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

**Second Session**  
**Geneva, June 12 to 16, 2006**

### AMENDMENT OF THE COMMON REGULATIONS

*Document prepared by the International Bureau*

#### INTRODUCTION

1. 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 certain matters, including, *inter alia*, proposals for the amendment of a number of features contained in the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to, respectively, as “the Agreement”, “the Protocol” and “the Common Regulations”).
2. The items under consideration by the Working Group are set out in detail in document MM/LD/WG/1/2 (hereinafter referred to as “the working document”) and 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 at its thirty-sixth session in September 2005.

3. The Working Group made recommendations concerning the following features of the Common Regulations:

- (i) Rule 3(1), concerning representation before the International Bureau,
- (ii) Rule 32(3), concerning the paper form of the yearly index,
- (iii) Rules 19 to 21, concerning the date of recording of certain communications,
- (iv) Rule 20(3), concerning the recording of restrictions, and
- (v) Rule 28(2), concerning corrections.

4. 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 of considering, *inter alia*, draft amendments of the Common Regulations, insofar as the items in paragraph 3, above, are concerned (see paragraph 15, document MM/A/36/3).

5. The present document contains, for the consideration by the second session of the Working Group, draft proposals for amendment of the Common Regulations, for submission to the thirty-seventh session of the Assembly of the Madrid Union in September 2006.

#### Rule 3(1): Representation before the International Bureau

6. Under Rule 3(1)(b)(i) and (ii) of the Common Regulations, depending on whether an international application is governed exclusively by the Agreement or exclusively by the Protocol, the address of an appointed representative must be in the territory of a Contracting Party bound, respectively, by the Agreement, or by the Protocol.

7. Such distinction applies only in respect of international *applications*. Whenever such applications have matured into registrations, the address of the representative appointed before the International Bureau may, pursuant to Rule 3(1)(b)(iv), be in the territory of *any* Contracting Party to the Madrid system, that is to say, irrespective of the treaty governing the resulting international registrations.

8. For the sake of simplicity and in order to allow more flexible arrangements to users of the Madrid system, it was proposed to the Working Group that one single criterion should apply with regard to the address of a representative, i.e., regardless of the treaty – Agreement or Protocol – governing the international application, and regardless of whether the appointment took place at the application or registration stage.

9. To that end, it was suggested that, in all cases, the only requirement concerning the address of a representative appointed before the International Bureau be that it be in the territory of a Contracting Party to the Madrid system. Alternatively, it was proposed that, as under the Hague Agreement Concerning the International Registration of Industrial Designs, it could be established that *anyone* might be appointed in an international application or an international registration to act as a representative before the International Bureau, i.e., not necessarily with an address in a Contracting Party to the Madrid system (see paragraphs 114 to 119 of the working document).

10. The Working Group recommended that a proposal consisting of amending Rule 3(1) of the Common Regulations so as to provide that anyone might be appointed in an international application or with regard to an international registration to act as a representative before the International Bureau (i.e., not necessarily a person with an address in a Contracting Party) be submitted to the Assembly of the Madrid Union for adoption (see paragraph 103 of the Report).

11. A draft text of the proposed amendment is set out for the consideration of the Working Group in the Annex hereto.

*12. The Working Group is invited to indicate whether it would recommend that a proposal to amend the Common Regulations with respect to representation, as provided in the draft annexed hereto, be submitted to the Assembly of the Madrid Union for adoption.*

#### Rule 32(3): The Paper Form of the Yearly Index

13. Rule 32(3) of the Common Regulations provides for the publication by the International Bureau, on a yearly basis, of an index indicating the names of the holders of the international registrations published in the *WIPO Gazette of International Marks* each year.

14. This provision was intended to be of use to the public when the paper form of the Gazette was the only source of information offered by the International Bureau. Nowadays, users have access to much more developed and up-to-date tools, such as the WIPO Gazette on CD-ROM, or the ROMARIN and Madrid Express databases. All of these electronic tools contain search facilities which enable users to obtain in an efficient manner, for a given year, the list of names of holders of international registrations.

15. In view of the above, it was suggested to the Working Group that Rule 32(3) be deleted. The practical consequence of such deletion would be that the paper form of the yearly index would no longer be issued by the International Bureau (see paragraphs 133 to 136 of the working document).

16. The Working Group recommended that a proposal consisting in the deletion of Rule 32(3) of the Common Regulations be submitted to the Assembly of the Madrid Union for adoption (see paragraph 119 of the Report).

17. A draft text of the proposed amendment is set out for the consideration of the Working Group in the Annex hereto.

*18. The Working Group is invited to indicate whether it would recommend that a proposal to amend the Common Regulations with respect to the paper form of the yearly index, as provided in the draft annexed hereto, be submitted to the Assembly of the Madrid Union for adoption.*

Rules 19 to 21: The Date of Recording of Certain Communications

19. With respect to the recording in the International Register of the following operations, no provision of the Common Regulations expressly mentions that such recordings must be made as of the date of receipt by the International Bureau of the relevant communication complying with the applicable requirements (in contrast to other operations concerning international registrations, such as the recording of changes in ownership, changes of name or address of the holder, or cancellations (see Rule 27(1)(b)):

- (a) invalidations (Rule 19),
- (b) restrictions of the holder's right of disposal (Rule 20),
- (c) licenses (Rule 20*bis*), and
- (d) replacement of a national or regional registration (Rule 21).

20. This being said, the practice of the International Bureau has always consisted, in fact, in the recording of such communications as of the date on which the corresponding request, provision of information, declaration or notification, complying with the applicable requirements, was received by the International Bureau. For the sake of consistency and legal certainty, however, it was suggested to the Working Group that it would seem advisable to supplement accordingly Rules 19 to 21 of the Common Regulations (see paragraphs 137 to 139 of the working document).

21. The Working Group recommended that a proposal consisting of specifying, in Rules 19 to 21, the date of recording of the communications above referred to, that is to say, the date on which the corresponding request, provision of information, declaration or notification, complying with the applicable requirements, had been received by the International Bureau, be submitted to the Assembly of the Madrid Union for adoption (see paragraph 120 of the Report).

22. A draft text of the proposed amendment is set out for the consideration of the Working Group in the Annex hereto.

*23. The Working Group is invited to indicate whether it would recommend that a proposal to amend the Common Regulations with respect to:*

*(a) the date of recording of invalidations;*

*(b) the date of recording of information concerning restrictions of the holder's right of disposal;*

*(c) the date of recording of licenses and related declarations, and*

*(d) the date of recording of indications concerning replacement,*

*as provided in the draft annexed hereto, be submitted to the Assembly of the Madrid Union for adoption.*

Rule 20(3): Communication to the Office of the Contracting Party of the Holder of the Fact of the Recording of a Restriction

24. As it currently stands, Rule 20(3) of the Common Regulations does not provide for communication, by the International Bureau to the Office of the Contracting Party of the holder, of the fact of the recording of a restriction, when such Office was not the Office which had requested the recording of the restriction. During the course of the Working Group it was proposed by the delegation of Switzerland that Rule 20(3) be amended to so provide.

25. The Working Group accepted the proposal of the delegation of Switzerland and recommended accordingly that Rule 20(3) be supplemented so as to provide that the recording of a restriction of the holder's right of disposal be communicated also to the Office of the Contracting Party of the holder (see paragraphs 121 and 122 of the Report).

26. A draft text of the proposed amendment is set out for the consideration of the Working Group in the Annex hereto.

*27. The Working Group is invited to indicate whether it would recommend that a proposal to amend the Common Regulations with respect to the parties to be notified of the fact of the recording of information concerning a restriction, as provided in the draft annexed hereto, be submitted to the Assembly of the Madrid Union for adoption.*

Rule 28(2): Corrections

28. At present, Rule 28(2) of the Common Regulations provides for the International Bureau to notify a correction to the holder, and additionally, the Offices of the designated Contracting Parties where the correction has effect. It was proposed by the delegation of Switzerland that Rule 28(2) be supplemented so as to provide that a correction in the International Register should be communicated by the International Bureau also to the Office that had requested such correction (where such Office is not the Office of a designated Contracting Party in which the correction has effect).

29. It was noted by the Secretariat that the International Bureau had already in fact adopted this practice, notwithstanding that this was not specifically required at present under Rule 28.

30. It was recommended by the Working Group that the proposal of the delegation of Switzerland be submitted to the Assembly of the Madrid Union for adoption (see paragraphs 123 to 126 of the Report).

31. A draft text of the proposed amendment is set out for the consideration of the Working Group in the Annex hereto.

*32. The Working Group is invited to indicate whether it would recommend that a proposal to amend the Common Regulations with respect to the parties to be notified of a correction, as provided in the draft annexed hereto, be submitted to the Assembly of the Madrid Union for adoption.*

[Annex follows]

ANNEX

COMMON REGULATIONS UNDER THE MADRID AGREEMENT  
CONCERNING THE INTERNATIONAL REGISTRATION OF  
MARKS AND THE PROTOCOL RELATING  
TO THAT AGREEMENT

(as in force on .....)

[...]

**Chapter 1**  
**General Provisions**

[...]

*Rule 3*

*Representation Before the International Bureau*

(1) [*Representative; ~~Address of Representative;~~ Number of Representatives*] (a) The applicant or the holder may have a representative before the International Bureau.

~~(b) The address of the representative shall be,~~  
~~———— (i) in respect of an international application governed exclusively by the Agreement, in the territory of a Contracting Party bound by the Agreement;~~  
~~———— (ii) in respect of an international application governed exclusively by the Protocol, in the territory of a Contracting Party bound by the Protocol;~~  
~~———— (iii) in respect of an international application governed by both the Agreement and the Protocol, in the territory of a Contracting Party;~~  
~~———— (iv) in respect of an international registration, in the territory of a Contracting Party.~~

(eb) The applicant or the holder may have one representative only. Where the appointment indicates several representatives, only the one indicated first shall be considered to be a representative and be recorded as such.

(dc) Where a partnership or firm composed of attorneys or patent or trademark agents has been indicated as representative to the International Bureau, it shall be regarded as one representative.

(2) [*Appointment of the Representative*] [...]

(3) *[Irregular Appointment]* ~~(a) Where the address of the purported representative is not in the territory relevant under paragraph (1)(b), the International Bureau shall treat the appointment as if it had not been made and shall inform accordingly the applicant or holder, the purported representative and, if the sender or transmitter is an Office, that Office.~~

**(ba)** Where the International Bureau considers that the appointment of a representative under paragraph (2) is irregular, it shall notify accordingly the applicant or holder, the purported representative and, if the sender or transmitter is an Office, that Office.

**(eb)** As long as the relevant requirements under paragraphs ~~(1)(b) and~~ (2) are not complied with, the International Bureau shall send all relevant communications to the applicant or holder himself.

[...]

## Chapter 7 Gazette and Data Base

### *Rule 32 Gazette*

(1) *[Information Concerning International Registrations]* [...]

(2) *[Information Concerning Particular Requirements and Certain Declarations of Contracting Parties]* [...]

~~(3) *[Yearly Index]* In respect of every year, the International Bureau shall publish an index indicating, in alphabetical order, the names of the holders of the international registrations concerning which one or more entries were published in the Gazette during that year. The name of the holder shall be accompanied by the number of the international registration, the page number of the Gazette issue in which the entry affecting the international registration was published and the indication of the nature of the entry, such as registration, renewal, refusal, invalidation, cancellation or change.~~

~~(4)~~ **(3)** *[Number of Copies for Offices of Contracting Parties]* [...]

[...]



**Chapter 4**  
**Facts in Contracting Parties**  
**Affecting International Registrations**

[...]

*Rule 19*  
*Invalidations in Designated Contracting Parties*

(1) *[Contents of the Notification of Invalidation]* [...]

(2) *[Recording of the Invalidation and Information to the Holder and the Office Concerned]* **(a)** [...]

**(b) The invalidation shall be recorded as of the date of receipt by the International Bureau of a notification complying with the applicable requirements.**

*Rule 20*  
*Restriction of the Holder's Right of Disposal*

(1) *[Communication of Information]* [...]

(2) *[Partial or Total Removal of Restriction]* [...]

(3) *[Recording]* **(a)** The International Bureau shall record the information communicated under paragraphs (1) and (2) in the International Register and shall inform accordingly the holder, **the Office of the Contracting Party of the holder and the Offices of the designated Contracting Parties concerned.** ~~and, where the information has otherwise been given by an Office, that Office.~~

**(b) The information communicated under paragraphs (1) and (2) shall be recorded as of the date of its receipt by the International Bureau, provided that the communication complies with the applicable requirements.**

*Rule 20bis*  
*Licenses*

(1) *[Request for the Recording of a License]* [...]

(2) *[Irregular Request]* [...]

(3) *[Recording and Notification]* **(a)** [...]

**(b) The license shall be recorded as of the date of receipt by the International Bureau of a request complying with the applicable requirements.**

(4) *[Amendment or Cancellation of the Recording of a License]* [...]

(5) *[Declaration that the Recording of a Given License has no Effect]* [...]

(a) [...]

(b) [...]

(c) [...]

(d) The International Bureau shall record in the International Register any declaration made in accordance with subparagraph (c) and shall notify accordingly the party (holder or Office) that presented the request to record the license. **The declaration shall be recorded as of the date of receipt by the International Bureau of a communication complying with the applicable requirements.**

(6) *[Declaration That the Recording of Licenses in the International Register Has No Effect in a Contracting Party]* [...]

*Rule 21*  
*Replacement of a National or Regional Registration*  
*by an International Registration*

(1) *[Notification]* [...]

(2) *[Recording]* (a) [...]

(b) **The indications notified under paragraph (1) shall be recorded as of the date of receipt by the International Bureau of a notification complying with the applicable requirements.**

*Rule 28*  
*Corrections in the International Register*

(1) *[Correction]* [...]

(2) *[Notification]* The International Bureau shall notify accordingly the holder and, at the same time, the Offices of the designated Contracting Parties in which the correction has effect. **In addition, where it is not the Office of a designated Contracting Party in which the correction has effect, the International Bureau shall also inform accordingly the Office that has requested the correction.**

(3) *[Refusal Following a Correction]* [...]

(4) *[Time Limit for Correction]* [...]