

Special Union for the International Registration of Marks (Madrid Union)

Assembly

**Forty-Fifth (26th Extraordinary) Session
Geneva, October 1 to 9, 2012**

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

Document prepared by the International Bureau

INTRODUCTION

1. At its tenth session, held from July 2 to 6, 2012, the 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 a number of Rules of the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement (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/10/2 and the background to the proposed amendments is elaborated hereunder.

RULE 7: NOTIFICATION OF CERTAIN SPECIAL REQUIREMENTS

Rule 7(3)(b) [Notification]

3. On September 16, 2011, the Director General of the World Intellectual Property Organization (WIPO) received from the Ministry of Foreign Affairs of Sweden a notice of withdrawal of the notification made by Sweden under former Rule 7(1) of the Common Regulations. The withdrawal was effective as from July 1, 2011. Sweden was at that time the only Contracting Party with a standing notification made under former Rule 7(1); insofar as Rule 7(1) has already been deleted, no further notifications under that Rule, or withdrawals thereof under item (3)(b) of the same provision, are now possible.

4. The Working Group agreed to recommend to the Assembly of the Madrid Union the deletion from Rule 7(3)(b) of the Common Regulations of the following words: "*paragraph (1), as in force before October 4, 2001¹, or*", as well as the accompanying footnote 1.

RULE 24: DESIGNATION SUBSEQUENT TO THE INTERNATIONAL REGISTRATION

Rule 24(2)(a)(i) [Presentation; Form and Signature]

5. Rule 24(2)(a)(i) contemplates the presentation of a subsequent designation by the Office of origin where Rule 7(1), as in force before October 4, 2001, applied. Since the Ministry of Foreign Affairs of Sweden has withdrawn its notification made under former Rule 7(1) and Rule 7(1) itself has already been deleted, Rule 24(2)(a)(i) is thus no longer applicable for any Contracting Party.

6. The Working Group agreed to recommend to the Assembly of the Madrid Union the deletion of this provision of the Common Regulations.

RULE 40: ENTRY INTO FORCE; TRANSITIONAL PROVISIONS

Rule 40(5) [Transitional Provision Relating to Statements of Grant of Protection]

7. Rule 40(5) established that no Office should be obliged to send statements of grant of protection under Rule 18~~ter~~(1) before January 1, 2011. Insofar as the said period has expired, Rule 40(5) is no longer applicable.

8. The Working Group agreed to recommend to the Assembly of the Madrid Union the deletion of this provision of the Common Regulations.

9. The proposed amendments are reproduced in the Annexes to the present document. In Annex I, the text proposed to be deleted is shown as struck out. The text of the amendments in final form, if and as adopted, is shown in Annex II.

10. *The Assembly is invited to adopt the amendment of Rules 7(3)(b), 24(2)(a)(i) and 40(5) of the Common Regulations, with a date of entry into force of January 1, 2013, as set out in the Annexes to this document.*

[Annexes follow]

**PROPOSED AMENDMENTS TO THE COMMON REGULATIONS UNDER THE MADRID
AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS AND THE
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**Common Regulations under
the Madrid Agreement Concerning
the International Registration of Marks
and the Protocol Relating to that Agreement**

(as in force on January 1, ~~2012~~2013)

LIST OF RULES

[...]

**Chapter 1
General Provisions**

[...]

*Rule 7
Notification of Certain Special Requirements*

[...]

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

(b) Any notification made under ~~paragraph (1), as in force before October 4, 2001⁴,~~
~~or~~ paragraph (2) may be withdrawn at any time. The notice of withdrawal shall be addressed to
the Director General. The withdrawal shall have effect upon receipt of the notice of withdrawal
by the Director General or at any later date indicated in the notice.

**Chapter 5
Subsequent Designations; Changes**

*Rule 24
Designation Subsequent to the International Registration*

[...]

(2) *[Presentation; Form and Signature]* (a) A subsequent designation shall be presented
to the International Bureau by the holder or by the Office of the Contracting Party of the holder;
however,

⁴ ~~Paragraph (1) of Rule 7 read:~~

~~"Where a Contracting Party requires that, where its Office is the Office of origin and the holder's
address is in the territory of that Contracting Party, designations made subsequently to the international
registration be presented to the International Bureau by the said Office, it shall notify that requirement to the
Director General."~~

(i) ~~[Deleted] where Rule 7(1), as in force before October 4, 2001, applies, it must be presented by the Office of origin;~~

[...]

[...]

[...]

Chapter 9 Miscellaneous

[...]

Rule 40 Entry into Force; Transitional Provisions

[...]

(5) ~~[Deleted] *[Transitional Provision Relating to Statements of Grant of Protection]* No Office shall be obliged to send statements of grant of protection under Rule 18ter(1) before January 1, 2011.~~

[Annex II follows]

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**Chapter 5
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*Rule 24
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(2) *[Presentation; Form and Signature]* (a) A subsequent designation shall be presented to the International Bureau by the holder or by the Office of the Contracting Party of the holder; however,

(i) [Deleted]
[...]

[...]

[...]

Chapter 9
Miscellaneous

[...]

Rule 40
Entry into Force; Transitional Provisions

[...]

(5) [Deleted]

[End of Annex II and of document]