

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

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PROPOSED AMENDMENTS TO THE REGULATIONS UNDER THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

Document prepared by the International Bureau

1. This document proposes 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”).
2. More specifically, these proposals concern amendments to Rules 3(2)(b), 5(5) and 30(1)(b) of the Regulations. These proposals support the ongoing process of simplifying the Regulations and making the Madrid System for the International Registration of Marks (hereinafter referred to as “the Madrid System”) more user-friendly to applicants and holders, Offices of Contracting Parties and interested third parties. The proposals are reproduced in the Annex to this document.

APPOINTMENT OF A REPRESENTATIVE

3. In recent years, the Madrid Union Assembly (hereinafter referred to as “the Assembly”) has adopted several amendments to standardize requests for recording concerning representation and to streamline their processing by the International Bureau.
4. On November 1, 2017, amendments to Rule 25 of the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol relating to that Agreement introduced the recording of a change in the name or address of the representative as one of the recordings that holders can request under this Rule. Consequently, holders or their representatives must present all requests for the recording of a change in the name or address of the representative in the prescribed form.

5. Amendments to Rule 3 of the Regulations that would enter into force on November 1, 2021, subject to their adoption by the Assembly in October 2021, would require holders of international registrations to appoint a representative only in a separate communication, and not as part of a request for the recording of a change, such as, a request for the recording of a change in name or address of the holder. Applicants and new holders could continue to appoint a representative in, respectively, the international application and request for the recording of a change in ownership.

6. The International Bureau has made available an optional form to request the recording of the appointment of a representative (MM12). Further, on March 1, 2021, the International Bureau released an online form allowing holders to present this request. The introduction of this online form has both decreased the number of irregular appointments and expedited the recording of such appointments.

7. In view of the above, it is proposed that Rule 3(2)(b) of the Regulations be amended to prescribe the use of a form when presenting requests for the recording of the appointment of a representative before the International Bureau. In accordance with Rule 3(3) of the Regulations, failure to use the prescribed form would result in an irregular appointment and would prevent the International Bureau from recording such appointment in the International Register.

EXCUSE IN DELAY IN MEETING TIME LIMITS

8. Amendments to Rule 5 of the Regulations that would enter into force on November 1, 2021, subject to their adoption by the Assembly in October 2021, would clarify that the International Bureau could excuse the failure to meet a time limit under the Regulations to perform any action before the International Bureau when this failure is due to any *force majeure* situation. These amendments would delete paragraphs (2) and (3) from that Rule, but not the reference to these paragraphs from paragraph (5). To correct this oversight, it is proposed that those references be deleted from paragraph (5). The proposed change is editorial only and would have no impact on the revised Rule.

PAYMENT MADE FOR THE PURPOSES OF RENEWAL

9. Presently, Rule 30(1)(b) of the Regulations prescribes that payments for the purposes of renewal received earlier than three months before the expiry date of the international registration are deemed to have been received three months before that date. For practical purposes, this Rule limits the period in which a holder can renew an international registration to the three months immediately preceding its expiry date.

10. When the International Bureau receives a premature renewal payment for an international registration (i.e., prior to the three months immediately preceding its expiry date), it must wait to calculate the required amount using the fees in force three months before the expiry date. Once it is confirmed that the payment is sufficient, the International Bureau would schedule the inscription and notification of the renewal to take place on the expiry date.

11. Holders and representatives from users' organizations have brought to the attention of the International Bureau that several Contracting Parties allow holders to renew their domestic registrations up to 12 months in advance of the due date. Moreover, they have indicated that the short period set out in the Regulations to renew international registrations negatively affects their interests when, for example, they must prove they have renewed the international registration to enforce their rights in a designated Contracting Party. Consequently, they have suggested that the Regulations be amended to allow for earlier renewal.

12. In view of the above, it is hereby proposed that Rule 30(1)(b) of the Regulations be amended to provide for a longer renewal period. Under the proposed amendment, the period would start 12 months before the due date to give holders ample time to renew their international registrations and facilitate the enforcement of their rights in the designated Contracting Parties. The International Bureau would record and notify the renewal of an international registration, as well as issue the corresponding certificate to the holder, as soon as it confirms that payment is sufficient. Renewal would continue to bear the date on which the international registration was to expire.

13. The provisions concerning the determination of the date of payment and the applicable fees, found in Rule 34(6) and (7)(d) of the Regulations, would continue to apply. That is, the amount due for renewal would continue to be calculated using the fees valid on the date of payment or, where payment is made after the due date, the fees valid on the due date.

14. Therefore, the proposed amendment would not have an impact on the renewal fees due in respect to the designated Contracting Parties. These Contracting Parties would continue to either participate in the annual distribution of the standard renewal fees or receive the amounts of their individual renewal fee, regardless of whether such renewal takes place 12 months before the due date or in the six-month grace period after the due date.

DATE OF ENTRY INTO FORCE

15. The amendments proposed in this document would only concern the practices and information and communication technology systems of the International Bureau, and they would not have any impact on the Offices of Contracting Parties. The International Bureau could make the necessary adjustment to its systems and practices to implement the proposed amendments to the Regulations using internal resources. Accordingly, it is proposed that the proposed amendments enter into force on November 1, 2022.

16. *The Working Group is invited to:*
- (i) consider the proposals made in this document; and,*
 - (ii) recommend to the Madrid Union Assembly some or all of the proposed amendments to the Regulations, as presented in the Annex to this document or in amended form, for their entry into force on November 1, 2022.*

[Annex follows]

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

as in force on ~~November 1, 2021~~ November 1, 2022

[...]

Chapter 1 **General Provisions**

[...]

Rule 3 **Representation Before the International Bureau**

[...]

(2) [Appointment of the Representative]

[...]

- (b) The appointment of a representative may also be made in a separate communication, provided it is made on the relevant official form, which and it may relate to one or more specified international applications or international registrations of the same applicant or holder. The said ~~communication~~ form shall be presented to the International Bureau
- (i) by the applicant, the holder or the appointed representative, or
 - (ii) by the Office of the Contracting Party of the holder.

The ~~communication~~ form shall be signed by the applicant or the holder, or by the Office ~~through which it was presented~~ presenting the request.

[...]

Rule 5 **Excuse in Delay in Meeting Time Limits**

[...]

- (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 Protocol and in Rule 24(6)(b), and the Office concerned indicates that the late receipt resulted from circumstances referred to in paragraph (1), ~~(2) or (3)~~, paragraphs (1), (2) or (3) and ~~paragraph~~ (4) shall apply.

[...]

Chapter 6
Renewals

Rule 30
Details Concerning Renewal

(1) *[Fees]*

[...]

- (b) If any payment made for the purposes of renewal is received by the International Bureau earlier than ~~three~~12 months before the date on which the renewal of the international registration is due, it shall be considered as having been received ~~three~~12 months before the date on which renewal is due.

[...]

[End of Annex and of document]