

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

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E-MAIL ADDRESS AS A REQUIRED INDICATION FOR SELECTED REQUESTS FOR RECORDING

Document prepared by the International Bureau

BACKGROUND

1. At the start of the COVID-19 pandemic, there remained 148,600 international registrations under the Madrid System for the International Registration of Marks (hereinafter referred to as “the Madrid System”) for which neither the holder nor the representative had provided their e-mail addresses to receive electronic communications from the International Bureau. Although applicants, holders and representatives had the option to provide their e-mail addresses, they were not required to do so. In April 2020, the International Bureau began contacting holders and representatives to collect their e-mail addresses to mitigate the negative effects of global postal and delivery services disruptions caused by the pandemic.

2. At its fifty-fourth (31st extraordinary) session, held in Geneva from September 21 to 25, 2020, the Assembly of the Madrid Union adopted amendments to Rules 3, 9 and 25 of the Regulations Under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as “the Regulations” and “the Protocol”) as a COVID-19 related measure. The amendments, which entered into force on February 1, 2021, require applicants and new holders to indicate their e-mail addresses in international applications and requests for the recording of a change in ownership. Additionally, they require representatives to indicate their e-mail addresses when appointed.

3. On February 1, 2023, amendments to Section 11 of the 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”) entered into force prescribing that all communications with the International Bureau be conducted by electronic means. Consequently, holders and representatives who had not yet provided their e-mail addresses, were urged to do so as soon as possible.

4. As a result of the measures described above, by April 2024, only 13,800 international registrations remained without any e-mail address for either the holder or the representative, which meant that for 98.4 per cent of international registrations, either the holder or the representative, or both, had provided their e-mail addresses.

5. Nevertheless, for most international registrations, only the representatives have provided their e-mail addresses. As of April 2024, holders had not yet provided their e-mail addresses for 459,500 international registrations, which represents 52 per cent of all international registrations. Additionally, there remained 6,000 international registrations for which the appointed representatives had not yet provided their e-mail addresses.

THE SIGNIFICANCE OF PROVIDING AN E-MAIL ADDRESS

6. Applicants, holders, and representatives must provide their e-mail addresses to benefit from the advantages of receiving electronic communications from the International Bureau, including receiving time-sensitive communications without delay, and from being able to submit online requests and manage their international applications and registrations through a soon-to-be-released secure online platform called eMadrid.

E-MAIL ADDRESS TO RECEIVE ELECTRONIC COMMUNICATIONS

7. The International Bureau has discussed the advantages of electronic communication extensively¹. Electronic communication is the fastest, most efficient, cost effective, eco-friendly, and resilient means to transmit communications. It ensures prompt delivery without negatively affecting delays to respond to time-sensitive communications. The International Bureau has put in place measures that allow it to confirm the delivery of electronic communications, to identify the instances and the reasons for delivery failures, and, when such failures occur, to mail a printed copy of the communication to the physical address of the recipient.

8. While the International Bureau must address all communications to the appointed representative, Article 7(3) of the Protocol requires the International Bureau to address unofficial notices of expiry of international registrations both to holders and representatives. Likewise, the Regulations require that the International Bureau address communications regarding the recording of the appointment of a representative, the cancellation of such recording, notifications of insufficient payment of renewal fees and notifications of non-renewal of international registrations both to holders and representatives.

¹ See document [MM/A/54/1](#) “COVID-19 Measures: Making E-mail a Required Indication”.

9. In 2023, the International Bureau mailed 103,676 communications under the Madrid System to applicants, holders or representatives who either had failed to provide their e-mail addresses or for whom an electronic communication could not be delivered to the e-mail address on record². Of these communications sent by post, 48 per cent of communications were unofficial notices of expiry under Article 7(3) of the Protocol and 32 per cent were non-renewal notifications, both primarily sent to holders who had not provided their e-mail addresses. The remaining 20 per cent consisted of other types of communication.

10. The Madrid System is the WIPO-administered global registration system for which WIPO's mail handling services process the largest number of outgoing communications, with negative cost and environmental implications. As comparison, in 2023, WIPO processed only 152 communications for PCT; 10,041 for the Arbitration and Mediation Center; and 8,951 for the rest of the Organization.

11. While the International Bureau will continue its efforts to collect e-mail addresses by contacting holders and representatives, further measures are required to ensure that holders and representatives who have not yet provided their e-mail address do so. Ensuring that holders and representatives provide their e-mail addresses will reduce the risk that they miss receiving time-sensitive communications due to possible postal services irregularities or disruptions. Most importantly, it will decrease the demand for mail handling services and help lower the carbon footprint of the Organization.

E-MAIL ADDRESS AS PART OF AN ONLINE MODE OF IDENTIFICATION TO SECURELY MANAGE INTERNATIONAL APPLICATIONS AND REGISTRATIONS

12. The introduction of online requests for recording has led to fewer irregular requests³ and shorter processing times compared to those requests transmitted by other means⁴. These advantages have contributed to a high adoption rate of online requests⁵. Additionally, online requests provide an opportunity for introducing automatic processing and inscription, without human intervention, for certain recordings.

13. Online requests are being enhanced to ensure greater security compared to requests transmitted by other means. This is being achieved through the introduction of a mode of identification for the purposes of Section 7 of the Administrative Instructions. In the context of electronic communications exchanged with applicants or holders and representatives, this section allows for the replacement of signatures with a mode of identification to be determined by the International Bureau.

14. Online requests for recording submitted by a user with a WIPO Account associated to the e-mail address of the representative or of the holder are deemed as having been signed by them. In cases where the WIPO Account is not associated with the e-mail address of the representative or the holder, a confirmation (signature) request is sent to the e-mail address of the representative. If there is no representative, the confirmation request is sent to the e-mail address of the holder. In all scenarios, the representative or the holder are informed that a request has been submitted and is being processed.

² The most common causes for such failure are defective e-mail addresses, e-mail addresses no longer valid or full e-mail inbox.

³ For instance, in March 2024, 8 per cent of online requests for recording a change in ownership were irregular, compared to 46 per cent of paper-based requests.

⁴ For instance, in March 2024, online requests for the recording of a change in ownership were processed in 19 days, compared to 43 days to process paper-based requests.

⁵ Adoption rate of online requests varies across recording. In March 2024, adoption rate for requests for the recording of a renunciation was 83 per cent, while it was 52 per cent for requests for the recording of a change in ownership.

15. The online signature process described above, was introduced as a pilot for online requests for the recording of a change in ownership in 2022. Following the positive experience gained during this pilot phase, the online signature process is now being introduced for other online requests for recording.

16. In the near future, online requests will be accessible through a new service called eMadrid. Applicants, holders and representatives who provide their e-mail addresses and create a WIPO Account linked to the same e-mail address will be able to securely, efficiently and effectively manage their portfolio of international applications and registrations by logging into eMadrid using their WIPO Account.

17. Applicants and representatives who have not yet provided their e-mail addresses will be unable to take advantage of online requests for recording and will miss out on the benefits offered by the new eMadrid platform. The current benefits of online requests for recording and the anticipated benefits of the new eMadrid platform underscore the importance of undertaking further efforts to ensure that holders and representatives who have not yet provided their e-mail addresses do so.

E-MAIL ADDRESS AS A REQUIREMENT FOR SELECTED REQUESTS FOR RECORDING

18. The International Bureau proposes to amend Rules 3, *20bis*, 24 and 25 of the Regulations to require holders and representatives who have not yet indicated their e-mail addresses to do so in requests presented under these rules. A similar requirement would extend to licensees and to their representatives in requests presented under Rule *20bis*.

19. An amendment to Rule 3(2)(a) of the Regulations would require applicants and holders who have not yet indicated their e-mail addresses to do so in a request for the recording of the appointment of a representative. In accordance with paragraph (3) of the same rule, requests for the recording of the appointment of a new representative that do not meet the new requirement would result in an irregular appointment.

20. New subparagraphs (vi) and (vii) in Rule *20bis*(1)(b) of the Regulations would require holders and representatives who have not yet indicated their e-mail addresses to do so in requests for the recording, amendment of the recording or cancellation of the recording of a license.

21. Proposed amendments to Rule *20bis*(1)(b)(iii) and (c)(iv) of the Regulations would require that requests for the recording of a license include the e-mail address of the licensee and of the representative of the licensee.

22. Proposed amendments to Rule *20bis*(2)(a) and (b), (3)(a) and (5)(d) and (e) of the Regulations would require that the International Bureau notify licensees or their representatives of irregularities in requests presented under the same rule, of the abandonment of such requests and of recordings effected under Rule *20bis* of the Regulations, including those concerning declarations that a given license has no effect.

23. New subparagraphs (vii) and (viii) in Rule 24(3)(a) of the Regulations would require holders and representatives who have not yet indicated their e-mail addresses to do so in a request for the recording of a subsequent designation.

24. New subparagraphs (viii) and (ix) in Rule 25(2)(b) of the Regulations would require holders and representatives who have not yet indicated their e-mail addresses to do so in requests for the recording of changes in ownership, limitations, renunciations, changes in name or address of the holder or representative and cancellations.

25. The e-mail addresses of the transferor and of the representative of the transferor in a request for the recording of a change in ownership are necessary to notify them of the recording of the change, and of any possible later declarations that such recording has no effect and of the creation of a new international registration in the name of the transferor.

26. Requests for recording presented under Rules 20*bis*, 24, 25 and 27*bis* of the Regulations that do not meet the proposed new requirements would be irregular. For requests concerning the recording of a subsequent designation, such irregularity, if remedied, would not affect the date of the subsequent designation. Requests that are not remedied within the prescribed three-month time limit would be considered abandoned.

27. It is suggested that the amendments to the Regulations proposed in this document enter into force on [November 1, 2025].

28. *The Working Group is requested to:*

(i) consider the contents of the present document; and,

*(ii) recommend to the Madrid Union Assembly some or all of the proposed amendments to Rules 3, 20*bis*, 24 and 25 of the Regulations, as presented in the Annex to this document or in amended form, for their entry into force on [November 1, 2025].*

[Annex follows]

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, 2024~~[\[November 1, 2025\]](#)

[...]

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 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 addresses of the representative and of the applicant or holder where the electronic mail address of the applicant or holder was not indicated in the international application or in a previous request for recording.

[...]

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.
- (b) The request shall indicate
- (i) the number of the international registration concerned,
 - (ii) the name of the holder,
 - (iii) the name and address of the licensee, given in accordance with the Administrative Instructions, and the electronic mail address of the licensee.
 - (iv) the designated Contracting Parties with respect to which the license is granted,
 - (v) that the license is granted for all the goods and services covered by the international registration, or the goods and services for which the license is granted, grouped in the appropriate classes of the International Classification of Goods and Services.
 - (vi) the electronic mail address of the holder where this address was not indicated in the international application or in a previous request for recording.

(vii) the electronic mail address of the representative, if any, where this address was not indicated in the request for the recording of the appointment of the representative as such.

- (c) The request may also indicate
- (i) where the licensee is a natural person, the State of which the licensee is a national,
 - (ii) where the licensee is a legal entity, the legal nature of that entity and the State and, where applicable, the territorial unit within that State, under the law of which the said legal entity has been organized,
 - (iii) that the license concerns only a part of the territory of a specified designated Contracting Party,
 - (iv) where the licensee has a representative, the name and address of the representative, given in accordance with the Administrative Instructions, and the electronic mail address of the representative,
 - (v) where the license is an exclusive license or a sole license, that fact,^[7]
 - (vi) where applicable, the duration of the license.
- (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, the licensee or the representative of the licensee, if any, 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, the licensee or the representative of the licensee, if any, 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, the licensee or the representative of the licensee, if any, and, if the request was presented by an Office, that Office.
- (b) The license shall be recorded as of the date of receipt by the International Bureau of a request complying with the applicable requirements.
- (c) Notwithstanding subparagraph (b), where continued processing has been recorded under Rule 5*bis*, the license shall be recorded in the International Register as of the date of expiry of the time limit specified in paragraph (2)(b).

- (4) *[Amendment or Cancellation of the Recording of a License]* Paragraphs (1) to (3) shall apply *mutatis mutandis* to a request for the amendment or cancellation of the recording of a license.
- (5) *[Declaration that the Recording of a Given License Has No Effect]*
- (a) The Office of a designated Contracting Party which is notified by the International Bureau of the recording of a license in respect of that Contracting Party may declare that such recording has no effect in the said Contracting Party.
 - (b) The declaration referred to in subparagraph (a) shall indicate
 - (i) the reasons for which the recording of the license has no effect,
 - (ii) where the declaration does not affect all the goods and services to which the license relates, those which are affected by the declaration or those which are not affected by the declaration,
 - (iii) the corresponding essential provisions of the law, and
 - (iv) whether such declaration may be subject to review or appeal.
 - (c) The declaration referred to in subparagraph (a) shall be sent to the International Bureau before the expiry of 18 months from the date on which the notification referred to in paragraph (3) was sent to the Office concerned.
 - (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 and the licensee or the representative of the licensee, if any. 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 and the licensee or the representative of the licensee, if any.

[...]

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 fulfills the conditions under Article 2 of the Protocol to be the holder of an international registration.
 - (b) [Deleted]
 - (c) [Deleted]

(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]
 - (ii) [Deleted]
 - (iii) where paragraph (7) applies, the subsequent designation resulting from conversion must be presented by the Office of the Contracting Organization.
- (b) The subsequent designation shall be presented on the official form. Where it is presented by the holder, it shall be signed by the holder. Where it is presented by an Office, it shall be signed by that Office and, where the Office so requires, also by the holder. Where it is presented by an Office and that Office, without requiring that the holder also sign it, allows that the holder also sign it, the holder may do so.

(3) *[Contents]*

- (a) Subject to paragraph (7)(b), the subsequent designation shall contain or indicate
- (i) the number of the international registration concerned,
 - (ii) the name of the holder,
 - (iii) the Contracting Party that is designated,
 - (iv) where the subsequent designation is for all the goods and services listed in the international registration concerned, that fact, or, where the subsequent designation is for only part of the goods and services listed in the international registration concerned, those goods and services,
 - (v) the amount of the fees being paid and the method of payment, or instructions to debit the required amount of fees to an account opened with the International Bureau, and the identification of the party effecting the payment or giving the instructions, ~~and,~~
 - (vi) where the subsequent designation is presented by an Office, the date on which it was received by that Office~~;~~
 - (vii) the electronic mail address of the holder where this address was not indicated in the international application or in a previous request for recording, and,
 - (viii) the electronic mail address of the representative, if any, where this address was not indicated in the request for the recording of the appointment of the representative as such.

[...]

Rule 25
Request for Recording

(1) *[Presentation of the Request]*

- (a) A request for recording shall be presented to the International Bureau on the relevant official form where the request relates to any of the following:
 - (i) a change in the ownership of the international registration in respect of all or some of the goods and services and all or some of the designated Contracting Parties;
 - (ii) a limitation of the list of goods and services in respect of all or some of the designated Contracting Parties;
 - (iii) a renunciation in respect of some of the designated Contracting Parties for all the goods and services;
 - (iv) a change in the name or address of the holder or, where the holder is a legal entity, an introduction of or a change in the indications concerning the legal nature of the holder and the State and, where applicable, the territorial unit within that State under the law of which the said legal entity has been organized;
 - (v) cancellation of the international registration in respect of all the designated Contracting Parties for all or some of the goods and services;
 - (vi) a change in the name or address of the representative.
- (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, or of one of the Contracting Parties, indicated in the said request in accordance with paragraph (2)(a)(iv).
- (c) *[Deleted]*
- (d) Where the request is presented by the holder, it shall be signed by the holder. Where it is presented by an Office, it shall be signed by that Office and, where the Office so requires, also by the holder. Where it is presented by an Office and that Office, without requiring that the holder also sign it, allows that the holder also sign it, the holder may do so.

(2) *[Contents of the Request]*

- (a) A request under paragraph (1)(a) shall, in addition to the requested recording, contain or indicate
 - (i) the number of the international registration concerned,
 - (ii) the name of the holder or the name of the representative where the change relates to the name or address of the representative,
 - (iii) in the case of a change in the ownership of the international registration, the name and address, given in accordance with the Administrative Instructions, and the electronic mail address of the natural person or legal entity mentioned in the request as the new holder of the international registration (hereinafter referred to as "the transferee"),

- (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,
- (vi) in the case of a change in the ownership of the international registration that does not relate to all the goods and services and to all the designated Contracting Parties, the goods and services and the designated Contracting Parties to which the change in ownership relates, ~~and~~
- (vii) the amount of the fees being paid and the method of payment, or instructions to debit the required amount of fees to an account opened with the International Bureau, and the identification of the party effecting the payment or giving the instructions.
- (viii) the electronic mail address of the holder where this address was not indicated in the international application or in a previous request for recording,
- (ix) the electronic mail address of the representative, if any, where this address was not indicated in the request for the recording of the appointment of the representative as such.

[End of Annex and of document]