

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

Assembly

**Forty-Ninth (21st Ordinary) Session
Geneva, October 5 to 14, 2015**

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 twelfth session, held from October 20 to 24, 2014, recommended to the Assembly the adoption of amendments to Rules 5, 9, 24 and 36 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/12/2. Relevant background information to the proposed amendments is given in the following paragraphs. The proposed amendments are reproduced in the Annexes to the present document. Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned (Annexes I and II). Clean copies of the proposed amended provisions (without underlining or striking through) appear in Annexes III and IV.

PROPOSED AMENDMENTS TO THE COMMON REGULATIONS

Rule 5 [Irregularities in Postal and Delivery Services and in Communications Sent Electronically]

3. Under a proposed new paragraph (3) of Rule 5, failure of an interested party to meet a time limit for a communication addressed to the International Bureau that was sent electronically would be excused where the interested party submits satisfactory evidence showing that the time limit was not met because of a failure in the electronic communication with the International Bureau or a failure that affects the locality of the interested party due to extraordinary circumstances. In this case, a new communication should be effected no later than five days after the electronic services are resumed. Consequential amendments to paragraphs (4) and (5) of the same Rule are also proposed.

Rule 9 [Contents of the International Application]

4. A proposed amendment to item (xi) in paragraph (4)(a) of Rule 9 would require that the description of the mark by words contained in the basic application or basic registration, if any, be included in the international application only when the Office of origin so requires.

5. Under a proposed new item (vi) in paragraph (4)(b) of Rule 9, an international application may contain any description of the mark by words or, if the applicant so wishes, the description contained in the basic application or the basic registration, where such has not already been provided under paragraph (4)(a)(xi) of the same Rule.

Rule 24 [Designation Subsequent to the International Registration]

6. An amendment to paragraph (5) of Rule 24 would provide for the application, *mutatis mutandis*, of Rules 12 and 13 where a subsequent designation is for only part of the goods and services listed in the international registration. Communications regarding any irregularity to be remedied under the application of these Rules shall be between the holder and the International Bureau. Where the International Bureau cannot group the goods and services listed in the subsequent designation under the classes of the *International Classification of Goods and Services for the Purposes of the Registration of Marks* (Nice Classification) already listed in the international registration and this irregularity is not remedied, the subsequent designation shall be deemed not to contain those goods and services.

Rule 36 [Exemption From Fees]

7. An amendment to paragraph (ii) of Rule 36 would exempt from the payment of a fee requests for the recording of a change in the address for correspondence, e-mail address or in any other means of communication with the applicant or holder, as specified in the Administrative Instructions.

ENTRY INTO FORCE OF THE PROPOSED AMENDMENTS

8. It is suggested that the proposed amendments to Rules 5 and 36 enter into force on April 1, 2016.

9. The proposed amendments to Rule 9 and 24 would require the deployment of changes affecting all the information technology (IT) systems of the International Bureau used for international trademark registration.

10. The International Bureau will start soon the validation phase of its new administrative system, the *Madrid International Registry Information System* (MIRIS). As a result, the International Bureau has stopped further developments in its current administrative system during the transition to avoid work and cost duplication. It is anticipated that MIRIS would be deployed soon after testing and validation are completed.

11. New Madrid System features could only be introduced in MIRIS following its successful deployment and once it has been deemed to be stable. It would be sensible to anticipate that the development, validation and deployment of any new feature in MIRIS should take into account a reasonable stabilization period.

12. To ensure that the required changes to the International Bureau's IT system are adequately implemented, it is suggested that the proposed amendments to Rules 9 and 24 enter into force on November 1, 2017.

13. The Assembly is invited to adopt the amendments to Rules 5, and 36 of the Common Regulations, with a date of entry into force of April 1, 2016, and to Rules 9 and 24 of the Common Regulations, with a date of entry into force of November 1, 2017, as set out in the Annexes to the "Proposed Amendments to the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement" (document MM/A/49/3).

[Annexes follow]

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**Common Regulations under
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(as in force on ~~January 1, 2015~~ April 1, 2016)

LIST OF RULES

**Chapter 1
General Provisions**

[...]

Rule 5
Irregularities in Postal and Delivery Services
and in Communications Sent Electronically

[...]

(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.

~~(3)~~(4) [Limitation on Excuse] Failure to meet a time limit shall be excused under this Rule only if the evidence referred to in paragraph (1), ~~or (2)~~ or (3) and the communication or, where applicable, a duplicate thereof are received by the International Bureau not later than six months after the expiry of the time limit.

~~(4)~~(5) [International Application and Subsequent Designation] Where the International Bureau receives an international application or a subsequent designation beyond the two-month period referred to in Article 3(4) of the Agreement, in Article 3(4) of the Protocol and in Rule 24(6)(b), and the Office concerned indicates that the late receipt resulted from circumstances referred to in paragraph (1), ~~or (2)~~, or (3), paragraph (1), ~~or (2)~~ or (3) and paragraph ~~(3)~~(4) shall apply.

Chapter 8 Fees

[...]

Rule 36 Exemption From Fees

Recording of the following shall be exempt from fees:

- (i) the appointment of a representative, any change concerning a representative and the cancellation of the recording of a representative,
- (ii) any change concerning the telephone and telefacsimile numbers, [address for correspondence, electronic mail address and any other means of communication](#) of [with the applicant or](#) holder, [as specified in the Administrative Instructions](#),
- (iii) the cancellation of the international registration,
- (iv) any renunciation under Rule 25(1)(a)(iii),
- (v) any limitation effected in the international application itself under Rule 9(4)(a)(xiii) or in a subsequent designation under Rule 24(3)(a)(iv),
- (vi) any request by an Office under Article 6(4), first sentence, of the Agreement or Article 6(4), first sentence, of the Protocol,
- (vii) the existence of a judicial proceeding or of a final decision affecting the basic application, or the registration resulting therefrom, or the basic registration,
- (viii) any refusal under Rule 17, Rule 24(9) or Rule 28(3), any statement under Rules 18*bis* or 18*ter* or any declaration under Rule 20*bis*(5) or Rule 27(4) or (5),
- (ix) the invalidation of the international registration,
- (x) information communicated under Rule 20,
- (xi) any notification under Rule 21 or Rule 23,
- (xii) any correction in the International Register.

[Annex II follows]

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LIST OF RULES

[...]

**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

(i) the name of the applicant, given in accordance with the Administrative Instructions,

(ii) the address of the applicant, given in accordance with the Administrative Instructions,

(iii) the name and address of the representative, if any, given in accordance with the Administrative Instructions,

(iv) where the applicant wishes, under the Paris Convention for the Protection of Industrial Property, to take advantage of the priority of an earlier filing, a declaration claiming the priority of that earlier filing, together with an indication of the name of the Office where such filing was made and of the date and, where available, the number of that filing, and, where the earlier filing relates to less than all the goods and services listed in the international application, the indication of those goods and services to which the earlier filing relates,

(v) a reproduction of the mark that shall fit in the box provided on the official form; that reproduction shall be clear and shall, depending on whether the reproduction in the basic application or the basic registration is in black and white or in color, be in black and white or in color,

(vi) where the applicant wishes that the mark be considered as a mark in standard characters, a declaration to that effect,

(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, an indication that color is claimed and an indication by words of the color or combination of colors claimed and, where the reproduction furnished under item (v) is in black and white, one reproduction of the mark in color,

(vii**bis**) where the mark that is the subject of the basic application or the basic registration consists of a color or a combination of colors as such, an indication to that effect,

(viii) where the basic application or the basic registration relates to a three-dimensional mark, the indication “three-dimensional mark,”

(ix) where the basic application or the basic registration relates to a sound mark, the indication “sound mark,”

(x) where the basic application or the basic registration relates to a collective mark or a certification mark or a guarantee mark, an indication to that effect,

(xi) where the basic application or the basic registration contains a description of the mark by words and ~~the applicant wishes to include the description or~~ the Office of origin requires the inclusion of the description, that same description; where the said description is in a language other than the language of the international application, it shall be given in the language of the international application,

(xii) where the mark consists of or contains matter in characters other than Latin characters or numbers expressed in numerals other than Arabic or Roman numerals, a transliteration of that matter in Latin characters and Arabic numerals; the transliteration into Latin characters shall follow the phonetics of the language of the international application,

(xiii) the names of the goods and services for which the international registration of the mark is sought, grouped in the appropriate classes of the International Classification of Goods and Services, each group preceded by the number of the class and presented in the order of the classes of that Classification; the goods and services shall be indicated in precise terms, preferably using the words appearing in the Alphabetical List of the said Classification; the international application may contain limitations of the list of goods and services in respect of one or more designated Contracting Parties; the limitation in respect of each Contracting Party may be different,

(xiv) the amount of the fees being paid and the method of payment, or instructions to debit the required amount of fees to an account opened with the International Bureau, and the identification of the party effecting the payment or giving the instructions, and

(xv) the designated Contracting Parties.

(b) The international application may also contain,

(i) where the applicant is a natural person, an indication of the State of which the applicant is a national;

(ii) where the applicant is a legal entity, indications concerning the legal nature of that legal entity and the State, and, where applicable, the territorial unit within that State, under the law of which the said legal entity has been organized;

(iii) where the mark consists of or contains a word or words that can be translated, a translation of that word or those words into English, French and Spanish, or in any one or two of those languages;

(iv) where the applicant claims color as a distinctive feature of the mark, an indication by words, in respect of each color, of the principal parts of the mark which are in that color;

(v) where the applicant wishes to disclaim protection for any element of the mark, an indication of that fact and of the element or elements for which protection is disclaimed.;

(vi) any description of the mark by words or, if the applicant so wishes, the description of the mark by words contained in the basic application or the basic registration, where it has not been provided under paragraph (4)(a)(xi).

- (5) *[Additional Contents of an International Application]* (a)
[...]
(d) The international application shall contain a declaration by the Office of origin certifying
[...]
(iii) that any indication referred to in paragraph (4)(a)(vii**bis**) to (xi) and appearing in the international application appears also in the basic application or the basic registration, as the case may be,
[...]
[...]

Chapter 5 Subsequent Designations; Changes

Rule 24 *Designation Subsequent to the International Registration*

[...]

(5) *[Irregularities]* (a) If the subsequent designation does not comply with the applicable requirements, and subject to paragraph (10), the International Bureau shall notify that fact to the holder and, if the subsequent designation was presented by an Office, that Office. Where the subsequent designation is for only part of the goods and services listed in the international registration concerned, Rules 12 and 13 shall apply, *mutatis mutandis*, with the exception that all communications regarding any irregularity to be remedied under these Rules shall be between the holder and the International Bureau. Where the International Bureau cannot satisfy itself that all the goods and services listed in the subsequent designation can be grouped in the classes of the International Classification of Goods and Services listed in the international registration concerned, the International Bureau shall raise an irregularity.

(b) If the irregularity is not remedied within three months from the date of the notification of the irregularity by the International Bureau, the subsequent designation shall be considered abandoned, and the International Bureau shall notify accordingly and at the same time the holder and, if the subsequent designation was presented by an Office, that Office, and refund any fees paid, after deduction of an amount corresponding to one-half of the basic fee referred to in item 5.1 of the Schedule of Fees, to the party having paid those fees.

(c) Notwithstanding subparagraphs (a) and (b), where the requirements of paragraphs (1)(b) or (c) or (3)(b)(i) are not complied with in respect of one or more of the designated Contracting Parties, the subsequent designation shall be deemed not to contain the designation of those Contracting Parties, and any complementary or individual fees already paid in respect of those Contracting Parties shall be reimbursed. Where the requirements of paragraphs (1)(b) or (c) or (3)(b)(i) are complied with in respect of none of the designated Contracting Parties, subparagraph (b) shall apply.

(d) Notwithstanding subparagraph (b), where an irregularity under the last sentence of subparagraph (a) is not remedied, the subsequent designation shall be deemed not to contain the goods and services concerned.

[...]

[Annex III follows]

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(c) Notwithstanding subparagraphs (a) and (b), where the requirements of paragraphs (1)(b) or (c) or (3)(b)(i) are not complied with in respect of one or more of the designated Contracting Parties, the subsequent designation shall be deemed not to contain the designation of those Contracting Parties, and any complementary or individual fees already paid in respect of those Contracting Parties shall be reimbursed. Where the requirements of paragraphs (1)(b) or (c) or (3)(b)(i) are complied with in respect of none of the designated Contracting Parties, subparagraph (b) shall apply.

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[End of Annex IV and of document]