

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

Assembly

Fiftieth (29th Extraordinary) Session
Geneva, October 3 to 11, 2016

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

Document prepared by the International Bureau

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”), has, in its two latest sessions (thirteenth session in November 2015¹, and fourteenth session in June 2016²) recommended a number of amendments to the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement (hereinafter referred to as “the Common Regulations”) for their adoption by the Madrid Union Assembly (hereinafter referred to as “the Assembly”) at its fiftieth session.
2. The recommendations concern Rules 3, 12, 18^{ter}, 22, new 23^{bis}, 25, 26, 27, new 27^{bis}, new 27^{ter}, 32, 40 and to items 7.4 and new 7.7 of the Schedule of Fees. An amendment to the title in French of item 7 of the Schedule of Fees and the suspension of the entry into force of amendments to Rule 24(5)(a) and (d) are also recommended.

¹ See document MM/LD/WG/13/2 “Proposed Amendments to the Common Regulations Under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement” (http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=313056).

² See document MM/LD/WG/14/2 Rev. “Proposed Amendments to the Common Regulations Under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement” (http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=334617).

PROPOSED AMENDMENTS TO THE COMMON REGULATIONS

3. Relevant background information is given in the following paragraphs and the proposed amendments are grouped by the topics to which they relate for ease of reference. The proposed amendments are reproduced in the Annexes to the present document. Proposed additions and deletions are indicated in Annexes I to III by, respectively, underlining or striking through the text concerned. A clean version of the proposed amended provisions (without underlining or striking through) appears in Annexes IV to VI.

PROPOSED AMENDMENTS THAT WOULD ASSIST OFFICES OF DESIGNATED CONTRACTING PARTIES

4. The proposed amendments to Rules 3 and 32 would require the International Bureau to notify Offices of designated Contracting Parties of any recording of the appointment of the holder's representative or cancellation thereof and to publish such recording in the *WIPO Gazette of International Marks*.

5. The proposed amendment to Rule 18~~ter~~ would make it easier for the Offices of designated Contracting Parties to notify the International Bureau further decisions concerning the protection of international marks.

6. The proposed new Rule 23~~bis~~ would allow the Offices of designated Contracting Parties to transmit communications through the International Bureau, where they are unable, due to their domestic legislation, to send those communications directly to holders who lack a local address for correspondence.

PROPOSED AMENDMENTS THAT WOULD CLARIFY TASKS BY THE INTERNATIONAL BUREAU

7. The proposed amendments to Rules 12, 25 to 27, with a consequential amendment to Rule 32, specify the level of examination by the International Bureau concerning limitations contained in international applications as well as for those requested as the recording of a change to international registrations.

8. The proposed amendment to Rule 22(2) clarifies that the International Bureau, when cancelling an international registration following the ceasing of effect of its basic mark, should also cancel, to the applicable extent, international registrations resulting from partial change in ownership, division or merger.

PROPOSED AMENDMENTS THAT WOULD BE BENEFICIAL FOR HOLDERS

9. The proposed amendments to Rule 25, with consequential amendments to Rule 32 and item 7.4 of the Schedule of Fees, would explicitly provide for the recording of or changes to the legal nature and State of organization of the holder, where the holder is a legal entity. Another amendment to Rule 25 would explicitly provide for the recording of a change in the name or address of the representative, consolidating a current practice.

10. The proposed new Rules 27~~bis~~ and 27~~ter~~, with consequential amendments to Rules 22, 25 to 27, 32 and 40, and new item 7.7 of the Schedule of Fees, would provide for the recording of division and merger of international registrations.

11. The proposed amendment to Rule 22(1) would require that an Office of origin notify the International Bureau of the outcome of judicial actions or proceedings concerning a ceasing of effect of the basic mark in all cases.

ENTRY INTO FORCE OF THE PROPOSED AMENDMENTS

12. It is proposed that the aforementioned amendments enter into force on three dates; those set out in Annex I, are proposed to enter into force on July 1, 2017; those set out in Annex II, on November 1, 2017; and, finally, those set out in Annex III, on February 1, 2019.

SUSPENSION OF THE ENTRY INTO FORCE OF AMENDMENTS TO RULE 24(5)

13. At its previous session, the Assembly adopted amendments to Rule 24(5)(a) and (d), with a date of entry into force of November 1, 2017³. In the following preparatory work, the International Bureau identified certain issues that would affect the implementation of those amendments. These issues were brought to the attention of the Working Group, at its thirteenth session⁴. Hence, the Working Group has recommended that the entry into force of the amendments to Rule 24(5)(a) and (d) be suspended until the Working Group has further reviewed the implications of their implementation.

14. *The Assembly is invited to*

(i) adopt the proposed amendments to Rules 12, 25, 26, 27 and 32 of the Common Regulations, to item 7.4 and to the title in French of item 7 of the Schedule of Fees, with a date of entry into force of July 1, 2017, as set out in Annex I to document MM/A/50/4;

(ii) adopt the proposed amendments to Rules 3, 18ter, 22, 25, 27 and 32, and the introduction of new Rule 23bis of the Common Regulations, with a date of entry into force of November 1, 2017, as set out in Annex II to document MM/A/50/4;

(iii) adopt the proposed amendments to Rules 22, 27, 32 and 40, the introduction of new Rules 27bis and 27ter of the Common Regulations and the introduction of item 7.7 in the Schedule of Fees, with a date of entry into force of February 1, 2019, as set out in Annex III to document MM/A/50/4; and

³ See documents MM/A/49/3 "Proposed Amendments to the Common Regulations Under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement" (http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=307081) and MM/A/49/5 "Report" (http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=327105).

⁴ See document MM/LD/WG/13/8 "Amended Rule 24(5) of the Common Regulations Under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement: Implementation Issues" (http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=317899).

(iv) suspend the entry into force of the amendments to Rule 24(5)(a) and (d) of the Common Regulations, which were adopted by the Assembly at its previous session, until the Working Group has further reviewed the implications of their implementation.

[Annexes follow]

**PROPOSED AMENDMENTS TO THE COMMON REGULATIONS UNDER THE MADRID
AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS AND THE
PROTOCOL RELATING TO THAT AGREEMENT**

**Common Regulations under
the Madrid Agreement Concerning
the International Registration of Marks
and the Protocol Relating to that Agreement**

(as in force on [July 1, 2017](#))

[...]

**Chapter 2
International Applications**

[...]

*Rule 12
Irregularities With Respect to the
Classification of Goods and Services*

[...]

[\(8bis\) \[Examination of Limitations\] The International Bureau shall examine limitations contained in an international application, applying paragraphs \(1\)\(a\) and \(2\) to \(6\) mutatis mutandis. Where the International Bureau cannot group the goods and services listed in the limitation under the classes of the International Classification of Goods and Services listed in the international application concerned, as amended pursuant to paragraphs \(1\) to \(6\), as the case may be, it shall issue an irregularity. Where the irregularity is not remedied within three months from the date of the notification of the irregularity, the limitation shall be deemed not to contain the goods and services concerned.](#)

[...]

Chapter 5 Subsequent Designations; Changes

[...]

Rule 25

~~Request for Recording of a Change;~~ ~~Request for Recording of a Cancellation~~

(1) *[Presentation of the Request]* (a) A request for recording shall be presented to the International Bureau on the relevant official form, in one copy, where the request relates to any of the following:

[...]

(iv) a change in the name or 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;

[...]

(2) *[Contents of the Request]* (a) ~~The~~A request ~~for the recording of a change or the request for the recording of a cancellation under paragraph (1)(a)~~ shall, in addition to the requested ~~recording change or cancellation~~, contain or indicate

[...]

(d) The request for the recording of a limitation shall group the limited goods and services only under the corresponding numbers of the classes of the International Classification of Goods and Services appearing in the international registration or, where the limitation affects all the goods and services in one or more of those classes, indicate the classes to be deleted.

[...]

Rule 26

Irregularities in Requests for Recording under Rule 25 of a Change and for Recording of a Cancellation

(1) *[Irregular Request]* If ~~the request for the recording of a change, or the request for the recording of a cancellation, referred to in~~ a request under Rule 25(1)(a) does not comply with the applicable requirements, and subject to paragraph (3), the International Bureau shall notify that fact to the holder and, if the request was made by an Office, to that Office. For the purposes of this Rule, where the request is for the recording of a limitation, the International Bureau shall only examine whether the numbers of the classes indicated in the limitation appear in the international registration concerned.

(2) *[Time Allowed to Remedy Irregularity]* The irregularity may be remedied within three months from the date of the notification of the irregularity by the International Bureau. If the irregularity is not remedied within three months from the date of the notification of the irregularity by the International Bureau, the request shall be considered abandoned, and the International Bureau shall notify accordingly and at the same time the holder and, if the request ~~for the recording of a change or the request for the recording of a cancellation~~ under Rule 25(1)(a) was presented by an Office, that Office, and refund any fees paid, after deduction of an amount corresponding to one-half of the relevant fees referred to in item 7 of the Schedule of Fees, to the party having paid those fees.

[...]

Rule 27

*Recording and Notification ~~of a Change or of a Cancellation~~ with respect to Rule 25;
Merger of International Registrations; Declaration That a Change in Ownership or a Limitation
Has No Effect*

(1) [*Recording and Notification ~~of a Change or of a Cancellation~~*] (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 ~~change~~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 Agreement and Article 6(3) of the Protocol, the International Bureau shall also inform the Office of origin.

(b) The indications, the change or the cancellation shall be recorded as of the date of receipt by the International Bureau of a request complying with the applicable requirements, except that, where a request has been made in accordance with Rule 25(2)(c), it may be recorded as of a later date.

**Chapter 7
Gazette and Data Base**

*Rule 32
Gazette*

(1) [*Information Concerning International Registrations*] (a) The International Bureau shall publish in the Gazette relevant data concerning

[...]

(vii) ~~changes in ownership, limitations, renunciations and changes of name or address of the holder recorded~~recordings under Rule 27;

[...]

[...]

PROPOSED AMENDMENTS TO THE SCHEDULE OF FEES

SCHEDULE OF FEES

(in force on ~~January 1, 2015~~ July 1, 2017)

Swiss francs

[...]

7. *Miscellaneous recordings*

[...]

7.4 Change ~~of~~in the name and/or address of the holder and/or, where the holder is a legal entity, introduction of or 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 ~~of~~for one or more international registrations for which ~~recordal of~~the same recording or change is requested in the same ~~request~~form

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[...]

[Annex II follows]

**PROPOSED AMENDMENTS TO THE COMMON REGULATIONS UNDER THE MADRID
AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS AND THE
PROTOCOL RELATING TO THAT AGREEMENT**

**Common Regulations under
the Madrid Agreement Concerning
the International Registration of Marks
and the Protocol Relating to that Agreement**

(as in force on [November 1, 2017](#))

[...]

**Chapter 1
General Provisions**

[...]

*Rule 3
Representation Before the International Bureau*

[...]

(4) *[Recording and Notification of Appointment of a Representative; Effective Date of Appointment]*

[...]

(b) The International Bureau shall notify the recording referred to in subparagraph (a) to both the applicant or holder and, in the ~~representative~~ latter case, the Offices of the designated Contracting Parties, as well as the representative. Where the appointment was made in a separate communication presented through an Office, the International Bureau shall also notify the recording to that Office.

[...]

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

[...]

(f) Cancellations at the request of the holder or the holder's representative shall also be notified to the Offices of the designated Contracting Parties.

Chapter 4
Facts in Contracting Parties
Affecting International Registrations

[...]

Rule 18ter

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

[...]

(4) *[Further Decision]* Where, a notification of provisional refusal has not been sent within the applicable time limit under Article 5(2) of the Agreement or of the Protocol, or, where following the sending of a statement ~~in accordance with either 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 concerned⁵.

[...]

Rule 22

*Ceasing of Effect of the Basic Application,
of the Registration Resulting Therefrom,
or of the Basic Registration*

(1) *[Notification Relating to Ceasing of Effect of the Basic Application, of the Registration Resulting Therefrom, or of the Basic Registration]*

[...]

(c) Once the judicial action or proceeding referred to in subparagraph (b) has resulted in the final decision referred to in Article 6(4) of the Agreement, in the final decision referred to in the second sentence of Article 6(3) of the Protocol or in the withdrawal or renunciation referred to in the third sentence of Article 6(3) of the Protocol, the Office of origin shall, where it is aware thereof, promptly notify the International Bureau accordingly and shall give the indications referred to in subparagraph (a)(i) to (iv). Where the judicial action or proceedings referred to in subparagraph (b) has been completed and has not resulted in any of the aforesaid final decisions, withdrawal or renunciation, the Office of origin shall, where it is aware thereof or at the request of the holder, promptly notify the International Bureau accordingly.

(2) *[Recording and Transmittal of the Notification; Cancellation of the International Registration]*

[...]

(b) Where any notification referred to in paragraph (1)(a) or (c) requests cancellation of the international registration and complies with the requirements of that paragraph, the International Bureau shall cancel, to the extent applicable, the international registration in the International Register. The International Bureau shall also cancel, to the extent applicable, international registrations resulting from partial change in ownership recorded under the international registration that has been cancelled, following the above-mentioned notification, and those resulting from their merger.

[...]

⁵

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."

Chapter 5 Subsequent Designations; Changes

[...]

Rule 23bis Communications from the Offices of the Designated Contracting Parties sent through the International Bureau

(1) [Communications from the Offices of the designated Contracting Parties 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 Office may request the International Bureau to transmit that communication to the holder on its behalf.

(2) [Format of the Communication] The International Bureau shall establish the format in which the communication referred to in paragraph (1) shall be sent by the Office concerned.

(3) [Transmission to the holder] The International Bureau shall transmit the communication referred to in paragraph (1) to the holder, in the format established by the International Bureau, without examining its contents or recording it in the International Register.

Rule 25 Request for Recording of a Change; Request for Recording of a Cancellation

(1) [Presentation of the Request] (a) A request for recording shall be presented to the International Bureau on the relevant official form, in one copy, where the request relates to any of the following:

[...]

(v) cancellation of the international registration in respect of all the designated Contracting Parties for all or some of the goods and services;

(vi) a change in the name or address of the representative.

[...]

(2) [Contents of the Request] (a) The request for the recording of a change or the request for the recording of a cancellation shall, in addition to the requested change or cancellation, contain or indicate

[...]

(ii) the name of the holder or the name of the representative where, ~~unless~~ the change relates to the name or address of the representative,

[...]

Rule 27
Recording and Notification of a Change or of a Cancellation;
Merger of International Registrations; Declaration That a Change in Ownership or a Limitation
Has No Effect

[...]

(2) ~~[Deleted]~~[Recording of Partial Change in Ownership] (a) A change in ownership of the international registration in respect of only some of the goods and services or only some of the designated Contracting Parties shall be recorded in the International Register under the number of the international registration concerned by the partial change in ownership.

(b) The part of the international registration for which a change in ownership has been recorded shall be deleted from the international registration concerned and recorded as a separate international registration.

[...]

Chapter 7
Gazette and Data Base

Rule 32
Gazette

(1) *[Information Concerning International Registrations]* (a) The International Bureau shall publish in the Gazette relevant data concerning

[...]

(xii) international registrations which have not been renewed;

(xiii) recordings of the appointment of the holder's representative communicated under Rule 3(2)(b) and cancellations at the request of the holder or the holder's representative under Rule 3(6)(a).

[...]

(3) The International Bureau~~Gazette~~ shall effect the publications under paragraphs (1) and (2) ~~be published~~ on the website of the World Intellectual Property Organization.

[Annex III follows]

**PROPOSED AMENDMENTS TO THE COMMON REGULATIONS UNDER THE MADRID
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(as in force on [February 1, 2019](#))

[...]

**Chapter 4
Facts in Contracting Parties
Affecting International Registrations**

[...]

*Rule 22
Ceasing of Effect of the Basic Application,
of the Registration Resulting Therefrom,
or of the Basic Registration*

[...]

(2) *[Recording and Transmittal of the Notification; Cancellation of the International
Registration]*

[...]

(b) Where any notification referred to in paragraph (1)(a) or (c) requests cancellation of the international registration and complies with the requirements of that paragraph, the International Bureau shall cancel, to the extent applicable, the international registration in the International Register. The International Bureau shall also cancel, to the extent applicable, international registrations resulting from partial change in ownership or division recorded under the international registration that has been cancelled, following the above-mentioned notification, and those resulting from their merger.

Chapter 5 Subsequent Designations; Changes

[...]

Rule 27

*Recording and Notification of a Change or of a Cancellation;
~~Merger of International Registrations; Declaration That a Change in
Ownership or a Limitation Has No Effect~~*

[...]

(3) ~~[Deleted] [Recording of Merger of International Registrations] Where the same natural person or legal entity has been recorded as the holder of two or more international registrations resulting from a partial change in ownership, the registrations shall be merged at the request of the said person or entity, made either direct or through the Office of the Contracting Party of the holder. The International Bureau shall notify accordingly the Offices of the designated Contracting Parties affected by the change and shall inform at the same time the holder and, if the request was presented by an Office, that Office.~~

[...]

Rule 27bis

Division of an International Registration

(1) [Request for the Division of an International Registration] (a) A request by the holder for the division of an international registration for some only of the goods and services in respect of a designated Contracting Party shall be presented to the International Bureau on the relevant official form by the Office of that designated Contracting Party, once the latter is satisfied that the division whose recording is requested meets the requirements of its applicable law, including the requirements concerning fees.

(b) The request shall indicate

(i) the Contracting Party of the Office presenting the request,

(ii) the name of the Office presenting the request,

(iii) the number of the international registration,

(iv) the name of the holder,

(v) the names of the goods and services to be set apart, grouped in the appropriate classes of the International Classification of Goods and Services,

(vi) the amount of the fee being paid and the method of payment, or instructions to debit the required amount to an account opened with the International Bureau, and the identification of the party effecting the payment or giving the instructions.

(c) The request shall be signed by the Office presenting the request and, where the Office so requires, also by the holder.

(d) Any request presented under this paragraph may include or be accompanied by a statement sent in accordance with either Rule 18bis or 18ter for the goods and services listed in the request.

(2) [Fee] The division of an international registration shall be subject to the payment of the fee specified in item 7.7 of the Schedule of Fees.

(3) [Irregular Request] (a) If the request does not comply with the applicable requirements, the International Bureau shall invite the Office that presented the request to remedy the irregularity and at the same time inform the holder.

(b) If the irregularity is not remedied by the Office within three months from the date of the invitation under subparagraph (a), the request shall be considered abandoned and the International Bureau shall notify accordingly the Office that presented the request, it shall inform at the same time the holder and refund any fee paid under paragraph (2), after the deduction of an amount corresponding to one-half of that fee.

(4) [Recording and Notification] (a) Where the request complies with the applicable requirements, the International Bureau shall record the division, create a divisional international registration in the International Register, notify accordingly the Office that presented the request and shall inform at the same time the holder.

(b) The division of an international registration shall be recorded with the date of receipt by the International Bureau of the request or, where applicable, the date where the irregularity referred to in paragraph (3) was remedied.

(5) [Request Not Considered as Such] A request for the division of an international registration in respect of a designated Contracting Party that is not or is no longer designated for the classes of the International Classification of Goods and Services mentioned in the request will not be considered as such.

(6) [Declaration That a Contracting Party Will Not Present Requests for Division] A Contracting Party, the law of which does not provide for division of applications for the registration of a mark or registrations of a mark, may notify the Director General, before the date this Rule comes into force or the date on which the said Contracting Party becomes bound by the Agreement or the Protocol, that it will not present to the International Bureau the request referred to in paragraph (1). This declaration may be withdrawn at any time.

Rule 27ter Merger of International Registrations

(1) [Merger of International Registrations Resulting from the Recording of a Partial Change in Ownership] Where the same natural person or legal entity has been recorded as the holder of two or more international registrations resulting from a partial change in ownership, the registrations shall be merged at the request of the said person or entity, made either direct or through the Office of the Contracting Party of the holder. The request shall be presented to the International Bureau on the relevant official form. The International Bureau shall record the merger, notify accordingly the Offices of the designated Contracting Party or Parties affected by the change and shall inform at the same time the holder and, if the request was presented by an Office, that Office.

(2) [Merger of International Registrations Resulting from the Recording of the Division of an International Registration] (a) An international registration resulting from division shall be merged into the international registration it was divided from at the request of the holder, presented through the Office that presented the request referred to in paragraph (1) of Rule 27bis, provided that the same natural person or legal entity is the recorded holder in both aforementioned international registrations and the Office concerned is satisfied that the request meets the requirements of its applicable law, including the requirements concerning fees. The request shall be presented to the International Bureau on the relevant official form. The International Bureau shall record the merger, notify accordingly the Office that presented the request and shall inform at the same time the holder.

(b) The Office of a Contracting Party, the law of which does not provide for the merger of registrations of a mark, may notify the Director General, before the date this Rule comes into force or the date on which the said Contracting Party becomes bound by the Agreement or the Protocol, that it will not present to the International Bureau the request referred to in subparagraph (a). This declaration may be withdrawn at any time.

Chapter 7 Gazette and Data Base

Rule 32 Gazette

(1) *[Information Concerning International Registrations]* (a) The International Bureau shall publish in the Gazette relevant data concerning

[...]

(viii**bis**) division recorded under Rule 27**bis**(4) and merger recorded under Rule 27**ter**,

[...]

(xi) information recorded under Rules 20, 20**bis**, 21, 21**bis**, 22(2)(a), 23, ~~27(3) and~~ (4) and 40(3);

[...]

[...]

(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, ~~or Rule 20**bis**(6), 27**bis**(6), 27**ter**(2)(b) or 40(6)~~ and any declaration made under Rule 17(5)(d) or (e);

[...]

Chapter 9 Miscellaneous

[...]

Rule 40

Entry into Force; Transitional Provisions

[...]

(6) *[Incompatibility with National Laws]* If, on the date this Rule comes into force or the date on which a Contracting Party becomes bound by the Agreement or the Protocol, paragraph (1) of Rule 27**bis** or paragraph (2)(a) of Rule 27**ter** are not compatible with the national law of that Contracting Party, the paragraph or paragraphs concerned, as the case may be, shall not apply in respect of this Contracting Party, for as long as it or they continue not to be compatible with that law, provided that the said Contracting Party notifies the International Bureau accordingly before the date this Rule comes into force or the date on which the said Contracting Party becomes bound by the Agreement or the Protocol. This notification may be withdrawn at any time.

[...]

PROPOSED AMENDMENTS TO THE SCHEDULE OF FEES

SCHEDULE OF FEES

(in force on [February 1, 2019](#))

Swiss francs

[...]

7. *Miscellaneous recordings*

[...]

[7.7 Division of an international registration](#)

[177](#)

[...]

[Annex IV follows]

**PROPOSED AMENDMENTS TO THE COMMON REGULATIONS UNDER THE MADRID
AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS AND THE
PROTOCOL RELATING TO THAT AGREEMENT**

**Common Regulations under
the Madrid Agreement Concerning
the International Registration of Marks
and the Protocol Relating to that Agreement**

(as in force on July 1, 2017)

[...]

**Chapter 2
International Applications**

[...]

*Rule 12
Irregularities With Respect to the
Classification of Goods and Services*

[...]

(8bis) [Examination of Limitations] The International Bureau shall examine limitations contained in an international application, applying paragraphs (1)(a) and (2) to (6) *mutatis mutandis*. Where the International Bureau cannot group the goods and services listed in the limitation under the classes of the International Classification of Goods and Services listed in the international application concerned, as amended pursuant to paragraphs (1) to (6), as the case may be, it shall issue an irregularity. Where the irregularity is not remedied within three months from the date of the notification of the irregularity, the limitation shall be deemed not to contain the goods and services concerned.

[...]

Chapter 5 Subsequent Designations; Changes

[...]

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, in one copy, where the request relates to any of the following:

[...]

(iv) a change in the name or 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;

[...]

(2) *[Contents of the Request]* (a) A request under paragraph (1)(a) shall, in addition to the requested recording, contain or indicate

[...]

(d) The request for the recording of a limitation shall group the limited goods and services only under the corresponding numbers of the classes of the International Classification of Goods and Services appearing in the international registration or, where the limitation affects all the goods and services in one or more of those classes, indicate the classes to be deleted.

[...]

Rule 26 *Irregularities in Requests for Recording under Rule 25*

(1) *[Irregular Request]* If a request under Rule 25(1)(a) does not comply with the applicable requirements, and subject to paragraph (3), the International Bureau shall notify that fact to the holder and, if the request was made by an Office, to that Office. For the purposes of this Rule, where the request is for the recording of a limitation, the International Bureau shall only examine whether the numbers of the classes indicated in the limitation appear in the international registration concerned.

(2) *[Time Allowed to Remedy Irregularity]* The irregularity may be remedied within three months from the date of the notification of the irregularity by the International Bureau. If the irregularity is not remedied within three months from the date of the notification of the irregularity by the International Bureau, the request shall be considered abandoned, and the International Bureau shall notify accordingly and at the same time the holder and, if the request under Rule 25(1)(a) was presented by an Office, that Office, and refund any fees paid, after deduction of an amount corresponding to one-half of the relevant fees referred to in item 7 of the Schedule of Fees, to the party having paid those fees.

[...]

Rule 27
Recording and Notification with respect to Rule 25;
Merger of International Registrations; 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 Agreement and Article 6(3) of the Protocol, the International Bureau shall also inform the Office of origin.

(b) The indications, the change or the cancellation shall be recorded as of the date of receipt by the International Bureau of a request complying with the applicable requirements, except that, where a request has been made in accordance with Rule 25(2)(c), it may be recorded as of a later date.

Chapter 7
Gazette and Data Base

Rule 32
Gazette

(1) *[Information Concerning International Registrations]* (a) The International Bureau shall publish in the Gazette relevant data concerning

[...]

(vii) recordings under Rule 27;

[...]

[...]

PROPOSED AMENDMENTS TO THE SCHEDULE OF FEES

SCHEDULE OF FEES

(in force on July 1, 2017)

Swiss francs

[...]

7. *Miscellaneous recordings*

[...]

- 7.4 Change in the name and/or address of the holder and/or, where the holder is a legal entity, introduction of or 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 for one or more international registrations for which the same recording or change is requested in the same form

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[...]

[Annex V follows]

**PROPOSED AMENDMENTS TO THE COMMON REGULATIONS UNDER THE MADRID
AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS AND THE
PROTOCOL RELATING TO THAT AGREEMENT**

**Common Regulations under
the Madrid Agreement Concerning
the International Registration of Marks
and the Protocol Relating to that Agreement**

(as in force on November 1, 2017)

[...]

**Chapter 1
General Provisions**

[...]

*Rule 3
Representation Before the International Bureau*

[...]

(4) *[Recording and Notification of Appointment of a Representative; Effective Date of Appointment]*

[...]

(b) The International Bureau shall notify the recording referred to in subparagraph (a) to both the applicant or holder and, in the latter case, the Offices of the designated Contracting Parties, as well as the representative. Where the appointment was made in a separate communication presented through an Office, the International Bureau shall also notify the recording to that Office.

[...]

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

[...]

(f) Cancellations at the request of the holder or the holder's representative shall also be notified to the Offices of the designated Contracting Parties.

Chapter 4
Facts in Contracting Parties
Affecting International Registrations

[...]

Rule 18ter

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

[...]

(4) *[Further Decision]* Where a notification of provisional refusal has not been sent within the applicable time limit under Article 5(2) of the Agreement or 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 concerned⁶.

[...]

Rule 22

*Ceasing of Effect of the Basic Application,
of the Registration Resulting Therefrom,
or of the Basic Registration*

(1) *[Notification Relating to Ceasing of Effect of the Basic Application, of the Registration Resulting Therefrom, or of the Basic Registration]*

[...]

(c) Once the judicial action or proceeding referred to in subparagraph (b) has resulted in the final decision referred to in Article 6(4) of the Agreement, in the final decision referred to in the second sentence of Article 6(3) of the Protocol or in the withdrawal or renunciation referred to in the third sentence of Article 6(3) of the Protocol, the Office of origin shall, where it is aware thereof, promptly notify the International Bureau accordingly and shall give the indications referred to in subparagraph (a)(i) to (iv). Where the judicial action or proceedings referred to in subparagraph (b) has been completed and has not resulted in any of the aforesaid final decisions, withdrawal or renunciation, the Office of origin shall, where it is aware thereof or at the request of the holder, promptly notify the International Bureau accordingly.

(2) *[Recording and Transmittal of the Notification; Cancellation of the International Registration]*

[...]

(b) Where any notification referred to in paragraph (1)(a) or (c) requests cancellation of the international registration and complies with the requirements of that paragraph, the International Bureau shall cancel, to the extent applicable, the international registration in the International Register. The International Bureau shall also cancel, to the extent applicable, international registrations resulting from partial change in ownership recorded under the international registration that has been cancelled, following the above-mentioned notification, and those resulting from their merger.

[...]

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.”

Chapter 5 Subsequent Designations; Changes

[...]

Rule 23bis *Communications from the Offices of the* *Designated Contracting Parties sent through* *the International Bureau*

(1) *[Communications from the Offices of the designated Contracting Parties 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 Office may request the International Bureau to transmit that communication to the holder on its behalf.

(2) *[Format of the Communication]* The International Bureau shall establish the format in which the communication referred to in paragraph (1) shall be sent by the Office concerned.

(3) *[Transmission to the holder]* The International Bureau shall transmit the communication referred to in paragraph (1) to the holder, in the format established by the International Bureau, without examining its contents or recording it in the International Register.

Rule 25 *Request for Recording of a Change;* *Request for Recording of a Cancellation*

(1) *[Presentation of the Request]* (a) A request for recording shall be presented to the International Bureau on the relevant official form, in one copy, where the request relates to any of the following:

[...]

(v) cancellation of the international registration in respect of all the designated Contracting Parties for all or some of the goods and services;

(vi) a change in the name or address of the representative.

[...]

(2) *[Contents of the Request]* (a) The request for the recording of a change or the request for the recording of a cancellation shall, in addition to the requested change or cancellation, contain or indicate

[...]

(ii) the name of the holder or the name of the representative where the change relates to the name or address of the representative,

[...]

Rule 27
Recording and Notification of a Change or of a Cancellation;
Merger of International Registrations; Declaration That a Change in Ownership or a Limitation
Has No Effect

[...]

(2) *[Recording of Partial Change in Ownership]* (a) A change in ownership of the international registration in respect of only some of the goods and services or only some of the designated Contracting Parties shall be recorded in the International Register under the number of the international registration concerned by the partial change in ownership.

(b) The part of the international registration for which a change in ownership has been recorded shall be deleted from the international registration concerned and recorded as a separate international registration.

[...]

Chapter 7
Gazette and Data Base

Rule 32
Gazette

(1) *[Information Concerning International Registrations]* (a) The International Bureau shall publish in the Gazette relevant data concerning

[...]

(xii) international registrations which have not been renewed;

(xiii) recordings of the appointment of the holder's representative communicated under Rule 3(2)(b) and cancellations at the request of the holder or the holder's representative under Rule 3(6)(a).

[...]

(3) The International Bureau shall effect the publications under paragraphs (1) and (2) on the website of the World Intellectual Property Organization.

[Annex VI follows]

**PROPOSED AMENDMENTS TO THE COMMON REGULATIONS UNDER THE MADRID
AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS AND THE
PROTOCOL RELATING TO THAT AGREEMENT**

**Common Regulations under
the Madrid Agreement Concerning
the International Registration of Marks
and the Protocol Relating to that Agreement**

(as in force on February 1, 2019)

[...]

**Chapter 4
Facts in Contracting Parties
Affecting International Registrations**

[...]

*Rule 22
Ceasing of Effect of the Basic Application,
of the Registration Resulting Therefrom,
or of the Basic Registration*

[...]

(2) *[Recording and Transmittal of the Notification; Cancellation of the International
Registration]*

[...]

(b) Where any notification referred to in paragraph (1)(a) or (c) requests cancellation of the international registration and complies with the requirements of that paragraph, the International Bureau shall cancel, to the extent applicable, the international registration in the International Register. The International Bureau shall also cancel, to the extent applicable, international registrations resulting from partial change in ownership or division recorded under the international registration that has been cancelled, following the above-mentioned notification, and those resulting from their merger.

Chapter 5
Subsequent Designations; Changes

[...]

Rule 27

*Recording and Notification of a Change or of a Cancellation;
Declaration That a Change in
Ownership or a Limitation Has No Effect*

[...]

(3) [Deleted]

[...]

Rule 27bis

Division of an International Registration

(1) *[Request for the Division of an International Registration]* (a) A request by the holder for the division of an international registration for some only of the goods and services in respect of a designated Contracting Party shall be presented to the International Bureau on the relevant official form by the Office of that designated Contracting Party, once the latter is satisfied that the division whose recording is requested meets the requirements of its applicable law, including the requirements concerning fees.

(b) The request shall indicate

(i) the Contracting Party of the Office presenting the request,

(ii) the name of the Office presenting the request,

(iii) the number of the international registration,

(iv) the name of the holder,

(v) the names of the goods and services to be set apart, grouped in the appropriate classes of the International Classification of Goods and Services,

(vi) the amount of the fee being paid and the method of payment, or instructions to debit the required amount to an account opened with the International Bureau, and the identification of the party effecting the payment or giving the instructions.

(c) The request shall be signed by the Office presenting the request and, where the Office so requires, also by the holder.

(d) Any request presented under this paragraph may include or be accompanied by a statement sent in accordance with either Rule 18*bis* or 18*ter* for the goods and services listed in the request.

(2) *[Fee]* The division of an international registration shall be subject to the payment of the fee specified in item 7.7 of the Schedule of Fees.

(3) *[Irregular Request]* (a) If the request does not comply with the applicable requirements, the International Bureau shall invite the Office that presented the request to remedy the irregularity and at the same time inform the holder.

(b) If the irregularity is not remedied by the Office within three months from the date of the invitation under subparagraph (a), the request shall be considered abandoned and the International Bureau shall notify accordingly the Office that presented the request, it shall inform at the same time the holder and refund any fee paid under paragraph (2), after the deduction of an amount corresponding to one-half of that fee.

(4) *[Recording and Notification]* (a) Where the request complies with the applicable requirements, the International Bureau shall record the division, create a divisional international registration in the International Register, notify accordingly the Office that presented the request and shall inform at the same time the holder.

(b) The division of an international registration shall be recorded with the date of receipt by the International Bureau of the request or, where applicable, the date where the irregularity referred to in paragraph (3) was remedied.

(5) *[Request Not Considered as Such]* A request for the division of an international registration in respect of a designated Contracting Party that is not or is no longer designated for the classes of the International Classification of Goods and Services mentioned in the request will not be considered as such.

(6) *[Declaration That a Contracting Party Will Not Present Requests for Division]* A Contracting Party, the law of which does not provide for division of applications for the registration of a mark or registrations of a mark, may notify the Director General, before the date this Rule comes into force or the date on which the said Contracting Party becomes bound by the Agreement or the Protocol, that it will not present to the International Bureau the request referred to in paragraph (1). This declaration may be withdrawn at any time.

Rule 27ter
Merger of International Registrations

(1) *[Merger of International Registrations Resulting from the Recording of a Partial Change in Ownership]* Where the same natural person or legal entity has been recorded as the holder of two or more international registrations resulting from a partial change in ownership, the registrations shall be merged at the request of the said person or entity, made either direct or through the Office of the Contracting Party of the holder. The request shall be presented to the International Bureau on the relevant official form. The International Bureau shall record the merger, notify accordingly the Offices of the designated Contracting Party or Parties affected by the change and shall inform at the same time the holder and, if the request was presented by an Office, that Office.

(2) *[Merger of International Registrations Resulting from the Recording of the Division of an International Registration]* (a) An international registration resulting from division shall be merged into the international registration it was divided from at the request of the holder, presented through the Office that presented the request referred to in paragraph (1) of Rule 27bis, provided that the same natural person or legal entity is the recorded holder in both aforementioned international registrations and the Office concerned is satisfied that the request meets the requirements of its applicable law, including the requirements concerning fees. The request shall be presented to the International Bureau on the relevant official form. The International Bureau shall record the merger, notify accordingly the Office that presented the request and shall inform at the same time the holder.

(b) The Office of a Contracting Party, the law of which does not provide for the merger of registrations of a mark, may notify the Director General, before the date this Rule comes into force or the date on which the said Contracting Party becomes bound by the Agreement or the Protocol, that it will not present to the International Bureau the request referred to in subparagraph (a). This declaration may be withdrawn at any time.

Chapter 7 Gazette and Data Base

Rule 32 Gazette

(1) *[Information Concerning International Registrations]* (a) The International Bureau shall publish in the Gazette relevant data concerning
[...]
Rule 27*ter*, (viii*bis*) division recorded under Rule 27*bis*(4) and merger recorded under
[...]
(4) and 40(3); (xi) information recorded under Rules 20, 20*bis*, 21, 21*bis*, 22(2)(a), 23, 27
[...]
[...]

(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, 20*bis*(6), 27*bis*(6), 27*ter*(2)(b) or 40(6) and any declaration made under Rule 17(5)(d) or (e);
[...]

Chapter 9 Miscellaneous

[...]

Rule 40 Entry into Force; Transitional Provisions

[...]

(6) *[Incompatibility with National Laws]* If, on the date this Rule comes into force or the date on which a Contracting Party becomes bound by the Agreement or the Protocol, paragraph (1) of Rule 27*bis* or paragraph (2)(a) of Rule 27*ter* are not compatible with the national law of that Contracting Party, the paragraph or paragraphs concerned, as the case may be, shall not apply in respect of this Contracting Party, for as long as it or they continue not to be compatible with that law, provided that the said Contracting Party notifies the International Bureau accordingly before the date this Rule comes into force or the date on which the said Contracting Party becomes bound by the Agreement or the Protocol. This notification may be withdrawn at any time.

[...]

PROPOSED AMENDMENTS TO THE SCHEDULE OF FEES

SCHEDULE OF FEES

(in force on February 1, 2019)

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[...]

7. *Miscellaneous recordings*

[...]

7.7 Division of an international registration

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[...]

[End of Annex VI and of document]