WIPO: Divisions and Mergers of IRS Allowed

Effective February 1, 2019, the new Rule 27*bis* of the Common Regulations under the Madrid Agreement and Protocol allows holders of International Registrations (IRs) to request the division of an IR within a designated jurisdiction. For example, some goods/services may remain in the existing IR,More

Effective February 1, 2019, the new Rule 27*bis* of the Common Regulations under the Madrid Agreement and Protocol allows holders of International Registrations (IRs) to request the division of an IR within a designated jurisdiction. For example, some goods/services may remain in the existing IR, whereas others may be divided into a divisional IR. This provision may be useful where, for example, a particular designated country refuses an IR for only some of the goods/services claimed in the IR. The refused items may now remain in the IR for further handling, while the allowed items may be divided and allowed to proceed toward protection.

Such requests are to be filed with the relevant jurisdiction's local trademark office rather than with WIPO. Form MM22 is available for making division requests, and a fee of 177 Swiss francs must be paid to the International Bureau of WIPO. Local offices may also charge additional fees, and they may examine division requests for compliance with local law. WIPO will also examine such requests for compliance with Rule 27*bis* and will notify any irregularity to the relevant trademark office; the local office then has three months from the date of notification to remedy the irregularity.

If approved, the division will be recorded with the date on which WIPO received the request or on the date the irregularity was remedied, as applicable. Following recordal, WIPO will create a divisional IR for the goods/services specified in the division request, and the relevant jurisdiction will be the sole designated party of that divisional IR.

Also effective February 1, 2019 is new Rule 27ter, which deals with the merger of IRs resulting from the recording of a partial ownership change, whereby part of the IR (i.e., only some goods/services, or only some extension countries) had previously been assigned to a different entity. Merger of multiple IRs will be allowed, so long as they are all held by the same owner. Form MM23 is available for this purpose and may be submitted either to WIPO or through the local trademark office of the IR holder. There is no fee payable to WIPO. This new rule also provides that in the case of division (i.e., along the lines of goods/services), an IR may be merged with the IR from which it was divided. Form MM24 is available for this purpose and must be presented through the local trademark office that presented the request for division. The main benefit of a merger is that it allows for the consolidated tracking and handling of multiple IRs, thus bringing them together under a single unitary record.

Divisions under Rule 27*bis* and mergers under Rule 27*ter* will be published in the WIPO Gazette.

Primary Contacts

Robin N. Baydurcan