

## **Working Group on the Legal Development of the Madrid System for the International Registration of Marks**

**Seventeenth Session  
Geneva, July 22 to 26, 2019**

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

*Document prepared by the International Bureau*

#### **INTRODUCTION**

1. This document proposes amendments to the Regulations Under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to, respectively, as “the Regulations” and “the Protocol”), in addition to those already proposed in document MM/LD/WG/17/2. These proposed amendments would enter into force on February 1, 2020<sup>1</sup>.

2. More specifically, these proposals concern amendments to Rules 25, 27bis, 30 and 40 of the Regulations. These proposals support the ongoing process of simplifying the Regulations and making the Madrid System for the International Registration of Marks (hereinafter referred to as “the Madrid System”) more user-friendly to its users, Offices of Contracting Parties and interested third parties. The proposals are reproduced in the Annex to this document.

---

<sup>1</sup> See documents MM/A/52/2 and MM/A/52/3.

## **REQUEST FOR THE RECORDING OF A CHANGE IN OWNERSHIP MENTIONING SEVERAL TRANSFEREES**

3. Rule 25(4) of the Regulations is meant to address the lack of a common treaty between a transferee and one of the Contracting Parties designated in the international registration that is the subject of a request for the recording of a change in ownership. Since the Madrid System became a one-treaty system, that situation is no longer possible. Accordingly, paragraph (4) of Rule 25 could be deleted.

4. However, instead of deleting it, it is proposed that the paragraph be amended to make explicit the requirement that, in a request for the recording of a change in ownership mentioning several transferees, each of them must fulfill the conditions to be the holder of an international registration. This requirement would be similar to the requirement found in Rule 8(2) of the Regulations, concerning two or more applicants jointly filing an international application.

## **IRREGULARITIES IN A REQUEST FOR DIVISION OF AN INTERNATIONAL REGISTRATION**

5. For the sake of clarity, a number of changes to paragraph (3) of Rule 27*bis* of the Regulations are hereby being proposed.

6. Paragraph (3)(a) of Rule 27*bis* requires the International Bureau to communicate irregularities concerning requirements that apply to a request presented under paragraph (1)(a), and to invite the Office that presented the request to remedy those irregularities. It is proposed that paragraph (3)(a) of Rule 27*bis* make a reference to the requirements prescribed in paragraph (1) of the same Rule. The proposed amendment would make it clear that the Office that presented the request is not required to remedy irregularities concerning the payment of the fee referred to in paragraph (2) of the same Rule.

7. In addition, it is proposed that a new paragraph (3)(b) be introduced in Rule 27*bis* to deal with irregularities concerning the payment of the fee referred to in paragraph (2). The proposed new paragraph (3)(b) would require the International Bureau to notify this irregularity to the holder of the international registration concerned and to inform the Office that presented the request.

8. Finally, it is proposed that current paragraph (3)(b) become new paragraph (3)(c) of Rule 27*bis*, slightly modified to take into account the notification sent to the holder under proposed new paragraph (3)(b).

## **RENEWAL OF THE INTERNATIONAL REGISTRATION**

9. The current Rule 30 of the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement (hereinafter referred to as “the Common Regulations”) was last amended at the forty-eighth session of the Assembly of the Madrid Union<sup>2</sup>.

10. The purpose of that amendment was to address the case in which the amount of the individual fee due for the renewal of an international registration for a designated Contracting Party is dependent on the number of classes. With this amendment, where applicable, the holder pays the amount of the individual fee for the renewal for the protected goods and services only.

---

<sup>2</sup> See documents MM/A/48/4 and MM/LD/WG/11/2.

11. In addition, the amendment sought to preserve the rights of holders who have appealed against a decision communicated in a statement recorded under Rule 18*ter*(2)(ii) or (4) of the Common Regulations. The amendment also provided holders with the option to renew the international registration for the Contracting Party concerned, for all goods and services, upon making a statement to this effect.
12. The amendment to Rule 30 of the Common Regulations has benefited holders of international registrations, who, where applicable, no longer have to pay the amount of the individual fee for the renewal in respect of goods and services for which protection has not been granted. Moreover, it has benefited Offices of designated Contracting Parties that cannot collect fees for the renewal of goods and services that have been refused.
13. However, the amendment has made the renewal process of an international registration more complex. For example, concerning the renewal of international registrations, the Madrid Customer Service Unit receives some 120 weekly inquiries; the Madrid Operations Division handles some 30 correction requests per week; and, in 2018, the Madrid Legal Division handled more than 30 complaints.
14. Most of the above-mentioned inquiries, correction requests and complaints result from a lack of understanding of the renewal process. Furthermore, examiners processing renewal requests have indicated that users make errors when filling out the renewal paper form (Form MM11) and appear not to understand the implications of making a statement to renew the international registration in respect of a designated Contracting Party for all goods and services.
15. The principle that the holder should pay the amount of the individual fee for the protected goods and services only is not new. This principle can be found in Rule 34(3)(c)(iii) of the Common Regulations and it applies to the payment of the second part of the individual fee.
16. Where the amount of the second part of the individual fee depends on the number of classes of goods and services for which the mark is protected in the designated Contracting Party concerned, the notification sent under that Rule must indicate this number. In such case, the International Bureau establishes the said amount taking into account the number of classes of goods and services for which the mark is protected, in accordance with paragraph (7)(c) of the same Rule.
17. To simplify the current process of calculating fees during the renewal of an international registration, it is proposed that Rule 30 of the Regulations be modified by deleting paragraph (2)(d) and the first sentence of paragraph (2)(e). In addition, it is proposed that the principle for establishing the amount of the individual fee for the renewal of an international registration, taking into account the protected goods and services only, be included in a new paragraph (1)(c) of Rule 30.
18. The proposed amendments would simplify the renewal process while preserving all its current advantages. Moreover, as a statement to renew the international registration in respect of a designated Contracting Party for all goods and services would no longer be required, both the paper (Form MM11) and electronic renewal request forms (e-Renewal) would be made simpler and, as a result, more user-friendly. The proposed amendments would require minor modifications to e-Renewal and would not require changing the operational or financial processes and systems of the International Bureau.
19. Finally, for the sake of clarity, it is proposed that paragraph (2)(b) of Rule 30 be modified to make it explicit that, when renewing an international registration in respect of a Contracting Party where the mark has been totally refused, renewal must be effected for all the goods and services for which the Contracting Party remains designated.

## **NOTIFICATION UNDER RULE 40(6)**

20. For the sake of accuracy, it is hereby proposed that paragraph (6) of Rule 40 of the Regulations be modified by inserting the words “or regional” both in the title and in the paragraph itself. The proposed change would simply take into account the possibility that the notification under Rule 40(6) be made by a Contracting Organization.

## **DATE OF ENTRY INTO FORCE**

21. It is suggested that the proposed amendments to Rules 25, 27*bis*, 30 and 40 enter into force on the date the Regulations will enter into force, that is, on February 1, 2020.

22. *The Working Group is invited to:*

*(i) consider the proposals made in this document; and*

*(ii) recommend to the Madrid Union Assembly some or all of the proposed amendments to the Regulations, as presented in the Annex to this document or in amended form, for their entry into force on February 1, 2020.*

[Annex follows]

**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.

[...]

[End of Annex and of document]