

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

### **Assembly**

#### **Fifty-Fourth (31<sup>st</sup> Extraordinary) Session Geneva, September 21 to 25, 2020**

#### **COVID-19 MEASURES: MAKING E-MAIL A REQUIRED INDICATION**

*Document prepared by the Secretariat*

### **INTRODUCTION**

1. The COVID-19 pandemic has resulted in severe disruptions for users of the Madrid System for the International Registration of Marks (hereinafter referred to as “the Madrid System”) due to measures taken in several countries to combat its spread. In particular, these measures have disrupted global postal and delivery services.
2. The above-mentioned disruptions are likely to continue for some time in several regions of the world. At the time this document was drafted, numerous countries still had measures in place to protect the population from the effects of the pandemic; other countries were lifting restrictions, but continued to face a possible second wave of infections and the reintroduction of such restrictions.
3. It is recalled that the eighteenth session of the Working Group for the Legal Development of the Madrid System for the International Registration of Marks (hereinafter referred to as “the Working Group”) will take place in October 2020, after the fifty-fourth session of the Madrid Union Assembly (hereinafter referred to as “the Assembly”) has taken place. Therefore, the Assembly could only consider any recommendation made by the Working Group at its fifty-fifth session.

4. For the foregoing reasons, there is a need to present this document directly to the Assembly for its immediate consideration. This document proposes amendments to ensure that users of the Madrid System benefit from receiving electronic communications from the International Bureau, which would allow them to react promptly to time sensitive communications, such as notifications of provisional refusal, should there be further disruptions in mail services.

5. More precisely, this document proposes amendments to Rules 3, 9, 25 and 36 of the Regulations under the Protocol Relating the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as “the Regulations”).

## **ELECTRONIC MAIL ADDRESS**

6. At its seventeenth session, the Working Group discussed document MM/LD/WG/17/5, concerning the time limit to reply to notifications of provisional refusal<sup>1</sup>. Following discussions, the Working Group requested that the International Bureau propose amendments to the Regulations making electronic communication the default mode for transmitting communications to applicants, holders and representatives, by requiring that they indicate an electronic mail (hereinafter referred to as “e-mail”) address for this purpose<sup>2</sup>.

7. The International Bureau introduced the transmission of communications by electronic means to holders and representatives on August 28, 2007, by inviting them to indicate an e-mail address<sup>3</sup>. In 2019, the International Bureau transmitted 86 per cent of communications to applicants, to holders, and to their representatives by electronic means. Nevertheless, the number of communications that the International Bureau mails through postal services remains high. For example, the International Bureau mailed almost 270,000 communications to applicants, to holders, or to their representatives in 2019.

8. On March 30, 2020, the International Bureau announced that it was temporarily unable to send or receive postal communications due to the suspension of postal services between Switzerland and a number of countries and the need to comply with guidance by public health authorities<sup>4</sup>. As a result, the International Bureau was temporarily unable to transmit communications where the party concerned had failed to indicate an e-mail address. For example, by the second week of May 2020, the International Bureau had been unable to mail almost 2,500 notifications of provisional refusal. The International Bureau resumed the sending of communications by postal services in the first week of June 2020, and, by the end of the following week, it had already mailed all pending communications.

9. To mitigate the negative effects of the suspension of postal communications, the International Bureau reached out to those holders and representatives who had failed to indicate an e-mail address. As a result of this initiative, the number of international registrations in force for which neither the holder nor the representative had indicated an e-mail address went from close to 160,000 in the last week of March 2020, to slightly over 85,000 during the first week of July 2020.

10. Electronic communication is the fastest, most efficient and resilient means to transmit information. As the default means of communication, it would benefit users of the Madrid System because it would ensure prompt delivery without negatively affecting delays to respond to time sensitive communications, such as, for example, notifications of provisional refusal.

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<sup>1</sup> See document MM/LD/17/5  
([https://www.wipo.int/edocs/mdocs/madrid/en/mm\\_ld\\_wg\\_17/mm\\_ld\\_wg\\_17\\_5.pdf](https://www.wipo.int/edocs/mdocs/madrid/en/mm_ld_wg_17/mm_ld_wg_17_5.pdf)).

<sup>2</sup> See document MM/LD/17/12  
([https://www.wipo.int/edocs/mdocs/madrid/en/mm\\_ld\\_wg\\_17/mm\\_ld\\_wg\\_17\\_12.pdf](https://www.wipo.int/edocs/mdocs/madrid/en/mm_ld_wg_17/mm_ld_wg_17_12.pdf)).

<sup>3</sup> See Information Notice No. 15/2007 ([https://www.wipo.int/edocs/madrdocs/en/2007/madrid\\_2007\\_15.pdf](https://www.wipo.int/edocs/madrdocs/en/2007/madrid_2007_15.pdf)).

<sup>4</sup> See Information Notice No. 11/2020 ([https://www.wipo.int/edocs/madrdocs/en/2020/madrid\\_2020\\_11.pdf](https://www.wipo.int/edocs/madrdocs/en/2020/madrid_2020_11.pdf)).

11. Therefore, it is proposed that Rules 3(2)(a) and (4)(a), 9(4)(a)(ii) and (iii) and 25(2)(a)(iii) of the Regulations be amended to require that applicants, holders and their representatives indicate an e-mail address in the international application, in a separate communication appointing a representative, or in a request for the recording of a change in ownership. A consequential amendment to Rule 36(ii) of the Regulations would clarify that changes to the e-mail address of the representative are exempt from the payment of fees; further, the word telefacsimile would be deleted from this Rule, as the International Bureau no longer communicates by telefacsimile.

12. Electronic communication is traceable and allows the International Bureau to determine whether a communication has reached its intended recipient. The International Bureau transmits time sensitive communications using a registered e-mail service that delivers a registered receipt record for every e-mail sent and indicates when such e-mail has failed to reach the intended recipient. As it is the case today, the International Bureau would continue to send communications by postal services where a communication sent by electronic means fails to reach its intended recipient.

13. While it continues its above-mentioned outreach initiative to collect e-mail addresses, the International Bureau estimates that there remains 11 per cent of international registrations in force for which neither the holder nor the representative has indicated an e-mail address. The International Bureau would continue to send by postal services communications for international registrations in which the holder or the representative have not indicated an e-mail address because they were not required to do so.

14. As it is currently the case and to address privacy concerns, the International Bureau would not include the e-mail address of applicants, holders or representatives on the Madrid System online information services (e.g., Madrid Monitor, Madrid Real-time Status). Moreover, in accordance with Rule 32(1)(a) of the Regulations, the International Bureau would not publish such information in the *WIPO Gazette of International Marks* because it is not relevant to the international registration.

15. It is recommended that the proposed amendments to the Regulations enter into force on February 1, 2021, which is the date on which other amendments adopted by the Assembly of the Madrid Union will enter into force.

*16. The Madrid Union Assembly is invited to adopt the amendments to Rules 3, 9, 25 and 36 of the Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, as set out in the Annex to document MM/A/54/1.*

[Annex follows]

**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, 2020~~ February 1, 2021

***Chapter 1  
General Provisions***

[...]

**Rule 3  
Representation Before the International Bureau**

[...]

(2) *[Appointment of the Representative]*

- (a) The appointment of a representative may be made in the international application or in a subsequent designation or in a request under Rule 25 and shall indicate the name and address, given in accordance with the Administrative Instructions, and the electronic mail address of the representative.

[...]

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

- (a) Where the International Bureau finds that the appointment of a representative complies with the applicable requirements, it shall record the fact that the applicant or holder has a representative, as well as the name, address and electronic mail address of the representative, in the International Register. In such a case, the effective date of the appointment shall be the date on which the International Bureau received the international application, subsequent designation, request or separate communication in which the representative is appointed.

[...]

[...]

**Chapter 2**  
**International Applications**

[...]

**Rule 9**  
**Requirements Concerning the International Application**

[...]

(4) *[Contents of the International Application]*

(a) The international application shall contain or indicate

[...]

(ii) the address ~~of the applicant~~, given in accordance with the Administrative Instructions, and the electronic mail address of the applicant.

(iii) the name and address ~~of the representative, if any~~, given in accordance with the Administrative Instructions, and the electronic mail address of the representative, if any.

[...]

[...]

[...]

**Chapter 5**  
**Subsequent Designations; Changes**

[...]

**Rule 25**  
**Request for Recording**

[...]

(2) *[Contents of the Request]*

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

[...]

- (iii) in the case of a change in the ownership of the international registration, the name and address, given in accordance with the Administrative Instructions, and the electronic mail address of the natural person or legal entity mentioned in the request as the new holder of the international registration (hereinafter referred to as “the transferee”),

[...]

[...]

[...]

**Chapter 8**  
**Fees**

[...]

**Rule 36**  
**Exemption From Fees**

Recording of the following shall be exempt from fees:

[...]

- (ii) any change concerning the telephone ~~and telefacsimile~~ numbers, address for correspondence, electronic mail address and any other means of communication with the applicant, ~~or~~ holder, or representative, as specified in the Administrative Instructions,

[...]

[...]

[End of Annex and of document]