

WIPO



MM/A/XXVIII/3

ORIGINAL: English

DATE: October 1, 1997

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

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

ASSEMBLY

Twenty-Eighth Session (12th Ordinary)
Geneva, September 22 to October 1, 1997

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document AB/XXXI/1 Prov.2): 1, 2, 3, 5, 6, 11, 21, 28, 29 and 30.
2. The report on the said items, with the exception of item 11, is contained in the General Report (document AB/XXXI/12).
3. The report on item 11 is contained in the present document.
4. Mr. Li-Feng Schrock (Germany), Chairman of the Assembly, presided over the meeting of the Assembly.

ITEM 11 OF THE CONSOLIDATED AGENDA:

MATTERS CONCERNING THE MADRID UNION

5. Discussions were based on documents MM/A/XXVIII/1 and 2.

Amendment of the Common Regulations Under the Madrid Agreement and Protocol

6. The Delegation of Luxembourg, speaking in the name of the European Community and its Member States, stated that it shared the objective of amending certain Rules of the Common Regulations, as proposed in document MM/A/XXVIII/1, in the light of experience and with the aim of simplifying the system. The Community and its Member States accepted the proposals in Part I of the document, with the exception of those relating to Rules 9, 18 and 20, with which certain Member States had difficulties. These could be considered at a future meeting, to which the International Bureau could submit proposals taking full account of the comments made during the current session of the Assembly or at a later stage. As for Part II of the document, relating to the future accession by the European Community to the Madrid Protocol, although the internal decision process of the Community was well advanced, certain sensitive issues had yet to be resolved, and a decision would be taken at the beginning of 1998 at the earliest. A discussion of these proposals seemed therefore to be premature; changes having an effect on the text could result from the decision-making process of the Community. The Delegation therefore proposed that Part II of the document be not discussed at the present meeting. An extraordinary session of the Assembly could be convened to discuss the proposals submitted by the International Bureau, revised as may be required.

7. The Delegation of Luxembourg, speaking on behalf of the three Benelux countries, also indicated that these countries were in the process of coordinating their ratification of the Madrid Protocol, and that it was expected that the Protocol would enter into force with respect to the Benelux during the first quarter of 1998.

8. The International Bureau welcomed this latter statement. On the other hand, it noted with regret and disquiet the problems inside the European Community concerning the link, and hoped that these could be rapidly resolved, in the interest of trademark owners wishing to combine the use of the Madrid and Community trademark systems; indeed, the establishment of such a link had been one of the main aims of the Protocol.

9. The Delegation of Germany recalled the importance of the link with the Community trademark, and thought that good progress was being made within the European Community. Turning to Part I of the document, the Delegation stated that it had problems with the proposals in Annex II, as far as they related to claims of color. One effect of these changes would be to allow an applicant to claim color in an international application even where no such claim was contained in the basic application or basic registration. The understanding of German jurisprudence was that this would result in the holder of an international registration having a broader protection than in the basic application or registration. It would be appreciated, therefore, if a decision on the proposed change of Rule 9 could be postponed and the matter given further consideration.

10. The Delegation of France recalled that its country would become bound by the Madrid Protocol on November 7, 1997. It appreciated that amendments to the Common Regulations were required; some of the proposals, however, raised technical issues which would have benefited from further consultations. The Delegation stated that it could not accept the proposal in Annex II to amend Rule 9 so that an applicant was not required to include in the international application a description of the mark which was present in the basic application or basic registration; such a change went against the principle that everything in the basic application or registration should be reflected in the international registration. The Delegation also had difficulty with the proposal, in Annex V of the document, to amend Rule 18 to require the Office of a designated Contracting Party to indicate a new period for requesting review or appeal when regularizing an irregular notification of refusal; this would cause a problem where the national law prescribed a fixed period to decide on a refusal or an opposition; this problem could be overcome by stating that a new time limit should be indicated if allowed by the deadlines prescribed by the legislation of the Contracting Party concerned; the Delegation of France also suggested that Rule 18(1)(c) stipulate that the International Bureau must invite without delay correction of the irregularity.

11. The Delegation of Italy said that it had the same difficulty as the Delegation of Germany regarding Rule 9. Furthermore, it stated that it could not accept the proposal, in Annex VI of the document, to amend Rule 20(1) to allow the Office of any Contracting Party (not just the Office of a designated Contracting Party or the Office of origin) to inform the International Bureau of a restriction in the holder's right of disposal. In addition, the Delegation would like paragraph (4) of Rule 20 to be deleted, to allow licenses to be recorded in the International Register.

12. The International Bureau noted the above comments, and agreed that the amendments in Annexes II, V and VI be postponed for discussion on a later occasion.

13. The Assembly adopted the amendments to the Common Regulations proposed in Annexes I, III, IV and VII to XII of document MM/A/XXVIII/1, and decided that they would enter into force on January 1, 1998. The amended provisions are reproduced in the Annex to this report.

Dissemination of Data

14. The Delegation of Germany thanked the International Bureau for the generous proposals contained in document MM/A/XXVIII/2, which would be welcomed by the business community. That delegation, therefore, fully supported the said proposals.

15. The Assembly approved the proposals contained in paragraph 15 of document MM/A/XXVIII/2.

[Annex follows]

ANNEX

RULES OF THE COMMON REGULATIONS UNDER THE MADRID AGREEMENT
AND PROTOCOL AMENDED BY THE ASSEMBLY OF THE MADRID UNION WITH
EFFECT FROM JANUARY 1, 1998

Rule 6
Languages

(1) [No change]

(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.

(b) [No change]

(3) [*Recordal and Publication*] (a) [No change]

(b) [No change]

(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.

(4) [No change]

Rule 15
Date of the International Registration
in Special Cases

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

(i) [No change]

(ii) indications permitting the conclusion that the applicant is entitled to file an international application,

- (iii) the Contracting Parties which are designated,
- (iv) 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) and (vii) [No change]

...

(b) [No change]

(2) [No change]

Rule 17
Notification of Refusal

(1) [No change]

(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

(i) [No change]

(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) [Deleted]

(iv) to (viii) [No change]

(3) to (5) [No change]

Rule 24
Designation Subsequent to the International Registration

(1) *[Entitlement]* (a) [No change]

(b) [No change]

(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, the said application resulted in a registration.

(2) [No change]

(3) [*Contents*] (a) [No change]

(b) [No change]

(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.

(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.

(4) and (5) [No change]

(6) [*Date of Subsequent Designation*] (a) [No change]

(b) and (c) [No change]

(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).

Rule 25

*Request for Recordal of a Change;
Request for Recordal of a Cancellation*

(1) *[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:

(i) to (iii) [No change]

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

(v) [No change]

(b) and (c) [No change]

(2) *[Contents of the Request]* (a) [No change]

(b) [No change]

(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.

(3) and (4) [No change]

Rule 27

*Recordal and Notification of a Change or of a Cancellation;
Declaration that a Change in Ownership has no Effect*

(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.

(b) 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.

(2) [No change]

(3) [*Recordal of Merger of International Registrations*] Where the same natural person or legal entity 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, 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.

(4) [No change]

Rule 35
Currency of Payments

(1) [No change]

(2) [*Establishment of the Amount of Individual Fees in Swiss Currency*] (a) [No change]

(b) [No change]

(c) Where, for more than 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 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 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 establish a new amount of the individual fee in Swiss currency according to the current official exchange rate of the United Nations. 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.

[End of Annex and of document]