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GENEVA

**SPECIAL UNION FOR THE INTERNATIONAL REGISTRATION OF MARKS
(MADRID UNION)**

ASSEMBLY

**Thirty-Seventh (21st Extraordinary) Session
Geneva, September 25 to October 3, 2006**

AMENDMENT OF THE COMMON REGULATIONS UNDER THE MADRID
AGREEMENT AND PROTOCOL

Document prepared by the International Bureau

I. INTRODUCTION

1. At its first session held from July 4 to 8, 2005, the *ad hoc* Working Group on the Legal Development of the Madrid System for the International Registration of Marks (hereinafter referred to as “the Working Group”) considered a number of matters, including proposals for the amendment of certain features of the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to, respectively, as “the Common Regulations”, “the Agreement” and “the Protocol”).

2. The discussions of the Working Group were based on document MM/LD/WG/1/2 and its conclusions and recommendations, which were submitted to the Assembly of the Madrid Union at its thirty-sixth session in September 2005, are contained in document MM/LD/WG/1/3.

3. At its first session, the Working Group made recommendations regarding the following features of the Common Regulations:

- (i) Rule 3(1), concerning representation before the International Bureau,
- (ii) Rule 32(3), concerning the paper form of the yearly index,
- (iii) Rules 19 to 21, concerning the date of recording of certain communications,
- (iv) Rule 20(3), concerning the recording of restrictions, and
- (v) Rule 28(2), concerning corrections.

4. However, at that time the Working Group did not discuss the text of the amendments which would be required in order to implement its recommendations.

5. At its thirty-sixth session in September, 2005, the Assembly of the Madrid Union decided that a second meeting of the Working Group should be convened for the purpose of, *inter alia*, considering further the proposed amendments of the Common Regulations (see document MM/A/36/3).

6. At its second session, held from June 12 to 16, 2006, the Working Group approved the text of the proposed amendments of the features of the Common Regulations referred to in paragraph 3 above. The discussions of the Working Group were based on document MM/LD/WG/2/5 and its conclusions and recommendations are contained in document MM/LD/WG/2/11.

7. The Working Group also recommended that Rule 21 of the Common Regulations, which deals with replacement of a national or regional registration by an international registration, be amended, and approved a draft text for that purpose. The discussions were based on document MM/LD/WG/2/8.

8. In addition, the Working Group also took note of the International Bureau's intention to submit to the Assembly of the Madrid Union a proposal for amendment of Rule 39 of the Common Regulations, concerning the continuation of effects of international registrations in certain successor States. This proposal is accompanied by a consequential amendment of Rule 1, which refers to abbreviated expressions.

9. The proposed amendments to the Common Regulations are contained in Annex I (the text proposed to be deleted is struck through and the text proposed to be added is in bold). Annex II contains the text of the proposed amendments in final form without highlighting the changes.

10. Except where indicated otherwise, the proposed date of entry into force of the amendments to the Common Regulations, if adopted, is January 1, 2007.

11. Explanatory notes on the proposed amendments are provided below.

II. NOTES ON PROPOSED AMENDMENTS OF THE COMMON REGULATIONS

Rule 3(1): Representation before the International Bureau

12. The proposed amendment will have the effect that no criterion shall apply with respect to the location of the address of a representative. Under the amended Rule 3(1) of the Common Regulations that address may be established regardless of the treaty – Agreement or Protocol – governing the international application, and regardless of whether the appointment of the representative took place at the application or registration stage. Any person could therefore be appointed with regard to an international registration to act as a representative before the International Bureau, not necessarily a person having an address in a Contracting Party.

13. The Assembly of the Madrid Union is invited to adopt the amendment of Rule 3(1) of the Common Regulations as set out in Annex II hereto.

Rule 32(3): The Paper Form of the Yearly Index

14. The proposed amendment consists of the deletion of subparagraph (3) of Rule 32. This will relieve the International Bureau of the requirement to publish, on an annual basis, an index indicating the names of the holders of the international registrations published in the *WIPO Gazette of International Marks* each year.

15. The Assembly of the Madrid Union is invited to adopt the amendment of Rule 32(3) of the Common Regulations as set out in Annex II hereto.

Rules 19 to 21: The Date of Recording of Certain Communications

16. The proposed amendments of these Rules follow what has, in effect, been the practice of the International Bureau with regard to the date of recording of certain communications. The proposed amendments provide for the recording, as of the date of their receipt, of communications concerning invalidations (Rule 19), restrictions of the holder's right of disposal (Rule 20), licenses (Rule 20*bis*), and replacement of a national or regional registration (Rule 21).

17. The Assembly of the Madrid Union is invited to adopt the amendments of Rules 19 to 21 of the Common Regulations as set out in Annex II hereto.

Rule 20(3): Communication to the Office of the Contracting Party of the holder of the fact of the recording of a restriction

18. As it currently stands, Rule 20(3) does not provide for communication, by the International Bureau to the Office of the Contracting Party of the holder, of the fact of the recording of a restriction, when such Office was not the Office which had requested the recording of the restriction. The proposed amendment supplements Rule 20(3) by providing that the recording of a restriction of the holder's right of disposal must be communicated also to the Office of the Contracting Party of the holder.

19. The Assembly of the Madrid Union is invited to adopt the amendment of Rule 20(3) of the Common Regulations as set out in Annex II hereto.

Rule 28(2): Corrections

20. At present, Rule 28(2) provides for the International Bureau to notify a correction to the holder, and additionally, to the Offices of the designated Contracting Parties where the correction has effect. In line with the practice already adopted by the International Bureau, the proposed amendment of Rule 28 provides that a correction in the International Register must be communicated by the International Bureau also to the Office that requested such correction, where such Office is not the Office of a designated Contracting Party in which the correction has effect.

21. The Assembly of the Madrid Union is invited to adopt the amendment of Rule 28(2) of the Common Regulations as set out in Annex II hereto.

Rule 21: Replacement

22. The purpose of Rule 21 is to ensure that the relevant information concerning replacement is made available to third parties in the International Register. The proposed amendment of the Rule is intended to broaden the scope of paragraph (1) of Rule 21 by allowing the communication by Offices to the International Bureau of information relating to other rights acquired by virtue of a replaced national or regional registration.

23. The Assembly of the Madrid Union is invited to adopt the amendment of Rule 21 of the Common Regulations as set out in Annex II hereto.

Rule 39: Continuation of Effects of International Registrations in Certain Successor States

24. At present, Rule 39 only refers to the Agreement. The proposed amendment will allow the procedure established under Rule 39 to apply also in respect of designations made under the Protocol.

25. Paragraph (1) (chapeau): it should be observed that if the declaration of continuation deposited by the successor State covers both the Agreement and the Protocol, the effects of an international registration will continue, under the safeguard clause or because the entitlement of the holder is limited to a single treaty, under the treaty which was applicable to the designation of the predecessor Contracting Party. By contrast, if the declaration of continuation refers to one treaty only, for example the Protocol, whereas the predecessor Contracting Party was party to both, the effects shall continue under the treaty which shall alone be applicable to the successor State, in so far as the holder himself is entitled under this treaty. This solution is similar to those which were adopted in relation to a change of holder (where the transferee and the transferor have no entitlement under the same treaty) or a subsequent designation resulting from a conversion under Rule 24(7).

26. Paragraph (1)(ii): as regards the fee paid to the Administration of the successor State, it is recalled that the current amount of 23 Swiss francs was fixed at a time when only the Agreement applied. This amount should now be brought into line with the possibility for a successor State which did not deposit a declaration of continuation but acceded to the Protocol to collect individual fees for the subsequent designations of which it is the subject. Such a declaration would, however, clearly be to the benefit of holders, at least because it guarantees the continuity of their rights. It therefore appears timely to increase the fee intended for the successor States in order to encourage them to deposit a declaration of continuation of the effects. By contrast, as regards the fee paid to the International Bureau to cover the tasks for which it is responsible under Rule 39, the processing means which the International Bureau possesses now allow it to agree to a reduction in the amount of this fee. In the final analysis, it is simply proposed to reverse the amounts of the fees paid to the administration of the successor State and to the International Bureau respectively, so that the overall amount of the fees to be paid remains unchanged for the holder.

27. Paragraph (5): it is also proposed at the same time to amend Rule 39(5), so as to make it applicable to any future situation where a State declares that it continues the legal personality of a Contracting Party. In such a case, this State naturally assumes all the rights and obligations of the Contracting Party, as the Russian Federation had declared it would in relation to the Soviet Union.

28. The Assembly of the Madrid Union is invited to adopt, with immediate effect, the amendment of Rule 39 of the Common Regulations as set out in Annex II hereto.

Rule 1(xxvibis): Contracting Party of the Holder

29. This proposed amendment is related to the proposed amendment of Rule 39, described in paragraph 24, above. It aims at taking into account the pragmatic approach of the International Bureau and of the Offices concerned where, following the independence of a State which was formerly part of the territory of a Contracting Party, that State becomes itself a Contracting Party, either through a declaration of continuation of effects or by accession in its own right. In such cases, the approach is to consider that where the holder's entitlement relates to this new Contracting Party, the latter has the capacity of "Contracting Party of the holder" in relation to the holder.

30. The Assembly of the Madrid Union is invited to adopt, with immediate effect, the amendment of Rule 1(xxvibis) of the Common Regulations as set out in Annex II hereto.

[Annexes follow]

ANNEX I

COMMON REGULATIONS UNDER THE MADRID AGREEMENT
CONCERNING THE INTERNATIONAL REGISTRATION OF
MARKS AND THE PROTOCOL RELATING
TO THAT AGREEMENT

(as in force on)

[...]

Chapter 1
General Provisions

[...]

Rule 3

Representation Before the International Bureau

(1) [*Representative; ~~Address of Representative; Number of Representatives~~*] (a) The applicant or the holder may have a representative before the International Bureau.

~~(b) The address of the representative shall be,~~

~~———— (i) in respect of an international application governed exclusively by the Agreement, in the territory of a Contracting Party bound by the Agreement;~~

~~———— (ii) in respect of an international application governed exclusively by the Protocol, in the territory of a Contracting Party bound by the Protocol;~~

~~———— (iii) in respect of an international application governed by both the Agreement and the Protocol, in the territory of a Contracting Party;~~

~~———— (iv) in respect of an international registration, in the territory of a Contracting Party.~~

(~~eb~~) The applicant or the holder may have one representative only. Where the appointment indicates several representatives, only the one indicated first shall be considered to be a representative and be recorded as such.

(~~dc~~) Where a partnership or firm composed of attorneys or patent or trademark agents has been indicated as representative to the International Bureau, it shall be regarded as one representative.

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

(3) [*Irregular Appointment*] (~~a~~) ~~Where the address of the purported representative is not in the territory relevant under paragraph (1)(b), the International Bureau shall treat the appointment as if it had not been made and shall inform accordingly the applicant or holder, the purported representative and, if the sender or transmitter is an Office, that Office.~~

(~~ba~~) Where the International Bureau considers that the appointment of a representative under paragraph (2) is irregular, it shall notify accordingly the applicant or holder, the purported representative and, if the sender or transmitter is an Office, that Office.

(eb) As long as the relevant requirements under paragraphs ~~(1)(b)~~ and (2) are not complied with, the International Bureau shall send all relevant communications to the applicant or holder himself.

[...]

Chapter 7 Gazette and Data Base

Rule 32 Gazette

(1) *[Information Concerning International Registrations]* [...]

(2) *[Information Concerning Particular Requirements and Certain Declarations of Contracting Parties]* [...]

~~(3) *[Yearly Index]* In respect of every year, the International Bureau shall publish an index indicating, in alphabetical order, the names of the holders of the international registrations concerning which one or more entries were published in the Gazette during that year. The name of the holder shall be accompanied by the number of the international registration, the page number of the Gazette issue in which the entry affecting the international registration was published and the indication of the nature of the entry, such as registration, renewal, refusal, invalidation, cancellation or change.~~

~~(4) (3) *[Number of Copies for Offices of Contracting Parties]* [...]~~

[...]

Chapter 4 Facts in Contracting Parties Affecting International Registrations

[...]

Rule 19 Invalidations in Designated Contracting Parties

(1) *[Contents of the Notification of Invalidation]* [...]

(2) *[Recording of the Invalidation and Information to the Holder and the Office Concerned]* (a) [...]

(b) **The invalidation shall be recorded as of the date of receipt by the International Bureau of a notification complying with the applicable requirements.**

Rule 20
Restriction of the Holder's Right of Disposal

(1) *[Communication of Information]* [...]

(2) *[Partial or Total Removal of Restriction]* [...]

(3) *[Recording]* **(a)** The International Bureau shall record the information communicated under paragraphs (1) and (2) in the International Register and shall inform accordingly the holder, **the Office of the Contracting Party of the holder and the Offices of the designated Contracting Parties concerned.** ~~and, where the information has otherwise been given by an Office, that Office.~~

(b) The information communicated under paragraphs (1) and (2) shall be recorded as of the date of its receipt by the International Bureau, provided that the communication complies with the applicable requirements.

Rule 20bis
Licenses

(1) *[Request for the Recording of a License]* [...]

(2) *[Irregular Request]* [...]

(3) *[Recording and Notification]* **(a)** [...]

(b) The license shall be recorded as of the date of receipt by the International Bureau of a request complying with the applicable requirements.

(4) *[Amendment or Cancellation of the Recording of a License]* [...]

(5) *[Declaration that the Recording of a Given License has no Effect]* [...]

(a) [...]

(b) [...]

(c) [...]

(d) The International Bureau shall record in the International Register any declaration made in accordance with subparagraph (c) and shall notify accordingly the party (holder or Office) that presented the request to record the license. **The declaration shall be recorded as of the date of receipt by the International Bureau of a communication complying with the applicable requirements.**

(e) [...]

(6) *[Declaration That the Recording of Licenses in the International Register Has No Effect in a Contracting Party]* [...]

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

- (1) *[Notification]* [...]
 (i) [...]
 (ii) [...]
 (iii) [...]

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

- (2) *[Recording]* (a) [...]

(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.

Rule 28
Corrections in the International Register

- (1) *[Correction]* [...]

(2) *[Notification]* The International Bureau shall notify accordingly the holder and, at the same time, the Offices of the designated Contracting Parties in which the correction has effect. **In addition, where the Office that has requested the correction is not the Office of a designated Contracting Party in which the correction has effect, the International Bureau shall also inform that Office.**

- (3) *[Refusal Following a Correction]* [...]

- (4) *[Time Limit for Correction]* [...]

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 ~~State—Party~~ (“the predecessor ~~country~~**Contracting Party**”) has deposited with the Director General a declaration of continuation the effect of which is that the Agreement, **the Protocol, or both the Agreement and the Protocol are**—~~is~~ applied by the successor State, the effects in the successor State of any international registration with a territorial extension to the predecessor ~~country~~**Contracting Party** which is effective from a date prior to the date fixed under paragraph (2) shall be subject to

(i) the filing with the International Bureau, within six months from the date of a notice addressed for that purpose by the International Bureau to the holder of the international registration concerned, of a request that such international registration continue its effects in the successor State, and

(ii) the payment to the International Bureau, within the same time limit, of a fee of ~~23~~**41** Swiss francs, which shall be transferred by the International Bureau to the Office of the successor State, and of a fee of ~~41~~**23** Swiss francs for the benefit of the International Bureau.

(2) The date referred to in paragraph (1) shall be the date notified by the successor State to the International Bureau for the purposes of this Rule, provided that such date may not be earlier than the date of independence of the successor State.

(3) The International Bureau shall, upon receipt of the request and the fees referred to in paragraph (1), notify the Office of the successor State and make the corresponding recording in the International Register.

(4) With respect to any international registration concerning which the Office of the successor State has received a notification under paragraph (3), that Office may only refuse protection if the **applicable** time limit referred to in Article 5(2) of the Agreement **or in Article 5(2)(a), (b) or (c) of the Protocol** has not expired with respect to the territorial extension to the predecessor ~~country~~**Contracting Party** and if the notification of refusal is received by the International Bureau within that time limit.

(5) This Rule shall not apply to the Russian Federation, **nor to a State which has deposited with the Director General a declaration according to which it continues the legal personality of a Contracting Party.**

Chapter 1 General Provisions

Rule 1 Abbreviated Expressions

For the purposes of these Regulations,

[...]

(xxvibis) “Contracting Party of the holder” means

- the Contracting Party whose Office is the Office of origin, or
- where a change of ownership has been recorded **or in the case of State succession**, the Contracting Party, or one of the Contracting Parties, in respect of which the holder fulfills the conditions, under Articles 1(2) and 2 of the Agreement or under Article 2 of the Protocol, to be the holder of an international registration;

[...]

[Annex II follows]

ANNEX II

COMMON REGULATIONS UNDER THE MADRID AGREEMENT
CONCERNING THE INTERNATIONAL REGISTRATION OF
MARKS AND THE PROTOCOL RELATING
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(as in force on)

[...]

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[...]

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(1) [*Representative; Number of Representatives*] (a) The applicant or the holder may have a representative before the International Bureau.

(b) The applicant or the holder may have one representative only. Where the appointment indicates several representatives, only the one indicated first shall be considered to be a representative and be recorded as such.

(c) Where a partnership or firm composed of attorneys or patent or trademark agents has been indicated as representative to the International Bureau, it shall be regarded as one representative.

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

(3) [*Irregular Appointment*] (a) Where the International Bureau considers that the appointment of a representative under paragraph (2) is irregular, it shall notify accordingly the applicant or holder, the purported representative and, if the sender or transmitter is an Office, that Office.

(b) As long as the relevant requirements under paragraph (2) are not complied with, the International Bureau shall send all relevant communications to the applicant or holder himself.

[...]

Chapter 7
Gazette and Data Base

Rule 32
Gazette

- (1) *[Information Concerning International Registrations]* [...]
 - (2) *[Information Concerning Particular Requirements and Certain Declarations of Contracting Parties]* [...]
 - (3) *[Number of Copies for Offices of Contracting Parties]* [...]
- [...]

Chapter 4
Facts in Contracting Parties
Affecting International Registrations

[...]

Rule 19
Invalidations in Designated Contracting Parties

- (1) *[Contents of the Notification of Invalidation]* [...]
- (2) *[Recording of the Invalidation and Information to the Holder and the Office Concerned]* (a) [...]
(b) The invalidation shall be recorded as of the date of receipt by the International Bureau of a notification complying with the applicable requirements.

Rule 20
Restriction of the Holder's Right of Disposal

- (1) *[Communication of Information]* [...]
- (2) *[Partial or Total Removal of Restriction]* [...]
- (3) *[Recording]* (a) The International Bureau shall record the information communicated under paragraphs (1) and (2) in the International Register and shall inform accordingly the holder, the Office of the Contracting Party of the holder and the Offices of the designated Contracting Parties concerned.
(b) The information communicated under paragraphs (1) and (2) shall be recorded as of the date of its receipt by the International Bureau, provided that the communication complies with the applicable requirements.

Rule 20bis
Licenses

- (1) *[Request for the Recording of a License]* [...]
- (2) *[Irregular Request]* [...]
- (3) *[Recording and Notification]* (a) [...]
(b) The license shall be recorded as of the date of receipt by the International Bureau of a request complying with the applicable requirements.
- (4) *[Amendment or Cancellation of the Recording of a License]* [...]
- (5) *[Declaration that the Recording of a Given License has no Effect]* [...]
 - (a) [...]
 - (b) [...]
 - (c) [...]
 - (d) The International Bureau shall record in the International Register any declaration made in accordance with subparagraph (c) and shall notify accordingly the party (holder or Office) that presented the request to record the license. The declaration shall be recorded as of the date of receipt by the International Bureau of a communication complying with the applicable requirements.
 - (e) [...]
- (6) *[Declaration That the Recording of Licenses in the International Register Has No Effect in a Contracting Party]* [...]

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

- (1) *[Notification]* [...]
 - (i) [...]
 - (ii) [...]
 - (iii) [...]

The notification may also include information relating to any other rights acquired by virtue of that national or regional registration, in a form agreed between the International Bureau and the Office concerned.
- (2) *[Recording]* (a) [...]
(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.

Rule 28
Corrections in the International Register

(1) *[Correction]* [...]

(2) *[Notification]* The International Bureau shall notify accordingly the holder and, at the same time, the Offices of the designated Contracting Parties in which the correction has effect. In addition, where the Office that has requested the correction is not the Office of a designated Contracting Party in which the correction has effect, the International Bureau shall also inform that Office.

(3) *[Refusal Following a Correction]* [...]

(4) *[Time Limit for Correction]* [...]

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 Agreement, the Protocol, or both the Agreement and the Protocol are 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

(i) the filing with the International Bureau, within six months from the date of a notice addressed for that purpose by the International Bureau to the holder of the international registration concerned, of a request that such international registration continue its effects in the successor State, and

(ii) the payment to the International Bureau, within the same time limit, of a fee of 41 Swiss francs, 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.

(2) The date referred to in paragraph (1) shall be the date notified by the successor State to the International Bureau for the purposes of this Rule, provided that such date may not be earlier than the date of independence of the successor State.

(3) The International Bureau shall, upon receipt of the request and the fees referred to in paragraph (1), notify the Office of the successor State and make the corresponding recording in the International Register.

(4) With respect to any international registration concerning which the Office of the successor State has received a notification under paragraph (3), that Office may only refuse protection if the applicable time limit referred to in Article 5(2) of the Agreement or in Article 5(2)(a), (b) or (c) of the Protocol has not expired with respect to the territorial extension to the predecessor Contracting Party and if the notification of refusal is received by the International Bureau within that time limit.

(5) This Rule shall not apply to the Russian Federation, nor to a State which has deposited with the Director General a declaration according to which it continues the legal personality of a Contracting Party.

Chapter 1 **General Provisions**

Rule 1 *Abbreviated Expressions*

For the purposes of these Regulations,

[...]

(xxvibis) “Contracting Party of the holder” means

- the Contracting Party whose Office is the Office of origin, or
- where a change of ownership has been recorded or in the case of State succession, the Contracting Party, or one of the Contracting Parties, in respect of which the holder fulfills the conditions, under Articles 1(2) and 2 of the Agreement or under Article 2 of the Protocol, to be the holder of an international registration;

[...]

[End of Annex II and of document]