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| INFORMATION NOTICE NO. 11/2017 |

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

**Amendments to the Common Regulations under the Madrid Agreement and Protocol entering into force on July 1, 2017**

1. Changes to specific Rules of the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement (the Common Regulations) will enter into force on July 1, 2017.

*Control by the International Bureau of the World Intellectual Property Organization (WIPO) of the classification of limitations to the list of goods and services made in international applications (Rule 12)*

1. A new paragraph (8*bis*) in Rule 12 of the Common Regulations will require the International Bureau of WIPO, when examining an international application, to also examine limitations contained in that application. Where the International Bureau of WIPO disagrees with the classification of the goods and services listed in a limitation made in an international application, it will issue an irregularity notice, following the procedure set out in paragraphs (1)(a) and (2) to (6) of Rule 12 of the Common Regulations, which apply, *mutatis mutandis*.
2. Where the International Bureau of WIPO cannot group the goods and services listed in the limitation in the classes of the International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Classification) that appear in the main list of the international application, either as originally filed or as amended according to Rules 12(1) to (6) of the Common Regulations, and this irregularity is not remedied within three months, the limitation shall be deemed not to contain the goods and services affected by the irregularity.

*New requirement to list the goods and services in a request for the recording of a limitation according to the numbers of the classes contained in the international registration (Rules 25 to 27)*

1. A new paragraph (2)(d) of Rule 25 of the Common Regulations will require that a request for the recording of a limitation, presented under paragraph (1)(a)(ii), group the limited list of goods and services only in the corresponding classes of the Nice Classification appearing in the main list of the international registration or, where applicable, indicate the classes to be deleted.
2. In addition, an amended Rule 26(1) of the Common Regulations will specify that the International Bureau of WIPO must examine requests for the recording of a limitation to determine whether the numbers of the classes indicated in that request correspond to the numbers of the classes in the international registration.
3. Consequently, the International Bureau cannot examine a request presented under Rule 25(1)(a)(ii) of the Common Regulations to confirm that the goods and services in the limited list are properly classified nor to determine whether that limited list falls within the scope of protection in the designated Contracting Parties concerned with the recording.
4. Nonetheless, under Rule 27(5) of the Common Regulations, the Offices of the designated Contracting Parties notified of the recording of a limitation can examine the limited list and may declare that such limitation has no effect when, for example, the Office considers that such list falls outside the scope of protection in the Contracting Party concerned.

*New recording to introduce in the international registration indications concerning the legal nature of the holder or to change those indications (Rules 25 to 27, 32 and item 7.4 of the Schedule of Fees)*

1. Under Rule 9(4)(b)(ii) of the Common Regulations, when the applicant is a legal entity, it can include in the international application indications regarding its legal nature and the State, and, where applicable, the territorial unit within that State, under the laws of which it has been organized. In addition, under Rule 24(3)(c)(i) of the Common Regulations, the holder can also include these indications in a subsequent designation.
2. An amended paragraph (1)(a)(iv) of Rule 25 and consequential amendments to Rules 27 and 32 of the Common Regulations will allow holders to request a recording to either introduce indications concerning their legal nature or to change those indications once they have been recorded.
3. Holders will be able to present in one official form (MM9) a request for the recording of a change in their name, a change in their address, to introduce or change indications concerning their legal nature or any combination therefrom.
4. A consequential amendment to Item 7.4 of the Schedule of Fees specifies that the amount due for a request presented under Rule 25(1)(a)(iv) of the Common Regulations for one or more international registrations remains 150 Swiss francs, provided the same recording or change is requested in the same form.
5. The amended text of the Common Regulations and form MM9 are reproduced in Annexes I and II.

June 12, 2017

# AMENDMENTS TO THE COMMON REGULATIONS UNDER THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS AND THE PROTOCOL RELATING TO THAT AGREEMENT

Adopted on October 11, 2016, by the Assembly of the Special Union for the International Registration of Marks (Madrid Union) at its Fiftieth (29th Extraordinary) Session, held from October 3 to 11, 2016, with effect from July 1, 2017

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

(as in force on July 1, 2017)

[…]

**Chapter 2**

**International Applications**

[…]

*Rule 12*

*Irregularities With Respect to the*

*Classification of Goods and Services*

 […]

 (8*bis*)  *[Examination of Limitations]*The International Bureau shall examine limitations contained in an international application, applying paragraphs (1)(a) and (2) to (6) *mutatis mutandis*. Where the International Bureau cannot group the goods and services listed in the limitation under the classes of the International Classification of Goods and Services listed in the international application concerned, as amended pursuant to paragraphs (1) to (6), as the case may be, it shall issue an irregularity. Where the irregularity is not remedied within three months from the date of the notification of the irregularity, the limitation shall be deemed not to contain the goods and services concerned.

 […]

**Chapter 5**

**Subsequent Designations; Changes**

[…]

*Rule 25*

*Request for Recording*

 (1) *[Presentation of the Request]*  (a)  A request for recording shall be presented to the International Bureau on the relevant official form, in one copy, where the request relates to any of the following:

 […]

 (iv) a change in the name or address of the holder or, where the holder is a legal entity, an introduction of or a change in the indications concerning the legal nature of the holder and the State and, where applicable, the territorial unit within that State under the law of which the said legal entity has been organized;

 […]

 (2) *[Contents of the Request]*(a)  A request under paragraph (1)(a) shall, in addition to the requested recording, contain or indicate

 […]

 (d) The request for the recording of a limitation shall group the limited goods and services only under the corresponding numbers of the classes of the International Classification of Goods and Services appearing in the international registration or, where the limitation affects all the goods and services in one or more of those classes, indicate the classes to be deleted.

 […]

*Rule 26*

*Irregularities in Requests for Recording under Rule 25*

 (1) *[Irregular Request]*  If a request under Rule 25(1)(a) does not comply with the applicable requirements, and subject to paragraph (3), the International Bureau shall notify that fact to the holder and, if the request was made by an Office, to that Office. For the purposes of this Rule, where the request is for the recording of a limitation, the International Bureau shall only examine whether the numbers of the classes indicated in the limitation appear in the international registration concerned.

 (2) *[Time Allowed to Remedy Irregularity]*  The irregularity may be remedied within three months from the date of the notification of the irregularity by the International Bureau. If the irregularity is not remedied within three months from the date of the notification of the irregularity by the International Bureau, the request shall be considered abandoned, and the International Bureau shall notify accordingly and at the same time the holder and, if the request under Rule 25(1)(a) was presented by an Office, that Office, and refund any fees paid, after deduction of an amount corresponding to one-half of the relevant fees referred to in item 7 of the Schedule of Fees, to the party having paid those fees.

 […]

*Rule 27*

*Recording and Notification with respect to Rule 25;*

*Merger of International Registrations; Declaration That a Change in Ownership or a Limitation Has No Effect*

 (1) *[Recording and Notification]*  (a)  The International Bureau shall, provided that the request referred to in Rule 25(1)(a) is in order, promptly record the indications, the change or the cancellation in the International Register, shall notify accordingly the Offices of the designated Contracting Parties in which the recording has effect or, in the case of a cancellation, the Offices of all the designated Contracting Parties, and shall inform at the same time the holder and, if the request was presented by an Office, that Office. Where the recording relates to a change in ownership, the International Bureau shall also inform the former holder in the case of a total change in ownership and the holder of the part of the international registration which has been assigned or otherwise transferred in the case of a partial change in ownership. Where the request for the recording of a cancellation was presented by the holder or by an Office other than the Office of origin during the five-year period referred to in Article 6(3) of the Agreement and Article 6(3) of the Protocol, the International Bureau shall also inform the Office of origin.

 (b) The indications, the change or the cancellation shall be recorded as of the date of receipt by the International Bureau of a request complying with the applicable requirements, 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 7**

**Gazette and Data Base**

*Rule 32*

*Gazette*

 (1) *[Information Concerning International Registrations]*  (a)  The International Bureau shall publish in the Gazette relevant data concerning

 […]

 (vii) recordings under Rule 27;

 […]

 […]

**amendments to the Schedule of fees**

Adopted on October 11, 2016, by the Assembly of the Special Union for the International Registration of Marks (Madrid Union) at its Fiftieth (29th Extraordinary) Session, held from October 3 to 11, 2016, with effect from July 1, 2017

SCHEDULE OF FEES

(in force on July 1, 2017)

*Swiss francs*

[…]

7. *Miscellaneous recordings*

 […]

7.4 Change in the name and/or address of the holder and/or, where the holder is a legal entity, introduction of or change in the indications concerning the legal nature of the holder and the State and, where applicable, the territorial unit within that State under the law of which the said legal entity has been organized for one or more international registrations for which the same recording or change is requested in the same form  150

[…]

[Annex II follows]











[End of Annex II]