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MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS AND PROTOCOL RELATING THERETO

Amendment of the Common Regulations

1. During its 33rd session (September 24 to October 3, 2001), the Assembly of the Madrid Union adopted a number of amendments to the Common Regulations under the Madrid Agreement and Protocol. A marked-up document showing all these changes vis-à-vis the text of the Regulations as in force before these amendments is available on the “International Marks” page on the WIPO website (wipo.int). Certain of these amendments entered into force on October 4, 2001; the rest will enter into force on April 1, 2002.

Amendments that entered into force on October 4, 2001

Rule 7

2. Paragraph (1) of Rule 7 (which provides for the possibility for a Contracting Party to notify the Director General that it requires subsequent designations made under the Protocol to be presented through its Office when it is the Office of origin) has been deleted. In consequence, no further notification may be made under this provision. The notifications already made by six Contracting Parties (Czech Republic, Germany, Italy, Lithuania, Slovakia and Sweden) remain effective, though the Assembly recommended that they should take steps to withdraw them and several of them have indicated that they expect to do so in the near future.

Rule 34

3. Rule 34 (which concerns the amounts and payment of fees) has been amended, in particular by the introduction of new paragraph (3) which provides for a Contracting Party that makes or has made a declaration under Article 8(7) of the Protocol (requiring the payment of an individual fee) to notify the Director General that the individual fee payable in respect of a designation of that Contracting Party comprises two parts, the first part to be paid at the time of filing the international application or subsequent designation and the second part to be paid at a later date determined in accordance with the law of that Contracting Party (in practice, when the Office is satisfied that the mark qualifies for protection). This proposal was made at the request of the Office of Australia and is intended to take account of the fact that a person who applies for the registration of a trademark with that Office (or with the Office of some other actual or potential Contracting Parties) must pay an application fee at the time of filing and, if the application is accepted, a registration fee.

4. As soon as a notification is made under Rule 34(3), a further information notice will be issued explaining its practical consequences.

Amendments that will enter into force on April 1, 2002

5. The following are the most significant changes (for further details, the reader is referred to the marked-up document mentioned in paragraph 1):

(a) several new definitions will be included in Rule 1, including a definition of “Contracting Party of the holder”; this will enable the term “interested Office”, which is not at present defined and is widely misunderstood, to be replaced by “Office of the Contracting Party of the holder” in several rules;

(b) Rule 9 (which relates *inter alia* to the contents of the international application) will be simplified; provision will also be made for the applicant to indicate that the mark consists of a color or a combination of colors as such and to include a disclaimer in respect of one or more elements of the mark;

(c) Rule 15 (which relates to the date of the international registration) will be simplified and the number of irregularities that may affect the said date will be reduced from seven to four;

(d) Rule 17 (which concerns refusal of protection) will be extensively revised; paragraph (1) will make clear that the initial notification of refusal is provisional and that it may be based on grounds raised *ex officio* or on an opposition or both; paragraph (4)(b)(i) (which provides for the communication of information relating to the fact that an appeal against the refusal has been filed or has not been filed or has been withdrawn) will be deleted, since experience has shown that this provision is implemented unevenly by Offices and is interpreted differently by different Offices; paragraph (4)(b)(ii) (which concerns the notification of final decisions) will be replaced by a new paragraph (5), providing for the Office of a designated Contracting Party to send a statement indicating the goods and services for which the mark is protected once all procedures before the Office have been completed and to send a further statement where a further decision affecting the protection of the mark is taken (for example by an external appeal board or a court);

(e) Rule 18 (which relates to irregular notifications of refusal) will be revised; in particular, where a notification of refusal is received in due time but is irregular on formal grounds, the International Bureau will, in general, nonetheless record and publish the refusal; it will invite the Office that sent it to send a rectified notification within two months (as is the case at present) but there will be no legal consequences if no rectified notification is received within this period; where however the irregularity is that the required information concerning the remedies available to the holder is missing, the irregular notification will not be recorded and, unless rectified, will not be considered as a notification of refusal;

(f) Rule 20 (which concerns the notification and recording of a restriction on the holder’s right to dispose of the international registration) will be amended to allow the holder or the Office of the Contracting Party of the holder to request the recording of such a restriction in respect of the international registration with regard to all or some of the designated Contracting Parties;

(g) Rule 20*bis* is new and provides for the recording of licenses in respect of international registrations, it being understood that the sole purpose of including this provision is to enable holders of international registrations or their licensees to record licenses in the International Register if they so wish and does not introduce any obligation to do so (at the moment recording can only be made in the Register of each of the designated Contracting Parties concerned); the Schedule of Fees will be amended to provide for a fee of 177 Swiss francs to be payable for the recording of a license or for the amendment of the recording of a license;

(h) Rule 25 (dealing with requests to record a change relating to an international registration) will be amended to allow a request to record a change in ownership or a limitation in the list of goods and services to be presented directly to the International Bureau by the holder even where the change affects Contracting Parties designated under the Agreement;

(i) Rule 28 (which relates to corrections in the International Register) will be amended to provide for a time limit (of nine months) for requesting the correction of an error in the International Register which is attributable to an Office where the correction of the error would affect the rights deriving from the international registration; in addition, paragraph (3) will be amended to make clear that it relates to the right of an Office to notify a refusal in respect of *the international registration as corrected*;

(j) Rule 41 is new and provides for the establishment of Administrative Instructions (as is already the case under the Hague Agreement and the Patent Cooperation Treaty) in order to deal with matters which need to be specified in the interests of transparency and legal certainty but which are too detailed and not sufficiently substantive to warrant inclusion in the Regulations themselves.

6. The Assembly also adopted five interpretative statements concerning certain of the new provisions. These statements will be included as footnotes in the published text of the Regulations.

7. Further information notices concerning the practical consequences of these changes and the establishment of Administrative Instructions will be issued early in 2002.

October 15, 2001