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MADRID AGREEMENT AND PROTOCOL CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

Amendment of the Common Regulations under the Madrid Agreement and Protocol

New Rule *1bis*

1. At its thirty-eighth (17th ordinary) session, which took place in Geneva from September 24 to October 3, 2007, the Assembly of the Madrid Union approved an amendment to the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement, providing for the inclusion of a new Rule *1bis*, along with a number of consequential amendments to the Common Regulations¹.
2. These amendments will come into effect on January 1, 2008.

New Rule *1bis*

3. The aim of the new Rule is to provide, under certain circumstances, for a change as to the treaty applicable (either the Madrid Agreement or the Madrid Protocol) to the recorded designation of a Contracting Party.
4. In particular, the new Rule *1bis* will apply in certain cases of change in ownership², or in the event that a Contracting Party bound by both the Agreement and the Protocol

¹ For further information concerning the adoption of new Rule *1bis*, please refer to Assembly document MM/A/38/1, which can be found on the WIPO website at: http://www.wipo.int/edocs/mdocs/govbody/en/mm_a_38/mm_a_38_1.pdf.

² A change of the applicable treaty, following certain types of change in ownership, had already been an established practice under the Common Regulations. Thus, for example, X, whose Office of origin is in Contracting Party A, bound by the Agreement and Protocol, is the recorded holder of an international registration designating Contracting Party B, also bound by the two treaties. That designation of Contracting Party B is governed by the Agreement (by virtue of the safeguard clause). X transfers the international registration to Y, whose entitlement to be recorded as holder is through Contracting Party C, bound only by the Protocol. Following the recording of the change in ownership from X to Y, the designation of Contracting Party B will no longer be governed by the Agreement, but instead by the Protocol.

denounces one of these two treaties³, and finally, as far as paragraph (1)(i) of the new Rule is concerned, following the repeal of the safeguard clause⁴.

5. New Rule *1bis*, paragraph (1), sets out the conditions under which a designation which, as a matter of principle, is governed by the treaty (Agreement or Protocol) under which it was made (in the international application or subsequent to the international registration) may become governed by the other of the two treaties. Item (i) thereof provides for a change of the treaty governing a designation from the Agreement to the Protocol, and item (ii) provides for a change of the treaty governing a designation from the Protocol to the Agreement.

6. Under the new Rule, the first condition for a change of the applicable treaty to occur in respect of a given recorded designation is that the treaty originally applicable ceases to apply in relations between the Contracting Party of the holder and the designated Contracting Party.

7. The second condition is that, on the date on which the treaty theretofore applicable ceases to apply, both Contracting Parties are bound by the other treaty. It is, however, not necessary that these two Contracting Parties had been already bound by that other treaty on the date of effect of the designation concerned.

8. The change of the applicable treaty takes place at the moment when the above conditions are met. Paragraph (2) of the new Rule ensures that the identity of the treaty governing the designation, as a result of the application of Rule *1bis*, will be reflected in the data accessible to Offices and third parties.

Consequential Amendments

Rule 1(xvii) and (xviii)

9. In order to clearly distinguish the treaty governing a given designation at a given time from the treaty under which the designation was originally made in the international application or subsequent to the international registration, items (xvii) and (xviii) of current Rule 1 have also been amended in order to redefine the expressions “Contracting Party designated under the Agreement” and “Contracting Party designated under the Protocol”. Following the amendment of these items, those expressions, which are both used in Rule *1bis*, will refer exclusively to the treaty under which a designation was originally made.

10. It should be noted that, as a consequence of the amendment of items (xvii) and (xviii) of current Rule 1, the period of refusal applicable to a recorded designation will not be affected by a change of the applicable treaty under Rule *1bis*. This results from the fact that the application of paragraph (1) or of paragraph (2) of Rule 18 (dealing with irregular notifications of provisional refusal) is dependent on the expressions “Contracting Party designated under the Agreement” and “Contracting Party designated under the Protocol”.

³ In this regard, see also Information Notice No. 5/2007 concerning the denunciation of the Madrid Agreement by Uzbekistan, which will take effect on January 1, 2008.

⁴ It will be recalled that, at the same session, the Madrid Union Assembly approved an amendment to Rule *9sexies* of the Protocol, the effect of which is the repeal of the safeguard clause, with effect from September 1, 2008. This is the subject of separate Information Notice No. 18/2007.

Rule 1(xvii bis)

11. Current item (xvii bis) of Rule 1 defines the expression “Contracting Party whose designation is governed by the Agreement” by reference to the situation where a change in ownership has been recorded in the International Register. It is thus too narrow to take into account all the possible circumstances leading to a change of the applicable treaty under new Rule 1 bis, as noted in paragraph 4, above. However, to the extent that the latter provision clearly establishes what should be understood by this expression, the Assembly has approved an amendment aimed at the deletion of this item, effective January 1, 2008.

Rule 25(1)(c) (Presentation of a Request for the Recording of a Cancellation or Renunciation)

12. Pursuant to Rule 25(1)(c), where a renunciation or a cancellation affects a Contracting Party whose designation is governed by the Agreement, the request must be presented to the International Bureau through the Office of the Contracting Party of the holder. Pursuant to Rule 26(3), when this aforementioned condition is not complied with, the request is not considered as such by the International Bureau. In contrast, where all the designations affected are governed by the Protocol, the request may, at the holder’s option, be presented directly to the International Bureau.

13. The purpose of the amendment to Rule 25(1)(c) is one of certainty: it will ensure that requests that should not be considered as such for the reason indicated in the previous paragraph will not become suddenly admissible following a change as to the applicable treaty, and that, conversely, those presented directly to the International Bureau will not be disregarded simply because, during their processing, the designation (or one of the designations) affected converted into a designation under the Agreement.

Rule 30(4) (Details Concerning Renewals – Period for Which Renewal Fees are Paid)

14. This amendment is consequential to the amendment of items (xvii) and (xviii) of Rule 1. It substitutes the expressions “Contracting Party whose designation is governed by the [Agreement/Protocol]” for the expressions “Contracting Party designated under the [Agreement/Protocol]”.

15. The text of Rule 1 bis and of the provisions, as amended, is reproduced in the Annex hereto.

November 16, 2007

ANNEX

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, 2008)

LIST OF RULES

Chapter 1: General Provisions

[...]

Rule *1bis*: Designations Governed by the Agreement and Designations Governed by the Protocol

[...]

Chapter 1
General Provisions

Rule 1
Abbreviated Expressions

For the purposes of these Regulations,

[...]

(xvii) “Contracting Party designated under the Agreement” means a Contracting Party for which the extension of protection (“territorial extension”) has been requested under Article *3ter*(1) or (2) of the Agreement;

(xviii) “Contracting Party designated under the Protocol” means a Contracting Party for which the extension of protection (“territorial extension”) has been requested under Article *3ter*(1) or (2) of the Protocol;

[...]

Rule 1bis

Designations Governed by the Agreement and Designations Governed by the Protocol

(1) *[General Principle and Exceptions]* The designation of a Contracting Party shall be governed by the Agreement or by the Protocol depending on whether the Contracting Party has been designated under the Agreement or under the Protocol. However,

(i) where, with regard to a given international registration, the Agreement ceases to be applicable in the relations between the Contracting Party of the holder and a Contracting Party whose designation is governed by the Agreement, the designation of the latter shall become governed by the Protocol as of the date on which the Agreement so ceases to be applicable, insofar as, on that date, both the Contracting Party of the holder and the designated Contracting Party are parties to the Protocol, and

(ii) where, with regard to a given international registration, the Protocol ceases to be applicable in the relations between the Contracting Party of the holder and a Contracting Party whose designation is governed by the Protocol, the designation of the latter shall become governed by the Agreement as of the date on which the Protocol so ceases to be applicable, insofar as, on that date, both the Contracting Party of the holder and the designated Contracting Party are parties to the Agreement.

(2) *[Recording]* The International Bureau shall record in the International Register an indication of the treaty governing each designation.

[...]

Chapter 5

Subsequent Designations; Changes

[...]

Rule 25

*Request for Recording of a Change;
Request for Recording of a Cancellation*

(1) *[Presentation of the Request]* [...]

(c) The request for the recording of a renunciation or a cancellation may not be presented directly by the holder where the renunciation or cancellation affects any Contracting Party whose designation is, on the date of receipt of the request by the International Bureau, governed by the Agreement.

[...]

Chapter 6 Renewals

[...]

Rule 30 Details Concerning Renewal

[...]

(4) *[Period for Which Renewal Fees Are Paid]* The fees required for each renewal shall be paid for ten years, irrespective of the fact that the international registration contains, in the list of designated Contracting Parties, only Contracting Parties whose designation is governed by the Agreement, only Contracting Parties whose designation is governed by the Protocol, or both Contracting Parties whose designation is governed by the Agreement and Contracting Parties whose designation is governed by the Protocol. As regards payments under the Agreement, the payment for ten years shall be considered to be a payment for an instalment of ten years.

[End of Annex]