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WORLD INTELLECTUAL PROPERTY ORGANIZATION
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**WORKING GROUP ON THE MODIFICATION OF THE COMMON
REGULATIONS UNDER THE MADRID AGREEMENT
CONCERNING THE INTERNATIONAL REGISTRATION OF
MARKS AND THE PROTOCOL RELATING TO THAT
AGREEMENT**

Second Session
Geneva, June 11 – 15, 2001

PROPOSALS FOR THE MODIFICATION OF THE COMMON REGULATIONS UNDER
THE MADRID AGREEMENT AND PROTOCOL

(2) NEW AND REVISED PROPOSALS: ADDENDUM

Document prepared by the International Bureau

INTRODUCTION

1. The present document contains new proposals for the modification of the Common Regulations under the Madrid Agreement and Protocol which are additional to those set out in document MM/WG/2/3.
2. The correction of the date of amendment of the Madrid Agreement in Rule 1(i) was foreshadowed in the first session of the Working Group (see paragraph 118 of document MM/WG/1/5).
3. The amendment to Rule 14(1) is proposed in order to deal with a concern expressed during the first session by the Delegation of China (see paragraph 114 of document MM/WG/1/5).
4. The additional subparagraph (d) in Rule 17(5) is proposed in order to overcome a difficulty which it is understood that the Office of Spain (and possibly other Offices) would have with Rule 17(5) as proposed in document MM/WG/2/3, in particular the fact that all provisional refusals issued by that Office are reviewed *ex officio*, whether or not such review has been requested by the holder, and may also be reviewed at the request of a third party, that the decision resulting from the said review may be the subject of a further review before the Office but that the Office is (for legal or practical reasons) not in a position to communicate the results of the review to a holder who has not appointed a local representative, who would therefore be deprived of the opportunity to request such further review if the Office sent to the International Bureau only the decision which closes the procedure before the Office.
5. The additional subparagraph (e) in Rule 17(5) is proposed in order to overcome a difficulty which it is understood that the Office of China would have with Rule 17(5) as proposed in document MM/WG/2/3, since *ex officio* refusals issued by that Office are not open to review by the Office but only to appeal before a separate body. It is proposed that any *ex officio* provisional refusal notified by an Office that has made the declaration provided for in subparagraph (e) would be deemed to include the statement referred to in subparagraph (a)(i) or (iii); any further decision affecting the protection of the mark would be sent to the International Bureau in accordance with subparagraph (b).
6. In addition, in the English version of the Common Regulations, the word “recordal” or “recordals” would be replaced by the word “recording” or “recordings” (which are the terms used in the Common Regulations Under the Hague Agreement, the Regulations Under the Geneva Act of the Hague Agreement and the PCT Regulations) in the following provisions:

Rule 3(4) (title), Rule 3(4)(b) (twice), Rule 3(6) (title), Rule 3(6)(a) (twice), Rule 3(6)(c)(ii), Rule 3(6)(e), Rule 6(2)(b)(iii), Rule 6(3) (title), Rule 6(3)(a), Rule 6(3)(b) (twice), Rule 6(3)(c), Rule 6(4)(a) (twice), Rule 16(2) (title), Rule 17(4) (title), Rule 18(1)(a)(iii) (twice), Rule 19(2) (title), Rule 20(3) (title), Rule 20*bis*(2)(a), Rule 21(2) (title), Rule 22(2) (title), Rule 23(2) (title), Rule 24(3)(c)(ii), Rule 24(7) (title), Rule 25 (title, twice), Rule 25(1)(a), Rule 25(1)(b), Rule 25(2)(c) (as amended), Rule 25(2)(a) (twice), Rule 25(2)(b), Rule 25(2)(c) (twice), Rule 25(4), Rule 26 (title) (twice), Rule 26(1) (twice), Rule 26(2) (twice), Rule 27 (title), Rule 27(1) (title), Rule 27(1)(a) (twice), Rule 27(2) (title), Rule 27(3) (title), Rule 27(4)(c), Rule 27(4)(d), Rule 31 (title), Rule 31(1) (title),

Rule 34(4)(b) (which would become Rule 34(6)(b)), Rule 36 (twice), Rule 38, Rule 39(3), Rule 40(2)(iii) and Rule 40(3)(d).

Rule 1
Abbreviated Expressions

For the purposes of these Regulations,

(i) “Agreement” means the Madrid Agreement Concerning the International Registration of Marks of April 14, 1891, as revised at Stockholm on July 14, 1967, and amended on ~~October 2~~, September 28, 1979;

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Rule 14
Registration of the Mark in the International Register

(1) [*Registration of the Mark in the International Register*] Where the International Bureau finds that the international application conforms to the applicable requirements, it shall register the mark in the International Register, notify the Offices of the designated Contracting Parties of the international registration and inform the Office of origin accordingly, and send a certificate to the holder. Where the Office of origin so wishes and has informed the International Bureau accordingly, the certificate shall be sent to the holder through the Office of origin.

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Rule 17
*Provisional Refusal and Statement of Grant of Protection*¹

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(5) [*Confirmation or Withdrawal of Provisional Refusal*]²

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(d) The Office of a Contracting Party may, in a declaration, notify the Director General that, in accordance with the law of the said Contracting Party,

(i) any provisional refusal that has been notified to the International Bureau is subject to review by the said Office, whether or not such review has been requested by the holder, and

(ii) the decision taken on the said review may be the subject of a further review or appeal before the Office.

Where this declaration applies and the Office is not in a position to communicate the said decision directly to the holder of the international registration concerned, the Office shall, notwithstanding the fact that all procedures before the said Office relating to the protection of the mark may not have been completed, send the statement referred to in subparagraph (a) to the International Bureau immediately following the said decision. Any further decision affecting the protection of the mark shall be sent to the International Bureau in accordance with subparagraph (b).

(e) The Office of a Contracting Party may, in a declaration, notify the Director General that, in accordance with the law of the said Contracting Party, any *ex officio* provisional refusal that has been notified to the International Bureau is not open to review before the said Office. Where this declaration applies, any *ex officio* notification of a provisional refusal by the said Office shall be deemed to include a statement in accordance with subparagraph (a)(i) or (iii).

[End of document]

¹ This is the title of Rule 17 as proposed in document MM/WG/2/3.

² This is the title of paragraph (5) as proposed in document MM/WG/2/3; the text of subparagraphs (a), (b) and (c) would be as proposed in that document. Rule 32(2)(i) would be modified to provide for the publication of any declaration made in accordance with subparagraph (d) or (e).