

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

Twenty-Third Session
Geneva, September 22 to 26, 2025

PROPOSAL BY THE DELEGATIONS OF AUSTRALIA, CHILE, GHANA, MEXICO, THE PHILIPPINES, THE REPUBLIC OF KOREA AND THE UNITED STATES OF AMERICA

Document prepared by the Secretariat

1. In a communication dated September 16, 2025, the International Bureau received a proposal from the Delegations of Australia, Chile, Ghana, Mexico, the Philippines, the Republic of Korea and the United States of America concerning dependency for consideration by the Working Group on the Legal Development of the Madrid System for the International Registration of Marks, at its twenty-third session to be held in Geneva from September 22 to 26, 2025.
2. This proposal is an updated version of the one contained in document [MM/LD/WG/21/8 Rev.2](#).
3. The said proposal is annexed to this document.

[Annex follows]

PROPOSAL TO MODERNIZE THE MADRID PROTOCOL BY THE DELEGATIONS OF AUSTRALIA, CHILE, GHANA, MEXICO, THE PHILIPPINES, THE REPUBLIC OF KOREA, AND THE UNITED STATES OF AMERICA

INTRODUCTION

1. After more than a decade of discussions at the Madrid Working Group (hereinafter “Working Group”) focused on reaching consensus on just **one** option to address the challenges posed by the dependency principle of the Madrid Protocol, Australia, Chile, Ghana, Mexico, the Philippines, the Republic of Korea, and the United States of America co-sponsored a proposal to allow Madrid Contracting Parties (hereinafter “Members”) to choose from a **list** of options to best serve their stakeholders. See document [MM/LD/WG/21/8 Rev.2](#).

2. This document updates that previous proposal by including two additional options discussed at the Working Group, namely: limiting the grounds for central attack and freezing dependency. This document also clarifies some misconceptions about the proposal revealed during discussions during the twenty-second session of the Working Group.

BACKGROUND

3. The Madrid Protocol requires a basic national or regional application or registration (basic mark) to file an international application to request extension of protection in one or more Members. It also mandates that the resulting international registration and all designations be dependent on that basic mark for five years from the date of the international registration. These provisions in combination have presented certain difficulties for some stakeholders.

4. In 2006, Norway proposed a long-term goal for the Madrid Protocol and requested the Working Group to discuss future aspects of the Madrid System to benefit applicants and holders, national Offices, and the International Bureau. Included in that proposal was the elimination of the basic mark and the ability for an applicant to designate the territory of the Office of origin in the international application. The Working Group has discussed various proposals, including the options listed below, with no consensus reached to date.

5. This current proposal acknowledges the difficulties trademark owners face and reflects the realities of conducting business in the 21st century global economy. It reduces the constraints and complications of the current Madrid Protocol that prevent greater use of the Madrid System. It also addresses the risk of the Madrid Protocol becoming redundant. With advancements in information technology, including artificial intelligence and machine translation, the advantages of using the Madrid System may diminish over time. More and more applicants may decide to file directly to avoid the challenges the Madrid Protocol currently presents.

6. But if modernized, the Madrid Protocol can continue to thrive as the only mechanism providing for the filing of a trademark application in multiple countries through a single international application and the additional associated efficiencies provided by centralized management of registrations across the globe. This proposal offers a way forward that accommodates the diverse positions and needs of Members and their stakeholders and aligns the Madrid Protocol with some of the flexibilities of the Hague System for the International Registration of Industrial Designs, an analogous WIPO filing and registration system developed and advanced off the concepts and attributes of the Madrid Protocol.

DIFFICULTIES ENCOUNTERED BY MADRID SYSTEM USERS

7. Madrid system users have encountered difficulties in relation to pursuing and managing their trademark registrations as a result of strict dependency requirements in relation to the basic mark. The below illustrative user difficulties and others would be addressed through implementation of this proposal to update the Madrid Protocol.

8. **Export marks (foreign language or script):** Marks intended for use in foreign markets (export marks) are typically in the languages/scripts of the foreign markets and not in the local language/script. These export marks present challenges for holders because, to use the Madrid System, holders are forced to protect them in the Offices of origin (as basic marks) even if they may not intend to use them in the market of the Office of origin. Holders may also be forced to provide evidence of use of the basic marks in the Offices of origin during the dependency period. Failure to use the mark may trigger non-use cancellation proceedings, resulting in cancellation of the international registrations and all the designations. These requirements of use in one market to preserve trademark rights in another market no longer align with the modern trade practices in which companies create unique marketing strategies for specific markets.

9. **Grounds of refusal:** Concerns exist as to whether a refusal or cancellation of the basic mark in an Office of origin should result in cancellation of the international registration and all designated Members. For example, a basic mark refused because it is descriptive under an Office of origin's national law might not be refused as descriptive under the law of a designated Member were it filed outside of the Madrid Protocol in that jurisdiction. In addition, a basic mark refused due to likelihood of confusion in the Office of origin results in the cancellation of protection in all the designated Members. This occurs even when the prior mark in the Office of origin has no protection in any of the designated Members and, even if the prior mark was protected, the prior mark's holder has no interest in the applicant's mark obtaining protection in the designated territories. Some have questioned whether the grounds of refusal applicable in Offices of origin contradict the principle of territoriality as well as sovereignty of the designated Members.

10. **Identification of goods and services:** Certain Members require very specific identifications of goods and services (for example, "T-shirts, pants and jackets" versus "clothing"). The specific identifications in the basic marks limit the scope of the goods and services in the international registrations and all designations. This uniquely disadvantages some holders vis-à-vis their foreign competitors. Holders are forced to choose between (1) using the Madrid System to file in multiple territories and forgoing the broader protection available in territories that allow it, or (2) filing in each territory separately to obtain the broadest protection available but forgoing the efficiencies and cost savings of the Madrid System.

11. **Dependency:** The World Intellectual Property Organization (WIPO) has shared information gleaned from studies and surveys about accession experiences, ceasing of effect, central attack, transformation, and dependency as well as input provided by users through inquiries, seminars, webinars, and meetings. It is notable for these studies and surveys that for some holders, dependency is a significant barrier to using the Madrid System and is viewed as less of a safeguard and more of a problem, such as in relation to the following issues:

- **Ceasing of effect:** Ceasing of effect of the basic mark due to third-party central attack does not appear to be widely used. Most are due to *ex officio* refusal, holder's inaction or third-party action when there is no interest in cancelling the designations. The grounds of refusal of the basic mark are also relevant only in the Office of origin and not in the designated Members.

- **Lost costs:** The costs of filing an international application and designating Members are lost when the basic mark, the international registration and all the designations are cancelled.
- **Transformation:** The ability to transform the cancelled designations into national applications of the designated Offices negates the perceived benefits of central attack. Additionally, transformation is complicated, incurs additional costs for the holder to file requests for transformation and the outcome is uncertain as to whether the mark will be protected or denied in each designated country.
- **Additional costs:** The holder incurs added costs to maintain the basic mark in the Office of origin during the dependency period when they have no interest there.
- **Legal uncertainty:** The holder's rights are under threat during the dependency period because there is the risk of cancellation of the basic mark which would terminate the international registration and all designations.
- **Imbalance of interests:** The prevailing sentiment is that the rights and interests of third parties are favored over those of the holders and the investment the holders have made in their brands.

PROPOSAL SUMMARY

12. To address these difficulties, it is requested that the Working Group consider including the following flexibilities in the Madrid System so it can be used more effectively. The below chart entitled "Proposal to Modernize the Madrid Protocol – Options Comparison" provides additional information summarizing the characteristics of the options that Member States could choose from in implementing the Protocol.

- (1) **Eliminate the basic mark and dependency**
No basic mark requirement would exist so the process would begin with the trademark owner filing an international application designating one or more Members for protection. WIPO would examine it for formalities, address any irregularities, issue an international registration, and forward to the designated Members. Each designated Member would then examine under its national laws and grant or refuse protection under existing practice. There is no dependency and no legal uncertainty. The Office of origin will not issue any ceasing of effect that would result in the cancellation of the international registration and the extensions of protection. *This approach tracks the approach taken under the Hague System.*
- (2) **Retain the basic mark, but eliminate dependency and transformation**
The basic mark requirement would remain, and the Office of origin and WIPO would perform their related duties. There is no dependency, there is no legal uncertainty. The Office of origin would not issue any ceasing of effect that would result in the cancellation of the international registration and all extensions of protection. The need for the trademark holder to expend additional resources to transform the cancelled extension of protection would no longer exist.
- (3) **Retain the basic mark, but temporarily suspend (freeze) dependency (added)**
The basic mark requirement would remain, and the Office of origin and WIPO would perform their related duties. However, dependency is temporarily suspended and would not apply. The Office of origin would not issue any ceasing of effect that would result in the cancellation of the international registration and all extensions of protection.

(4) Retain the basic mark, but reduce the dependency period from five to three years

Like the existing practice, both the basic mark and dependency would remain, and the Office of origin and WIPO would perform their related duties. Dependency would remain but the dependency period would be reduced from five years to three years.

(5) Retain the basic mark, but limit the grounds for cancelling the international registration (added)

The basic mark requirement would remain, and the Office of origin and WIPO would perform their related duties. Dependency would remain but the grounds for cancelling the basic mark, the international registration and all extensions of protection would be limited. *Ex officio* refusal of the basic mark on grounds that only apply in the Office of origin would not result in the cancellation of the international registration and all extensions of protection.

(6) Retain the basic mark, but eliminate the automatic effect of dependency

The basic mark requirement would remain, and the Office of origin and WIPO would perform their related duties. Dependency would remain for the five-year dependency period. However, if the basic mark is refused or cancelled in the Office of origin due to third-party action, this would not automatically trigger a ceasing of effect of the international registration and all extensions of protection. The Office of origin would issue a ceasing of effect only if the third party requested the international registration and all extensions of protection be cancelled.

CLARIFICATIONS OF MISUNDERSTANDINGS OF THE PROPOSAL

13. The interventions of Members during the meetings of the Working Group uncovered various misunderstandings of the co-sponsored proposal. Below are clarifications addressing those misunderstanding:

- The options presented do not implicate designated Offices, they only relate to international applications transmitted from the Office of Origin to the International Bureau.
- IP Offices and their stakeholders do not need to know which option a foreign IP Office of Origin or designated Office has chosen because the options only impact international applications and not designations; however, this information may be provided on WIPO's Declarations and Notifications as well as Madrid Member Profiles pages.
- In some cases, national laws can be amended with minimum changes for adopting an option.
- If a Member chooses to retain the basic mark but eliminate the dependency requirement, the basic mark will be used to certify the international application and resolve any irregularities.
- Designated Offices will continue to examine applications under their national law – nothing changes.
- Retaining the basic mark requirement may not be useful for export markets. Eliminating it could address the problem linguistic diversity presents when other languages must be used for export markets.
- The basic mark requirement does not prevent bad faith filing. In fact, if the basic mark is filed in bad faith, all the designations are considered to be filed in bad faith.

- This proposal envisions that the Working Group will determine the final list of options to be provided for Member State selection and implementation.
- The Working Group need only agree that Members be allowed to choose from a list of options provided.
- Members do not need to decide now which option they would choose, if any.

Even if the proposal is adopted, Members may decide to stay with the current Madrid Protocol.

POSSIBLE WAY FORWARD

14. Madrid users have expressed frustration that legacy provisions in the system, provisions not included in establishing subsequent international filing and registrations systems, continue to frustrate expanded use, benefit and outcomes the Madrid Protocol could provide. As such, with many jurisdictions wishing to accommodate user concerns, the time is right to actively reach agreement on a solution or solutions.

15. For those that prefer the system remain as is, at least with respect to their jurisdiction, it is important to note that the current proposal enables Members who find the existing practice satisfactory to retain their current practices while allowing other jurisdictions the ability to update practices. Therefore, the named delegations request the Working Group discuss and consider advancement of this proposal of multiple options on dependency into the Madrid System.

Proposal to Modernize the Madrid Protocol – Options Comparison

NO.	OPTION	BENEFIT TO OFFICE OF ORIGIN	BENEFIT TO DESIGNATED OFFICE	BENEFIT TO TRADEMARK OWNER	REMEDY FOR INTERESTED PARTY
1	No Basic/No Dependency	<ul style="list-style-type: none"> - No certification - No ceasings - No corrections - No irregularities - Simplify national law *Help/charge fee for IA *Require self-designation 	<ul style="list-style-type: none"> - No cancellations due to ceasings - No transformations to process - No corrections to process 	<ul style="list-style-type: none"> - Designations not cancelled due to cancellation of basic/no transformation - Free to use different language for export market - No restrictions on identification and classification of goods or services 	<ul style="list-style-type: none"> - WIPO's ADR option for cancelling the IR and its designations, including on the grounds of bad faith
2	Basic Mark but No Dependency	<ul style="list-style-type: none"> - Fees for basic mark - No ceasings 	<ul style="list-style-type: none"> - No cancellations due to ceasings - No transformations to process 	<ul style="list-style-type: none"> - Designations not cancelled due to cancellation of basic/no transformation - No restrictions on identification and classification of goods or services 	<ul style="list-style-type: none"> - WIPO's ADR option for cancelling the IR and its designations, including on the grounds of bad faith
3	Basic Mark but temporarily suspend (freeze) Dependency	<ul style="list-style-type: none"> - No ceasings 	<ul style="list-style-type: none"> - Fewer cancellations due to ceasings 	<ul style="list-style-type: none"> - Designations not cancelled due to cancellation of basic/no transformation - No restrictions on identification and classification of goods or services 	<ul style="list-style-type: none"> - WIPO's ADR option for cancelling the IR and its designations, including on the grounds of bad faith
4	Basic Mark but Dependency down to 3 Years	<ul style="list-style-type: none"> - Fees for basic mark - Possibly fewer ceasings 	<ul style="list-style-type: none"> - Possibly fewer cancellations due to ceasings 	<ul style="list-style-type: none"> - Reduces time that basic mark can be cancelled 	<ul style="list-style-type: none"> - CA or WIPO's ADR option for cancelling the IR and its designations

NO.	OPTION	BENEFIT TO OFFICE OF ORIGIN	BENEFIT TO DESIGNATED OFFICE	BENEFIT TO TRADEMARK OWNER	REMEDY FOR INTERESTED PARTY
5	Basic Mark but Limit the Grounds for Central Attack	- Fewer ceasings but Office may need to develop a system for tracking grounds	- Fewer cancellations due to ceasings	- Fewer designations cancelled due to cancellation of basic	- CA or WIPO's ADR upon request of objector
6	Basic Mark but No Automatic Effect of Dependency	- Fewer ceasings; send only upon request of 3 rd party	- Fewer cancellations due to ceasings	- Designations not cancelled due to cancellation of basic	- CA or WIPO's ADR option but must request to cancel IR

* – additional considerations that could benefit the Office of Origin

IA – International Application; IR – International Registration; ADR – Alternate Dispute Resolution; CA – Central Attack

[End of Annex and of document]