

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. This document contains proposals to amend 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”). More specifically, the proposals concern amendments to Rules 12, 21, 25, 26, 32 and to item 7.4 of the Schedule of Fees. These proposals support the ongoing process of making the Madrid System for the International Registration of Marks (hereinafter referred to as “the Madrid System”) more user-friendly and attractive to its users, Offices of Contracting Parties and interested third parties. The proposals are reproduced in the Annex to this document.

EXAMINATION OF LIMITATIONS BY THE INTERNATIONAL BUREAU

2. In its twelfth session, the Working Group on the Legal Development of the Madrid System for the International Registration of Marks (hereinafter referred to as “the Working Group”) discussed the level of examination to be undertaken by the International Bureau concerning subsequent designations in which the list of goods and services is limited to only part of the goods and services listed in the international registration concerned.

3. As one of the outcomes of the said session, the Working Group agreed to recommend to the Madrid Union Assembly an amendment to Rule 24 of the Common Regulations (see documents MM/LD/WG/12/2 and MM/LD/WG/12/6). Under this amendment, where a subsequent designation is made for a limited list of goods and services, the International Bureau would control the classification of the terms used to express a limitation in a subsequent designation, in accordance with Rules 12 and 13 of the Common Regulations. In doing so, the International Bureau would not examine the limited list to determine whether it falls within the scope of the main list. This determination shall be made by the Offices of the designated Contracting Parties where the limitation has effect.

4. A limitation of the list of goods and services for one or more designated Contracting Parties can also be made in an international application (Rule 9(4)(a)(xiii)) and as a request for the recording of change in the international registration (Rule 25(1)(a)(ii)).

5. In 2014, during discussions on this particular subject held in the Madrid Working Group Roundtable and in the previous session of the Working Group, observers from users' organizations expressed the view that it would be beneficial for the users of the Madrid System that similar recordings follow, as far as possible, the same examination process and suggested that the level of the examination of limitations, in particular, the control of the classification exercised by the International Bureau, be clearly indicated in the Common Regulations.

6. The examination of limitations should properly balance:

- the International Bureau's mandate to ensure sufficiently clear information in the International Register concerning properly classified goods and services;
- the need of applicants and holders to avoid unnecessary delays in the processing of international applications, subsequent designations or requests for the recording of a change; and
- the Offices of the designated Contracting Parties' right to avail themselves of the existing mechanisms for their substantive decision on the scope of protection.

CONTROL OF THE CLASSIFICATION OF INDICATIONS OF GOODS AND SERVICES USED TO EXPRESS LIMITATIONS IN INTERNATIONAL APPLICATIONS

Background

7. According to Rule 9(4)(a)(xiii) of the Common Regulations, an applicant may limit the list of goods and services in respect of one or more Contracting Parties designated in an international application.

8. Applicants take advantage of this flexibility for various reasons, such as to align the scope of protection with their commercial interests in particular territories; to prevent possible provisional refusals, due to, for example, a high degree of specification required by the Office of that Contracting Party; or, to avoid possible conflicts with prior rights.

9. The share of international registrations including one or more limitations has remained stable since 2011, at around 10% of the total number of registrations. However, as the number of international registrations has increased by 4.2% between 2011 and 2014, the number of applications containing one or more limitations has grown by 8.2% in the same period (see Table I).

Table I: Limitations in International Registrations, Subsequent Designations or Recorded as a Change (2011 to 2014)

| Year | Type | Number of Registrations or Recorded Requests | Applications or Requests with a Limited List | Percentage of Applications or Requests with a Limited List |
|------|-----------------------------|--|--|--|
| 2011 | International Registrations | 40,711 | 3,978 | 9.8% |
| | Subsequent Designations | 13,668 | 2,248 | 16.4% |
| | Limitations under Rule 25 | 3,337 | | |
| 2012 | International Registrations | 41,954 (▲3.1%) | 4,141 (▲4.1%) | 9.9% |
| | Subsequent Designations | 14,283 (▲4.5%) | 2,892 (▲28.6%) | 20.2% |
| | Limitations under Rule 25 | 5,187 (▲55.4%) | | |
| 2013 | International Registrations | 44,414 (▲5.9%) | 4,332 (▲4.6%) | 9.8% |
| | Subsequent Designations | 14,380 (▲0.7%) | 2,644 (▼8.6%) | 18.4% |
| | Limitations under Rule 25 | 3,864 (▼25.5%) | | |
| 2014 | International Registrations | 42,430 (▼4.5%) | 4,304 (▼0.6%) | 10.1% |
| | Subsequent Designations | 15,824 (▲10.0%) | 3,211 (▲21.4%) | 20.3% |
| | Limitations under Rule 25 | 4,389 (▲13.6%) | | |

10. More significant than the growth in the number of international registrations with one or more limitations, has been the increase in the number of words used to express a limitation. While in 2012 and 2013, the number of words used to express a limitation in an international registration decreased, respectively, by 61% and 42%, that number increased by 413% in 2014. A similar situation was experienced in respect to the number of words used to express a limitation in a subsequent designation, which increased by 309% in 2012, decreasing by 19% and 46% in the following years. Overall, since 2012, there has been an increasing trend in the number of words to express a limitation, with a high degree of year-to-year variance (see Table II).

Table II: Average Number of Words Expressed in a Limited List of Goods and Services (2011 to 2014)

| Year | Type | Average number of Words in the Main List | Number of Words to Express a Limited List | Average Number of Words to Express a Limited List |
|------|-----------------------------|--|---|---|
| 2011 | International Registrations | 98 | 763,273 | 192 |
| | Subsequent Designations | | 106,509 | 47 |
| | Limitations under Rule 25 | | 244,267 | 73 |
| 2012 | International Registrations | 113 (▲15.3%) | 307,370 (▼59.7%) | 74 (▼61.3%) |
| | Subsequent Designation | | 560,757 (▲426.5%) | 194 (▲309.2%) |
| | Limitations under Rule 25 | | 560,196 (▲129.3%) | 108 (▲47.9%) |
| 2013 | International Registrations | 121 (▲7.1%) | 184,861 (▼39.9%) | 43 (▼42.5%) |
| | Subsequent Registrations | | 413,082 (▼26.3%) | 156 (▼19.4%) |
| | Limitations under Rule 25 | | 413,448 (▼26.2%) | 107 (▼0.9%) |
| 2014 | International Registrations | 144 (▲19.0%) | 942,898 (▲410.1%) | 219 (▲413.4%) |
| | Subsequent Designation | | 270,105 (▼34.6%) | 84 (▼46.2%) |
| | Limitations under Rule 25 | | 532,253 (▲28.7%) | 121 (▲13.1%) |

11. The control of the classification of indications used to express limitations in international applications is undertaken by the International Bureau in accordance with Rules 12 and 13. Paragraph (1) of Rule 12 refers to the requirements under Rule 9(4)(a)(xiii), which includes limitations, and Rule 13 refers to the terms used to indicate any of the goods and services in the international application, which also includes those terms used in a limitation. Where the International Bureau finds a limitation in an international application to be irregular, it will invite the Office of origin to remedy this irregularity, in line with the procedures set out in Rules 12 and 13. Nevertheless, the Rules concerned do not expressly indicate that the irregularity should only refer to the control of the classification exercised by the International Bureau, in particular, for irregularities under Rule 12.

Proposal

12. In order to increase the consistency and predictability of the outcome of the examination of limitations in international applications undertaken by the International Bureau, it is proposed that Rule 12 of the Common Regulations be amended for clarity. Under Rule 12, the International Bureau should control that the indications used to express a limitation in an international application are properly classified under the numbers of the classes in the main list. However, it should not examine those terms to determine whether they are indeed a limitation or an extension of that main list, as this determination falls entirely under the competence of the Offices of the designated Contracting Parties.

13. Consequently, the introduction of a new paragraph (8bis) in Rule 12 is being proposed. Under the proposed new paragraph, where the International Bureau considers that all the goods and services listed in a limitation made in an international application cannot be grouped in the classes contained in the main list of that application, the International Bureau should raise an irregularity. Paragraphs 1(a) and (2) to (6) would apply *mutatis mutandis*. Should the irregularity not be timely remedied, the limitation would be deemed not to contain the goods and services mentioned in the irregularity.

14. Paragraphs 1(b), 7 and 8 of Rule 12 would not apply, as an irregularity concerning goods and services listed in a limitation made in an international application that cannot be grouped under the classes in the main list of that application would not result in additional classes.

15. Under the proposed amendment to Rule 12, the control of the classification of the indications used to express limitations made in an international application would be equivalent to that for limitations made in a subsequent designation.

EXAMINATION OF LIMITATIONS REQUESTED AS THE RECORDING OF A CHANGE UNDER RULE 25

Background

16. Holders seeking the recording of a limitation under Rule 25 regularly do so to satisfy a time-sensitive need, such as to overcome a provisional refusal, to avoid possible third-party actions or to limit the scope of protection before the renewal of an international registration. In the first example, the terms used to express the limitation often follow specific wording suggested by the Office that issued the provisional refusal.

17. Limitations recorded as a change under Rule 25 are different in nature from those limitations included in an international application or in a subsequent designation. The recording of a limitation under Rule 25 is requested after the international registration has effect and, possibly, after the mark has been granted protection in the designated Contracting Parties. Therefore, it would correspond to the Office of the designated Contracting Parties to examine the substantive elements of the limitation and, where appropriate, declare that such limitation has no effect in accordance with the applicable national or regional law.

18. Examination by the International Bureau of requests for the recording of a limitation under Rule 25 should therefore be limited to ensure that all formalities have been met, without adding unnecessary complexities. Moreover, should the International Bureau exercise control of the classification of the indications set out in the request, it might interfere with wording agreed between the holder and the Office or a third party, or with wording that might be acceptable to the Offices where the limitation is to have effect.

Proposal

19. It is proposed that it be further clarified in the Common Regulations, in an amendment to Rule 26, that the formal examination undertaken by the International Bureau of requests for the recording of a limitation under Rule 25 be limited to verifying the correspondence between the class numbers indicated in the limitation and those contained in the international registration concerned. This proposal will increase the consistency and predictability of the outcome of the examination of these requests.

20. Under proposed paragraph (1) of Rule 26, where the class numbers indicated in a request for the recording of a limitation under Rule 25 do not correspond to those contained in the international registration, subject to paragraph (3), the International Bureau would notify that fact to the holder and, if the request was made by an Office, to that Office. Should the International Bureau raise such irregularity, the holder would be given a time limit of three months to remedy it; otherwise, in accordance with paragraph (2), the request would be considered abandoned.

CONSIDERATIONS ON THE IMPACT RESULTING FROM THE INTRODUCTION OF A CONSISTENT PRACTICE FOR THE CONTROL OF THE CLASSIFICATION OF INDICATIONS OF GOODS AND SERVICES USED TO EXPRESS LIMITATIONS IN INTERNATIONAL APPLICATIONS AND SUBSEQUENT DESIGNATIONS

21. Following the entry into force of the above-mentioned recommended amendment to Rule 26, as well as the proposed amendment to Rule 12, the International Bureau will control, in a similar and consistent manner, the classification of indications used to express limitations included in international applications and subsequent designations. The introduction of this consistent practice would have an impact on the Madrid Registry, as it would require changes to its administrative systems, to its processes and to its resources.

22. The administrative systems would have to be modified to apply the existing classification tools developed by the International Bureau to the examination of limitations in international applications and subsequent designations. Moreover, the contents of the communications sent by the International Bureau regarding irregularities in international applications and subsequent designations would have to be reviewed and adapted to align it with the amended Rules and with the new consistent practice.

23. The International Bureau is in the validation phase of its new administrative system, the Madrid International Registries Information System (MIRIS) and, as a result, it has stopped further developments in its current administrative system during the transition to avoid work and cost duplication. It is anticipated that the above-described changes would be developed in MIRIS only and introduced once MIRIS has been deemed to be stable.

24. The existing examination process of the Madrid Registry would have to be adapted to ensure a consistent application of the classification principles for the control of all the indications of goods and services used in international applications and subsequent designations. International applications and subsequent designations, including any limitation therein requested, would be assigned to the same cluster of qualified examiners dealing with classification matters, after the examination of other formalities is completed. It is expected that the new process be documented and that the resulting internal training needs be thoroughly addressed before the new consistent practice is deployed.

25. Finally, the introduction of the new consistent practice would also have a measurable impact on the resources required by the Madrid Registry. As seen in Table I, above, there were 4,304 international applications and 3,211 subsequent designations with one or more limitations recorded in 2014. Taking into account the average number of words used to express a limitation and the amount of work resulting from irregularities raised under Rules 12 and 13, the International Bureau estimates that no fewer than four qualified new examiners would need to be allocated to handle the resulting additional workload, under a zero growth assumption. The required additional resources would keep the introduction of the new consistent practice from having a negative impact on the average pendency of international applications and subsequent designations.

26. The International Bureau would introduce the consistent practice described above, subject to the deployment of the required changes to its administrative system, the successful implementation of the required changes to its current processes and, most importantly, the availability of the additional human resources required to handle the anticipated workload increase.

27. Taking into account the previous considerations, the International Bureau suggests that the proposed changes to Rules 12 and 26 enter into force on April 1, 2017, at the earliest, subject to having met the conditions indicated in the preceding paragraph.

REPLACEMENT

BACKGROUND

28. Replacement was discussed in two documents in the last session of the Working Group. Document MM/LD/WG/12/2 contained a proposal to amend Rule 21 by introducing a new procedure to request that an Office take note of replacement. Document MM/LD/WG/12/5 presented the findings of a questionnaire on the implementation of replacement by the Offices of the Contracting Parties to the Madrid System.

29. The findings presented in the latter document revealed that divergent interpretations, procedures and practices continue to exist in respect of the implementation of replacement under Articles 4*bis* of the Agreement and the Protocol and Rule 21 of the Common Regulations. More troublesome, the findings showed that there are different interpretations of the key elements of replacement, namely, (i) its effective date; (ii) the time at which a request under Articles 4*bis*(2) may be filed with the Office; (iii) the goods and services listed in the replaced national or regional registration; and, (iv) the effects on the replaced national or regional registration.

30. The Working Group requested that the International Bureau submit, for its next session, a new proposal for the amendment of Rule 21, which would clarify the aspects of replacement that were discussed.

PROPOSAL

Inclusion of Key Elements in Rule 21

31. It is proposed that Rule 21 be amended to reflect the discussions of the Working Group during its previous session and to incorporate the four key elements mentioned above. These four key elements are all set out in paragraph (1), namely that

- the effective date of replacement is the date of the international registration or the date of subsequent designation;
- the Offices should accept requests to take note of replacement as from the date of notification of the international registration or the subsequent designation by the International Bureau;
- the goods and services listed in the national or regional registration are all listed in the international registration, but that the international registration does not need to have an identical list of goods and services: the list in the international registration can be broader in scope, but not narrower. The names of the goods and services used in the international registration do not need to be the same, but they must be equivalent; and
- the national or regional registration and the international registration that is replacing it should be able to co-exist. Replacement itself does not necessarily imply or require a cancellation of the national or regional registration. It should be a decision by the holder whether to renew the national or regional registration.

Procedure for Requesting that an Office Take Note

32. The proposed revised Rule 21 envisages a new procedure for the holder to request that an Office of a designated Contracting Party take note of an international registration. It is proposed that the holder present the request through the International Bureau, thus streamlining the filing process and saving the need to present a request before the Office of each designated Contracting Party concerned. The request may be presented as from the date of notification of the international registration or the subsequent designation, as the case may be, using the relevant official form, one form per designated Contracting Party.

33. The request must be per Contracting Party and provide the following information:

- the number of the international registration concerned;
- the Contracting Party where replacement has occurred;
- where replacement concerns only one or some of the goods and services listed in the international registration, those goods and services; and
- the relevant information concerning the national or regional registration that the international registration is deemed to have replaced, such as the national or regional filing date and number, the registration date and number, and the priority date, if any.

34. The request may also contain information regarding any other rights acquired by virtue of that national or regional registration.

Effect of Replacement on the Replaced Registration

35. In its previous session, the Working Group discussed whether or not replacement implied automatic cancellation of the replaced registrations; such was the current practice in certain Contracting Parties. The Secretariat was asked to investigate the revisions of the Madrid System legal framework, to clarify this point. This investigation has revealed the following:

Act of Brussels (1900):

Replacement (with the name “substitution”) was introduced by the Act of Brussels in 1900. A new Article 4*bis* was inserted in the Agreement, with the following wording: “*When a mark already filed in one or more of the contracting States is later registered by the International Bureau in the name of the same proprietor or his successor in title, the international registration shall be deemed to have replaced the earlier national registrations, without prejudice to any rights acquired by reason of such earlier registrations*”^{*}.

The background documents explained that the purpose of replacement was to prevent a refusal of the international registration by the national jurisdiction thus (a) ensuring the unification of the status of the mark (as to the deposit, duration of the protection, renewal, assignment) and (b) preserving the reduced expenses of the international registration. The previous national registration would not affect the validity of the international registration. In turn, replacement, as such, would not affect the validity of the previous national or regional registration.

^{*} This text is available in French only.

Act of London (1934):

In 1934, Article 4bis was subsequently modified by the Act of London, when paragraph (2) was added to the provision, stating that “(2) *The national Office shall, upon request, be required to take note in its registers of the international registration*”.

In the “*Exposé général sur le Service de l’enregistrement international des marques de fabrique ou de commerce*”, the International Bureau stated that a national Administration had asked whether replacement would entail the cancellation of the replaced national mark. The answer was clear: “*We [the International Bureau] do not recommend such cancellation, since, should the international mark be cancelled or limited, it would be useful to fully preserve the protection resulting from the earlier national registration*”.

36. In order to clarify the effect of replacement on the replaced national or regional registration, it is now proposed that Rule 21 expressly state that, unless a cancellation of the replaced registration is requested by the holder, it will co-exist with the international registration. Such request for cancellation, separate from the request to take note of replacement, should be made by the holder directly to that Office concerned.

37. Some Contracting Parties require the payment of a fee before its Office can take note of replacement. In the future, the International Bureau could collect and forward those fees. However, there are a number of issues that would need to be clarified before this could be implemented, such as, for instance, how to inform the International Bureau of the fees and any changes to their amounts, the currency used to express these amounts and whether there would be any mechanism to manage exchange rate fluctuations. Moreover, this procedure may also entail legislative or regulatory amendments in the concerned Contracting Parties. Therefore, at this moment, it is not proposed that the International Bureau take on the role of collecting and forwarding the fees required, under the applicable law, for an Office to take note of replacement. In other words, where a Contracting Party requests the payment of this fee, the holder would need to pay it directly to the Contracting Party concerned.

38. Finally, it is proposed that that requests filed under modified Rule 21 do not require the payment of a fee to the International Bureau.

Recording of Replacement in the International Register

39. Paragraph (2) elaborates on the recording and notification by the International Bureau of a request for an Office to take note of an international registration. The indications provided under paragraph (1) shall be recorded as of the date of receipt by the International Bureau of a request complying with the applicable requirements; the International Bureau shall notify the designated Contracting Party and the holder.

Actions by an Office upon Receipt of a Request to Take Note

40. Paragraph (3) deals with the possible actions by an Office that has been notified of a request to take note of an international registration. The proposed wording does not prejudge whether or not the Office would undertake any examination before taking note; this is left to the national or regional law; thus a Contracting Party may exhaust the applicable procedures before making a decision on whether or not the Office should take note of the international registration. The Office must notify the International Bureau that it has either taken note of the international registration and listing the goods and services concerned, where applicable, or that it cannot take note of the international registration, stating the reasons therefor. The International Bureau should record any notification received under this paragraph, publish the received information, inform the holder accordingly and transmit a copy of the notification to the holder. This recorded information will be duly published as prescribed by Rule 32(1)(a)(xi).

41. 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 Effective Date of Replacement

42. Finally, in paragraph (4), the effective date of replacement shall be the date of the international registration or the subsequent designation concerned.

43. 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 and in consultation with Offices and users' organizations.

CONSIDERATIONS FOR THE IMPLEMENTATION OF THE PROPOSED CHANGES AND FOR A POSSIBLE DATE OF ENTRY INTO FORCE

44. It is difficult to estimate the impact the proposed changes will have, in particular, the number of requests that would now be filed directly with the International Bureau under the modified Rule. This, in turn, makes it hard to estimate what human resources would be required to handle any additional workload. The International Bureau has recorded 53, 80 and 63 notifications sent under current Rule 21 in, correspondingly, 2012, 2013 and 2015. Based on these statistics and under the assumption that the number of requests presented under modified Rule 21 would be relatively low, the additional workload could be absorbed by the existing human resources.

45. Nevertheless, the proposed modifications to Rule 21 would introduce new recordings, publications and notifications for which further developments to the information and communication systems and to the processes of the Madrid Registry would be necessary. Offices of the Contracting Parties would have to evaluate these developments and make the necessary adjustments to process the new notifications and communicate the outcome of the request to take note of replacement.

46. Finally, the implementation of proposed Rule 21 may require legislative or regulatory changes in the Contracting Parties of the Madrid System. The Working Group is invited to consider this, as well as all the above-mentioned implications in order to recommend a possible date of entry into force for the proposed modifications to Rule 21.

RECORDING A CHANGE IN THE LEGAL NATURE AND STATE OF ORGANIZATION OF THE HOLDER

BACKGROUND

47. The possibility to provide information on the legal nature and State of organization of the holder, as a legal entity, was introduced in the Madrid System to enable holders to satisfy the requirements in the laws of certain Contracting Parties. It was therefore foreseen that this information could be provided

- in the international application (Rule 9 and set out in the Official forms MM2 and MM3);

- in a request for subsequent designation (Rule 24 and set out in the Official form MM4), where this information had not already been provided in the international application; and

- in a request for the recording of a change in ownership, in respect of the new holder (Rule 25 and set out in the Official form MM5).

48. According to Rule 14(2)(i), this information shall be part of the international registration. However, the legal framework of the Madrid System did not foresee that the information on the legal nature and State of organization of the holder, as a legal entity, could change or be updated in the International Register. The recording in the International Register of a change in the legal nature and State of organization of the holder is not explicitly mentioned in Rule 25, which contains the exhaustive list of possible changes to an international registration that can be recorded in the International Register.

49. The International Bureau frequently receives requests to record a change in the legal nature and State of organization of the holder. In certain Contracting Parties, a legal entity may change its legal nature without this change resulting in a new legal entity. This could pose significant challenges for holders of international registrations in, for instance, prosecution, enforcement and litigation proceedings because the holder's information contained in the International Register and notified to the Contracting Parties is no longer current. Therefore, it seems clear that there is a need for a procedure to record a change in the legal nature of the holder.

50. It would be preferable to have a specific procedure for this in the Common Regulations, as this would add transparency to the operations of the Madrid Registry and maintain the accuracy of the International Register.

PROPOSAL

51. It is proposed that Rule 25 be amended to explicitly provide for changes to the legal nature and State of organization of the holder, where the holder is a legal entity.

52. Current official form MM9, the purpose of which is to request the recording of changes in the name or address of the holder, could be amended to include the possibility to also request the recording of a change in the indications concerning the legal nature and State of organization of a the legal entity. The holder could request the recording of a change of just this information or do so in conjunction with a request for the recording of a change in its name or address.

53. Should the International Bureau find any irregularities concerning the request to change the legal nature and State of organization, the procedure set out in Rule 26 would apply, namely the holder would be invited to remedy it within the given time limit of three months. If the irregularity is not remedied, the request for recording the change of the legal nature would be considered abandoned in accordance with Rule 26(2). Should the International Bureau receive all the relevant information, the change in the legal nature and State of organization of the legal entity would be recorded in the International Register and the International Bureau would notify this fact to the holder and to all the designated Contracting Parties.

54. The recorded information would be published in the *WIPO Gazette of International Marks*. To this effect, a consequential amendment to Rule 32 is being proposed to include in paragraph (1)(a)(vii) a reference to changes in the indications concerning the legal nature and State of organization of a legal entity.

55. Finally, another consequential amendment to item 7.4 of the Schedule of Fees is proposed, to include a reference to the change in the indications concerning the legal nature and State of organization of a legal entity. The fee payable for a change in name or address of the holder would apply, meaning that if changes to name, address or legal nature are requested in the same form, only one fee of 150 Swiss francs would be payable to the International Bureau.

DATE OF ENTRY INTO FORCE

56. It is suggested that the proposed amendments to Rules 25, 32 of the Common Regulations and to item 7.4 of the Schedule of Fees enter into force on January 1, 2017.

57. *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, as presented in the Annex to this document or in amended form, and suggest a date for their entry into force.

[Annex follows]

**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, 2015~~)

[...]

**Chapter 2
International Applications**

[...]

*Rule 12
Irregularities With Respect to the
Classification of Goods and Services*

[...]

(8bis) [Examination of Limitations] Where the international application contains a limitation of the list of goods and services and the International Bureau cannot group those goods and services under the classes of the International Classification of Goods and Services listed in the international application concerned, the International Bureau shall issue an irregularity. Paragraphs 1(a) and (2) to (6) shall apply *mutatis mutandis*. Where the irregularity is not remedied within three months from the date of the notification of the irregularity, the limitation shall be deemed not to contain the goods and services concerned.

[...]

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

[...]

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

~~(1) [Notification] Where, in accordance with Article 4bis(2) of the Agreement or Article 4bis(2) of the Protocol, the Office of a designated Contracting Party has taken 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. Such notification shall indicate~~ [Request that an Office Take Note in its Register of an International Registration] (a) In accordance with Article 4bis(2) of the Agreement or Article 4bis(2) of the Protocol, the holder of an international registration may request, as from the date of the notification of designation, that the Office of the Contracting Party concerned take note in its Register of an international registration deemed to have replaced a national or regional registration. The request shall be presented to the International Bureau on the relevant official form and shall indicate

- (i) the number of the international registration concerned, (ibis) the Contracting Party where replacement has occurred,
- (ii) where the replacement concerns only one or some of the goods and services listed in the international registration, those goods and services, and
- (iii) 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.

(b) 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 Notifications] (a) The International Bureau shall, provided that the request referred to in paragraph (1) is in order, record the indications information notified provided under paragraph (1) in the International Register and shall notify the Office of the designated Contracting Party concerned and inform at the same time the holder accordingly.

(b) The indications information 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.

(3) [Notification Following the Recording of a Request that an Office Take Note of an International Registration] (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 in its Register of the international registration; 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 in its register of the international registration, listing those goods and services; or,
- (iii) a notification indicating that it cannot take note in its Register of the international registration and stating the reasons therefor.

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

(4) [Effective Date of Replacement] The effective date of replacement under Article 4bis(2) of the Agreement or Article 4bis(2) of the Protocol shall be the date of the registration or recording effected under Articles 3 and 3ter of the Agreement or Articles 3 and 3ter of the Protocol.

(5) [Scope of Replacement] The names of the goods and services listed in the national or regional registration shall be equivalent, but not necessarily identical, to those listed in the international registration that has replaced it.

(6) [Effects of Replacement on the National or Regional Registration] A national or regional registration shall not be cancelled or otherwise affected by the fact that it has been replaced by an international registration or that the Office has taken note in its Register of the latter.

Chapter 5 Subsequent Designations; Changes

[...]

Rule 25 *Request for Recording of a Change; Request for Recording of a Cancellation*

(1) *[Presentation of the Request]* (a) A request for recording shall be presented to the International Bureau on the relevant official form, in one copy, where the request relates to any of the following:

[...]

(iv) a change in the name or address of the holder or in the indications concerning the legal nature of the holder, as a 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;

[...]

[...]

Rule 26 *Irregularities in Requests for Recording of a Change and for Recording of a Cancellation*

(1) *[Irregular Request]* If the request for the recording of a change, or the request for the recording of a cancellation, referred to in Rule 25(1)(a) does not comply with the applicable requirements, and, where the request is for the recording of a limitation, and where the numbers of the classes indicated in the limitation do not correspond to those contained in the international registration concerned, and subject to paragraph (3), the International Bureau shall notify that fact to the holder and, if the request was made by an Office, to that Office.

[...]

Chapter 7 Gazette and Data Base

Rule 32 *Gazette*

(1) *[Information Concerning International Registrations]* (a) The International Bureau shall publish in the Gazette relevant data concerning

[...]

(vii) changes ~~in ownership, limitations, renunciations and changes of name or address of the holder~~ recorded under Rule 27;

[...]

[...]

PROPOSED AMENDMENTS TO THE SCHEDULE OF FEES

SCHEDULE OF FEES

(in force on **January 1, 2015**)

Swiss francs

[...]

7. *Miscellaneous recordings*

[...]

- 7.4 Change ~~of~~in the name and/or address of the holder or in the indications concerning the legal nature of the holder, where the holder is a 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 of one or more international registrations for which recordal of the same change is requested in the same request

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[...]

[End of Annex and of document]