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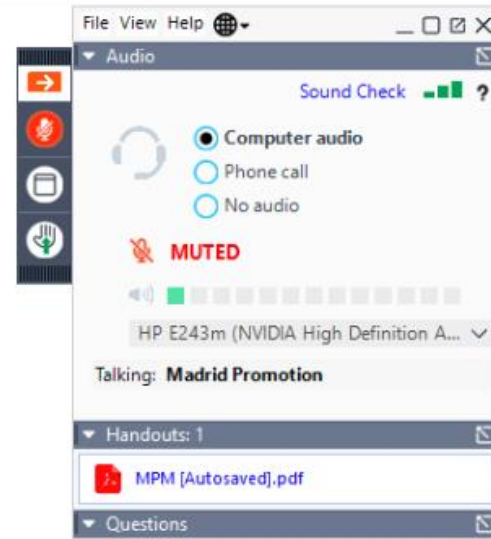
# Understanding the new Madrid System Regulations updates

## Madrid System Webinar

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**Geneva**  
**29 January**  
**2020**

# How to use GoToWebinar



# Structure of the Webinar

- Presentation: Interactive questions during the webinar
- Question and answer session at the end
- Presentation slides available for download
- Recording will be uploaded on the [Madrid Webinar page](#)
- Short survey to provide feedback

# Legal updates February 2020

- Common Regulations become the Regulations under the Protocol
- Simplified renewal of the international registration

# When did the Common Regulations enter into force for the first time?

- 1996
- 1989
- 1893
- 2020

# Common Regulations

- Two treaties System:
  - Madrid Agreement
  - Madrid Protocol
    - Common Regulations
- 2015: One-treaty System
  - Madrid Protocol
  - Common Regulations
- 2020: Common Regulations become Regulations under the Protocol



# Common Regulations

- What changes?
  - The name
  - The schedule of fees
  - The Administrative Instructions



# What was the reason for the change in name to the Common Regulations?

- A change in name, to adapt to the one treaty System
- A change of all the Madrid System
- New Regulations for a new Treaty



# Overview of the Renewal

- Every ten years upon payment of the relevant fee
- No changes at the renewal
- For some or all Contracting Parties
- Possibility to renew all the refused goods and services
- Possibility to renew, when there is a partial protection for only the goods and services protected.

# Which Rule contains the details concerning renewal?

- Rule 20
- Rule 29
- Rule 30
- Rule 40

# Renewal for a Contracting Party that has granted partial protection (before Feb 2020)

- Rule 30(2)(d): Where a statement under Rule 18*ter*(2)(ii) or (4) is recorded in the International Register, the international registration shall not be renewed in respect of the designated Contracting Party concerned for the goods and services that are not included in that statement, unless payment of the required fees is accompanied by a statement by the holder that the international registration is to be renewed also for those goods and services.

# Renewal for a Contracting Party that has granted partial protection (before Feb 2020)

- The **renewal fee** was calculated taking into account only the **classes protected**, **unless** the **holder states** that the international registration is to be renewed also for **the goods and services refused**.

# Renewal for a Contracting Party that has granted partial protection (before Feb 2020)

▶ Contracting Parties that have granted partial protection - Protected goods and services and/or classes

AU Australia  JP Japan

NO Norway

**Selected Contracting Parties 3 / 3** Select all Unselect all

Renew the goods and services or the classes that have been refused protection [paragraph 4 in the MM11 form]

Contracting Parties that have granted partial protection - Unprotected goods and services and/or classes

AU Australia  JP Japan

NO Norway

Select all Unselect all

Selecting to protect all goods and services for a contracting party that have only granted protection for some goods and services should only be done if they are ongoing proceedings in those countries.

# Renewal for a Contracting Party that has granted partial protection (before Feb 2020)

MM11(E), page 3

**4 RENEWAL FOR ALL GOODS AND SERVICES IN RESPECT OF CONTRACTING PARTIES WHERE PROTECTION HAS BEEN PARTIALLY REFUSED, FOLLOWING THE RECORDING OF A STATEMENT SENT UNDER RULE 18TER OF THE COMMON REGULATIONS**

You may still renew the international registration for all goods and services in respect of a Contracting Party that has partially refused protection, following the recording of a statement sent under Rule 18ter.

You must indicate below the Contracting Parties in respect of which you want to renew the international registration **for all goods and services, despite the fact that protection has been partially refused**, following the recording of the aforementioned statement. This may be useful, pending the outcome of further proceedings in the Contracting Party concerned.

An indication provided below will not be taken into account if the Contracting Party concerned has not been indicated in item 3 of this form.

<input type="checkbox"/> AF Afghanistan	<input type="checkbox"/> EE Estonia	<input type="checkbox"/> LA Lao People's Democratic Republic	<input type="checkbox"/> RO Romania
<input type="checkbox"/> AG Antigua and Barbuda	<input type="checkbox"/> EG Egypt	<input type="checkbox"/> LI Liechtenstein	<input type="checkbox"/> RS Serbia
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<input type="checkbox"/> BO Bonaire, Saint Eustatius and Saba <sup>1</sup>	<input type="checkbox"/> HR Croatia	<input type="checkbox"/> MN North Macedonia	<input type="checkbox"/> ST Sao Tome and Principe
<input type="checkbox"/> BR Brazil	<input type="checkbox"/> HU Hungary	<input type="checkbox"/> MW Malawi	<input type="checkbox"/> SX Sint Maarten (Dutch part) <sup>3</sup>
<input type="checkbox"/> BT Bhutan	<input type="checkbox"/> ID Indonesia	<input type="checkbox"/> MY Malaysia	<input type="checkbox"/> SY Syrian Arab Republic
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<input type="checkbox"/> BX Benelux <sup>4</sup>	<input type="checkbox"/> IL Israel	<input type="checkbox"/> NA Namibia	<input type="checkbox"/> TH Thailand
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<input type="checkbox"/> CH Switzerland	<input type="checkbox"/> IS Iceland	<input type="checkbox"/> OA African Intellectual Property Organization (OAPI) <sup>3</sup>	<input type="checkbox"/> TN Tunisia
<input type="checkbox"/> CN China	<input type="checkbox"/> IT Italy	<input type="checkbox"/> OM Oman	<input type="checkbox"/> TR Turkey
<input type="checkbox"/> CO Colombia	<input type="checkbox"/> JP Japan	<input type="checkbox"/> PH Philippines	<input type="checkbox"/> UA Ukraine
<input type="checkbox"/> CU Cuba	<input type="checkbox"/> KE Kenya	<input type="checkbox"/> PL Poland	<input type="checkbox"/> UA Ukraine
<input type="checkbox"/> CW Curaçao <sup>3</sup>	<input type="checkbox"/> KG Kyrgyzstan	<input type="checkbox"/> PT Portugal	<input type="checkbox"/> US United States of America
<input type="checkbox"/> CY Cyprus	<input type="checkbox"/> KH Cambodia		<input type="checkbox"/> UZ Uzbekistan
<input type="checkbox"/> CZ Czech Republic	<input type="checkbox"/> KP Democratic People's Republic of Korea		<input type="checkbox"/> VN Viet Nam
<input type="checkbox"/> DE Germany	<input type="checkbox"/> KR Republic of Korea		<input type="checkbox"/> WS Samoa
<input type="checkbox"/> DK Denmark	<input type="checkbox"/> KZ Kazakhstan		<input type="checkbox"/> ZM Zambia
<input type="checkbox"/> DZ Algeria			<input type="checkbox"/> ZW Zimbabwe

Others: .....

<sup>1</sup> Territorial entity previously part of the Netherlands Antilles.

<sup>2</sup> The designation of the European Union covers the following Member States: Austria, Belgium, Bulgaria, Croatia, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Luxembourg, Malta, Netherlands, Poland, Portugal, Romania, Slovakia, Slovenia, Spain, Sweden, United Kingdom.

<sup>3</sup> The designation of the African Intellectual Property Organization (OAPI) covers the following Member States: Benin, Burkina Faso, Cameroon, Central African Republic, Chad, Comoros, Congo, Côte d'Ivoire, Equatorial Guinea, Gabon, Guinea, Guinea-Bissau, Mali, Mauritania, Niger, Senegal, Togo.

<sup>4</sup> The designation of Benelux covers the following States: Belgium, Luxembourg and the Netherlands.

# What changes in the renewal from February 2020?

- Amendments to Rule 30
- Simplification of the renewal

# Renewal for a Contracting Party that has granted partial protection (before Feb 2020)

- Rule 30(2)(d): Where a statement under Rule 18*ter*(2)(ii) or (4) is recorded in the International Register, the international registration shall not be renewed in respect of the designated Contracting Party concerned for the goods and services that are not included in that statement, unless payment of the required fees is accompanied by a statement by the holder that the international registration is to be renewed also for those goods and services.



# Renewal for a Contracting Party that has granted partial protection (from Feb 2020)

- Rule 30 (1) (c) [...] where a statement under Rule 18*ter*(2) or (4) has been recorded in the International Register for a Contracting Party in respect of which payment of individual fee is due [...], the amount of that individual fee shall be established taking into account the goods and services included in the said statement only.

# Renewal for a Contracting Party that has granted partial protection (from Feb 2020)

- Contracting Parties with an individual fee per class: renewal fee calculated taking into account **only classes for which protection has been granted.**
- Holders of international registrations who have been granted **partial protection and are appealing such decision** will **no** longer be required to pay **individual fees for classes that are not protected** upon renewal.

# Renewal for a Contracting Party that has granted partial protection (from Feb 2020)

▶ Contracting Parties that have granted partial protection - Protected goods and services and/or classes

AU Australia  JP Japan

NO Norway

**Selected Contracting Parties 3 / 3**

~~Renew the goods and services or the classes that have been refused protection (paragraph 4 in the MM11 form).~~

# Renewal for a Contracting Party that has granted partial protection (from Feb 2020)

Renew the goods and services or the classes that have been refused protection (paragraph 4 in the MM11 form)

Contracting Parties that have granted partial protection - Unprotected goods and services and/or classes

AU Australia  JP Japan

NO Norway

Select all Unselect all

Selecting to protect all goods and services for a contracting party that have only granted protection for some goods and services should only be done if they are ongoing proceedings in those countries.



# Renewal for a Contracting Party that has granted partial protection (from Feb 2020)

MM11(E), page 3

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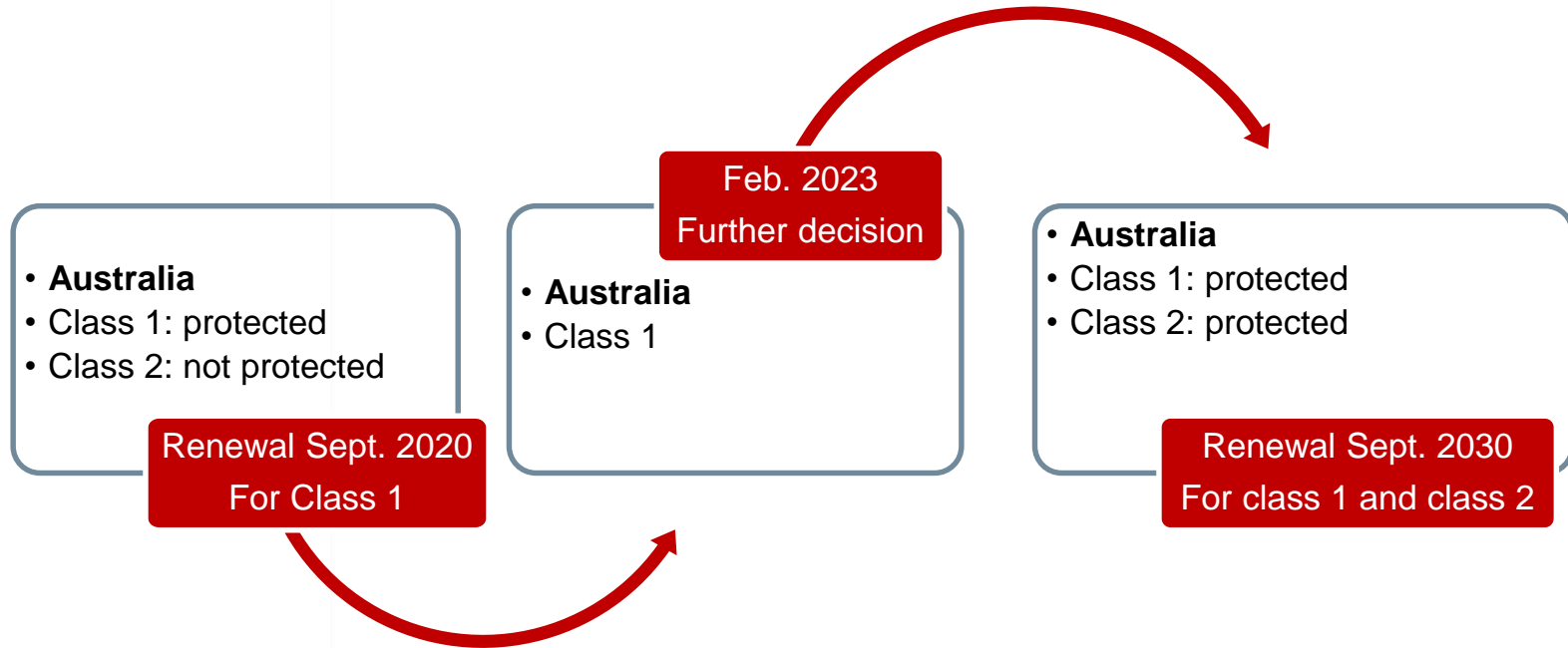
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<sup>4</sup> The designation of Benelux covers the following States: Belgium, Luxembourg and the Netherlands.

# Example of the change on Rule 30



# Example of the change on Rule 30

WIPO IP PORTAL MENU International Registration of Marks - Fee Calculation What is this? x HELP ENGLISH LOGIN WIPO

## International Registration of Marks - Fee Calculation

For date: 13.02.2020 Office of the Contracting Party of the holder: Switzerland

Number of classes: 1 Type: Renewal

Grace Period:

<input type="checkbox"/> AF Afghanistan	<input type="checkbox"/> DZ Algeria	<input type="checkbox"/> KZ Kazakhstan	<input type="checkbox"/> RS Serbia
<input type="checkbox"/> AG Antigua and Barbuda	<input type="checkbox"/> EE Estonia	<input type="checkbox"/> LA Lao People's Democratic Republic	<input type="checkbox"/> RU Russian Federation
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<input type="checkbox"/> CH Switzerland	<input type="checkbox"/> IR Islamic Republic of Iran		<input type="checkbox"/> TR Turkey
	<input type="checkbox"/> IS Iceland		

**Related links**

- Schedule of fees
- Individual fees
- How to pay
- Forms



## Q&A Session about the Webinar

Lucy Headington-  
Horton  
Madrid Legal Division

Lucía J. Yanguas  
Madrid Information and  
Promotion Division



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