

## **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 and to the Schedule of Fees in force as from November 1, 2021**

1. At its fifty-fifth (24<sup>th</sup> ordinary) session, the Madrid Union Assembly adopted amendments to Rules 3, 5, *5bis*, 21, 22, 24, 39 and 40 of the Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as “the Regulations”) and to the Schedule of Fees that will enter into force on November 1, 2021.
2. The amended text of the Regulations is available in the Annex to the present Information Notice.

#### Representation before the International Bureau

3. Amendments to Rule 3(2) and (4) of the Regulations will require that holders of international registrations appoint a representative before the International Bureau only in a separate communication, and no longer as part of a request for recording. Applicants and new holders (transferees) can continue to appoint a representative in, respectively, the international application and request for the recording of a change in ownership.
4. Consequently, the item concerning the appointment of a representative by the holder will be removed from the prescribed forms\* to request the recording of a subsequent designation (form MM4), subsequent designation resulting from conversion (form MM16), limitation (form MM6), renunciation (form MM7), cancellation (form MM8) and change in the name or address of the holder (form MM9).
5. Holders of international registrations can take advantage of official form MM12 to appoint a representative before the International Bureau. Holders can also take advantage of the [online management of representative](#) service for this purpose.

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\* All official forms (MM2 to MM24) and online services are available at the following address:  
<https://www.wipo.int/madrid/en/forms/>.

6. An amendment to Rule 3(6) will no longer require that the International Bureau send to the applicant or holder copies of all communications exchanged with a representative in the six months preceding the recording of a cancellation of the appointment requested by this representative. Holders of international registrations and their representatives can download all documents concerning their international applications and registrations from the [Madrid Portfolio Manager](#) online service.

#### Excuse in Meeting Time Limits

7. Amendments to Rule 5 of the Regulations will excuse failure by an interested party (i.e., applicants, holders, their representative and Offices) to meet a time limit specified in the Regulations to perform an action before the International Bureau due to *force majeure* situations. Such excuse will be subject to the interested party submitting to the International Bureau satisfactory evidence of the above and performing the relevant action as soon as possible or, in any case, not later than six months from the expiry of the time limit concerned.

#### Continued Processing

8. Under Rule 5*bis* of the Regulations, applicants and holders may request the continued processing of international applications and requests for recording when they miss the time limits specified therein. Amendments to Rule 5*bis*(1)(a) will provide for continued processing when applicants or holders miss the time limits specified in Rules 12(7) and 27*bis*(3)(c) of the Regulations.

9. Continued processing will be available to applicants who have missed the time limit specified in Rule 12(7) of the Regulations to pay the fees due to a classification proposal made by the International Bureau under paragraph (1) of this Rule. Continued processing will also be available in relation to the time limit specified in Rule 27*bis*(3)(c) of the Regulations to remedy an irregularity in a request for the division of an international registration made under paragraph (1) of the same rule.

10. To request continued processing, applicants and holders must use prescribed form MM20, pay the continued processing fee and, at the same time, perform the action to which the missed time limit applied. Applicants and holders may request continued processing within two months from the expiry of the time limit concerned.

#### Partial Replacement

11. An international registration replaces national or regional registration or registrations to the applicable extent. Accordingly, amendments to Rule 21(3)(d) of the Regulations will acknowledge that the partial replacement of an earlier national or regional registration or registrations by an international registration is possible. Nevertheless, a transitional provision in new paragraph (7) of Rule 40 will not require Offices to apply amended Rule 21(3)(d) before February 1, 2025.

#### Ceasing of Effect

12. Amendments to Rule 22(1)(c) of the Regulations will eliminate unnecessary references to judicial actions and proceedings, in plural, as they are no longer relevant. These editorial amendments will not result in any substantive change.

### Subsequent Designation

13. Amendments to Rule 24(3)(a)(iii) of the Regulations will simplify requests for the recording of subsequent designations by eliminating the requirement that they indicate the address of the holder. Consequently, the item concerning the address of the holder will be removed from the prescribed form to request the recording of a subsequent designation (form MM4). The [online subsequent designation](#) service will not present any noticeable change.

### Continuation of Effects

14. Proposed amendments to Rule 39(1)(ii) of the Regulations will remove from this Rule the amount of the prescribed fee for a request for the continuation of effects in a successor State. New item 10 of the Schedule of Fees will specify that amount. These editorial amendments will not result in any substantive change. Moreover, the amount of the fee will not change.

November 1, 2021

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

as in force on ~~February 1, 2021~~ November 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 by the new holder of the international registration in a request under Rule 25 (1)(a)(i) 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.

[...]

[...]

(6) *[Cancellation of Recording; Effective Date of Cancellation]*

[...]

- (d) The International Bureau shall, upon receipt of a request for cancellation made by the representative, notify accordingly the applicant or holder, ~~and add to the notification copies of all communications sent to the representative, or received by the International Bureau from the representative, during the six months preceding the date of the notification.~~

[...]

**Rule 5****~~Irregularities in Postal and Delivery Services and in Communications Sent Electronically~~Excuse in Delay in Meeting Time Limits**

- (1) ~~*[Excuse in Delay in Meeting Time Limits due to Force Majeure Reasons Communications Sent Through a Postal Service]*~~ Failure by an interested party to meet a time limit specified in the Regulations to perform an action before ~~for a communication addressed to the International Bureau and mailed through a postal service~~ shall be excused if the interested party submits evidence showing, to the satisfaction of the International Bureau, that such failure was due to war, revolution, civil disorder, strike, natural calamity, irregularities in postal, delivery or electronic communication services owing to circumstances beyond the control of the interested party or other force majeure reason.

- (i) ~~that the communication was mailed at least five days prior to the expiry of the time limit, or, where the postal service was, on any of the ten days preceding the day of expiry of the time limit, interrupted on account of war, revolution, civil disorder, strike, natural calamity, or other like reason, that the communication was mailed not later than five days after postal service was resumed,~~[Deleted]
- (ii) ~~that the mailing of the communication was registered, or details of the mailing were recorded, by the postal service at the time of mailing, and~~[Deleted]
- (iii) ~~in cases where all classes of mail do not normally reach the International Bureau within two days of mailing, that the communication was mailed by a class of mail which normally reaches the International Bureau within two days of mailing or by airmail.~~[Deleted]

- (2) ~~*[Communications Sent Through a Delivery Service]*~~ Failure by an interested party to meet a time limit for a communication addressed to the International Bureau and sent through a delivery service shall be excused if the interested party submits evidence showing, to the satisfaction of the International Bureau,[Deleted]

- (i) ~~that the communication was sent at least five days prior to the expiry of the time limit, or, where the delivery service was, on any of the ten days preceding the day of expiry of the time limit, interrupted on account of war, revolution, civil disorder, strike, natural calamity, or other like reason, that the communication was sent not later than five days after the delivery service was resumed, and~~[Deleted]
- (ii) ~~that details of the sending of the communication were recorded by the delivery service at the time of sending.~~[Deleted]

- (3) ~~*[Communication Sent Electronically]* Failure by an interested party to meet a time limit for a communication addressed to the International Bureau and submitted by electronic means shall be excused if the interested party submits evidence showing, to the satisfaction of the International Bureau, that the time limit was not met because of failure in the electronic communication with the International Bureau, or which affects the locality of the interested party owing to extraordinary circumstances beyond the control of the interested party, and that the communication was effected not later than five days after the electronic communication service was resumed.~~[\[Deleted\]](#)
- (4) *[Limitation on Excuse]* Failure to meet a time limit shall be excused under this Rule only if the evidence [and action](#) referred to in paragraph (1), ~~(2) or (3) and the communication or, where applicable, a duplicate thereof~~ are received by [and performed before](#) the International Bureau [as soon as reasonably possible and](#) not later than six months after the expiry of the time limit [concerned](#).

[...]

### **Rule 5bis** **Continued Processing**

- (1) *[Request]*
- (a) Where an applicant or holder has failed to comply with any of the time limits specified or referred to in Rules 11(2) and (3), [12\(7\)](#), [20bis\(2\)](#), [24\(5\)\(b\)](#), [26\(2\)](#), [27bis\(3\)\(c\)](#), [34\(3\)\(c\)\(iii\)](#) and [39\(1\)](#), the International Bureau shall, nevertheless, continue the processing of the international application, subsequent designation, payment or request concerned, if:
- (i) a request to that effect, signed by the applicant or holder, is presented to the International Bureau on the official form; and
  - (ii) the request is received, the fee specified in the Schedule of Fees is paid and, together with the request, all of the requirements in respect of which the time limit concerned applied are complied with, within two months from the date of expiry of that time limit.

[...]

[...]

**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, following the said request, the Office has taken note in its Register that a national or a regional registration or registrations, as the case may be, have been replaced by 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 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.

- (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. Replacement may concern only some ~~only~~ of the goods and services listed in the national or regional 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.

## Rule 22

### Ceasing of Effect of the Basic Application, of the Registration Resulting Therefrom, or of the Basic Registration

- (1) *[Notification Relating to Ceasing of Effect of the Basic Application, of the Registration Resulting Therefrom, or of the Basic Registration]*

[...]

- (c) Once the proceeding referred to in subparagraph (b) has resulted in the final decision referred to in the second sentence of Article 6(3) of the Protocol or in the withdrawal or renunciation referred to in the third sentence of Article 6(3) of the Protocol, the Office of origin shall, where it is aware thereof, promptly notify the International Bureau accordingly and shall give the indications referred to in subparagraph (a)(i) to (iv). Where the ~~judicial action or~~ proceedings referred to in subparagraph (b) has been completed and has not resulted in any of the aforesaid final decisions, withdrawal or renunciation, the Office of origin shall, where it is aware thereof or at the request of the holder, promptly notify the International Bureau accordingly.

[...]

## Chapter 5

### Subsequent Designations; Changes

## Rule 24

### Designation Subsequent to the International Registration

[...]

- (3) *[Contents]*

- (a) Subject to paragraph (7)(b), the subsequent designation shall contain or indicate

[...]

- (ii) the name ~~and address~~ of the holder,

[...]

[...]

**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 Protocol is 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

[...]

(ii) the payment to the International Bureau, within the same time limit, of ~~the fee of 41 Swiss francs~~ specified in item 10.1 of the Schedule of Fees for the International Bureau, and of the fee specified in item 10.2 of the Schedule of Fees, 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.~~

[...]

**Rule 40**  
**Entry into Force; Transitional Provisions**

[...]

(7) [Transitional Provision Relating to Partial Replacement] No Office shall be obliged to apply Rule 21(3)(d), second sentence, before February 1, 2025.

**Schedule of Fees**

as in force on ~~February 1, 2021~~ November 1, 2021

*Schedule of Fees*

*Swiss francs*

[...]

**10. Continuation of Effects**

10.1 Fee for the International Bureau 23

10.2 Fee to be transferred by the  
International Bureau to the successor  
State 41

[End of Annex and of document]