

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

**Twelfth Session  
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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. This document contains proposals to change 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”) and the Administrative Instructions for the Application of the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating Thereto (hereinafter referred to as “the Administrative Instructions”). More specifically, the proposals concern amendments to Rules 5, 9, 10, 21, 24 and 36(ii) and (v) of the Common Regulations and to Part Three of the Administrative Instructions, amendments to Section 7, and Part Six, proposed new Section 15*bis*. This document also proposes changes to the Schedule of Fees. These proposals support the ongoing process of making the Madrid System more user-friendly and attractive to its users, interested third parties and Offices of Contracting Parties. The proposals are reproduced in the Annexes to this document.

## I. FAILURES IN POSTAL AND DELIVERY SERVICES OR COMMUNICATIONS SENT ELECTRONICALLY (RULE 5)

### A. BACKGROUND

2. Rule 5 of the Common Regulations provides for remedies where the interested party fails to meet time limits for the sending of communications addressed to the International Bureau when these have been sent through a postal or a delivery service. The provision requires due care to take into account the late receipt of communications as a consequence of *force majeure* (war, revolution, civil disorder, strike, natural calamity or other like reason).

3. During the eleventh session of the Working Group on the Legal Development of the Madrid System for the International Registration of Marks (hereinafter referred to as “the Working Group”), a number of delegations noted that the provision does not contemplate failure to meet time limits where the communication has been sent through electronic means. More and more communications within the Madrid System are exchanged in electronic form. The Working Group therefore asked that the International Bureau draft a revised Rule 5, with a view to consider disturbances of electronic means of communication, and present it for its consideration in this session.

### B. PROPOSAL

4. Amendments to Rule 5 are proposed to provide for remedies where the late receipt of communications is the result of failures in electronic services. It is proposed that a new paragraph (3) be introduced to consider communications sent electronically; current paragraphs (3) and (4), renumbered as paragraphs (4) and (5), would be amended to include references to new paragraph (3).

5. Proposed new paragraph (3) would apply where an interested party (i.e., the applicant, the holder, the representative or an Office) fails to meet a time limit for a communication addressed to the International Bureau and sent by electronic means (e.g., e-mail, fax, electronic forms). The interested party would need to submit evidence, to the satisfaction of the International Bureau, showing that the time limit was not met because of failures in the electronic communication system of the International Bureau or on account of *force majeure*.

6. The proposed amendment would also apply to failure on account of a disruption of Internet services in the locality of the interested party. In such case, the party could provide the International Bureau with reliable and verifiable information of the situation, such as, for instance, an attestation from the party’s Internet service provider indicating that the service was not available.

7. It is recalled that continued processing, as discussed at the previous session of the Working Group, is set out in new Rule 5*bis*, which will be submitted to the Madrid Union Assembly for its adoption in September 2014, to address a particular need. Continued processing is a relief measure available to applicants and holders when they fail to meet time limits in specific procedures before the International Bureau. Continued processing would not require that such failure result from *force majeure* or that evidence of due care be provided, but it would require the payment of a fee, the remedying of the irregularity concerned, and that the continued processing be requested within two months following the expiry of the time limit concerned.

## II. VOLUNTARY DESCRIPTION OF THE MARK (RULE 9)

### A. BACKGROUND

8. Rule 9 of the Common Regulations sets forth the requirements for an international application. Rule 9(4)(a)(xi)<sup>1</sup> allows for the inclusion of a description of the mark in the international application where such description is present in the basic application or registration, and the applicant wishes to include this description or the Office of origin so requires. The applicant, however, cannot introduce a description of the mark in the international application if the basic application or registration does not contain such description.

9. Some Contracting Parties require a description of the mark where the mark is considered to be a mark in non-standard characters. In those cases, where a description is not provided, the Office would notify a provisional refusal. To streamline processes and to resolve this difficulty for the users of the Madrid System, the International Bureau is proposing three amendments to Rule 9.

### B. PROPOSAL

10. The first proposal is to delete paragraph (4)(a)(xi) from Rule 9, where the possibility to provide a description is linked to the presence of such description in the basic application or registration. The second proposal is to delete the reference to paragraph (4)(a)(xi) from paragraph (5)(d)(iii), thereby removing the description from the certification process to be undertaken by the Office of origin. The third proposal is to introduce a new item (vi) in Rule 9(4)(b), which would allow the applicant to provide in the international application a voluntary description of the mark, which may or may not be identical to the one in the basic application or registration. The Office of origin would no longer need to certify that a given description in the international application is the same as the one in the basic application or registration. The applicant would be free to include a description of his mark, to meet requirements of certain designated Contracting Parties, regardless of whether such description is contained in the basic application or registration.

11. The International Bureau would not check the accuracy of any such voluntary description of the mark and it would not question its absence. The International Bureau would, however, provide a translation of any voluntary description into the two other working languages of the Madrid System.

12. The Offices of the designated Contracting Parties would determine the adequacy of the voluntary description of the mark, according to their national or regional laws and jurisprudence.

13. Should the proposed amendments to Rule 9 be approved, the international application form would be revised accordingly.

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<sup>1</sup> Rule 9(4)(a)(xi) of the Common Regulations reads as follows: "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,"

### III. REPLACEMENT (RULE 21)

#### A. BACKGROUND

14. Replacement is a fundamental feature of the Madrid System established by Articles 4*bis* of the Agreement and of the Protocol. Replacement is also addressed by Rule 21 of the Common Regulations.

15. Article 4*bis*(1) was adopted and included in the text of the Madrid Agreement at the Conference of Brussels, on December 14, 1900. The underlying concern at the time of the adoption of the provision was the possibility of an international registration being rejected by the Office of a designated Contracting Party on the ground that the mark in question was already protected at the national level in the territory concerned. This would have considerably undermined the efficacy of the Madrid System. More elaborate provisions concerning the replacement procedure were incorporated in the Protocol.

16. Replacement is a mechanism geared toward making the use of the Madrid System and the centralized management of trademark portfolios more efficient, as international registrations are deemed, under certain conditions, to have replaced national or regional registrations in designated Contracting Parties. Right holders and Offices have stated that replacement should be clarified and, if possible, simplified. It is relevant to underline that replacement is not effected by the concerned national or regional Offices.

17. Provided the appropriate conditions are met, replacement is deemed to be automatic. Articles 4*bis* of the treaties merely provide that an Office shall “upon request” be required to take note of replacement in its Register. Rule 21 of the Common Regulations requires Offices having taken note of replacement to notify the International Bureau accordingly. The International Bureau records that fact and publishes it in the *WIPO Gazette of International Marks*.

18. The current procedure under Rule 21 of the Common Regulations stipulates that holders must address each Office concerned requesting that it take note of replacement. A procedural change, which would require a modification to Rule 21, is hereby proposed whereby this request would be made through the International Bureau. The proposed change would encourage the use of replacement with the introduction of a normalized and streamlined procedure and it will increase the information available in the International Register resulting in a more user-friendly Madrid System.

19. The advantage of channeling these requests through the International Bureau is that the holder could submit the request in one official form and in one of the three working languages of the Madrid System. The holder would need to indicate in the request the Contracting Party where replacement has occurred, one Contracting Party per form, together with the relevant information, such as the national or regional registration number, the date of effect of the registration, and the goods and services concerned by replacement. The International Bureau would record this information in the International Register and notify it to the Offices concerned.

20. The Office would then have the possibility to send to the International Bureau a notification simply indicating that it has taken note of replacement or, where applicable, a notification listing the goods and services in respect of which it has taken note. Otherwise, the Office could send a notification indicating that it cannot take note of replacement in its Register and stating the reasons why it cannot do so. The latter would, for example, be the case where the Office considers that the conditions listed in Articles 4*bis* of the treaties had not been met. Any further action taken by the Office on a request to take note of replacement could be notified, inscribed and transmitted to the holder under the same Rule.

21. No time limit is being proposed for an Office to send a notification following a notification by the International Bureau of the recording of a request to take note of replacement. The Working Group is invited to consider whether such would be a desirable feature and discuss the possible consequences resulting from the failure to send that notification, taking into account that replacement, as such, would not be affected on that account.

22. Should the above described procedure be acceptable and the proposed modifications to Rule 21 be adopted, an official form for the presentation of the request and a model form to be used by Offices would be prepared in due time, in consultation with the Offices and the users' organizations.

23. While there would be no fee payable for the filing of the request before the International Bureau, designated Contracting Parties may require payment of a fee for taking note of replacement in their national or regional Register.

24. Replacement is also the subject of document MM/LD/WG/12/5 presented to the Working Group in this session, reporting on information provided to the International Bureau by volunteering Offices of Contracting Parties on practices for the implementation of replacement.

#### **IV. SUBSEQUENT DESIGNATIONS (RULES 24 AND 36)**

##### **A. BACKGROUND**

25. Rule 24 of the Common Regulations is concerned with subsequent designations, which are later requests for territorial extension of the protection resulting from the international registration (see Articles 3<sup>ter</sup> of the Agreement and the Protocol). Subsequent designation is a procedure separate from those concerning changes affecting the international registration (Rules 25 to 27), and from the procedure concerning an international application (Rules 9 to 13).

26. Paragraph (3) of Rule 24 sets out the contents of the request for subsequent designation. Subparagraph (a)(iv) states that the subsequent designation should indicate whether "*[such designation] is for all the goods and services listed in the international registration concerned [...]*" or list the goods and services "*[...] where the subsequent designation is for only part of the goods and services listed in the international registration concerned [...]*."

27. Paragraph (5) of Rule 24 is concerned with irregularities that could affect the subsequent designation. The Office of the Contracting Party of the holder does not have the same institutional role in remedying irregularities as that of the Office of origin in respect of the international application, mainly because the holder can present subsequent designations to the International Bureau directly. Where the holder presents the form through an Office, the main functions of that Office relate to correcting certain specific irregularities, for example, the lack of signature by the Office.

28. In the period from 2009 to 2013, the annual percentage of subsequent designations presented by holders directly to the International Bureau, relative to the total number of subsequent designations, has grown steadily, and, since 2012, most subsequent designations are presented directly (see Table 1).

Table 1

*Percentage of subsequent designations presented by holders directly to the International Bureau (2009 to 2013)*

<b>Year</b>	<b>Percentage of subsequent designations presented directly to the International Bureau</b>
2009	35.43%
2010	41.88%
2011	47.38%
2012	53.13%
2013	57.82%

## B. PROPOSAL

29. This proposal concerns two amendments to Rule 24:

(a) Clarifying that the examination of subsequent designations undertaken by the International Bureau also requires examination of the list of goods and services; and

(b) Limiting the abandonment of the subsequent designation to the designated Contracting Party concerned, where an irregularity related to a declaration of intention to use is not remedied.

### Examination of the list of goods and services

30. A subsequent designation may be made for: (i) all of the goods and services listed in the international registration in respect of all of the Contracting Parties subsequently designated; (ii) some only of the goods and services listed in the international registration (i. e., a reduced list of goods and services, but the same reduced list) in respect of all of the Contracting Parties subsequently designated; (iii) a reduced list of goods and services and for some only of the Contracting Parties subsequently designated. In the second and third cases, the subsequent designation would, in effect, carry a limitation of the main list of the international registration.

31. In principle, a subsequent designation should be viewed as a mere extension of the original international registration and therefore, again, in principle, there should be no need for the International Bureau to re-examine the list of goods and services. The reality is, however, that many subsequent designations refer to a reduced list for some or all of the Contracting Parties (i.e., a limitation).

32. Offices of Contracting Parties have requested the International Bureau to examine the reduced lists presented in subsequent designations, to ensure that these comply with the principles of classification set out in Rules 12 and 13 of the Common Regulations, and to confirm that they, in fact, fall within the main list and not expand it.

33. The first proposed amendment to Rule 24 would clarify that the International Bureau should examine the classification of goods and services where the subsequent designation is for only part of the main list. This proposal follows up the conclusions reached in the Working Group Roundtable where this issue was discussed.

34. Rule 24(5) sets out that the irregularities in a subsequent designation concern failure to meet the requirements as provided for in paragraphs (1) to (4), which already cover the indication of the goods and services concerned that must be provided under paragraph (3). However, for further clarity, it is proposed that a reference to Rules 12 and 13 be added to paragraph (5)(a). This addition would expressly state that the International Bureau should undertake examination of subsequent designations where these are for only part of the goods and services listed in the international registration. The examination procedure would be in accordance with the procedure already in place in respect of Rules 12 and 13, and it would clearly enable the International Bureau to address irregularities concerning the classification of, or the indication of, the goods and services mentioned in the subsequent designation.

35. There would, however, be one fundamental difference compared to the procedures set out in Rules 12 and 13, as the irregularities concerning the goods and services mentioned in the subsequent designation would be remedied directly by the holder and, where the subsequent designation has been presented through an Office, this Office would only receive a copy of the resulting notification. The proposal seeks to avoid unnecessary complexity and possible delays resulting from including an Office which might not have been involved with how the holder has presented the goods and services in the subsequent designation.

36. As it is the case today, requests for the recording of limitations presented under Rule 25 would not undergo examination of the limited list of goods and services mentioned in the requests. Holders seek a limitation under this Rule to avoid or overcome provisional refusals by designated Contracting Parties and present the request for its recording often using specific wording suggested by the Offices of those designated Contracting Parties. Additional examination by the International Bureau could interfere with this process and lead to unwarranted delays.

Limiting the abandonment of the subsequent designation to the designated Contracting Party concerned, where an irregularity related to a declaration of intention to use is not remedied

37. The second proposed amendment to Rule 24 would limit the consequences resulting from an irregularity related to a missing or defective declaration of intention to use the mark which is not remedied.

38. Where official form MM18 has not been submitted together with a subsequent designation covering the United States of America, or where the submitted form is defective, and where this irregularity is not remedied within the given time limit, the consequence, under the current version of Rule 24, is that the *entire* subsequent designation is considered abandoned, with effect for all the Contracting Parties indicated in the subsequent designation.

39. To reduce the negative effect on the subsequent designation in a situation where an irregularity concerning the declaration of intention to use (MM18) has not been remedied within the given time limit, the International Bureau proposes to amend Rule 24(5)(c). Under the proposed amendment, only the designation of the concerned Contracting Party requiring the declaration of intention to use the mark would be affected, and the International Bureau would continue processing the subsequent designation where other Contracting Parties are indicated.

## V. INTRODUCING A FEE PER LIMITATION IN INTERNATIONAL APPLICATIONS AND FOR A REDUCED LIST OF GOODS AND SERVICES IN A SUBSEQUENT DESIGNATION

### A. BACKGROUND

40. It is clear that there has been a substantial growth in the number of limitations presented in international applications, of subsequent designations concerning only a part of the main list, and of requests for the recording of limitations under Rule 25. Table 2, below, which presents the relevant figures from 2000 to 2010, shows that those numbers are increasing in line with the geographical expansion of the Madrid System.

Table 2

*Number of limitations presented in international applications, subsequent designations concerning only a part of the main list and requests for recording of limitations under Rule 25 (2000 to 2010)*

<b>Number of requests</b>	<b>2000</b>	<b>2002</b>	<b>2004</b>	<b>2006</b>	<b>2008</b>	<b>2010</b>
Limitations in international applications	497	788	1,294	3,035	3,680	3,436
Subsequent designations concerning only a part of the main list	406	554	1,384	1,588	1,853	1,592
Requests for recording of limitations filed under Rule 25	408	1,080	1,856	2,033	3,019	2,948

41. Almost 10% of all international applications filed in the last three years contain one or more limitations, while around 18% of all subsequent designations filed in the same period were for only part of the main list. This has had a direct impact on the workload of the International Bureau. (Please, see Table 3 below; requests for recording of limitations filed under Rule 25 are included for comparison purposes).

Table 3

*International applications containing limitations and subsequent designations for only part of the main list (2011 to 2013)*

<b>Year</b>	<b>Type</b>	<b>Number of applications or requests</b>	<b>Applications or requests with a limited or reduced list</b>	<b>Percentage of applications or requests with a limited or reduced list</b>
<b>2011</b>	International applications	40,711	3,978	9.77%
	Subsequent designations	13,668	2,248	16.45%
	Limitations under Rule 25	3,337		
<b>2012</b>	International applications	41,954	4,141	9.87%
	Subsequent designations	14,283	2,892	20.25%
	Limitations under Rule 25	5,187		
<b>2013</b>	International applications	44,414	4,332	9.75%
	Subsequent designations	14,380	2,644	18.39%
	Limitations under Rule 25	3,864		

42. Along with an increase in the number of limitations in international applications or subsequent designations with a reduced main list for specific designated Contracting Parties, the number of words used to express the limited or reduced list has also increased. The average number of words in the main list of goods and services presented in an international application, without any limitation, was 98, 113 and 121 words in, correspondingly, 2011, 2012 and 2013. Meanwhile, in the same years, the average number of words in a limitation requested in the international application was 192, 136 and 175 words. (Please, see Table 4 below).

Table 4

*Average number of words expressed in a limited or reduced list of goods and services (2011 to 2013)*

<b>Year</b>	<b>Type</b>	<b>Average number of words in the main list</b>	<b>Number of words to express a limited or reduced lists</b>	<b>Average number of words to express a limited or reduced list</b>
<b>2011</b>	International applications	98	763,273	192
	Subsequent designations		106,509	47
	Limitations under Rule 25		244,267	73
<b>2012</b>	International application	113	307,370	136
	Subsequent designation		560,757	106
	Limitations under Rule 25		560,196	108
<b>2013</b>	International application	121	184,861	175
	Subsequent designation		413,082	70
	Limitations under Rule 25		413,448	107

## B. PROPOSAL

43. The increased workload of the International Bureau to examine limitations supports an appropriate adjustment of the fee structure to cover the added related cost. Currently, there is a fee for a request for recording of a limitation presented under Rule 25, with an amount set at 177 Swiss francs per limitation. The International Bureau is proposing that a similar fee be applicable for limitations in international applications and for subsequent designations covering only part of the main list.

44. It is proposed that Rule 10 be modified accordingly, and item (v) be deleted from Rule 36. In addition, items 1, 2, 3 and 5 of the Schedule of Fees are proposed to be amended, introducing a fee of 177 Swiss francs to cover the costs of the examination of limitations in an international application and of the reduced list of goods and services in a subsequent designation. The text of item 7 of the Schedule of Fees is also proposed to be amended to clearly state that the fee applies per limitation.

## **VI. EXEMPTION FROM FEES OF CERTAIN RECORDINGS (RULE 36)**

### **A. BACKGROUND**

45. Rule 36 stipulates the gratuity of certain recordings. Specifically, under item (ii) of the provision, the recording of any change concerning the telephone and telefacsimile numbers of the holder is exempted from fees.

### **B. PROPOSAL**

46. It is proposed to amend Rule 36 to clarify that additional recording of changes is exempt from fees, more specifically the recording of changes concerning the address for correspondence and the electronic mail address of the holder, as the latter is a means of communication increasingly used. There is no reason to exclude these from gratuity, as well as any other means of communication as specified in the Administrative Instructions. Moreover, it is also proposed that, for the sake of clarity, it is mentioned that the gratuity of these changes extends to applicants. The proposed change would encourage applicants and holders to timely update this information to ensure that they actually receive the various communications sent by the International Bureau, and it would make the Madrid System more user-friendly.

## **VII. FACILITATING THE USE OF E-FORMS**

### **A. BACKGROUND**

47. The International Bureau has recently developed an electronic form (e-form) for subsequent designations. E-subsequent designation is available on the Madrid System web site (<https://www3.wipo.int/osd/>). Other e-forms are under development and will be available in the near future to request the recording of specific changes, such as limitations, cancellations and changes in the name or address of the holder.

48. A trademark holder, or his appointed representative, may acquire a WIPO account and manage his portfolio of international registrations through a web user tool called the Madrid Portfolio Manager (<https://www3.wipo.int/login/en/mpm/index.jsp>). A WIPO account is established in agreement with the International Bureau and it provides with a secure log-in and identification. The new e-forms will be accessible only through the use of the Madrid Portfolio Manager.

### **B. PROPOSAL**

49. To facilitate the use of the new e-forms, it is proposed to amend the requirement of signature as set out in Section 7 of the Administrative Instructions, to allow a signature to be replaced by a mode of identification determined by the International Bureau where the signatures of applicants, holders or representatives are concerned.

## VIII. IDENTIFYING DESIGNATIONS

### A. BACKGROUND

50. A Contracting Party may be designated more than once in an international registration. In general, holders use this feature in a sensible manner, designating one Contracting Party more than once but for different goods and services. Several designations of the same Contracting Party, with overlapping goods and services, usually occur when a previous designation has been the subject of a limitation, renunciation, final refusal or invalidation. Where several designations of the same Contracting Party are contemporaneous, determining the scope of protection in a designated Contracting Party is a very difficult task, because the Offices concerned have no means to indicate to which designation a particular decision applies.

### B. PROPOSAL

51. It is proposed that, for ease of reference, the Administrative Instructions be amended to provide for a simple but unique reference code each time a Contracting Party is designated in an international registration. This code would be clearly indicated in the corresponding notification to the Office of the designated Contracting Party concerned. The Office might use this code when processing designations made in an international registration, and refer to it when sending communications under the Common Regulations. However, it is to be noted that Offices would not be required to either use or indicate that code in those communications. Subject to further technical considerations, this code could consist of, for instance, the WIPO Standard ST.3 two-letter code corresponding to the designated Contracting Party concerned followed by a number.

*52. The Working Group is invited to:*

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

*(ii) indicate whether it would recommend to the Madrid Union Assembly some or all of the proposed amendments to the Common Regulations, the Schedule of Fees and the Administrative Instructions, as presented in the Annexes to this document or in amended form, and suggest a date for their entry into force.*

[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**

**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 to send the communication was not met because of failures in the electronic communication systems of the International Bureau or on account of war, revolution, civil disorder, strike, natural calamity, or any other like reason.

~~(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 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,

(viii) 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,

(ix) where the basic application or the basic registration relates to a three-dimensional mark, the indication "three-dimensional mark,"

(x) where the basic application or the basic registration relates to a sound mark, the indication "sound mark,"

(xi) 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,

(xii) ~~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,~~

(xiii) 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) a description of the mark by words.

(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**is**) to ~~(xi)~~(x) and appearing in the international application appears also in the basic application or the basic registration, as the case may be,

[...]

[...]

#### Rule 10

#### *Fees Concerning the International Application*

(1) *[International Applications Governed Exclusively by the Agreement]* An international application governed exclusively by the Agreement shall be subject to the payment of the basic fee, the complementary fee and, where applicable, the supplementary fee and/or the fee per limitation, specified in item 1 of the Schedule of Fees. Those fees shall be paid in two instalments of ten years each, but for the fee per limitation, that shall be paid in the first instalment only. For the payment of the second instalment, Rule 30 shall apply.

(2) *[International Applications Governed Exclusively by the Protocol]* An international application governed exclusively by the Protocol shall be subject to the payment of the basic fee, the complementary fee and/or the individual fee and, where applicable, the supplementary fee and/or the fee per limitation, specified or referred to in item 2 of the Schedule of Fees. Those fees shall be paid for ten years.

(3) *[International Applications Governed by Both the Agreement and the Protocol]* An international application governed by both the Agreement and the Protocol shall be subject to the payment of the basic fee, the complementary fee and, where applicable, the individual fee and the supplementary fee and/or the fee per limitation, specified or referred to in item 3 of the Schedule of Fees. As far as the Contracting Parties designated under the Agreement are concerned, paragraph (1) shall apply. As far as the Contracting Parties designated under the Protocol are concerned, paragraph (2) shall apply.

[...]

#### Chapter 4 Facts in Contracting Parties Affecting International Registrations

[...]

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

(1) *[Notification Presentation of a Request for an Office to Take Note of Replacement]* ~~Where, in accordance with Article 4bis(2) of the Agreement or Article 4bis(2) of the Protocol, A request for~~ the Office of a designated Contracting Party ~~has to~~ take note in its Register, ~~following a request made direct by the holder with that Office,~~ that a national or a regional registration has been replaced by an international registration, ~~that Office shall notify the International Bureau accordingly.~~ shall be presented by the holder to the International Bureau on the relevant official form, in one copy, and ~~Such notification~~ shall indicate

(i) the number of the international registration concerned,  
(ii) the Contracting Party where replacement has occurred,  
~~(ii)(iii)~~ where ~~the~~ replacement concerns only one or some of the goods and services listed in the international registration, those goods and services, and  
~~(iii)(iv)~~ the filing date and number, the registration date and number, and, if any, the priority date of the national or regional registration which has been replaced by the international registration.

The notification request 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 and Notification of a Request for an Office to Take Note of Replacement]* (a) The International Bureau shall record the indications ~~notified~~ provided under paragraph (1) in the International Register and shall ~~inform~~ notify the Office of the designated Contracting Party concerned and the holder, ~~accordingly.~~

(b) The indications ~~notified~~ provided under paragraph (1) shall be recorded as of the date of receipt by the International Bureau of a notification request complying with the applicable requirements.

*[Notification Following the Recording of a Request for an Office to Take Note of Replacement]* (a) The Office of a Contracting Party notified under paragraph (2) shall send to the International Bureau

(i) a notification to the effect that it has taken note of replacement in its Register; or,

(ii) where replacement concerns only one or some of the goods and services listed in the international registration, a notification to the effect that it has taken note of replacement listing those goods and services; or,

(iii) a notification indicating that it cannot take note of replacement in its Register and stating the reasons why it cannot do so.

(b) The International Bureau shall record any notification received under this paragraph, inform the holder accordingly and transmit a copy of the notification to the holder.

[...]

## **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 the holder shall remedy the irregularity directly with the International Bureau. Where the International Bureau considers that the goods and services, as indicated in the subsequent designation, are not listed in the international registration concerned, the subsequent designation shall be deemed not to contain those goods and services.

(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.

[...]

## 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) ~~[Deleted]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]

## PROPOSED AMENDMENTS TO THE SCHEDULE OF FEES

### SCHEDULE OF FEES

Swiss francs

1. *International applications governed exclusively by the Agreement*

The following fees shall be payable and shall cover 10 years, but for the fee per limitation that shall be payable only once:

[...]

1.4 Per limitation contained in an international application 177

2. *International applications governed exclusively by the Protocol*

The following fees shall be payable and shall cover 10 years, but for the fee per limitation that shall be payable only once:

2.5 Per limitation contained in an international application 177

3. *International applications governed by both the Agreement and the Protocol*

The following fees shall be payable and shall cover 10 years, but for the fee per limitation that shall be payable only once:

3.5 Per limitation contained in an international application 177

[...]

5. *Designation subsequent to international registration*

The following fees shall be payable and shall cover the period between the effective date of the designation and the expiry of the then current term of the international registration:

5.4 Where the subsequent designation is for only part of the goods and services listed in the international registration concerned, per reduced list of goods and services in the subsequent designation 177

[...]

7. *Miscellaneous recordings*

[...]

7.3 [Per U](#) limitation requested by the holder subsequent to international registration, provided that, if the limitation affects more than one Contracting Party, it is the same for all

177

[...]

[...]

[Annex III follows]

## PROPOSED AMENDMENTS TO THE ADMINISTRATIVE INSTRUCTIONS

### Administrative Instructions for the Application of the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating Thereto

[...]

#### Part Three Communications with the International Bureau; Signature

[...]

##### *Section 7: Signature*

A signature shall be handwritten, printed or stamped; it may be replaced by the affixing of a seal. As regards the electronic communications referred to in Section 11(a)(i), a signature may be replaced by a mode of identification agreed upon between the International Bureau and the Office concerned. ~~With respect to the electronic communications referred to in Section 11(a)(ii), a signature may be replaced by a mode of identification to be, or as in the manner~~ determined by the International Bureau where communications with applicants or holders are concerned.

#### Part Six Numbering of International Registrations

##### *Section 15bis: Numbering of Requests for Territorial Extension*

A request for territorial extension to a Contracting Party, registered in accordance with Rule 14(1) or recorded in accordance with Rule 24(8), shall bear a unique code.

##### *Section 16: Numbering Following Partial Change in Ownership*

(a) Assignment or other transfer of the international registration in respect of only some of the goods and services or only some of the designated Contracting Parties shall be recorded in the International Register under the number of the international registration of which a part has been assigned or otherwise transferred.

(b) Any assigned or otherwise transferred part shall be cancelled under the number of the said international registration and recorded as a separate international registration. The separate international registration shall bear the number of the registration of which a part has been assigned or otherwise transferred, together with a capital letter.

[End of Annex III and of document]