

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

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PROPOSED AMENDMENTS TO THE REGULATIONS UNDER THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS INTRODUCING A REQUIREMENT TO ISSUE A NATIONAL OR REGIONAL CERTIFICATE

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 as “the Regulations”). The proposed amendments seek to enhance the enforceability and usability of trademark rights obtained through the Madrid System for the International Registration of Marks (hereinafter referred to as “the Madrid System”) by requiring Offices of designated members to issue national or regional certificates when granting protection and upon renewal of an international registration.
2. The proposed amendments also include a transitional provision to allow members sufficient time to adjust their national or regional legislations and administrative procedures accordingly.

PROBLEMS FACED BY HOLDERS DUE TO THE LACK OF NATIONAL OR REGIONAL CERTIFICATES

3. There is no consistent practice among the Offices of designated members under the Madrid System regarding the issuance of national or regional certificates for trademarks in international registrations that have been granted protection. Some Offices do not issue such certificates, leaving holders of international registrations without locally recognized

documentation to confirm the protection of their trademarks. Others provide certificates only upon request, with a few requiring local representation or the payment of a fee for their issuance. In some jurisdictions, the certificate is made available online, allowing holders of international registrations to access and retrieve it digitally. Meanwhile, certain Offices take a more proactive approach by automatically issuing a certificate and sending it along with the statement of grant of protection.

4. These variations in practice create inconsistencies in how international registrations are documented and recognized across different jurisdictions, potentially leading to uncertainty and administrative challenges for holders of international registrations who rely on uniform and predictable procedures for enforcing and managing their rights. Addressing these disparities is essential to ensuring a more coherent and reliable trademark protection framework for users of the Madrid System. Some of the challenges holders of international registrations may face when exercising or enforcing their rights in jurisdictions that do not issue national or regional certificates are described below.

LEGAL AND ENFORCEMENT BARRIERS

5. In several jurisdictions, holders of international registrations may be required to obtain a national or regional certificate before they can initiate enforcement actions, such as filing trademark infringement lawsuits. Courts and administrative authorities may not always recognize statements of grant of protection issued by the Offices of designated members as sufficient proof of ownership. As a result, holders of international registrations may find themselves without adequate legal recourse when disputes arise. This disparity places an additional burden on these holders, who must navigate complex legal procedures to secure the necessary documentation before seeking enforcement.

CHALLENGES IN BUSINESS AND COMMERCIAL TRANSACTIONS

6. Many business transactions, such as licensing agreements, franchise arrangements, mergers, acquisitions, and financial dealings, necessitate formal proof of trademark ownership in the form of a national or regional certificate. Business partners, financial institutions, and investors may often require official documentation issued by a recognized national or regional authority to validate the legal standing of a trademark. Without such certification, holders of international registrations may face difficulties in securing partnerships, obtaining financing, or successfully concluding commercial negotiations, ultimately hindering their business opportunities.

CUSTOMS AND BORDER PROTECTION MEASURES

7. To effectively prevent the importation and sale of counterfeit goods, many customs authorities may require holders of international registrations to present a national or regional certificate before allowing them to record their rights for enforcement purposes. The absence of such documentation could significantly weaken efforts to combat counterfeiting, leaving holders with limited means to protect their trademarks from infringement at the border. Without formal recognition of their trademarks at the national or regional level, holders of international registrations may struggle to enforce their rights against counterfeiters, allowing unauthorized goods to enter the market.

LOCAL MARKET RECOGNITION AND ADMINISTRATIVE PROCESSES

8. In certain jurisdictions, authorities may prioritize locally issued documents over those provided by the International Bureau. This preference could create bureaucratic obstacles for users of the Madrid System who seek to enforce their rights or engage in business activities requiring official trademark documentation. As a result, holders of international registrations may face administrative delays, additional procedural requirements, or even rejection of their claims due to the lack of locally recognized certificates. These challenges could complicate efforts to establish and protect trademark rights in different markets, discouraging businesses from expanding internationally.

ADDRESSING THE PROBLEMS THROUGH THE ISSUANCE OF NATIONAL OR REGIONAL CERTIFICATES

9. The proposed amendments to the Regulations aim to address the challenges described above by introducing a requirement for Offices of designated members to issue national or regional certificates upon granting protection and upon renewal. These certificates would be provided in the format and language customary to each Office. The introduction of this requirement seeks to enhance transparency, streamline administrative processes, and provide holders of international registrations with clear and enforceable documentation that facilitates the protection and management of their trademarks. The benefits of implementing such a measure are multifaceted and would have positive implications for both holders of international registrations and national or regional authorities.

ENHANCED LEGAL CERTAINTY

10. A standardized issuance of national or regional certificates would provide holders of international registrations with an official, legally recognized document confirming the validity of their rights within each designated jurisdiction. This measure would significantly reduce ambiguity regarding the status and enforceability of a trademark in an international registration, ensuring that businesses, legal practitioners, and enforcement agencies have a clear reference point when determining the scope of protection. In many jurisdictions, legal disputes may arise due to inconsistencies in documentation or the lack of a formal recognition mechanism at the national or regional level. By mandating the issuance of these certificates, holders of international registrations can be assured of a uniform standard that aligns with the legal framework of each jurisdiction, thus strengthening their ability to assert and defend their trademark rights effectively.

FACILITATION OF COMMERCIAL TRANSACTIONS

11. A recognized national or regional certificate of trademark registration would greatly facilitate commercial transactions by providing businesses, investors, and financial institutions with a tangible and credible document that verifies ownership and legal protection. In mergers, acquisitions, and licensing agreements, trademark rights are often a key asset that must be evaluated for their legal standing. Having a standardized certificate would simplify due diligence processes, making it easier for companies to assess the value and security of trademark assets. Furthermore, financial institutions that provide loans or funding based on intellectual property assets would benefit from a more transparent and reliable system that enables them to assess risk and make informed lending decisions. This measure would ultimately enhance the efficiency of commercial negotiations and contractual agreements related to trademark rights.

IMPROVED BORDER PROTECTION MEASURES

12. Counterfeit goods pose a significant threat to legitimate businesses, causing financial losses and damaging brand reputation. Customs authorities play a crucial role in preventing the entry of counterfeit products into markets, but their effectiveness is often hindered by the lack of standardized documentation to verify trademark ownership. By requiring Offices of designated members to issue national or regional certificates, customs authorities would have a clear and reliable reference to confirm the legitimacy of trademark claims. This would enable them to take timely and decisive action against counterfeit goods, thereby enhancing brand protection efforts and safeguarding consumer interests. A recognized national or regional certificate could also foster greater cooperation between national and international enforcement agencies, strengthening the global fight against trademark infringement and counterfeiting.

GREATER HARMONIZATION AND ADMINISTRATIVE EFFICIENCY

13. One of the key advantages of implementing a uniform requirement for national or regional certificates is the harmonization of administrative procedures across different jurisdictions. Currently, disparities in documentation requirements and processing times create inefficiencies for both holders of international registrations and national or regional authorities. By introducing a standardized approach, Offices of designated members would benefit from a more streamlined workflow, reducing administrative burdens and expediting the issuance of trademark protection documents. This measure would also promote greater alignment with global best practices. For holders of international registrations, the reduced complexity in managing their portfolios across multiple jurisdictions would lead to cost savings and improved operational efficiency, enabling them to focus on strategic brand management and market expansion.

14. The proposed amendments to the Regulations, which would mandate the issuance of national or regional certificates upon granting protection and renewal, offer substantial benefits for holders of international registrations, competent authorities, and enforcement agencies. By enhancing legal certainty, facilitating commercial transactions, improving border protection measures, and promoting administrative efficiency, this initiative would contribute to a more robust and harmonized trademark protection framework.

FEATURES OF THE CERTIFICATE

EQUIVALENCE WITH NATIONAL OR REGIONAL REGISTRATION CERTIFICATES

15. The certificate issued for an international registration should be identical in terms of layout, design, and format to a national or regional registration certificate issued by the Offices of the designated members. This uniformity is essential to ensure that international registrations are seamlessly integrated into the local legal and administrative framework. If international certificates were designed differently from national or regional certificates, they could create confusion among enforcement agencies, business partners, and regulatory bodies, potentially leading to unnecessary scrutiny, delays, or even rejection of their validity. By making the certificates practically indistinguishable, authorities and stakeholders can immediately recognize them as official documents, eliminating any doubt regarding their authenticity and enforceability.

16. Moreover, the certificate should be issued in a language used by the Office of the designated member to ensure that it is readily understood and accepted by relevant authorities, businesses, and enforcement agencies. If the certificates were issued in a different language than the one commonly used by local institutions, it could create additional administrative burdens, requiring translations or further verification before acceptance. This could delay legal

and commercial processes, placing holders of international registrations at a disadvantage. A certificate that mirrors national or regional certificates in both design and language ensures that it can be used without additional steps, facilitating seamless enforcement and recognition.

TIMELINESS OF ISSUANCE

17. To be effective, the certificate must be issued neither faster nor slower than a national or regional certificate. Maintaining parity in the timing of its issuance is crucial to ensuring that holders of international registrations are not placed at a disadvantage compared to those with national or regional trademarks. If the issuance of the certificate is delayed, holders may face obstacles in enforcing their rights, as legal actions, customs recordation, and business transactions often depend on timely documentation. Such delays could result in lost opportunities, weakened enforcement efforts, and an increased risk of counterfeiting or unauthorized use.

18. Conversely, if certificates are issued too quickly, it could create an imbalance between holders of international registrations and local applicants. To uphold fairness and consistency, both groups should follow the same process and timeline, ensuring that international registrations are neither unduly accelerated nor subjected to unnecessary delays. This approach guarantees that all trademark holders, regardless of the registration route they choose, are treated equitably and can rely on a predictable, transparent system for obtaining certification. By aligning the issuance process for both holders of international registrations and local applicants, authorities can reinforce trust in the trademark system while ensuring smooth enforcement and business operations.

FEES AND COST RECOVERY

19. Offices that charge a fee for national or regional certificates and have declared for individual fees under the Madrid System could include this cost in their individual fee, ensuring a streamlined approach to cost recovery. This mechanism would allow Offices of designated members to maintain financial sustainability while providing this essential service to right holders.

AVAILABILITY OF INFORMATION FOR ENFORCEMENT AND LEGAL CERTAINTY

20. It is essential that information regarding the status of international registrations that have been granted protection be made available in the same manner as national or regional registrations. Ensuring equal accessibility to this information allows enforcement authorities, business partners, and other stakeholders to verify trademark rights efficiently and without unnecessary administrative hurdles.

21. In addition to availability, the certificate confirming the grant of protection must be retrievable in the same manner and through the same channels as a national or regional certificate. For instance, many customs authorities rely on online systems to verify trademark rights when assessing enforcement measures against counterfeit goods. If international registrations are not integrated into these systems, holders may face difficulties in protecting their rights at the border.

22. Similarly, other verification mechanisms used by courts, government agencies, and financial institutions should provide seamless access to international registration data, ensuring that holders of international registrations are not disadvantaged compared to those with national or regional trademarks. By standardizing access to this critical information, authorities and businesses can make informed decisions while reducing administrative barriers for trademark owners operating under the Madrid System.

ISSUANCE OF A NATIONAL OR REGIONAL CERTIFICATE UPON RENEWAL

23. When an international registration is renewed for a designated member that issues a renewal certificate for marks registered by its Office, it would be essential that this Office also issues a renewal certificate for international registrations for which the Office has granted protection to provide right holders with clear and official proof of the continued validity of their trademark in that jurisdiction.

24. Without such documentation, holders of international registrations may struggle to demonstrate the uninterrupted existence of their rights, particularly in legal and enforcement contexts. Courts, administrative bodies, and regulatory authorities often require proof that a trademark remains in force when assessing infringement claims, handling opposition proceedings, or processing customs recordation.

25. A national or regional certificate of renewal issued by the local Office removes any doubt regarding the ongoing protection of trademarks that are the subject of international registrations, ensuring that holders can enforce their rights as effectively as national or regional trademark holders.

PROPOSED AMENDMENTS TO THE REGULATIONS

26. It is proposed to amend Rule 18^{ter} of the Regulations by adding a new paragraph (6). New subparagraph (a) would require Offices to send a certificate along with statements under paragraphs (1), (2) or (4) granting protection to the mark. The certificate should be issued in the language, format, and design used by the Office and in a manner sufficient to enforce the rights deriving from the international registration. A new subparagraph (b) would require the International Bureau to transmit a copy of that certificate to the holder. Several Offices no longer send certificates to holders but instead make available electronic versions of those certificates. In such cases, under proposed subparagraph (c), Offices could provide information on how to access the certificate in the aforementioned statements.

27. A new paragraph (7) in Rule 18^{ter} of the Regulations would require Offices of designated members to promptly make available information concerning international registrations and their status of protection in the same manner as they provide information on marks registered by these Offices. The title of Rule 18^{ter} would be amended accordingly.

28. It is also proposed to amend Rule 31 of the Regulations by introducing a new paragraph (5). A new subparagraph (a) would require Offices of designated members that issue a renewal certificate for marks registered by this Office, and for which a statement under Rule 18^{ter}(1), (2) or (4) granting protection to the mark is recorded, to send to WIPO a certificate when notified of the renewal of the international registration concerned. Instead, Offices could send a document with information on how to download an electronic version of that certificate. Under a new subparagraph (b), the International Bureau would be required to transmit a copy of the certificate or document to the holder. The title of Rule 31 would be amended accordingly.

29. It is further proposed to introduce a transitional provision by amending Rule 40 of the Regulations. A new paragraph (9) would provide for the delayed effectiveness of the new provisions, giving time to members to introduce required changes to their legislation, processes, practices, and systems. It is proposed that the period of delayed effectiveness be no more than one year from the date of entry into force of the proposed amendments.

DATE OF ENTRY INTO FORCE

30. It is recommended that the proposed amendments enter into force on November 1, 2026.

31. *The Working Group is invited to:*

(i) consider the proposals made in this document; and

(ii) recommend to the Madrid Union Assembly the adoption of the proposed amendments to Rules 18ter, 31 and 40, as presented in the Annex to this document or in amended form, for entry into force on November 1, 2026.

[Annex follows]

**ANNEX: 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~~[\[November 1, 2026\]](#)

Rule 18ter

Final Disposition on Status of a Mark in a Designated Contracting Party: [Certificate of Protection in the Designated Contracting Party](#)

[...]

(6) *[Certificate of Protection]*

- (a) A statement under paragraph (1), (2) or (4) granting protection to the mark that is the subject of the international registration shall be accompanied by a certificate that is
- (i) presenting the same information found in a certificate issued for a mark registered by the Office of the designated Contracting Party concerned,
 - (ii) in the same language, format and design as a certificate issued for a mark registered by this Office,
 - (iii) issued within the same timeframe as a certificate for a mark registered by this Office,
 - (iv) provided without any additional charge or requirement,
 - (v) sufficient to enforce the rights deriving from the international registration in the designated Contracting Party concerned.
- (b) When informing the holder under paragraph (5), the International Bureau shall transmit a copy of the certificate referred to in subparagraph (a) to the holder.
- (c) Where the certificate referred to in subparagraph (a) is accessible to the holder through electronic means, the Office may, instead of sending the certificate, provide information in the statement referred to in the said subparagraph on how to obtain the certificate.

(7) *[Availability of Information on the Status of the Mark]* The Office of a designated Contracting Party shall promptly make available information regarding international registrations and the status of the mark in the Contracting Party concerned, particularly for enforcement purposes, in the same manner as it provides information on marks registered by this Office.

[...]

Rule 31

Recording of the Renewal; Notification and Certificate; Certificate of Continued Protection in the Designated Contracting Party

[...]

(5) [Certificate of Protection]

- (a) The Office of a designated Contracting Party that issues a renewal certificate for marks registered by this Office and has sent a statement under Rule 18ter(1), (2) or (4) that has been recorded in the International Register shall, promptly after being notified under paragraph (3), send to the International Bureau either a renewal certificate, issued in accordance with Rule 18ter(6)(a); or, where the certificate is accessible to the holder through electronic means, a document providing information on how to obtain the certificate.
- (b) The International Bureau shall promptly transmit to the holder a copy of the renewal certificate or document referred to in subparagraph (a).

[...]

Rule 40

Entry into Force; Transitional Provisions

[...]

- (9) [Transitional Provision Relating to National or Regional Certificates of Protection] No Office shall be obliged to send or make available a certificate under Rules 18ter(6) and 31(5) or to make available information regarding international registrations and the status of the mark in the Contracting Party concerned under Rule 18ter(7) until [November 1, 2027].

[End of Annex and of document]