



WIPO | MADRID

The International
Trademark System

Legal Updates of 2022 and feedback from the Working Group

Madrid System Webinar

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Geneva
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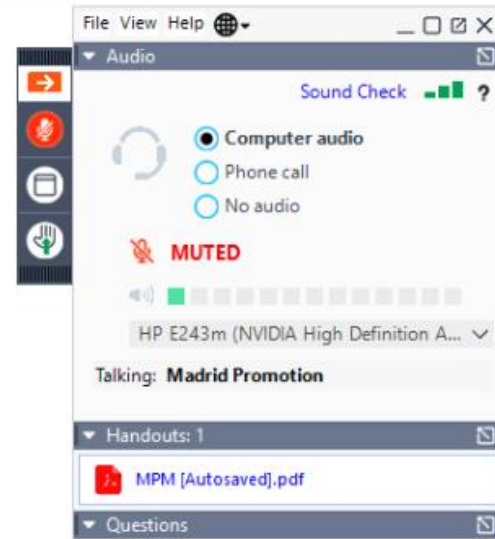


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How to use GoToWebinar



Program

- In force as from November 1, 2021
- In force as from November 1, 2022
- In force as from February 1, 2023
- Geographical expansion and Working Group discussions

In force as from
November 1, 2021

Question

- Can I appoint a representative when I submit a subsequent designation or a change in the address of the holder?
- Yes
- No

Appointment of a representative

- Amendments to Rules 3.2) and 4) of the Regulations
- Holder can no longer appoint a representative in a request for the recording of a change
- Amendments to forms MM4, 6, 7, 8, 9 and 16
- Holder must appoint a representative in a separate communication (form MM12 or online form)

“Resignation” of the representative

- Amendment to Rule 3.6) of the Regulations
- Copies of communications exchanged with the representative who has “resigned” no longer sent to the holder
- Holder or new representative may download those communications using the Madrid Portfolio Manager (MPM)

Excuse for missing time limits

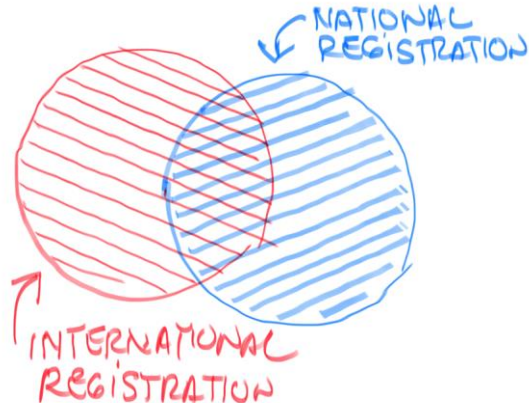
- Amendment to Rule 5 of the Regulations
- Before : due to failure in postal, delivery or electronic communication services owed to *force majeure* reasons
- Now : due to *force majeure* reasons
- All other requirements continue to apply:
 - must be invoked
 - within six months from the expiry
 - sufficient evidence required

Continued processing

- Amendment to Rule *5bis* of the Regulation
- It applies to the time limit specified in
 - Rule 12(7) of the Regulations to pay the fees following a reclassification proposal made by WIPO
 - Rule *27bis*(3)(c) to remedy irregularities in a request for the division of the international registration

“Partial” replacement

- Amendment to Rule 21(3)(d) of the Regulations
- International registration is deemed to replace an earlier national registration, for the same mark and in the name of the same person, to the “applicable extent”



Subsequent designation

- Amendment to Rule 23(3)(a)(iii) of the Regulations
- Address of the holder no longer required in a request for the recording of a subsequent designation
- Amendment to form MM4

Editorial amendments

- Ceasing of effects : amendment to Rule 22(1)(c)
- Continuation of effects : amendment to Rule 39(1)(ii) and new item 10 of the Schedule of Fees



In force as from
November 1, 2022

Question

■ Is it compulsory to use a form to appoint a representative?

■ Yes

■ No

Appointment of a representative

- Amendment to Rule 3(2)(b) of the Regulations
- Holder must use form MM12 or the online form to request the recording of the appointment of a representative
- Appointment will not be recorded if the holder fails to use the form

Renewal

- Amendment to Rule 30(1)(b) of the Regulations
- Renewal will be possible as early as six months before the due date to coincide with the renewal reminder

Editorial amendment

Amendment to Rule 5(5) of the Regulations to eliminate references to paragraphs (2) and (3), which have been deleted

In force as from
February 1, 2023

New means of representation

- Amendment to Rule 9(4)(a)(v) and consequential amendments to Rules 15(1)(ii), 17(2)(v) and 32(1)(b) of the Regulations, as well as to Item 2(1) of the Schedule of Fees
- One representation of the mark, in accordance with the administrative instructions

Representation of the mark (1)

- New Section 11bis of the Administrative Instructions
- Visual representation in the international application no bigger than 20cm by 20cm (about 7.8in by 7.8in)

Representation of the mark (1)

Alternatively, with the international application as a single digital file and, when the representation consists of a

- visual representation, in JPEG, PNG or TIFF format (ST.67)
- sound recording, in MP3 or WAV format (ST.68)
- motion or multimedia recording, in MP4 format (ST.69)

Only one representation of the mark

- Amendment to Rules 9(4)(a)(v) and (5)(d)(v) and 32(1)(c) of the Regulations
- In black and white or color, as the case may be

Electronic communication

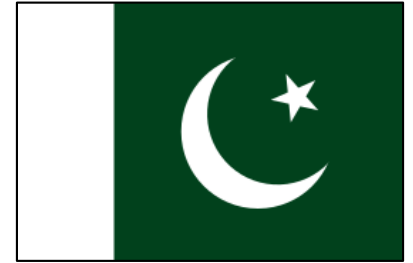
- Amendment to Sections 6(b), 11, 14 and 15(b) of the Administrative Instructions
- Applicants, holders and their representatives must exchange communications with WIPO by electronic means

New members and Working Group discussions

Question

- Which are the last 3 members to join the Madrid System?
 - Chile, Jamaica and United Arab Emirates
 - Pakistan, Jamaica and United Arab Emirates
 - Pakistan, Saudi Arabia and United Emirates

Pakistan



- Entered into force on May 24, 2021
- Declarations and notifications
 - 18-month refusal period or more in case of opposition
 - individual fee
 - recording of licenses has no effect in Pakistan
 - does not accept requests for merger following division

United Arab Emirates



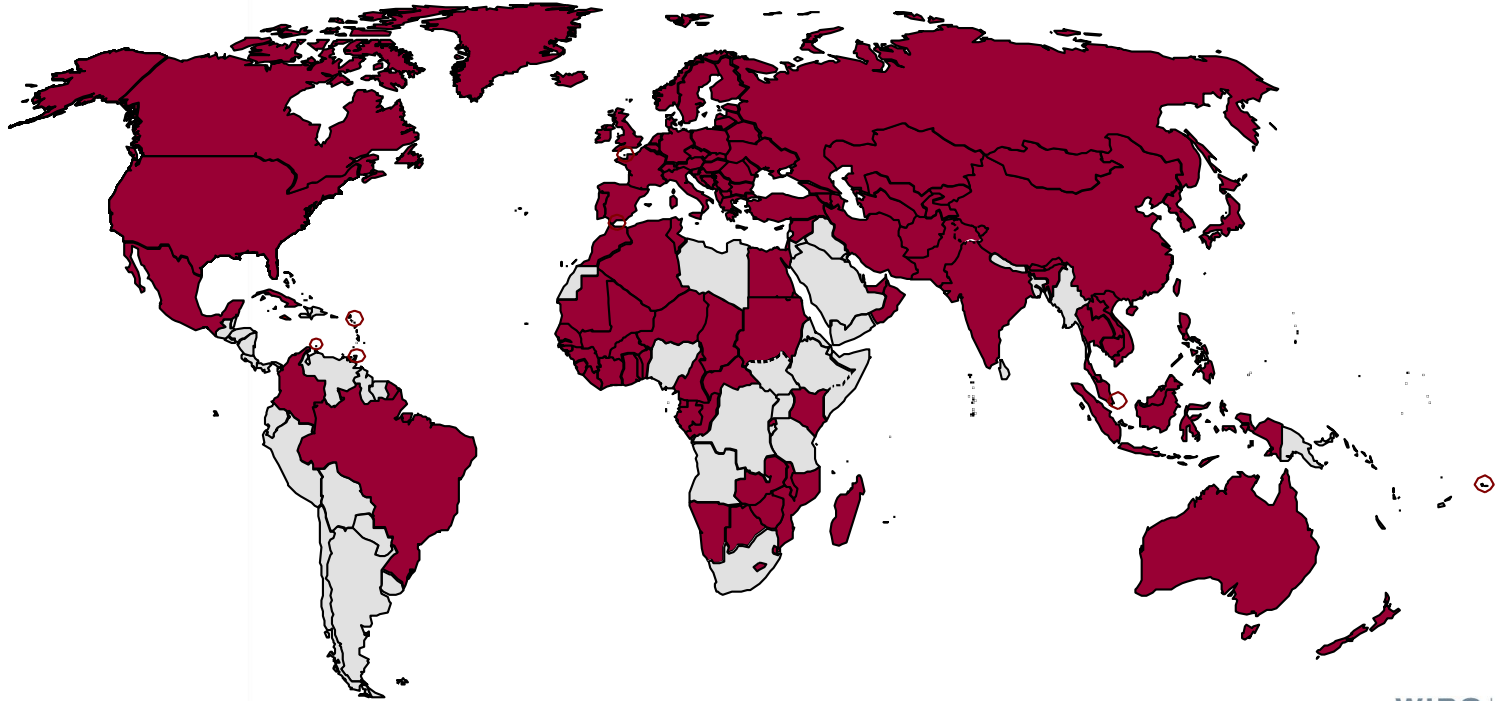
- Entered into force on December 28, 2021
- Declarations and notifications
 - 18-month refusal period or more in case of opposition
 - individual fee
 - recording of licenses has no effect in the UAE
 - does not accept requests for division or merger of international registrations

Jamaica



- Will enter into force on March 27, 2022
- Declarations and notifications
 - 18-month refusal period or more in case of opposition
 - individual fee
 - provisional refusals are subject to ex officio review

Members of the Madrid System: 2022



110 members (including EU and OAPI) covering 126 countries

Working Group proposals under discussion

- Provisional refusal : to introduce a minimum time limit to respond and an obligation to indicate the end date
- Dependency : to shorten the dependency period from five to three years
- Limitations : to clarify the role of each Office in the examination of limitations
- Languages : to introduce Arabic, Chinese and Russian in the language regime of the Madrid System



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■ Questions?

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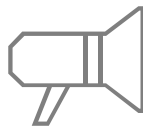
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