



MM/A/53/1
ORIGINAL: ENGLISH
DATE: AUGUST 7, 2019

Special Union for the International Registration of Marks (Madrid Union)

Assembly

**Fifty-Third (23rd Ordinary) Session
Geneva, September 30 to October 9, 2019**

PROPOSED AMENDMENTS TO THE REGULATIONS UNDER THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

Document prepared by the Secretariat

INTRODUCTION

1. The Working Group on the Legal Development of the Madrid System for the International Registration of Marks (hereinafter referred to as “the Working Group”), at its seventeenth session, held from July 22 to 26, 2019, recommended amendments to Rules 21, 25, 27bis, 30 and 40 of the Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as “the Regulations”) for their adoption by the Madrid Union Assembly (hereinafter referred to as “the Assembly”) at its fifty-third session.
2. The discussions in the Working Group were based on documents MM/LD/WG/17/2 and MM/LD/WG/17/3. Relevant background information on the proposed amendments is given in the following paragraphs. The proposed amendments are reproduced in the Annexes to the present document. Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned (Annexes I and II). Clean copies of the proposed amended provisions (without underlining or striking through) appear in Annexes III and IV.

PROPOSED AMENDMENTS TO THE REGULATIONS

3. The proposed amendments to Rule 21 of the Regulations set out the key principles governing the replacement of a previous national or regional registration by an international registration, providing useful guidance to both trademark holders and Offices on the operation of replacement.

4. The proposed amendment to paragraph (4) of Rule 25 clarifies that, in a request for the recording of a change in ownership mentioning several transferees, each of them must fulfil the conditions to be the holder of an international registration.

5. The proposed amendment to paragraph (3) of Rule 27*bis* states that the International Bureau would notify the holder of any irregularity concerning the payment of the fee set out in item 7.7 of the Schedule of Fees and clarifies that the holder should remedy that irregularity.

6. The proposed amendment to Rule 30 simplifies the current renewal process and the calculation of fees, which will benefit the holders by making it easier for them to renew their international registrations.

7. The proposed amendment to paragraph 6 of Rule 40 clarifies that a notification under this paragraph may be sent by a Contracting Party that is an intergovernmental organization.

ENTRY INTO FORCE OF THE PROPOSED AMENDMENTS

8. The Working Group further recommended that the proposed amendments to Rules 25, 27*bis*, 30 and 40 enter into force on February 1, 2020, and that the proposed amendment to Rule 21 enter into force on February 1, 2021, as reproduced in the Annexes to the present document.

9. The Madrid Union Assembly is invited to adopt the amendments to Rules 21, 25, 27bis, 30 and 40 of the Regulations Under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, as set out in the Annexes to document MM/A/53/1.

[Annexes follow]

**PROPOSED AMENDMENTS TO THE REGULATIONS UNDER THE PROTOCOL
RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL
REGISTRATION OF MARKS**

**Regulations Under the Protocol Relating to the Madrid Agreement
Concerning the International Registration of Marks**

(as in force on February 1, 2020)

[...]

**Chapter 5
Subsequent Designations; Changes**

[...]

*Rule 25
Request for Recording*

[...]

(4) *[Several Transferees]* Where the request for the recording of a change in the ownership of the international registration mentions several transferees, each of them must that change may not be recorded in respect of a given designated Contracting Party if any of the transferees does not fulfill the conditions under Article 2 of the Madrid Protocol to be holder of the international registration in respect of that Contracting Party.

[...]

*Rule 27bis
Division of an International Registration*

[...]

(3) *[Irregular Request]* (a) If the request does not comply with the applicable requirements specified in paragraph (1), the International Bureau shall invite the Office that presented the request to remedy the irregularity and at the same time inform the holder.

(b) If the irregularity is not remedied by the Office within three months from the date of the invitation under subparagraph (a), the request shall be considered abandoned and amount of the fees received is less than the amount of the fees referred to in paragraph (2), the International Bureau shall notify accordingly the Office that presented the request holder, it shall inform and at the same time inform the holder and refund any fee paid under paragraph (2), after the deduction of an amount corresponding to one-half of that fee Office that presented the request.

(c) If the irregularity is not remedied within three months from the date of the communication under subparagraph (a) or (b), the request shall be considered abandoned and the International Bureau shall notify accordingly the Office that presented the request, it shall inform at the same time the holder and refund any fee paid under paragraph (2), after the deduction of an amount corresponding to one-half of that fee.

[...]

[...]

Chapter 6 Renewals

[...]

Rule 30 Details Concerning Renewal

(1) *[Fees]* (a) [...]

[...]

(c) Without prejudice to paragraph (2), where a statement under Rule 18ter(2) or (4) has been recorded in the International Register for a Contracting Party in respect of which payment of individual fee is due under subparagraph (a)(iii), the amount of that individual fee shall be established taking into account the goods and services included in the said statement only.

(2) *[Further Details]* (a) [...]

(b) Where the holder wishes to renew the international registration in respect of a designated Contracting Party notwithstanding the fact that a statement of refusal under Rule 18ter 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 by the holder that the renewal of the international registration is to be recorded in the International Register in respect of that Contracting Party for all the goods and services concerned.

(c) The international registration shall 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 shall 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) [Deleted]Where a statement under Rule 18ter(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.~~

~~(e) The fact that the international registration is not renewed under subparagraph (d) in respect of all the goods and services concerned, shall not be considered to constitute a change for the purposes of Article 7(2) of the Protocol.~~ 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 Protocol.

[...]

Chapter 9
Miscellaneous

[...]

Rule 40
Entry into Force; Transitional Provisions

[...]

(6) *[Incompatibility with National [or Regional](#) Laws]* If, on the date this Rule comes into force or the date on which a Contracting Party becomes bound by the Protocol, paragraph (1) of Rule 27*bis* or paragraph (2)(a) of Rule 27*ter* are not compatible with the national [or regional](#) law of that Contracting Party, the paragraph or paragraphs concerned, as the case may be, shall not apply in respect of this Contracting Party, for as long as it or they continue not to be compatible with that law, provided that the said Contracting Party notifies the International Bureau accordingly before the date this Rule comes into force or the date on which the said Contracting Party becomes bound by the Protocol. This notification may be withdrawn at any time.

[...]

[Annex II follows]

**PROPOSED AMENDMENT TO RULE 21 OF THE REGULATIONS UNDER THE PROTOCOL
RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL
REGISTRATION OF MARKS**

**Regulations Under the Protocol Relating to the Madrid Agreement
Concerning the International Registration of Marks**

(as in force on February 1, 2020~~21~~)

[...]

Rule 21

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

(1) [Request and Notification] From the date of the notification of the international registration or of the subsequent designation, as the case may be, the holder may present directly to the Office of a designated Contracting Party a request for that Office to take note of the international registration in its Register, in accordance with Article 4bis(2) of the Protocol. Where, ~~in accordance with Article 4bis(2) of the Protocol~~ following the said request, 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 or registrations, as the case may be, have been replaced by ~~an~~the 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 or registrations which ~~has~~have 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 or registrations, 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.

(3) [Further Details Concerning Replacement] (a) Protection to the mark that is the subject of an international registration may not be refused, even partially, based on a national or regional registration which is deemed replaced by that international registration.

(b) A national or regional registration and the international registration that has replaced it shall be able to coexist. The holder may not be required to renounce or request the cancellation of a national or regional registration which is deemed replaced by an international registration and should be allowed to renew that registration, if the holder so wishes, in accordance with the applicable national or regional law.

(c) Before taking note in its Register, the Office of a designated Contracting Party shall examine the request referred to in paragraph (1) to determine whether the conditions specified in Article 4*bis*(1) of the Protocol have been met.

(d) The goods and services concerned with replacement, listed in the national or regional registration, shall be covered by those listed in the international registration.

(e) A national or regional registration is deemed replaced by an international registration as from the date on which that international registration takes effect in the designated Contracting Party concerned, in accordance with Article 4(1)(a) of the Protocol.

[Annex III follows]

**PROPOSED AMENDMENTS TO THE REGULATIONS UNDER THE PROTOCOL
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(as in force on February 1, 2020)

[...]

**Chapter 5
Subsequent Designations; Changes**

[...]

*Rule 25
Request for Recording*

[...]

(4) *[Several Transferees]* Where the request for the recording of a change in the ownership of the international registration mentions several transferees, each of them must fulfill the conditions under Article 2 of the Madrid Protocol to be holder of the international registration.

[...]

*Rule 27bis
Division of an International Registration*

[...]

(3) *[Irregular Request]* (a) If the request does not comply with the requirements specified in paragraph (1), the International Bureau shall invite the Office that presented the request to remedy the irregularity and at the same time inform the holder.

(b) If the amount of the fees received is less than the amount of the fees referred to in paragraph (2), the International Bureau shall notify accordingly the holder and at the same time inform the Office that presented the request.

(c) If the irregularity is not remedied within three months from the date of the communication under subparagraph (a) or (b), the request shall be considered abandoned and the International Bureau shall notify accordingly the Office that presented the request, it shall inform at the same time the holder and refund any fee paid under paragraph (2), after the deduction of an amount corresponding to one-half of that fee.

[...]

[...]

Chapter 6 Renewals

[...]

Rule 30 Details Concerning Renewal

(1) *[Fees]* (a) [...]

[...]

(c) Without prejudice to paragraph (2), 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 under subparagraph (a)(iii), the amount of that individual fee shall be established taking into account the goods and services included in the said statement only.

(2) *[Further Details]* (a) [...]

(b) Where the holder wishes to renew the international registration in respect of a designated Contracting Party notwithstanding the fact that a statement of refusal under Rule 18*ter* 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 by the holder that the renewal of the international registration is to be recorded in the International Register in respect of that Contracting Party for all the goods and services concerned.

(c) The international registration shall 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 shall 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) [Deleted]

(e) 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 Protocol.

[...]

Chapter 9
Miscellaneous

[...]

Rule 40
Entry into Force; Transitional Provisions

[...]

(6) *[Incompatibility with National or Regional Laws]* If, on the date this Rule comes into force or the date on which a Contracting Party becomes bound by the Protocol, paragraph (1) of Rule 27*bis* or paragraph (2)(a) of Rule 27*ter* are not compatible with the national or regional law of that Contracting Party, the paragraph or paragraphs concerned, as the case may be, shall not apply in respect of this Contracting Party, for as long as it or they continue not to be compatible with that law, provided that the said Contracting Party notifies the International Bureau accordingly before the date this Rule comes into force or the date on which the said Contracting Party becomes bound by the Protocol. This notification may be withdrawn at any time.

[...]

[Annex IV follows]

**PROPOSED AMENDMENT TO RULE 21 OF THE REGULATIONS UNDER THE PROTOCOL
RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL
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**Regulations Under the Protocol Relating to the Madrid Agreement
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(as in force on February 1, 2021)

[...]

Rule 21

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

(1) *[Request and Notification]* From the date of the notification of the international registration or of the subsequent designation, as the case may be, the holder may present directly to the Office of a designated Contracting Party a request for that Office to take note of the international registration in its Register, in accordance with Article 4*bis*(2) of the Protocol. Where, following the said request, the Office has taken note in its Register that a national or a regional registration or registrations, as the case may be, have been replaced by the 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 or registrations which have 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 or registrations.

(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.

(3) *[Further Details Concerning Replacement]* (a) Protection to the mark that is the subject of an international registration may not be refused, even partially, based on a national or regional registration which is deemed replaced by that international registration.

(b) A national or regional registration and the international registration that has replaced it shall be able to coexist. The holder may not be required to renounce or request the cancellation of a national or regional registration which is deemed replaced by an international registration and should be allowed to renew that registration, if the holder so wishes, in accordance with the applicable national or regional law.

(c) Before taking note in its Register, the Office of a designated Contracting Party shall examine the request referred to in paragraph (1) to determine whether the conditions specified in Article 4*bis*(1) of the Protocol have been met.

(d) The goods and services concerned with replacement, listed in the national or regional registration, shall be covered by those listed in the international registration.

(e) A national or regional registration is deemed replaced by an international registration as from the date on which that international registration takes effect in the designated Contracting Party concerned, in accordance with Article 4(1)(a) of the Protocol.

[End of Annex IV and of document]