

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

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PROPOSAL BY THE DELEGATION OF THE UNITED KINGDOM

Document prepared by the Secretariat

In a communication dated July 18, 2025, the International Bureau of the World Intellectual Property Organization (WIPO) received a proposal from the Delegation of the United Kingdom, which is contained in the Annex to the present document.

[Annex follows]

ANNEX: PROPOSAL BY THE DELEGATION OF THE UNITED KINGDOM

SUMMARY

1. This UK position paper follows on from stakeholder discussions and suggestions for improvements and puts forward proposals that could be made which would benefit users of the Madrid System, the International Bureau and national offices. The first part of the paper focuses on the proposals and possible amendments to the Regulations. The second part covers areas where we think there would be benefit in having further discussion, potentially through discussion at the Madrid Working Group Roundtables.

BACKGROUND

2. Since its introduction, the Madrid System has been a huge success for both applicants and national offices. For applicants, the Madrid System offers a time efficient, simple way of obtaining trade mark registrations in their key markets. It currently offers potential for protection in 131 territories through its 115 members.

3. At the 15th session of the Madrid Working Group the UK put forward a position paper with proposals on ways to improve the Madrid System for the benefit of its users. The UK position paper was a follow on from the Future Paper put forward by the Secretariat at the 14th session. The UK welcomed this paper and believed it to be very useful including proposals we could support.

4. The UK Intellectual Property Office and UK stakeholders value the Madrid System and believe that it plays an important role in supporting and encouraging innovation, and economic growth. The UK continues to believe that increased harmonisation will lead to a simpler System and one which users have more confidence in. The UK also firmly supports exploring ways in which the Madrid System can be further improved.

PROPOSAL DETAILS

PART A – AMENDMENTS TO THE REGULATIONS

1) *A centralised replacement procedure*

5. The current replacement procedure requires holders to file replacement requests with the national offices of each designated country. UK users of the System find this a time-consuming process. It also requires national offices to understand a process for which they might receive only a handful of requests per year. The UK Intellectual Property Office, even as a relatively large office, for example received only five replacement requests between 2013 to 2020. Between 2021 and 2023, a total of 180 replacement requests were received, this was due to the UK's departure from the EU¹. From January

¹ From 01 January 2021, protected international trade mark registrations designating the EU were no longer valid in the UK. To preserve the trade mark rights for the rightsholder, the IPO created a comparable UK trade mark. Ahead of EU exit date, some rightsholders with EU designations added the UK to their existing international registration to ensure continued protection. This meant that once the comparable UK trade mark had been created some rightsholders had multiple trade marks protected in the UK. [EU trade mark protection and comparable UK trade marks - GOV.UK](#).

2024 to July 2025, 91 replacement requests have been received. This is on the higher side due to the partial replacement changes coming into effect in the UK in October 2024 and also the number of comparable EU trade marks in our database that are coming up for renewal. We expect these figures to return to pre-2021 levels in due course (once trade marks have been renewed). We are aware that there are offices which receive few, if any, of these requests each year.

6. One option to streamline this process would be to move to a centralised replacement system, where a single replacement request can be filed directly to the International Bureau and examined centrally. The replacement request would contain details of all the countries and list goods and services classes in the national registrations that the holder wants to replace by their International Registration. This would relieve the burden from national offices and make the replacement process more efficient and cost effective for users. This would require changes to the Madrid Regulations, and we set out proposals below.

7. We propose amending Rule 21(1) and 21(2) as follows:

- (1) *[Request and Notification] From the date of the notification of the international registration or of the subsequent designation, as the case may be, a request that a national or regional registration be replaced by an international registration may be presented by the holder to the International Bureau [on the relevant official form]. The request shall indicate: the relevant national or regional offices for such national or regional registrations; the holder may present directly to the Office of a designated Contracting Party a request for that Office the Bureau to take note of the international registration in its Register, in accordance with Article 4bis(2) of the Protocol. Where, following the said request, the Office has taken note in its Register that a national or a regional registration or registrations, as the case may be, have been replaced by the international registration, that Office shall notify the International Bureau accordingly.*
- (i) *the number of the international registration concerned,*
- (ii) *where the replacement concerns only one or some of the goods and services listed in the international registration, those goods and services, and*
- (iii) *the filing date and number, the registration date and number, and, if any, the priority date of the national or regional registration or registrations which have been replaced by the international registration.*

The notification may also include information relating to any other rights acquired by virtue of that national or regional registration or registrations.

- (2) *[Recording and Notification]*
- (a) *The International Bureau shall take note in the International Register that a national or regional registration or registrations, as the case may be, have been replaced by the International Registration and record the indications notified under paragraph (1) in the International Register and shall inform the holder accordingly.*

(aa) Where, pursuant to paragraph (1) the International Bureau has taken note in the International Register that a national or a regional registration or registrations, as the case may be, have been replaced by the international registration, the International Bureau shall present a request to the relevant office or offices of the designated Contracting Parties, as the case may be, for that Office to take note of the international registration in accordance with Article 4bis(2) of the Protocol.

(b) The indications notified under paragraph (1) shall be recorded as of the date of receipt by the International Bureau of a ~~notification~~ request complying with the applicable requirements.

8. We propose amending Rule 21(3)(c) as follows:

(3) (c) ~~Before taking note in its in the International Register, the Office of a designated Contracting Party International Bureau shall examine the request referred to in paragraph (1) to determine whether the conditions specified in Article 4bis(1) of the Protocol have been met.~~

9. We would welcome discussion on this proposal, which we believe would improve the efficiency of the replacement system by requiring only a central team at the International Bureau to build up knowledge and expertise in this area, rather than national offices which might go years without a single replacement request.

2) Allow for 'partial' renewal

10. The current renewal system does not allow for 'partial' renewal of an International Registration. If a holder has an International Registration that contains multiple classes, but only wishes to renew the International Registration for some and not all of those classes, they are not able to do so. Similarly, if they want to renew it only for some of the designated countries, they cannot do so. They instead have to file form MM7 in advance of the International Registration coming up for renewal, to remove any unwanted classes or countries.

11. UK users of the System would find it extremely beneficial if, at the point of renewal, a holder or representative could choose to renew an International Registration for only those countries and classes for which protection is still required.

12. Allowing holders to partially renew International Registrations only for those countries and classes of goods and services for which protection is still required would save applicants time and money. They would no longer have to ensure that they checked International Registrations months in advance of renewal dates to check for, and remove, unwanted classes or designated countries, and they would no longer have to pay renewal fees for protection that they no longer require.

13. We understand that whilst Article 7(2) of the Madrid Protocol was introduced to prevent holders from adding countries or classes on renewal, an unintended consequence of this is that holders are prevented from removing classes. Although it is possible to drop a country on renewal without the need to file a renunciation, as this is not considered a change to the International Registration, it is not possible to remove unwanted classes.

14. To allow for partial renewal, we propose amending Rule 30(2) to read:

(2) *[Further Details]*

(a) *Where the holder does not wish to renew the international registration in respect of a designated Contracting Party for which no statement of refusal under Rule 18ter, in respect of all the goods and services concerned, is recorded in the International Register, payment of the required fees shall be accompanied by a statement by the holder that the renewal of the international registration is not to be recorded in the International Register in respect of that Contracting Party.*

(aa) *Where the holder wishes to renew the international registration in respect of some only of the goods and services concerned as recorded in the International Register, payment of the required fees shall be accompanied by a statement by the holder that the renewal of the international registration is to be recorded in the International Register in respect of those goods and services.*

(b) *Where the holder wishes to renew the international registration in respect of a designated Contracting Party notwithstanding the fact that a statement of refusal under Rule 18ter is recorded in the International Register for that Contracting Party in respect of all the goods and services concerned, payment of the required fees, including the complementary fee or individual fee, as the case may be, for that Contracting Party, shall be accompanied by a statement by the holder that the renewal of the international registration is to be recorded in the International Register in respect of that Contracting Party for all the goods and services concerned.*

(c) *The international registration shall not be renewed in respect of any designated Contracting Party in respect of which an invalidation has been recorded for all goods and services under Rule 19(2) or in respect of which a renunciation has been recorded under Rule 27(1)(a). The international registration shall not be renewed in respect of any designated Contracting Party for those goods and services in respect of which an invalidation of the effects of the international registration in that Contracting Party has been recorded under Rule 19(2) or in respect of which a limitation has been recorded under Rule 27(1)(a).*

(d) *[Deleted]*

(e) *The fact that the international registration is not renewed in respect of all of the designated Contracting Parties shall not be considered to constitute a change for the purposes of Article 7(2) of the Protocol.*

15. We propose amending Rule 31 as follows:

- (1) *[Recording and Effective Date of the Renewal]* Renewal shall be recorded in the International Register with the date on which renewal was due, even if the fees required for renewal are paid within the period of grace referred to in Article 7(4) of the Protocol.
- (2) *[Renewal Date in the Case of Subsequent Designations]* The effective date of the renewal shall be the same for all designations contained in the international registration, irrespective of the date on which such designations were recorded in the International Register.
- (3) *[Notification and Certificate]* The International Bureau shall notify the Offices of the designated Contracting Parties concerned of the renewal and shall send a certificate to the holder.
- (4) *[Notification in Case of Non-Renewal]*
 - (a) Where an international registration is not renewed, the International Bureau shall notify accordingly the holder, the representative, if any, and the Offices of all of the Contracting Parties designated in that international registration.
 - (b) Where an international registration is not renewed in respect of a designated Contracting Party, the International Bureau shall notify the holder, the representative, if any, and the Office of that Contracting Party accordingly.
- (5) *[Notification in case of Renewal in respect of only some of the goods and services]* Where an international registration is renewed in respect of some only of the goods and services concerned as recorded in the International Register, the International Bureau shall notify the holder, the representative, if any, and the Offices of all the Contracting Parties designated in the international registration

16. We welcome discussion on this proposal from the Working Group and request the International Bureau explore the practicalities of allowing for 'partial renewal' of International Registrations, and to present a plan for introducing 'partial renewal' at a future Session.

PART B – TOPICS FOR FURTHER DISCUSSION

The topics listed under this section do not have concrete proposals at present. However, we believe the topics may benefit from further discussion. These discussions could either take place within the Working Group or through the Roundtable discussions where Contracting Parties would have the opportunity to share their own experiences.

3) Subsequent designations

17. To add a subsequent designation to an International Registration, the prescribed elements for such a request include the number of the International Registration. It can take several months after an application is submitted to the International Bureau before it is assigned an International Registration number, and it is not currently possible for applicants to file subsequent designations during this period. UK users of the System find it inconvenient to have a substantial period of time where they are unable to file subsequent designations.

18. We understand that WIPO systems are currently configured to require the International Registration number when completing actions associated with an international designation and would require an IT change to accept another reference number. We are also aware that the current focus of WIPO resources is, rightly, on the new e-Madrid and new IT platform. Any IT changes would not be able to be undertaken immediately. Despite this we feel that there is merit in discussing this issue now, so that when resources become available any necessary changes can be made.

19. The International Bureau provides a unique reference number before the International Registration number is assigned. When IT resource becomes available, WIPO systems could be reconfigured to accept both the International Registration number (if that has been assigned) or the unique reference number. This would allow subsequent designations to be added in the absence of the International Registration number.

20. We would welcome further discussion on this proposal to determine whether other Contracting Parties face the same issue and whether other processes could be put in place to speed up the allocation of the International Registration number.

4) Improving Madrid Monitor

21. We welcome the efforts of the International Bureau in the creation and maintenance of Madrid Monitor. UK users of the System have noted the usefulness of Madrid Monitor, but also have suggestions for continued improvement.

(a) Clarity on registry of International Registration (International Bureau or Designated Countries)

22. Contracting Parties and the International Bureau will be aware that information on Madrid Monitor can be incomplete. UK users of the System have noted that they are occasionally unsure as to the final scope of protection granted in some jurisdictions. This is due to some IP offices that consider the International Bureau to be the true registry and do not therefore hold all the relevant information on the international registration in their domestic register.

23. Stakeholders have also noted that there have been instances when Madrid Monitor shows that information is incomplete or not available. The 'designation status' tab in Madrid Monitor can contain several values under the status column e.g. 'protection granted', 'under examination', 'provisionally refused', 'complex'. Stakeholders have indicated that when the International Registration shows the status as 'complex' it does not give complete information which is unhelpful.

24. It would be beneficial to have clarity on whether the International Bureau is considered the true registry or whether the registry is the IP office of the designated country. In addition, we feel it would be beneficial to explore whether the International Bureau and the national office should hold the same/similar information on the International Registration for consistency purposes.

(b) Link to the base mark(s) in Madrid Monitor

25. Currently, there is no link between Madrid Monitor and the base mark. UK users of the System would find it beneficial to have a link from Madrid Monitor to the base mark in the Office of Origin's database. This would allow users to view the status of the base mark. In many cases national databases hold more information than Madrid Monitor and linking this to the Madrid Monitor would be a quick and easy way to access this information.

26. Offices of Contracting Parties have various ways of displaying information which can make navigation difficult for those not familiar with them. Where users are unfamiliar with how to access or search certain national databases, a link from Madrid Monitor would provide a simple and efficient way of accessing the database entries for their International Registration.

27. We recognise that this request may require IT changes therefore propose that the International Bureau considers the feasibility and potential cost implications of this proposal. We would encourage Contracting Parties to ensure their databases are both easily accessible and navigable for all users of the Madrid System and would welcome discussion on this proposal to hear the experiences of other Contracting Parties and users of the System.

(c) Update Madrid Monitor so that it represents an accurate reflection of the real-time status of International Registration in each designated country

28. Stakeholders have told us that the issue of Madrid Monitor not being up to date is linked to the issue of not knowing who the true registry is. The status of an International Registration on Madrid Monitor can differ from the status of the International Registration in the national office. Stakeholders would like Madrid Monitor to be updated consistently to reflect the real-time status of an International Registration in each designated country.

29. We would like the International Bureau to confirm whether there are any restrictions on how often Madrid Monitor can be updated and if there is a possibility for it to be updated more frequently. We would also like to hear from other Contracting Parties on how often information on International Registrations is transmitted to the International Bureau.

5) Improvements to timeliness

30. Two proposals were put forward in document MM/LD/WG/14/4 at the Fourteenth Session of the Madrid Working Group in 2016 that the UK feels there is merit in revisiting.

(a) Improving timeliness of communication through the 'Madrid Commitment Charter'

31. The first proposal discussed at the Fourteenth Session of the Madrid Working Group was for a 'Madrid Commitment Charter'. This 'Charter' would oblige Contracting Parties to meet certain service standards, including standards relating to processing times. We thank the International Bureau for including this proposal in the document. There was lengthy discussion of many of the proposals contained in document MM/LD/WG/14/4, but only limited discussion of the proposal for a 'Madrid Commitment Charter'. The UK feels there is merit in revisiting this proposal. UK users of the System have raised concerns about national offices not always notifying the International Bureau when the basic mark has lapsed due to it not being renewed, surrendered, or cancelled. Therefore, the status of the International Registration in Madrid Monitor is not always accurate.

32. We propose that the Working Group revisit the proposal for 'Madrid Commitment Charter' as set out in document MM/LD/WG/14/4. This Charter could be a way forward to ensure national offices are committed to providing the relevant information on the basic mark to the International Bureau in a timely manner (for example, within 30 days), so that the Madrid Monitor gives an accurate status of the International Registration, to the benefit of users of the System.

(b) Expedite timelines for new filings, actioning records, etc

33. The second proposal discussed at the Fourteenth Session of the Madrid Working Group was the option of 'fast-tracking' applications. Timeliness is crucial to applicants when it comes to securing their rights. Applications made through the Madrid System go through the additional step of the preliminary examination at the International Bureau, before they are passed on to national offices for full examinations. It is important that this step is completed expeditiously so that the Madrid route remains an attractive option for applicants.

34. We understand that certain Offices provide services for domestic applications that meet certain criteria which assists with faster processing. We feel it would be beneficial for these Offices to share their best practices with the Working Group to identify any best practices that could be taken forward to expedite international applications.

CONCLUSIONS

The UK would like to thank the International Bureau for their continuous efforts to make the Madrid System a success. The UK looks forward to discussing with the International Bureau, Contracting Parties and other WIPO member states and users of the System, how the Madrid System can be further improved. This paper outlines some proposals and our preliminary thoughts on them, but the UK is of course open to discussing other options and priorities.

[End of Annex and of document]