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AD HOC WORKING GROUP ON THE LEGAL DEVELOPMENT OF THE MADRID SYSTEM FOR THE INTERNATIONAL REGISTRATION OF MARKS

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PROPOSED AMENDMENT OF ARTICLE 5 OF THE MADRID PROTOCOL

Document prepared by the International Bureau

INTRODUCTION

1. Article 5(2)(e) of the Madrid Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as “the Protocol”) provides that, upon the expiry of a period of 10 years from the entry into force of the Protocol (namely as from December 1, 2005), the Assembly shall examine the operation of the refusal procedure established by subparagraphs (a) to (d) of that Article, and that the provisions of such subparagraphs may be modified by a unanimous decision of the Assembly.

2. On the occasion of its first session in July 2005, the *ad hoc* Working Group on the Legal Development of the Madrid System for the International Registration of Marks (hereinafter referred to as “the Working Group”) considered the main features of the refusal procedure, as set out in document MM/LD/WG/1/2 (hereinafter referred to as “the working document”). The conclusions and recommendations of the Working Group are contained in document MM/LD/WG/1/3, comprising the Report adopted by the Working Group (hereinafter called “the Report”) at the conclusion of its first session and submitted to the Assembly of the Madrid Union (document MM/A/36/1) at its thirty-sixth session in September 2005.

3. The Working Group recommended that the following provisions of the Protocol should not be modified at this time:

- Article 5(2)(a) (the one year refusal period);
- Article 5(2)(b) (possibility of declaring the replacement of the one year period by a period of 18 months);
- Article 5(2)(c) [*chapeau*] (possibility of declaring, in case of refusal resulting from opposition, that refusals may be notified after 18 months);
- Article 5(2)(c)(i) (notification, before expiry of 18 months, of possibility of refusal after expiry of 18 months), and
- Article 5(2)(d) (the making and date of effect of declarations under Article 5(2)(b) or (c)).

4. On the other hand, the Working Group recommended, firstly, that Article 5(2)(c)(ii) be amended with a view to simplifying its drafting and, secondly, that with regard to Article 5(2)(e), the Assembly of the Madrid Union adopt an interpretative statement.

5. At its thirty-sixth session in September, 2005 the Assembly of the Madrid Union decided that a further meeting of the Working Group should be convened for the purpose, *inter alia*, of considering, in further preparation for the review of the refusal procedure to be undertaken by the Assembly in 2006, a draft amendment of Article 5(2) of the Protocol and a draft interpretative statement concerning that Article.

6. The present document submits for consideration by the Working Group a draft amendment of Article 5(2) of the Protocol, in particular, concerning Article 5(2)(c)(ii), together with a draft interpretative statement regarding that Article.

Article 5(2)(c)(ii) of the Protocol

7. After examining Article 5(2)(c)(ii) of the Protocol, the Working Group recommended, during its first session, that the reference to a maximum time limit of seven months should be maintained, but concluded that the drafting of this provision could be simplified.

8. Upon a request from the Chair, the Secretariat suggested an alternative drafting of Article 5(2)(c)(ii), which read as follows (see paragraph 37 of the Report):

“(ii) the notification of the refusal based on an opposition is made within a time limit of one month from the expiry of the opposition period, provided that such time limit does not exceed seven months from the date on which the opposition period begins.”

9. The recommendation of the Working Group was that Article 5(2)(c)(ii) be amended along the lines of that alternative drafting. A draft amendment of Article 5(2)(c)(ii), based on the wording suggested by the Secretariat, but slightly modified, is set out in the Annex hereto for the consideration of the Working Group. Transitional provisions are not required as this new drafting, if adopted by the Assembly, would not entail any substantive or procedural consequences.

10. Since the full name of the Protocol is currently followed by the indication “adopted at Madrid on June 27, 1989”, it would be necessary to supplement that indication with a reference to the amendment, once it is adopted. This addition is reflected in the Annex hereto.

11. The Working Group is invited to comment on the above and, in particular, to indicate whether it would recommend that a proposal to amend Article 5(2)(c)(ii) of the Protocol, as provided in the draft annexed hereto, be submitted to the Assembly of the Madrid Union for adoption.

Article 5(2)(e) of the Protocol

12. Article 5(2)(e) of the Protocol provides for review, by the Assembly, of the refusal procedure under subparagraphs (a) to (d) of Article 5(2), and includes the requirement of a unanimous decision by the Assembly for that purpose.

13. During its first session, the Working Group addressed the question as to whether, following the present review of the refusal procedure, the Assembly would be entitled to undertake further reviews of the refusal procedure established by subparagraphs (a) to (d), as amended. It was recommended by the Working Group that, for the sake of legal certainty, the Assembly adopt an interpretative statement to the effect that Article 5(2)(e) of the Protocol be understood as allowing the Assembly to undertake, at any point in time, further reviews of the operation of the system established by subparagraphs (a) to (d), as last amended, and to adopt any modification of those subparagraphs subject to the voting requirements established by Article 5(2)(e).

14. In line with the practice already followed on a number of occasions, it is proposed that such interpretative statement, if adopted by the Assembly, be introduced in the text of the Protocol by means of a footnote. In addition to containing the interpretative statement itself, the footnote should also refer to the resolution of the Assembly to adopt that statement.

15. The proposed footnote is as follows:

“Interpretative statement adopted by the Assembly of the Madrid Union: Article 5(2)(e) of the Protocol is understood as allowing the Assembly to further examine the operation of the system established by subparagraphs (a) to (d), as last amended, it being also understood that any further modification of those provisions shall require a unanimous decision of the Assembly.”

16. *The Working Group is invited to comment on the above and, in particular, to indicate whether it would recommend that the interpretative statement concerning the review of the refusal procedure under Article 5(2)(a) to (d), as set out in paragraph 15, above, be submitted to the Assembly of the Madrid Union for adoption.*

[Annex follows]

ANNEX

PROTOCOL
RELATING TO THE MADRID AGREEMENT
CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

adopted at Madrid on June 27, 1989
and amended on September .., 2006

Article 5

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

(1) [...]

(2)(a) [...]

(b) [...]

(c) Such declaration may also specify that, when a refusal of protection may result from an opposition to the granting of protection, such refusal may be notified by the Office of the said Contracting Party to the International Bureau after the expiry of the 18-month time limit. Such an Office may, with respect to any given international registration, notify a refusal of protection after the expiry of the 18-month time limit, but only if

(i) [...]

(ii) the notification of the refusal based on an opposition is made within a time limit of **one month from the expiry of the opposition period, and in any case**, not more than seven months from the date on which the opposition period begins; ~~if the opposition period expires before this time limit of seven months, the notification must be made within a time limit of one month from the expiry of the opposition period.~~

(d) [...]

[End of Annex and of document]