

Special Union for the International Registration of Marks (Madrid Union)

Assembly

Fifty-Seventh (25th Ordinary) Session Geneva, July 6 to 14, 2023

PROPOSED AMENDMENTS TO THE REGULATIONS UNDER THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

Document prepared by the Secretariat

INTRODUCTION

1. The Working Group on the Legal Development of the Madrid System for the International Registration of Marks (hereinafter referred to as “the Working Group”), at its twentieth session, held from November 7 to 11, 2022, recommended amendments to Rules 17, 18, 21, 23*bis*, 32 and 40 of the Regulations Under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as “the Regulations”), for their adoption by the Madrid Union Assembly (hereinafter referred to as “the Assembly”) at its fifty-seventh session.
2. Discussions in the Working Group were based on documents MM/LD/WG/20/2, MM/LD/WG/20/2 Corr. and MM/LD/WG/20/3. Relevant background information on the proposed amendments to the Regulations is provided in the following paragraphs. The proposed amendments are reproduced in the Annexes to the present document. Proposed additions and deletions are indicated by, respectively, underlining and striking through the text concerned in Annexes I and II. A clean version of the proposed amended provisions appears in Annexes III and IV.

RECOMMENDED AMENDMENTS TO THE REGULATIONS PROPOSED TO ENTER INTO FORCE ON NOVEMBER 1, 2023

3. Amendments to Rules 17 and 18 of the Regulations oblige Offices to provide holders with a minimum time limit to respond to a notification of provisional refusal and to clearly indicate the start and end date of this time limit, simplifying holders' management of their portfolios.
4. An amendment to Rule 17(2)(vii) of the Regulations requires a minimum time limit of two months to respond to a notification of provisional refusal.
5. A new paragraph (2)(viii) in the same Rule also requires the Office issuing the refusal to indicate the start and end dates of that period, when this period starts on a date other than the date on which the International Bureau transmits the notification to the holder or on which the holder receives this notification.
6. For further legal certainty, a new paragraph (7) of Rule 17 of the Regulations requires that all Contracting Parties notify the International Bureau of the length of the time limit to respond to a notification of provisional refusal and the way in which to calculate it. The International Bureau will publish this information in accordance with an amended Rule 32(2).
7. New paragraph (8) of Rule 40 of the Regulations allows for a transitional period, which means that Contracting Parties will be obliged to apply the amended Rules providing for the minimum time limit referred to in paragraph 4, above, only as from February 1, 2025. Under the same provision, Contracting Parties that need further time to, for example, amend their domestic legal framework to provide for the said minimum time limit, are required to notify the International Bureau accordingly and defer their obligation to apply the amended Rules until a later date.
8. Amendments to Rule 17(2)(v) and (3) of the Regulations require Contracting Parties to indicate the name of the representative of the holder of the earlier right on which the provisional refusal is based, if any. Contracting Parties are no longer required to indicate the address of the holder of the said earlier right or of the holder's representative, which is helpful for those Contracting Parties that cannot share this information due to legal restrictions.
9. Further amendments to Rules 17 and 18 of the Regulations are editorial in nature, making the provisions clearer.

RECOMMENDED AMENDMENTS TO THE REGULATIONS PROPOSED TO ENTER INTO FORCE ON NOVEMBER 1, 2024

10. An amendment to Rule 23*bis*(1) of the Regulations allows all Contracting Parties to send communications not covered by the Regulations to holders of international registrations through the International Bureau. Currently, only Contracting Parties whose legislation does not allow them to contact the holder directly can send those communications through the International Bureau. The proposed amendment makes it easier for Contracting Parties to notify holders in a timely manner.
11. Amendments to Rules 21(3)(b) and 32(1)(a)(xi) of the Regulations are editorial in nature, clarifying that Contracting Parties must allow a domestic registration and the international registration that has replaced it to coexist, and to confirm that the International Bureau must publish declarations that a given limitation has no effect.

12. *The Madrid Union Assembly is invited to adopt the amendments to:*

(i) Rules 17, 18, 32 and 40 of the Regulations Under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, as set out in Annexes I and III to document MM/A/57/1, with November 1, 2023, as their date of entry into force; and,

(ii) Rules 21, 23bis and 32 of the Regulations Under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, as set out in Annexes II and IV to document MM/A/57/1, with November 1, 2024, as their date of entry into force.

[Annexes follow]

ANNEX I: 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 ~~February 1, 2023~~ November 1, 2023

[...]

Rule 17 Provisional Refusal

[...]

(2) *[Content of the Notification]* A notification of provisional refusal shall contain or indicate

[...]

(v) where the grounds on which the provisional refusal is based relate to a mark which has been the subject of an application or registration and with which the mark that is the subject of the international registration appears to be in conflict, the filing date and number, the priority date, ~~(if any)~~, the registration date and number, ~~(if available)~~, the name ~~and address~~ of the owner and of the representative, if any, their addresses, if possible, and a representation of the former mark or an indication of how to access that representation, together with the list of all or the relevant goods and services in the application or registration of the former mark, it being understood that the said list may be in the language of the said application or registration,

[...]

(vii) the time limit, ~~reasonable under the circumstances~~ which shall be no less than two months¹, for filing a request for review of, or appeal against, the *ex officio* provisional refusal or the provisional refusal based on an opposition and, as the case may be, for filing a response to the opposition,

(viii) where the time limit referred to in paragraph (2)(vii) begins on a date other than the date on which the International Bureau transmits a copy of the notification to the holder or the date on which the holder receives said copy, preferably with an indication of the date on which the said time limit expires begins and ends,
~~and~~

(ix) the authority with which such request for review, appeal or response should be filed, with
~~and~~

¹ In adopting this provision, the Assembly of the Madrid Union understood that Contracting Parties whose legislation provides for a time limit of 60 calendar or consecutive days meet the requirement specified in Rule 17(2)(vii).

(x) ~~the~~an indication, where applicable, that the request for review, the appeal or the response has to be filed through the intermediary of a representative whose address is within the territory of the Contracting Party whose Office has pronounced the refusal.

- (3) *[Additional Requirements Concerning a Notification of Provisional Refusal Based on an Opposition]* Where the provisional refusal of protection is based on an opposition, or on an opposition and other grounds, the notification shall, in addition to complying with the requirements referred to in paragraph (2), contain an indication of that fact and the name ~~and address~~ of the opponent and of the representative, if any and, if possible, their addresses; however, notwithstanding paragraph (2)(v), the Office making the notification must, where the opposition is based on a mark which has been the subject of an application or registration, communicate the list of the goods and services on which the opposition is based and may, in addition, communicate the complete list of goods and services of that earlier application or registration, it being understood that the said lists may be in the language of the earlier application or registration.

[...]

(7) *[Information Concerning the Time Limit to Respond to a Provisional Refusal]* Contracting Parties shall notify the International Bureau of the length of the time limit referred to in paragraph (2)(vii) and of the way in which this time limit shall be calculated.

Rule 18 **Irregular Notifications of Provisional Refusal**

(1) *[General]*

- (a) A notification of provisional refusal communicated by the Office of a designated Contracting Party shall not be regarded as such by the International Bureau

[...]

- (iii) if it is sent too late to the International Bureau, that is, if it is sent after the expiry of the time limit applicable under Article 5(2)(a) or, subject to Article 9*sexies*(1)(b) of the Protocol, under Article 5(2)(b) or (c)(ii) of the Protocol, from the date on which ~~the recording of the international registration or the recording of the designation made subsequently to the international registration has been effected, it being understood that the said date is the same as the date of sending~~the International Bureau sent the notification of the international registration or of the designation made subsequently.
- (b) Where subparagraph (a) applies, the International Bureau shall nevertheless transmit a copy of the notification to the holder, shall inform, at the same time, the holder and the Office that sent the notification that the notification of provisional refusal is not regarded as such by the International Bureau, and shall indicate the reasons therefor.
- (c) If the notification
- (i) is not signed on behalf of the Office which communicated it, or does not otherwise comply with the requirements of Rule 2 or with the requirement applicable under Rule 6(2),

- (ii) does not contain, where applicable, the details of the mark with which the mark that is the subject of the international registration appears to be in conflict (Rule 17(2)(v) and (3)),
- (iii) does not comply with the requirements of Rule 17(2)(vi), or
- (iv) ~~does not comply with the requirements of Rule 17(2)(vii), or~~ [Deleted]
- (v) [Deleted]
- (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, ~~except where subparagraph (d) applies,~~ 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.

- (d) Where the notification does not comply with the requirements of Rule 17(2)(vii) to (x), the provisional refusal shall not be regarded as such and shall not be recorded in the International Register. The International Bureau shall inform the Office that communicated the provisional refusal of this fact, indicate the reasons therefor and transmit to the holder a copy of the defective notification. If hHowever, if the Office sends a rectified notification ~~is sent within the time limit referred to in subparagraph (c)~~ two months from the date on which the International Bureau informed this Office of the defective notification, ~~the rectified notification~~ shall be regarded, for the purposes of Article 5 of the Protocol, as having been sent ~~to the International Bureau~~ on the date on which the defective notification had been sent to ~~the International Bureau and shall be recorded in the International Register.~~ If the notification is not so rectified, it shall not be regarded as a notification of provisional refusal. In the latter case, the International Bureau shall inform, at the same time, the holder and the Office that sent the notification that the notification of provisional refusal is not regarded as such by the International Bureau, and shall indicate the reasons therefor.
- (e) Any rectified notification shall, where the applicable law so permits, indicate a new time limit, ~~reasonable under the circumstances, and provide information, in accordance with Rule 17(2)(vii) to (x),~~ for filing a request for review of, or appeal against, the *ex officio* provisional refusal or the provisional refusal based on an opposition and, as the case may be, for filing a response to the opposition, ~~preferably with an indication of the date on which the said time limit expires.~~
- (f) The International Bureau shall transmit a copy of any rectified notification to the holder.

[...]

**Rule 32
Gazette**

[...]

- (2) *[Information Concerning Particular Requirements and Certain Declarations of Contracting Parties]* The International Bureau shall publish in the Gazette
- (i) any notification made under Rules 7, [17\(7\)](#), [20bis\(6\)](#), [27bis\(6\)](#) [27ter\(2\)\(b\)](#) or [40\(6\)](#) [and \(7\)](#) and any declaration made under Rule [17\(5\)\(d\)](#) or (e);

**Rule 40
Entry Into Force; Transitional Provisions**

[...]

- [\(8\) *\[Transitional Provision Relating to Rules 17\(2\)\(v\) and \(vii\) and \(3\) and 18\(1\)\(e\)\]* Contracting Parties may continue to apply Rules \[17\\(2\\)\\(v\\)\]\(#\) and \[\\(vii\\)\]\(#\) and \[\\(3\\)\]\(#\) and \[18\\(1\\)\\(e\\)\]\(#\), as in force on November 1, 2021, until February 1, 2025, or until a later date, provided the Contracting Party concerned sends a notification to the International Bureau before February 1, 2025, or before the date on which this Contracting Party becomes bound by the Protocol, whichever occurs later. The Contracting Party may withdraw the said notification at any time thereafter².](#)

[Annex II follows]

² [In adopting this provision, the Assembly of the Madrid Union understood that Contracting Parties are not required to specify in the notification the date on which they will apply Rules \[17\\(2\\)\\(v\\)\]\(#\) and \[\\(vii\\)\]\(#\) and \[18\\(1\\)\\(e\\)\]\(#\), as in force on November 1, 2023.](#)

ANNEX II: 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 ~~February 1, 2023~~ November 1, 2024

[...]

Rule 21

Replacement of a National or Regional Registration by an International Registration

[...]

(3) *[Further Details Concerning Replacement]*

[...]

- (b) A national or regional registration and the international registration that has replaced it shall be able to coexist. The holder may not be required to renounce or request the cancellation of a national or regional registration which is deemed replaced by an international registration and ~~should~~shall be allowed to renew that registration, if the holder so wishes, in accordance with the applicable national or regional law.

[...]

[...]

Rule 23bis

Communications from the Offices of the Designated Contracting Parties Sent Through the International Bureau

- (1) *[Communications Not Covered by These Regulations]* ~~Where the law of a designated Contracting Party does not allow the Office to transmit a communication concerning an international registration directly to the holder, that~~The Office of a designated Contracting Party may request the International Bureau to transmit ~~that~~ communications concerning an international registration to the holder on its behalf.

[...]

Rule 32
Gazette

(1) *[Information Concerning International Registrations]*

(a) The International Bureau shall publish in the Gazette relevant data concerning

[...]

(xi) information recorded under Rules 20, 20*bis*, 21, 21*bis*, 22(2)(a), 23 and 27(4)
[and \(5\)](#);

[...]

[Annex III follows]

**ANNEX III: 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, 2023

[...]

**Rule 17
Provisional Refusal**

[...]

(2) *[Content of the Notification]* A notification of provisional refusal shall contain or indicate

[...]

(v) where the grounds on which the provisional refusal is based relate to a mark which has been the subject of an application or registration and with which the mark that is the subject of the international registration appears to be in conflict, the filing date and number, the priority date, if any, the registration date and number, if available, the name of the owner and of the representative, if any, their addresses, if possible, and a representation of the former mark or an indication of how to access that representation, together with the list of all or the relevant goods and services in the application or registration of the former mark, it being understood that the said list may be in the language of the said application or registration,

[...]

(vii) the time limit, which shall be no less than two months³, for filing a request for review of, or appeal against, the *ex officio* provisional refusal or the provisional refusal based on an opposition and, as the case may be, for filing a response to the opposition,

(viii) where the time limit referred to in paragraph (2)(vii) begins on a date other than the date on which the International Bureau transmits a copy of the notification to the holder or the date on which the holder receives said copy, an indication of the date on which the said time limit begins and ends,

(ix) the authority with which such request for review, appeal or response should be filed, and

(x) an indication, where applicable, that the request for review, the appeal or the response has to be filed through the intermediary of a representative whose address is within the territory of the Contracting Party whose Office has pronounced the refusal.

³ In adopting this provision, the Assembly of the Madrid Union understood that Contracting Parties whose legislation provides for a time limit of 60 calendar or consecutive days meet the requirement specified in Rule 17(2)(vii).

- (3) *[Additional Requirements Concerning a Notification of Provisional Refusal Based on an Opposition]* Where the provisional refusal of protection is based on an opposition, or on an opposition and other grounds, the notification shall, in addition to complying with the requirements referred to in paragraph (2), contain an indication of that fact and the name of the opponent and of the representative, if any and, if possible, their addresses; however, notwithstanding paragraph (2)(v), the Office making the notification must, where the opposition is based on a mark which has been the subject of an application or registration, communicate the list of the goods and services on which the opposition is based and may, in addition, communicate the complete list of goods and services of that earlier application or registration, it being understood that the said lists may be in the language of the earlier application or registration.

[...]

- (7) *[Information Concerning the Time Limit to Respond to a Provisional Refusal]* Contracting Parties shall notify the International Bureau of the length of the time limit referred to in paragraph (2)(vii) and of the way in which this time limit shall be calculated.

Rule 18 **Irregular Notifications of Provisional Refusal**

(1) *[General]*

- (a) A notification of provisional refusal communicated by the Office of a designated Contracting Party shall not be regarded as such by the International Bureau

[...]

- (iii) if it is sent too late to the International Bureau, that is, if it is sent after the expiry of the time limit applicable under Article 5(2)(a) or, subject to Article 9sexies(1)(b) of the Protocol, under Article 5(2)(b) or (c)(ii) of the Protocol, from the date on which the International Bureau sent the notification of the international registration or of the designation made subsequently.
- (b) Where subparagraph (a) applies, the International Bureau shall nevertheless transmit a copy of the notification to the holder, shall inform, at the same time, the holder and the Office that sent the notification that the notification of provisional refusal is not regarded as such by the International Bureau, and shall indicate the reasons therefor.
- (c) If the notification
- (i) is not signed on behalf of the Office which communicated it, or does not otherwise comply with the requirements of Rule 2 or with the requirement applicable under Rule 6(2),
 - (ii) does not contain, where applicable, the details of the mark with which the mark that is the subject of the international registration appears to be in conflict (Rule 17(2)(v) and (3)),
 - (iii) does not comply with the requirements of Rule 17(2)(vi), or
 - (iv) [Deleted]
 - (v) [Deleted]

- (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.

- (d) Where the notification does not comply with the requirements of Rule 17(2)(vii) to (x), the provisional refusal shall not be regarded as such and shall not be recorded in the International Register. The International Bureau shall inform the Office that communicated the provisional refusal of this fact, indicate the reasons therefor and transmit to the holder a copy of the defective notification. However, if the Office sends a rectified notification within two months from the date on which the International Bureau informed this Office of the defective notification, the rectified notification shall be regarded, for the purposes of Article 5 of the Protocol, as having been sent on the date on which the defective notification had been sent to the International Bureau and shall be recorded in the International Register.
- (e) Any rectified notification shall, where the applicable law so permits, indicate a new time limit and provide information, in accordance with Rule 17(2)(vii) to (x), for filing a request for review of, or appeal against, the *ex officio* provisional refusal or the provisional refusal based on an opposition and, as the case may be, for filing a response to the opposition.
- (f) The International Bureau shall transmit a copy of any rectified notification to the holder.

[...]

Rule 32 Gazette

[...]

- (2) *[Information Concerning Particular Requirements and Certain Declarations of Contracting Parties]* The International Bureau shall publish in the Gazette
 - (i) any notification made under Rules 7, 17(7), 20*bis*(6), 27*bis*(6) 27*ter*(2)(b) or 40(6) and (7) and any declaration made under Rule 17(5)(d) or (e);

Rule 40
Entry Into Force; Transitional Provisions

[...]

- (8) *[Transitional Provision Relating to Rules 17(2)(v) and (vii) and (3) and 18(1)(e)]* Contracting Parties may continue to apply Rules 17(2)(v) and (vii) and (3) and 18(1)(e), as in force on November 1, 2021, until February 1, 2025, or until a later date, provided the Contracting Party concerned sends a notification to the International Bureau before February 1, 2025, or before the date on which this Contracting Party becomes bound by the Protocol, whichever occurs later. The Contracting Party may withdraw the said notification at any time thereafter⁴.

[Annex IV follows]

⁴ In adopting this provision, the Assembly of the Madrid Union understood that Contracting Parties are not required to specify in the notification the date on which they will apply Rules 17(2)(v) and (vii) and 18(1)(e), as in force on November 1, 2023.

**ANNEX IV: 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

[...]

**Rule 21
Replacement of a National or Regional Registration by an International Registration**

[...]

(3) *[Further Details Concerning Replacement]*

[...]

- (b) A national or regional registration and the international registration that has replaced it shall be able to coexist. The holder may not be required to renounce or request the cancellation of a national or regional registration which is deemed replaced by an international registration and shall be allowed to renew that registration, if the holder so wishes, in accordance with the applicable national or regional law.

[...]

[...]

**Rule 23bis
Communications from the Offices of the Designated Contracting Parties Sent Through
the International Bureau**

(1) *[Communications Not Covered by These Regulations]* The Office of a designated Contracting Party may request the International Bureau to transmit communications concerning an international registration to the holder on its behalf.

[...]

Rule 32
Gazette

(1) *[Information Concerning International Registrations]*

(a) The International Bureau shall publish in the Gazette relevant data concerning

[...]

(xi) information recorded under Rules 20, 20*bis*, 21, 21*bis*, 22(2)(a), 23 and 27(4) and (5);

[...]

[End of Annex IV and of document]