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MATTERS CONCERNING THE MADRID UNION: REGULATIONS

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INTRODUCTION

1. Under Article 10(2)(a)(iii) of the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as “the Agreement”) and Article 10(2)(iii) of the Protocol Relating to that Agreement (hereinafter referred to as “the Protocol”), the Assembly of the Madrid Union may “modify the Regulations” or “modify the provisions of the Regulations concerning the implementation of the Protocol,” respectively. It is recalled that, on January 18, 1996, the Assembly of the Madrid Union adopted Common Regulations under the Agreement and the Protocol (hereinafter referred to as “the Common Regulations”).
2. The present document consists of two Parts and 14 Annexes. Part I and Annexes I to XII contain proposals to amend a number of Rules under the heading “Various Amendments”, whereas Part II and Annexes XIII and XIV contain proposals to amend certain Rules and to add two new Rules.

PART I: VARIOUS AMENDMENTS

Languages: First Subsequent Designation Under the Protocol (Annex I)

3. Under Rule 6(2)(a) of the Common Regulations, any communication concerning an international application governed exclusively by the Agreement, or the international registration resulting therefrom, must, subject to Rule 17(2)(v) and (3), be in French. An exception is, however, provided for where the international registration *has been* the subject of a subsequent designation under the Protocol; in that case subparagraph (b) of Rule 6(2) applies, that is, any communication may be in English or French. Yet, Rule 6(2)(a) as currently drafted implies that this exception comes into operation only after a first subsequent designation has been made under the Protocol—in other words, that the subsequent designation itself must be in French. The proposed amendment would make clear that the first subsequent designation under the Protocol may itself be in English or French.
4. Rule 6(3)(c) provides that, when a first subsequent designation made under the Protocol is published in the Gazette, the international registration concerned is published in English and republished in French. However, Rule 6(3) makes no provision concerning the languages in which that subsequent designation should be recorded and in which any further modification in respect of the international registration concerned should be recorded and published. It is therefore proposed to amend Rule 6(3)(c) so as to provide for the recordal of the first subsequent designation under the Protocol, as well as for the recordal and publication of any further modification, to be in both English and French.

Claim for Color and Description of the Mark by Words (Annex II)

5. Rule 9(4)(a)(vii) refers to the indications that an international application should contain where color is claimed as a distinctive feature of the mark in accordance with Article 3(3) of the Agreement or of the Protocol. Since the Rule does not specify that color must be claimed in the international application if it is claimed in the basic application or basic registration, the applicant could obtain a broader protection from the international registration than from the basic

registration or the registration resulting from the basic application. It is therefore proposed that Rule 9(4)(a)(vii) specify that, where the basic registration or basic application contains a claim for color, the same claim must be contained in the international application. On the other hand, where color is not claimed in the basic registration or basic application, the applicant could retain the option to claim or not to claim color as a distinctive feature of the mark.

6. The proposed change to Rule 9(4)(a)(vii) would entail changes to Rule 9(5)(b)(v) and (6)(b)(v) in order to specify that, where color has been claimed in the basic registration or basic application, the declaration by the Office of origin must certify that the same claim is included in the international application.

7. Under the current text of Rule 9(4)(a)(xi), where the basic application or the basic registration contains a description of the mark by words, the same description must be contained in the international application. Where the description contains information which is not apparent from the reproduction of the mark, its inclusion in the international application may be indispensable. Where however the description simply describes the reproduction of the mark, and was included in the basic application or basic registration for the sole reason that this is a formal requirement in the Office of origin, the applicant may take the view that the description would serve no useful purpose with regard to the international registration. In the latter case, the inclusion of a description in the international application only results in unnecessary extra costs, in terms of translation and publication, for the International Bureau and ultimately for the users of the system.

8. It is therefore proposed that the applicant should be free to choose whether or not to include a description of the mark in the international application. However, where such a description is included in the international application, the requirement that it be the same as the one included in the basic registration or basic application would remain.

Irregularities Which Affect the Date of the International Registration (Annex III)

9. Under Rule 15(1)(a)(ii), failure to indicate explicitly whether the applicant has an establishment in, is domiciled in, or is a national of, the Contracting Party whose Office is the Office of origin, may affect the date of the international registration. The proposed amendment to Rule 15(1)(a)(ii) would relax this requirement so that, where the applicant appears *prima facie* entitled to file an international application through the Office of a given Contracting Party (for example, where his address is in that Contracting Party), the absence of specific indications as to establishment, domicile or nationality would not affect the date of the international registration. Their absence would however still constitute an irregularity (not affecting the date of international registration) under Rule 11(4)(a)(iii).

10. The further amendments to Rule 15(1)(a) involve replacing the cross-references to the provisions of Rule 9(5)(a) and (6)(a) by references to the subject-matter of those provisions. The aim is simply to make the text more user-friendly.

Content of a Notification of Refusal Not Based on an Opposition (Annex IV)

11. Rule 17(2)(iii) currently requires that a notification of refusal contain the name of the holder. The purpose is to confirm the identity of the international registration to which the notification of refusal refers by number. However, there may be a discrepancy in a notification of refusal between the name of the holder and the number of the international registration, for example, where there has been a change in ownership or a change in the name of the holder of which the Office concerned was not aware at the time it issued the notification of refusal. It is therefore believed that the indication of the name of the holder is not the most appropriate information that can be provided for this purpose. Instead, it is proposed that the Offices be encouraged to give some other indication permitting the identity of the international registration to be confirmed, such as verbal elements of the mark or the number of the basic application or basic registration. The absence of such additional indication would not however render a notification of refusal irregular.

Rectification of Irregular Refusals (Annex V)

12. Rule 18(1)(c) provides that, where the International Bureau finds that a notification of refusal is irregular, it shall invite the Office that sent it to rectify it within a period of two months. It further provides that, if the notification is so rectified, the rectified notification shall be regarded as having been sent to the International Bureau on the date on which the original (irregular) notification had been sent. The purpose of this latter provision is to ensure that, where a notification which was sent within the period of one year referred to in Article 5(2) of the Agreement and Article 5(2)(a) of the Protocol (or, where applicable, the longer periods referred to in Article 5(2)(b) and (c) of the Protocol) is rectified after the end of that period (but within the two months deadline specified in this Rule), it is nonetheless regarded as having been sent within that period.

13. It is proposed that the Rule should state explicitly that it is for this purpose only that the notification is regarded as having been sent on the earlier date. One reason for this change is that the Office concerned may have indicated a time limit for lodging a request for review or an appeal which is counted from the date of the original (irregular) refusal. Much (or even all) of this time limit may have expired by the time the holder receives the rectified notification of refusal. The amendment referred to above has the effect that, for purposes *other than* Article 5(2) of the Agreement and the Protocol, the rectified notification is regarded as bearing the date on which it was actually sent. Moreover, it is proposed that Rule 18(1) should also specify that, in such a case, the Office concerned should set a new time limit for requesting review or appeal. Finally, it is proposed that the Rule should refer to the International Bureau transmitting copies of the rectified notification *or the rectification*; this addition is to cover the case where an Office, instead of sending a new (rectified) notification to the International Bureau, simply sends an element that had been missing (such as a copy of an earlier mark cited in the refusal).

14. The opportunity has also been taken to divide Rule 18(1)(c) into three subparagraphs in order to make it easier to read. This has necessitated a minor amendment to Rule 17(4)(a).

Restriction of the Holder's Right of Disposal (Annex VI)

15. Rule 20(1) provides that the Office of a designated Contracting Party may inform the International Bureau that the holder's right of disposal has been restricted in respect of the international registration in the territory of that Contracting Party. This restriction may, for example, result from the fact that the extension of the international registration in that Contracting Party has been given as security, or is the subject of a right *in rem*, or there has been a court order (for example, relating to bankruptcy) concerning the disposal of the holder's assets.

16. From time to time, the International Bureau receives requests to record in the International Register restrictions concerning the holder's right of disposal of the international registration *per se*, arising out of legal proceedings or an agreement with a third party in the country of the holder. At present, the International Bureau has no power to record such a matter. However, even though the international registration may have no effect in that country, it is an asset of a person based in that country. It seems reasonable that, for the information of the public, it should be possible to record in the International Register a restriction on the holder's right to dispose of the international registration. Accordingly, it is proposed that Rule 20(1) should be amended to allow the Office of origin or another interested Office to submit such information to the International Bureau.

Subsequent Designation; Information on the Registration Resulting from a Basic Application (Annex VII)

17. Where an international application governed exclusively by the Protocol is based on a basic application, a subsequent designation under the Agreement may be made only after that application has resulted in a registration. In order to implement this principle, Rule 24(1)(c) currently provides that, in such a case, the subsequent designation may be recorded only if the International Bureau has already received and recorded relevant data (contained in a declaration to be sent by the Office of origin, at the request of the holder) relating to the registration resulting from the basic application.

18. What, in effect, is of importance is not that the International Bureau has received and recorded a declaration by the Office of origin that the basic application has resulted in a registration, but the fact that the basic application has resulted in a registration. Besides, there seems to be no reason to require that the declaration by the Office of origin be made at the request of the holder of the international registration. It is therefore proposed to modify Rule 24 accordingly. Only the condition that the basic application has resulted in a registration would be retained in Rule 24(1)(c) while provisions relating to the declaration would be made the subject of a separate subparagraph (d) of paragraph (3) of Rule 24 (which deals with the contents of a subsequent designation).

19. Under the proposed Rule 24(3)(d), the declaration might be submitted together with a subsequent designation and should not necessarily have been received and recorded by the International Bureau before the subsequent designation is made. Alternatively, the declaration might be sent beforehand by the Office of origin or (provided it is signed by the Office of origin) by the holder. Of course, if the declaration has already been submitted in connection with an earlier subsequent designation, it is then not necessary to submit it again for a further subsequent designation.

20. As regards the content of the declaration itself, only the date and number of the registration resulting from the basic application must be given. The list of goods and services should not be required because, if the registration resulting from the basic application covers fewer goods and services than the basic application (because of a partial refusal or partial withdrawal), a notification to that effect should have been sent by the Office of origin to the International Bureau under Rule 22.

Date of Subsequent Designation (Annex VII)

21. Under Rule 24(6)(b), a subsequent designation which is presented to the International Bureau through an Office bears the date on which it is received by that Office (provided that it is received by the International Bureau within two months of that date and that it does not contain irregularities which affect the date). In general, the possibility of being accorded an earlier date will be of advantage to the holders of international registrations. In certain circumstances however (subsequent designation presented through an Office shortly before renewal of the relevant international registration is due, or subsequent designation presented at the same time as a request for recordal of a change under Rule 25), this possibility can cause complications.

22. In order to avoid the problems mentioned in the preceding paragraph, it is proposed that a subsequent designation may contain a request that it take effect after some other specified event, namely, recordal of a change, recordal of a cancellation, or renewal. This is the subject of the proposed amendment to Rule 24(3)(c) and of the proposed new Rule 24(6)(d). (See also Date of Recordal of a Change or Cancellation in paragraphs 24 and 25, below.)

Change in Name or Address of Representative (Annex VIII)

23. Rule 25(1)(a)(iv) currently requires an official form to be used for requesting the recordal of a change in the name or address of the representative. In contrast, it is not required to use an official form for the appointment of a representative in the first place. It is therefore proposed to amend Rule 25(1)(a)(iv) in order to remove this requirement. The International Bureau will nevertheless make available an unofficial form for this purpose, as it does for the appointment of a representative.

Date of Recordal of a Change or Cancellation (Annex IX)

24. It sometimes happens that a holder wishes the date of recordal of a change or cancellation to be linked with the recordal of another change, or of a subsequent designation or the renewal of the same international registration. For example, he may wish a limitation to be recorded after a partial change in ownership, or a renunciation to be recorded before the renewal of the international registration. Accordingly, a new provision, Rule 25(2)(c), is proposed in order to allow a request to this effect to be made, and it is proposed to amend Rule 27(1)(b) to allow the International Bureau to give effect to such a request.

25. The opportunity has also been taken to make clear that Rule 27(1)(b) deals with the effective date of the recordal of a change, and that it applies also to the recordal of a cancellation.

Information Concerning Recordal of a Change in Ownership (Annex X)

26. Rule 27(1)(a) provides that the holder is informed of the recordal of a change in the International Register. In the case of a total change in ownership (a transfer), the “holder” means the recorded holder, that is, the new holder (the transferee); in the case of a partial change in ownership, two recorded holders are concerned, namely, the new holder of the part of the international registration which has been assigned or otherwise transferred and which is the subject of a separate international registration, and the holder of the international registration a part of which has been assigned or otherwise transferred. It is proposed that, in the case of the recordal of a change in ownership, whether total or partial, both parties (the transferor and transferee) be informed of the recordal.

Merger of International Registrations (Annex XI)

27. A merger of international registrations can only result from a change in ownership and can only be recorded after the change in ownership has been recorded in the International Register; in other words, a request for merger cannot replace a request for the recordal of a change in ownership. In order to make this clear, it is proposed to replace, in the second line of Rule 27(3), the word “becomes” by the words “has been recorded as.” It is recalled that a request for the recordal of a merger (which does not require the use of an official form) is free of charge.

28. As currently drafted, the reference to Rule 25 in Rule 27(3) means that the provisions governing the presentation of a request for recordal of a change (Rule 25(1)(b)) apply to requests for recordal of a merger; in other words, it must be presented to the International Bureau by the Office of origin or another interested Office where the merger affects any Contracting Party designated under the Agreement. Since the request for merger can only follow from a request for a change in ownership, which itself must be presented by the Office of origin or another interested Office where the change affects a Contracting Party designated under the Agreement, this seems an unnecessary requirement as regards the request for merger. It is therefore proposed to allow, in all cases, the holder to present a request for the recordal of a merger either direct or through an Office. Accordingly, it is proposed to delete the reference to Rule 25. Moreover, since the result is that there are no formal requirements that a request for recordal of a merger must comply with, it is proposed also to delete the reference to Rule 26 (which relates to irregularities in requests for recordal of a change).

Establishment of the Amount of Individual Fees in Swiss Currency (Annex XII)

29. Rule 35(2)(a) provides that, where a Contracting Party makes a declaration under Article 8(7)(a) of the Protocol that it wants to receive an individual fee, the amount of the individual fee indicated to the International Bureau shall be expressed in the currency used by its Office. Rule 35(2)(b) provides that, where this fee is indicated in a currency other than Swiss

currency (the currency in which the individual fee must be paid), the Director General shall, after consultation with the Office of the Contracting Party concerned, establish the amount of the individual fee in Swiss currency on the basis of the official exchange rate of the United Nations.

30. Rule 35(2)(c) and (d) provide for this latter amount to be changed in consequence of variations in the exchange rate between the currency concerned and Swiss currency. According to subparagraph (c), where, for more than 30 consecutive days, the exchange rate between the currency concerned and Swiss currency is higher or lower by at least 5% than the last exchange rate applied to establish the amount of the individual fee in Swiss currency, the Office of the Contracting Party concerned may ask the Director General to establish a new amount of the individual fee in Swiss currency. According to subparagraph (d), where, for more than 30 consecutive days, the exchange rate is higher or lower by at least 10% than the last exchange rate applied, the Director General is required, after consultation with the Office concerned, to establish a new amount of the individual fee in Swiss currency.

31. Since the Common Regulations were adopted in January 1996, the Swiss currency has fluctuated to a greater extent than had been foreseen against the currencies in which individual fees have been established. Although no Office has yet exercised the right, under Rule 35(2)(c), to ask the Director General to establish a new amount, the Director General has, in accordance with Rule 35(2)(d), on several occasions initiated the process of consultation concerning the establishment of a new amount. It has also happened that, after this consultation has been started (because the 10% threshold had been passed), the rate concerned has moved in the opposite direction and has fallen below the 5% threshold.

32. Frequent changes in the amounts of individual fees are inconvenient and confusing for the users. Accordingly, it is proposed to make two modifications to Rule 35(2)(c) and (d), with the aim of reducing the frequency of such changes.

33. Firstly, it is proposed that the reference to the exchange rate being higher or lower than a given threshold for 30 consecutive days be replaced by a reference to the rate being beyond this threshold for three consecutive months. This will have the effect of smoothing out temporary fluctuations in exchange rates.

34. Secondly, it is proposed that Rule 35(2)(d) should be amended so that the Director General will be required to initiate action leading to a change in the amount in Swiss currency of an individual fee only when this would entail a reduction in the amount concerned. Offices will retain the right, under Rule 35(2)(c), to ask the Director General to establish a new amount where this would entail an increase in the amount concerned.

35. Furthermore, experience has shown that consultation over the application of a new official exchange rate of the United Nations, as called for in Rule 35(2)(d), only results in delays in the introduction of new amounts of the individual fee and does not serve any substantive purpose. Since the application of the official exchange rate of the United Nations is a mere arithmetic operation, it is proposed to suppress the requirements for that consultation.

PART II: AMENDMENTS PROPOSED IN CONNECTION WITH THE EXPECTED
ACCESSION OF THE EUROPEAN COMMUNITY TO THE PROTOCOL

Background

36. Under Article 14(1)(b) of the Madrid Protocol, an intergovernmental organization which has a regional Office for the purposes of registering marks with effect in the territory of the organization may become party to the Protocol. The European Community is such an organization, and preparations for its accession to the Protocol are well advanced. The consequences of such accession will be that it will be possible to designate the European Community as such under the Protocol in an international registration (whether in the international application or subsequently), and that it will be possible to base an international application on a Community trademark or on an application for a Community trademark.

37. In addition to modifications to the European Community's own internal legislation, it is also necessary to make some changes to the Common Regulations to take into account certain specific features of the Community trademark system arising from its regional nature. The present document contains (in Annexes XIII and XIV) proposals of the International Bureau for such changes. These proposals were the subject of a preliminary exchange of views between the International Bureau, the European Commission and the Member States of the European Community in an informal meeting on June 12, 1997. The proposals are submitted to the Assembly at its September-October 1997 session in the expectation that accession by the European Community to the Protocol will take place before the next ordinary session of the Assembly. It is to be noted, however, that the said proposals are based on a draft of amendments to Council Regulation (EC) No. 40/94 of 20 December 1993 on the Community Trade Mark (document COM (96)372), which draft has not yet been approved by the Council of the European Union. Should the text eventually adopted by the Council render it necessary to amend the Common Regulations in any other way, further proposals will be made to the Assembly, an extraordinary session of which would be convened for that purpose as may be required.

Amendments to Rules 9(6) and 14(2), new Rule 21bis and amendments to Rules 24(3) and 32(1)(a)(xi) (Annex XIII)

38. The Regulation on the Community Trade Mark provides for the claiming of seniority from an earlier mark having effect in a Member State of the European Community. Such a claim may be made either within two months of filing an application for a Community trademark or after the registration of the Community trademark. The proposed modifications to the said Regulation provide for the possibility to claim seniority in the case of an international registration designating the European Community.

39. The proposed new subparagraph (e)(i) of Rule 9(6) provides for an applicant who designates the European Community and wishes to claim seniority from an earlier mark having effect in a Member State of the Community to include appropriate indications in his international application. The proposed new subparagraph (vi) of Rule 14(2) provides for certain of these indications to be included in the international registration. It follows from Rule 32(1)(a)(i) that those indications would be included in the publication of the international registration in the Gazette.

40. Paragraphs (1) and (2) of proposed new Rule 21*bis* deal with the case where seniority is claimed before the Office of the European Community after the international registration has become protected in the Community. They provide for the Office, once it is satisfied that the claim may be allowed, to notify certain relevant indications to the International Bureau, which will then record them in the International Register.

41. Paragraph (3) of new Rule 21*bis* provides for the Office to notify the International Bureau of any decision affecting information which has been recorded in the International Register concerning a claim to seniority, for example, where the Office has decided that a claim to seniority which accompanied the international application should not be allowed. Where however the Office takes a decision relating to the goods and services covered by a seniority claim, this would not be notified to the International Bureau, since such information is not recorded in the International Register.

42. The proposed amendment to Rule 32(1)(a)(xi) provides for information concerning a seniority claim which has been recorded to be published in the Gazette.

43. New subparagraph (e)(ii) of Rule 9(6) provides for the international application to contain an indication of a second language which the applicant accepts as a possible language of certain proceedings before the Office of the European Community, as provided for in the legislation governing the European Community trademark. If an international application designating the European Community does not contain this indication, it may subsequently be provided direct to the Office of the European Community. The purpose of the new provision is, by allowing the indication to be given in the international application, to facilitate the task of the applicant.

44. The proposed amendment to Rule 24(3)(c) provides in item (iii) for indications concerning a claim to seniority or a second language to be included in a subsequent designation of the European Community.

New Rule 24*bis* and amendment to Rule 32(1)(a)(v) (Annex XIV)

45. The background to the proposed new Rule 24*bis* is as follows. The Regulation on the Community Trade Mark provides for the conversion of a Community trademark, or a Community trademark application, into one or more national applications in Member States of the Community. Such conversion may take place where the Community trademark has ceased to have effect or the Community application has been refused or withdrawn. Each national application resulting from such conversion enjoys the date of filing of the Community application or trademark concerned, together with any priority or seniority which is applicable. When the European Community accedes to the Protocol, the said Regulation will make analogous provision for the conversion of a designation of the Community under the Madrid Protocol into one or more national applications. Such conversion will be possible where, and to the extent that, the designation of the Community has been refused or has ceased to have effect (that is, it has been invalidated or has been the subject of a limitation, renunciation or cancellation, or it has not been renewed). A national application resulting from such conversion will enjoy the same effective date as the original designation of the Community under the Protocol, together with any applicable priority or seniority. Such conversion into national applications would be governed by the internal legislation of the European Community and would take place entirely outside the framework of the Madrid Protocol and the Common Regulations.

46. In addition, however, the said Regulation will provide for the possibility of converting a designation of the Community effected under the Madrid Protocol through designations made, under the Madrid Agreement or the Madrid Protocol, of Community Member States that are party to the Madrid Agreement or the Madrid Protocol, as the case may be. This will enable a holder who finds it necessary to invoke the conversion provisions to continue to be able to enjoy the benefits of the international system. Complementary provision is however needed in the Common Regulations for allowing the International Bureau to receive requests for such conversion and for recording it in the International Register and publishing in the Gazette the designations resulting from conversion.

47. The role of the International Bureau will be limited to recording, notifying and publishing the designation resulting from conversion. The fact that that designation will have the same effect as if it had been recorded on the effective date of the designation of the European Community (and that it will also enjoy any applicable priority or seniority) is entirely a matter for the internal legislation of the European Community and, as the case may be, of its Member States.

48. The conversion of designations in the manner described above is not contemplated by the Protocol. It is something which is offered by the European Community, over and above the obligations which it will undertake on acceding to the Protocol, for the benefit of trademark owners who designate the European Community in international registrations.

Decisions invited: 49. The Assembly of the Madrid Union is invited

(i) to adopt the amendments of the Common Regulations appearing in Annexes I to XII of this document and to decide that those amendments will enter into force on January 1, 1998;

(ii) to adopt the amendments appearing in Annexes XIII and XIV of this document and to decide that those amendments will enter into force on the date on which the accession of the European Community to the Madrid Protocol becomes effective, on the understanding however that if, subsequent to the adoption of those amendments, changes to the Regulation on the European Community Trade Mark were to render it necessary to amend the Common Regulations in some other way, further proposals will be made to the Assembly, and that, as required, an extraordinary session of the Assembly will be convened by the Director General for that purpose.

[Annexes follow]

ANNEX I

PROPOSED AMENDMENTS TO RULE 6(2)(a) AND RULE 6(3)(c)

6(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 Rule 24(1)(b), the provisions of subparagraph (b) shall apply.

6(3)(c) If a subsequent designation made under Rule 24(1)(b) is the first subsequent designation made under that Rule in respect of a given international registration, the International Bureau shall, together with the publication in the Gazette of that subsequent designation, publish the international registration in English and republish the international registration in French. Thereafter, that subsequent designation shall be recorded in the International Register in English and French. The recordal 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 and French.

[Annex II follows]

ANNEX II

PROPOSED AMENDMENTS TO RULE 9(4)(a)(vii) AND (xi), RULE 9(5)(b)(v)
AND RULE 9(6)(b)(v)

9(4)(a) Subject to paragraphs (5), (6) and (7), the international application shall contain or indicate

...

(vii) ~~where, according to Article 3(3) of the Agreement or Article 3(3) of the Protocol, the applicant claims wishes to claim color as a distinctive feature of the mark, or where color is claimed in the basic application or the basic registration, an indication of that fact and an indication by words of the color or combination of colors claimed and, where the reproduction furnished under item (v) is in black and white, one reproduction of the mark in color,~~

...

(xi) where the basic application or the basic registration contains a description of the mark by words, ~~the~~ and the applicant wishes to include a description, that same description; where the said description is in a language other than the language of the international application, it shall be given in the language of the international application,

...

9(5)(b) The declaration referred to in subparagraph (a)(v) shall certify

...

(v) ~~that, if colors are claimed in the international application, the claim for color is the same as in the basic registration, where color is claimed in the basic registration, the same claim is included in the international application, and~~

...

9(6)(b) The declaration referred to in subparagraph (a)(vii) shall certify

...

(v) ~~that, if colors are claimed in the international application, the claim for color is the same as in the basic application or the basic registration, as the case may be, where color is claimed in the basic application or the basic registration, the same claim is included in the international application, and~~

...

[Annex III follows]

ANNEX III

PROPOSED AMENDMENTS TO RULE 15(1)(a)

15(1)(a) [*Irregular International Application*] (a) Where the international application received by the International Bureau does not contain all of the following elements:

- (i) indications allowing the identity of the applicant to be established and sufficient to contact the applicant or his representative, if any,
- (ii) ~~the indications referred to in Rule 9(5)(a)(i) or Rule 9(6)(a)(i) or (iii),~~ indications permitting the conclusion that the applicant is entitled to file an international application,
- (iii) ~~the indications referred to in Rule 9(5)(a)(iii) or Rule 9(6)(a)(v),~~ the Contracting Parties which are designated,
- (iv) ~~the indications referred to in Rule 9(5)(a)(iv) or Rule 9(6)(a)(vi),~~ the date and number of the basic application or basic registration, as the case may be,
- (v) the declaration of the Office of origin referred to in Rule 9(5)(a)(v) or Rule 9(6)(a)(vii),
- (vi) a reproduction of the mark,
- (vii) the indication of the goods and services for which registration of the mark is sought,

...

[Annex IV follows]

ANNEX IV

PROPOSED AMENDMENTS TO RULE 17(2)

17(2) *[Refusals Not Based on an Opposition]* Where the refusal of protection is not based on an opposition, the notification referred to in paragraph (1) shall contain or indicate

...

(ii) the number of the international registration, preferably accompanied by other indications enabling the identity of the international registration to be confirmed, such as the verbal elements of the mark or the basic application or basic registration number,

~~(iii) the name of the holder,~~

...

[Annex V follows]

ANNEX V

PROPOSED AMENDMENTS TO RULE 17(4)(a) AND RULE 18(1)(c)

17(4) [Recordal; Review or Appeal] (a) The International Bureau shall record the refusal in the International Register together with the data contained in the notification, with an indication of the date on which the notification of refusal was sent or is regarded under Rule 18(1)(~~e~~)(d) as having been sent to the International Bureau.

18(1)(c) If the notification of refusal

...

the International Bureau shall invite the Office which communicated the refusal to rectify its notification within two months from the invitation and shall transmit to the holder copies of the irregular notification of refusal and of the invitation sent to the Office concerned.

(d) If the notification is so rectified, ~~the rectified notification~~ it shall, for the purposes of Article 5(2) of the Agreement or Article 5(2)(a) to (c) of the Protocol, be regarded as having been sent to the International Bureau on the date on which the defective irregular notification had been sent to it. The Office which communicated the refusal shall, where the refusal may be subject to review or appeal, indicate the new time limit, reasonable under the circumstances, for lodging a request or appeal. The International Bureau shall transmit copies of the rectified notification, or the rectification, to the Office of origin, if that Office has informed the International Bureau that it wishes to receive such copies, and to the holder.

(e) If the notification is not so rectified, it shall not be regarded as a notification of refusal. ~~In the latter case, the~~ The International Bureau shall inform, at the same time, the holder and the Office that sent the notification that the notification of refusal is not regarded as such by the International Bureau, and shall indicate the reasons therefor.

[Annex VI follows]

ANNEX VI

PROPOSED AMENDMENTS TO RULE 20(1)

20(1) *[Communication of Information]* The Office of ~~any designated~~ a Contracting Party may inform the International Bureau that the holder's right of disposal has been restricted in respect of the international registration ~~in the territory of that Contracting Party~~. Such information, if given, shall consist of a summary statement of the main facts concerning the restriction.

[Annex VII follows]

ANNEX VII

PROPOSED AMENDMENTS TO RULE 24(1)(c), RULE 24(3) AND RULE 24(6)

24(1)(c) The holder of an international registration resulting from an international application governed exclusively by the Protocol may designate Contracting Parties bound by the Agreement, whether or not those Contracting Parties are bound also by the Protocol, provided that, at the time of that designation, the Contracting Party whose Office is the Office of origin is bound by the Agreement, or, where a change in ownership has been recorded, the Contracting Party, or at least one of the Contracting Parties, in respect of which the new holder fulfills the conditions to be the holder of an international registration, is bound by the Agreement, and provided that either the international registration is based on a basic registration, or, if it is based on a basic application, ~~and the said application resulted in a registration, the Office of origin has sent, at the request of the holder of the international registration, a declaration to the International Bureau certifying that fact and indicating the date of the registration and the list of goods and services included in that registration, and the International Bureau has recorded the contents of that declaration.~~

24(3)(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 recordal of a change or a cancellation in respect of the international registration concerned or after the renewal of the international registration.*

24(3)(d) Where the international registration is based on a basic application, the subsequent designation 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.

24(6)(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).

[Annex VIII follows]

* Rule 24(3)(c) is proposed to be further amended on page 2 of Annex XIII.

ANNEX VIII

PROPOSED AMENDMENTS TO RULE 25(1)(a)(iv)

25(1)(a) [*Presentation of the Request*] (a) A request for recordal shall be presented to the International Bureau on the relevant official form, in one copy, where the request relates to any of the following:

...

(iv) a change in the name or address of the holder ~~or of the representative~~;

...

[Annex IX follows]

ANNEX IX

PROPOSED AMENDMENTS TO RULE 25(2) AND RULE 27(1)(b)

25(2)(c) The request for recordal of a change or a cancellation may also contain a request that it be recorded before, or after, the recordal of another change or cancellation or a subsequent designation in respect of the international registration concerned or after the renewal of the international registration.

27(1)(b) The recordal of the change shall show the date of receipt by the International Bureau of the request complying with the applicable requirements. The change or the cancellation shall be recorded as of the date of receipt by the International Bureau of a request complying with the applicable requirements, except that, where a request has been made in accordance with Rule 25(2)(c), it may be recorded as of a later date.

[Annex X follows]

ANNEX X

PROPOSED AMENDMENTS TO RULE 27(1)(a)

27(1) *[Recordal and Notification of a Change or of a Cancellation]* (a) The International Bureau shall, provided that the request referred to in Rule 25(1)(a) is in order, promptly record the change or the cancellation in the International Register, shall notify accordingly the Offices of the designated Contracting Parties in which the change has effect or, in the case of a cancellation, the Offices of all the designated Contracting Parties, and shall inform at the same time the holder and, if the request was presented by an Office, that Office. Where the recordal relates to a change in ownership, the International Bureau shall also inform the former holder in the case of a total change in ownership and the holder of the part of the international registration which has been assigned or otherwise transferred in the case of a partial change in ownership. Where the request for the recordal of a cancellation was presented by the holder or an interested Office during the five-year period referred to in Article 6(3) of the Agreement and Article 6(3) of the Protocol, the International Bureau shall also inform the Office of origin.

[Annex XI follows]

ANNEX XI

PROPOSED AMENDMENTS TO RULE 27(3)

27(3) *[Recordal of Merger of International Registrations]* Where the same natural person or legal entity ~~becomes~~ has been recorded as the holder of two or more international registrations resulting from a partial change in ownership under paragraph (2), the registrations shall be merged at the request of the said person or entity, ~~and paragraph (1) and Rules 25 and 26 shall apply~~ *mutatis mutandis*. made either direct or through the Office of origin or another interested Office. The international registration resulting from the merger shall bear the number of the international registration of which a part had been assigned or otherwise transferred, together, where applicable, with a capital letter.

[Annex XII follows]

ANNEX XII

PROPOSED AMENDMENTS TO RULE 35(2)(c) AND (d)

35(2)(c) Where, for more than ~~30 consecutive days~~, three consecutive months, the official exchange rate of the United Nations between the Swiss currency and the other currency in which the amount of an individual fee has been indicated by a Contracting Party is higher or lower by at least 5% than the last exchange rate applied to establish the amount of the individual fee in Swiss currency, the Office of that Contracting Party may ask the Director General to establish a new amount of the individual fee in Swiss currency according to the official exchange rate of the United Nations prevailing on the day preceding the day on which the request is made. The Director General shall proceed accordingly. The new amount shall be applicable as from a date which shall be fixed by the Director General, provided that such date is between one and two months after the date of the publication of the said amount in the Gazette.

(d) Where, for more than ~~30 consecutive days~~, three consecutive months, the official exchange rate of the United Nations between the Swiss currency and the other currency in which the amount of an individual fee has been indicated by a Contracting Party is ~~higher or~~ lower by at least 10% than the last exchange rate applied to establish the amount of the individual fee in Swiss currency, the Director General shall, ~~after consultation with the Office of that Contracting Party~~, establish a new amount of the individual fee in Swiss currency according to the current official exchange rate of the United Nations ~~prevailing on the day preceding the day on which the consultation is initiated by the Director General~~. The new amount shall be applicable as from a date which shall be fixed by the Director General, provided that such date is between one and two months after the date of the publication of the said amount in the Gazette.

[Annex XIII follows]

ANNEX XIII

PROPOSED AMENDMENTS TO RULE 9(6) AND RULE 14(2), PROPOSED NEW
RULE 21*bis* AND PROPOSED AMENDMENTS TO RULE 24(3) AND RULE 32(1)(a)(xi)

9(6) *[Additional Contents of an International Application Governed Exclusively by the Protocol]*

...

(e) Where the international application contains the designation of a Contracting Organization, it may be accompanied by the following indications, which shall be on a separate official form annexed to the international application and shall be considered part of the designation of the Contracting Organization concerned:

(i) where the applicant wishes to claim, under the law of that Contracting Organization, the seniority of an earlier mark registered in, or for, a Member State of that Organization, a declaration to that effect, indicating the name of the State concerned, the date from which the registration of the earlier mark was effective, the number of the relevant registration and the goods and services for which the earlier mark is registered;

(ii) where the law of that Contracting Organization provides for the applicant to indicate a language of the Office of the Organization which the applicant accepts, in addition to the language of the international application, as a possible language of certain proceedings before that Office, an indication of that language.

14(2) *[Contents of the Registration]* The international registration shall contain

...

(vi) indications annexed to the international application in accordance with Rule 9(6)(e)(i) concerning the date and number of an earlier registration from which seniority is claimed and the State in, or for, which it is registered.

Rule 21bis

Claim to Seniority of Earlier Mark

(1) [Notification] Where, under the law of a designated Contracting Organization, the holder claims the seniority of an earlier mark registered in, or for, a Member State of that Organization, and the claim fulfills the requirements of the said law, the Office of that Organization shall notify the International Bureau accordingly. Such notification shall indicate

- (i) the number of the international registration concerned,
- (ii) the name of the State concerned,
- (iii) the number of the earlier registration from which seniority is claimed, and
- (iv) the date from which the earlier registration was effective in the State concerned.

(2) [Recordal] The International Bureau shall record any information notified under paragraph (1) in the International Register and shall inform the holder accordingly.

(3) [Decision Affecting Claim to Seniority] The Office of such a Contracting Organization shall notify the International Bureau of any decision affecting information recorded under Rule 14(2)(vi), Rule 24(7) or paragraph (2) above. The International Bureau shall modify the International Register accordingly and inform the holder.

24(3)(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 recordal of a change or a cancellation in respect of the international registration concerned or after the renewal of the international registration;*

(iii) the indications referred to in Rule 9(6)(e).

* Subparagraph (ii) is proposed in Annex VII.

32(1) *[Information Concerning International Registrations]* (a) The International Bureau shall publish in the Gazette relevant data concerning

...

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

...

[Annex XIV follows]

ANNEX XIV

PROPOSED NEW RULE 24BIS AND PROPOSED AMENDMENT TO RULE 32(1)(a)(v)

Rule 24bis

Conversion of the Designation of a Contracting Organization
into Designations of its Member States

(1) [Entitlement] A Contracting Organization may notify the Director General that, where a designation of that Organization has been recorded in the International Register, that designation may, to the extent that it has ceased to have effect, be converted into the designation of any Member State of that Organization, provided that

(i) that State is a party to the Protocol and the conditions under Rule 24(1)(b) to designate a Contracting State under the Protocol are fulfilled; or

(ii) that State is a party to the Agreement and the conditions under Rule 24(1)(c) to designate a Contracting State under the Agreement are fulfilled.

(2) [Presentation: Form and Signature] A request for conversion under paragraph (1) shall be presented to the International Bureau by the Office of the Contracting Organization.

(3) [Contents] The request shall contain or indicate

(i) the number of the international registration concerned,

(ii) the name and address of the holder,

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

(iv) the Contracting State whose designation results from the conversion,

(v) where the designation of that Contracting State is for all the goods and services listed in 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, and

(vi) 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.

(4) [Additional Contents: Fees; Irregularities; Refusal; Request Not Considered as Such] Rule 24(2)(b), (3)(b) and (c), (4), (5), (8) and (9) shall apply, mutatis mutandis.

(5) [Recordal and Notification] The designation shall be recorded in the International Register as of the date of receipt by the International Bureau of a request complying with the applicable requirements. The International Bureau shall notify accordingly the Office of the designated Contracting State and at the same time inform the holder and the Office that presented the request.

32(1) *[Information Concerning International Registrations]* (a) The International Bureau shall publish in the Gazette relevant data concerning

...

(v) ~~subsequent~~ designations recorded under Rules 24(7) and *24bis* (5);

...

[End of Annex XIV and of document]