

Madrid Protocol Concerning the International Registration of Marks

Amendments to the Regulations Under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks in force as from November 1, 2023, and November 1, 2024

1. At its fifty-seventh (25th ordinary) session, the Madrid Union Assembly adopted amendments to Rules 17, 18, 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” and “the Protocol”) that will enter into force on November 1, 2023.
2. In addition, the Madrid Union Assembly adopted changes to Rules 21, 23*bis* and 32 of the Regulations that will enter into force on November 1, 2024.
3. The amended text of the Regulations is available in the Annexes to the present Information Notice.

CHANGES TO ENTER INTO FORCE ON NOVEMBER 1, 2023

Start and end dates of the time limit to respond to a provisional refusal

4. Amendments to Rule 17 of the Regulations require that Offices of the designated Contracting Parties clearly indicate in the notification of provisional refusal the start and end dates of the time limit to file a request for review of, or an appeal against, or a response to the provisional refusal. This new requirement applies to Contracting Parties for which the said time limit starts on a date other than the date on which the International Bureau transmits a copy of the notification to the holder or on which the holder receives said copy.
5. When the time limit starts on the date on which the International Bureau transmits a copy of the notification to the holder, the International Bureau will specify the start and end dates based on the date on which it transmitted the notification to the holder and the time limit indicated by the Office concerned in the notification of provisional refusal.
6. The same applies when the time limit starts on the date on which the holder receives a copy of the notification, and the International Bureau transmits such copy electronically. Electronic communications are delivered within a short delay. In addition, the International Bureau uses a delivery tracking service, which promptly confirms whether the holder has received the electronic communication. The International Bureau will specify the start and end dates under the assumption that the holder will receive the electronic communication shortly after it is sent, which will be confirmed soon thereafter by the e-mail delivery report.

7. The cover letter transmitted by the International Bureau with a copy of the notification to the holder will specify the time limit and the start and end dates indicated by the Office in that notification or the start and end dates as established by the International Bureau. This communication is in the language chosen by the holder to receive communications from the International Bureau.

8. In the few cases in which the electronic communication fails to reach the intended recipient due to, for example, the e-mail address being defective or the inbox being full, the International Bureau will transmit a copy of the notification of provisional refusal by certified postal mail, as a courtesy. In such case, the International Bureau will not indicate the start and end dates in its cover letter if the time limit starts on the date on which the holder receives a copy of the notification.

Minimum time limit to respond to a provisional refusal

9. Further amendments to Rule 17 of the Regulations require Contracting Parties to provide holders of international registration with a minimum time limit of two months, or 60 consecutive or calendar days, to file a request for review of, or an appeal against, or a response to the provisional refusal.

10. New Rule 40(8) of the Regulations gives Contracting Parties until February 1, 2025, to meet the new minimum time limit requirement. Contracting Parties that need more time, for example, to amend their domestic legal framework, could further delay the effectiveness of this obligation by notifying the International Bureau before February 1, 2025, or, for new Contracting Parties, before they are bound by the Protocol.

Failure to meet the new requirements concerning notifications of provisional refusal

11. Where an Office fails to indicate the start and end dates of the time limit to file a request for review of, or an appeal against, or a response to the provisional refusal, that provisional refusal will not be regarded as such, in accordance with an amended Rule 18(1)(d) of the Regulations.

12. In such case, the International Bureau will inform the Office concerned and the holder of that fact. The Office concerned must send a rectified notification within two months, for it to be deemed as having been sent on the date on which the defective notification had been sent. In this case, the Regulations prompt Offices to provide a new delay to respond, where possible. The Office can also send a new notification, instead of sending a rectified notification, provided the Office sends it before the applicable refusal period under Article 5 of the Protocol expires.

13. The same will apply to notifications of provisional refusal that fail to provide holders of international registrations with the above-mentioned minimum time limit as from February 1, 2025, or as from the later date notified by the Contracting Party concerned in accordance with new Rule 40(8) of the Regulations.

Obligation to notify time limits and the way in which to calculate them

14. New Rule 17(7) of the Regulations requires Contracting Parties to notify the International Bureau of the applicable time limit to file a request for review of, or an appeal against, or a response to a provisional refusal. An amendment to Rule 32 of the Regulations requires the International Bureau to publish these notifications in the *WIPO Gazette of International Marks* (hereinafter referred to as “the Gazette”) to make this information available to users of the Madrid System and to other interested parties.

Address of the holder of earlier rights or of the opponent

15. An amendment to Rule 17 exempts Contracting Parties from indicating in the notification of provisional refusal the address of the holder of the earlier rights upon which the refusal is based, or of the representative, when this is not possible. The same applies regarding the address of the opponent, or of the representative, for refusals based on an opposition.

16. The amended Rule continues to require that Contracting Parties indicate the address of the holder of the earlier rights or of the opponent, or of their representatives, whenever possible, while exempting from this requirement those Contracting Parties that cannot do so due to, for example, privacy laws or unavailability of this information.

Editorial amendments to Rule 17(2) of the Regulations

17. For the sake of clarity, the requirements that are now indicated in Rule 17(2)(vii) of the Regulations will be listed in subparagraphs (vii) to (x) in the same Rule.

CHANGES TO ENTER INTO FORCE ON NOVEMBER 1, 2024

Communications from designated Contracting Parties not covered under the Regulations

18. Amendments to Rule 23*b/s* of the Regulations allow all Contracting Parties to request that the International Bureau transmit to holders any communication not covered under the Regulations. For example, Contracting Parties can take advantage of the amended Rule to request that the International Bureau transmit to the holder information regarding possible actions, reminders to meet certain requirements before their Offices or any information of particular interest to the holder.

19. This amendment makes it possible for holders to receive official communications from Contracting Parties through the International Bureau, remain informed about relevant developments affecting their registration and take appropriate action where needed.

Editorial amendments to Rules 21 and 32 of the Regulations

20. The amendment to Rule 21(3)(b) of the Regulations clarifies that Contracting Parties must allow a domestic registration and the international registration that has replaced it to coexist. The amendment to Rule 32(1)(a)(xi) of the Regulations clarifies that the International Bureau must also publish in the Gazette declarations that a given limitation has not effect.

September 19, 2023

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, withand

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 9sexies(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, ~~it~~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 ~~it~~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 \[November 1, 2023\]\(#\).](#)

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~~ communication s 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, 20bis, 21, 21bis, 22(2)(a), 23 and 27(4) and (5);

[...]

[End of Annex II]