

Working Group on the Legal Development of the Madrid System for the International Registration of Marks

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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 purpose of the present document is to submit to the Working Group on the Legal Development of the Madrid System for the International Registration of Marks (hereinafter referred to as “the Working Group”) proposals for the amendment of certain 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of Marks and the Protocol Relating to that Agreement (hereinafter referred to as “the Common Regulations”), that are no longer applicable. The proposed amendments are reproduced in the Annex to the present document.

PROPOSED AMENDMENTS

RULE 7: NOTIFICATION OF CERTAIN SPECIAL REQUIREMENTS

Rule 7(3)(b) [Notification]

2. 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 under former Rule 7(1) of the Common Regulations. The withdrawal is effective as from July 1, 2011. Sweden was the only Contracting Party with a standing notification made under former Rule 7(1); insofar as Rule 7(1) is now deleted, no more

notifications under that Rule, or withdrawals thereof under item (3)(b) of the same provision, are possible. It is proposed to delete in Rule 7(3)(b) the following words: "*paragraph (1), as in force before October 4, 2001¹, or*", as well as the accompanying footnote 1. Rule 7(3)(b) would then read as follows:

(b) Any notification made under paragraph (2) may be withdrawn at any time.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.

RULE 24: DESIGNATION SUBSEQUENT TO THE INTERNATIONAL REGISTRATION

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

3. 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 Since the Ministry of Foreign Affairs of Sweden has withdrawn its notification made under Rule 7(1), Rule 7(1) becomes inapplicable and thus Rule 24(2)(a)(i) is also no longer applicable for any Contracting Party. It is proposed to delete this provision.

RULE 40: ENTRY INTO FORCE; TRANSITIONAL PROVISIONS

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

4. Rule 40(5) establishes that no Office shall be obliged to send statements of grant of protection under Rule 18ter(1) before January 1, 2011. Insofar as the period during which the sending of such statements was not mandatory has expired, Rule 40(5) is no longer applicable. It is proposed to delete this provision.

5. *The Working Group is invited to:*

(i) consider the proposals made in this document; and

(ii) indicate any further course of action, including whether it would recommend to the Madrid Union Assembly some or all the proposed amendments to Rules 7, 24 and 40 of the Common Regulations, as presented in the Annex to this document or in amended form.

[Annex follows]

**PROPOSED AMENDMENTS TO THE COMMON REGULATIONS UNDER THE MADRID
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PROTOCOL RELATING TO THAT AGREEMENT**

**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, 2001¹,~~
~~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,

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

[...]

[...]

[...]

¹ 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.”~~

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.~~

[End of Annex and of document]