

## **Madrid Protocol Concerning the International Registration of Marks**

### **Amendments to the Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks in force as from February 1, 2021**

1. At its fifty-third (23<sup>rd</sup> ordinary) and fifty fourth (31<sup>st</sup> extraordinary) sessions, the Madrid Union Assembly adopted amendments to Rules 3, 9, 21, 25 and 36 of the Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as “the Regulations”) that will enter into force on February 1, 2021.

2. The amended text of the Regulations is available in the Annex to the present Information Notice.

#### E-mail address as a prescribed indication (amendments to Rules 3, 9, 25 and 36 of the Regulations)

3. Amendments to Rules 3, 9, 25 and 36 of the Regulations will require that applicants, in the international application, new holders, in a request for the recording of a change in ownership, and representatives, appointed as such in the international application, in a request for recording or in a separate communication, indicate their electronic mail (e-mail) address.

4. The International Bureau will send all communications to applicants, holders or representatives by electronic means to the e-mail address on record. The International Bureau will continue to send communications by postal services to applicants, holders or representatives who have not indicated an e-mail address because they were not required to do so before the entry into force of the above-mentioned amendments. It will also send communications by postal services when an electronic communication fails to reach its intended recipient.

5. Failure to indicate the e-mail address of the applicant in an international application will result in an irregularity that, in accordance with Rule 11(2) of the Regulations, the applicant may remedy within three months from the date of the notification of the irregularity by the International Bureau. The international application will be considered abandoned if the applicant does not remedy the irregularity within that period. If remedied, this irregularity will not affect the date of the international registration. The new requirement applies to international applications received by the Office of origin on or after February 1, 2021.

6. Failure to indicate the e-mail address of the new holder in a request for the recording of a change in ownership will result in an irregularity that, in accordance with Rule 26 of the Regulations, the new holder may remedy within three months from the date of the notification of the irregularity by the International Bureau. The request will be considered abandoned if the new holder does not remedy the irregularity within that period. The new requirement applies to requests for recording received by the International Bureau or by the Office concerned, when presented through an Office, on or after February 1, 2021.

7. Failure to indicate the e-mail address of the representative, appointed as such in the international application, in a request for recording or in a separate communication, will result in an irregular appointment. In accordance with Rule 3(3) of the Regulations, the International Bureau will inform the applicant or holder, the purported representative and the Office concerned, if any, of this fact and will send all relevant communications only to the applicant or holder until a representative is appointed. The applicant or holder may appoint a representative in a new communication meeting the requirements prescribed in Rule 3(2) of the Regulations.

8. The new requirement applies to appointments made on or after February 1, 2021, in an international application, request for recording or as in a separate communication. An irregular appointment made in an international application or in a request for recording, while preventing the recording of the appointment, will not prevent the registration of the mark or the requested recording, as the case may be, from being effected in the International Register.

#### Principles governing replacement (amendments to Rule 21 of the Regulations)

9. Amendments to Rule 21 of the Regulations will specify the principles that govern the replacement of a national or regional registration by an international registration, as provided for in Article 4*bis*(1) of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as “the Protocol”).

10. For replacement to occur, the national or regional registration and the international registration that is replacing it must be for the same mark and in the name of the same person. Further, the international registration must cover all the goods and services concerned with replacement in the national or regional registration<sup>1</sup> and the designation of the Contracting Party concerned must take effect after the date of the said national or regional registration. The amendments acknowledge the fact that an international registration may replace more than one national or regional registration.

11. An amended paragraph (1) of Rule 21 indicates that holders may present, directly to the Office concerned, a request for this Office to take note under Article 4*bis*(2) of the Protocol as from the date of the notification by the International Bureau of the international registration or subsequent designation, as the case may be.

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<sup>1</sup> The Working Group on the Legal Development of the Madrid System for the International Registration of Marks has recommended an amendment to Rule 21(3)(d) of the Regulations that confirms that replacement may concern some only of the goods and services listed in the national or regional registration (partial replacement). Subject to its adoption by the Madrid Union Assembly, this amendment would enter into force on November 1, 2021. However, under a transitional provision in new Rule 40(7) of the Regulations, Offices would not be obliged to apply amended Rule 21(3)(d) before February 1, 2025.

12. An amended paragraph (2) of Rule 21 indicates that Offices of designated Contracting Parties may not refuse protection to the mark in an international registration based on the national or regional registration that the former has replaced; and, acknowledges that both, the national or regional registration and the international registration that has replaced it, may coexist. The amended paragraph also requires that the Office concerned examine requests made under Article 4*bis*(2) of the Protocol to determine whether the conditions in paragraph (1) of the same Article have been met; and, states that the goods and services concerned with replacement in the national or regional registration must be covered by those in the international registration. Finally, the amended paragraph clarifies that replacement is deemed to take place when the international registration takes effect in the designated Contracting Party concerned, in accordance with Article 4(1)(a) of the Protocol.

December 16, 2020

## PROPOSED AMENDMENTS TO THE REGULATIONS UNDER THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

### Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks

as in force on ~~February 1, 2020~~ [February 1, 2021](#)

#### **Chapter 1** **General Provisions**

[...]

#### **Rule 3** **Representation Before the International Bureau**

[...]

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

- (a) The appointment of a representative may be made in the international application or in a subsequent designation or in a request under Rule 25 and shall indicate the name and address, given in accordance with the Administrative Instructions, and the electronic mail address of the representative.

[...]

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

- (a) Where the International Bureau finds that the appointment of a representative complies with the applicable requirements, it shall record the fact that the applicant or holder has a representative, as well as the name, address and electronic mail address of the representative, in the International Register. In such a case, the effective date of the appointment shall be the date on which the International Bureau received the international application, subsequent designation, request or separate communication in which the representative is appointed.

[...]

[...]

## **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

[...]

(ii) the address ~~of the applicant~~, given in accordance with the Administrative Instructions, and the electronic mail address of the applicant,

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

[...]

[...]

[...]

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

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

(1) *[Request and Notification]* From the date of the notification of the international registration or of the subsequent designation, as the case may be, the holder may present directly to the Office of a designated Contracting Party a request for that Office to take note of the international registration in its Register, in accordance with Article 4bis(2) of the Protocol. Where, ~~in accordance with Article 4bis(2) of the Protocol~~ following the said request, the Office ~~of a designated Contracting Party~~ has taken note in its Register, ~~following a request made direct by the holder with that Office~~, that a national or a regional registration or registrations, as the case may be, ~~has~~ have been replaced by ~~an~~ the international registration, that Office shall notify the International Bureau accordingly. Such notification shall indicate

(i) the number of the international registration concerned,

(ii) where the replacement concerns only one or some of the goods and services listed in the international registration, those goods and services, and

- (iii) the filing date and number, the registration date and number, and, if any, the priority date of the national or regional registration or registrations which ~~has~~have been replaced by the international registration.

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

(2) *[Recording]*

- (a) The International Bureau shall record the indications notified under paragraph (1) in the International Register and shall inform the holder accordingly.
- (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.

(3) *[Further Details Concerning Replacement]*

- (a) Protection to the mark that is the subject of an international registration may not be refused, even partially, based on a national or regional registration which is deemed replaced by that international registration.
- (b) A national or regional registration and the international registration that has replaced it shall be able to coexist. The holder may not be required to renounce or request the cancellation of a national or regional registration which is deemed replaced by an international registration and should be allowed to renew that registration, if the holder so wishes, in accordance with the applicable national or regional law.
- (c) Before taking note in its Register, the Office of a designated Contracting Party shall examine the request referred to in paragraph (1) to determine whether the conditions specified in Article 4bis(1) of the Protocol have been met.
- (d) The goods and services concerned with replacement, listed in the national or regional registration, shall be covered by those listed in the international registration.
- (e) A national or regional registration is deemed replaced by an international registration as from the date on which that international registration takes effect in the designated Contracting Party concerned, in accordance with Article 4(1)(a) of the Protocol.

**Chapter 5**  
**Subsequent Designations; Changes**

[...]

**Rule 25**  
**Request for Recording**

[...]

(2) *[Contents of the Request]*

- (a) A request under paragraph (1)(a) shall, in addition to the requested recording, contain or indicate

[...]

- (iii) in the case of a change in the ownership of the international registration, the name and address, given in accordance with the Administrative Instructions, and the electronic mail address of the natural person or legal entity mentioned in the request as the new holder of the international registration (hereinafter referred to as “the transferee”),

[...]

[...]

[...]

**Chapter 8**  
**Fees**

[...]

**Rule 36**  
**Exemption From Fees**

Recording of the following shall be exempt from fees:

[...]

- (ii) any change concerning the telephone ~~and telefacsimile~~ numbers, address for correspondence, electronic mail address and any other means of communication with the applicant, ~~or~~ holder, or representative, as specified in the Administrative Instructions,

[...]

[...]

[End of Annex and of document]