

# WIPO



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**WORLD INTELLECTUAL PROPERTY ORGANIZATION**  
GENEVA

**WORKING GROUP ON THE MODIFICATION OF THE COMMON  
REGULATIONS UNDER THE MADRID AGREEMENT  
CONCERNING THE INTERNATIONAL REGISTRATION OF  
MARKS AND THE PROTOCOL RELATING TO THAT  
AGREEMENT**

**Second Session**  
**Geneva, June 11 – 15, 2001**

PROPOSALS FOR THE MODIFICATION OF THE COMMON REGULATIONS UNDER  
THE MADRID AGREEMENT AND PROTOCOL

(1) PROPOSALS APPROVED IN THE FIRST SESSION OF THE WORKING GROUP

*Document prepared by the International Bureau*

## INTRODUCTION

1. The present document contains those provisions of the Common Regulations under the Madrid Agreement and Protocol on whose amendment there was agreement in the first session (October 9 to 13, 2000) of the Working Group.

2. In particular:

(a) Rule 1 is amended by the inclusion of definitions of “Contracting Party whose designation is governed by the Agreement”, “Contracting Party whose designation is governed by the Protocol”, “Contracting Party of the holder”, and “Administrative Instructions”;

(b) Rule 9 is rearranged and simplified;

(c) Rule 15 is simplified and the number of elements whose omission from an international application would affect the date of the resultant international registration is reduced;

(d) Rules 24 and 25 are simplified as a result of the introduction of the definitions referred to above; further consequential amendments are made in other rules;

(e) provision is made for Administrative Instructions and the details presently contained in Rule 2, Rule 27(2) and Rule 32(3) and (4) are transferred to those Instructions.

3. For further explanation concerning these amendments, see the proposals submitted to the first session (document MM/WG/1/3), the notes on those proposals (document MM/WG/1/2) and the report on that session (document MM/WG/1/5).

*Rule 1*  
*Abbreviated Expressions*

For the purposes of these Regulations,

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(xvii**ibis**) “Contracting Party whose designation is governed by the Agreement” means a Contracting Party designated under the Agreement or, where a change of ownership has been recorded and the Contracting Party of the holder is bound by the Agreement, a designated Contracting Party which is also bound by the Agreement;

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(xviii**ibis**) “Contracting Party whose designation is governed by the Protocol” means a Contracting Party designated under the Protocol or, where a change of ownership has been recorded and the Contracting Party of the holder is bound by the Protocol, a designated Contracting Party which is also bound by the Protocol, provided that the said Contracting Parties are not both bound by the Agreement;

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(xxvii**ibis**) “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, the Contracting Party, or one of the Contracting Parties, in respect of which the holder fulfils 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;

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(xxx**i**) “Administrative Instructions” means the Administrative Instructions referred to in Rule 41.<sup>1</sup>

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<sup>1</sup> Draft Administrative Instructions are given in document MM/WG/2/5.

*Rule 2*

*Communication with the International Bureau*

Communications addressed to the International Bureau shall be effected as specified in the Administrative Instructions.<sup>2</sup>

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<sup>2</sup> It was agreed in the first session that the details currently specified in Rule 2 could be transferred to the Administrative Instructions. The new wording for Rule 2 follows the corresponding rule under the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs.

*Rule 3*

*Representation Before the International Bureau*

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(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 if such subsequent designation or request is made through an Office.

(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.

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

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(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,<sup>3</sup>

(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 priority claim relates to less than all the goods and services listed in the international application, the indication of those goods and services to which the priority claim relates,<sup>4</sup>

(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,<sup>5</sup>

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

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<sup>3</sup> Rule 25(2)(a)(iii) will also be amended to refer to the Administrative Instructions.

<sup>4</sup> A proposal for modification of this item is made in document MM/WG/2/3.

<sup>5</sup> A proposal for an additional item (concerning marks that consist of color as such) is made in document MM/WG/2/3.

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

(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.<sup>6</sup>

(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 that Contracting State, that he has a domicile in the territory of that State, or

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

(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.

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<sup>6</sup> A proposal for an additional item (concerning disclaimers) is made in document MM/WG/2/3.



(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)(viii) 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.

*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.

*Rule 19*

*Invalidations in Designated Contracting Parties*

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(2) *[Recordal of the Invalidation and Information to the Holder and the Office Concerned]* 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.

*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) *[Recordal 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.

*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 is entitled, under Article 1(2) and 2 of the Agreement or Article 2 of the Protocol to file international applications.

(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 also bound by the Agreement.

(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 also bound by the Protocol, provided that the said Contracting Parties are not both 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 [date],]<sup>7</sup> 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.

(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]*

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(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.

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<sup>7</sup> The words in square brackets will be included if paragraph (1) of Rule 7 is deleted (see documents MM/WG/2/3 and 4).

(5) *[Irregularities]*

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(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. If the requirements of paragraph (1)(b) or (c) are not complied with in respect of all the designated Contracting Parties, subparagraph (b) shall apply.

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*Rule 25*

*Request for Recordal of a Change;  
Request for Recordal of a Cancellation*

(1) [*Presentation of the Request*] (a) A request for recordal 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 recordal of a change in ownership may be presented through the Office of the Contracting Party, or one of the Contracting Parties, indicated in the said request in accordance with paragraph (2)(a)(iv).

(c)<sup>8</sup>

(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 recordal of a change or the request for the recordal 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,

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<sup>8</sup> For the proposal relating to subparagraph (c), see document MM/WG/2/3.

(iii) in the case of a change in the ownership of the international registration, the name and address, indicated in accordance with Rule 9(4)(a)(i) and (ii), 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 subparagraph (a)(iii) is not in the territory of the Contracting Party, or of one of the Contracting Parties, given in accordance with subparagraph (a)(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.

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*Rule 27**Recordal and Notification of a Change or of a Cancellation; Merger of International Registrations; Declaration That a Change or a Cancellation Has No Effect*

(1) *[Recordal 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 recordal 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 recordal 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]*<sup>9</sup>

(3) *[Recordal 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 under paragraph (2), 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.<sup>10</sup> 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.

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<sup>9</sup> This provision has been transferred to the Administrative Instructions (see document MM/WG/2/5), as agreed in the first session.

<sup>10</sup> The second sentence of this provision has been transferred to the Administrative Instructions, as agreed in the first session.

(1) [*Information Concerning International Registrations*] (a) The International Bureau shall publish in the Gazette relevant data concerning

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(xi) information recorded under Rules 20, 21, 22(2)(a), 23, 27(3) and (4) and 40(3);

(xii) international registrations which have not been renewed.

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<sup>11</sup> Further proposals concerning the amendment of Rule 32 are made in document MM/WG/2/3.

*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.

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*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.

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