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WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

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

**Fifth Session
Geneva, May 5 to 9, 2008**

CONTRIBUTION BY SWITZERLAND

Document prepared by the International Bureau

1. In a communication dated February 1, 2008, the International Bureau received a contribution from Switzerland on the subject of improving the accessibility of information regarding the fate of international registrations in designated Contracting Parties, for consideration by the Working Group on the Legal Development of the Madrid System for the International Registration of Marks, at its fifth session to be held in Geneva from May 5 to 9, 2008.
2. The said contribution is annexed to this document.
3. *The Working Group is invited to note the content of the attached contribution by Switzerland.*

[Annex follows]

ANNEX

**WORKING GROUP ON THE LEGAL DEVELOPMENT
OF THE MADRID SYSTEM**

Contribution by Switzerland

By way of introduction, we wish to specify that the proposed subjects for discussion put forward by Switzerland relate to access to information concerning the fate of international registrations in Contracting Parties, *in the broad sense of the term*. They are therefore part of the current work of the Working Group and, in more general terms, aim to provide users of the Madrid System with a high-quality examination procedure, as regards both the formal aspects of the procedure and the actual substantive examination equivalent to that of the national examination.

Before explaining the proposals put forward by Switzerland, we give a brief introduction to the services currently provided by the Swiss Office, in order to demonstrate the chosen solutions and to better understand what improvements we consider to be necessary and/or possible:

1. Services provided by the Swiss Office

1.1. As the office of the holder:

- The Swiss Office examines in full the application (for registration or amendment) before it is forwarded to the International Bureau (IB). The advantage for the user is that his application, which does not contain or no longer contains any errors, can be processed more quickly by the IB.
- The Swiss Office agrees to act as an intermediary for the payment of fees to the IB. Thus, the user has only one point of contact for the payment of fees and he does not need to hold a current account with the World Intellectual Property Organization (WIPO).
- The Swiss Office adopts a position, as far as is possible, on all the notifications of irregularities by the IB. The applicant therefore has a better understanding of the notifications issued, which allows him firstly to ensure that the international application actually corresponds to his basic application and, secondly, to respond correctly to the notification.
- In most cases, the Swiss Office registers the basic application within a period allowing the applicant to benefit from possible priority over a previous application. That allows the applicant to base his international application on a Swiss registration, and not simply on an application for Swiss registration.
- Wherever Swiss and international regulations allow, the Swiss Office accepts that a holder submits his requests directly to the Office. The holder can thus file an application for amendment concerning both the Swiss base and the international registration by referring the matter to a single authority.

1.2. As a designated office:

- The holder may request the accelerated examination of the Swiss designation, in return for payment of a fee (SFR 400.-). In this case, the holder receives a declaration of grant of protection should the international registration be accepted. On average, the usual examination period of 11 months is reduced to one month, once the fee has been paid (WIPO Information Notice No. 36/ 2002).

- Upon request and once the refusal period has expired, the Swiss Office informs the applicant that the Swiss designation has been accepted or, where appropriate, refused. The register is therefore transparent and the information accessible.
- In certain particular cases, the holder has the possibility to respond directly to a provisional refusal, without having to be represented by an agent in Switzerland (provisional refusals linked to indications of origin or to color disclaimers on coats of arms). This allows the holder to limit his costs and not make the processing of his application last too long.
- The holder may forward to the Swiss Office, through an agent in Switzerland, the rules on collective/guarantee marks before the international registration is examined, in order to avoid a provisional refusal based solely on the fact that the rules are missing (WIPO Information Notice 03/2004).

1.3. As office of the holder or a designated office:

- The Swiss Office has a helpline allowing applicants or third parties to easily obtain information on a registration or, in broader terms, on the international procedure and practice of the Swiss Office. The activity of the Swiss Office is thus transparent and, to a certain extent, can be planned.
- Consultation of files is free of charge, which facilitates access to information and improves the transparency of procedures.

2. Proposals submitted for discussion

2.1. Concerning national offices:

- Each office should make its guidelines relating to the examination of marks available to users, in the form of an English translation, in order to enhance the transparency of procedures and the capacity to plan examination practices.
- Each office should attach to its refusals a summary presentation (one A4 page), in the other two languages of the Madrid system, of the procedure and grounds for refusal. The presentation of the grounds for refusal could consist of a simple transcription of the national legislation.

The aim of these two proposals is to allow the applicant/holder to better understand the grounds for refusal and to be able to evaluate more easily whether it is necessary to resort to the assistance of an agent so as to continue the procedure in the designated Contracting Party that has issued the refusal.

In more precise terms, the provision of guidelines would allow the applicant/holder to become familiar with the procedure and practice of the national (or regional) office designated previously, outside of any specific case. This presentation, which should be as exhaustive as possible, would allow the applicant/holder to determine whether it is advisable for him to request protection in the form of a mark in a given Contracting Party.

As to the summary presentation, this would be a small (one A4 page) summary memorandum which would allow the grounds for refusal applied by the national (or regional) office to be explained or recalled. On this basis, the holder/applicant would be able to understand the refusal and make an initial analysis, in order to determine whether it is advisable to adopt a position on the refusal.

2.2. As regards the International Bureau:



- It should be possible to monitor international registrations actively in ROMARIN (using an alert system), so that the applicant/holder or third parties may be informed in real time of any entry (amendment, refusal, declaration, etc.) in the International Register, for a given international registration or for a specific holder. By means of such a system, the holder or a third party would no longer need to consult ROMARIN regularly, as the entries relating to the international registration or the holder concerned (amendments etc.) would be brought to his attention.
- The refusals and declarations issued by the designated offices should be made available on line through ROMARIN. This would allow third parties to know the grounds for refusal of a mark and would avoid, in more general terms, having to request a file consultation.
- Refusals and declarations should be translated into the other two languages of the Madrid system. This would allow the applicant/holder speaking a language other than that of the designated office to understand the grounds for the refusal. The translation could be done upon request and be the subject of an additional one-off fee.
- The electronic exchanges between the IB and national (regional) offices should be standardized and improved. Such offices should be able to access the International Register directly and to make the necessary changes to it. The standardization and improvement of the electronic exchanges would also allow the quality of the graphic reproductions to be improved, for example.
- The legibility and user-friendliness of the ROMARIN extracts should be improved, in particular that of the search lists, in order to facilitate the understanding and use of the results obtained (see annex comparing a ROMARIN extract and a Swissreg extract (Swiss online register)).
- The IB should establish transparent quality standards, concerning *inter alia* the periods for processing applications, the availability of administrative staff and practice (for example, regarding examination of lists of goods and services). The activity of the IB would thus become easier to plan and more user-friendly for applicants/holders.

N°	Mark N°	Mark Name	Office of Origin	Registration date	Nice Classification
1.	331502	LANVIN	FR	10.01.1967	30
2.	581412	BACI	CH	15.01.1992	30
3.	773696	Prebio 1	CH	20.12.2001	05 29 30 32
4.	820327	CRECIOMEGA	CH	24.02.2004	05
5.	824804	No verbal elements found	CH	27.04.2004	30
6.	831145	OmegaEssentials	CH	26.07.2004	05
7.	877072	No verbal elements found	CH	30.01.2006	29 30 32
8.	883380	LIPOACTIV	CH	07.07.2005	05 29 30
9.	901016	DOLCE GUSTO	CH	09.10.2006	21
10.	940762	Baci	CH	21.09.2007	29 30
11.	943932	NESFRAPPE	CH	23.10.2007	29 30 32
12.	944685	No verbal elements found	CH	24.10.2007	29 30 32
13.	946738	No verbal elements found	CH	08.11.2007	30



Register view, results list: Trademarks

Number of results 3

Trademark	Status	Nice classification no.	Number	Owner
	<input checked="" type="checkbox"/>	29 - 30	426223	Chocoladefabriken, Lindt & Sprüngli AG, Seestrasse 204, 8802 Kilchberg ZH
LINDT ONICE	<input checked="" type="checkbox"/>	29 - 30	470235	Chocoladefabriken, Lindt & Sprüngli AG, Seestrasse 204, 8802 Kilchberg ZH
	<input checked="" type="checkbox"/>	29 - 30	531953	Chocoladefabriken, Lindt & Sprüngli AG, Seestrasse 204, 8802 Kilchberg

Register view, results list

Search terms:

Owner=Lindt; Country (owner)=all; Nice classification no.=29; Trademark type=all; Trademark form=all; Color claim=all; Publication reason=all; Status= Pending applications, Cancelled applications, Active trademarks, Cancelled trademarks

Length of time for query:

13.03.2008 - 12:17:23 (GMT+01:00) - Switzerland/Bern

Protective title:

Trademarks

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