

WIPO



MM/A/31/2

ORIGINAL: English

DATE: August 20, 1999

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

SPECIAL UNION FOR THE INTERNATIONAL REGISTRATION OF MARKS
(MADRID UNION)

ASSEMBLY

Thirty-First (13th Ordinary) Session
Geneva, September 20 to 29, 1999

CLAIMING PRIORITY UNDER THE MADRID AGREEMENT AND PROTOCOL:
PROPOSED CHANGE IN THE PRACTICE OF THE INTERNATIONAL BUREAU

Memorandum of the Secretariat

1. Article 2.1 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) provides that Members of the World Trade Organization (WTO) shall comply with Articles 1 to 12 and 19 of the Paris Convention for the Protection of Industrial Property. This has been taken to mean that a Member of the WTO is obliged to recognize a claim to priority based on an application for a patent or for the registration of a utility model, industrial design or trademark filed in or for (a) a State which is a party to the Paris Convention or (b) any Member of the WTO even if the latter is not a party to the Paris Convention.

2. Express account of this interpretation is taken by Article 6(1)(a) of the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs, adopted on July 2, 1999, which reads:

“The international application may contain a declaration claiming, under Article 4 of the Paris Convention, the priority of one or more earlier applications filed in or for any country party to that Convention or any Member of the World Trade Organization.”

It is to be noted that, while this provision refers to the possibility of claiming priority from an application filed either in a country party to the Paris Convention or in a Member of the WTO, in either case *the claim is made under Article 4 of the Paris Convention*. In other words, where the earlier application was filed in a Member of the WTO which is not a party to the Paris Convention, the claim to priority is considered to be made under Article 4 of the Paris Convention *as applied by Article 2.1 of the TRIPS Agreement*. It is also to be noted that, as stated in the Notes concerning Article 6(1)(a) as presented to the Diplomatic Conference which adopted the Geneva Act (document H/DC/5, paragraph 6.03), this provision would not oblige a Contracting Party which is not a Member of the WTO to recognize the effects of a priority claim based on an application filed in a State that is not party to the Paris Convention. The Geneva Act is, of course, not yet in force.

3. In contrast, the Madrid Agreement Concerning the International Registration of Marks (Article 4(2)), the Madrid Protocol relating to the Madrid Agreement (Article 4(2)) and the Common Regulations under the Madrid Agreement and Protocol (Rule 9(4)(a)) refer only to the Paris Convention, since they were adopted long before the TRIPS Agreement. The text of the relevant provisions is given in the Annex.

4. Bearing in mind the remarks in paragraph 2, above, to the effect that, whether the earlier application was filed in a country party to the Paris Convention or in a Member of the WTO, the claim to priority is always made under Article 4 of the Paris Convention, it will be seen that Article 4(2) of the Madrid Agreement and the Madrid Protocol, which provide that an international registration shall enjoy the right of priority provided for by Article 4 of the Paris Convention, and Rule 9(4)(a)(iv), which refers to an applicant taking advantage, under the Paris Convention, of the priority of an earlier filing, are not at variance with the notion that, where a contracting country is also a Member of the WTO, it is under an obligation to recognize a claim to priority even where the earlier application was filed in a Member of the WTO which is not party to the Paris Convention.

5. In the view of the International Bureau therefore, nothing in the provisions of the Madrid Agreement, the Madrid Protocol or the Common Regulations prevents the recording of a priority date resulting from a first filing in a Member of the WTO which is not a party to the Paris Convention.

6. At present, the practice of the International Bureau is to check that the first filing whose priority is claimed was effected in or for a State party to the Paris Convention¹. However, although the International Bureau is not aware of an instance so far of an international application containing a claim to priority from an application filed in a Member of the WTO (other than the European Communities (see footnote 1)) which is not a party to the Paris Convention, if the International Bureau were, in accordance with its present practice, to decline to record such a claim, a State in which the international deposit has effect and which is a Member of the WTO would be hindered from fulfilling its obligation to recognize the priority claim.

¹ According to Article 4A(2) of the Paris Convention, the right of priority also arises from a filing which, under bilateral or multilateral treaties concluded between countries of the Paris Union, is equivalent to a regular national filing. On this basis, the International Bureau records claims to priority resulting from applications filed with the Office for Harmonization in the Internal Market (Article 32 of the Community Trade Mark Regulation refers).

7. It is therefore proposed that the International Bureau record a priority claim not only where the earlier filing was effected in a country party to the Paris Convention but also where it was effected in a Member of the WTO. In view of the fact that most of the Members of the WTO that are not yet bound by Article 2.1 of the TRIPS Agreement will become bound by that Article on January 1, 2000, it is proposed that such change in practice become effective on that date.

8. It should be noted that this change in the practice of the International Bureau will not oblige a Member of the Madrid Union that is not a Member of the WTO to recognize the effects of a priority claim based on an application filed in a Member of the WTO that is not party to the Paris Convention.

9. The Assembly of the Madrid Union is invited to approve the proposal contained in paragraph 7, above.

[Annex follows]

ANNEX

PROVISIONS OF THE MADRID AGREEMENT, THE MADRID PROTOCOL AND THE
COMMON REGULATIONS THAT CONCERN PRIORITY

Article 4(2) of the Madrid Agreement

Every mark which has been the subject of an international registration shall enjoy the right of priority provided for by Article 4 of the Paris Convention for the Protection of Industrial Property, without requiring compliance with the formalities prescribed in Section D of that Article.

Article 4(2) of the Madrid Protocol

Every international registration shall enjoy the right of priority provided for by Article 4 of the Paris Convention for the Protection of Industrial Property, without it being necessary to comply with the formalities prescribed in Section D of that Article.

Rule 9(4)(a)

Subject to paragraphs (5), (6) and (7), the international application shall contain or indicate

[...]

(iv) where the applicant wishes, under the Paris Convention for the Protection of Industrial Property, to take advantage of the priority of an earlier filing, a declaration claiming the priority of that earlier filing, together with an indication of the name of the Office where such filing was made and of the date and, where available, the number of that filing, and, where the priority claim relates to less than all the goods and services listed in the international application, the indication of those goods and services to which the priority claim relates,

[...]

[End of Annex and of document]