

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

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OTHER 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”).
2. More specifically, these proposals concern amendments to Rules 3, 18, 18^{ter}, 25, 27 and 40 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 Annex to this document.

FORM TO REQUEST THE CANCELLATION OF THE RECORDING OF THE APPOINTMENT OF A REPRESENTATIVE

3. Under Rule 3(2)(a) of the Regulations, applicants and transferees may appoint a representative in the international application or in the request for the recording of a change in ownership, which must be presented in the relevant official form. Additionally, under Rule 3(2)(b) of the Regulations, holders may appoint a representative in a separate communication, provided the appointment is made in the relevant official form. However, a request to cancel the recording of the appointment of a representative under Rule 3(6)(a)

does not require the use of an official form and may be requested in a letter signed by the holder or representative.

4. The use of forms, particularly online forms, has significantly reduced processing times and minimized errors. An online form is already available for requesting the cancellation of the recording of the appointment of a representative.

5. Given the benefits of using forms, it is proposed to amend Rule 3(6)(a) of the Regulations requiring that requests to cancel the recording of the appointment of a representative be presented in the relevant official form.

6. The proposed amendment would only affect the International Bureau, as it would only concern representation before the latter. It would merely require the introduction of a new official form in PDF for requesting the cancellation of the recording of the appointment of a representative. As indicated earlier, an online version of this form already exists. Offices that offer holders customized versions of the official forms could either replicate the new PDF form or direct holders to use the forms provided by the International Bureau.

ADDRESS OF THE OPPONENT IN NOTIFICATIONS OF PROVISIONAL REFUSAL

7. In July 2023, the Madrid Union Assembly (hereinafter referred to as “the Assembly”) adopted an amendment to Rule 17(3) of the Regulations, which took effect on November 1, 2023. The amendment requires that Offices of designated Contracting Parties indicate the address of the opponent in a notification of provisional refusal based on opposition only when possible. The amendment was introduced in response to the enactment of privacy laws preventing certain Offices from sharing postal addresses.

8. As a result of the entry into force of the said amendment, the reference to the address of the opponent in Rule 18(1)(c)(vi) of the Regulations has become obsolete as a notification of provisional refusal based on opposition that omits the address of the opponent is not considered irregular.

9. Therefore, the International Bureau proposes to amend Rule 18(1)(c)(vi) by deleting the reference to the address of the opponent. The amendment is editorial in nature and would not impact users, Offices of the Contracting Parties or the International Bureau.

DATE OF GRANT OF PROTECTION AND START DATE OF USE REQUIREMENT

10. Holders of international registrations have requested that, for the sake of legal certainty, statements of grant of protection indicate the date on which protection was granted as well as the date as from which the use requirement starts.

11. Holders need to know the date of grant of protection because in some jurisdictions it may mark the official recognition of their exclusive rights to the trademark. This date may be relevant for enforcing trademark rights, as it establishes the starting point for legal protection and the ability to take action against infringers.

12. Holders must also be aware of the date from which the use requirement starts, as failure to use the mark within the required time frame may lead to invalidation of the international registration due to non-use. In some jurisdictions, this date may be linked to the grant of protection, while in others, it may be based on the date of designation. Understanding this timeline helps trademark owners ensure they comply with national or regional trademark laws and take the necessary steps to maintain their rights.

13. Proposed amendments to Rule 18*ter*(1), (2) and (4) would require that statements sent under this rule granting protection to the mark in an international registration indicate the date on which protection was granted and the date as from which the use requirement starts. The International Bureau would update the model forms and electronic communication standards for this purpose.

14. To allow Contracting Parties time to amend their legislation, practices and information and technology (IT) systems, the International Bureau proposes a transitional provision by amending Rule 40 of the Regulations. A proposed new paragraph (10) provides for the delayed effectiveness of the new provisions, which should be no more than one year from the date of entry into force of the proposed amendments. Should the Working Group agree to recommend the amendments to the Regulations proposed in document [MM/LD/WG/23/2](#), the transitional provision specified therein could be merged with the transitional provision proposed in this document.

CHANGE IN THE ELECTRONIC MAIL ADDRESS OF THE HOLDER OR REPRESENTATIVE

15. In September 2020, the Assembly adopted amendments to Rules 3, 9 and 25 of the Regulations requiring holders and representatives to provide their electronic mail (e-mail) addresses in the international application and in requests to record the appointment of a representative or a change in ownership. Additionally, an amendment to Rule 36 of the Regulations exempts from the payment of fees changes to the e-mail addresses of holders and representatives. These amendments took effect on February 1, 2021.

16. 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 entered into force on February 1, 2023. The amendments prescribe that all communications with the International Bureau be exchanged by electronic means. As a result, holders and representatives who had not yet provided their e-mail addresses to receive communications from the International Bureau were urged to do so without delay.

17. In October 2024, the Working Group recommended to the Assembly the adoption of amendments to Rules 3, 20*bis*, 24 and 25 of the Regulations. These amendments required holders and representatives who had not yet done so to provide their e-mail addresses in requests presented under those rules, with an entry into force date of November 1, 2025.

18. In May 2025, the International Bureau unveiled eMadrid, a secure online environment that relies on the e-mail addresses of holders and representatives and the use of a WIPO Account for identification to grant access to international registrations and authenticate requests for recording.

19. E-mail addresses are now essential to ensure the prompt, secure and traceable delivery of communications from the International Bureau and for secure online management of international registrations. It is important that changes to the e-mail address of the holder and of the representative be processed as requests for recording under Rule 25 of the Regulations, meeting the formal requirements prescribed therein and notifying holders and representatives when a change has been recorded.

20. Therefore, the International Bureau proposes that Rule 25(1)(a)(iv) and (vi) of the Regulations be amended to include changes to the e-mail addresses of the holder and of the representative as requests for recording that can be presented under this rule. A consequential amendment to Rule 27(1)(a) would clarify that recordings concerning a change in the e-mail address of the holder or the representative would only be notified to the holder. Under Rule 3(5)(b) of the Regulations, these communications would be addressed to

the representative, unless they concern a change in the e-mail address of a holder who has not yet appointed a representative.

21. Addressing privacy concerns and considering that Rule 32(1)(a) of the Regulations requires the International Bureau to publish only relevant data concerning recordings under Rule 27 of the Regulations, changes to the e-mail addresses of holders and representatives would not be published in the *WIPO Gazette of International Marks*.

22. Additionally, as these recordings concern the way in which the International Bureau communicates with holders and representatives and the online management of international registrations, they would not be notified to the Offices of the designated Contracting Parties, as they would not have any effect in the latter.

23. Online forms to manage the details of holders and representatives already provide the option to update their e-mail addresses. PDF forms would be reviewed to ensure this option is available. The International Bureau would amend its current processes to ensure holders and representatives are notified when a change is recorded. Offices that provide holders with customized versions of the prescribed forms could either amend their forms or direct holders to use the forms made available by the International Bureau.

24. Finally, changes to e-mail addresses and to the name and address of representatives are exempted from the payment of fees. As a result, not all requests presented under Rule 25 of the Regulations require an indication of the amount of the fees being paid and the method of payment. Consequently, the International Bureau proposes to introduce an editorial amendment to Rule 25(2)(a)(vii) of the Regulations clarifying that these indications are required only when relevant.

DATE OF ENTRY INTO FORCE

25. It is suggested that the proposed amendments to Rules 3, 18, 18ter, 25, 27 and 40 of the Regulations enter into force on November 1, 2026.

26. *The Working Group is invited to:*

(i) consider the proposals made in the present document; and,

(ii) recommend to the Madrid Union Assembly the adoption of the proposed amendments to Rules 3, 18, 18ter, 25, 27 and 40 of the Regulations, 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 3 Representation Before the International Bureau

[...]

(6) *[Cancellation of Recording; Effective Date of Cancellation]*

- (a) Any recording under paragraph (4)(a) shall be cancelled where cancellation is requested in ~~a communication~~ [the relevant official form](#) signed by the applicant, holder or representative. The recording shall be cancelled *ex officio* by the International Bureau where a new representative is appointed or, in case a change in ownership has been recorded, where no representative is appointed by the new holder of the international registration.

[...]

Rule 18 Irregular Notifications of Provisional Refusal

(1) *[General]*

[...]

- (c) If the notification

[...]

- (vi) does not contain, where applicable, the name ~~and address~~ of the opponent and the indication of the goods and services on which the opposition is based (Rule 17(3)),

the International Bureau shall, nonetheless record the provisional refusal in the International Register. The International Bureau shall invite the Office that communicated the provisional refusal to send a rectified notification within two months from the invitation and shall transmit to the holder copies of the irregular notification and of the invitation sent to the Office concerned.

[...]

Rule 18ter

Final Disposition on Status of a Mark in a Designated Contracting Party

- (1) *[Statement of Grant of Protection Where No Notification of Provisional Refusal Has Been Communicated]*⁴ When, before the expiry of the period applicable under Article 5(2)(a), (b) or (c) of the Protocol, all procedures before an Office have been completed and there is no ground for that Office to refuse protection, that Office shall, as soon as possible and before the expiry of that period, send to the International Bureau a statement to the effect that protection is granted to the mark that is the subject of the international registration in the Contracting Party concerned, with an indication of the date on which protection was granted and the date as from which use requirement starts⁵.
- (2) *[Statement of Grant of Protection Following a Provisional Refusal]* Except where it sends a statement under paragraph (3), an Office which has communicated a notification of provisional refusal shall, once all procedures before the said Office relating to the protection of the mark have been completed, send to the International Bureau either
- (i) a statement to the effect that the provisional refusal is withdrawn and that protection of the mark is granted, in the Contracting Party concerned, for all goods and services for which protection has been requested, with an indication of the date on which protection was granted and the date as from which use requirement starts or
 - (ii) a statement indicating the goods and services for which protection of the mark is granted in the Contracting Party concerned, with an indication of the date on which protection was granted and the date as from which use requirement starts.
- [...]
- (4) *[Further Decision]* Where a notification of provisional refusal has not been sent within the applicable time limit under Article 5(2) of the Protocol, or, where following the sending of a statement under paragraph (1), (2) or (3), a further decision, taken by the Office or other authority, affects the protection of the mark, the Office shall, to the extent that it is aware of that decision, without prejudice to Rule 19, send to the International Bureau a further statement indicating the status of the mark and, where applicable, the goods and services for which the mark is protected in the Contracting Party concerned, with an indication of the date on which protection was granted and the date as from which use requirement starts⁶.

[...]

⁴ In adopting this provision, the Assembly of the Madrid Union understood that a statement of grant of protection could concern several international registrations and take the form of a list, communicated electronically or on paper, that permits identification of these international registrations.

⁵ In adopting paragraphs (1) and (2) of this rule, the Assembly of the Madrid Union understood that where Rule 34(3) applies, the grant of protection will be subject to the payment of the second part of the fee.

⁶ Interpretative statement endorsed by the Assembly of the Madrid Union:
"The reference in Rule 18ter(4) to a further decision that affects the protection of the mark includes also the case where that further decision is taken by the Office, for example in the case of *restitutio in integrum*, notwithstanding the fact that the Office has already stated that the procedures before the Office have been completed."

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:

[...]

- (iv) a change in the name, ~~or~~ address or electronic mail 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;

[...]

- (vi) a change in the name, ~~or~~ address or electronic mail address of the representative.

[...]

(2) *[Contents of the Request]*

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

[...]

- (vii) where applicable, 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.

[...]

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. Where the recording relates to a change

in the electronic mail address of the holder or the representative, the International Bureau shall inform only the holder.

[...]

Rule 40
Entry into Force; Transitional Provisions

(10) *[Transitional Provision Relating to Date of Grant of Protection and Date as From Which Use Requirement Start]* No Office shall be obliged to indicate the date of grant of protection or the date as from which use requirement starts in statements under Rule 18*ter*(1), (2) or (4) until [November 1, 2027].

[End of Annex and of document]