

## **Working Group on the Legal Development of the Madrid System for the International Registration of Marks**

**Twentieth Session**  
**Geneva, November 7 to 11, 2022**

### **THE POSSIBLE CONVENING OF A DIPLOMATIC CONFERENCE TO AMEND ARTICLE 6 OF THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS**

*Document prepared by the International Bureau*

#### **INTRODUCTION**

1. At its nineteenth session, held in Geneva from November 15 to 17, 2021, the Working Group on the Legal Development of the Madrid System for the International Registration of Marks (hereinafter referred to as “the Working Group”) discussed document MM/LD/WG/19/5.<sup>1</sup> That document explored various possible options to amend the dependency period set out in Article 6 of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as “the Protocol”).
2. Following the discussions based on the above-mentioned document, the Working Group indicated that it favored the option of reducing the dependency period from five to three years. Consequently, the Working Group requested the Secretariat to prepare a document on the possibility of convening a Diplomatic Conference to amend Article 6 of the Protocol for this purpose, and on other possible options to implement this reduction, for discussion at its following session.

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<sup>1</sup> See document MM/LD/WG/19/5 “Dependency”.

3. At its nineteenth session, the Working Group also requested the Secretariat to prepare another document, for discussion at its following session, exploring further options concerning dependency. This request is addressed in document MM/LD/WG/20/4.<sup>2</sup>

4. Certain articles of the Protocol may be amended by a decision of the Madrid Union Assembly (hereinafter referred to as the Assembly). This follows from Article 13 of the Protocol, which specifically states that the Assembly, following a given procedure, has the authority to amend Articles 10 to 13. This also means that all other provisions may only be amended through the convening of a Diplomatic Conference. As dependency is established by Article 6 of the Protocol, convening a Diplomatic Conference is required to reduce the dependency period from five to three years.

5. The present document describes the proposed amendment to Article 6 of the Protocol, the procedure to convene a Diplomatic Conference to conclude such an amendment, the possible timeframe for the convening of a Diplomatic Conference, other possible amendments for the Working Group to consider, and the entry into force of such amendments.

### **PROPOSED AMENDMENT TO ARTICLE 6 OF THE PROTOCOL**

6. Dependency is anchored in Article 6(2) and (3) of the Protocol. Many trademark holders consider that dependency is a disadvantage and have frequently cited it as a reason for not using the Madrid System. In the past, some Contracting Parties have indicated that they believe that dependency should be abolished while other Contracting Parties have taken a different view, and a consensus in this regard was not reached.

7. However, during the nineteenth session of the Working Group, there was broad agreement to reduce the dependency period from five to three years. A reduction of the dependency period could be deemed as a less radical solution than its abolition, while being a positive change to the Madrid System. It would balance the need of holders of international registrations for increased legal certainty, while, at the same time, allowing third parties to rely on the principle of “central attack” as a mechanism to cancel the effects of an international registration through a single action.

8. In particular, a reduction of the dependency period to three years would lower the risk of a cancellation of the international registration due to non-use of the basic mark in the home market. Several Contracting Parties allow third parties to initiate a cancellation action against a domestic registration where the holder has not used the mark for a given period, which usually ranges from three to five years and could start on the date of the registration of the basic mark, or any time thereafter.

9. A reduction of the dependency period would not eliminate the above-mentioned risk for all international registrations. However, such a reduction would undoubtedly bring some comfort to the holder by shortening the period of uncertainty to three years. For international registrations based on a domestic registration, depending on the date of the domestic registration, a third party could still initiate a cancellation action within the reduced dependency period. However, for international registrations based on a domestic application, the risk of non-use cancellation would be lower with a reduced dependency period.

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<sup>2</sup> See document MM/LG/WG/20/4 “Dependency”.

10. For example, if the holder files the international and domestic applications at the same time, third parties might be unable to initiate a cancellation action within the reduced dependency period. While the Office of origin could still refuse the basic application during the dependency period, resulting in the cancellation of the international registration, the overall risk of the cancellation of the international registration due to ceasing of effect of its basic mark would be lower with a shorter dependency period.

11. A possible reduction of the dependency period would not exonerate holders from the responsibility of starting their Madrid System journey with a solid foundation, be it in the form of a sound domestic application or registration, and of remaining vigilant and using their mark in their home market. However, a decision by Contracting Parties to take the necessary steps to reduce the dependency period would be an important signal and a modernization of the Protocol.

12. A reduction of the dependency period from five to three years would require a textual amendment to Article 6 of the Protocol by replacing the length of the period specified therein from “five” to “three” years, as set out in Annex I to this document.

## **PROCEDURE FOR CONVENING A DIPLOMATIC CONFERENCE**

### **REVISION OF THE PROTOCOL**

13. Article 10(2) of the Protocol lists the functions of the Assembly. One of those functions is to decide on the convening and preparations of Diplomatic Conferences. Article 10(2)(ii) specifically states that “the Assembly shall [...] give directions to the International Bureau concerning the preparation for conferences of revision of this Protocol, due account being taken of any comments made by those countries of the Union which are not party to this Protocol [...]”.

14. The formal procedure to convene a Diplomatic Conference would require decisions by the Working Group, the Assembly and by a Preparatory Committee for the Diplomatic Conference (hereinafter referred to as “the Preparatory Committee”).

15. The Working Group would need to agree on the articles that would be subject to the revision of the Protocol, propose a draft revised Protocol to be discussed at the Diplomatic Conference (hereinafter referred to as “the basic proposal”), and recommend the title for the Diplomatic Conference. The Working Group should also consider who could participate in the Diplomatic Conference. See more on the latter in paragraph 19, below.

16. Following the recommendations made by the Working Group, the Assembly would need to adopt the decision to convene a Diplomatic Conference. Once this decision has been adopted, the International Bureau would schedule a meeting of the Preparatory Committee and would prepare the draft agenda as well as the documents for this meeting.

17. At its meeting, the Preparatory Committee would decide on the exact dates and venue of the Diplomatic Conference. It would consider the Draft Rules of Procedure of the Diplomatic Conference with a view to recommending their adoption by the Diplomatic Conference, and approve the List of Invitees to the Diplomatic Conference, the texts of the draft letters of invitation and the Draft Agenda for the Diplomatic Conference. Furthermore, the Preparatory Committee would approve the Final and Administrative Provisions. Consistent with established practice, a Diplomatic Conference could take place six months following the meeting of the Preparatory Committee, at the earliest.

18. Following the approval of the above-mentioned documents by the Preparatory Committee, the International Bureau, consistent with its responsibilities under Article 11(2)(a) of the Protocol, would thereafter finalize and transmit the invitations and other relevant documents to the invitees, dedicate a webpage to the Diplomatic Conference and make arrangements to provide for organizational, administrative and procedural support during the Diplomatic Conference.

#### PARTICIPATION IN A DIPLOMATIC CONFERENCE

19. There are three possible options concerning the composition of a Diplomatic Conference for the revision of the Protocol, regarding, in particular, the category of “Member Delegations” with full participation and voting rights in the Conference and Main Committees. “Member Delegations” of the Conference could be the delegations of the:

- (i) Contracting Parties of the Madrid Union; or
- (ii) States members of the Paris Union for the Protection of Industrial Property; or
- (iii) States members of WIPO.

20. All other participants would fall under the categories of “Special Delegations”, “Observer Delegations” or “Observers”.

21. The Working Group is invited to express its views regarding the category of which “Member Delegations” should consist, as per paragraph 19, above.

#### POSSIBLE TIMEFRAME TO HOLD A DIPLOMATIC CONFERENCE

22. Should the Working Group, at its twentieth session in November 2022, decide to recommend to the Assembly the convening of a Diplomatic Conference, the Assembly could adopt that decision, at the earliest, at its fifty-seventh session, in July 2023.

23. When discussing a date for a possible meeting of the Preparatory Committee and a Diplomatic Conference, due consideration should be given to the fact that the WIPO General Assembly, at its fifty-fifth (30<sup>th</sup> extraordinary) session held in July 2022, decided to convene two Diplomatic Conferences to conclude (i) an International Legal Instrument Relating to Intellectual Property, Genetic Resources and Traditional Knowledge Associated with Genetic Resources, and (ii) a Design Law Treaty. Both Diplomatic Conferences should take place no later than 2024.

24. Consequently, the Preparatory Committee meeting could take place late in 2024 or early in 2025. In such a case, the Diplomatic Conference could take place, at the earliest, in the second half of 2025, allowing a minimum of six months between the meeting of the Preparatory Committee and the Diplomatic Conference, to give the International Bureau sufficient time to finalize the necessary arrangements and provide for the logistical support to the Diplomatic Conference.

#### BUDGET

25. The cost for convening a Diplomatic Conference to revise the Protocol would be included in the Program of Work and Budget for 2024/25, as a separate budget line.

## AMENDMENTS TO THE PROTOCOL: ENTRY INTO FORCE

26. Consistent with Article 14(4)(a) of the Protocol, the amended version of the treaty would enter into force three months after four Contracting Parties to the Protocol have deposited instruments of ratification or acceptance. The amended version, or new Act, would automatically apply to new Contracting Parties acceding to the Protocol after it has entered into force.

27. However, any current Contracting Party to the Protocol would need to deposit an instrument of ratification or accession with the Director General of WIPO before the amended version takes effect in their territories. Until all the Contracting Parties have deposited the above-mentioned instrument, trademark holders would need to pay attention to determine which version of Article 6 applies in the Contracting Party of their Office of origin.

## OTHER POSSIBLE AMENDMENTS TO THE PROTOCOL

28. An agreement by the Working Group to move forward with a proposal for the convening of a Diplomatic Conference would also provide an opportunity to include further possible amendments to the Protocol. These possible amendments would be housekeeping matters, non-controversial in nature, and concern the modernization of certain provisions of the Protocol.

29. The following articles have been identified as those that would benefit from an update or where some modernization would be appropriate: Articles 3(2), 3(3)(ii), 3(5), 4*bis*(1), 5(2)(c)(ii), 5(3), and 5*ter*(2). The proposed amendments to these Articles are set out in track-changes in Annex II to this document.

### Article 3(2)

30. It is proposed to amend Article 3(2) to require the applicant to group the list of goods and services under the corresponding class of the *International Classification of Goods and Services for the Purposes of the Registration of Marks* (Nice Classification). For practical purposes, all applications meet this requirement.

### Article 3(3)(ii)

31. It is also proposed to delete the requirement in subparagraph (ii) for the applicant to append copies of the reproduction of the mark where this is in color, as this is no longer applicable.

### Article 3(5)

32. Further, it is proposed to delete the text referring to the International Bureau providing a number of copies of the *WIPO Gazette of International Marks* (hereinafter referred to as "the Gazette") free of charge and further a number of copies at a reduced price. Such amendment would reflect the fact that the Gazette is now only available in electronic format, published on the WIPO website, accessible by anyone.

Article 4bis(1)

33. It is proposed to amend Article 4bis(1) to clarify that partial replacement<sup>3</sup> is possible.

Article 5(2)(c)(ii)

34. It is proposed to delete the requirement that the notification of the refusal based on an opposition is made within a time limit of one month from the expiry of the opposition period. The final time limit of seven months from the date on which the opposition period begins will remain. This amendment would make it easier to understand the requirement to send the notification of provisional refusal based on opposition.

Article 5(3)

35. It is proposed to make an editorial amendment to Article 5(3) by replacing the requirement of “one of the copies” to “a copy”.

Article 5ter(2)

36. It is proposed to delete Article 5ter(2) as the International Bureau no longer provides the service of “undertaking searches for anticipations among marks that are the subject of international registrations”. The Global Brand Database is available online so anyone can make such searches, free of charge.

Final and Administrative Provisions

37. Finally, there would be a need to introduce consequential amendments to a number of final and administrative provisions concerning, for example, the Assembly or the International Bureau, as well as to introduce a new provision regulating the relations between Contracting Parties bound by both the Protocol and its new Act. The details of these consequential amendments would be provided at a more advanced stage of the process.

38. *The Working Group is invited to:*

*(i) consider the present document and comment on the various proposals contained in its Annexes;*

*(ii) express its view on whether it would recommend to the Madrid Union Assembly the convening of a Diplomatic Conference; and, the composition of the Diplomatic Conference, in particular, regarding the category of “Member Delegations”; and,*

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<sup>3</sup> See document MM/LD/WG/18/4 “Partial Replacement”.

*(iii) should it agree to make the recommendation referred to in item (ii) above, request that the Secretariat prepare a revised version of the Protocol, including final and administrative provisions, to be discussed by the Working Group at its following session.*

[Annexes follow]

## Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks

adopted at Madrid on June 27, 1989,  
as amended on October 3, 2006,  
~~and~~ on November 12, 2007,  
[and on \[...\]](#)

[...]

### Article 6 Period of Validity of International Registration; Dependence and Independence of International Registration

[...]

- (2) Upon expiry of a period of ~~five~~[three](#) years from the date of the international registration, such registration shall become independent of the basic application or the registration resulting therefrom, or of the basic registration, as the case may be, subject to the following provisions.
- (3) The protection resulting from the international registration, whether or not it has been the subject of a transfer, may no longer be invoked if, before the expiry of ~~five~~[three](#) years from the date of the international registration, the basic application or the registration resulting therefrom, or the basic registration, as the case may be, has been withdrawn, has lapsed, has been renounced or has been the subject of a final decision of rejection, revocation, cancellation or invalidation, in respect of all or some of the goods and services listed in the international registration. The same applies if
  - (i) an appeal against a decision refusing the effects of the basic application,
  - (ii) an action requesting the withdrawal of the basic application or the revocation, cancellation or invalidation of the registration resulting from the basic application or of the basic registration, or
  - (iii) an opposition to the basic application

results, after the expiry of the ~~five~~[three](#)-year period, in a final decision of rejection, revocation, cancellation or invalidation, or ordering the withdrawal, of the basic application, or the registration resulting therefrom, or the basic registration, as the case may be, provided that such appeal, action or opposition had begun before the expiry of the said period. The same also applies if the basic application is withdrawn, or the registration resulting from the basic application or the basic registration is renounced, after the expiry of the ~~five~~[three](#)-year period, provided that, at the time of the withdrawal or renunciation, the said application or registration was the subject of a proceeding referred to in item (i), (ii) or (iii) and that such proceeding had begun before the expiry of the said period.

[...]

[Annex II follows]



## Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks

adopted at Madrid on June 27, 1989,  
as amended on October 3, 2006,  
~~and on November 12, 2007,~~  
[and on \[...\]](#)

[...]

### Article 3 International Application

[...]

- (2) The applicant must indicate the goods and services in respect of which protection of the mark is claimed and also, ~~if possible,~~ the corresponding class or classes according to the classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks. ~~If the applicant does not give such indication, the International Bureau shall classify the goods and services in the appropriate classes of the said classification.~~ The indication of classes given by the applicant shall be subject to control by the International Bureau, which shall exercise the said control in association with the Office of origin. In the event of disagreement between the said Office and the International Bureau, the opinion of the latter shall prevail.
- (3) If the applicant claims color as a distinctive feature of his mark, he shall be required
- (i) to state the fact, and to file with his international application a notice specifying the color or the combination of colors claimed;
  - (ii) ~~to append to his international application copies in color of the said mark, which shall be attached to the notifications given by the International Bureau; the number of such copies shall be fixed by the Regulations;~~ [\[Deleted\]](#)

[...]

- (5) With a view to the publicity to be given to marks registered in the International Register, ~~each Office shall receive from the International Bureau a number of copies of~~ [shall provide access to](#) the said gazette ~~free of charge and a number of copies at a reduced price,~~ under the conditions fixed by the Assembly referred to in Article 10 (hereinafter referred to as “the Assembly”). Such publicity shall be deemed to be sufficient for the purposes of all the Contracting Parties, and no other publicity may be required of the holder of the international registration.

[...]

#### **Article 4bis**

##### **Replacement of a National or Regional Registration by an International Registration**

- (1) Where a mark that is the subject of a national or regional registration in the Office of a Contracting Party is also the subject of an international registration and both registrations stand in the name of the same person, the international registration is deemed to replace the national or regional registration, to the applicable extent, without prejudice to any rights acquired by virtue of the latter, provided that
- (i) the protection resulting from the international registration extends to the said Contracting Party under Article 3ter(1) or (2),
  - (ii) ~~all~~ the goods and services listed in the national or regional registration that are the subject of replacement are also listed in the international registration in respect of the said Contracting Party,
  - (iii) such extension takes effect after the date of the national or regional registration.

[...]

#### **Article 5**

##### **Refusal and Invalidation of Effects of International Registration in Respect of Certain Contracting Parties**

[...]

(2) [...]

- (c) Such declaration may also specify that, when a refusal of protection may result from an opposition to the granting of protection, such refusal may be notified by the Office of the said Contracting Party to the International Bureau after the expiry of the 18 month time limit. Such an Office may, with respect to any given international registration, notify a refusal of protection after the expiry of the 18-month time limit, but only if
- (i) it has, before the expiry of the 18-month time limit, informed the International Bureau of the possibility that oppositions may be filed after the expiry of the 18-month time limit, and
  - (ii) the notification of the refusal based on an opposition is made ~~within a time limit of one month from~~ as soon as possible after the expiry of the opposition period and, in any case, not later than seven months from the date on which the opposition period begins.

[...]

- (3) The International Bureau shall, without delay, transmit ~~one of the copies~~ a copy of the notification of refusal to the holder of the international registration. The said holder shall have the same remedies as if the mark had been deposited by him direct with the Office which has notified its refusal. Where the International Bureau has received information under paragraph (2)(c)(i), it shall, without delay, transmit the said information to the holder of the international registration.

[...]

**Article 5ter**  
**Copies of Entries in International Register; Searches for Anticipations; Extracts from International Register**

[...]

- (2) ~~The International Bureau may also, upon payment, undertake searches for anticipations among marks that are the subject of international registrations.~~ [\[Deleted\]](#)

[...]

[End of Annex II and of document]