

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

Twentieth Session
Geneva, November 7 to 11, 2022

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

INTRODUCTION

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”) and an interpretative statement to Article 2 of the Protocol.

2. More specifically, these proposals concern amendments to Rules 8, 9, 20*bis*, 21, 22, 23*bis*, 24, 25, 26, 27 and 32 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 for applicants and holders, Offices of Contracting Parties and interested third parties. The proposals are reproduced in the Annexes to this document.

PROPOSALS CONCERNING THE ENTITLEMENT REQUIREMENT AND THE CONNECTION CLAIM

ENTITLEMENT REQUIREMENT WHERE THERE ARE TWO OR MORE APPLICANTS, HOLDERS OR TRANSFEREES

3. The Offices of some Contracting Parties have informally contacted the International Bureau about the possibility of amending the Madrid System legal framework to allow the Office of origin to certify international applications filed by two applicants who jointly own the basic mark, when only one of them has a connection with the Contracting Party of the Office of origin.

4. Rule 8(2) of the Regulations prescribes that, where there are two or more applicants, each of them must be entitled to file the international application by meeting the requirements specified in Article 2(1) of the Protocol in relation to the Contracting Party of the Office of origin. In contrast, Rule 18.3 of the Regulations under the Patent Cooperation Treaty (hereinafter referred to as “the PCT”) prescribes that, “if there are two or more applicants, the right to file an international application shall exist if at least one of them is entitled to file an international application according to Article 9 [of the PCT].”

5. At the 1970 Washington Diplomatic Conference on the Patent Cooperation Treaty, when discussing Rule 18.3 of the Regulations under the PCT, the delegations debated extensively the question of the entitlement to file an international application where there were multiple applicants. Several delegations shared the opinion that if one of the applicants had the right to file an international application, this applicant should not lose that right due to an association with persons who had no such right. Consequently, the delegations adopted the above-mentioned Rule, on the understanding that, on balance, it was more equitable not to exclude persons entitled to file due to their association with persons who were not entitled to do so, rather than the other way round.*

6. It is proposed that the same principle apply to applicants under the Madrid System. For the sake of legal certainty, the Madrid Union Assembly could introduce this principle by endorsing an interpretative statement to Article 2(1) of the Protocol. The statement would indicate that, where the basic application or basic registration stands in the name of more than one person, only one of them must meet the requirements specified in that Article. A consequential amendment to Rule 8(2) of the Regulations is also proposed.

7. The same principle would apply also to subsequent designations and to requests for the recording of a change in ownership involving two or more transferees, for which consequential amendments to Rules 24(1)(a) and 25(4) of the Regulations are also proposed.

8. The proposed interpretative statement and amendments would not have a significant impact on the practices of the Offices of the Contracting Parties of the Protocol, when acting as the Office of origin of an international registration, or the International Bureau. Nevertheless, they would help joint applicants when only one of them is entitled to file an international application with the Office of origin.

* Records of the Washington Diplomatic Conference on the Patent Cooperation Treaty, paragraphs 1035 to 1057, and 1841.

ONLY ONE CONNECTION REQUIRED TO BE ENTITLED TO FILE AN INTERNATIONAL APPLICATION

9. Rule 9(5)(b) of the Common Regulations Under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement in force until January 31, 2020, required the applicant to indicate only one connection with the Contracting Party of the Office of origin for the purpose of establishing the entitlement to file an international application.

10. After the Madrid System became a one-treaty system, the Madrid Union Assembly adopted the Regulations (i.e., the current Regulations under the Protocol) at its fifty-second session, held in October 2018, for their entry into force on February 1, 2020. Rule 9(5)(b) of the Regulations varies from the Rule referred to in the preceding paragraph because it allows applicants to indicate more than one connection with the Contracting Party of the Office of origin.

11. Upon planning for the implementation of this particular provision, it became apparent that allowing the applicant to claim more than one connection unnecessarily increases the complexity of the Madrid System and would have implications on the systems of the International Bureau and the Offices. While applicants are likely to be able to claim more than one of the said connections, such claim has no implications on the right to file an international application. Entitlement is determined at the time of filing, all connections are equally valid and the accumulation of connections does not give the applicant a better or stronger entitlement. Consequently, it is proposed to amend Rule 9(5)(b) of the Regulations to require that the applicant indicate only one connection with the Contracting Party of the Office of origin.

12. The proposed amendments would not have a significant impact on the Offices of the Contracting Parties to the Protocol or on the International Bureau.

ENTITLEMENT REQUIREMENT FOR THE RECORDING OF A CHANGE IN OWNERSHIP

13. Rule 25(2)(a)(iv) and (v) of the Regulations refers to the possibility that transferees mention more than one Contracting Party with which they have a connection that entitles them to be the new holder of the international registration. In a two-treaty system, where only one of the treaties could govern some of the designations in an international registration, this Rule allowed transferees to claim entitlement mentioning Contracting Parties bound by one, the other, or both treaties. This possibility gave transferees the right to be the holder of the entire international registration, with all its designations, regardless of the treaty governing these designations.

14. Under the current one-treaty system, the possibility that the transferee mention more than one Contracting Party is no longer required. Consequently, it is proposed to amend Rule 25(2)(a)(iv) and (v) to eliminate this possibility. This amendment would not have any impact on the Offices of the Contracting Parties to the Protocol or on the International Bureau.

CLARIFICATION OF THE NATURE OF THE STANDARD CHARACTER DECLARATION

15. The Regulations offer applicants the possibility to declare that the mark is to be considered as a mark in standard characters, but the Regulations do not define the nature of these marks or the implications of this declaration. Furthermore, the Regulations do not require the Office of origin to certify this declaration. Moreover, while the Office of origin of the international application could deem the mark to be in standard characters, based on the script of the mark, the same might not be the case in the Offices of the designated Contracting Parties.

16. The Offices of certain Contracting Parties understand that the declaration concerns marks that exclusively consist of letters, numbers or words, without any particular form of writing or figurative element, akin to a word mark, which might have implications on the scope of protection.

17. The International Bureau has no mandate to examine the consistency of this declaration and it could not notify an irregularity even where it appears that the declaration is not consistent with the representation of the mark. The International Bureau must simply register the mark with the claim. As a result, the International Register contains contradictory information, with several international registrations for marks that appear to be in a special form or writing or with figurative elements, or both, for which the applicant has declared that the mark is to be considered in standard characters.

18. As a practice, the Offices of some designated Contracting Parties disregard the standard character declarations when they deem that these declarations are not consistent with the representation of the mark and with their understanding of what a mark in standard characters is. Other Offices disregard the claim when they find it to be devoid of purpose in the context of their applicable laws and practices, for example, where, in the view of the Office, the representation of the mark does not correspond to a mark in standard characters. Finally, where appropriate, some Offices would deem the mark to be a word mark, even in the absence of a standard character declaration.

19. The Offices of a few Contracting Parties have informally brought up this matter with the International Bureau and suggested that the Regulations provide further clarity on the standard character declaration.

20. Consequently, it is proposed that the Regulations be amended to clarify that the standard character declaration is optional in nature and that it does not bind the Offices of the designated Contracting Parties in the determination of the scope of protection. For this purpose, Rule 9(4)(a)(vi) of the Regulations could be deleted and a new item (vii) in Rule 9(4)(b) be introduced. Furthermore, consequential amendments to Rules 24(3)(c)(i) and 32(1)(b) of the Regulations would be necessary. These proposed amendments appear to be consistent with what already seems to be the prevailing practice among the Offices in this regard.

REFERENCE TO THE ALPHABETICAL LIST OF THE NICE CLASSIFICATION

21. While the Alphabetical List is part of the Classification established under the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of Registration of Marks, the way in which applicants can indicate the goods or services in their international applications is not limited to that list. The International Bureau is processing an increasing number of international applications with expressions that are not in the Alphabetical List.

22. Although it remains preferable that applicants use indications from the Alphabetical List, it is most important that the indications of the goods and services listed in the international application appear in the correct class. This prompted the International Bureau to make available to the public an expanded list of properly classified acceptable indications, known as the Madrid Goods and Services (MGS) Manager database, with an indication of their acceptance by the International Bureau and by participating Offices of Contracting Parties.

23. In view of the above, it is proposed that the reference to the Alphabetical List be removed from Rule 9(4)(a)(xiii) of the Regulations. The proposed change would not have an impact on the Offices of the Contracting Parties to the Protocol nor on the International Bureau.

DIRECT FILING OF REQUESTS FOR THE RECORDING OF SUBSEQUENT DESIGNATIONS, CHANGES AND LICENSES

24. While the Regulations provide holders with the possibility to present requests for recording of subsequent designations, changes and licenses to the International Bureau or through the Office of the Contracting Party of the holder, holders are increasingly opting for the former. In 2018, holders filed 86 per cent of all requests for recording with the International Bureau. In 2022, that share reached 90 per cent.

25. The trend described in the preceding paragraph is likely to intensify with the introduction of online forms. In November 2020, the International Bureau released an online form to request the recording of limitations. In that month, holders presented 21 per cent of those requests using the new online form. At the end of the first quarter of 2022, that share reached 67 per cent. The same is the case for other new online forms. Online requests for the recording of a change in the representative's details, available since March 2021, are now 47 per cent of the total. Online requests for the recording of a change in the holders' details, available since July 2021, are now 62 per cent of the total. Online requests for the recording of a renunciation, available since July 2021, are now 79 per cent of the total.

26. Use of online forms to present requests for recording have a positive impact on the irregularity rate and on the processing time. The irregularity rate for requests for the recording of limitations presented through the online form is 3 per cent. Whereas, for requests for the recording of a limitation presented by other means, the irregularity rate varies between 15 and 18 per cent.

27. Average processing time is also much shorter for requests presented using an online form. On average, the International Bureau takes 28 days to record a limitation presented through the online form. Instead, it takes between 37 to 48 days to record a limitation requested by other means. The need to capture manually the data and the higher irregularity rate in requests presented by means other than an online form explain the longer processing time for these requests.

28. There are similar differences in irregularity rates and processing times in favor of other requests for recording presented through an online form, where such form is available, relative to those requests presented by other means.

29. In view of the above, it is proposed to amend the Regulations and prescribe direct filing with the International Bureau for requests for the recording of subsequent designations, changes and licenses, except in those circumstances that require presenting the request through an Office, namely, request for the recording of a change in ownership, when the holder is unable to sign the request, and for the recording of subsequent designations resulting from conversion.

30. The experience described above has proven that a combination of direct filing and the use of online forms benefits holders with lower irregularity rates and shorter processing times. The proposed change could also benefit Offices by eliminating the workload resulting from receiving, processing and transmitting requests for recording to the International Bureau.

REQUEST FOR THE RECORDING OF SUBSEQUENT DESIGNATIONS

31. Holders can submit a request for the recording of a subsequent designation to the International Bureau or through the Office of the Contracting Party of the holder. Holders have presented 82.08 per cent of all requests for the recording of subsequent designations directly to the International Bureau. While there is an online form available to present this request, this form does not yet provide for the possibility to provide certain information, such as the nationality or legal nature of the holder. The International Bureau will release a new version of the subsequent designation online form that will provide for this possibility later in 2022.

32. In the past, an advantage resulted from requesting the recording of a subsequent designation through the Office of the Contracting Party of the holder. The first sentence in Rule 24(6)(b) prescribes that a subsequent designation must bear the date on which the International Bureau receives the request, where the holder presents it directly. In contrast, the second sentence in that Rule prescribes that the subsequent designation must bear the date on which the Office of the Contracting Party of the holder receives the request, where the holder presents it through an Office, provided the International Bureau receives this request from this Office within two months from that date.

33. The provision in the second sentence of Rule 24(6)(b) was necessary to preserve the holders' rights against inherent delays when sending communications to the International Bureau by post. A holder sending a request for the recording of a subsequent designation by post could expect this request to reach the International Bureau several days later, negatively affecting the date of the subsequent designation.

34. Users can no longer send communications to the International Bureau by post and, in the context of electronic communication, the provision in the second sentence of Rule 24(6)(b) is no longer necessary. Holders presenting requests for the recording of a subsequent designation directly to the International Bureau, either by using the online form or by uploading the official form MM4 to the Contact Madrid online platform, can rely on the International Bureau receiving the requests immediately.

35. In fact, a concrete advantage for holders and Offices of the designated Contracting Parties results from presenting requests for the recording of a subsequent designation to the International Bureau using the online form. As indicated earlier, requests presented using online forms have lower irregularity rates and shorter processing times. In most cases, the International Bureau inscribes subsequent designations, without limitations or other indications or instructions, immediately after it has confirmed the payment of the prescribed fees. Offices of new Contracting Parties of the Madrid System can bear witness to the fact that the International Bureau notifies them of the recording of subsequent designations within a fortnight of the entry into force of the Protocol in those Contracting Parties.

36. Consequently, it is proposed to amend Rule 24(2)(a), 6(a), (c) and (d) and (10) and to delete Rule 24(3)(a)(vi) and (6)(b) of the Regulations to prescribe that holders present subsequent designations directly to the International Bureau.

37. Holders would still be required to request subsequent designations resulting from conversion through the Office of the Contracting Organization concerned (i.e., the European Union). The latter must still determine that the circumstances specified in Rule 24(7)(a) of the Regulations have occurred and, in such a case and at the holder's initiative, request the conversion of the designation of the Contracting Organization into the subsequent designation of any of its member States, which is also party to the Protocol.

REQUESTS FOR THE RECORDING OF CHANGES

38. Holders can present requests for recording under Rule 25 of the Regulations to the International Bureau or through the Office of the Contracting Party of the holder. In addition, the Office of the Contracting Party through which the transferee is entitled to be the holder of an international registration can present the requests.

39. Holders of international registrations present most requests for recording under Rule 25 of the Regulations to the International Bureau. In 2022, holders presented 98.57 per cent of all requests for the recording of a limitation with the International Bureau. The percentage was 98.11 per cent for a change in the name and address of the representative; 92.35 per cent for a change in the name or address of the holder; 97.45 per cent for a partial cancellation; 93.01 per cent for a total cancellation; 99.64 per cent for a renunciation; and, 89.75 per cent for a change in ownership.

40. The International Bureau has released online forms to request the recording of a limitation, of a change in the name or address of the representative and of the holder, of a renunciation and of a change in ownership, the latter released early in May 2022. The International Bureau will soon release an online form to request the cancellation of the international registration and will then have made available online forms for all requests under Rule 25 of the Regulations. As indicated earlier, a more intense use of the online forms will have a positive impact on irregularity rates and processing times.

41. In view of the above, it is proposed to amend Rules 25(1)(b), 26(3), 27(1)(a) and (5)(d) and (e) of the Regulations to prescribe that holders present requests under Rule 25 of the Regulations to the International Bureau.

42. Notwithstanding the above, it is proposed to preserve indirect filing, through the Office of the Contracting Party of the holder or of the Contracting Party through which the transferee is entitled to be the new holder, for requests for the recording of a change in ownership. There remain circumstances in which the holder of an international registration might be unable to sign and present the request to the International Bureau. For example, the holder might be deceased or be a dissolved legal entity. In such cases, the successor in title could request the Office concerned to assess the situation and present the request for the recording of a change in ownership to the International Bureau.

REQUESTS FOR THE RECORDING OF LICENSES

43. Holders can request the recording of licenses in the International Register to the International Bureau or through a concerned Office; however, the Offices of 29 Contracting Parties have notified that this recording has no effect in those Contracting Parties. The recording of a license is a request for which there is not yet an online form. Nevertheless, holders have presented to the International Bureau 96.43 per cent of all requests for that recording made thus far in 2022. That percentage is likely to increase once the International Bureau makes available an online form for this request in 2023.

44. Consequently, it is proposed to amend Rule 20*bis*(1)(a) and (d), (2)(a) and (b), 3(a) and 5(d) and (e) of the Regulations to prescribe that holders present all requests for the recording and amendment of a license, as well as for the cancellation of the recording of a license, directly to the International Bureau.

REQUIREMENT TO NOTIFY CEASING OF EFFECT PROMPTLY

45. Holders of international registrations and interested third parties often contact the International Bureau to inform of a possible ceasing of effect of the basic mark and to inquire about the time limit the Office of origin has to notify of this fact and to request the cancellation of the international registration. Some users of the Madrid System have suggested introducing a time limit for the Office of origin to send that notification and request.

46. While a long delay in notifying the ceasing of effect of the basic mark creates legal uncertainty for holders and third parties alike, it seems impracticable to introduce a time limit to do so. For example, some Offices may not be aware of an administrative or judicial decision resulting in the ceasing of effect of the basic mark until they receive a notification from the competent authority, while other Offices may need to wait for that decision to be final.

47. It is therefore suggested that Rule 22(1)(a) of the Regulations be amended to introduce the word “promptly”, as a reminder that Offices must notify the ceasing of effect of the basic mark and request the cancellation of the international registration as soon as reasonably possible.

WIDENING THE SCOPE OF COMMUNICATIONS COVERED BY RULE 23*BIS*

48. Rule 23*bis* of the Regulations gives Offices of designated Contracting Parties whose applicable legislation does not allow them to communicate directly with the holder the possibility to request that the International Bureau send communications not covered by the Regulations on their behalf. This provision has proven useful to inform holders of, for example, proceedings initiated in the designated Contracting Parties or of impending deadlines to meet an obligation with the Office.

49. It is suggested to amend Rule 23*bis*(1) of the Regulations to allow the Offices of all designated Contracting Parties to request that the International Bureau send communications not covered by the Regulations on their behalf. The International Bureau plans to make available standards so Offices can transmit data concerning these communications by electronic means in eXtensible Markup Language (XML) format.

NOTIFYING ALL PARTIES CONCERNED OF RECORDINGS AND MODIFICATIONS RESULTING FROM A DECLARATION THAT A CHANGE IN OWNERSHIP HAS NO EFFECT

50. The Office of a designated Contracting Party may declare that a change in ownership has no effect in its jurisdiction. This declaration results in the recording of a new international registration in the name of the previous holder. A final decision relating to that declaration could also result in modifications to the International Register.

51. At present, Rule 27(4) of the Regulations requires the International Bureau to notify only the party that presented the request for the recording of a change in ownership of the recordings and modifications resulting from a declaration under this Rule. Nevertheless, there could be up to three parties involved in the recording of a change in ownership, namely, the transferee, the transferor and an Office, where an Office presents the request.

52. Consequently, it is proposed to amend Rule 27(4)(d) and (e) and to add new item (f) to Rule 27(4) of the Regulations, prescribing that the International Bureau notify all parties concerned of recordings and modifications resulting from a declaration that a change in ownership has no effect. An editorial amendment to Rule 27(4)(d) would clarify that the new international registration is to be recorded in the name of the previous holder.

EDITORIAL AMENDMENTS

53. It is proposed to amend Rule 21(3)(b) of the Regulations to replace the word “should” with the word “shall” to clarify that Offices of the designated Contracting Parties must allow holders of international registrations to renew a domestic registration that has been replaced by the former.

54. It is also proposed to amend Rule 32(1)(a)(xi) of the Regulations to include a reference to Rule 27(5), confirming that declarations regarding limitations are published in the *WIPO Gazette of International Marks*.

DATE OF ENTRY INTO FORCE

55. The amendments proposed in this document would mainly concern the practices and the information and communication technology systems of the International Bureau. The International Bureau could make the necessary adjustments to its systems and practices to implement the proposed amendments to the Regulations using internal resources. As specified above, a few of the amendments proposed in this document may require Offices to make some adjustments. Accordingly, to provide Offices time to assess the implications of the proposed amendments and to make these adjustments, if needed, it is suggested that all of the amendments proposed in this document enter into force on November 1, 2024.

56. *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 Annexes to this document or in amended form, for their entry into force on November 1, 2024.

[Annexes follow]

PROPOSED INTERPRETATIVE STATEMENT TO ARTICLE 2(1) OF THE MADRID PROTOCOL

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

adopted at Madrid on June 27, 1989,
as amended on October 3, 2006,
and on November 12, 2007

[...]

Article 2 Securing Protection through International Registration

- (1) Where an application for the registration of a mark has been filed with the Office of a Contracting Party, or where a mark has been registered in the register of the Office of a Contracting Party, the person in whose name^{*} that application (hereinafter referred to as “the basic application”) or that registration (hereinafter referred to as “the basic registration”) stands may, subject to the provisions of this Protocol, secure protection for his mark in the territory of the Contracting Parties, by obtaining the registration of that mark in the register of the International Bureau of the World Intellectual Property Organization (hereinafter referred to as “the international registration,” “the International Register,” “the International Bureau” and “the Organization,” respectively), provided that,
- (i) where the basic application has been filed with the Office of a Contracting State or where the basic registration has been made by such an Office, the person in whose name that application or registration stands is a national of that Contracting State, or is domiciled, or has a real and effective industrial or commercial establishment, in the said Contracting State,
 - (ii) where the basic application has been filed with the Office of a Contracting Organization or where the basic registration has been made by such an Office, the person in whose name that application or registration stands is a national of a State member of that Contracting Organization, or is domiciled, or has a real and effective industrial or commercial establishment, in the territory of the said Contracting Organization.

[Annex II follows]

^{*} [Interpretative statement endorsed by the Assembly of the Madrid Union:](#)
[“Where the basic application or basic registration stands in the name of more than one person, Article 2\(1\) of the Madrid Protocol is understood as requiring that only one of the persons in which the basic application or basic registration stands meet the requirements specified therein.”](#)

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 ~~November 1, 2022~~November 1, 2024

[...]

Rule 8 Several Applicants

(1) [Deleted]

(2) *[Two or More Applicants]* Two or more applicants may jointly file an international application if the basic application was jointly filed by them or the basic registration is jointly owned by them, and if ~~each~~at least one of them qualifies, in relation to the Contracting Party whose Office is the Office of origin, for filing an international application under Article 2(1) of the Protocol.

Rule 9 Requirements Concerning the International Application

[...]

(4) *[Contents of the International Application]*

(a) The international application shall contain or indicate

(vi) ~~where the applicant wishes that the mark be considered as a mark in standard characters, a declaration to that effect,~~[Deleted]

[...]

(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,

[...]

- (b) The international application may also contain,

[...]

- (vi) any description of the mark by words or, if the applicant so wishes, the description of the mark by words contained in the basic application or the basic registration, where it has not been provided under paragraph (4)(a)(xi);

(vii) where the applicant wishes that the mark be considered as a mark in standard characters, a declaration to that effect, which shall not bind the Contracting Parties with regard to the determination of the scope of the protection of the mark.

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

[...]

- (b) The international application shall contain the number and date of the basic application or basic registration and shall indicate one ~~or more~~ of the following:

- (i) where the Contracting Party whose Office is the Office of origin is a State, that the applicant is a national of that State;

[...]

[...]

Rule 20bis Licenses

- (1) *[Request for the Recording of a License]*

- (a) A request for the recording of a license shall be presented to the International Bureau on the relevant official form by the holder ~~or, if the Office admits such presentation, by the Office of the Contracting Party of the holder or the Office of a Contracting Party with respect to which the license is granted.~~

[...]

- (d) The request shall be signed by the holder ~~or by the Office through which it is presented.~~

- (2) *[Irregular Request]*

- (a) If the request for the recording of a license does not comply with the requirements of paragraph (1)(a), (b) and (d), the International Bureau shall notify that fact to the holder ~~and, if the request was presented by an Office, to that Office.~~

- (b) If the irregularity is not remedied within three months from the date of the notification of the irregularity by the International Bureau, the request shall be considered abandoned, and the International Bureau shall notify accordingly ~~and at the same time~~ the holder ~~and, if the request was presented by an Office, that Office,~~ and refund any fees paid, after deduction of an amount corresponding to one-half of the relevant fees referred to in item 7 of the Schedule of Fees, to the party having paid those fees.

(3) *[Recording and Notification]*

- (a) Where the request complies with the requirements of paragraph (1)(a), (b) and (d), the International Bureau shall record the license in the International Register, together with the information contained in the request, shall notify accordingly the Offices of the designated Contracting Parties in respect of which the license is granted and shall inform ~~at the same time the holder and, if the request was presented by an Office, that Office.~~

[...]

[...]

(5) *[Declaration that the Recording of a Given License Has No Effect]*

[...]

- (d) The International Bureau shall record in the International Register any declaration made in accordance with subparagraph (c) and shall notify accordingly the ~~party (holder or Office) that presented the request to record the license.~~ The declaration shall be recorded as of the date of receipt by the International Bureau of a communication complying with the applicable requirements.

- (e) Any final decision relating to a declaration made in accordance with subparagraph (c) shall be notified to the International Bureau which shall record it in the International Register and notify accordingly the ~~party (holder or Office) that presented the request to record the license.~~

[...]

Rule 21

Replacement of a National or Regional Registration by an International Registration

[...]

(3) *[Further Details Concerning Replacement]*

[...]

- (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~~shall be allowed to renew that registration, if the holder so wishes, in accordance with the applicable national or regional law.

[...]

[...]

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]*

(a) Where Article 6(3) and (4) of the Protocol apply, the Office of origin shall promptly notify the International Bureau accordingly and shall indicate

(i) the number of the international registration,

[...]

[...]

Rule 23bis

Communications from the Offices of the Designated Contracting Parties Sent Through the International Bureau

(1) *[Communications Not Covered by These Regulations]* ~~Where the law of a designated Contracting Party does not allow the Office to transmit a communication concerning an international registration directly to the holder, that~~ The Office of a designated Contracting Party may request the International Bureau to transmit ~~that~~ communication s concerning an international registration to the holder on its behalf.

[...]

Rule 24

Designation Subsequent to the International Registration

(1) *[Entitlement]*

(a) A Contracting Party may be the subject of a designation made subsequent to the international registration (hereinafter referred to as “subsequent designation”) where, at the time of that designation, the holder or, where there is more than one holder, at least one of the holders fulfills the conditions under Article 2 of the Protocol to be the holder of an international registration.

[...]

(2) *[Presentation; Form and Signature]*

(a) A subsequent designation shall be presented to the International Bureau by the holder ~~or by the Office of the Contracting Party of the holder~~; however,

(i) [Deleted]

[...]

(3) *[Contents]*

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

[...]

(vi) ~~where the subsequent designation is presented by an Office, the date on which it was received by that Office.~~ [\[Deleted\]](#)

[...]

(c) The subsequent designation may also contain

(i) the indications and translation or translations, as the case may be, referred to in Rule 9(4)(b) [\(i\) to \(vi\)](#),

[...]

[...]

(6) *[Date of Subsequent Designation]*

(a) A subsequent designation ~~presented by the holder direct to the International Bureau shall, subject to subparagraph (c)(i),~~ bear the date of its receipt by the International Bureau.

(b) ~~A subsequent designation presented to the International Bureau by an Office shall, subject to subparagraph (c)(i), (d) and (e), bear the date on which it was received by that Office, provided that the said designation has been received by the International Bureau within a period of two months from that date. If the subsequent designation has not been received by the International Bureau within that period, it shall, subject to subparagraph (c)(i), (d) and (e), bear the date of its receipt by the International Bureau.~~ [\[Deleted\]](#).

(c) Where the subsequent designation does not comply with the applicable requirements and the irregularity is remedied within three months from the date of the notification referred to in paragraph (5)(a),

(i) the subsequent designation shall, where the irregularity concerns any of the requirements referred to in paragraph (3)(a)(i), (iii) and (iv) and (b)(i), bear the date on which that designation is put in order, ~~unless the said designation was presented to the International Bureau by an Office and the irregularity is remedied within the period of two months referred to in subparagraph (b); in the latter case, the subsequent designation shall bear the date on which it was received by the said Office;~~

(ii) the date applicable under subparagraph (a) ~~or (b), as the case may be,~~ shall not be affected by an irregularity concerning requirements other than those which are referred to in paragraph (3)(a)(i), (iii) and (iv) and (b)(i).

(d) Notwithstanding subparagraphs (a), ~~(b)~~ and (c), where the subsequent designation contains a request made in accordance with paragraph (3)(c)(ii), it may bear a date which is later than that resulting from subparagraph (a), ~~(b)~~ or (c).

[...]

[...]

- (10) *[Subsequent Designation Not Considered as Such]* If the requirements of paragraph (2)(a) are not complied with, the subsequent designation shall not be considered as such and the International Bureau shall inform the ~~sender~~holder accordingly and, if the subsequent designation was presented by an Office, that Office.

Rule 25

Request for Recording

- (1) *[Presentation of the Request]*

[...]

- (b) The request shall be presented by the holder ~~or by the Office of the Contracting Party of the holder~~; however, the request for the recording of a change in ownership may be presented through the Office of the Contracting Party of the holder, or of ~~one of~~ the Contracting Parties, indicated in the said request in accordance with paragraph (2)(a)(iv).

[...]

- (2) *[Contents of the Request]*

- (a) A request under paragraph (1)(a) shall, in addition to the requested recording, contain or indicate

[...]

- (iv) in the case of a change in the ownership of the international registration, the Contracting Party ~~or Parties~~ in respect of which the transferee fulfills the conditions under Article 2 of the Protocol to be the holder of an international registration,

- (v) in the case of a change in the ownership of the international registration, where the address of the transferee given in accordance with item (iii) is not in the territory of the Contracting Party, ~~or of one of the Contracting Parties~~, given in accordance with item (iv), and unless the transferee has indicated to be a national of a Contracting State or of a State member of a Contracting Organization, the address of the establishment, or the domicile, of the transferee in the Contracting Party, ~~or in one of the Contracting Parties~~, in respect of which the transferee fulfills the conditions to be the holder of an international registration,

[...]

[...]

- (4) *[Several Transferees]* Where the request for the recording of a change in the ownership of the international registration mentions several transferees, ~~each~~at least one of them must fulfill the conditions under Article 2 of the Madrid Protocol to be holder of the international registration.

Rule 26
Irregularities in Requests for Recording Under Rule 25

[...]

- (3) *[Requests Not Considered as Such]* If the requirements of Rule 25(1)(b) are not complied with, the request shall not be considered as such and the International Bureau shall inform at the same time the ~~sender accordingly~~ holder and, if the request under Rule 25(1)(a) was presented by an Office, that Office.

Rule 27
Recording and Notification with Respect to Rule 25; Declaration that a Change in Ownership or a Limitation Has No Effect

- (1) *[Recording and Notification]*

- (a) The International Bureau shall, provided that the request referred to in Rule 25(1)(a) is in order, promptly record the indications, the change or the cancellation in the International Register, shall notify accordingly the Offices of the designated Contracting Parties in which the recording has effect or, in the case of a cancellation, the Offices of all the designated Contracting Parties, and shall inform at the same time the holder and, if the request was presented by an Office, that Office. Where the recording relates to a change in ownership, the International Bureau shall also inform the former holder in the case of a total change in ownership and the holder of the part of the international registration which has been assigned or otherwise transferred in the case of a partial change in ownership. Where the request for the recording of a cancellation was presented ~~by the holder or by an Office other than the Office of origin~~ during the five-year period referred to in Article 6(3) of the Protocol, the International Bureau shall also inform the Office of origin.

[...]

[...]

- (4) *[Declaration that a Change in Ownership Has No Effect]*

[...]

- (d) The International Bureau shall record in the International Register any declaration made in accordance with subparagraph (c) and, as the case may be, record as a separate international registration, in the name of the transferor, that the part of the international registration ~~which that~~ has been the subject of the said declaration, ~~and shall notify accordingly the party (holder or Office) that presented the request for the recording of a change in ownership and the new holder.~~
- (e) Any final decision relating to a declaration made in accordance with subparagraph (c) shall be notified to the International Bureau which shall record it in the International Register and, as the case may be, modify the International Register accordingly, ~~and shall notify accordingly the party (holder or Office) that presented the request for the recording of a change in ownership and the new holder.~~
- (f) The International Bureau shall notify at the same time the transferor, the transferee and, where applicable, the Office that presented the request for the recording of a change in ownership of the recordings and modifications referred to in subparagraphs (d) and (e).

(5) *[Declaration that a Limitation Has No Effect]*

[...]

- (d) The International Bureau shall record in the International Register any declaration made in accordance with subparagraph (c) and shall notify accordingly the ~~party (holder or Office) that presented the request to record the limitation.~~
- (e) Any final decision relating to a declaration made in accordance with subparagraph (c) shall be notified to the International Bureau which shall record it in the International Register and notify accordingly the ~~party (holder or Office) that presented the request to record the limitation.~~

[...]

Rule 32
Gazette

(1) *[Information Concerning International Registrations]*

- (a) The International Bureau shall publish in the Gazette relevant data concerning

[...]

- (xi) information recorded under Rules 20, 20*bis*, 21, 21*bis*, 22(2)(a), 23 and 27(4) and (5);

[...]

- (b) The reproduction of the mark shall be published as it appears in the international application. Where the applicant has made the declaration referred to in Rule 9(4)(~~a~~b)(~~vi~~vii), the publication shall indicate that fact.

[End of Annex II and of document]