

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)

2. A new paragraph (8bis) 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*.

3. 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)

4. 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.

5. 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.

6. 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.

7. 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)

8. 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.

9. 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.

10. 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.

11. 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.

12. 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*

[...]

(8bis) [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]

MM9(E)

MADRID AGREEMENT AND PROTOCOL CONCERNING
THE INTERNATIONAL REGISTRATION OF MARKS

**REQUEST FOR THE RECORDING OF A CHANGE IN THE NAME OR ADDRESS OF THE HOLDER OR,
WHERE THE HOLDER IS A LEGAL ENTITY, FOR THE RECORDING TO INTRODUCE OR CHANGE
INDICATIONS CONCERNING ITS LEGAL NATURE**

(Rule 25 of the Common Regulations)

IMPORTANT

1. Holders may present this request directly to the International Bureau or through the Office of the Contracting Party of the holder.
2. This form is to be used only to request the recording or change of indications concerning the currently recorded holder. Please, use form MM5 if you want to request the recording of a change in ownership of the international registration.
3. Holders should also take this opportunity to provide or update their contact details (address for correspondence, email address and telephone and fax numbers). However, holders wishing to change their contact details only may request so, free of charge, by sending a simple letter to the International Bureau, signed by them or by their recorded representatives.

World Intellectual Property Organization
34, chemin des Colombettes
1211 Geneva 20, Switzerland
Tel. (Madrid Customer Service): +41 (0)22 338 8686
Fax (Madrid Registry): +41 (0)22 740 1429
e-mail: intreg.mail@wipo.int – Internet: www.wipo.int

MM9(E)

**REQUEST FOR THE RECORDING OF A CHANGE IN THE NAME OR ADDRESS OF
THE HOLDER OR, WHERE THE HOLDER IS A LEGAL ENTITY, FOR THE RECORDING
TO INTRODUCE OR CHANGE INDICATIONS CONCERNING ITS LEGAL NATURE**

<u>For use by the holder</u>	<u>For use by the Office</u>
This request contains the following number of continuation sheets: Holder's reference:	Office's reference:
1 INTERNATIONAL REGISTRATION NUMBER(S) (You may use this form for several international registrations of the same holder)	
2 NAME OF THE HOLDER (Please type the name of the holder as it is currently recorded in the International Register)	
3 CHANGE IN NAME OR ADDRESS OF THE HOLDER (Please indicate the change(s) by ticking the appropriate box(es) and providing the new name or new address) <input type="checkbox"/> New name: <input type="checkbox"/> New address:	
4 IF THE HOLDER IS A LEGAL ENTITY, RECORDING OF OR CHANGE IN THE INDICATIONS CONCERNING THE LEGAL NATURE OF THE HOLDER (Please provide both the following indications) Legal nature of the legal entity: State (country) and, where applicable, the territorial unit within that State (canton, province, state, etc.), under the laws of which the said legal entity has been organized:	

5**CHANGE IN THE HOLDER'S CONTACT INFORMATION (optional)**

If no change is requested below, the International Bureau will maintain the holder's current contact information, if any

 Delete the holder's address for correspondence or update it with the information that appears below

New address for correspondence:

.....

.....

.....

.....

 Delete the holder's phone and fax numbers or update them with the information that appears below

New telephone: New fax:

 Delete the holder's e-mail address or update it with the information that appears below

New e-mail address:

By providing an e-mail address, any further correspondence from the International Bureau related to this/these international registration(s) will be sent only electronically and, **therefore, you will no longer receive any paper correspondence**. Likewise, any further correspondence from the International Bureau related to other international applications or international registrations for which the same e-mail address has been, or will be, provided will also be sent only electronically. Please note that, for the purpose of electronic communication, there can be only one e-mail address recorded per each international registration.

6**APPOINTMENT OF A (NEW) REPRESENTATIVE (optional)**

(only complete this item if you are appointing a (new) representative)

Name:

Address:

.....

.....

.....

.....

Telephone: Fax:

E-mail address:

By providing an e-mail address, any further correspondence from the International Bureau related to this/these international registration(s) will be sent only electronically and, **therefore, you will no longer receive any paper correspondence**. Likewise, any further correspondence from the International Bureau related to other international applications or international registrations for which the same e-mail address has been, or will be, provided will also be sent only electronically. Please note that, for the purpose of electronic communication, there can be only one e-mail address recorded per each international registration.

SIGNATURE OF THE HOLDER APPOINTING THE ABOVE (NEW) REPRESENTATIVE

.....

7**SIGNATURE BY THE HOLDER AND/OR HIS REPRESENTATIVE**

Holder
(as recorded in the International Register)

Representative of the holder
(as recorded in the International Register or herein appointed)

By signing this form, I declare that I am entitled to sign it under the applicable law:

By signing this form, I declare that I am entitled to sign it under the applicable law:

Name:

Name:

Signature:

Signature:

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OFFICE OF THE CONTRACTING PARTY OF THE HOLDER PRESENTING THE REQUEST
(where this request is presented through an Office)

Name of the Office:

.....

Name and signature of the official signing on behalf of the Office:

By signing this form, I declare that I am entitled to sign it under the applicable law:

.....

.....

Name and e-mail address of the contact person in the Office:

.....

FEE CALCULATION SHEET**(a) INSTRUCTIONS TO DEBIT FROM A CURRENT ACCOUNT**

- The International Bureau is hereby instructed to debit the required amount of fees from a current account opened with the International Bureau (if this box is checked, it is not necessary to complete (b)).

Holder of the account: Account number:

Identity of the party giving the instructions:

(b) AMOUNT OF FEES

(The fee is 150 Swiss francs, irrespective of the number of international registrations listed in item 1)

Amount

(c) METHOD OF PAYMENT

Identity of the party effecting the payment:

Payment received and acknowledged by WIPO

WIPO receipt number

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Payment made to WIPO bank account
IBAN No. CH51 0483 5048 7080 8100 0
Crédit Suisse, CH-1211 Geneva 70
Swift/BIC: CRESCHZZ80A

Payment identification

dd/mm/yyyy

.....

Payment made to WIPO postal account
(within Europe only)
IBAN No. CH03 0900 0000 1200 5000 8
Swift/BIC: POFICHBE

Payment identification

dd/mm/yyyy

.....

CONTINUATION SHEET

No: of

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