

Madrid Agreement and Protocol Concerning the International Registration of Marks

Amendments to the Common Regulations under the Madrid Agreement and Protocol in force as from November 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” and the “Madrid Protocol”) entered into force on November 1, 2017.

Publication in the WIPO Gazette of International Marks (the “WIPO Gazette”) and notification to Offices of designated Contracting Parties of recordings concerning representation before the International Bureau (Rules 3 and 32)

2. An amendment to paragraph (4)(b) of Rule 3 of the Common Regulations requires the International Bureau of WIPO to notify Offices of the designated Contracting Parties the recording of the appointment of a representative. In addition, a new paragraph 6(f) of the same Rule also requires the International Bureau of WIPO to notify the above-mentioned Offices the cancellation of such recording.

3. A new item (xiii) in paragraph (1)(a) of Rule 32 of the Common Regulations requires the International Bureau of WIPO to publish in the WIPO Gazette the recording of the appointment of a representative and the cancellation thereof.

Voluntary description of the mark in the international application or in a subsequent designation (Rule 9)

4. An amendment to paragraph (4)(a)(xi) of Rule 9 of the Common Regulations requires the applicant to include in the international application the description of the mark contained in the basic application or basic registration (basic mark), as the case may be, only when the Office of origin so requires. In that case, this description will still be subject to certification by the Office of origin, in accordance with paragraph (5)(d)(iii) of the same Rule.

5. A new paragraph (4)(b)(vi) of Rule 9 of the Common Regulations allows applicants to include in the international application any description of the mark. This voluntary description can be included in the international application in addition to the description contained in the basic mark, when so required by the Office of origin under paragraph (4)(a)(xi) of the same Rule.

6. When the Office of origin does not require the applicant to include in the international application the description contained in the basic mark, the applicant can include this as the voluntary description. A voluntary description included in the international application under paragraph (4)(b)(vi) of Rule 9 will not be subject to certification by the Office of origin.

7. Moreover, in accordance with paragraph (3)(c)(i) of Rule 24, the holder of an international registration can include a voluntary description of the mark in a subsequent designation, provided such description was not included in the international registration or in a previously recorded subsequent designation.

8. The International Bureau of WIPO will disregard a voluntary description included in a subsequent designation when such description has been already registered or recorded in the International Register for the mark concerned. In that case, the Offices of the subsequently designated Contracting Parties will be notified of the international registration with the description or descriptions already contained in that registration.

Statements of further decisions that affect the protection of the mark (Rule 18ter)

9. An amendment to paragraph (4) of Rule 18ter of the Common Regulations allows Offices of the designated Contracting Parties to send to the International Bureau of WIPO a statement under this paragraph when there is a further decision, by the Office or other authority, that affects the protection of the mark and either one of the following two facts has happened:

- (a) the applicable refusal period under Article 5(2) of the Madrid Protocol has expired without the Office sending a notification of provisional refusal; or,
- (b) the Office has sent a statement under paragraph (1), (2) or (3) of the same Rule.

10. Before November 1, 2017, Offices could only send a statement of further decision after sending a statement under either paragraph (2) or (3) of Rule 18ter. With the entry into force of these amendments, Offices are now able to send a statement of further decision after sending a statement under paragraph (1) of Rule 18ter or when the mark is deemed protected in accordance with Articles 4(1)(a) and 5(5) of the Madrid Protocol.

11. Offices of the designated Contracting Parties must continue to notify the International Bureau of WIPO under Rule 19 of the Common Regulations when the competent authorities pronounce the invalidation of the effects of the international registration in that Contracting Party, in accordance with Article 5(6) of the Madrid Protocol, and such decision is not subject to appeal.

Final decisions upholding the effects of the basic mark (Rule 22(1)(c))

12. Under paragraph (1)(b) of Rule 22 of the Common Regulations, the Office of origin must notify the International Bureau of WIPO of a proceeding that may result in the ceasing of effect of the basic mark, when such proceeding started before the expiry of the five-year period referred to in paragraph (2) of Article 6 of the Madrid Protocol but it has not yet, at the expiry of such period, resulted in a final decision, a withdrawal or a renunciation referred to in paragraph (3) of the same Article.

13. Moreover, under paragraph (1)(c) of Rule 22, the Office of origin must notify the International Bureau of WIPO once the said proceeding results in the abovementioned final decision, withdrawal or renunciation and the basic mark has ceased to have effect.

14. An amendment to the aforesaid paragraph (1)(c) requires that, for the sake of legal certainty, the Office of origin also notify the International Bureau of WIPO once the proceeding has been completed and results in a final decision that upholds the effects of the basic mark.

Cancellation of international registrations resulting from the recording of a partial change in ownership following the ceasing of effect of the basic mark (Rule 22(2)(b))

15. An amendment to paragraph (2)(b) of Rule 22 of the Common Regulations requires the International Bureau of WIPO to cancel, to the applicable extent, international registrations resulting from a partial change in ownership recorded under an international registration that has been cancelled at the request of the Office of origin in accordance with this Rule. The same will apply to international registrations resulting from the merger of the former.

Communications from the Offices of the designated Contracting Parties sent through the International Bureau of WIPO (Rule 23bis)

16. A new Rule 23bis of the Common Regulations allows the Office of a designated Contracting Party to send communications that concern an international registration but are not covered by the Common Regulations through the International Bureau of WIPO, provided the law of that Contracting Party does not allow the Office to transmit such communications directly to the holder.

17. Offices of the designated Contracting Parties are required to send communications under the new Rule to the International Bureau of WIPO exclusively through the Madrid Office Portal (MOP), a secure online service to exchange communications between those Offices and the International Bureau of WIPO. The International Bureau of WIPO will transmit the above-mentioned communications to the holder without examining their contents or recording them in the International Register.

Possibility to record a subsequent designation when an irregularity concerning a declaration of intention to use the mark, as required by certain Contracting Parties, is not remedied (Rule 24)

18. An amendment to paragraph (5)(c) of Rule 24 of the Common Regulations allows the International Bureau of WIPO to record a subsequent designation when an irregularity concerning the requirement to make a declaration of intention to use the mark in a separate official form is not remedied within the applicable time-limit in respect to one or more Contracting Parties. In that case, the subsequent designation will be deemed not to contain the designation of those Contracting Parties and the International Bureau of WIPO will reimburse any complementary or individual fee paid in respect of them.

19. Notwithstanding the above, if the aforesaid irregularity is not remedied and no other designated Contracting Party remains, the subsequent designation will be considered abandoned and the International Bureau of WIPO will refund any fees paid, after the deduction of an amount corresponding to one-half of the basic fee, in accordance with paragraph (5)(b) of the same Rule.

20. Currently, the United States of America is the only Contracting Party that requires a declaration of intention to use the mark in its territory to be made in an official form, namely, form MM18.

Request for the recording of a change in the name or address of the representative (Rule 25)

21. A new item (vi) in paragraph (1)(a) of Rule 25 of the Common Regulations, as well as a consequential amendment to item (ii) of paragraph (2)(a) of the same Rule, introduce, as one of the recordings that can be requested under this Rule, the recording of a change in the name or address of the representative.

22. As a result of the above, representatives wishing to request the recording of a change in their name or address will be required to use official form MM10 to present this request. Moreover, this recording will be notified to the Offices of the designated Contracting Parties, in accordance with Rule 27(1)(a), and published in the WIPO Gazette, in accordance with Rule 32(1)(a)(vii).

Recording of partial change in ownership (Rule 27)

23. Paragraph (2) of Rule 27 of the Common Regulations, which provided for the creation of a new international registration following the recording of a partial change in ownership and established the numbering of such registration, was deleted in an amendment to the Common Regulations that entered into force on April 1, 2002. It then became Section 16 of the Administrative Instructions for the Application of the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to Thereto (the Administrative Instructions).

24. The above-mentioned paragraph has been reintroduced and Section 16 of the Administrative Instructions has been amended to deal exclusively with the numbering of international registrations. These amendments do not change the way in which a partial change in ownership is recorded.

25. The amended text of the Common Regulations is reproduced in the Annex.

November 9, 2017

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

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

(as in force on [November 1, 2017](#))

LIST OF RULES

[...]

**Chapter 1
General Provisions**

[...]

Rule 3

Representation Before the International Bureau

[...]

(4) *[Recording and Notification of Appointment of a Representative; Effective Date of Appointment]*

[...]

(b) The International Bureau shall notify the recording referred to in subparagraph (a) to both the applicant or holder and, in the ~~representative~~ latter case, the Offices of the designated Contracting Parties, as well as the representative. Where the appointment was made in a separate communication presented through an Office, the International Bureau shall also notify the recording to that Office.

[...]

(6) *[Cancellation of Recording; Effective Date of Cancellation]*

[...]

(f) Cancellations at the request of the holder or the holder's representative shall also be notified to the Offices of the designated Contracting Parties.

[...]

Chapter 2 International Applications

[...]

Rule 9 Requirements Concerning the International Application

[...]

(4) *[Contents of the International Application]* (a) The international application shall contain or indicate

(i) the name of the applicant, given in accordance with the Administrative Instructions,

(ii) the address of the applicant, given in accordance with the Administrative Instructions,

(iii) the name and address of the representative, if any, given in accordance with the Administrative Instructions,

(iv) where the applicant wishes, under the Paris Convention for the Protection of Industrial Property, to take advantage of the priority of an earlier filing, a declaration claiming the priority of that earlier filing, together with an indication of the name of the Office where such filing was made and of the date and, where available, the number of that filing, and, where the earlier filing relates to less than all the goods and services listed in the international application, the indication of those goods and services to which the earlier filing relates,

(v) a reproduction of the mark that shall fit in the box provided on the official form; that reproduction shall be clear and shall, depending on whether the reproduction in the basic application or the basic registration is in black and white or in color, be in black and white or in color,

(vi) where the applicant wishes that the mark be considered as a mark in standard characters, a declaration to that effect,

(vii) where color is claimed as a distinctive feature of the mark in the basic application or basic registration, or where the applicant wishes to claim color as a distinctive feature of the mark and the mark contained in the basic application or basic registration is in color, an indication that color is claimed and an indication by words of the color or combination of colors claimed and, where the reproduction furnished under item (v) is in black and white, one reproduction of the mark in color,

(vii*bis*) where the mark that is the subject of the basic application or the basic registration consists of a color or a combination of colors as such, an indication to that effect,

(viii) where the basic application or the basic registration relates to a three-dimensional mark, the indication "three-dimensional mark,"

(ix) where the basic application or the basic registration relates to a sound mark, the indication "sound mark,"

(x) where the basic application or the basic registration relates to a collective mark or a certification mark or a guarantee mark, an indication to that effect,

(xi) where the basic application or the basic registration contains a description of the mark by words and ~~the applicant wishes to include the description or~~ the Office of origin requires the inclusion of the description, that same description; where the said description is in a language other than the language of the international application, it shall be given in the language of the international application,

(xii) where the mark consists of or contains matter in characters other than Latin characters or numbers expressed in numerals other than Arabic or Roman numerals, a transliteration of that matter in Latin characters and Arabic numerals; the transliteration into Latin characters shall follow the phonetics of the language of the international application,

(xiii) the names of the goods and services for which the international registration of the mark is sought, grouped in the appropriate classes of the International Classification of Goods and Services, each group preceded by the number of the class and presented in the order of the classes of that Classification; the goods and services shall be indicated in precise terms, preferably using the words appearing in the Alphabetical List of the said Classification; the international application may contain limitations of the list of goods and services in respect of one or more designated Contracting Parties; the limitation in respect of each Contracting Party may be different,

(xiv) the amount of the fees being paid and the method of payment, or instructions to debit the required amount of fees to an account opened with the International Bureau, and the identification of the party effecting the payment or giving the instructions, and

(xv) the designated Contracting Parties.

(b) The international application may also contain,

(i) where the applicant is a natural person, an indication of the State of which the applicant is a national;

(ii) where the applicant is a legal entity, indications concerning the legal nature of that legal entity and the State, and, where applicable, the territorial unit within that State, under the law of which the said legal entity has been organized;

(iii) where the mark consists of or contains a word or words that can be translated, a translation of that word or those words into English, French and Spanish, or in any one or two of those languages;

(iv) where the applicant claims color as a distinctive feature of the mark, an indication by words, in respect of each color, of the principal parts of the mark which are in that color;

(v) where the applicant wishes to disclaim protection for any element of the mark, an indication of that fact and of the element or elements for which protection is disclaimed;

(vi) any description of the mark by words or, if the applicant so wishes, the description of the mark by words contained in the basic application or the basic registration, where it has not been provided under paragraph (4)(a)(xi).

(5) *[Additional Contents of an International Application]* (a)

[...]

(d) The international application shall contain a declaration by the Office of origin certifying

[...]

(iii) that any indication referred to in paragraph (4)(a)(vii*bis*) to (xi) and appearing in the international application appears also in the basic application or the basic registration, as the case may be,

[...]

[...]

[...]

Chapter 4
Facts in Contracting Parties
Affecting International Registrations

[...]

Rule 18ter

Final Disposition on Status of a Mark in a Designated Contracting Party

[...]

(4) *[Further Decision]* Where, a notification of provisional refusal has not been sent within the applicable time limit under Article 5(2) of the Agreement or of the Protocol, or, where following the sending of a statement ~~in accordance with either under~~ paragraph (1), (2) or (3), a further decision, taken by the Office or other authority, affects the protection of the mark, the Office shall, to the extent that it is aware of that decision, without prejudice to Rule 19, send to the International Bureau a further statement indicating the status of the mark and, where applicable, the goods and services for which the mark is protected in the Contracting Party concerned¹.

[...]

[...]

Rule 22

*Ceasing of Effect of the Basic Application,
of the Registration Resulting Therefrom,
or of the Basic Registration*

(1) *[Notification Relating to Ceasing of Effect of the Basic Application, of the Registration Resulting Therefrom, or of the Basic Registration]*

[...]

(c) Once the judicial action or proceeding referred to in subparagraph (b) has resulted in the final decision referred to in Article 6(4) of the Agreement, in the final decision referred to in the second sentence of Article 6(3) of the Protocol or in the withdrawal or renunciation referred to in the third sentence of Article 6(3) of the Protocol, the Office of origin shall, where it is aware thereof, promptly notify the International Bureau accordingly and shall give the indications referred to in subparagraph (a)(i) to (iv). Where the judicial action or proceedings referred to in subparagraph (b) has been completed and has not resulted in any of the aforesaid final decisions, withdrawal or renunciation, the Office of origin shall, where it is aware thereof or at the request of the holder, promptly notify the International Bureau accordingly.

¹

Interpretative statement endorsed by the Assembly of the Madrid Union:

“The reference in Rule 18ter(4) to a further decision that affects the protection of the mark includes also the case where that further decision is taken by the Office, for example in the case of *restitutio in integrum*, notwithstanding the fact that the Office has already stated that the procedures before the Office have been completed.”

(2) *[Recording and Transmittal of the Notification; Cancellation of the International Registration]*

[...]

(b) Where any notification referred to in paragraph (1)(a) or (c) requests cancellation of the international registration and complies with the requirements of that paragraph, the International Bureau shall cancel, to the extent applicable, the international registration in the International Register. The International Bureau shall also cancel, to the extent applicable, international registrations resulting from partial change in ownership recorded under the international registration that has been cancelled, following the above-mentioned notification, and those resulting from their merger.

[...]

[...]

Chapter 5 Subsequent Designations; Changes

[...]

Rule 23bis Communications from the Offices of the Designated Contracting Parties sent through the International Bureau

(1) [Communications from the Offices of the designated Contracting Parties not covered by these Regulations] Where the law of a designated Contracting Party does not allow the Office to transmit a communication concerning an international registration directly to the holder, that Office may request the International Bureau to transmit that communication to the holder on its behalf.

(2) [Format of the Communication] The International Bureau shall establish the format in which the communication referred to in paragraph (1) shall be sent by the Office concerned.

(3) [Transmission to the holder] The International Bureau shall transmit the communication referred to in paragraph (1) to the holder, in the format established by the International Bureau, without examining its contents or recording it in the International Register.

Chapter 5 Subsequent Designations; Changes

Rule 24 *Designation Subsequent to the International Registration*

[...]

(5) *[Irregularities]* (a) If the subsequent designation does not comply with the applicable requirements, and subject to paragraph (10), the International Bureau shall notify that fact to the holder and, if the subsequent designation was presented by an Office, that Office.

(b) If the irregularity is not remedied within three months from the date of the notification of the irregularity by the International Bureau, the subsequent designation shall be considered abandoned, and the International Bureau shall notify accordingly and at the same time the holder and, if the subsequent designation was presented by an Office, that Office, and refund any fees paid, after deduction of an amount corresponding to one-half of the basic fee referred to in item 5.1 of the Schedule of Fees, to the party having paid those fees.

(c) Notwithstanding subparagraphs (a) and (b), where the requirements of paragraphs (1)(b) or (c) or (3)(b)(i) are not complied with in respect of one or more of the designated Contracting Parties, the subsequent designation shall be deemed not to contain the designation of those Contracting Parties, and any complementary or individual fees already paid in respect of those Contracting Parties shall be reimbursed. Where the requirements of paragraphs (1)(b) or (c) or (3)(b)(i) are complied with in respect of none of the designated Contracting Parties, subparagraph (b) shall apply.

[...]

Rule 25
Request for Recording of a Change;
Request for Recording of a Cancellation

(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:

[...]

(v) cancellation of the international registration in respect of all the designated Contracting Parties for all or some of the goods and services;

(vi) a change in the name or address of the representative.

[...]

(2) *[Contents of the Request]* (a) The request for the recording of a change or the request for the recording of a cancellation shall, in addition to the requested change or cancellation, contain or indicate

[...]

(ii) the name of the holder or the name of the representative where, ~~unless~~ the change relates to the name or address of the representative,

[...]

[...]

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

[...]

(2) ~~[Deleted]~~ [Recording of Partial Change in Ownership] (a) A change in ownership of the international registration in respect of only some of the goods and services or only some of the designated Contracting Parties shall be recorded in the International Register under the number of the international registration concerned by the partial change in ownership.

(b) The part of the international registration for which a change in ownership has been recorded shall be deleted from the international registration concerned and recorded as a separate international registration.

[...]

[...]

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

[...]

(xii) international registrations which have not been renewed;

(xiii) recordings of the appointment of the holder's representative communicated under Rule 3(2)(b) and cancellations at the request of the holder or the holder's representative under Rule 3(6)(a).

[...]

(3) The International Bureau ~~Gazette~~ shall effect the publications under paragraphs (1) and (2) ~~be published~~ on the website of the World Intellectual Property Organization.

**AMENDMENTS TO THE ADMINISTRATIVE INSTRUCTIONS FOR THE APPLICATION OF
THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF
MARKS AND THE PROTOCOL RELATING THERETO**

**Administrative Instructions for the Application of the
Madrid Agreement Concerning the International
Registration of Marks and the Protocol
Relating Thereto**

(as in force on [November 1, 2017](#))

[...]

**Part Six
Numbering of International Registrations**

*Section 16: Numbering Following Partial Change
in Ownership*

(a) ~~Assignment or other transfer of the international registration in respect of only some of the goods and services or only some of the designated Contracting Parties shall be recorded in the International Register under the number of the international registration of which a part has been assigned or otherwise transferred. The separate international registration resulting from the recording of partial change in ownership shall bear the number of the registration of which a part has changed in ownership, followed by a capital letter.~~

(b) ~~[Deleted] Any assigned or otherwise transferred part shall be cancelled under the number of the said international registration and recorded as a separate international registration. The separate international registration shall bear the number of the registration of which a part has been assigned or otherwise transferred, together with a capital letter.~~

[End of Annex]