

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

Assembly

Forty-Eighth (28th Extraordinary) Session Geneva, September 22 to 30, 2014

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. The Working Group on the Legal Development of the Madrid System for the International Registration of Marks (hereinafter referred to as “the Working Group”), at its eleventh session, held from October 30 to November 1, 2013, recommended to the Assembly the adoption of a procedure of continued processing, through a new Rule 5*bis* and related amendments to Rules 20*bis*, Rule 27 and the Schedule of Fees, and further amendments to Rules 30 and 31 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 in the Working Group were based on document MM/LD/WG/11/2 (see document MM/LD/WG/11/7, paragraphs 17 to 115). Relevant background information to the proposed amendments is given in the following paragraphs. The proposed amendments are reproduced in Annexes I and II to the present document. Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Clean copies of the proposed amended provisions (without underlining or striking through) appear in Annexes III and IV.

PROPOSED AMENDMENTS TO THE COMMON REGULATIONS

CONTINUED PROCESSING

Rule 5bis [Continued Processing]

3. This proposed new Rule would allow an applicant or holder to request continued processing before the International Bureau where the applicant or holder has failed to meet a time limit for an action in a procedure before the International Bureau. The introduction of continued processing would be a user-friendly improvement of the Madrid system that would strike a fair balance among the interests of the parties having missed time limits, third parties and the designated Contracting Parties. The proposed new Rule is in line with Article 14 of the Singapore Treaty on the Law of Trademarks and Rule 9 of the Regulations under the Singapore Treaty.

Rule 20bis [Licenses]

4. The proposed new subparagraph (c) in Rule 20bis(3) clarifies the date of recording of a license under this Rule in case of continued processing, and it would be a consequence of the introduction of new Rule 5bis.

Rule 27 [Recording and Notification of a Change or of a Cancellation; Merger of International Registrations; Declaration That a Change in Ownership or a Limitation Has No Effect]

5. The proposed new subparagraph (c) in Rule 27(1) clarifies the date of recording of a change or cancellation under this Rule in case of continued processing, and it would be a consequence of the introduction of new Rule 5bis.

Schedule of Fees

6. The proposed amount of the fee for a request for continued processing under proposed Rule 5bis is 200 Swiss francs.

PARTIAL RENEWAL

Rule 30 [Details Concerning Renewal]

7. The proposed amendments to Rule 30(1)(a)(iii) and (2)(a) to (c) clarify that the provision does not refer to provisional refusals sent under Rule 17, but to any statement sent under Rule 18ter limiting the scope of protection. The proposed amended subparagraph (d) and new subparagraph (e) in Rule 30(2) stipulate that, following the recording of a statement sent under Rule 18ter(2)(ii) or (4), the international registration should not be renewed for the unprotected goods and services, unless so requested by the holder. The proposed amendment to Rule 30 is user-friendly as it would introduce the principle of partial renewal, meaning renewal only for the protected goods and services in a designated Contracting Party, unless otherwise explicitly stated by the holder and upon payment of the applicable fees.

NOTIFICATION TO THE HOLDER OF NON-RENEWAL OF AN INTERNATIONAL
REGISTRATION

Rule 31 [Recording of the Renewal; Notification and Certificate]

8. The proposed amendment to Rule 31(4) provides for notifications by the International Bureau to the holder and the representative, if any, when an international registration has not been renewed, thus improving legal certainty for the holder.

9. *The Assembly is invited to adopt Rule 5bis and the amendments to Rules 20bis, 27, 30 and 31 of the Common Regulations, as well as the amendment of the Schedule of Fees, with a date of entry into force of January 1, 2015, 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
PROTOCOL RELATING TO THAT AGREEMENT**

**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, ~~2013~~2015)

LIST OF RULES

[...]

**Chapter 1
General Provisions**

[...]

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), 20bis(2), 24(5)(b), 26(2), 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.

(b) A request not complying with items (i) and (ii) of subparagraph (a) shall not be considered as such and the applicant or holder shall be notified to that effect.

(2) [Recording and Notification] The International Bureau shall record in the International Register any continued processing and notify the applicant or holder accordingly.

Chapter 4
Facts in Contracting Parties
Affecting International Registrations

[...]

Rule 20bis
Licenses

[...]

(3) *[Recording and Notification]*

[...]

(c) Notwithstanding subparagraph (b), where continued processing has been recorded under Rule 5bis, the license shall be recorded in the International Register as of the date of expiry of the time limit specified in paragraph (2).

[...]

Chapter 5
Subsequent Designations; Changes

[...]

Rule 27
Recording and Notification of a Change or of a Cancellation;
Merger of International Registrations; Declaration That a Change in
Ownership or a Limitation Has No Effect

(1) *[Recording and Notification of a Change or of a Cancellation]*

[...]

(c) Notwithstanding subparagraph (b), where continued processing has been recorded under Rule 5bis, the change or cancellation shall be recorded in the International Register as of the date of expiry of the time limit specified in Rule 26(2), except that, where a request has been made in accordance with Rule 25(2)(c), it may be recorded as of a later date.

Chapter 6 Renewals

[...]

Rule 30 Details Concerning Renewal

(1) *[Fees]* (a) The international registration shall be renewed upon payment, at the latest on the date on which the renewal of the international registration is due, of

[...]

(iii) the complementary fee or individual fee, as the case may be, for each designated Contracting Party for which no [statement of refusal under Rule 18ter](#) or invalidation, [in respect of all the goods and services concerned](#), is recorded in the International Register ~~in respect of all the goods and service concerned~~, as specified or referred to in item 6 of the Schedule of Fees. However, such payment may be made within six months from the date on which the renewal of the international registration is due, provided that the surcharge specified in item 6.5 of the Schedule of Fees is paid at the same time.

[...]

(2) *[Further Details]* (a) Where the holder does not wish to renew the international registration in respect of a designated Contracting Party for which no [statement of refusal under Rule 18ter, in respect of all the goods and services concerned](#), is recorded in the International Register ~~in respect of all the goods and services concerned~~, payment of the required fees shall be accompanied by a statement [by the holder](#) that the renewal of the international registration is not to be recorded in the International Register in respect of that Contracting Party.

(b) Where the holder wishes to renew the international registration in respect of a designated Contracting Party notwithstanding the fact that a [statement of refusal under Rule 18ter](#) is recorded in the International Register for that Contracting Party in respect of all the goods and services concerned, payment of the required fees, including the complementary fee or individual fee, as the case may be, for that Contracting Party, shall be accompanied by a statement [by the holder](#) that the renewal of the international registration is to be recorded in the International Register in respect of that Contracting Party.

(c) The international registration ~~may~~[shall](#) not be renewed in respect of any designated Contracting Party in respect of which an invalidation has been recorded for all goods and services under Rule 19(2) or in respect of which a renunciation has been recorded under Rule 27(1)(a). The international registration ~~may~~[shall](#) not be renewed in respect of any designated Contracting Party for those goods and services in respect of which an invalidation of the effects of the international registration in that Contracting Party has been recorded under Rule 19(2) or in respect of which a limitation has been recorded under Rule 27(1)(a).

(d) [Where a statement under Rule 18ter\(2\)\(ii\) or \(4\) is recorded in the International Register, the international registration shall not be renewed in respect of the designated Contracting Party concerned for the goods and services that are not included in that statement, unless payment of the required fees is accompanied by a statement by the holder that the international registration is to be renewed also for those goods and services.](#) ~~The fact that the international registration is not renewed in respect of all of the designated Contracting Parties shall not be considered to constitute a change for the purposes of Article 7(2) of the Agreement or Article 7(2) of the Protocol.~~

(e) The fact that the international registration is not renewed under subparagraph (d) in respect of all the goods and services concerned, shall not be considered to constitute a change for the purposes of Article 7(2) of the Agreement or Article 7(2) of the Protocol. The fact that the international registration is not renewed in respect of all of the designated Contracting Parties shall not be considered to constitute a change for the purposes of Article 7(2) of the Agreement or Article 7(2) of the Protocol.

[...]

Rule 31
Recording of the Renewal; Notification and Certificate

[...]

(4) *[Notification in Case of Non-Renewal]* (a) Where an international registration is not renewed, the International Bureau shall notify accordingly the holder, the representative, if any, and the Offices of all of the Contracting Parties designated in that international registration.

(b) Where an international registration is not renewed in respect of a designated Contracting Party, the International Bureau shall notify the holder, the representative, if any, and the Office of that Contracting Party accordingly.

[Annex II follows]

PROPOSED AMENDMENTS TO THE SCHEDULE OF FEES

SCHEDULE OF FEES

(in force on ~~September~~January 1, ~~2008~~2015)

Swiss francs

[...]

7. *Miscellaneous recordings*

[...]

7.6 Request for a continued processing under Rule 5bis(1)

200

[Annex III follows]

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(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.

(b) A request not complying with items (i) and (ii) of subparagraph (a) shall not be considered as such and the applicant or holder shall be notified to that effect.

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Affecting International Registrations

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Rule 20bis
Licenses

[...]

(3) *[Recording and Notification]*

[...]

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Chapter 5
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Rule 27
Recording and Notification of a Change or of a Cancellation;
Merger of International Registrations; Declaration That a Change in
Ownership or a Limitation Has No Effect

(1) *[Recording and Notification of a Change or of a Cancellation]*

[...]

(c) Notwithstanding subparagraph (b), where continued processing has been recorded under Rule 5*bis*, the change or cancellation shall be recorded in the International Register as of the date of expiry of the time limit specified in Rule 26(2), except that, where a request has been made in accordance with Rule 25(2)(c), it may be recorded as of a later date.

Chapter 6 Renewals

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(iii) the complementary fee or individual fee, as the case may be, for each designated Contracting Party for which no statement of refusal under Rule 18ter or invalidation, in respect of all the goods and services concerned, is recorded in the International Register, as specified or referred to in item 6 of the Schedule of Fees. However, such payment may be made within six months from the date on which the renewal of the international registration is due, provided that the surcharge specified in item 6.5 of the Schedule of Fees is paid at the same time.

[...]

(2) *[Further Details]* (a) Where the holder does not wish to renew the international registration in respect of a designated Contracting Party for which no statement of refusal under Rule 18ter, in respect of all the goods and services concerned, is recorded in the International Register, payment of the required fees shall be accompanied by a statement by the holder that the renewal of the international registration is not to be recorded in the International Register in respect of that Contracting Party.

(b) Where the holder wishes to renew the international registration in respect of a designated Contracting Party notwithstanding the fact that a statement of refusal under Rule 18ter is recorded in the International Register for that Contracting Party in respect of all the goods and services concerned, payment of the required fees, including the complementary fee or individual fee, as the case may be, for that Contracting Party, shall be accompanied by a statement by the holder that the renewal of the international registration is to be recorded in the International Register in respect of that Contracting Party.

(c) The international registration shall not be renewed in respect of any designated Contracting Party in respect of which an invalidation has been recorded for all goods and services under Rule 19(2) or in respect of which a renunciation has been recorded under Rule 27(1)(a). The international registration shall not be renewed in respect of any designated Contracting Party for those goods and services in respect of which an invalidation of the effects of the international registration in that Contracting Party has been recorded under Rule 19(2) or in respect of which a limitation has been recorded under Rule 27(1)(a).

(d) Where a statement under Rule 18ter(2)(ii) or (4) is recorded in the International Register, the international registration shall not be renewed in respect of the designated Contracting Party concerned for the goods and services that are not included in that statement, unless payment of the required fees is accompanied by a statement by the holder that the international registration is to be renewed also for those goods and services.

(e) The fact that the international registration is not renewed under subparagraph (d) in respect of all the goods and services concerned, shall not be considered to constitute a change for the purposes of Article 7(2) of the Agreement or Article 7(2) of the Protocol. The fact that the international registration is not renewed in respect of all of the designated Contracting Parties shall not be considered to constitute a change for the purposes of Article 7(2) of the Agreement or Article 7(2) of the Protocol.

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Rule 31
Recording of the Renewal; Notification and Certificate

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(4) *[Notification in Case of Non-Renewal]* (a) Where an international registration is not renewed, the International Bureau shall notify accordingly the holder, the representative, if any, and the Offices of all of the Contracting Parties designated in that international registration.

(b) Where an international registration is not renewed in respect of a designated Contracting Party, the International Bureau shall notify the holder, the representative, if any, and the Office of that Contracting Party accordingly.

[Annex IV follows]

PROPOSED AMENDMENTS TO THE SCHEDULE OF FEES

SCHEDULE OF FEES

(in force on January 1, 2015).

Swiss francs

[...]

7. *Miscellaneous recordings*

[...]

7.6	Request for a continued processing under Rule 5 <i>bis</i> (1)	200
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[End of Annex IV and of document]