and intergovernmental organizations which, at the time the amendment was adopted, were members of the Assembly and had the right to vote on the amendment. Any amendment to the said Articles thus accepted shall bind all the States and intergovernmental organizations which are Contracting Parties at the time the amendment enters into force, or which become Contracting Parties at a subsequent date.

## Article 14

### Becoming Party to the Protocol; Entry into Force

(1)(a) Any State that is a party to the Paris Convention for the Protection of Industrial Property may become party to this Protocol.

(b) Furthermore, any intergovernmental organization may also become party to this Protocol where the following conditions are fulfilled:

- (i) at least one of the member States of that organization is a party to the Paris Convention for the Protection of Industrial Property;
- (ii) that organization has a regional Office for the purposes of registering marks with effect in the territory of the organization, provided that such Office is not the subject of a notification under Article 9<sup>quater</sup>.

(2) Any State or organization referred to in paragraph (1) may sign this Protocol. Any such State or organization may, if it has signed this Protocol, deposit an instrument of ratification, acceptance or approval of this Protocol or, if it has not signed this Protocol, deposit an instrument of accession to this Protocol.

(3) The instruments referred to in paragraph (2) shall be deposited with the Director General.

(4)(a) This Protocol shall enter into force three months after four instruments of ratification, acceptance, approval or accession have been deposited, provided that at least one of those instruments has been deposited by a country party to the Madrid (Stockholm) Agreement and at least one other of those instruments has been deposited by a State not party to the Madrid (Stockholm) Agreement or by any of the organizations referred to in paragraph (1)(b).

(b) With respect to any other State or organization referred to in paragraph (1), this Protocol shall enter into force three months after the date on which its ratification, acceptance, approval or accession has been notified by the Director General.

(5) Any State or organization referred to in paragraph (1) may, when depositing its instrument of ratification, acceptance or approval of, or accession to, this Protocol, declare that the protection resulting from any international registration effected under this Protocol before the date of entry into force of this Protocol with respect to it cannot be extended to it.

## Article 15

### Denunciation

(1) This Protocol shall remain in force without limitation as to time.

(2) Any Contracting Party may denounce this Protocol by notification addressed to the Director General.

(3) Denunciation shall take effect one year after the day on which the Director General has received the notification.

(4) The right of denunciation provided for by this Article shall not be exercised by any Contracting Party before the expiry of five years from the date upon which this Protocol entered into force with respect to that Contracting Party.

(5)(a) Where a mark is the subject of an international registration having effect in the denouncing State or intergovernmental organization at the date on which the denunciation becomes effective, the holder of such registration may file an application for the registration of the same mark with the Office of the denouncing State or intergovernmental organization, which shall be treated as if it had been filed on the date of the international registration according to Article 3(4) or on the date of recordal of the territorial extension according to Article 3<sup>ter</sup>(2) and, if the international registration enjoyed priority, enjoy the same priority, provided that

- (i) such application is filed within two years from the date on which the denunciation became effective,
- (ii) the goods and services listed in the application are in fact covered by the list of goods and services contained in the international registration in respect of the denouncing State or intergovernmental organization, and
- (iii) such application complies with all the requirements of the applicable law, including the requirements concerning fees.

(b) The provisions of subparagraph (a) shall also apply in respect of any mark that is the subject of an international registration having effect in Contracting Parties other than the denouncing State or intergovernmental organization at the date on which denunciation becomes effective and whose holder, because of the denunciation, is no longer entitled to file international applications under Article 2(1).

## Article 16

### **Signature; Languages; Depositary Functions**

(1)(a) This Protocol shall be signed in a single copy in the English, French and Spanish languages, and shall be deposited with the Director General when it ceases to be open for signature at Madrid. The texts in the three languages shall be equally authentic.

(b) Official texts of this Protocol shall be established by the Director General, after consultation with the interested governments and organizations, in the Arabic, Chinese, German, Italian, Japanese, Portuguese and Russian languages, and in such other languages as the Assembly may designate.

(2) This Protocol shall remain open for signature at Madrid until December 31, 1989.

(3) The Director General shall transmit two copies, certified by the Government of Spain, of the signed texts of this Protocol to all States and intergovernmental organizations that may become party to this Protocol.

(4) The Director General shall register this Protocol with the Secretariat of the United Nations.

(5) The Director General shall notify all States and international organizations that may become or are party to this Protocol of signatures, deposits of instruments of ratification, acceptance, approval or accession, the entry into force of this Protocol and any amendment thereto, any notification of denunciation and any declaration provided for in this Protocol.

**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)

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## **Chapter 1 General Provisions**

### *Rule 1 Abbreviated Expressions*

For the purposes of these Regulations,

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

- (xxviii) “prescribed fee” means the applicable fee set out in the Schedule of Fees;
- (xxix) “Director General” means the Director General of the World Intellectual Property Organization;
- (xxx) “International Bureau” means the International Bureau of the World Intellectual Property Organization.
- (xxxi) “Administrative Instructions” means the Administrative Instructions referred to in Rule 41.

### *Rule Ibis*

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

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

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

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

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

### *Rule 2*

#### *Communication with the International Bureau*

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

### *Rule 3*

#### *Representation Before the International Bureau*

(1) [*Representative; Number of Representatives*] (a) The applicant or the holder may have a representative before the International Bureau.

(b) The applicant or the holder may have one representative only. Where the appointment indicates several representatives, only the one indicated first shall be considered to be a representative and be recorded as such.

(c) Where a partnership or firm composed of attorneys or patent or trademark agents has been indicated as representative to the International Bureau, it shall be regarded as one representative.



(2) *[Appointment of the Representative]* (a) The appointment of a representative may be made in the international application, or in a subsequent designation or a request under Rule 25.

(b) The appointment of a representative may also be made in a separate communication which may relate to one or more specified international applications or international registrations of the same applicant or holder. The said communication shall be presented to the International Bureau

(i) by the applicant, the holder or the appointed representative, or

(ii) by the Office of the Contracting Party of the holder.

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

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

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

(c) As long as the relevant requirements under paragraphs (1)(b) and (2) are not complied with, the International Bureau shall send all relevant communications to the applicant or holder himself.

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

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

(5) *[Effect of Appointment of a Representative]* (a) Except where these Regulations expressly provide otherwise, the signature of a representative recorded under paragraph (4)(a) shall replace the signature of the applicant or holder.

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

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

(6) *[Cancellation of Recording; Effective Date of Cancellation]* (a) Any recording under paragraph (4)(a) shall be cancelled where cancellation is requested in a communication signed by the applicant, holder or representative. The recording shall be cancelled *ex officio* by the International Bureau where a new representative is appointed or, in case a change in ownership has been recorded, where no representative is appointed by the new holder of the international registration.

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

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

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

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

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

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

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

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

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

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

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

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

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

*Rule 5*  
*Irregularities in Postal and Delivery Services*

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

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

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

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

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

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

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

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

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

*Rule 6*  
*Languages*

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

(2) *[Communications Other Than the International Application]* Any communication concerning an international application or an international registration shall, subject to Rule 17(2)(v) and (3), be

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

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

(iii) in the language of the international application where the communication is a notification addressed by the International Bureau to an Office, unless that Office has notified the International Bureau that all such notifications are to be in English, or are to be in French or are to be in Spanish; where the notification addressed by the International Bureau concerns the recording in the International Register of an international registration, the notification shall indicate the language in which the relevant international application was received by the International Bureau;

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

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

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

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

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

### *Rule 7*

#### *Notification of Certain Special Requirements*

(1) [Deleted]

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

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

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

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

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

## Chapter 2 International Applications

### Rule 8 *Several Applicants*

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

(2) *[Two or More Applicants Applying Exclusively Under the Protocol]* Two or more applicants may jointly file an international application governed exclusively by the Protocol if the basic application was jointly filed by them or the basic registration is jointly owned by them, and if each of them qualifies, in relation to the Contracting Party whose Office is the Office of origin, for filing an international application under Article 2(1) of the Protocol.

### Rule 9 *Requirements Concerning the International Application*

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

(2) *[Form and Signature]* (a) The international application shall be presented on the official form in one copy.

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

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

(4) *[Contents of the International Application]* (a) The international application shall contain or indicate

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

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

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

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

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

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

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

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

(viii) where the basic application or the basic registration relates to a three-dimensional mark, the indication "three-dimensional mark,"

(ix) where the basic application or the basic registration relates to a sound mark, the indication "sound mark,"

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

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

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

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

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

(xv) the designated Contracting Parties.

(b) The international application may also contain,

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

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

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

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

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

(5) *[Additional Contents of an International Application]* (a) An international application governed exclusively by the Agreement or by both the Agreement and the Protocol shall contain the number and date of the basic registration and shall indicate one of the following:

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

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

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

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

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

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

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

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

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

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

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

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

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

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



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

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

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

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

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

(ii) be included in the international application.

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

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

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

### *Rule 10*

#### *Fees Concerning the International Application*

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

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

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

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

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

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

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

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

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

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

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

(4) *[Irregularities to Be Remedied by the Office of Origin]* (a) If the International Bureau

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

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

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

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

(v) [Deleted]

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

### Rule 13

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

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

(2) *[Time Allowed to Remedy Irregularity]* (a) The Office of origin may make a proposal for remedying the irregularity within three months from the date of the notification referred to in paragraph (1).

(b) If no proposal acceptable to the International Bureau for remedying the irregularity is made within the period indicated in subparagraph (a), the International Bureau shall include in the international registration the term as appearing in the international application, provided that the Office of origin has specified the class in which such term should be classified; the international registration shall contain an indication to the effect that, in the opinion of the International Bureau, the specified term is too vague for the purposes of classification or is incomprehensible or is linguistically incorrect, as the case may be. Where no class has been specified by the Office of origin, the International Bureau shall delete the said term *ex officio* and shall notify the Office of origin accordingly and at the same time inform the applicant.

### Chapter 3 International Registrations

#### Rule 14

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

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

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

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

(ii) the date of the international registration,

(iii) the number of the international registration,

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

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

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

#### Rule 15

##### *Date of the International Registration*

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

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

(ii) the Contracting Parties which are designated,

(iii) a reproduction of the mark,

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

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

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

##### *Rule 16*

##### *Time Limit for Notifying Provisional Refusal Based on an Opposition*

(1) *[Information Relating to Possible Oppositions]* (a) Subject to Article 9*sexies*(1)(b) of the Protocol, where a declaration has been made by a Contracting Party pursuant to Article 5(2)(b) and (c), first sentence, of the Protocol, the Office of that Contracting Party shall, where it has become apparent with regard to a given international registration designating that Contracting Party that the opposition period will expire too late for any provisional refusal based on an opposition to be notified to the International Bureau within the 18-month time limit referred to in Article 5(2)(b), inform the International Bureau of the number, and the name of the holder, of that international registration.

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

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

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

##### *Rule 17*

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

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

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

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

- (i) the Office making the notification,
- (ii) the number of the international registration, preferably accompanied by other indications enabling the identity of the international registration to be confirmed, such as the verbal elements of the mark or the basic application or basic registration number,
- (iii) [Deleted]
- (iv) all the grounds on which the provisional refusal is based, together with a reference to the corresponding essential provisions of the law,
- (v) where the grounds on which the provisional refusal is based relate to a mark which has been the subject of an application or registration and with which the mark that is the subject of the international registration appears to be in conflict, the filing date and number, the priority date (if any), the registration date and number (if available), the name and address of the owner, and a reproduction, of the former mark, together with the list of all or the relevant goods and services in the application or registration of the former mark, it being understood that the said list may be in the language of the said application or registration,
- (vi) either that the grounds on which the provisional refusal is based affect all the goods and services or an indication of the goods and services which are affected, or are not affected, by the provisional refusal,
- (vii) the time limit, reasonable under the circumstances, for filing a request for review of, or appeal against, the *ex officio* provisional refusal or the provisional refusal based on an opposition and, as the case may be, for filing a response to the opposition, preferably with an indication of the date on which the said time limit expires, and the authority with which such request for review, appeal or response should be filed, with the indication, where applicable, that the request for review, the appeal or the response has to be filed through the intermediary of a representative whose address is within the territory of the Contracting Party whose Office has pronounced the refusal.

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

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

(5) *[Confirmation or Withdrawal of Provisional Refusal]* (a) An Office which has sent to the International Bureau a notification of provisional refusal shall, once all procedures before the said Office relating to the protection of the mark have been completed, send to the International Bureau a statement indicating either



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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

### *Rule 18*

#### *Irregular Notifications of Provisional Refusal*

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

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

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

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

(b) Where subparagraph (a) applies, the International Bureau shall nevertheless transmit a copy of the notification to the holder, shall inform, at the same time, the holder and the Office that sent the notification that the notification of provisional refusal is not regarded as such by the International Bureau, and shall indicate the reasons therefor.

(c) If the notification

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

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

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

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

(v) [Deleted]

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

<sup>3</sup> Interpretative statement endorsed by the Assembly of the Madrid Union:  
"The references in Rule 17(6)(a)(ii) and (iii) to observations by third parties apply only to those Contracting Parties whose legislation provides for such observations."

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

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

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

(2) [*Contracting Party Designated Under the Protocol*] (a) Paragraph (1) shall also apply in the case of a notification of provisional refusal communicated by the Office of a Contracting Party designated under the Protocol, it being understood that the time limit referred to in paragraph (1)(a)(iii) shall be the time limit applicable under Article 5(2)(a) or, subject to Article 9*sexies*(1)(b) of the Protocol, under Article 5(2)(b) or (c)(ii) of the Protocol.

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

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

### Rule 19

#### *Invalidations in Designated Contracting Parties*

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

- (i) the authority which pronounced the invalidation,
- (ii) the fact that the invalidation is no longer subject to appeal,
- (iii) the number of the international registration,
- (iv) the name of the holder,
- (v) if the invalidation does not concern all the goods and services, those in respect of which the invalidation has been pronounced or those in respect of which the invalidation has not been pronounced, and

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

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

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

#### *Rule 20*

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

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

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

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

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

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

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

#### *Rule 20bis*

#### *Licenses*

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

(b) The request shall indicate

(i) the number of the international registration concerned,

(ii) the name of the holder,

- (iii) the name and address of the licensee, given in accordance with the Administrative Instructions,
  - (iv) the designated Contracting Parties with respect to which the license is granted,
  - (v) that the license is granted for all the goods and services covered by the international registration, or the goods and services for which the license is granted, grouped in the appropriate classes of the International Classification of Goods and Services.
- (c) The request may also indicate
- (i) where the licensee is a natural person, the State of which the licensee is a national,
  - (ii) where the licensee is a legal entity, the legal nature of that entity and the State and, where applicable, the territorial unit within that State, under the law of which the said legal entity has been organized,
  - (iii) that the license concerns only a part of the territory of a specified designated Contracting Party,
  - (iv) where the licensee has a representative, the name and address of the representative, given in accordance with the Administrative Instructions,
  - (v) where the license is an exclusive license or a sole license, that fact,<sup>4</sup>
  - (vi) where applicable, the duration of the license.
- (d) The request shall be signed by the holder or by the Office through which it is presented.

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

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

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

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

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

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

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

(5) *[Declaration That the Recording of a Given License Has No Effect]* (a) The Office of a designated Contracting Party which is notified by the International Bureau of the recording of a license in respect of that Contracting Party may declare that such recording has no effect in the said Contracting Party.

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

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

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

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

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

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

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

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

(6) *[Declaration That the Recording of Licenses in the International Register Has No Effect in a Contracting Party]* (a) The Office of a Contracting Party the law of which does not provide for the recording of trademark licenses may notify the Director General that the recording of licenses in the International Register has no effect in that Contracting Party.

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

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

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

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

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

- (i) the number of the international registration concerned,
- (ii) where the replacement concerns only one or some of the goods and services listed in the international registration, those goods and services, and
- (iii) the filing date and number, the registration date and number, and, if any, the priority date of the national or regional registration which has been replaced by the international registration.

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

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

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

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

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

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

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

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

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

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

(1) *[Notification Relating to Ceasing of Effect of the Basic Application, of the Registration Resulting Therefrom, or of the Basic Registration]* (a) Where Article 6(3) and (4) of the Agreement or Article 6(3) and (4) of the Protocol, or both, apply, the Office of origin shall notify the International Bureau accordingly and shall indicate

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

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

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

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

(2) *[Recording and Transmittal of the Notification; Cancellation of the International Registration]* (a) The International Bureau shall record any notification referred to in paragraph (1) in the International Register and shall transmit a copy of the notification to the Offices of the designated Contracting Parties and to the holder.

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

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

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

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

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



**Rule 23*****Division or Merger of the Basic Applications,  
of the Registrations Resulting Therefrom,  
or of the Basic Registrations***

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

- (i) the number of the international registration or, if the international registration has not yet been effected, the number of the basic application,
- (ii) the name of the holder or applicant,
- (iii) the number of each application resulting from the division or the number of the application resulting from the merger.

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

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

**Chapter 5****Subsequent Designations; Changes****Rule 24*****Designation Subsequent to the International Registration***

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

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

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

(2) *[Presentation; Form and Signature]* (a) A subsequent designation shall be presented to the International Bureau by the holder or by the Office of the Contracting Party of the holder; however,

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

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

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

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

(3) *[Contents]* (a) Subject to paragraph (7)(b), the subsequent designation shall contain or indicate

(i) the number of the international registration concerned,

(ii) the name and address of the holder,

(iii) the Contracting Party that is designated,

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

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

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

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

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

(ii) be included in the subsequent designation.

(c) The subsequent designation may also contain

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

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

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

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

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

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

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

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

(6) *[Date of Subsequent Designation]* (a) A subsequent designation presented by the holder direct to the International Bureau shall, subject to subparagraph (c)(i), bear the date of its receipt by the International Bureau.

(b) A subsequent designation presented to the International Bureau by an Office shall, subject to subparagraph (c)(i), (d) and (e), bear the date on which it was received by that Office, provided that the said designation has been received by the International Bureau within a period of two months from that date. If the subsequent designation has not been received by the International Bureau within that period, it shall, subject to subparagraph (c)(i), (d) and (e), bear the date of its receipt by the International Bureau.

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

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

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

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

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

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

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

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

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

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

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

#### Rule 25

#### *Request for Recording of a Change; Request for Recording of a Cancellation*

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

- (i) a change in the ownership of the international registration in respect of all or some of the goods and services and all or some of the designated Contracting Parties;
- (ii) a limitation of the list of goods and services in respect of all or some of the designated Contracting Parties;
- (iii) a renunciation in respect of some of the designated Contracting Parties for all the goods and services;
- (iv) a change in the name or address of the holder;
- (v) cancellation of the international registration in respect of all the designated Contracting Parties for all or some of the goods and services.

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

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

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

(2) [*Contents of the Request*] (a) The request for the recording of a change or the request for the recording of a cancellation shall, in addition to the requested change or cancellation, contain or indicate

(i) the number of the international registration concerned,  
(ii) the name of the holder, unless the change relates to the name or address of the representative,

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

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

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

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

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

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

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

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

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

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

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

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

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

#### *Rule 26*

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

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

(2) *[Time Allowed to Remedy Irregularity]* The irregularity may be remedied within three months from the date of the notification of the irregularity by the International Bureau. If the irregularity is not remedied within three months from the date of the notification of the irregularity by the International Bureau, the request shall be considered abandoned, and the International Bureau shall notify accordingly and at the same time the holder and, if the request for the recording of a change or the request for the recording of a cancellation was presented by an Office, that Office, and refund any fees paid, after deduction of an amount corresponding to one-half of the relevant fees referred to in item 7 of the Schedule of Fees, to the party having paid those fees.

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

#### *Rule 27*

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

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

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

(2) [Deleted]

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

(4) *[Declaration That a Change in Ownership Has No Effect]* (a) The Office of a designated Contracting Party which is notified, by the International Bureau, of a change in ownership affecting that Contracting Party may declare that the change in ownership has no effect in the said Contracting Party. The effect of such a declaration shall be that, with respect to the said Contracting Party, the international registration concerned shall remain in the name of the transferor.

- (b) The declaration referred to in subparagraph (a) shall indicate
- (i) the reasons for which the change in ownership has no effect,
  - (ii) the corresponding essential provisions of the law, and
  - (iii) whether such declaration may be subject to review or appeal.

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

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

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

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

- (b) The declaration referred to in subparagraph (a) shall indicate
- (i) the reasons for which the limitation has no effect,
  - (ii) where the declaration does not affect all the goods and services to which the limitation relates, those which are affected by the declaration or those which are not affected by the declaration,
  - (iii) the corresponding essential provisions of the law, and
  - (iv) whether such declaration may be subject to review or appeal.

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

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

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

### *Rule 28*

#### *Corrections in the International Register*

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

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

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

(4) *[Time Limit for Correction]* Notwithstanding paragraph (1), an error which is attributable to an Office and the correction of which would affect the rights deriving from the international registration may be corrected only if a request for correction is received by the International Bureau within nine months from the date of publication of the entry in the International Register which is the subject of the correction.

## **Chapter 6 Renewals**

### *Rule 29*

#### *Unofficial Notice of Expiry*

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



*Rule 30*  
*Details Concerning Renewal*

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

(i) the basic fee,

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

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

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

(2) *[Further Details]* (a) Where the holder does not wish to renew the international registration in respect of a designated Contracting Party for which no refusal is recorded in the International Register in respect of all the goods and services concerned, payment of the required fees shall be accompanied by a statement that the renewal of the international registration is not to be recorded in the International Register in respect of that Contracting Party.

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

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

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

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

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

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

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

### *Rule 31*

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

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

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

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

(4) *[Notification in Case of Non-Renewal]* (a) Where an international registration is not renewed, the International Bureau shall notify accordingly the Offices of all of the Contracting Parties designated in that international registration.

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

## **Chapter 7**

### **Gazette and Data Base**

#### *Rule 32*

##### *Gazette*

(1) *[Information Concerning International Registrations]* (a) The International Bureau shall publish in the Gazette relevant data concerning

(i) international registrations effected under Rule 14;

- (ii) information communicated under Rule 16(1);
  - (iii) provisional refusals recorded under Rule 17(4), with an indication as to whether the refusal relates to all the goods and services or only some of them but without an indication of the goods and services concerned and without the grounds for refusal, and statements and information recorded under Rule 17(5)(c) and (6)(b);
  - (iv) renewals recorded under Rule 31(1);
  - (v) subsequent designations recorded under Rule 24(8);
  - (vi) continuation of effects of international registrations under Rule 39;
  - (vii) changes in ownership, limitations, renunciations and changes of name or address of the holder recorded under Rule 27;
  - (viii) cancellations effected under Rule 22(2) or recorded under Rule 27(1) or Rule 34(3)(d);
  - (ix) corrections effected under Rule 28;
  - (x) invalidations recorded under Rule 19(2);
  - (xi) information recorded under Rules 20, 20bis, 21, 21bis, 22(2)(a), 23, 27(3) and (4) and 40(3);
  - (xii) international registrations which have not been renewed.
- (b) The reproduction of the mark shall be published as it appears in the international application. Where the applicant has made the declaration referred to in Rule 9(4)(a)(vi), the publication shall indicate that fact.
- (c) Where a color reproduction of the mark is furnished under Rule 9(4)(a)(v) or (vii), the Gazette shall contain both a reproduction of the mark in black and white and the reproduction in color.

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

- (i) any notification made under Rule 7 or Rule 20bis(6) and any declaration made under Rule 17(5)(d) or (e);
- (ii) any declarations made under Article 5(2)(b) or Article 5(2)(b) and (c), first sentence, of the Protocol;
- (iii) any declarations made under Article 8(7) of the Protocol;
- (iv) any notification made under Rule 34(2)(b) or (3)(a);
- (v) a list of the days on which the International Bureau is not scheduled to be open to the public during the current and the following calendar year.

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

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

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

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

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

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

**Chapter 8**  
**Fees**

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

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

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

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

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

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

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

(i) the number of the international registration concerned,  
 (ii) the name of the holder,  
 (iii) the date by which the second part of the individual fee must be paid,  
 (iv) where the amount of the second part of the individual fee is dependent on the number of classes of goods and services for which the mark is protected in the designated Contracting Party concerned, the number of such classes.

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

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

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

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

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

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

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

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

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

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

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

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

### *Rule 35*

#### *Currency of Payments*

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

(2) [*Establishment of the Amount of Individual Fees in Swiss Currency*] (a) Where a Contracting Party makes a declaration under Article 8(7)(a) of the Protocol that it wants to receive an individual fee, the amount of the individual fee indicated to the International Bureau shall be expressed in the currency used by its Office.

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

(c) Where, for more than three consecutive months, the official exchange rate of the United Nations between the Swiss currency and the other currency in which the amount of an individual fee has been indicated by a Contracting Party is higher or lower by at least 5% than the last exchange rate applied to establish the amount of the individual fee in Swiss currency, the Office of that Contracting Party may ask the Director General to establish a new amount of the individual fee in Swiss currency according to the official exchange rate of the United Nations prevailing on the day preceding the day on which the request is made. The Director General shall proceed accordingly. The new amount shall be applicable as from a date which shall be fixed by the Director General, provided that such date is between one and two months after the date of the publication of the said amount in the Gazette.

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

### *Rule 36*

#### *Exemption From Fees*

Recording of the following shall be exempt from fees:

(i) the appointment of a representative, any change concerning a representative and the cancellation of the recording of a representative,

- (ii) any change concerning the telephone and telefacsimile numbers of the holder,
- (iii) the cancellation of the international registration,
- (iv) any renunciation under Rule 25(1)(a)(iii),
- (v) any limitation effected in the international application itself under Rule 9(4)(a)(xiii) or in a subsequent designation under Rule 24(3)(a)(iv),
- (vi) any request by an Office under Article 6(4), first sentence, of the Agreement or Article 6(4), first sentence, of the Protocol,
- (vii) the existence of a judicial proceeding or of a final decision affecting the basic application, or the registration resulting therefrom, or the basic registration,
- (viii) any refusal under Rule 17, Rule 24(9) or Rule 28(3), any statement under Rule 17(5) or (6) or any declaration under Rule 20*bis*(5) or Rule 27(4) or (5),
- (ix) the invalidation of the international registration,
- (x) information communicated under Rule 20,
- (xi) any notification under Rule 21 or Rule 23,
- (xii) any correction in the International Register.

#### *Rule 37*

#### *Distribution of Supplementary Fees and Complementary Fees*

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

for Contracting Parties which examine only for  
absolute grounds of refusal ..... two

for Contracting Parties which also examine for prior rights:

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

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

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

#### *Rule 38*

#### *Crediting of Individual Fees to the Accounts of the Contracting Parties Concerned*

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

## Chapter 9 Miscellaneous

### Rule 39

#### *Continuation of Effects of International Registrations in Certain Successor States*

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

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

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

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

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

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

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

### Rule 40

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

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



## (2) [General Transitional Provisions] (a) Notwithstanding paragraph (1),

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

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

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

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

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

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

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

(3) [Transitional Provisions Applicable to International Registrations for Which Fees Have Been Paid for 20 Years] (a) Where an international registration for which the required fees had been paid for 20 years is the subject of a subsequent designation under Rule 24 and where the current term of protection of that international registration expires more than ten years after the effective date of the subsequent designation as determined in accordance with Rule 24(6), the provisions of subparagraphs (b) and (c) shall apply.

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

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

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

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

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

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

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

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

(b) For the purposes of this paragraph, an international application is deemed to be filed on the date on which the request to present the international application to the International Bureau is received, or deemed to have been received under Rule 11(1)(a) or (c), by the Office of origin, and an international registration is deemed to be the subject of a subsequent designation on the date on which the subsequent designation is presented to the International Bureau, if it is presented directly by the holder, or on the date on which the request for presentation of the subsequent designation is filed with the Office of the Contracting Party of the holder if it is presented through the latter.

#### *Rule 41*

#### *Administrative Instructions*

(1) *[Establishment of Administrative Instructions; Matters Governed by Them]* (a) The Director General shall establish Administrative Instructions. The Director General may modify them. Before establishing or modifying the Administrative Instructions, the Director General shall consult the Offices which have a direct interest in the proposed Administrative Instructions or their proposed modification.

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

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

(3) *[Publication and Effective Date]* (a) The Administrative Instructions and any modification thereof shall be published in the Gazette.

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

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