



## WORLD INTELLECTUAL PROPERTY ORGANIZATION

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### MADRID AGREEMENT AND PROTOCOL CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

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

1. At its thirty-seventh (21<sup>st</sup> extraordinary) session, which took place in Geneva from September 25, to October 3, 2006, the Assembly of the Madrid Union adopted an amendment to the Madrid Protocol and a number of amendments to the Common Regulations under the Madrid Agreement and Protocol.

#### Amendment to the Madrid Protocol

2. The amendment concerns Article 5 of the Madrid Protocol and, in particular, subparagraph (2)(c)(ii) thereof. The amended text of Article 5(2)(c)(ii), as reproduced in Part I of the Annex hereto, is a mere simplification of the current text of the subparagraph in question and does not entail any substantive modification of the existing provision.

3. Having been adopted with immediate effect, the amendment of Article 5(2)(c)(ii) of the Madrid Protocol came into force on October 3, 2006.

4. In addition, the Assembly adopted the text of an interpretative statement, to be introduced as a footnote to Article 5(2)(c)(ii) of the Madrid Protocol, to the effect that Article 5(2)(e) be understood as allowing the Assembly to undertake, at any point in time, further reviews of the operation of the refusal system established by subparagraphs (a) to (d) of Article 5 and to adopt any modification of those subparagraphs, subject to the voting requirements established by Article 5(2)(e). The text of the said interpretative statement is also reproduced in Part I of the Annex hereto.

#### Amendment to the Common Regulations

5. The amendments concern the following Rules of the Common Regulations:

- (i) Rule 1(xxvibis), concerning abbreviated expressions,
- (ii) Rule 3, concerning representation before the International Bureau,
- (iii) Rules 19 to 21, concerning the date of recording of certain communications,

- (iv) Rule 20(3), concerning the recording of restrictions,
- (v) Rule 21, concerning replacement,
- (vi) Rule 28(2), concerning corrections,
- (vii) Rule 32(3), concerning the paper form of the yearly index, and
- (viii) Rule 39, concerning the continuation of effects of international registrations.

Adopted with immediate effect

6. Having been adopted with immediate effect, the amendments to Rule 1(*xxxvibis*) and Rule 39 came into force on October 3, 2006. The amended text of those Rules is reproduced in Part II of the Annex hereto.

7. Rule 39 establishes a procedure for the continuation of effects of international registrations in certain States which have become independent and whose territory had, before independence, been part of the territory of a Contracting State to the Madrid Agreement. Prior to its amendment, Rule 39 referred only to the Madrid Agreement and not to the Protocol. This was because at the time when the Rule was adopted, the Protocol was not yet in force. The amendment makes it clear that the procedure established under Rule 39 also now applies with respect to designations made under the Protocol. Amended Rule 39 also states clearly that the Rule will not apply to a State that declared that it continued the legal personality of a Contracting Party, thus assuming all the rights and obligations of that Contracting Party.

8. The amendment of Rule 1(*xxvibis*) takes into account the provisions of Rule 39, for the purpose of defining what is meant by “Contracting Party of the holder”.

Adopted with effect from April 1, 2007

*Rule 3: Representation before the International Bureau*

9. The amendment will have the effect that no criterion shall apply with respect to the location of the address of a representative. Under the amended Rule 3(1) of the Common Regulations that address may be established regardless of the treaty – Agreement or Protocol – governing the international application, and regardless of whether the appointment of the representative takes place at the application or registration stage. From the date of coming into force of the amendment it will be possible to appoint any person to act as a representative before the International Bureau with regard to an international registration, and not necessarily a person having an address in a Contracting Party.

*Rules 19 to 21: Date of Recording of Certain Communications*

10. The amendments of these Rules follow what has, in effect, been the practice of the International Bureau with regard to the date of recording of certain communications. The amendments provide for the recording, as of the date of their receipt, of communications concerning invalidations (Rule 19), restrictions of the holder's right of disposal (Rule 20), licenses (Rule 20*bis*) and replacement of a national or regional registration (Rule 21).

*Rule 20(3): Communication to the Office of the Contracting Party of the Holder of the Fact of the Recording of a Restriction*

11. As it currently stands, Rule 20(3) does not provide for communication, by the International Bureau to the Office of the Contracting Party of the holder, of the fact of the recording of a restriction, when such Office was not the Office which had requested the recording of the restriction. The amendment will supplement Rule 20(3) by providing that the recording of a restriction of the holder's right of disposal must be communicated also to the Office of the Contracting Party of the holder.

*Rule 21: Replacement*

12. The purpose of Rule 21 is to ensure that the relevant information concerning replacement is made available in the International Register to third parties. The amendment of the Rule will broaden the scope of paragraph (1) of Rule 21 by allowing the communication by Offices to the International Bureau of information relating to other rights acquired by virtue of a replaced national or regional registration.

*Rule 28(2): Corrections*

13. At present, Rule 28(2) provides for the International Bureau to notify a correction to the holder, and additionally, to the Offices of the designated Contracting Parties where the correction has effect. In line with the practice already adopted by the International Bureau, the amendment of Rule 28 will provide that a correction in the International Register must be communicated by the International Bureau also to the Office that requested such correction, where such Office is not the Office of a designated Contracting Party in which the correction has effect.

*Rule 32(3): Paper Form of the Yearly Index*

14. The amendment will consist of the deletion of subparagraph (3) of Rule 32. This will relieve the International Bureau of the requirement to publish, on an annual basis, an index indicating the names of the holders of the international registrations published in the *WIPO Gazette of International Marks* each year. As previously, this information will continue to be available on both the on-line and CD-ROM versions of the *WIPO Gazette of International Marks*.

15. The amended text of Rules 3, 19, 20, 20*bis*, 21, 28 and 32 of the Common Regulations is reproduced in Part III of the Annex hereto.



Part I

**Protocol Relating to the Madrid Agreement  
Concerning the International Registration  
of Marks**

adopted at Madrid on June 27, 1989  
and amended on October 3, 2006

**Article 5**

**Refusal and Invalidation of Effects of International Registration  
in Respect of Certain Contracting Parties**

(1) [...]

(2)(a)[...]

(b) [...]

(c) Such declaration may also specify that, when a refusal of protection may result from an opposition to the granting of protection, such refusal may be notified by the Office of the said Contracting Party to the International Bureau after the expiry of the 18-month time limit. Such an Office may, with respect to any given international registration, notify a refusal of protection after the expiry of the 18-month time limit, but only if

(i) [...]

(ii) the notification of the refusal based on an opposition is made within a time limit of one month from the expiry of the opposition period and, in any case, not later than seven months from the date on which the opposition period begins.

(d) [...]

(e) Upon the expiry of a period of ten years from the entry into force of this Protocol, the Assembly shall examine the operation of the system established by subparagraphs (a) to (d). Thereafter, the provisions of the said subparagraphs may be modified by a unanimous decision of the Assembly\*.

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\* Interpretative statement adopted by the Assembly of the Madrid Union:

“Article 5(2)(e) of the Protocol is understood as allowing the Assembly to keep under review the operation of the system established by subparagraphs (a) to (d), it being also understood that any modification of those provisions shall require a unanimous decision of the Assembly.”

Part II

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

(as in force on October 3, 2006)

**Chapter 1  
General Provisions**

*Rule 1  
Abbreviated Expressions*

For the purposes of these Regulations,

[...]

- (xxvibis) “Contracting Party of the holder” means
- the Contracting Party whose Office is the Office of origin, or
  - where a change of ownership has been recorded or in the case of State succession, the Contracting Party, or one of the Contracting Parties, in respect of which the holder fulfills the conditions, under Articles 1(2) and 2 of the Agreement or under Article 2 of the Protocol, to be the holder of an international registration;

[...]

**Chapter 9  
Miscellaneous**

*Rule 39  
Continuation of Effects of International Registrations  
in Certain Successor States*

(1) Where any State (“the successor State”) whose territory was, before the independence of that State, part of the territory of a Contracting Party (“the predecessor Contracting Party”) has deposited with the Director General a declaration of continuation the effect of which is that the Agreement, the Protocol, or both the Agreement and the Protocol are applied by the successor State, the effects in the successor State of any international registration with a territorial extension to the predecessor Contracting Party which is effective from a date prior to the date fixed under paragraph (2) shall be subject to

(i) the filing with the International Bureau, within six months from the date of a notice addressed for that purpose by the International Bureau to the holder of the international registration concerned, of a request that such international registration continue its effects in the successor State, and

(ii) the payment to the International Bureau, within the same time limit, of a fee of 41 Swiss francs, which shall be transferred by the International Bureau to the Office of the successor State, and of a fee of 23 Swiss francs for the benefit of the International Bureau.

(2) The date referred to in paragraph (1) shall be the date notified by the successor State to the International Bureau for the purposes of this Rule, provided that such date may not be earlier than the date of independence of the successor State.

(3) The International Bureau shall, upon receipt of the request and the fees referred to in paragraph (1), notify the Office of the successor State and make the corresponding recording in the International Register.

(4) With respect to any international registration concerning which the Office of the successor State has received a notification under paragraph (3), that Office may only refuse protection if the applicable time limit referred to in Article 5(2) of the Agreement or in Article 5(2)(a), (b) or (c) of the Protocol has not expired with respect to the territorial extension to the predecessor Contracting Party and if the notification of refusal is received by the International Bureau within that time limit.

(5) This Rule shall not apply to the Russian Federation, nor to a State which has deposited with the Director General a declaration according to which it continues the legal personality of a Contracting Party.

**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, 2007)

[...]

**Chapter 1  
General Provisions**

[...]

*Rule 3*

*Representation Before the International Bureau*

(1) *[Representative; Number of Representatives]* (a) The applicant or the holder may have a representative before the International Bureau.

(b) The applicant or the holder may have one representative only. Where the appointment indicates several representatives, only the one indicated first shall be considered to be a representative and be recorded as such.

(c) Where a partnership or firm composed of attorneys or patent or trademark agents has been indicated as representative to the International Bureau, it shall be regarded as one representative.

(2) *[Appointment of the Representative]* [...]

(3) *[Irregular Appointment]* (a) Where the International Bureau considers that the appointment of a representative under paragraph (2) is irregular, it shall notify accordingly the applicant or holder, the purported representative and, if the sender or transmitter is an Office, that Office.

(b) As long as the relevant requirements under paragraph (2) are not complied with, the International Bureau shall send all relevant communications to the applicant or holder himself.

[...]



**Chapter 4**  
**Facts in Contracting Parties**  
**Affecting International Registrations**

[...]

*Rule 19*  
*Invalidations in Designated Contracting Parties*

- (1) *[Contents of the Notification of Invalidation]* [...]
- (2) *[Recording of the Invalidation and Information to the Holder and the Office Concerned]* (a) [...]  
(b) The invalidation shall be recorded as of the date of receipt by the International Bureau of a notification complying with the applicable requirements.

*Rule 20*  
*Restriction of the Holder's Right of Disposal*

- (1) *[Communication of Information]* [...]
- (2) *[Partial or Total Removal of Restriction]* [...]
- (3) *[Recording]* (a) The International Bureau shall record the information communicated under paragraphs (1) and (2) in the International Register and shall inform accordingly the holder, the Office of the Contracting Party of the holder and the Offices of the designated Contracting Parties concerned.  
(b) The information communicated under paragraphs (1) and (2) shall be recorded as of the date of its receipt by the International Bureau, provided that the communication complies with the applicable requirements.

*Rule 20bis*  
*Licenses*

- (1) *[Request for the Recording of a License]* [...]
- (2) *[Irregular Request]* [...]
- (3) *[Recording and Notification]* (a) [...]  
(b) The license shall be recorded as of the date of receipt by the International Bureau of a request complying with the applicable requirements.
- (4) *[Amendment or Cancellation of the Recording of a License]* [...]

- (5) *[Declaration that the Recording of a Given License has no Effect]* [...]
- (a) [...]
  - (b) [...]
  - (c) [...]
  - (d) The International Bureau shall record in the International Register any declaration made in accordance with subparagraph (c) and shall notify accordingly the party (holder or Office) that presented the request to record the license. The declaration shall be recorded as of the date of receipt by the International Bureau of a communication complying with the applicable requirements.
  - (e) [...]
- (6) *[Declaration That the Recording of Licenses in the International Register Has No Effect in a Contracting Party]* [...]

*Rule 21*  
*Replacement of a National or Regional Registration*  
*by an International Registration*

- (1) *[Notification]* [...]
- (i) [...]
  - (ii) [...]
  - (iii) [...]

The notification may also include information relating to any other rights acquired by virtue of that national or regional registration, in a form agreed between the International Bureau and the Office concerned.

- (2) *[Recording]* (a) [...]
- (b) The indications notified under paragraph (1) shall be recorded as of the date of receipt by the International Bureau of a notification complying with the applicable requirements.

*Rule 28*  
*Corrections in the International Register*

- (1) *[Correction]* [...]
- (2) *[Notification]* The International Bureau shall notify accordingly the holder and, at the same time, the Offices of the designated Contracting Parties in which the correction has effect. In addition, where the Office that has requested the correction is not the Office of a designated Contracting Party in which the correction has effect, the International Bureau shall also inform that Office.
- (3) *[Refusal Following a Correction]* [...]
- (4) *[Time Limit for Correction]* [...]
- [...]

**Chapter 7**  
**Gazette and Data Base**

*Rule 32*  
*Gazette*

- (1) *[Information Concerning International Registrations] [...]*
- (2) *[Information Concerning Particular Requirements and Certain Declarations of Contracting Parties] [...]*
- (3) *[Number of Copies for Offices of Contracting Parties] [...]*