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| INFORMATION NOTICE NO. 23/2014 |

**Madrid Agreement and Protocol Concerning the International Registration of Marks**

**Amendments to the Common Regulations under the Madrid Agreement and Protocol**

 At its forty-eighth (28th extraordinary) session, which took place in Geneva from September 22 to 30, 2014, the Assembly of the Madrid Union adopted a new rule and other amendments to the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement (the Common Regulations) that will enter into force on January 1, 2015.

### New Rule 5*bis* and amendments to Rules 20*bis*(3) and 27(1) of the Common Regulations: Continued Processing

 New Rule 5*bis* of the Common Regulations will provide for continued processing where an applicant or holder has missed certain time limits.

 Continued processing will be available only with respect to time limits concerning:

1. an international application, under Rule 11(2) or (3) of the Common Regulations;
2. a request for the recording of licenses, under Rule 20*bis*(2) of the Common Regulations;
3. a subsequent designation, under Rule 24(5)(b) of the Common Regulations;
4. a request for the recording of a change or cancellation, under Rule 26(2) of the Common Regulations;
5. payment of the second part of the individual fee, under Rule 34(3)(c)(iii) of the Common Regulations; and
6. a request that an international registration continue its effects in a successor State and the payment of the fees related to this request, under Rule 39(1) of the Common Regulations.

 Continued processing can be requested within two months from the expiry of the time limit concerned, by presenting the new official form MM20 (see Annex III) to the International Bureau and upon the payment of a fee of 200 Swiss francs. Along with the request, the requirements in respect of which the time limit concerned applied shall also be complied with. Continued processing cannot be requested before the relevant time limit has expired.

 A request for continued processing that does not meet the previously mentioned requirements shall not be considered as such and the International Bureau will notify the applicant or holder accordingly.

 The International Bureau shall continue to process the international application, subsequent designation, request or payment in respect of which a request for continued processing has been received in order. The International Bureau will record this fact in the International Register and notify the applicant or holder accordingly.

 Following the recording of continued processing, licenses recorded under Rule 20*bis*(3) of the Common Regulations and changes and cancellations recorded under Rule 27(1) of the Common Regulations shall be recorded with the date on which the time limit to comply with the corresponding requirement expired.

 Continued processing may be requested where the time limit to comply with the concerned requirements expires on or after January 1, 2015.

### Amendments to Rule 30 of the Common Regulations: Details Concerning Renewal

 Amendments to Rule 30 of the Common Regulations will change the manner in which an international registration is renewed.

 Following a decision recorded under Rule 18*ter*(5) and without any further instruction from the holder, an international registration will be renewed only for the goods and services that are effectively protected, if any, in respect of the designated Contracting Party concerned.

 The holder may still use form MM11 (see Annex IV) to request the renewal of an international registration.  The holder must indicate, in item 3 of this form, ***all*** the designated Contracting Parties in respect of which the international registration shall be renewed by ticking the boxes corresponding to those Contracting Parties.

 The holder may still choose to renew an international registration for all the concerned goods and services in respect of a designated Contracting Party where protection to the mark has been totally or partially refused. This may be necessary where the outcome of further proceedings in that Contracting Party is still pending.

 Where protection to the mark has been totally refused in a designated Contracting Party and the holder wishes to renew the international registration in respect of this Contracting Party, he must indicate so in item 3 of form MM11 by ticking the box corresponding to the designated Contracting Party concerned. The registration will be renewed for all the concerned goods and services in respect of that Contracting Party.

 Where protection to the mark has been partially refused in a designated Contracting Party and the holder wishes to renew the international registration for all the concerned goods and services in respect of this Contracting Party, he must indicate so in items 3 and 4 of form MM11, by ticking, in both items, the boxes corresponding to the designated Contracting Party concerned.

 The way in which a holder chooses to renew an international registration will have an impact on the amount of the renewal fee due in respect of a designated Contracting Party that has made a declaration to receive an individual fee, where this individual fee ought to be calculated taking into account the number of classes of the International Classification of Goods and Services (the Nice Classification) for which renewal is sought.

 The amendments to Rule 30 of the Common Regulations apply to international registrations for which renewal is requested on or after January 1, 2015, and for which the said renewal is due on or after that date.

### Amendments to Rule 31 of the Common Regulations: Recording of the Renewal; Notification and Certificate

 Amendments to Rule 31 will provide for the sending of a notification to the holder and to his representative, if any, where an international registration has not been renewed or where it has not been renewed in respect of a designated Contracting Party.

 The amendments to Rule 31 of the Common Regulations apply to international registrations for which renewal is due on or after January 1, 2015.

 The amended text of the Common Regulations and the Schedule of Fees is reproduced in Annexes I and II.

December 18, 2014

**Common Regulations under**

**the Madrid Agreement Concerning**

**the International Registration of Marks**

**and the Protocol Relating to that Agreement**

(as in force on January 1, 2015)

[…]

**Chapter 1**

**General Provisions**

 […]

*Rule 5bis*

*Continued Processing*

 (1) *[Request]*  (a)  Where an applicant or holder has failed to comply with any of the time limits specified or referred to in Rules 11(2) and (3), 20*bis*(2), 24(5)(b), 26(2), 34(3)(c)(iii) and 39(1), the International Bureau shall, nevertheless, continue the processing of the international application, subsequent designation, payment or request concerned, if:

 (i) a request to that effect, signed by the applicant or holder, is presented to the International Bureau on the official form; and

 (ii) the request is received, the fee specified in the Schedule of Fees is paid and, together with the request, all of the requirements in respect of which the time limit concerned applied are complied with, within two months from the date of expiry of that time limit.

(b) A request not complying with items (i) and (ii) of subparagraph (a) shall not be considered as such and the applicant or holder shall be notified to that effect.

(2) *[Recording and Notification]*  The International Bureau shall record in the International Register any continued processing and notify the applicant or holder accordingly.

**Chapter 4**

**Facts in Contracting Parties**

**Affecting International Registrations**

 […]

*Rule 20bis*

*Licenses*

 […]

 (3) *[Recording and Notification]*

 […]

 (c) Notwithstanding subparagraph (b), where continued processing has been recorded under Rule 5*bis*, the license shall be recorded in the International Register as of the date of expiry of the time limit specified in paragraph (2)(b).

[…]

**Chapter 5**

**Subsequent Designations; Changes**

 […]

*Rule 27*

*Recording and Notification of a Change or of a Cancellation;*

*Merger of International Registrations; Declaration That a Change in*

*Ownership or a Limitation Has No Effect*

(1) *[Recording and Notification of a Change or of a Cancellation]*

[…]

 (c) Notwithstanding subparagraph (b), where continued processing has been recorded under Rule 5*bis*, the change or cancellation shall be recorded in the International Register as of the date of expiry of the time limit specified in Rule 26(2), except that, where a request has been made in accordance with Rule 25(2)(c), it may be recorded as of a later date.

**Chapter 6**

**Renewals**

 […]

*Rule 30*

*Details Concerning Renewal*

 (1) *[Fees]*  (a)  The international registration shall be renewed upon payment, at the latest on the date on which the renewal of the international registration is due, of

[…]

 (iii) the complementary fee or individual fee, as the case may be, for each designated Contracting Party for which no statement of refusal under Rule 18*ter* or invalidation, in respect of all the goods and services concerned, is recorded in the International Register, as specified or referred to in item 6 of the Schedule of Fees. However, such payment may be made within six months from the date on which the renewal of the international registration is due, provided that the surcharge specified in item 6.5 of the Schedule of Fees is paid at the same time.

 […]

(2) *[Further Details]*  (a)  Where the holder does not wish to renew the international registration in respect of a designated Contracting Party for which no statement of refusal under Rule 18*ter*,in respect of all the goods and services concerned, is recorded in the International Register, payment of the required fees shall be accompanied by a statement by the holder that the renewal of the international registration is not to be recorded in the International Register in respect of that Contracting Party.

(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.

(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) 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.

(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 Agreement or 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 Agreement or Article 7(2) of the Protocol.

 […]

*Rule 31*

*Recording of the Renewal; Notification and Certificate*

 […]

(4) *[Notification in Case of Non-Renewal]*  (a)  Where an international registration is not renewed, the International Bureau shall notify accordingly the holder, the representative, if any, and the Offices of all of the Contracting Parties designated in that international registration.

(b) Where an international registration is not renewed in respect of a designated Contracting Party, the International Bureau shall notify the holder, the representative, if any, and the Office of that Contracting Party accordingly.

[Annex II follows]

SCHEDULE OF FEES

(in force on January 1, 2015)

*Swiss francs*

[…]

7. *Miscellaneous recordings*

[…]

7.6 Request for a continued processing under Rule 5*bis*(1) 200

[Annex III follows]









[Annex IV follows]











[End of Annex IV]