

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

### **Assembly**

**Fifty-Sixth (32<sup>nd</sup> Extraordinary) Session**  
**Geneva, July 14 to 22, 2022**

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 nineteenth session, held from November 15 to 17, 2021, recommended amendments to Rules 3, 5 and 30 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-sixth session.

2. Discussions in the Working Group were based on document MM/LD/WG/19/4. Relevant background information on the proposed amendments to the Regulations is given in the following paragraphs. The proposed amendments are reproduced in the Annexes to the present document. Proposed additions and deletions are indicated by, respectively, underlining and striking through the text concerned in Annex I. A clean version of the proposed amended provisions (without underlining or striking through) appears in Annex II.

## PROPOSED AMENDMENTS TO THE REGULATIONS

3. The proposed amendments to Rule 3 of the Regulations would require that holders of international registrations use a form to present a request for the recording of the appointment of a representative before the International Bureau of WIPO. While, at present, use of an official form remains optional, most holders take advantage of the optional form to present the said request. The use of a form has helped to streamline and expedite the processing of the above-mentioned request. Therefore, amending Rule 3 of the Regulations to prescribe the use of a form would be consistent with ongoing efforts to make the Madrid System more efficient for the benefit of users.

4. The proposed amendments to Rule 5 of the Regulations are merely editorial and seek to remove from paragraph (5) references to former paragraphs (2) and (3) of the same Rule, which have since been deleted.

5. The proposed amendments to Rule 30 of the Regulations would provide for a longer renewal period, more specifically increase the period in which holders can make an early payment of the fees for the renewal of an international registration from three to six months prior to its expiry date. The International Bureau would process the renewal of the international registration as soon as it receives complete payment of all the required fees, record the renewal in the International Register, notify the designated Contracting Parties concerned as well as issue the corresponding certificate to the holder. The proposed amendments would benefit holders of international registrations who must prove they have renewed their international registrations to enforce their rights in the designated Contracting Parties.

## ENTRY INTO FORCE OF THE PROPOSED AMENDMENTS

6. The Working Group recommended that the proposed amendments to Rules 3, 5 and 30 of the Regulations, as reproduced in the Annexes to the present document, enter into force on November 1, 2022.

*7. The Madrid Union Assembly is invited to adopt the amendments to Rules 3, 5 and 30 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/56/1, with November 1, 2022, as their date of entry into force.*

[Annexes follow]

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

as in force on ~~November 1, 2021~~ [November 1, 2022](#)

[...]

### Chapter 1 General Provisions

[...]

#### Rule 3 Representation Before the International Bureau

[...]

##### (2) *[Appointment of the Representative]*

[...]

(b) The appointment of a representative may also be made in a separate communication, [provided it is made on the relevant official form, which and it](#) may relate to one or more specified international applications or international registrations of the same applicant or holder. The said ~~communication~~ [form](#) 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~~ [form](#) shall be signed by the applicant or the holder, or by the Office ~~through which it was presented~~ [presenting the request](#).

[...]

#### Rule 5 Excuse in Delay in Meeting Time Limits

[...]

(5) *[International Application and Subsequent Designation]* Where the International Bureau receives an international application or a subsequent designation beyond the two-month period referred to in Article 3(4) of the Protocol and in Rule 24(6)(b), and the Office concerned indicates that the late receipt resulted from circumstances referred to in paragraph (1), ~~(2) or (3)~~, paragraphs [\(1\), \(2\) or \(3\)](#) and ~~paragraph (4)~~ shall apply.

[...]

**Chapter 6**  
**Renewals**

**Rule 30**  
**Details Concerning Renewal**

(1) *[Fees]*

[...]

- (b) If any payment made for the purposes of renewal is received by the International Bureau earlier than ~~three~~six months before the date on which the renewal of the international registration is due, it shall be considered as having been received ~~three~~six months before the date on which renewal is due.

[...]

[Annex II follows]

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

as in force on [November 1, 2022]

[...]

### **Chapter 1 General Provisions**

[...]

#### **Rule 3 Representation Before the International Bureau**

[...]

##### **(2) *[Appointment of the Representative]***

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(b) The appointment of a representative may also be made in a separate communication, provided it is made on the relevant official form, and it may relate to one or more specified international applications or international registrations of the same applicant or holder. The said form shall be presented to the International Bureau

(i) by the applicant, the holder or the appointed representative, or

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The form shall be signed by the applicant or the holder, or by the Office presenting the request.

[...]

#### **Rule 5 Excuse in Delay in Meeting Time Limits**

[...]

(5) *[International Application and Subsequent Designation]* Where the International Bureau receives an international application or a subsequent designation beyond the two-month period referred to in Article 3(4) of the Protocol and in Rule 24(6)(b), and the Office concerned indicates that the late receipt resulted from circumstances referred to in paragraph (1), paragraphs (1) and (4) shall apply.

[...]

**Chapter 6**  
**Renewals**

**Rule 30**  
**Details Concerning Renewal**

(1) *[Fees]*

[...]

- (b) If any payment made for the purposes of renewal is received by the International Bureau earlier than six months before the date on which the renewal of the international registration is due, it shall be considered as having been received six months before the date on which renewal is due.

[...]

[End of Annex II and of document]