

WIPO



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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

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

ASSEMBLY

**Thirty-Fifth (15th Ordinary) Session
Geneva, September 22 to October 1, 2003**

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/39/1): 1, 2, 3, 4, 5, 7, 9, 14, 18, 23, 25 and 26.
2. The report on the said items, with the exception of item 14, is contained in the General Report (A/39/15).
3. The report on item 14, is contained in the present document.
4. Mr. Miklós Bendzsel (Hungary) was elected Chair of the Assembly; Mr. Li Dongsheng (China) and Mrs. María de los Angeles Sánchez Torres (Cuba) were elected Vice-Chairs.
5. In the absence of Mr. Miklós Bendzsel (Hungary) Chair of the Assembly, Mr. Li Dongsheng, Vice-Chair (China) presided over the meeting of the Assembly and Mrs. María de los Angeles Sánchez Torres, Vice-Chair (Cuba) presided over the adoption of the Report.

ITEM 14 OF THE CONSOLIDATED AGENDA:

MATTERS CONCERNING THE MADRID UNION

Proposed Amendments to the Common Regulations Under the Madrid Agreement and Protocol

6. Discussions were based on document MM/A/35/1.
7. The Chair welcomed those countries which had joined the Madrid system since the last session of the Assembly in 2002, namely (in chronological order): Republic of Korea, United States of America and Cyprus. He further noted that, during the same period, Albania, which was already party to the Madrid Agreement, had also acceded to the Protocol and that the Netherlands had extended the geographical coverage of the Protocol to the Netherlands Antilles. As a result, the Madrid system now comprised 73 Members, of which 60 were party to the Protocol.
8. The Delegation of Italy made the following statement: “The European Community and its Member States, as well as the acceding States, are pleased to confirm that an agreement has been reached last week among EU Member States on the accession of the European Community to the Madrid Protocol. As regards the proposals made in document MM/A/35/1, the European Community and its Member States, as well as the acceding States, support the amendments to the Common Regulations related to the accession to the EC to the Madrid Protocol, as proposed by the International Bureau. The EU Member States, as well as the acceding States, also support the amendments related to the inclusion of Spanish as an additional language of the Madrid Protocol, as proposed by the International Bureau under Scenario A. Finally, the European Community and its Member States, as well as the acceding States, agree that all these amendments should enter into force on April 1, 2004. The delegation of Italy also added that it was not a coincidence if that accession had been made possible under the Italian presidency.
9. The Delegation of Germany supported the intervention made by the Italian delegation concerning the amendments to the Common Regulations. It expressed its gratitude for the consultations held by the Director General and his team with Member States and warmly thanked the Italian and the Spanish delegations for their fruitful cooperation. It also proposed two minor editorial changes in the English version of these amendments, namely that the word “from” be replaced by the word “for” in Rule 14(2)(vi), and that the word “direct” be replaced by the word “directly” in Rule 40(4).
10. The Delegation of Morocco expressed its support for Scenario A regarding the inclusion of Spanish as an additional language of the Madrid system.
11. The Delegation of Monaco stated that it also favored Scenario A with regard to the modification of the language regime of the Madrid system.
12. The Delegation of Costa Rica, speaking on behalf of the Group of Latin American and Caribbean Countries (GRULAC), pointed out that the countries in its Group had been following with great interest recent developments in the Madrid system. The Latin American and Caribbean region had enormous human and technical resources at its disposal and

inventive and innovative capacities, which represented a solid foundation for protection and development. In this context, the availability for use in the Madrid system of a language spoken by more than 300 million people was essential. The Group was therefore firmly in favor of the inclusion of Spanish in the Madrid system and expressed its preference for Scenario B which would put English, French and Spanish on the same footing.

13. The Delegation of China stated that it endorsed the support which had been expressed by other delegations for the proposed amendments to the Common Regulations, including the inclusion of Spanish under Scenario A, on the understanding that Offices of Contracting Parties would continue to have the possibility of indicating their preferred working language or languages.

14. Recalling the vital importance of the inclusion of Spanish in the Madrid system, in terms of it being an important stimulus for accession to the Madrid system by countries of the Latin American region, the Delegation of Cuba expressed its support to the declaration made by the representative of GRULAC which favored the adoption of Scenario B.

15. The Delegation of Switzerland stated that it supported the amendments to the Common Regulations and specified that, with the aim of encouraging a larger membership of the Madrid system, it favored the introduction of Spanish in the Madrid system under Scenario A.

16. The Delegation of Japan said that the accession of the European Community would bring about an enlargement of the scope for designations under the Madrid system and that it favored Scenario A regarding the inclusion of Spanish, given that such scenario would be less burdensome for the International Bureau to implement.

17. The Delegation of the Islamic Republic of Iran said that it was pleased to inform the Assembly that the Iranian Parliament had approved its country's accession to the Madrid Agreement and to the Madrid Protocol. The instruments of accession were ready and would be shortly submitted to the Director General. The delegation was confident that, with the necessary assistance from WIPO in terms of technical and legal training, implementation of the Madrid system in its country would take place as smoothly as possible.

18. The Delegation of the United States of America supported the amendments to the Common Regulations, noting that these amendments would facilitate the accession of the European Community to the Madrid Protocol, and expressed its preference for Scenario A with regard to the inclusion of Spanish under the Madrid system.

19. The Delegation of the European Commission noted the historic importance of the European Community acceding, for the first time, to a WIPO administered treaty and stated that the European Commission would use its full endeavors to bring about such accession, which was foreseen within one year. It also underlined the importance of Spanish in the global economy and expressed support for the inclusion of Spanish in the Madrid system in accordance with Scenario A.

20. The Director General noted that consensus was emerging on the proposals that had been submitted to the Assembly for decision and enquired whether the Group of Latin American and Caribbean Countries in the Madrid Union might be in a position to agree to Scenario A for the inclusion of Spanish into the Madrid system.

21. The Delegation of Costa Rica, speaking on behalf of the Group of Latin American and Caribbean Countries, said that the delegations on behalf of which it spoke could join the consensus and agree to the inclusion of Spanish into the Madrid system on the basis of Scenario A.

22. The Assembly:

(i) adopted the amendments to the Common Regulations in respect of Rules 9(5)(g), 14(2)(vi), 21*bis*, 24, 32(1)(a)(v) and (xi) and 36(viii), as proposed in Annex I of document MM/A/35/1, with the editorial corrections in the English version of Rule 14(2)(vi) and Rule 40(4) as indicated in paragraph 9, above;

(ii) decided that, in respect of Rules 6, 7(2), 9(4)(b)(iii) and 40(4), Scenario A has been chosen and adopted the corresponding amendments to these provisions, as proposed in Annex I of document MM/A/35/1; and

(iii) decided that all these amendments should enter into force on April 1, 2004.

23. Rules 6, 7(2), 9(4)(b)(iii), 9(5)(g), 14(2)(vi), 21*bis*, 24, 32(1)(a)(v) and (xi), 36(viii) and 40(4), as amended by the Assembly with effect from April 1, 2004, are reproduced in the Annex to this report.

[Annex follows]

ANNEX

RULES 6, 7(2), 9(4)(b)(iii), 9(5)(g), 14(2)(vi), 21*bis*, 24, 32(1)(a)(v) and (xi), 36(viii) and 40(4) OF THE COMMON REGULATIONS UNDER THE MADRID AGREEMENT AND PROTOCOL, AS AMENDED WITH EFFECT FROM APRIL 1, 2004

Rule 6
Languages

(1) [*International Application*] (a) An international application governed exclusively by the Agreement shall be in French.

(b) An international application governed exclusively by the Protocol or governed by both the Agreement and the Protocol shall be in English, French or Spanish according to what is prescribed by the Office of origin, it being understood that the Office of origin may allow applicants to choose between English, French and Spanish.

(2) [*Communications Other Than the International Application*] (a) Any communication concerning an international application governed exclusively by the Agreement or the international registration resulting therefrom shall, subject to Rule 17(2)(v) and (3), be in French, except that, where the international registration resulting from an international application governed exclusively by the Agreement is or has been the subject of a subsequent designation under the Protocol, the provisions of subparagraph (b) shall apply.

(b) Any communication concerning an international application governed exclusively by the Protocol or governed by both the Agreement and the Protocol, or the international registration resulting therefrom, shall, subject to Rule 17(2)(v) and (3), be

(i) in English, French or Spanish where such communication is addressed to the International Bureau by the applicant or holder, or by an Office;

(ii) in the language applicable under Rule 7(2) where the communication consists of the declaration of intention to use the mark annexed to the international application under Rule 9(5)(f) or to the subsequent designation under Rule 24(3)(b)(i);

(iii) in the language of the international application where the communication is a notification addressed by the International Bureau to an Office, unless that Office has notified the International Bureau that any such notifications are to be in English, in French or in Spanish; where the notification addressed by the International Bureau concerns the recording in the International Register of an international registration, the notification shall indicate the language in which the relevant international application was received by the International Bureau;

(iv) in the language of the international application where the communication is a notification addressed by the International Bureau to the applicant or holder, unless that applicant or holder has expressed the wish that all such notifications are to be in English, or in French or in Spanish.

(3) *[Recording and Publication]* (a) Where the international application is governed exclusively by the Agreement, the recording in the International Register and the publication in the Gazette of the international registration resulting therefrom and of any data to be both recorded and published under these Regulations in respect of that international registration shall be in French.

(b) Where the international application is governed exclusively by the Protocol or is governed by both the Agreement and the Protocol, the recording in the International Register and the publication in the Gazette of the international registration resulting therefrom and of any data to be both recorded and published under these Regulations in respect of that international registration shall be in English, French and Spanish. The recording and publication of the international registration shall indicate the language in which the international application was received by the International Bureau.

(c) Where a first subsequent designation is made under the Protocol in respect of an international registration that has been published only in French, or only in English and French, the International Bureau shall, together with the publication in the Gazette of that subsequent designation, either publish the international registration in English and Spanish and republish the international registration in French, or publish the international registration in Spanish and republish it in English and French, as the case may be. That subsequent designation shall be recorded in the International Register in English, French and Spanish. Thereafter, the recording in the International Register and the publication in the Gazette of any data to be both recorded and published under these Regulations in respect of the international registration concerned shall be in English, French and Spanish.

(4) *[Translation]* (a) The translations needed for the notifications under paragraph (2)(b)(iii) and (iv), and recordings and publications under paragraph (3)(b) and (c), shall be made by the International Bureau. The applicant or the holder, as the case may be, may annex to the international application, or to a request for the recording of a subsequent designation or of a change, a proposed translation of any text matter contained in the international application or the request. If the proposed translation is not considered by the International Bureau to be correct, it shall be corrected by the International Bureau after having invited the applicant or the holder to make, within one month from the invitation, observations on the proposed corrections.

(b) Notwithstanding subparagraph (a), the International Bureau shall not translate the mark. Where, in accordance with Rule 9(4)(b)(iii) or Rule 24(3)(c), the applicant or the holder gives a translation or translations of the mark, the International Bureau shall not check the correctness of any such translations.

Rule 7 *Notification of Certain Special Requirements*

[...]

(2) *[Intention to Use the Mark]* Where a Contracting Party requires, as a Contracting Party designated under the Protocol, a declaration of intention to use the mark, it shall notify that requirement to the Director General. Where that Contracting Party requires the declaration to be signed by the applicant himself and to be made on a separate official form annexed to the international application, the notification shall contain a statement to that effect and shall specify

the exact wording of the required declaration. Where the Contracting Party further requires the declaration to be in English, French or Spanish, the notification shall specify the required language.

[...]

Rule 9
Requirements Concerning the International Application

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

[...]

(b) The international application may also contain,

[...]

(iii) where the mark consists of or contains a word or words that can be translated, a translation of that word or those words into French if the international application is governed exclusively by the Agreement, or into English, French and/or Spanish if the international application is governed exclusively by the Protocol or is governed by both the Agreement and the Protocol;

(5) *[Additional Contents of an International Application]*

[...]

(g) Where an international application contains the designation of a Contracting Organization, it may also contain the following indications:

(i) where the applicant wishes to claim, under the law of that Contracting Organization, the seniority of one or more earlier marks registered in, or for, a Member State of that Organization, a declaration to that effect, stating the Member State or Member States in or for which the earlier mark is registered, the date from which the relevant registration was effective, the number of the relevant registration and the goods and services for which the earlier mark is registered. Such indications shall be on an official form to be annexed to the international application;

(ii) where, under the law of that Contracting Organization, the applicant is required to indicate a second working language before the Office of that Contracting Organization, in addition to the language of the international application, an indication of that second language.

Rule 14
Registration of the Mark in the International Register

(2) *[Contents of the Registration]* The international registration shall contain

[...]

(vi) indications annexed to the international application in accordance with Rule 9(5)(g)(i) concerning the Member State or Member States in or for which an earlier mark, for which seniority is claimed, is registered, the date from which the registration of that earlier mark was effective and the number of the relevant registration.

Rule 21bis
Other Facts Concerning Seniority Claim

(1) *[Final Refusal of Seniority Claim]* Where a claim of seniority has been recorded in the International Register in respect of the designation of a Contracting Organization, the Office of that Organization shall notify the International Bureau of any final decision refusing, in whole or in part, the validity of such claim.

(2) *[Seniority Claimed Subsequent to the International Registration]* Where the holder of an international registration designating a Contracting Organization has, under the law of such Contracting Organization, claimed directly with the Office of that Organization the seniority of one or more earlier marks registered in, or for, a Member State of that Organization, and where such claim has been accepted by the Office concerned, that Office shall notify that fact to the International Bureau. Such notification shall indicate:

(i) the number of the international registration concerned, and

(ii) the Member State or Member States in or for which the earlier mark is registered, together with the date from which the registration of that earlier mark was effective and the number of the relevant registration.

(3) *[Other Decisions Affecting Seniority Claim]* The Office of a Contracting Organization shall notify the International Bureau of any further final decision, including withdrawal and cancellation, affecting a claim to seniority which has been recorded in the International Register.

(4) *[Recording in the International Register]* The International Bureau shall record in the International Register the information notified under paragraphs (1) to (3).

Rule 24
Designation Subsequent to the International registration

(1) *[Entitlement]* (a) A Contracting Party may be the subject of a designation made subsequent to the international registration (hereinafter referred to as “subsequent designation” where, at the time of that designation, the holder fulfills the conditions, under Article 1(2) and 2 of the Agreement or under Article 2 of the Protocol, to be the holder of an international registration.

(b) Where the Contracting Party of the holder is bound by the Agreement, the holder may designate, under the Agreement, any Contracting Party that is bound by the Agreement.

(c) Where the Contracting Party of the holder is bound by the Protocol, the holder may designate, under the Protocol, any Contracting Party that is bound by the Protocol, provided that the said Contracting Parties are not both bound by the Agreement.

(2) *[Presentation; Form and Signature]* (a) A subsequent designation shall be presented to the International Bureau by the holder or by the Office of the Contracting Party of the holder; however,

(i) where Rule 7(1), as in force before October 4, 2001, applies, it must be presented by the Office of origin;

(ii) where any of the Contracting Parties are designated under the Agreement, the subsequent designation must be presented by the Office of the Contracting Party of the holder;

(iii) where paragraph (7) applies, the subsequent designation resulting from conversion must be presented by the Office of the Contracting Organization.

(b) The subsequent designation shall be presented on the official form in one copy. Where it is presented by the holder, it shall be signed by the holder. Where it is presented by an Office, it shall be signed by that Office and, where the Office so requires, also by the holder. Where it is presented by an Office and that Office, without requiring that the holder also sign it, allows that the holder also sign it, the holder may do so.

(3) *[Contents]* (a) Subject to paragraph (7)(b), the subsequent designation shall contain or indicate

(i) the number of the international registration concerned,

(ii) the name and address of the holder,

(iii) the Contracting Party that is designated,

(iv) where the subsequent designation is for all the goods and services listed in the international registration concerned, that fact, or, where the subsequent designation is for only part of the goods and services listed in the international registration concerned, those goods and services,

(v) the amount of the fees being paid and the method of payment, or instructions to debit the required amount of fees to an account opened with the International Bureau, and the identification of the party effecting the payment or giving the instructions, and,

(vi) where the subsequent designation is presented by an Office, the date on which it was received by that Office.

(b) Where the subsequent designation concerns a Contracting Party that has made a notification under Rule 7(2), that subsequent designation shall also contain a declaration of intention to use the mark in the territory of that Contracting Party; the declaration shall, as required by the said Contracting Party,

(i) be signed by the holder himself and be made on a separate official form annexed to the subsequent designation, or

(ii) be included in the subsequent designation.

(c) The subsequent designation may also contain

(i) the indications and translation or translations, as the case may be, referred to in Rule 9(4)(b),

(ii) a request that the subsequent designation take effect after the recording of a change or a cancellation in respect of the international registration concerned or after the renewal of the international registration,

(iii) where the subsequent designation concerns a Contracting Organization, the indications referred to in Rule 9(5)(g)(i), which shall be on a separate official form to be annexed to the subsequent designation, and in Rule 9(5)(g)(ii).

(d) Where the international registration is based on a basic application, a subsequent designation under the Agreement shall be accompanied by a declaration, signed by the Office of origin, certifying that the said application has resulted in a registration and indicating the date and number of that registration, unless such a declaration has already been received by the International Bureau.

(4) [*Fees*] The subsequent designation shall be subject to the payment of the fees specified or referred to in item 5 of the Schedule of Fees.

(5) [*Irregularities*] (a) If the subsequent designation does not comply with the applicable requirements, and subject to paragraph (10), the International Bureau shall notify that fact to the holder and, if the subsequent designation was presented by an Office, that Office.

(b) If the irregularity is not remedied within three months from the date of the notification of the irregularity by the International Bureau, the subsequent designation shall be considered abandoned, and the International Bureau shall notify accordingly and at the same time the holder and, if the subsequent designation was presented by an Office, that Office, and refund any fees paid, after deduction of an amount corresponding to one-half of the basic fee referred to in item 5.1 of the Schedule of Fees, to the party having paid those fees.

(c) Notwithstanding subparagraphs (a) and (b), where the requirements of paragraph (1)(b) or (c) are not complied with in respect of one or more of the designated Contracting Parties, the subsequent designation shall be deemed not to contain the designation of those Contracting Parties, and any complementary or individual fees already paid in respect of those Contracting Parties shall be reimbursed. Where the requirements of paragraph (1)(b) or (c) are complied with in respect of none of the designated Contracting Parties, subparagraph (b) shall apply.

(6) *[Date of Subsequent Designation]* (a) A subsequent designation presented by the holder direct to the International Bureau shall, subject to subparagraph (c)(i), bear the date of its receipt by the International Bureau.

(b) A subsequent designation presented to the International Bureau by an Office shall, subject to subparagraph (c)(i), (d) and (e), bear the date on which it was received by that Office, provided that the said designation has been received by the International Bureau within a period of two months from that date. If the subsequent designation has not been received by the International Bureau within that period, it shall, subject to subparagraph (c)(i), (d) and (e), bear the date of its receipt by the International Bureau.

(c) Where the subsequent designation does not comply with the applicable requirements and the irregularity is remedied within three months from the date of the notification referred to in paragraph (5)(a),

(i) the subsequent designation shall, where the irregularity concerns any of the requirements referred to in paragraph (3)(a)(i), (iii) and (iv) and (b)(i), bear the date on which that designation is put in order, unless the said designation was presented to the International Bureau by an Office and the irregularity is remedied within the period of two months referred to in subparagraph (b); in the latter case, the subsequent designation shall bear the date on which it was received by the said Office;

(ii) the date applicable under subparagraph (a) or (b), as the case may be, shall not be affected by an irregularity concerning requirements other than those which are referred to in paragraph (3)(a)(i), (iii) and (iv) and (b)(i).

(d) Notwithstanding subparagraphs (a), (b) and (c), where the subsequent designation contains a request made in accordance with paragraph (3)(c)(ii), it may bear a date which is later than that resulting from subparagraph (a), (b) or (c).

(e) Where a subsequent designation results from conversion in accordance with paragraph (7), that subsequent designation shall bear the date on which the designation of the Contracting Organization was recorded in the International Register.

(7) *[Subsequent Designation Resulting From Conversion]* (a) Where the designation of a Contracting Organization has been recorded in the International Register and to the extent that such designation has been withdrawn, refused or has ceased to have effect under the law of that Organization, the holder of the international registration concerned may request the conversion of the designation of the said Contracting Organization into the designation of any Member State of that Organization which is party to the Agreement and/or the Protocol.

(b) A request for conversion under subparagraph (a) shall indicate the elements referred to in paragraph (3)(a)(i) to (iii) and (v), together with:

(i) the Contracting Organization whose designation is to be converted,
and

(ii) where the subsequent designation of a Contracting State resulting from conversion is for all the goods and services listed in respect of the designation of the Contracting Organization, that fact, or, where the designation of that Contracting State is for only part of the goods and services listed in the designation of that Contracting Organization, those goods and services.

(8) *[Recording and Notification]* Where the International Bureau finds that the subsequent designation conforms to the applicable requirements, it shall record it in the International Register and shall notify accordingly the Office of the Contracting Party that has been designated in the subsequent designation and at the same time inform the holder and, if the subsequent designation was presented by an Office, that Office.

(9) *[Refusal]* Rules 16 to 18 shall apply *mutatis mutandis*.

(10) *[Subsequent Designation Not Considered as Such]* If the requirements of paragraph (2)(a) are not complied with, the subsequent designation shall not be considered as such and the International Bureau shall inform the sender accordingly.

Rule 32
Gazette

(1) *[Information Concerning International Registrations]* (a) The International Bureau shall publish in the Gazette relevant data concerning

[...]

(v) subsequent designations recorded under Rule 24(8);

[...]

(xi) information recorded under Rules 20, 20*bis*, 21, 21*bis*, 22(2)(a), 23, 27(3) and (4) and 40(3);

Rule 36
Exemption From Fees

Recording of the following shall be exempt from fees:

[...]

(viii) any refusal under Rule 17, Rule 24(9) or Rule 28(3), any statement under Rule 17(5) or (6) or any declaration under Rule 20*bis*(5) or Rule 27(4) or (5),

[...]

Rule 40
Entry into Force; Transitional Provisions

[...]

(4) *[Transitional Provisions Concerning Languages]* Rule 6 as in force before April 1, 2004 shall continue to apply to any international application which was received, or in accordance with Rule 11(1)(a) or (c) is deemed to have been received, by the Office of origin before that date, to any international registration resulting therefrom and to any communication relating thereto. Rule 6 as in force before April 1, 2004 shall cease to apply where a subsequent designation under the Protocol is filed directly with the International Bureau or is filed with the Office of the Contracting Party of the holder on or after that date, provided that the subsequent designation is recorded in the International Register.

[End of Annex and of document]