

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

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

(1) [Request and Notification] From the date of the notification of the international registration or of the subsequent designation, as the case may be, the holder may present directly to the Office of a designated Contracting Party a request for that Office to take note of the international registration in its Register, in accordance with Article 4bis(2) of the Protocol. Where, ~~in accordance with Article 4bis(2) of the Protocol~~ following the said request, the Office ~~of a designated Contracting Party~~ has taken note in its Register, ~~following a request made direct by the holder with that Office~~, that a national or a regional registration or registrations, as the case may be, ~~has~~ have been replaced by ~~an~~ the international registration, that Office shall notify the International Bureau accordingly. Such notification shall indicate

(i) the number of the international registration concerned,

(ii) where the replacement concerns only one or some of the goods and services listed in the international registration, those goods and services, and

- (iii) the filing date and number, the registration date and number, and, if any, the priority date of the national or regional registration or registrations which ~~has~~have been replaced by the international registration.

The notification may also include information relating to any other rights acquired by virtue of that national or regional registration or registrations, ~~in a form agreed between the International Bureau and the Office concerned.~~

(2) *[Recording]*

- (a) The International Bureau shall record the indications notified under paragraph (1) in the International Register and shall inform the holder accordingly.
- (b) The indications notified under paragraph (1) shall be recorded as of the date of receipt by the International Bureau of a notification complying with the applicable requirements.

(3) *[Further Details Concerning Replacement]*

- (a) Protection to the mark that is the subject of an international registration may not be refused, even partially, based on a national or regional registration which is deemed replaced by that international registration.
- (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 be allowed to renew that registration, if the holder so wishes, in accordance with the applicable national or regional law.
- (c) Before taking note in its Register, the Office of a designated Contracting Party shall examine the request referred to in paragraph (1) to determine whether the conditions specified in Article 4bis(1) of the Protocol have been met.
- (d) The goods and services concerned with replacement, listed in the national or regional registration, shall be covered by those listed in the international registration.
- (e) A national or regional registration is deemed replaced by an international registration as from the date on which that international registration takes effect in the designated Contracting Party concerned, in accordance with Article 4(1)(a) of the Protocol.

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]