

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

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

1. At its forty-ninth (21<sup>st</sup> ordinary) session, which took place in Geneva from October 5 to 14, 2015, the Assembly of the Madrid Union adopted 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 April 1, 2016.

#### Amendments to Rule 5 of the Common Regulations: Irregularities in Postal and Delivery Services and in Communications Sent Electronically

2. Under the new text of paragraph (3) of Rule 5, failure of an interested party to meet a time limit for a communication addressed to WIPO will be excused where the communication was sent electronically and the interested party submits satisfactory evidence showing that the time limit was not met due to a failure in the electronic communication with WIPO or to one that affects the locality of the interested party due to extraordinary circumstances. In this case, a new communication should be effected no later than five days after the electronic services are resumed.

3. The new provision is meant to cover communications sent to WIPO by an interested party (i.e., the applicant, holder, representative or Office of a Contracting Party) by electronic means (e.g., e-mail, fax, e-forms). An interested party may be excused for not meeting a time limit when an electronic communication is not received by WIPO due to any failure in the electronic communication systems. Moreover, the interested party will also be excused where extraordinary circumstances in its locality (e.g., prolonged Internet service disruptions, unanticipated power outages) prevent this party from effecting the communication.

4. In order to be excused, the interested party must submit sufficient evidence to WIPO (e.g. an attestation from its Internet service provider confirming that the communication was sent or that service was not available, a letter from the power company informing of unanticipated outages, news articles of those events) and a new communication is received by WIPO within five days after services are resumed.

5. In accordance with new paragraph (4) of Rule 5, the supporting evidence and the new communication shall be received by WIPO no later than six months from the expiry of the time-limit concerned.

6. Under new paragraph (5) of Rule 5, when an Office is excused for not meeting the two-month time limit for WIPO to receive an international application or subsequent designation, as specified in Article 3(4) of the Madrid Protocol and Rule 24(6)(b), the date of the international registration or subsequent designation will be the date on which the Office received the said application or designation, as certified by that Office.

7. Finally, users are reminded that failure to meet a time-limit for communications mailed through a postal service or sent through a delivery service may be excused under the conditions specified in paragraphs (1) or (2) of Rule 5.

#### Amendments to Rule 36 of the Common Regulations: Exemption From Fees

8. An amendment to paragraph (ii) of Rule 36 clarifies that changes in the address for correspondence, e-mail address, telephone and fax numbers and in any other means of communication with the applicant or holder are exempt from the payment of a fee.

9. Applicants and holders wishing to request any of the abovementioned changes to their contact information can do so by sending a communication to WIPO, signed by the applicant, holder or the recorded representative. In addition to the requested change, the communication must clearly indicate the name of the applicant or holder and, as the case may be, the basic application, basic registration or international registration number(s). Applicants and holders are encouraged to maintain their contact information up-to-date in order to receive communications from WIPO at their current addresses.

10. When holders request the recording of a change in their name or address, by using form MM9, they need to confirm their address for correspondence. If this is not done, WIPO will send communications to their new address. Holders may also take advantage of this opportunity to opt for electronic communication or to request that their other contact information be updated by providing the relevant details in item 4 of the form.

#### How to Present Requests Under Rules 5 and 36(ii) of the Common Regulations

11. A communication under Rules 5, requesting that an interested party be excused for having failed to meet a time limit, or 36(ii) of the Common Regulations, requesting a change in the contact details of the applicant or holder, may be presented to WIPO as follows:

By e-mail: [intreg@wipo.int](mailto:intreg@wipo.int)  
indicating in the subject line, as the case may be,  
“Request to be excused for having failed to meet a time limit under Rule 5”  
“Request to change contact details under Rule 36(ii)”

By post: Madrid Registry  
World Intellectual Property Organization  
34, chemin des Colombettes  
1211 Geneva 20, Switzerland

12. The amended text of the Common Regulations and form MM9 are reproduced in Annexes I and II.

March 29, 2016

**Common Regulations under  
the Madrid Agreement Concerning  
the International Registration of Marks  
and the Protocol Relating to that Agreement**

(as in force on April 1, 2016)

[...]

**Chapter 1  
General Provisions**

[...]

*Rule 5  
Irregularities in Postal and Delivery Services  
and in Communications Sent Electronically*

[...]

(3) *[Communication Sent Electronically]* Failure by an interested party to meet a time limit for a communication addressed to the International Bureau and submitted by electronic means shall be excused if the interested party submits evidence showing, to the satisfaction of the International Bureau, that the time limit was not met because of failure in the electronic communication with the International Bureau, or which affects the locality of the interested party owing to extraordinary circumstances beyond the control of the interested party, and that the communication was effected not later than five days after the electronic communication service was resumed.

(4) *[Limitation on Excuse]* Failure to meet a time limit shall be excused under this Rule only if the evidence referred to in paragraph (1), (2) or (3) and the communication or, where applicable, a duplicate thereof are received by the International Bureau not later than six months after the expiry of the time limit.

(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 Agreement, 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), paragraph (1), (2) or (3) and paragraph (4) shall apply.

## Chapter 8 Fees

[...]

### *Rule 36 Exemption From Fees*

Recording of the following shall be exempt from fees:

- (i) the appointment of a representative, any change concerning a representative and the cancellation of the recording of a representative,
- (ii) any change concerning the telephone and telefacsimile numbers, address for correspondence, electronic mail address and any other means of communication with the applicant or holder, as specified in the Administrative Instructions,
- (iii) the cancellation of the international registration,
- (iv) any renunciation under Rule 25(1)(a)(iii),
- (v) any limitation effected in the international application itself under Rule 9(4)(a)(xiii) or in a subsequent designation under Rule 24(3)(a)(iv),
- (vi) any request by an Office under Article 6(4), first sentence, of the Agreement or Article 6(4), first sentence, of the Protocol,
- (vii) the existence of a judicial proceeding or of a final decision affecting the basic application, or the registration resulting therefrom, or the basic registration,
- (viii) any refusal under Rule 17, Rule 24(9) or Rule 28(3), any statement under Rules 18*bis* or 18*ter* or any declaration under Rule 20*bis*(5) or Rule 27(4) or (5),
- (ix) the invalidation of the international registration,
- (x) information communicated under Rule 20,
- (xi) any notification under Rule 21 or Rule 23,
- (xii) any correction in the International Register.

[Annex II follows]

**MM9(E)**

MADRID AGREEMENT AND PROTOCOL CONCERNING THE  
INTERNATIONAL REGISTRATION OF MARKS

REQUEST FOR THE RECORDING OF A  
CHANGE IN NAME AND/OR ADDRESS OF THE HOLDER

(Rule 25 of the Common Regulations)

**IMPORTANT**

1. This request may be presented to the International Bureau directly by the holder or through the Office of the Contracting Party of the holder.
2. This form is to be used only to request the recording of a change in the name and/or address of the recorded holder. The form to be used for requesting the recording of a change in the ownership of the international registration is form MM5.
3. Holders should also take this opportunity to change their contact details, namely, their address for correspondence, email address and telephone and fax numbers. However, holders wishing to change their contact details only may request so, free of charge, by sending a simple letter to the International Bureau, signed by them or by their recorded representatives.

World Intellectual Property Organization  
34, chemin des Colombettes  
1211 Geneva 20, Switzerland  
Tel. (Madrid Customer Service): +41 (0)22 338 8686  
Fax (Madrid Registry): +41 (0)22 740 1429  
e-mail: [intreg\\_mail@wipo.int](mailto:intreg_mail@wipo.int) – Internet: [www.wipo.int](http://www.wipo.int)

**MM9(E)****REQUEST FOR THE RECORDING OF A CHANGE  
IN NAME AND/OR ADDRESS OF THE HOLDER**

<u>For use by the holder</u>	<u>For use by the Office</u>
This request contains the following number of continuation sheets: ..... Holder's reference: .....	Office's reference: .....
<b>1</b> INTERNATIONAL REGISTRATION NUMBER(S) (this form may be used for several international registrations of the same holder) ..... ..... ..... .....	
<b>2</b> NAME OF THE HOLDER (as recorded in the International Register) .....	
<b>3</b> CHANGE IN NAME AND/OR ADDRESS OF THE HOLDER (indicate the change(s) by ticking the appropriate box(es)) <input type="checkbox"/> New name: ..... <input type="checkbox"/> New address: ..... .....	
<b>4</b> NEW CONTACT DETAILS (optional) New telephone: ..... New fax: ..... New e-mail address: ..... By providing an e-mail address, any further correspondence from the International Bureau related to this/these international registration(s) will be sent only electronically and, therefore, you will no longer receive any paper correspondence. Likewise, any further correspondence from the International Bureau related to other international applications or international registrations for which the same e-mail address has been, or will be, provided will also be sent only electronically. Please note that, for the purpose of electronic communication, there can be only one e-mail address recorded per each international registration. New address for correspondence: ..... ..... Indicate the address for correspondence, if any, and if different from the address of the holder indicated in item 3; if this item is <b>not completed</b> , the address for correspondence already recorded in the International Register will be <b>automatically disregarded</b> by the International Bureau.	

**5** APPOINTMENT OF A (NEW) REPRESENTATIVE (optional)  
(only complete this item if you are appointing a (new) representative)

Name: .....

Address: .....

Telephone: ..... Fax: .....

E-mail address: .....

By providing an e-mail address, any further correspondence from the International Bureau related to this/these international registration(s) will be sent only electronically and, therefore, you will no longer receive any paper correspondence. Likewise, any further correspondence from the International Bureau related to other international applications or international registrations for which the same e-mail address has been, or will be, provided will also be sent only electronically. Please note that, for the purpose of electronic communication, there can be only one e-mail address recorded per each international registration.

SIGNATURE OF THE HOLDER APPOINTING THE ABOVE (NEW) REPRESENTATIVE

**6** SIGNATURE BY THE HOLDER AND/OR HIS REPRESENTATIVE

Holder  
(as recorded in the International Register)

Representative of the holder  
(as recorded in the International Register or herein appointed)

Name: ..... Name: .....

Signature: ..... Signature: .....

**7** OFFICE OF THE CONTRACTING PARTY OF THE HOLDER PRESENTING THE REQUEST  
(where this request is presented through an Office)

Name of the Office: .....

Name and signature of the official signing on behalf of the Office: .....

Name and e-mail address of the contact person in the Office: .....

## FEE CALCULATION SHEET

(a) INSTRUCTIONS TO DEBIT FROM A CURRENT ACCOUNT	
<input type="checkbox"/> The International Bureau is hereby instructed to debit the required amount of fees from a current account opened with the International Bureau (if this box is checked, it is not necessary to complete (b)).	
Holder of the account: .....	Account number: .....
Identity of the party giving the instructions: .....	
(b) AMOUNT OF FEES	
(The fee is 150 Swiss francs, irrespective of the number of international registrations listed in item 1)	
	<b>Amount</b> .....
(c) METHOD OF PAYMENT	
Identity of the party effecting the payment: .....	
Payment received and acknowledged by WIPO	<input type="checkbox"/> WIPO receipt number .....
Payment made to WIPO bank account IBAN No. CH51 0483 5048 7080 8100 0 Crédit Suisse, CH-1211 Geneva 70 Swift/BIC: CRESCHZZ80A	<input type="checkbox"/> Payment identification ..... dd/mm/yyyy
Payment made to WIPO postal account (within Europe only) IBAN No. CH03 0900 0000 1200 5000 8 Swift/BIC: POFICHBE	<input type="checkbox"/> Payment identification ..... dd/mm/yyyy



CONTINUATION SHEET

No: ..... of .....

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