

# WIPO



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WORLD INTELLECTUAL PROPERTY ORGANIZATION  
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## 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 AUSTRALIA (PART 2)

*Document prepared by the International Bureau*

1. In a communication dated January 2, 2008, the International Bureau received a contribution from Australia 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 contents of the attached contribution by Australia.*

[Annex follows]

ANNEX

**IMPROVING ACCESS TO INFORMATION ON INTERNATIONAL REGISTRATIONS IN DESIGNATED COUNTRIES**

**Establishing a 'final' standard for provision of information**

**Part 2 of a contribution by Australia**

**to assist preparation for 2008 meetings of the *Ad Hoc* Working Group on the Legal Development of the Madrid Protocol**

These notes supplement those provided in a paper being submitted concurrently which deals with establishing an interim standard for the provision of information. Both are in response to the Working Group's invitation to contracting parties to contribute comments to assist the Secretariat's preparation of a paper on accessibility of information on international registrations.

**BACKGROUND**

A paper presented by Australia at the 2007 sessions of the Working Group (MM/LD/WG/4/4) proposed that standards should be set relating to the provision of information on international registrations in designated contracting parties. It was suggested that there should be two stages in this work. The first stage would include a statement being made that standards would be set relating to the provision of information which would apply throughout the Madrid system and that this work would be done when the Working Group is considering other aspects of the future development of the Madrid Protocol. As that work would be done at a later time, it was further proposed that a minimum standard in provision of information should be adopted which would apply in the interim.

Our proposal arose in large part because trade mark owners, their representatives and others with interests of a third party have reported difficulty in utilising the Madrid system effectively as they are frequently unable to find out details regarding international registrations. Users have mentioned that:

- this acts as a disincentive to using the Madrid system
- additional costs are incurred if local agents are required to ascertain the status in designated countries
- remedying the issue is likely to increase use of the Madrid system and may encourage additional membership

In the paper we suggested that the standards to be set should ensure all parties interested in an international registration are able to access information regarding its status in all designated countries. This would include:

- information being published to ensure it is available to third parties, and
- the holder being informed of the progress of international registrations in designated contracting parties.

However, our paper did little to elaborate on issues which might need to be addressed in establishing such a final standard and as yet there has been no discussion along those lines within the Working Group.

## SETTING A 'FINAL' STANDARD FOR PROVISION OF INFORMATION

IP Australia has been discussing this issue with Australian trade mark owners and their representatives. While additional consultation may occur at a later time, it may be helpful to provide some notes on matters which have been mentioned.

### Principles and objectives in setting a standard

Some of the matters which we see as important to determine, or consider, early in the work on determination of a 'final standard' in provision of information on international registrations are noted below.

- i. In proposing elements of a 'final standard' in provision of information on international registrations, we need to address:
  - what information (data) should be available to holders and all users of the system
  - whether all these items should be accessible through IB's data base
  - which notifications should be sent to the holder, the holder's representative before the IB, or the holder's representative in the designated contracting party concerned
  - whether those are sent directly or through the IB.
- ii. Depending on the timing in relation to other work, the Group will need to remain aware that subsequent decisions on development of the Madrid Protocol may mean some elements or issues may need to be revisited.
  - Some of the proposals which have already been put before the Working Group would involve quite fundamental changes to the operation of the Madrid Protocol.
- iii. General objectives of setting a standard must be agreed. These might include the need to ensure:
  - holders, third parties and their representatives are able to access the information they require to use the system effectively
  - preferably in a single location (but it will be necessary to avoid long delays in recording data)
  - increased consistency in procedures across all contracting parties
  - records are clear and data easy to find.

Information on the status of an international registration in each designated contracting party

As mentioned in our earlier paper, we believe it is important for the final standard to require the holder to be notified that protection has been extended to the mark in a designated contracting party, including all the details applicable to the grant.

Australian users would operate more effectively if able to follow changes in status of a mark within a designated contracting party.

- It is acknowledged that it might be difficult to reach agreement on a single setup across all contracting parties but it may be feasible to develop a minimum set of common data on status.

Uniformity in approach to provision of information is seen by users to be particularly important.

*Information to be provided on a central database*

The following list of data to be included on the database is intended to be indicative rather than exhaustive. It is included here to provide an indication of the extent of the information which users would want to be able to access easily. Only some elements of this information would be provided by offices of designated contracting parties.

- Prior to notification of designated countries, the database should show
  - international application is filed
  - irregularities in application are awaiting resolution
- When the mark registered and designated contracting parties notified
  - holder's name
  - IR number
  - goods/services specified for each designation
  - notification date
- Changes in status notified by designated contracting parties would be published.

As this would have to cover the needs of all contracting parties, more terms indicating status would have to be available than would be relevant for any one country. There might also be some need for interpretation of terms as appropriate for a designated party.

Some statuses which might be included are:

- awaiting examination
- provisional refusal based on examination
- opposition period commenced
  - there may be a need to include options for opposition occurring before and after examination and also after protection is granted
- provisional refusal based on opposition
- final outcome before the office

- For marks which are protected within a contracting party, the following items should be included:
  - goods and services for which mark is protected
  - date protection extended (may be critical for infringement and non-use actions)
  - disclaimers/translations
  - any changes in status following grant of protection
  - perhaps also any number allocated in the country concerned

Users also emphasise the importance of having a central location for data which is organised so it is easy to access all items relevant to particular designation.

- This may mean consideration of some changes to the existing setup for ROMARIN such as ordering by designation and then by date c.f. current date order

#### *Notification of the holder*

As noted earlier, it is appropriate for information on the status of marks in designated contracting parties to go to the holder or a representative of the holder so that the holder does not have to rely on the database for such information.

Representatives of Australian users have expressed concern that currently offices handle notification of the holder in different ways – some send notices to the holder directly and some send to the representative of the holder before the IB.

- These are in situations other than those where correspondence is sent to the holder's local representative.

This divergence in procedure has led to the view that, other than correspondence appropriately sent to a local representative, notifications to the holder should always go through the IB.

- This would result in consistent treatment and hence predictability
- However, the large volume of notices to be forwarded by the IB may result in delays.
  - Use of email notification may assist this process

We suggest that the standard to be established for providing information on international registrations in designated contracting parties must enable holders and their representatives to predict what notifications will be received throughout the life of their international registration and how the notices will be received.

## CONCLUSION

This paper indicates some outcomes of early consideration of issues which relate to the setting of a final standard in provision of information to be applied across the Madrid system. In particular we believe it will be very important for the Working Group to be clear on the objectives which are to prevail in setting such a standard. We will be continuing to consider these matters and would be happy to make additional contributions to the work of the Secretariat if that would be helpful.

[End of Annex and of document]