

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

Eighteenth Session
Geneva, October 12 to 16, 2020

SUMMARY BY THE CHAIR

approved by the Working Group

1. The Working Group on the Legal Development of the Madrid System for the International Registration of Marks (hereinafter referred to as “the Working Group”) met in Geneva from October 12 to 16, 2020.
2. The following Contracting Parties of the Madrid Union were represented at the session: African Intellectual Property Organization (OAPI), Albania, Algeria, Antigua and Barbuda, Armenia, Australia, Austria, Azerbaijan, Bahrain, Belarus, Bhutan, Bosnia and Herzegovina, Brazil, Brunei Darussalam, Canada, China, Colombia, Croatia, Cuba, Czech Republic, Denmark, Estonia, European Union (EU), Finland, France, Georgia, Germany, Ghana, Greece, Hungary, Iceland, India, Indonesia, Iran (Islamic Republic of), Israel, Italy, Japan, Kazakhstan, Kyrgyzstan, Latvia, Lesotho, Lithuania, Madagascar, Malaysia, Malawi, Mexico, Mongolia, Montenegro, Morocco, Namibia, New Zealand, Norway, Oman, Philippines, Poland, Portugal, Republic of Korea, Republic of Moldova, Russian Federation, Rwanda, Sao Tome and Principe, Singapore, Slovakia, Slovenia, Spain, Sudan, Sweden, Switzerland, Syrian Arab Republic, Tajikistan, Thailand, Trinidad and Tobago¹, Tunisia, Turkey, Turkmenistan, Ukraine, United Kingdom, United States of America, Uzbekistan, Viet Nam, Zimbabwe (81).

¹ On October 12, 2020, the Government of Trinidad and Tobago deposited its instrument of accession to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks. The Madrid Protocol will enter into force with respect to Trinidad and Tobago on January 12, 2021.

3. The following States were represented as observers: Bangladesh, El Salvador, Ethiopia, Jordan, Kuwait, Myanmar, Nicaragua, Nigeria, Pakistan, Peru, Saudi Arabia, Togo, Uganda, United Arab Emirates, Uruguay, Venezuela (Bolivarian Republic of), Yemen (17).

4. Representatives of: (i) Palestine (1); (ii) African Regional Intellectual Property Organization (ARIPO), Benelux Organization for Intellectual Property (BOIP), World Trade Organization (WTO) (3); and (iii) American Intellectual Property Law Association (AIPLA), Centre for International Intellectual Property Studies (CEIPI), European Communities Trade Mark Association (ECTA), International Federation of Intellectual Property Attorneys (FICPI), International Trademark Association (INTA), Japan Intellectual Property Association (JIPA), Japan Patent Attorneys Association (JPAA), MARQUES – Association of European Trademark Owners, The Chartered Institute of Trade Mark Attorneys (CITMA) (9); participated in an observer capacity.

5. The list of participants is contained in document MM/LD/WG/18/INF/3 Prov. 2².

AGENDA ITEM 1: OPENING OF THE SESSION

6. Mr. Daren Tang, Director General of the World Intellectual Property Organization (WIPO) opened the session and welcomed the participants.

AGENDA ITEM 2: ELECTION OF THE CHAIR AND TWO VICE-CHAIRS

7. Mr. Nicolas Lesieur (Canada) was elected as Chair of the Working Group, Ms. María José Lamus Becerra (Colombia) and Mr. Tanyaradzwa Manhombu (Zimbabwe) were elected as Vice-Chairs.

8. Ms. Debbie Roenning acted as Secretary to the Working Group.

AGENDA ITEM 3: ADOPTION OF THE AGENDA

9. The Working Group adopted the draft agenda (document MM/LD/WG/18/1).

10. The Working Group took note of the electronic adoption of the report of the seventeenth session of the Working Group.

AGENDA ITEM 4: PROPOSED AMENDMENTS TO THE REGULATIONS UNDER THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

11. Discussions were based on document MM/LD/WG/18/2 Rev.

12. The Working Group agreed to recommend to the Madrid Union Assembly the adoption of the proposed amendments to the Regulations Under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to, respectively, as “the Regulations” and “the Protocol”), as amended by the Working Group and as set out in Annex I to the present document, with November 1, 2021, as the date of their entry into force.

² The final list of participants will be made available as an Annex to the Report of the session.

AGENDA ITEM 5: NEW MEANS OF REPRESENTATION

13. Discussions were based on document MM/LD/WG/18/3.

14. The Working Group:

(i) recommended to the Madrid Union Assembly the adoption of the proposed amendments to the Regulations, as amended by the Working Group and as set out in Annex II to the present document, for entry into force on February 1, 2023;

(ii) requested that the Director General send, in the first quarter of 2021, proposed Administrative Instructions for the Application of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as “the Administrative Instructions”) dealing with acceptable formats for representing marks for a two-month consultation period with the Offices of the Contracting Parties, and send the final version of the Administrative Instructions to these Offices in the second quarter of 2021; and,

(iii) agreed to continue discussions on the role of the Office of origin in the certification of the representation of the mark and on possible flexibilities allowing users to meet representation requirements in the designated Contracting Parties.

AGENDA ITEM 6: PARTIAL REPLACEMENT

15. Discussions were based on document MM/LD/WG/18/4.

16. The Working Group agreed to recommend to the Madrid Union Assembly the adoption of the proposed amendments to the Regulations, as amended by the Working Group and as set out in Annex III to this document, with November 1, 2021, as the date of their entry into force.

AGENDA ITEM 7: STUDY OF THE COST IMPLICATIONS AND TECHNICAL FEASIBILITY OF THE GRADUAL INTRODUCTION OF THE ARABIC, CHINESE AND RUSSIAN LANGUAGES INTO THE MADRID SYSTEM

17. Discussions were based on documents MM/LD/WG/18/5 and MM/LD/WG/18/5 Corr³.

18. The Working Group, recalling the decisions taken at its sixteenth and seventeenth sessions:

(i) requested the Secretariat to provide, in advance of the nineteenth session of the Working Group, a revised *Study of the Cost Implications and Technical Feasibility of the Gradual Introduction of the Arabic, Chinese and Russian Languages into the Madrid System* (document MM/LD/WG/18/5) and other relevant information, so as to address the issues raised by delegations at the eighteenth session of the Working Group, and submit it for consideration by the Working Group at its next session; and,

(ii) requested the Secretariat to consult with interested Contracting Parties of the Protocol and other WIPO Member States, in advance of the nineteenth session of the Working Group, to clarify issues and relevant information so as to support the Working Group in its consideration of this subject matter.

³ Document MM/LD/WG/18/5 Corr. concerns the English version only.

AGENDA ITEM 8: SUMMARY BY THE CHAIR

19. The Working Group approved the Summary by the Chair, as amended to take account the interventions of a number of delegations.

AGENDA ITEM 9: CLOSING OF THE SESSION

20. The Chair closed the session on October 16, 2020.

[Annexes follow]

ANNEX I: PROPOSED AMENDMENTS TO THE REGULATIONS UNDER THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS*

Regulations Under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks

as in force on ~~February 1, 2021~~ November 1, 2021

Chapter 1 **General Provisions**

[...]

Rule 3 **Representation Before the International Bureau**

[...]

(2) [Appointment of the Representative]

- (a) The appointment of a representative may be made in the international application ~~or in a subsequent designation~~ or by the new holder of the international registration in a request under Rule 25(1)(a)(i) and shall indicate the name and address, given in accordance with the Administrative Instructions, and the electronic mail address of the representative.

[...]

(4) [Recording and Notification of Appointment of a Representative; Effective Date of Appointment]

- (a) Where the International Bureau finds that the appointment of a representative complies with the applicable requirements, it shall record the fact that the applicant or holder has a representative, as well as the name, address and electronic mail address of the representative, in the International Register. In such a case, the effective date of the appointment shall be the date on which the International Bureau received the international application, ~~subsequent designation,~~ request or separate communication in which the representative is appointed.

[...]

[...]

* Amended Rule 3 of the Regulations, as approved by the Assembly of the Madrid Union in September 2020. The amendments to Rule 3 will enter into force on February 1, 2021. See Annex of document MM/A/54/1 "COVID-19 Measures: Making E-mail a Required Indication" (https://www.wipo.int/edocs/mdocs/govbody/en/mm_a_54/mm_a_54_1.pdf).

(6) *[Cancellation of Recording; Effective Date of Cancellation]*

[...]

- (d) The International Bureau shall, upon receipt of a request for cancellation made by the representative, notify accordingly the applicant or holder, ~~and add to the notification copies of all communications sent to the representative, or received by the International Bureau from the representative, during the six months preceding the date of the notification.~~

[...]

Rule 5

~~Irregularities in Postal and Delivery Services and in Communications Sent Electronically~~Excuse in Delay in Meeting Time Limits

- (1) ~~*[Excuse in Delay in Meeting Time Limits due to Force Majeure Reasons*~~Communications Sent Through a Postal Service] Failure by an interested party to meet a time limit specified in the Regulations to perform an action before~~for a communication addressed to the International Bureau and mailed through a postal service~~ shall be excused if the interested party submits evidence showing, to the satisfaction of the International Bureau, that such failure was due to war, revolution, civil disorder, strike, natural calamity, irregularities in postal, delivery or electronic communication services owing to circumstances beyond the control of the interested party or other force majeure reason.

- (i) ~~that the communication was mailed at least five days prior to the expiry of the time limit, or, where the postal service was, on any of the ten days preceding the day of expiry of the time limit, interrupted on account of war, revolution, civil disorder, strike, natural calamity, or other like reason, that the communication was mailed not later than five days after postal service was resumed,~~[Deleted]
- (ii) ~~that the mailing of the communication was registered, or details of the mailing were recorded, by the postal service at the time of mailing, and~~[Deleted]
- (iii) ~~in cases where all classes of mail do not normally reach the International Bureau within two days of mailing, that the communication was mailed by a class of mail which normally reaches the International Bureau within two days of mailing or by airmail.~~[Deleted]

- (2) ~~*[Communications Sent Through a Delivery Service]*~~ Failure by an interested party to meet a time limit for a communication addressed to the International Bureau and sent through a delivery service shall be excused if the interested party submits evidence showing, to the satisfaction of the International Bureau,[Deleted]

- (i) ~~that the communication was sent at least five days prior to the expiry of the time limit, or, where the delivery service was, on any of the ten days preceding the day of expiry of the time limit, interrupted on account of war, revolution, civil disorder, strike, natural calamity, or other like reason, that the communication was sent not later than five days after the delivery service was resumed, and~~[Deleted]
- (ii) ~~that details of the sending of the communication were recorded by the delivery service at the time of sending.~~[Deleted]

- (3) ~~*[Communication Sent Electronically]* Failure by an interested party to meet a time limit for a communication addressed to the International Bureau and submitted by electronic means shall be excused if the interested party submits evidence showing, to the satisfaction of the International Bureau, that the time limit was not met because of failure in the electronic communication with the International Bureau, or which affects the locality of the interested party owing to extraordinary circumstances beyond the control of the interested party, and that the communication was effected not later than five days after the electronic communication service was resumed.~~[\[Deleted\]](#)
- (4) *[Limitation on Excuse]* Failure to meet a time limit shall be excused under this Rule only if the evidence [and action](#) referred to in paragraph (1), ~~(2) or (3) and the communication or, where applicable, a duplicate thereof~~ are received by [and performed before](#) the International Bureau [as soon as reasonably possible and](#) not later than six months after the expiry of the time limit [concerned](#).

[...]

Rule 5bis Continued Processing

- (1) *[Request]*
- (a) Where an applicant or holder has failed to comply with any of the time limits specified or referred to in Rules 11(2) and (3), [12\(7\)](#), [20bis\(2\)](#), 24(5)(b), 26(2), [27bis\(3\)\(c\)](#), 34(3)(c)(iii) and 39(1), the International Bureau shall, nevertheless, continue the processing of the international application, subsequent designation, payment or request concerned, if:
- (i) a request to that effect, signed by the applicant or holder, is presented to the International Bureau on the official form; and
 - (ii) the request is received, the fee specified in the Schedule of Fees is paid and, together with the request, all of the requirements in respect of which the time limit concerned applied are complied with, within two months from the date of expiry of that time limit.

[...]

[...]

Chapter 4
Facts in Contracting Parties Affecting International Registrations

[...]

Rule 22
**Ceasing of Effect of the Basic Application, of the Registration Resulting Therefrom,
or of the Basic Registration**

(1) *[Notification Relating to Ceasing of Effect of the Basic Application, of the Registration Resulting Therefrom, or of the Basic Registration]*

[...]

- (c) Once the proceeding referred to in subparagraph (b) has resulted in the final decision referred to in the second sentence of Article 6(3) of the Protocol or in the withdrawal or renunciation referred to in the third sentence of Article 6(3) of the Protocol, the Office of origin shall, where it is aware thereof, promptly notify the International Bureau accordingly and shall give the indications referred to in subparagraph (a)(i) to (iv). Where the ~~judicial action or~~ proceedings referred to in subparagraph (b) has been completed and has not resulted in any of the aforesaid final decisions, withdrawal or renunciation, the Office of origin shall, where it is aware thereof or at the request of the holder, promptly notify the International Bureau accordingly.

[...]

Chapter 5
Subsequent Designations; Changes

Rule 24
Designation Subsequent to the International Registration

[...]

(3) *[Contents]*

- (a) Subject to paragraph (7)(b), the subsequent designation shall contain or indicate

[...]

- (ii) the name ~~and address~~ of the holder,

[...]

[...]

Chapter 9
Miscellaneous

Rule 39
Continuation of Effects of International Registrations in Certain Successor States

- (1) Where any State (“the successor State”) whose territory was, before the independence of that State, part of the territory of a Contracting Party (“the predecessor Contracting Party”) has deposited with the Director General a declaration of continuation the effect of which is that the Protocol is applied by the successor State, the effects in the successor State of any international registration with a territorial extension to the predecessor Contracting Party which is effective from a date prior to the date fixed under paragraph (2) shall be subject to

[...]

- (ii) the payment to the International Bureau, within the same time limit, of ~~the fee of 41 Swiss francs~~ specified in item 10.1 of the Schedule of Fees for the International Bureau, and of the fee specified in item 10.2 of the Schedule of Fees, which shall be transferred by the International Bureau to ~~the Office of the successor State, and of a fee of 23 Swiss francs for the benefit of the International Bureau.~~

[...]

Schedule of Fees

as in force on ~~February 1, 2021~~ [November 1, 2021](#)

Schedule of Fees

Swiss francs

[...]

10. Continuation of Effects

10.1 Fee for the International Bureau 23

10.2 Fee to be transferred by the
International Bureau to the successor
State 41

[Annex II follows]

ANNEX II: PROPOSED AMENDMENTS TO THE REGULATIONS UNDER THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS AND CONSEQUENTIAL AMENDMENTS TO THE SCHEDULE OF FEES

Regulations Under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks

as in force on ~~February 1, 2020~~ February 1, 2023

[...]

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

[...]

(v) a ~~reproduction~~ representation of the mark, furnished in accordance with the Administrative Instructions, 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~~ shall be in color where color is claimed under item (vii),

[...]

(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 or is applied to be or is protected 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,~~

[...]

(5) *[Additional Contents of the International Application]*

[...]

- (d) The international application shall contain a declaration by the Office of origin certifying

[...]

- (v) that, if color is claimed as a distinctive feature of the mark in the basic application or the basic registration, or the mark in the basic application or the basic registration is applied to be or is protected in color, the same a color claim is included in the international application or that, if color is claimed as a distinctive feature of the mark in the international application without having being claimed in the basic application or basic registration, the mark in the basic application or basic registration is in fact in the color or combination of colors claimed, and

[...]

[...]

[...]

Chapter 3
International Registrations

[...]

Rule 15
Date of the International Registration

- (1) *[Irregularities Affecting the Date of the International Registration]* Where the international application received by the International Bureau does not contain all of the following elements:

[...]

- (iii) a ~~reproduction~~representation of the mark,

[...]

[...]

Chapter 4

Facts in Contracting Parties Affecting International Registrations

[...]

Rule 17

Provisional Refusal

[...]

(2) *[Content of the Notification]* A notification of provisional refusal shall contain or indicate

[...]

- (v) where the grounds on which the provisional refusal is based relate to a mark which has been the subject of an application or registration and with which the mark that is the subject of the international registration appears to be in conflict, the filing date and number, the priority date (if any), the registration date and number (if available), the name and address of the owner, and a ~~reproduction,~~representation of the former mark or an indication of how to access that representation, together with the list of all or the relevant goods and services in the application or registration of the former mark, it being understood that the said list may be in the language of the said application or registration,

[...]

[...]

Chapter 7

Gazette and Data Base

Rule 32

Gazette

(1) *[Information Concerning International Registrations]*

[...]

- (b) The ~~reproduction,~~representation of the mark shall be published as it ~~appears~~was furnished in the international application. Where the applicant has made the declaration referred to in Rule 9(4)(a)(vi), the publication shall indicate that fact.
- (c) ~~[Deleted]Where a color reproduction of the mark is furnished under Rule 9(4)(b)(v) or (vii), the Gazette shall contain both a reproduction of the mark in black and white and the reproduction in color.~~

[...]

Schedule of Fees

as in force on ~~February 1, 2020~~ February 1, 2023

Schedule of Fees

Swiss francs

1. [Deleted]

2. *International application*

The following fees shall be payable and shall cover 10 years:

2.1. Basic fee (Article 8(2)(i) of the Protocol)*

2.1.1. where no ~~reproduction~~representation of the mark is in color 653

2.1.2. where any ~~reproduction~~representation of the mark is in color 903

[...]

[Annex III follows]

* For international applications filed by applicants whose country of origin is a Least Developed Country, in accordance with the list established by the United Nations, the basic fee is reduced to 10% of the prescribed amount (rounded to the nearest full figure). In such case, the basic fee will amount to 65 Swiss francs (where no ~~reproduction~~representation of the mark is in color) or to 90 Swiss francs (where any ~~reproduction~~representation of the mark is in color).

ANNEX III: PROPOSED AMENDMENTS TO RULES 21* AND 40 OF THE REGULATIONS UNDER THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

Regulations Under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks

as in force on ~~February 1, 2021~~ November 1, 2021

[...]

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

[...]

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

- (1) *[Request and Notification]* From the date of the notification of the international registration or of the subsequent designation, as the case may be, the holder may present directly to the Office of a designated Contracting Party a request for that Office to take note of the international registration in its Register, in accordance with Article 4*bis*(2) of the Protocol. Where, following the said request, the Office has taken note in its Register that a national or a regional registration or registrations, as the case may be, have been replaced by the international registration, that Office shall notify the International Bureau accordingly. Such notification shall indicate
- (i) the number of the international registration concerned,
 - (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 or registrations which have been replaced by the international registration.

The notification may also include information relating to any other rights acquired by virtue of that national or regional registration or registrations.

- (2) *[Recording]*
- (a) The International Bureau shall record the indications notified under paragraph (1) in the International Register and shall inform the holder accordingly.
 - (b) The indications notified under paragraph (1) shall be recorded as of the date of receipt by the International Bureau of a notification complying with the applicable requirements.

* Amended Rule 21 of the Regulations, as approved by the Assembly of the Madrid Union in October 2019. The amendments to Rule 21 will enter into force on February 1, 2021. See documents MM/A/53/1 "Proposed Amendments to the Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks", Annex II (https://www.wipo.int/edocs/mdocs/govbody/en/mm_a_53/mm_a_53_1.pdf) and MM/A/53/3 "Report", paragraph 16 (https://www.wipo.int/edocs/mdocs/govbody/en/mm_a_53/mm_a_53_3.pdf).

(3) *[Further Details Concerning Replacement]*

- (a) Protection to the mark that is the subject of an international registration may not be refused, even partially, based on a national or regional registration which is deemed replaced by that international registration.
- (b) A national or regional registration and the international registration that has replaced it shall be able to coexist. The holder may not be required to renounce or request the cancellation of a national or regional registration which is deemed replaced by an international registration and should be allowed to renew that registration, if the holder so wishes, in accordance with the applicable national or regional law.
- (c) Before taking note in its Register, the Office of a designated Contracting Party shall examine the request referred to in paragraph (1) to determine whether the conditions specified in Article 4*bis*(1) of the Protocol have been met.
- (d) The goods and services concerned with replacement, listed in the national or regional registration, shall be covered by those listed in the international registration. Replacement may concern only some ~~only~~ of the goods and services listed in the national or regional registration.
- (e) A national or regional registration is deemed replaced by an international registration as from the date on which that international registration takes effect in the designated Contracting Party concerned, in accordance with Article 4(1)(a) of the Protocol.

[...]

Rule 40
Entry into Force; Transitional Provisions

[...]

(7) *[Transitional Provision Relating to Partial Replacement]* No Office shall be obliged to apply Rule 21(3)(d), second sentence, before February 1, 2025.

[End of Annex III and of document]