|  |  |  |
| --- | --- | --- |
|  | WIPO-E |  |
|  |
| INFORMATION NOTICE NO. 2/2023  |

**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, to the Schedule of Fees and to the Administrative Instructions for the Application of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks in force as from February 1, 2023**

1. At its fifty‑fifth (24th ordinary) session, the Madrid Union Assembly adopted amendments to Rules 9, 15, 17 and 32 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 item 2.1 of the Schedule of Fees that will enter into force on February 1, 2023. These amendments will require updating the international application form (Madrid e-Filing, Madrid Application Assistant and Form MM2).
2. In addition, the Director General of the World Intellectual Property Organization (WIPO) has modified the Administrative Instructions for the Application of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as “the Administrative Instructions”), in consultation with the Offices of the Contracting Parties. The modifications to the Administrative Instructions concern changes to Section 11, the deletion of Sections 6(b), 14 and 15(b) and the introduction of new Section 11*bis*. The modified Administrative Instructions will enter into force on February 1, 2023.
3. The amended text of the Regulations, the Schedule of Fees, the modified text of the Administrative Instructions and the updated Form MM2 are available in the Annex to the present Information Notice.

### Only one representation of the mark

1. Amendments to Rules 9(4)(a)(v) and (vii) of the Regulations will eliminate the need to provide a second representation of the mark.
2. Currently, a second representation of the mark is required when the representation of the mark in the basic application or registration (hereinafter referred to as the “basic mark”) is in black and white, and the applicant claims color as a distinctive feature of the mark in the international application. In such a case, the applicant must provide, in the international application, the representation of the mark in black and white, corresponding to the representation in the basic mark, and a second representation in color.
3. As from February 1, 2023, applicants will be required to furnish only one representation of the mark in the international application, which must be in color when the applicant claims color as a distinctive feature of the mark.
4. As a consequential amendment, Rule 32(1)(c) of the Regulations, which requires the publication of both representations furnished under the situation described in paragraph 5, above, will be deleted.
5. The amendments described above will not affect international applications filed before February 1, 2023, or the resulting international registrations. The International Bureau of WIPO will continue to process those international applications and, where applicable, it will register both representations of the mark. Likewise, international registrations with a date earlier than February 1, 2023, that have two representations of the mark, one in black and white and a second representation in color, will not be affected.

### Claim of color as a distinctive feature of the mark

1. Under Rule 9(4)(a)(vii) of the Regulations, the applicant can claim color as a distinctive feature of the mark when this claim also appears in the basic mark; otherwise, the applicant can make this claim only if the representation in the basic mark is in the color or colors that are claimed in the international application.
2. An amendment to Rule 9(4)(a)(vii) of the Regulations will also allow applicants to claim color as a distinctive feature of the mark when the basic mark is protected or meant to be protected in color, even when a corresponding color claim does not appear in the basic mark and the representation of the basic mark is not in color.
3. A consequential amendment to Rule 9(5)(d)(v) clarifies that a claim as described in paragraph 10, above, must also be certified by the Office of origin.

### New means of representing marks

1. An amendment to Rule 9(4)(a)(v) of the Regulations will replace the word “reproduction” with the word “representation”. There will be similar consequential amendments to Rules 15(1)(iii), 17(2)(v) and 32(1)(b) of the Regulations, as well as to item 2.1 of the Schedule of Fees.
2. An additional amendment to Rule 9(4)(a)(v) of the Regulations will replace the current requirement that the reproduction of the mark fit in the box provided in the international application with a new requirement to furnish the representation of the mark in or with the international application in accordance with the Administrative Instructions.
3. New Section 11*bis* of the Administrative Instructions will prescribe that applicants must provide a visual representation of the mark in or with the international application not exceeding 20 centimeters in either length or width. This new Section will also give applicants the alternative to provide a representation of the mark in a single digital file, instead of providing a visual representation of the mark in or with the international application.
4. The single digital file referred to in paragraph 14, above, can consist of a visual representation in JPEG, PNG or TIFF format; a sound recording in WAV or MP3 format not exceeding 5 MB in size; or, a motion or multimedia recording in MP4 format not exceeding 20 MB in size. The above‑mentioned single digital file must comply with the relevant WIPO Standard relating to trademark information and documentation[[1]](#footnote-2).
5. Under Rule 9(5)(d) of the Regulations, the Office of origin must continue to certify that the mark, as represented in or with the international application, is the same as the basic mark.
6. The amendments to the Regulations and the modifications to the Administrative Instructions referred to in paragraphs 12 to 14, above, will provide holders with the possibility to obtain international registrations for marks represented by a sound, motion or multimedia recording. Nevertheless, the designated Contracting Parties will continue to apply the relevant domestic legal provisions to determine whether the mark, as represented in the international registration, may be the subject of protection. For example, Contracting Parties that continue to require a graphical representation of the mark might not grant protection to marks represented by a sound recording in MP3 format.
7. Users of the Madrid System can find information on the types of marks that can be the subject of protection in the Contracting Parties of the Madrid Protocol, as well as information on further requirements and acceptable formats for the representation of the mark in the Madrid Member Profile online tool, available at: <https://www.wipo.int/madrid/memberprofiles/>.

### Representation of the mark in a notification of provisional refusal

1. Where a provisional refusal is based on an earlier mark, an amendment to Rule 17(2)(v) of the Regulations will give Offices of the designated Contracting Parties the option to either provide a representation of the earlier mark in the notification or indicate how the holder can access such representation.
2. This would be the case, where, for example, the representation of the earlier mark is a sound recording in MP3 format or a motion or multimedia recording in MP4 format. While it will not be possible for the Office to include a representation of the mark in the notification, the Office will be required to provide information on how the holder can access the representation of the earlier mark, such as, for example, a link to an online database or publication accessible to the public.

### Electronic exchange of communications with the International Bureau of WIPO[[2]](#footnote-3)

1. Amendments to Section 11 of the Administrative Instructions will prescribe that all communications with the International Bureau of WIPO be exchanged by electronic means. Consequently, Section 6(b), dealing with several documents mailed in one envelope, Section 14, dealing with the date of sending of notifications of provisional refusals sent through postal services, and Section 15(b), dealing with documents accompanying a notification of provisional refusal, will be deleted.
2. The Offices of all the Contracting Parties already exchange all communications with the International Bureau of WIPO by electronic means. Likewise, this is already the case for most applicants and holders. Applicants and holders must send communications and present their requests to the International Bureau of WIPO either through the Contact Madrid online platform or by using the e-Madrid online service.
3. Almost all holders and their representatives already have an e-mail address on record and benefit from receiving electronic communications from the International Bureau of WIPO. Holders and representatives who have not yet indicated an e-mail address must do so within the shortest possible delay. Furthermore, as the International Bureau of WIPO continues its efforts to deliver a secure online service platform, holders and representatives who have not yet indicated an e-mail address will find it increasingly more difficult to manage their international registrations.

January 27, 2023

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

as in force on February 1, 2023

[…]

***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

[…]

(v) a representation of the mark, furnished in accordance with the Administrative Instructions, that shall be in color where color is claimed under item (vii),

[…]

(vii) where color is claimed as a distinctive feature of the mark in the basic application or basic registration, or where the applicant wishes to claim color as a distinctive feature of the mark and the mark contained in the basic application or basic registration is in color or is applied to be or is protected in color, an indication that color is claimed and an indication by words of the color or combination of colors claimed,

[…]

(5) *[Additional Contents of the International Application]*

[...]

(d) The international application shall contain a declaration by the Office of origin certifying

[…]

(v) that, if color is claimed as a distinctive feature of the mark in the basic application or the basic registration, or the mark in the basic application or the basic registration is applied to be or is protected in color, a color claim is included in the international application or that, if color is claimed as a distinctive feature of the mark in the international application without having being claimed in the basic application or basic registration, the mark in the basic application or basic registration is in fact in the color or combination of colors claimed, and

[…]

[…]

[…]

***Chapter 3
International Registrations***

[…]

**Rule 15
Date of the International Registration**

(1) *[Irregularities Affecting the Date of the International Registration]* Where the international application received by the International Bureau does not contain all of the following elements:

[…]

(iii) a representation of the mark,

[…]

[…]

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

[…]

**Rule 17
Provisional Refusal**

[…]

(2) *[Content of the Notification]*  A notification of provisional refusal shall contain or indicate

[…]

(v) where the grounds on which the provisional refusal is based relate to a mark which has been the subject of an application or registration and with which the mark that is the subject of the international registration appears to be in conflict, the filing date and number, the priority date (if any), the registration date and number (if available), the name and address of the owner, and a representation of the former mark or an indication of how to access that representation, together with the list of all or the relevant goods and services in the application or registration of the former mark, it being understood that the said list may be in the language of the said application or registration,

[…]

[…]

***Chapter 7
Gazette and Data Base***

**Rule 32
Gazette**

(1) *[Information Concerning International Registrations]*

[…]

(b) The representation of the mark shall be published as it was furnished in the international application. Where the applicant has made the declaration referred to in Rule 9(4)(a)(vi), the publication shall indicate that fact.

(c) [Deleted]

[…]

**Schedule of Fees**

as in force on February 1, 2023

| *Schedule of Fees*  | *Swiss francs* |
| --- | --- |
| ***1. [Deleted]*** |  |
| ***2. International application*** |  |
| The following fees shall be payable and shall cover 10 years:  |  |
| 2.1. Basic fee (Article 8(2)(i) of the Protocol)[[3]](#footnote-4)\* |  |
| 2.1.1. where no representation of the mark is in color | 653 |
| 2.1.2. where any representation of the mark is in color | 903 |
| […] |  |

Administrative Instructions for the Application of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks

as in force on February 1, 2023

[…]

Part Three
Communications with the International Bureau; Signature; Representation of the Mark

Section 6
Communication in Writing

* 1. Subject to Section 11(a), communications addressed to the International Bureau shall be effected in writing by typewriter or other machine and shall be signed.
	2. [Deleted]

[…]

Section 11
Electronic Communications; Acknowledgement and Date of Receipt of Electronic Transmission by the International Bureau

(a) (i) Communications between an Office and the International Bureau, including the presentation of the international application, shall be by electronic means in the way agreed upon between the International Bureau and the Office concerned.

* + 1. Communications between the International Bureau and applicants and holders shall take place by electronic means, in a manner and format to be determined by the International Bureau, the particulars of which shall be published on the website of the World Intellectual Property Organization.
	1. The International Bureau shall promptly and by electronic transmission inform the originator of an electronic transmission of the receipt of that transmission, and, where the electronic transmission received is incomplete or otherwise unusable, also of that fact, provided that the originator can be identified and can be reached.
	2. Where, because of the time difference between the place from where the communication is sent and Geneva, the date on which the sending started is different from the date of receipt by the International Bureau of the complete communication, the earlier of the two dates shall be considered as the date of receipt by the International Bureau.

Section 11*bis*
Representation of the Mark

* + - * 1. A visual representation of the mark shall not exceed a maximum size of 20 by 20 centimeters and shall be furnished in or with the international application.
				2. Alternatively, the representation of the mark shall be furnished with the international application as a single digital file, and where it consists of a
		1. visual representation, in JPEG, PNG or TIFF format, in accordance with the Recommendations for the Electronic Management of the Figurative Elements of Trademarks, WIPO Standard ST.67, adopted on May 4, 2012; or
		2. sound recording, in MP3 or WAV format, not exceeding 5 MB in size, in accordance with the Recommendations for the Electronic Management of Sound Marks, WIPO Standard ST.68, adopted on March 24, 2016; or
		3. motion or multimedia recording, in MP4 format, with AVC/H.264 or MPEG‑2/H.262 codecs, not exceeding 20 MB in size, in accordance with the Recommendations for the Electronic Management of Motion and Multimedia Marks, WIPO Standard ST.69, adopted on December 4, 2020.

[…]

Part Five
Notification of Provisional Refusals

Section 14
[Deleted]

Section 15
Contents of a Notification of Provisional Refusal Based on an Opposition

* 1. A notification of provisional refusal based on an opposition shall be confined to the elements specified in Rule 17(2) and (3). The indication of the grounds on which the provisional refusal is based, in accordance with Rule 17(2)(iv), shall, in addition to stating that the refusal is based on an opposition, state concisely what are the grounds of the opposition (for example, conflict with an earlier mark or other right, lack of distinctive character). Where the opposition is based on a conflict with an earlier right other than a mark which is registered or is the subject of an application for registration, that right, and preferably the owner of that right, shall be identified as concisely as possible. The notification shall not be accompanied by memoranda or evidence.
	2. [Deleted]

[…]



































[End of Annex]

1. The relevant WIPO Standards are:

ST.67, Recommendations for the Electronic Management of the Figurative Elements of Trademarks;

ST.68, Recommendations for the Electronic Management of Sound Marks;

ST.69, Recommendation for the Electronic Management of Motion and Multimedia Marks. [↑](#footnote-ref-2)
2. Please, refer to Information Notice No. 19/2022, available at: <https://www.wipo.int/edocs/madrdocs/en/2022/madrid_2022_19.pdf>. [↑](#footnote-ref-3)
3. \* For international applications filed by applicants whose country of origin is a Least Developed Country, in accordance with the list established by the United Nations, the basic fee is reduced to 10 per cent of the prescribed amount (rounded to the nearest full figure). In such case, the basic fee will amount to 65 Swiss francs (where no representation of the mark is in color) or to 90 Swiss francs (where any representation of the mark is in color). [↑](#footnote-ref-4)