

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

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**IN THE ABSENCE OF THE REQUIREMENT OF A BASIC MARK, ANALYSIS
OF THE TASKS THAT WOULD BE REQUIRED TO BE PERFORMED WITH
RESPECT TO THE FILING OF AN INTERNATIONAL APPLICATION, AND BY
WHOM**

Document prepared by the International Bureau

INTRODUCTION

1. It will be recalled that at the conclusion of its sixth session, held in Geneva from November 24 to 26, 2008, the Working Group on the Legal Development of the Madrid System for the International Registration of Marks (hereinafter referred to as “the Working Group”) requested the Secretariat to prepare a questionnaire (hereinafter referred to as “the questionnaire”) for distribution among the Offices of Contracting Parties to 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” and “the Protocol”) ¹.

¹ See paragraph 97 of document MM/LD/WG/6/7.

2. It was intended that the questionnaire would seek to elicit from Offices information on the range and level of services and tasks which Offices currently provide and carry out as Offices of origin, in the context of both the international registration procedure, and national/regional registration procedures to the extent that the latter benefit an international application.
3. The Working Group requested that, upon the basis of the replies to the questionnaire, the Secretariat would prepare a document for consideration by the Working Group. That document would assess, in the absence of the requirement of a basic mark, the tasks that would be required to be performed with respect to the filing of an international application, and by whom. In order to establish a context for discussions, the document would contain, where available, statistical data relating to operational aspects of the work carried out by the International Bureau².
4. The questionnaire was also to enquire as to what might ensure that users would continue to receive at least the level of support and services that they currently receive from national/regional Offices, and as to the readiness of such Offices to continue to provide such support and services in the absence of the requirement of a basic mark. The questionnaire would distinguish between those tasks and services that are mandated by the Madrid treaties and those that are not³.
5. Accordingly, on June 3, 2009, a circular was issued to the Offices of the Contracting Parties of the Madrid system, enclosing a copy of the questionnaire and advising those Offices of the availability also of an electronic version of the questionnaire, online on the Madrid website. A password for access to the online electronic version of the questionnaire was provided and the Offices were requested to submit to the International Bureau their responses online, by e-mail, ordinary mail, or via fax. The initial deadline for submission of responses was June 30, 2009. The deadline was later extended until September 18, 2009, and the online electronic version remained available until November 30, 2009.
6. The Offices of 58 Contracting Parties responded to the questionnaire using, mostly, the online electronic version. A list of those Offices that responded to the questionnaire is contained in Annex II to the present document.
7. The questionnaire was comprised of three main parts.

² See footnote 1, above.

³ See paragraph 101 of document MM/LD/WG/6/7.

8. Part A was entitled *The International Filing Stage*, and consisted of two sections. Section A.1 was entitled *Tasks and Services Performed by an Office, Acting as Office of Origin* and dealt with tasks and services provided by Offices, as Offices of origin, that are not subject to the certification requirement of Rule 9 of the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement (hereinafter referred to as “the Common Regulations”). Section A.2 was concerned with the tasks of an Office of origin as mandated by the regulatory framework of the Madrid system and was entitled *Tasks Performed by an Office, Acting as Office of Origin, in the Framework of the Certification Procedure*.
9. Part B of the questionnaire was entitled *National Filing Stage* and was concerned with tasks and services provided by an Office during the course of the filing/registration of a basic mark, which may in turn benefit the filing of an international application.
10. Finally, Part C of the questionnaire dealt with tasks and services that may be provided by an Office subsequently to the international registration of a mark, and was entitled *Post-Registration Stage*.
11. In response to the request by the Working Group that the Secretariat prepare a document summarizing the tasks currently performed by Offices relating to the procedures of the international registration system⁴, the International Bureau has provided a statistical compilation of the responses to the questionnaire, which is contained in Annex I to the present document.
12. The purpose of the present document is, firstly, in Part I, to present to the Working Group a general analysis of the tasks and services, both mandated and non-mandated, provided by Offices as Offices of origin at the international stage, based upon the responses provided by Offices to the questions contained in the questionnaire. This general analysis is supported by the more detailed statistical compilation of the responses to the questionnaire, as contained in Annex I. Secondly, in Part II, the document sets out for consideration by the Working Group an assessment of the tasks that are carried out by Offices at the national filing stage in the course of the filing/registration of a basic mark, and which may in turn benefit the filing of an international application. Part III of the document looks at certain tasks and services that may be provided by Offices at the post-registration stage.

⁴ See paragraph 97 of document MM/LD/WG/6/7.

13. This is followed, in Part IV, by an assessment of the tasks that, in the absence of the requirement of a basic mark, would be required to be performed with respect to the filing of an international application, and by whom.
14. In Part V, the document considers what might ensure that users would continue to receive from Offices at least the level of support and services that they currently receive and the readiness of Offices to continue to provide such support and services in the absence of the requirement of a basic mark.
15. Part VI of the document raises a number of issues that have not, to date, been addressed in depth by the Working Group in the context of its discussion on the question of the possible abolition of the requirement of a basic mark, and the document offers its conclusions in Part VII.
16. Finally, document MM/LD/WG/6/5 entitled *Considerations Relating to the Proposal by Norway* is reproduced in Annex III of the present document. That document was prepared by the Secretariat for the purpose of facilitating the discussions of the Working Group during its sixth session, held in November 2008.

I. GENERAL ANALYSIS OF THE TASKS AND SERVICES (BOTH MANDATED AND NON-MANDATED) PROVIDED BY OFFICES, AS OFFICES OF ORIGIN

A. Non-Mandated Services Provided by an Office, Acting as Office of Origin, at the International Filing Stage

17. Within the context of the issue under consideration, Part A.1 of the questionnaire will likely be seen as the most relevant. This part is concerned with the general range of services that Offices, acting as Offices of origin, voluntarily provide to applicants in connection with the filing of an international trademark application under the Madrid system.
18. At the outset, it is notable that almost all (97 per cent) of the 58 Offices which responded to the questionnaire confirmed that they do indeed provide general information, assistance and/or guidance to applicants with regard to the procedures under the Madrid system⁵. In response to a question addressing the frequency of the provision of such general information, assistance and/or guidance, 48 per cent indicated that they do so very frequently, 34 per cent confirmed doing so quite frequently and 18 per cent said that they do so not very frequently⁶.

⁵ Question 1.

⁶ Question 2.

19. It appeared from the responses to the question addressing the nature of the information, assistance or guidance that is provided by Offices that it is very wide-ranging and a summary list is contained in the analysis of the responses to the questionnaire, annexed to this document⁷. However, it can be said that the advice and information relates primarily to the general procedures under the Madrid system, the completion of the international application form, the establishment of fees and classification of goods and services.
20. Regarding the manner in which information, assistance or guidance is provided, a large percentage of those Offices which responded to the questionnaire indicated that it is provided by one or more means, including a helpline, the Internet (with a specific section dedicated to the Madrid system), a dedicated team of staff members and brochures⁸.
21. With regard to the completion of the international application form in cases where the applicant does not speak one of the three languages of the Madrid system (English, French and Spanish) and, presumably, the Office is the Office of a Contracting Party that does not normally utilize one of those languages, a good percentage of those Offices (64 per cent) that responded to the questionnaire confirmed that they will assist the applicant. This assistance ranges from aiding the applicant to complete the form to actually completing the application form for the applicant. Additionally, sixteen Offices said that they provide for users non-official Madrid forms in the local language, and fourteen others said that they provide information material in the local language⁹.
22. When asked if they check to ensure that the correct form is being used for the purpose of an international filing, a very large number of those Offices which responded to the questionnaire indicated that they do (94 per cent)¹⁰. Furthermore, almost the same percentage (95 per cent) indicated that they routinely check that an application form has been correctly completed¹¹ and, of further importance to applicants, 91 per cent of those Offices that responded to the questionnaire confirmed that they also check to ascertain that certain items of the application form have been completed in a way as to avoid the applicant meeting with a notification of provisional refusal from the Offices of certain designated Contracting Parties¹². Examples given in the question included the provision of the translation of a word mark, the indication of the legal nature of an applicant when it is a legal entity, and the indication of a second language when the European Union has been designated.

⁷ Question 2(b).

⁸ Question 2(c).

⁹ In this regard, reference is made to the study that is currently under way concerning the possible introduction of new filing languages (see document MM/LD/WG/7/2).

¹⁰ Question 4.

¹¹ Question 5(a).

¹² Question 5(b).

23. The responses to the questionnaire confirmed also that Offices, in their capacity as Offices of origin, actively assist international applicants by ensuring that when the United States of America has been designated, the international application form is accompanied by the requisite additional form MM18 (Declaration of Intention to Use the Mark) and, where necessary, will assist the applicant in the completion of that form (93 per cent and 86 per cent, respectively)¹³. The same applies when an international applicant wishes to file form MM17 (Claim of Seniority) in connection with a designation of the European Union.
24. With regard to issues of language, a sizeable percentage (62 per cent) of those Offices that responded to the questionnaire confirmed that if the list of goods and/or services covered by the basic mark is in a language other than one of the languages of the Madrid system, the Office will assist in the translation of the list¹⁴. Mostly, that assistance consists of merely checking the translated list (69 per cent), but 22 per cent of the Offices that confirmed offering such assistance said that they actually carry out a translation of the list of goods and/or services for international applicants¹⁵.
25. In the same vein, if there is a description in the basic application or in the basic registration in a language other than the language in which it is proposed to file the international application, and the applicant wishes to include such description in the international application, or the Office so requires, a smaller number of those Offices that responded to the questionnaire (31 per cent) confirmed that they will carry out the necessary translation¹⁶. On the other hand, a substantial percentage of Offices (48 per cent) confirmed that they will assist in the translation of the verbal elements of a word mark¹⁷. The same percentage of Offices confirmed that they will assist in the transliteration of a mark that is not in Latin characters, or Arabic or Roman numerals¹⁸.
26. Of further assistance to international applicants, a quite substantial percentage of those Offices that responded to the questionnaire (66 per cent) confirmed that they will help in the drafting of a disclaimer, when an applicant so requires¹⁹. Furthermore, an even larger percentage of those Offices (69 per cent) indicated that when an international applicant requires to make a limitation of the list of goods and/or services, they will assist the applicant, in the sense of helping in the formulation and drafting of such a limitation²⁰.

¹³ Question 6(a) and (b).

¹⁴ Question 10.

¹⁵ In this regard, account should be taken of the project currently being undertaken by the International Bureau concerning the establishment of a database of acceptable indications of goods and services.

¹⁶ Question 9.

¹⁷ Question 11.

¹⁸ Question 12.

¹⁹ Question 13.

²⁰ Question 15.

27. If the basic mark is in color, while the basic application or the basic registration does not contain a color claim, and the applicant wishes to include in the international application a color claim, 71 per cent of those Offices that responded to the questionnaire indicated that they will assist the applicant in that regard, in the sense of explaining to the applicant the functioning and drafting of a color claim²¹.
28. With regard to the matter of fees, of those Offices that responded to the questionnaire, 69 per cent confirmed that they check the accuracy of the fees before sending the application to the International Bureau²², and furthermore, although of somewhat lesser importance, 21 per cent of those Offices also confirmed that they accept to transmit to the International Bureau the fees payable in connection with an international application²³.
29. A number of questions in the questionnaire referred to certain other tasks that might be carried out by Offices, which, while useful in the overall context of the international filing, may not be considered as of direct benefit to applicants, as such. Thus, when asked if they check in order to verify the entitlement of an applicant to file an international application, of those Offices that responded to the questionnaire, 72 per cent confirmed that they do²⁴. Likewise, 76 per cent of those Offices indicated that they check the accuracy of a priority claim²⁵. If an international application contains an indication to the effect that a mark is in standard characters, 90 per cent of those Offices that responded to the questionnaire confirmed that they check the appropriateness of such an indication²⁶.
30. At the conclusion of this part of the questionnaire, Offices were requested to indicate whether they charge applicants a fee for the provision of information and/or assistance²⁷ and, in addition, whether, in the absence of the requirement of a basic mark, the Offices would be ready to provide such services to international applicants²⁸. To the first question, of those Offices that responded to the questionnaire, 26 per cent said that they do charge a fee, and in response to the second question, 45 per cent confirmed that they would continue to provide such services in the absence of the requirement of a basic mark.
31. To summarize, the following is a list of the principal non-mandated services provided, to a lesser or greater extent, by Offices, acting as Office of origin, at the international filing stage:

²¹ Question 16.
²² Question 17.
²³ Question 18.
²⁴ Question 7.
²⁵ Question 8.
²⁶ Question 14.
²⁷ Question 19.
²⁸ Question 20.

- (a) General procedures under the Madrid system.
- (b) Information and assistance regarding entitlement to file.
- (c) Ensuring use of correct official international application form.
- (d) Completion of the international application form, including linguistic assistance.
- (e) Establishment of fees.
- (f) Classification of goods and services.
- (g) Translation of list of goods and services.
- (h) Translation of description of mark.
- (i) Assistance in the drafting of a disclaimer.
- (j) Assistance in the drafting of a limitation.
- (k) Assistance regarding color claims.
- (l) Assistance regarding the claiming of Paris Convention priority.
- (m) Information regarding marks in standard characters.
- (n) Information and assistance regarding the declaration of intention to use the mark.

B. Tasks Carried out by Offices, Acting as Offices of Origin, that Are Currently Mandated by the Agreement and Protocol and by the Common Regulations (the Certification Procedure)

- 32. In accordance with Rule 9(5)(d) of the Common Regulations, in its capacity as Office of origin, an Office is required to certify a number of elements in the context of a declaration contained in the international application form.
- 33. The following are the elements to be certified:
 - (i) *The Applicant* – that the applicant named in the international application is the same as the applicant named in the basic application or the holder named in the basic registration, as the case may be.
 - (ii) *Color Marks, as such* – where there is an indication in the international application that the mark consists of a color, or a combination of colors as such, that the same indication appears with respect to the basic mark.

- (iii) *Type of Mark* – where there is an indication in the international application that the mark is three-dimensional, a sound mark or a collective, certification or guarantee mark, that the same indication appears with respect to the basic mark.
- (iv) *Description* – where the international application contains a description of the mark, that the same description appears in the basic mark.
- (v) *The Mark* – that the mark that is the subject matter of the international application is the same as in the basic application or the basic registration, as the case may be.
- (vi) *Color as a Distinctive Feature* – that if color is claimed as a distinctive feature of the mark in the basic application or the basic registration, the same claim is included in the international application or that, if color is claimed as a distinctive feature of the mark in the international application without having been claimed in the basic application or basic registration, the mark in the basic application or basic registration is in fact in the color or combination of colors claimed.
- (vii) *Goods and Services* – that the goods and services indicated in the international application are covered by the list of goods and services appearing in the basic application or basic registration, as the case may be.

- 34. The only other element that an Office, in its capacity as Office of origin, is currently required to certify under Rule 9(5)(d) of the Common Regulations is the date upon which the request to present the international application was received, or was deemed to have been received, by the Office.
- 35. The questionnaire addressed the above matters. However, given that the certification of those elements is mandatory, and thus that it was not necessary to enquire as to the provision, or not, of those services, that part of the questionnaire merely confined itself to the ascertainment of the methods and systems adopted by Offices for the purpose of performing the necessary checks, and how Offices generally handled discrepancies or deficiencies in that regard.

II. THE NATIONAL FILING STAGE - TASKS AND SERVICES WHICH ARE PROVIDED BY OFFICES DURING THE COURSE OF THE FILING/REGISTRATION OF A BASIC MARK, AND WHICH MAY IN TURN BENEFIT THE FILING OF AN INTERNATIONAL APPLICATION

- 36. It is notable that 90 per cent of those Offices that responded to the questionnaire confirmed that advice or guidance is offered to applicants with regard to the filing of a basic mark. That advice or guidance covers a wide range and includes issues such as entitlement to file an application, registrability of a mark (in terms of distinctiveness, non-descriptiveness etc.), information concerning availability for registration of a mark, classification of goods and services in accordance with the Nice classification and claiming of priority under the Paris Convention. For

more detailed information, the Working Group is invited to refer to the summarized statistical compilation of the responses to the questionnaire contained in Annex I, and in particular the response to question 28(b) in Part B of the questionnaire.

37. By way of further illustration, the following extract from the responses provided by one Office²⁹ is offered for the consideration of the Working Group:

“[The Office] gives applicants advice and guidance both in relation to the national as well as the international filing process. Some issues in relation to the applications, as such, overlap, e.g., the list of goods and services and priority. This does, in particular, benefit international applications in relation to the list of goods and services, as applicants very often include imprecise and wrongly classified goods and services in the applications. The Office aims at having correctly specified and classified goods and services in as many of the international applications as possible before the Office certifies and sends the international application to WIPO. We believe this helps both the applicant and WIPO in the process, in particular since the applicant will receive the guidance in Danish, thus making it easier for the applicant to understand why the goods or services will have to be specified in a particular way or classified in particular classes, or why a good or service will have to be translated in a particular way to both properly mirror the basic application or registration and at the same time be acceptable to WIPO.”

38. When asked if, in the absence of the requirement of a basic mark, Offices would be prepared to continue to offer advice and guidance to applicants with respect to the filing of an international application, 41 per cent said that they would, 21 per cent said that they would not, and 36 per cent said that they were not in a position to indicate either way³⁰.
39. The questionnaire also enquired of Offices as to the profile of applicants in general³¹. It requested Offices to estimate the percentage of trademark applications that are filed personally by applicants (individuals or small and medium-sized enterprises), rather than by professional representatives or corporations. Of those who responded to this question, 33 per cent indicated that such applicants account for up to one quarter of all filings and 17 per cent indicated that such applicants account for a figure between one quarter and a half of all filings. A further 19 per cent of the Offices that responded said that the figure for such filings would fall

²⁹ The Office of Denmark.

³⁰ Question 32. A small percentage did not respond to this question.

³¹ Question 34.

between a half and three quarters of all filings. Taken together, these figures suggest that a large proportion of all filings are initiated by non-professional or corporate enterprises, and this is an aspect that the Working Group may wish to take into account within the larger framework of its discussions³².

III. TASKS AND SERVICES THAT MAY BE PROVIDED BY AN OFFICE SUBSEQUENT TO THE INTERNATIONAL REGISTRATION OF A MARK

40. Finally, and while not directly related to the filing of an international application and the issue of the requirement of a basic mark, the questionnaire also addressed certain questions to Offices with regard to tasks and services that might be provided by an Office subsequently to the international registration of a mark. These questions concerned partly the issue of responding to refusals³³. A further two questions concerned the filing of subsequent designations and requests to record changes under Rule 25 of the Common Regulations³⁴. Those two latter questions might concern Offices as Offices of origin, or indeed as Offices of the Contracting Party of the holder. In the overall framework of the scope of the questionnaire, it was considered that the inclusion of those questions was merited.
41. Thus, Offices, as Offices of origin, were requested to indicate whether, in the event of the notification of a provisional refusal by the Office of a designated Contracting Party, they will assist the holder of an international registration generally in responding to such a notification³⁵. Of those Offices that replied to the questionnaire, 24 per cent confirmed that they will and 76 per cent indicated that they will not. On the other hand, when asked whether, within the context of, for example, responding to a notification of provisional refusal, such an Office will assist an applicant in the formulation of a limitation of the list of goods and/or services, 64 per cent said that they will and 34 per cent indicated that they will not³⁶.
42. Quite a substantial percentage of those Offices that responded to the questionnaire (81 per cent) confirmed that they will assist in the filing of a subsequent designation³⁷ and a somewhat lower percentage (74 per cent) indicated that they will assist holders of international registrations to file requests for changes under Rule 25 of the Common Regulations³⁸.

³² A further 9 per cent said that such filings would account for between three quarters and all.

³³ Questions 35 and 36.

³⁴ Questions 37 and 38.

³⁵ Question 35.

³⁶ Question 36.

³⁷ Question 37.

³⁸ Question 38.

IV. ASSESSMENT OF THE TASKS THAT, IN THE ABSENCE OF THE REQUIREMENT OF A BASIC MARK, WOULD BE REQUIRED TO BE PERFORMED WITH RESPECT TO THE FILING OF AN INTERNATIONAL APPLICATION, AND BY WHOM

43. With a view to establishing the tasks that would continue to be required to be performed, in the absence of the requirement of a basic mark, the document, in this part, reviews the scope of the examination presently carried out by the International Bureau, in accordance with the current regulatory regime of the Madrid system. The relevant rules of the Common Regulations are Rules 11, 12 and 13, which define, in the context of the filing of an international application, what will consist of an irregularity that will require to be remedied, when, and by whom.

Rule 12 - Irregularities with Respect to the Classification of Goods and Services

44. Rule 12 of the Common Regulations is concerned with irregularities relating to the classification of goods and services. In the event of such irregularity, it is provided by paragraph (1) of Rule 12 that the International Bureau shall make a proposal for the classification, which shall be sent to the Office of origin, at the same time as informing the applicant.
45. Under paragraph (2) of Rule 12, the Office of origin may, within three months of the notification, communicate to the International Bureau an opinion on the proposed classification. This may lead to the International Bureau either withdrawing or modifying its proposal (paragraphs (4) and (5) of Rule 12). On the other hand, the International Bureau may, notwithstanding the opinion of the Office of origin, confirm its original proposal (paragraph (6) of Rule 12).
46. Paragraph (9) of Rule 12 provides that the mark shall be registered with the classification that the International Bureau considers to be correct.

Rule 13 - Irregularities with Respect to the Indication of Goods and Services

47. Paragraph (1) of Rule 13 of the Common Regulations provides that if the International Bureau considers that any of the goods and services is indicated in the international application by a term that is too vague for the purposes of classification, or is incomprehensible or linguistically incorrect, it shall so notify the Office of origin, and at the same time, inform the applicant.
48. If, within the time allowed for responding to the irregularity notice, no proposal acceptable to the International Bureau for remedying the irregularity is made, the International Bureau shall include in the international registration the term as appearing in the international application, provided that a class has already been specified for the term

in question, along with an indication to the effect that, in the opinion of the International Bureau, the specified term is too vague, or is incomprehensible, or is linguistically incorrect, as the case may be. Where no class has been specified, the term in question shall be deleted by the International Bureau (paragraph (2) of Rule 13).

Rule 11 - Irregularities Other Than Those Concerning the Classification of Goods and Services or their Indication

49. Paragraph (1) of Rule 11 is entitled *Premature Request to the Office of Origin*, and is concerned with the situation where an Office of origin receives a request to present to the International Bureau an international application which is governed either exclusively by the Agreement, or by both the Agreement and the Protocol, before the basic mark has been registered. Obviously, in the event of the abolition of the requirement of a basic mark, there would no longer be a situation such as is now provided for under this paragraph of Rule 11.
50. Paragraph (3) of Rule 11 is concerned with irregularities in the amount of the fees paid in connection with an international application³⁹. A fees irregularity may be remedied either by the applicant or by the Office of origin, and both are notified of the irregularity.
51. Paragraph (4) of Rule 11 relates to miscellaneous irregularities, which are notified to the Office of origin, and in respect of which the applicant is at the same time informed. Those irregularities are as follows:
- (a) the international application does not comply with the requirements of Rule 2, concerning communications with the International Bureau, or the international application was not presented on the official form⁴⁰;
 - (b) the international application contains any of the irregularities referred to in Rule 15(1)⁴¹. Paragraph (1) of Rule 15 is concerned with irregularities which will affect the date of an international registration, and are as follows:
 - lack of indications allowing the identity of the applicant to be established and sufficient to contact the applicant or his representative, if any⁴²;
 - failure to designate Contracting Parties⁴³;
 - no reproduction of the mark⁴⁴;

³⁹ Rule 9(3).

⁴⁰ Rule 11(4)(i).

⁴¹ Rule 11(4)(ii).

⁴² Rule 15(1)(i).

⁴³ Rule 15(1)(ii).

⁴⁴ Rule 15(1)(iii).

- no goods and services indicated⁴⁵.
 - (c) the international application contains irregularities relating to the entitlement of the applicant to file an international application⁴⁶;
 - (d) the international application contains irregularities relating to the declaration by the Office of origin, as provided for under Rule 9(5)(d)⁴⁷. Apart from the indication of the date of receipt of the international application, this declaration is concerned only with elements that refer to the basic mark, and thus, in the absence of the requirement of a basic mark, this irregularity would become largely redundant. Whether there would continue to be participation by an Office of origin, in the absence of the requirement of a basic mark, and certification of the date of receipt by that Office, would depend upon the eventual regulatory regime to be adopted;
 - (e) the international application is not signed by the Office of origin⁴⁸;
 - (f) the international application does not contain the date and number of the basic mark. Again, this irregularity would become redundant in the event of the abolition of the requirement of a basic mark⁴⁹.
52. Paragraph 6 of Rule 11 is concerned with international applications which contain the designation of a Contracting Party which requires to receive a declaration of intention to use the mark, and where that declaration is missing (currently only the United States of America)⁵⁰.
53. It is provided under paragraph (7) of Rule 11 that if an international application is presented directly to the International Bureau⁵¹, or does not comply with the language regime provided for by Rule 6, the international application shall not be considered as such and shall be returned to the sender.
54. Apart from those irregularities noted above, which, by and large must be remedied by the Office of origin, there are a number of irregularities which must be remedied by the applicant. In those cases, the International Bureau will notify the applicant, and at the same time, inform the Office of origin⁵². Those irregularities will generally encompass the provisions of Rule 9 of the Common Regulations relating to the requirements concerning an international application.

⁴⁵ Rule 15(1)(iv).

⁴⁶ Rule 11(4)(iii).

⁴⁷ Rules 11(4)(iv) and 9(5)(d)(i) to (vi).

⁴⁸ Rule 9(2)(b).

⁴⁹ Rule 9(5)(a) and (b).

⁵⁰ Rules 7(2) and 9(5)(f).

⁵¹ Rule 9(1).

⁵² Rules 11(2) and 9(5)(a),(b) and (c).

55. Broadly speaking, the following are the elements, taken from Rule 9(4)(a) of the Common Regulations, in respect of which an irregularity may be notified by the International Bureau to the applicant, and at the same time the International Bureau will inform the Office of origin:
- (a) the name and address of the applicant have not been indicated in accordance with the Administrative Instructions⁵³;
 - (b) the name and address of the representative, if any, have not been indicated in accordance with the Administrative Instructions⁵⁴;
 - (c) where the applicant wishes to claim Paris Convention priority and includes a declaration to that effect, the name of the Office, the date of the earlier filing and, where available, the number of the earlier filing have not been indicated⁵⁵;
 - (d) the reproduction of the mark does not fit in the box provided in the official form, and/or the reproduction is not clear⁵⁶;
 - (e) the applicant indicates that he wishes to claim color as a distinctive feature of the mark and the reproduction of the mark is in black and white, but no color reproduction has been furnished⁵⁷;
 - (f) the mark consists of, or contains, matter in characters other than Latin characters, or numerals other than Arabic numerals, and the international application does not contain a transliteration⁵⁸;
 - (g) the international application contains, in respect of one or more of the designated Contracting Parties, a limitation of the list of goods and services, and the limitation refers to goods and services not covered by the main list of goods and services;
 - (h) the applicant has indicated that the mark is in standard characters and this is contradicted by the reproduction of the mark as shown in the international application⁵⁹;
 - (i) there is an indication that the mark consists of a color or combination of colors, as such, and this is contradicted by the reproduction of the mark as shown in the international application⁶⁰;

53 Rule 9(4)(i).

54 Rule 9(4)(iii).

55 Rule 9(4)(a)(iv).

56 Rule 9(4)(a)(v).

57 Rule 9(4)(a)(vii).

58 Rule 9(4)(a)(xii).

59 Rule 9(4)(a)(vi) allows for such indication in the international application.

60 Rule 9(4)(a)(vii) allows for such indication in the international application.

- (j) the international application contains a description of the mark which is not in a language of the international application⁶¹.

56. Apart from the elements above mentioned, Rule 9(4) also allows for the following:

- (a) an indication that a mark is three-dimensional⁶²;
- (b) an indication that a mark is a sound mark⁶³;
- (c) an indication that a mark is a collective, certification or guarantee mark⁶⁴.

57. It should be noted that paragraph (b) of Rule 9(4) provides additionally for the inclusion in an international application of a number of elements entirely at the option of the applicant. These would be elements that could be seen as reducing the risk of an international application meeting with a refusal in a designated Contracting Party and consist of the following:

- (a) where the applicant is a natural person and the applicant wishes to indicate the State of which he is a national, such indication⁶⁵;
- (b) where the applicant is a legal entity and the applicant wishes to indicate its legal nature, such indication⁶⁶;
- (c) where the applicant wishes to include a translation of the mark, such translation⁶⁷;
- (d) where the applicant wishes to include a disclaimer, such disclaimer⁶⁸;
- (e) where the applicant claims color as a distinctive feature of the mark, an indication by words, in respect of each color, of the principal parts of the mark that are in that color⁶⁹;
- (f) where there is a designation of a Contracting Organization and the applicant wishes to make a seniority claim, the particulars of such claim, along with the indication of a second language⁷⁰.

⁶¹ Rule 9(4)(a)(xi).

⁶² Rule 9(4)(a)(viii).

⁶³ Rule 9(4)(a)(ix).

⁶⁴ Rule 9(4)(a)(x).

⁶⁵ Rule 9(4)(b)(i).

⁶⁶ Rule 9(4)(b)(ii).

⁶⁷ Rule 9(4)(b)(iii).

⁶⁸ Rule 9(4)(b)(v).

⁶⁹ Rule 9(4)(b)(iv).

⁷⁰ Rule 9(5)(g)(i) and (ii).

58. While an international application may contain one, or several, of the elements referred to in the paragraph above, they will not be formally examined, as such, by the International Bureau and will be recorded and communicated to the Offices of the designated Contracting Parties, in the manner in which they had been received by the International Bureau.

Review of Those Tasks that, in the Absence of the Requirement of a Basic Mark, Would be Required to be Performed

59. In the absence of the requirement of a basic mark, and under the current regulatory regime of the Madrid system, the following checks would continue to be performed or required to be performed by the International Bureau, in connection with the filing of an international application:
- (a) classification of goods and services (Rule 12);
 - (b) identification of goods and services (Rule 13);
 - (c) payment of correct fees;
 - (d) required mode of communication (Rule 2) and use of official form;
 - (e) elements for granting date to the international registration (Rule 15):
 - indications allowing applicant to be identified,
 - designation of Contracting Parties,
 - reproduction of the mark,
 - indication of goods and services,
 - (f) indication of entitlement of applicant;
 - (g) depending upon eventual regulatory regime:
 - date of receipt by Office of origin,
 - signature by Office of origin,
 - signature by applicant,
 - presentation of the international application (direct or indirect);
 - (h) where relevant, declaration of intention to use;
 - (i) compliance with language regime;

- (j) Rule 9 elements:
- name/address of applicant according to Administrative Instructions,
 - name/address of representative according to Administrative Instructions,
 - details of Paris Convention priority,
 - reproduction of the mark in box, and clear,
 - color reproduction available, when color claimed,
 - transliteration of non-Latin characters or Arabic or Roman numerals,
 - correctness of limitation,
 - correctness of indication of mark in standard characters,
 - correctness of indication that mark is color, as such,
 - description in language of international application.

60. It would appear, therefore, that on the face of it, there would not be a substantial difference between the tasks now being carried out by the International Bureau and those tasks that the International Bureau would be required to carry out, in the event that there was not any longer the requirement of a basic mark.
61. In effect, only the following tasks, which are directly aligned to the requirement of a basic mark, would be directly concerned by the removal of that requirement:
- (a) premature request to Office of origin (Rule 11(1) (see paragraph 49, above);
 - (b) date and number of the basic mark;
 - (c) certification by Office of origin (Rule 9(5)(d)) which, apart from the date of receipt of the international application by the Office of origin, is concerned with the basic mark.
62. Whether, in the absence of the requirement of a basic mark, an Office of origin would be required to continue to certify the date of receipt of an international application, to be in turn required to be checked by the International Bureau, would ultimately depend upon the legal framework eventually adopted in the event that the requirement of a basic mark were removed. Thus, it might be envisaged that Offices would continue to have a formal role as a receiving office, or, as in the Hague system for the International Registration of Industrial Designs, applicants may be offered

the choice of filing directly or indirectly, with or without Offices being given the option of accepting, or not, international trademark filings under the Madrid system. On the other hand, were it to be established that international applications should, in all cases, be filed directly with the International Bureau, then the dating requirement would also become redundant.

63. The Working Group may wish to consider the potential consequences, for applicants and the International Bureau, were the role of an Office as filter or interface between Madrid users and the International Bureau no longer to exist, in whatever format.
64. If there were to be no longer a formal role attributed to an Office as an Office of origin, the International Bureau would, in effect, be required to deal with *not* a relatively small number of Offices on a regular basis, but instead with tens of thousands of individual private parties. No doubt, many of those applicants would already have experience of filing international applications under the Madrid system. However, for those applicants whose experience is limited, or indeed who may not previously have utilized the Madrid system, the absence of a formal input on the part of Offices in their capacity as Office of origin may well have substantial negative implications for all parties involved in the filing process.
65. Those implications would be likely to be many and varied and would probably include, *inter alia*, issues such as the following:
 - problems with the eventual registrability of a mark, in terms of distinctiveness and descriptiveness;
 - problems with representation of marks;
 - lack of clarity and precision in regard to descriptions of marks;
 - difficulties in the handling of applications in relation to non-traditional marks;
 - confusion with regard to the issue of color marks, the claiming of color as a distinctive feature of a mark, and marks that are color(s), as such;
 - almost certainly, difficulties in defining the specification of goods and/or services;
 - possibly, difficulties in relation to the issue of entitlement;
 - problems in the claiming of priority.
66. The implications, for the efficiency of the international procedures, of such a change, may require further elaboration and discussion and may influence decisions that would require to be taken in the context of the regulatory regime to be established, in the event that the requirement of a basic mark were to be abolished.

V. WHAT MIGHT ENSURE THAT USERS WOULD CONTINUE TO RECEIVE FROM OFFICES AT LEAST THE LEVEL OF SUPPORT AND SERVICES THAT THEY CURRENTLY RECEIVE AND THE READINESS OF OFFICES TO CONTINUE TO PROVIDE SUCH SUPPORT AND SERVICES, IN THE ABSENCE OF THE REQUIREMENT OF A BASIC MARK

67. It will be recalled that the responses to the questionnaire indicated that, at present, Offices provide a substantial level of support and services to applicants at all stages – that is to say, at the national filing stage, at the international filing stage to users of the Madrid system, and also subsequently to the international registration⁷¹.
68. The responses to the questionnaire indicated that, at present, assistance and support is primarily provided by a helpline (68%), Internet (with specific reference to the Madrid system) (64%), brochures (54%) and dedicated teams of staff members (79%).
69. It will also be recalled that it would appear that a large percentage of applicants filing basic applications are not professional representatives or corporations, but are individuals or small or medium-sized enterprises⁷².
70. Briefly, it will be recalled that Offices assist in the completion of the international application form, checking to ensure that the correct form has been used, checking the accuracy of the form (if the form has been completed directly by the applicant), checking that the form has been completed in such a way as to avoid the applicant meeting with a notification of provisional refusal, ensuring that form MM18 has been annexed, and correctly completed, when the United States of America has been designated, assisting applicants to file a seniority claim, when the European Union has been designated, assisting in the formulation and translation of lists of goods and services, assisting in the formulation and translation of descriptions of a mark, assisting in the translation of a word mark, assisting in the drafting of a disclaimer, assisting in the formulation and drafting of a limitation, assisting in the formulation of a color claim, and checking the accuracy of the fees payable in connection with an international application.
71. It has also been established from the responses to the questionnaire that the assistance and support currently being provided by Offices is not limited merely to the filing stage of a national or international application. It has been noted earlier in the document that Offices also assist holders of international registrations when it comes to responding to notifications of provisional refusal, the filing of subsequent designations and the recording of changes to an international registration.
72. Thus, while it may be that, as far as the International Bureau is concerned, and strictly in formal terms, there might not be a large difference between the tasks now being carried out by it and those tasks that the International Bureau would be required to carry out in the absence of the requirement of

⁷¹ See questions 1, 28 and 35 *et seq.*

⁷² See Question 34.

a basic mark (although the same might not be so in terms of substance (see paragraphs 64 and 65, above)), it is probably fair to say, however, that were the abolition of the requirement of a basic mark to impact upon the level of support and services being provided to users, this would be a significant concern.

73. The questionnaire requested Offices to indicate their readiness to continue to offer support and services in respect of filings by international applicants – i.e., regarding Madrid procedures, completion of the official international application form, etc., in the absence of the requirement of a basic mark. Just 45 per cent of those Offices that responded to the questionnaire replied to this question in the affirmative. On the other hand, 18 per cent of the Offices that responded to the questionnaire replied that they would in fact *not* continue to provide support or services and a substantial 35 per cent remained undecided⁷³.
74. The questionnaire also requested Offices to indicate their readiness to continue to offer to applicants the support and services that they currently offer in connection with the filing/registration of a basic mark, and which, in turn, may benefit the filing of an international application, in the absence of the requirement of a basic mark⁷⁴. This perhaps would have a more direct impact for users, and for the International Bureau, as it would impinge upon, for example, the mark, *per se*, as well as the specification and classification of the goods and/or services.
75. The percentage of those Offices responding to this question in the affirmative was lower in this case (41 per cent), with 21 per cent indicating that they would not, in fact, continue to offer such support and services, and 36 per cent remaining undecided.
76. If those responses (concerning procedures at both the international filing stage and the national filing stage) were to be representative of the approach that would be taken by the Offices of all Contracting Parties across the board, in the absence of the requirement of a basic mark, it is suggested that the impact for users of the Madrid system, and indeed for the International Bureau, could be significant.
77. The responses to the questionnaire have established the varied extent of the readiness of Offices to continue to offer support and services in the absence of the requirement of a basic mark. However, it is less clear what might ensure that users would continue to receive from Office at least the level of support and services that they currently receive. To an extent, the answer may depend, at least in part, on the extent to which Offices may, or may not, continue to have a formal role in the filing procedures under the Madrid system, were the basic mark requirement to be removed. This aspect is further considered in Part VI of the document, which follows.

⁷³ See Question 20.

⁷⁴ See Question 32.

VI. CONSIDERATION OF THE REGULATORY FRAMEWORK THAT MIGHT BE PUT IN PLACE, IN THE EVENT OF THE ABOLITION OF THE REQUIREMENT OF A BASIC MARK, AND THE IMPLICATIONS FOR USERS, IN TERMS OF OFFICES CONTINUING, OR NOT, TO OFFER SUPPORT AND SERVICES

78. It may be noted that in its earlier discussions on the issue of the possible abolition of the requirement of a basic mark and its subsequent request that a questionnaire be circulated to Offices, the Working Group essentially confined itself to the matter of the requirement of a basic mark, *per se*. That is to say, the Working Group has not, up to this time, specifically discussed in depth the nature of the legal or regulatory framework that might be put in place upon the abolition of the requirement of a basic mark, if such were to occur.
79. In particular, the Working Group has not specifically addressed the question as to whether there would continue to be participation on the part of the Offices of the Contracting Parties to the Madrid system, in the event that the requirement of a basic mark were to cease to exist. In effect, would a revised legal and regulatory system require that international applications be filed directly with the International Bureau, or optionally filed directly or indirectly (perhaps with the added provision that an Office might be entitled to elect not to accept indirect filings through its agency), or perhaps would a revised system require that international applications continue to be filed through the Office of the Contracting Party through which an applicant claims entitlement, albeit without any more the requirement to file or register also a basic mark⁷⁵?
80. It is submitted that the response to these questions would have a substantial bearing upon the issue of the scope of the services and/or guidance that Offices might be willing to continue to provide, in the event that the basic mark requirement were to be abolished, and that this is a matter that the Working Group may wish therefore to consider further, in its discussions.
81. A further issue that may have implications, in terms of Offices continuing to offer support and services, is the question as to whether or not, in the absence of the requirement of a basic mark, the revised regulatory framework would permit self-designation of the Contracting Party through which an international applicant derives his entitlement to file an international application.
82. To conclude this part, it may be noted that a certain percentage of those Offices that responded to the questionnaire (26 per cent) indicated that they charge a fee to international applicants and Madrid system users in respect of the provision of information or assistance relating to the Madrid procedures. This may be an option that would merit further exploration.

⁷⁵ This aspect was not specifically addressed in the questionnaire.

VII. ABOLITION OF BASIC MARK REQUIREMENT - CONCLUSION

Implications for the International Bureau

83. In conclusion, a number of points may be made. Firstly, as far as the implications for the International Bureau are concerned, in terms strictly of the scope of its formal examination of international applications, the provision of assistance and/or guidance by Offices to applicants is of considerable importance, but probably not critical or insurmountable, in the overall scheme of things.
84. However, as has already been noted in paragraphs 64 and 65, above, the abolition of the requirement of a basic mark, in combination with the removal from Offices of a formal role in the filing process, would be likely to have hugely significant implications for the International Bureau, in terms of logistics. The International Bureau would, in effect, be required to deal with *not* a relatively small number of Offices on a regular basis, but instead with tens of thousands of individual private parties.
85. In addition, in two respects, and as is evident from the responses to the questionnaire, the removal of the requirement of a basic mark would have significant implications for the International Bureau.
86. In the first place, it is evident from the responses to the questionnaire that a large number of applicants obtain assistance from Offices with regard to the identification and classification of goods and services, both in terms of the national filing of the basic mark, and subsequently at the international level, with respect to translation. A supplementary document has been prepared by the International Bureau (document MM/LD/WG/8/3) which contains statistical data relating to operational aspects of the work carried out by the International Bureau⁷⁶. It is evident from the data in question that a very substantial proportion of irregularity notices issued at present by the International Bureau, in relation to international applications, concern irregularities with respect to the identification or the classification of goods and services. It is suggested that if the provision by Offices of assistance in this regard were to be terminated, this would have the potential to seriously impact upon the efficiency of international filings generally and result in delays in the securing of registrations by international applicants. (However, this aspect needs also to be considered in the light of the ongoing project being undertaken by the International Bureau relating to the database of acceptable indications of goods and services).
87. It is also evident that, at the national level, when filing a basic mark, applicants currently receive from Offices a certain amount of assistance with regard to the mark itself (in terms of registrability and probably also in the preparation of the representation of the mark). Were this assistance to cease to be offered by Offices, certain consequences would be likely to ensue. In the first place, it is possible that international applicants may begin to find that they are receiving an increased number of notifications of provisional refusals on the basis of non-registrability. Furthermore, there is a distinct likelihood of an increased number of irregularities at the point

⁷⁶ This data was requested by the Working Group at its seventh session. See paragraph 3, above.

of receipt of the international application by the International Bureau, due to the representations of marks not being sufficiently clear, for publication purposes. Inevitably, the need to communicate larger numbers of irregularities and notifications of provisional refusal would impact upon the International Bureau.

Implications for Users

88. It is clear that, at present, the scope of assistance and/or guidance that applicants receive from Offices, in their capacity as Offices of origin, is wide-ranging and substantial. It is also clear that there is a degree of uncertainty with regard to the continuation of such support and services in the event that the requirement of a basic mark were to be abolished. Apart from the implications for the International Bureau, the loss of such support and services would in all likelihood be felt substantially by users. Users would be likely to be met with an increased number of irregularity notices from the International Bureau, relating to the completion of the application form itself and concerning also issues regarding the mark and the classification of goods and services. It is likely also that the disappearance of guidance and assistance from Offices, at the filing stage, would have an impact in terms of increased numbers of notifications of provisional refusal. This may, ultimately, have consequences in the context of the overall perception of the Madrid system, in terms of its efficiency, effectiveness and user-friendliness.

Future Regulatory Framework

89. As noted above, two important aspects have not yet been addressed by the Working Group. In the event of the deletion of the requirement of a basic mark, what would be the filing structure in the revised regime, and would the new regime allow for self-designation? It is submitted that the response to these questions will have a direct bearing upon the question as to the continuation, or not, of the offering by Offices of support and services to users of the Madrid system.

The Future in Perspective

90. As far as the International Bureau is concerned, in the longer term certain steps might be taken in order to alleviate the difficulties for users, in the event of the deletion of the requirement of a basic mark. These might include, for example, the making available to users of a comprehensive explanatory note on the completion of the official international application form, in the same way as has been done with respect to the application form for the filing of an international industrial design application under the Hague system for the international registration of industrial design. Offices might subsequently be willing to cooperate with the International Bureau in the provision of local-language versions of that document. A further initiative might be the inclusion of additional functionalities in the International Application Simulator currently to be found on the Madrid website. The simulator is designed to assist applicants at a pre-filing stage. It might also be possible to provide for additional sophistication in the official application forms so as to make them more interactive and reduce the scope for the filing of international applications that contain evident errors.

91. It will be recalled that under the Hague system for the International Registration of Industrial Designs, the facility of electronic filing has been available since January 2008. Were a decision taken to abolish the requirement of a basic mark in the Madrid system, consideration might be given to the introduction of an electronic filing interface.
92. A further avenue for improved interaction between the International Bureau and users of the Madrid system may lie with the establishment of the database of acceptable indications of goods and services as well as other possible means or approaches that are being explored, in conjunction with the Madrid Filing Assistant, which has been already been demonstrated to the Working Group, during the course of its seventh session.

93. The Working Group is invited to consider the above and to note the contents of the Annexes to this document.

[Annexes follow]

STATISTICAL COMPILATION OF THE RESPONSES TO THE QUESTIONNAIRE

PART A – INTERNATIONAL FILING STAGE

PART A.1 – TASKS AND SERVICES PERFORMED BY AN OFFICE, ACTING AS AN OFFICE OF ORIGIN

Introduction: Part A.1 relates to tasks and services provided by an Office, as Office of origin, that are not subject to the certification requirement referred to in Part A.2.

1. Does your Office provide general information, assistance or guidance to members of the public, with regard to the Madrid system? (*Percentage⁷⁷ based on total number of replies received, 58*):

Yes	97%
No	2%
Blank	1%

2. If the answer to question 1 is “Yes”,

- (a) Please indicate if the Office provides this service (*Percentage based on the number of “Yes” answers received for question 1, 56*):

Not very frequently	18%
Quite frequently	34%
Very frequently	48%

- (b) Please indicate in general terms the nature of the information, assistance or guidance⁷⁸ that your Office provides. (*What follows is a summary list extracted from the more detailed responses received from Offices*):

⁷⁷ Please note that, for ease, percentage figures have been rounded to the nearest full figure.

⁷⁸ A number of Offices stated that they do not provide guidance; they provide assistance.

Basic application and basic registration	(3)
Changes and amendments	(3)
Classification of good and services	(4)
Costs and Fees	(18)
Information concerning Contracting Parties	(7)
Consultations in general	(3)
Entitlement to file	(2)
Filing of an international application	(14)
Completion of forms	(23)
General information regarding the Madrid system	(15)
International application in general	(2)
Languages	(1)
Period of protection	(1)
Locating the forms	(1)
The Madrid treaties	(5)
Modes of payment	(1)
National and international registrations	(5)
Notices of irregularity from the International Bureau of WIPO	(3)
Procedures	(10)
Prior rights searches	(1)
Priority claims	(1)
Refusals	(1)
The Common Regulations	(1)
Time limits	(1)
Personal guidance	(1)
Requirements for the filing of an international registration	(2)
Subsequent management of international registrations	(1)
Training	(7)
Transformation	(1)
Translation	(3)
Statistics	(1)

- (c) How is the general information, assistance or guidance provided?
(More than one choice allowed; percentage based on the number of
“Yes” answers received for question 1, 56):

Help-line	68%
Internet (with a specific section dedicated to the Madrid system)	64%
Brochures, leaflets, etc.	54%
Dedicated staff members or team	79%
Self-service electronic search facilities for public	27%
E-mail, personalized assistance, telephone, training	28%

3. (a) In the event that an international applicant does not speak or write English, French or Spanish, does your Office assist such applicant with regard to the general filing of an international application under the Madrid system? (Percentage based on total number of replies received, 58):

Yes	64%
No	34%
Blank	2%

- (b) If the answer to question 3(a) is “Yes”, please indicate how this assistance is rendered (e.g., the Office makes available non-official versions of the official Madrid forms, in the local language).

Completion of the official forms by the Office	(5)
Consultation	(1)
Guide and brochures	(2)
Assisting the applicant to fill in the official forms	(9)
Information in national language	(14)
Non-official Madrid forms in local language	(16)
Telephone	(1)
Translation of the goods and services	(2)
Translation tool	(2)

4. Does your Office check that the international applicant has used the correct form for the filing of an international application (MM1, MM2 or MM3) so as to ensure that the Contracting Parties designated in an international application are correctly designated, in the sense that the applicant is entitled to make such designations? (*Percentage based on total number of replies received, 58*):

Yes	94%
No	4%
Blank	2%

5. Apart from the matters that are required to be certified by an Office when it is the Office of origin, does your Office check the international application form in order to ensure that:

- (a) the form has been correctly completed by the international applicant? (*Percentage based on total number of replies received, 58*):

Yes	95%
No	0%
Blank	5%

- (b) more particularly, the form has been completed in a manner such to avoid the issuing of a notification of provisional refusal by a designated Contracting Party (*e.g.*, missing translation of the mark, missing indication of the legal nature of the international applicant when it is a legal entity, indication of a second language when the European Union is a designated Contracting Party, etc.)? (*Percentage based on total number of replies received, 58*):

Yes	91%
No	5%
Blank	4%

6. Apart from the matters that are required to be certified by an Office when it is the Office of origin:

- (a) If the United States of America has been designated, does your Office check in order to ensure that form MM18 (declaration of intention to use the mark) accompanies the international application? (*Percentage based on total number of replies received, 58*):

Yes 93%

No 4%

Blank 3%

- (b) In a case where additional forms (*i.e.*, MM17 (claim of seniority) or MM18 (declaration of intention to use the mark)) may or must accompany an international application, does your Office assist in the completion of such forms? (*Percentage based on total number of replies received, 58*):

Yes 86%

No 12%

Blank 2%

7. (a) Does your Office check the entitlement (*i.e.*, domicile, nationality or establishment) of an international applicant? (*Percentage based on total number of replies received, 58*):

Yes 72%

No 26%

Blank 2%

- (b) If the answer to question 7(a) is "Yes", how does your Office check such entitlement? (*more than one choice allowed; percentages based on total number of "Yes" answers to question 7(a), 42*):

By requesting a copy of the passport of the applicant 21%

By requesting extracts of the register of commerce of the applicant 52%

Other: (mail, telephone, applicant's address, applicant's ID number in the Office's database, applicant's national ID details, applicant's website on the Internet, available databases, the national registry, other supporting documentation, copy of incorporation documents, residence permit, a declaration) 52%

8. (a) If the international application contains a priority claim, does your Office check the accuracy of such priority claim? (*Percentage based on total number of replies received, 58*):

Yes, in all cases	76%
Yes, but only if the basic application/registration does not contain such priority claim	10%
No, never	12%
Blank	2%

- (b) If the answer to question 8(a) is “Yes, in all cases” or “Yes, but only if the basic application/registration does not contain such priority claim”, please indicate how your Office carries out such a check (e.g., the Office requests a copy of the first trademark application which gave rise to the claim of priority):

Checks claim is within the time limit	(4)
Checks foreign databases	(2)
Checks national database/register/application	(16)
Checks priority documents	(6)
Requests certified translated copy of the first trademark application which gave rise to the claim of priority	(1)
Requests copy of the first trademark application which gave rise to the claim of priority	(27)
Requests official certificate bearing the filing date	(1)
Verifies databank extracts	(1)
Verifies that the priority application originated in a WTO and/or Paris Convention Member State	(1)

9. If there is a description in the basic application or in the basic registration, in a language other than the language in which it is proposed to file the international application, and the international applicant wishes to include such description in the international application, or the Office so requires, does your Office carry out the necessary translation? (*Percentage based on total number of replies received, 58*):

Yes	31%
No	67%
Blank	2%

10. (a) Does your Office assist international applicants with respect to the translation of the list of goods and/or services for an international application, if the list of goods and/or services covered by the basic application or the basic registration is in a language other than one of the languages of the Madrid system? (*Percentage based on total number of replies received, 58*):

Yes	62%
No	36%
Blank	2%

- (b) If the answer to question 10(a) is "Yes", does your Office (*more than one choice allowed; percentage based on the number of "Yes" answers to question 10(a), 36*)

Translate the list	22%
Merely check the translation appearing in the international application	69%
Other: (Charge of additional fees applied for translation service, cooperation with the applicant in the translation of the list, granting of a time limit to the applicant to correct the translation, provision of suggestions/corrections/improvements/solutions, provision of support to the applicant with the translation, refers the applicant to the English edition of the Nice Classification)	28%

11. (a) If a mark that is the subject of an international application may be translated, does your Office assist the international applicant in this respect? (*Percentage based on total number of replies received, 58*)

Yes 48%

No 50%

Blank 2%

- (b) If the answer to question 11(a) is "Yes", how does your Office provide such assistance? (*More than one choice allowed; percentages based on total number of "Yes" answers received for question 11(a), 28*):

The Office translates the mark 25%

The Office merely checks the translation appearing in the international application 69%

Other: (Provision of assistance upon request, granting of time limit to the applicant to correct the translation, provision of such assistance in just one language, suggestion of corrections/improvements, translation after consulting with the applicant) 14%

12. (a) If a mark that is the subject of an international application requires transliteration (*i.e.*, a mark not in Latin characters, or Arabic or Roman numerals), does your Office assist the international applicant in this respect? (*Percentage based on total number of replies received, 58*):

Yes 48%

No 50%

Blank 2%

- (b) If the answer to question 12(a) is "Yes", how does your Office provide such assistance? (*More than one choice allowed; percentages based on total number of "Yes" replies received to question 12(a), 28*):

The Office transliterates the mark 32%

The Office merely checks the transliteration appearing in the international application 68%

Other: (Checks against the basic application or registration, checks the transliteration provided by the applicant and suggests corrections or improvements, checks for errors in the transliteration provided by the applicant, provides information) 11%

13. If an international applicant wishes to include, in an international application, a disclaimer, does your Office assist the applicant in this respect? (*Percentage based on total number of replies received, 58*):

Yes 66%

No 33%

Blank 1%

14. If the international application contains an indication to the effect that the mark is a mark in standard characters, does your Office check the appropriateness of such indication? (*Percentage based on total number of replies received, 58*):

Yes 90%

No 9%

Blank 1%

15. If an international applicant wishes to make a limitation of the list of goods or services at the time of filing the international application, in respect of a designated Contracting Party, does your Office assist the applicant (in the sense of assisting the applicant in the formulation and drafting of such a limitation)? (*Percentage based on total number of replies received, 58*):

Yes 69%

No 29%

Blank 2%

16. If the basic mark is in color, the basic application or registration does not contain a color claim, and the international applicant wishes to include in the international application a color claim, does your Office assist such

applicant in this respect (in the sense of explaining to the applicant the function of a color claim and its implication and assisting the applicant in the formulation and drafting of the color claim)? (*Percentage based on total number of replies received, 58*):

Yes 71%

No 26%

Blank 3%

17. Does your Office check the accuracy of the total amount of the fees to be paid in Swiss francs, as indicated in the fee calculation sheet of the international application form? (*Percentage based on total number of replies received, 58*):

Yes 69%

No 26%

Blank 5%

18. Does your Office accept to transmit to the International Bureau the fees payable by an international applicant in respect of an international application? (*Percentage based on total number of replies received, 58*):

Yes 21%

No 78%

Blank 1%

19. (a) Does your Office charge a fee to international applicants/users in respect of the provision of information or assistance as referred to in any of the questions contained in Part A.1.? (*Percentage based on total number of replies received, 58*):

Yes 26%

No 72%

Blank 2%

- (b) If the answer to question 19(a) is “Yes”, please specify for which information or assistance such fees are charged:

Filling of international applications	(2)
General processing and services fee	(12)
Information regarding trademarks upon request	(1)
Translation of lists of goods and services	(3)

20. In the absence of the requirement of a basic mark, would your Office be ready to continue to provide the above mentioned tasks and services to international applicants? (*Percentage based on total number of replies received, 58*):

Yes	45%
No	18%
Do not know	35%
Blank	2%

PART A.2 – TASKS PERFORMED BY AN OFFICE, ACTING AS AN OFFICE OF ORIGIN, IN THE FRAMEWORK OF THE CERTIFICATION PROCEDURE

Introduction: Part A.2 relates to tasks performed by an Office, acting as an Office of origin, in the framework of the certification procedure. As part of the international procedure, an Office, acting in the capacity of Office of origin, is required, under Rule 9(5)(d) of the Common Regulations, to certify certain matters. The purpose of this part of the questionnaire is to determine how the Office, acting in its capacity as Office of origin, performs the certification procedure and/or how the Office remedies discrepancies, when such occur.

21. In general, what is the system used by your Office to conduct certification? (*More than one choice allowed; percentages based on total number of replies received, 58*)

The Office uses an electronic filing system that populates an international application with the previously captured data of the basic application or basic registration	10%
The Office compares the paper copy of the international application with the data relating to the basic application or basic registration, as already entered in the national system	83%

The Office compares the paper copy of the international application with the paper copy of the basic application or basic registration 38%

Other: (If the Office receives the application via email, it compares it with the data relating to the basic application or basic registration before sending this data to the WIPO databank (MAPS) (1), the Office uses all the three above mentioned systems (1), the Office has developed a system which checks and compares the goods and services between the basic application and the international application (1), the Office uses electronic filing system that allows the applicant to populate an international application with the data relating to the basic application or registration as already entered in the national system (1)) 5%

22. If it occurs that a relevant item of data (*i.e.*, data that requires certification) has been indicated in the basic application or basic registration and has been omitted from the international application (*e.g.*, the basic application or registration indicates that the mark is three-dimensional and such indication is not mentioned in the international application), how does your Office remedy such omission? (*More than one choice allowed; percentages based on total number of replies received, 58*):

The Office remedies it *ex officio*, without informing the international applicant 5%

The Office remedies it *ex officio*, after having informed the international applicant 26%

The Office remedies it *ex officio*, and subsequently informs the international applicant 7%

The Office informs the international applicant of the omission, granting a period within which the international applicant is required to respond 59%

Other: (According to the omission and to the available time limit, the Office informs the applicant before of after the correction or grants him a period within which the international applicant is required to correct it (1), the Office informs the international applicant of the omission, but the period within which the applicant is required to respond is not specified (1), the Office informs the international applicant of the omission and requires him to correct it (1), the Office informs the international applicant of the omission; the applicant must file a petition before the Director to seek recourse for the denial decision (1), the Office will try to remedy the deficiencies in consultation with the applicant through several means (1)) 9%

23. If a relevant item of data (*i.e.*, data that requires certification) has been indicated in the international application and is not included in the basic application or basic registration (*e.g.*, the international application includes a description that is not contained in the basic application or registration), how does your Office correct this discrepancy? (*More than one choice allowed; percentages based on total number of replies received, 58*):

The Office deletes it, <i>ex officio</i> , without informing the international applicant	5%
The Office deletes it, <i>ex officio</i> , after having informed the international applicant	22%
The Office deletes it, <i>ex officio</i> , and subsequently informs the international applicant	2%
The Office informs the international applicant, granting a period within which the international applicant is required to respond	69%
Other: (The Office informs the international applicant of the omission and, according to his reply, the Office keeps the description or deletes it when it extends the protection (1), the Office informs the international applicant of the omission and requires him to correct it (1), the Office informs the international applicant of the omission, but the period within which the applicant is required to respond is not specified (1), the Office informs the international applicant of the omission; the applicant must file a petition before the Director to seek recourse for the denial decision (1), the Office requires that the applicant adds the corresponding data to the basic application within a time limit (1))	9%

24. If the basic application (not yet examined) and the international application are filed simultaneously and both contain an immediately apparent error – *e.g.*, there is an indication that the mark is a three-dimensional or a sound mark, but it is evidently not the case (*e.g.*, the mark consists of a picture of a bottle and it is indicated as a sound mark), how does your Office react? (*More than one choice allowed; percentages based on total number of replies received, 58*):

The Office corrects it, <i>ex officio</i> , without informing the international applicant	0%
The Office corrects it, <i>ex officio</i> , after having informed the international applicant	14%
The Office corrects it, <i>ex officio</i> , and subsequently informs the international applicant	0%

The Office informs the international applicant, granting a period within which the international applicant is required to respond 78%

Other: (The Office has had no relevant practice so far (1), the Office corrects it in both the basic application and the international application (1), the Office requires that the applicant corrects the error in the basic application within a time limit and that he either corrects the international application himself or gives the Office the permission to make the correction (1), according to the law and practice of the country, the applicant cannot file the international application before the mark is registered before the Office (1), the Office informs the international applicant of the omission; the applicant must file a petition to the Director to seek recourse for the denial decision (1)) 10%

25. (a) If the basic application (not yet examined) and the international application are filed simultaneously and both indicate that the mark is a collective mark, certification mark or guarantee mark, does your Office check the accuracy of such indication? (*Percentage based on total number of replies received, 58*):

Yes 81%

No 17%

Blank 2%

(b) If the answer to question 25(a) is "Yes", how does your Office check the accuracy of such indication? (*Percentage based on the total number of "Yes" answers to question 25(a), 47*):

By requesting a copy of regulations, agreement, etc. 85%

Other: (Checks the data and the documents filed with the basic application (1), checks the documents attached to the basic application (1), checks the national database (2), compares basic and international applications on their face (1), contacts the applicant by phone immediately to help the applicant remedy the application (1), implements internal control (1)) 15%

26. If the basic application (not yet examined) and the international application are filed simultaneously and both contain a description of the mark in words, that is *obviously* incorrect (e.g., the mark consists of a picture of a mountain and the description is “pair of shoes with yellow laces”), how does your Office react? (*More than one choice allowed; percentage based on total number of replies received, 58*):
- | | |
|--|-----|
| The Office corrects it, <i>ex officio</i> , without informing the international applicant | 0% |
| The Office corrects it, <i>ex officio</i> , after having informed the international applicant | 16% |
| The Office corrects it, <i>ex officio</i> , and subsequently informs the international applicant | 2% |
| The Office informs the international applicant, granting a period within which the international applicant is required to respond | 68% |
| Other: (The Office has had no relevant practice so far (1), it is unlikely to occur (1), the Office will immediately contact the applicant by phone and e-mail (1), the Office requires that the applicant corrects the error in the basic application within a time limit and that he either corrects the international application himself or gives the Office the permission to make the correction (1), the Office does not check the description of the mark because there is no requirement in the national law (1), according to the law and practice of the country, the applicant cannot file the international application before the mark is registered (1), the description is not mandatory (1), the Office informs the international applicant of the omission; the applicant must file a petition to the Director to seek recourse for the denial decision (1)) | 16% |
27. If the basic application (not yet examined) and the international application are filed simultaneously and both contain a claim of color as a distinctive feature of the mark, that is *obviously* incorrect (e.g., the mark consists of the word “SKY” written in black and white and there is a claim for the color blue), how does your Office react? (*More than one choice allowed; percentage based on total number of replies received, 58*):
- | | |
|--|-----|
| The Office corrects it, <i>ex officio</i> , without informing the international applicant | 2% |
| The Office corrects it, <i>ex officio</i> , after having informed the international applicant | 14% |
| The Office corrects it, <i>ex officio</i> , and subsequently informs the international applicant | 0% |

The Office informs the international applicant, granting a period within which the international applicant is required to respond 76%

Other: (The Office has had no relevant practice so far (1), the Office corrects it in both the basic application and the international application (1), the Office will immediately contact the applicant by phone and e-mail (1), the Office does not check “color claim” since there is no requirement in the national law (1), according to the law and practice of the country, the applicant cannot file the international application before registering its mark before the Office (1), the Office informs the international applicant of the omission; the applicant must file a petition to the Director to seek recourse for the denial decision (1)) 12%

PART B – NATIONAL FILING STAGE

Introduction: Part B relates to tasks and services provided by an Office during the course of the filing/registration of a basic mark, which may in turn benefit the filing of an international application.

28. (a) Does your Office provide advice or guidance to applicants with respect to the filing of a basic application? (*Percentage based on total number of replies received, 58*):

Yes 90%

No 10%

(b) If the answer to question 28(a) is “Yes”, please indicate, in more particular terms, the extent, if any, to which it is believed that such advice or guidance may in turn benefit the filing of an international application⁷⁹:

Consultation, absolute grounds clarified; entitlement to register clarified; classification of goods and services clarified and corrected; guidance to applicants regarding completion of the forms; general information as to the registrability of a mark; if the applicant is a foreigner, the Office brings to his attention potential problems regarding entitlement; advice regarding the conducting of searches for prior rights; information regarding the characteristics of the Madrid system; information, guidance and assistance in the applicant’s mother tongue; information about Nice classification; information concerning priority claims; there is a helpdesk team

⁷⁹ Considering the diversity and richness of each reply, the replies to this question are reproduced almost *verbatim*.

within the Office that provides all necessary information; the Office helps applicants in meeting the requirements related to international applications; as the international application is based on and cannot be broader than the national application, the advice given will ensure to a large extent that the information contained in the international application should have little or no errors; all applicants who file a national application are informed of the possibility to file an international application; all applications are screened for accuracy; website, call center, information point; description of the mark; few benefits regarding the international filing; the Office provides information about freely accessible databases of national trademarks, international marks and Community trademarks; gives applicants understanding and some experience regarding trademark registration and protection; opinions and advice help the applicant to have basic applications properly filled, without mistakes or omissions; checks the applicant's address and entitlement; checks the Nice classification; checks the mark (color, verbal, figurative), advice regarding representation; checks priority documents; check that a sign is capable of being considered as a "mark"; checks the precision and the clarity of information contained in the form, which will be reproduced in the international application; general information which may benefit in long term in applying for an international registration; the Office provides general information about its processes by giving leaflets and organizing seminars; the Office advises the applicant that he or she should use the WIPO Nice Classification of goods and services, which may in turn prevent eventual notifications of irregularities from the International Bureau; The office's assistance reduces the risk that the basic application is rejected because of formality irregularities that would, in turn, affect the filing date of the basic mark and international application.

29. Does your Office carry out searches for applicants in order to ascertain the availability for registration of a basic mark? (*Percentage based on total number of replies received, 58*):

Yes	71%
No	29%

30. Does your Office provide advice or guidance with regard to the registrability of the basic mark (e.g., descriptiveness, mark contrary to morality or public order, etc.)? (*Percentage based on total number of replies received, 58*):

Yes	76%
No	24%

31. Does your Office provide assistance with regard to the classification of goods and/or services at the time of filing of a basic mark? (*Percentage based on total number of replies received, 58*):

Yes	88%
No	12%

32. In the absence of the requirement of a basic mark, would your Office be ready to provide the above-mentioned tasks and services to international applicants with respect to international applications? (*Percentage based on total number of replies received, 58*):

Yes	41%
No	21%
Do not know	36%
Blank	2%

33. (a) A number of Offices offer a so-called "fast track" procedure, at the national level, to applicants intending to use the mark that is the subject of such procedure as the basic mark for the purpose of an international trademark application under the Madrid system. Does your Office offer such a procedure? (*Percentage based on total number of replies received, 58*):

Yes	43%
No	57%

(b) If the answer to question 33(a) is "Yes", would your Office intend to continue to offer such "fast track" procedure, at the national level, in the absence of the requirement of a basic mark? (*Percentage based on total number of "Yes" answers to the question 33(b), 26*):

Yes	42%
No	19%
Do not know	39%

34. What is the percentage of trademark applications that are filed personally by applicants (individuals or small and medium-sized enterprises), rather than professional representatives or corporations? (*More than one choice allowed; percentages based on total number of replies received, 58*):

0 – 25%	33%
25 – 50 %	17%

50 – 75 %	19%
75 – 100 %	9%
Do not know	19%
Blank	3%

PART C – POST-REGISTRATION STAGE

Introduction: Part C relates to tasks and services that may be provided by an Office subsequent to the international registration of a mark.

35. (a) In the event of the notification of a provisional refusal by the Office of a designated Contracting Party, does your Office assist generally in responding to such notification? (*Percentages based on total number of replies received, 58*):

Yes	24%
No	76%

- (b) If the answer to question 35(a) is “Yes”, please indicate how such assistance is provided⁸⁰:

Information, assistance and guidance upon request; act as an intermediary for transmitting the required changes; upon request of the concerned party, in person, by phone or via email; assistance is given in understanding the meaning of the refusal process and in understanding the main items in the refusal - however, the Office does not assist in drawing up the actual response to a refusal; if the holder has designated a local address or an agent, the Office contacts him so as to take appropriate measures; the Office provides information regarding procedural matters only; the Office provides assistance regarding the grounds of a provisional refusal; the Office consults the applicant and might, in some cases, advise him on what he has to do, but the Office does not become part of the process; the Office refers the holder to an agent or a representative in the territory in which the provisional refusal was issued; the Office explains or verbally translates the refusal and gives advice on how to respond to the refusal; assistance for preparing a proper reply to the notice of irregularity; the Office explains to the holder how to proceed in a designated Contracting Party.

⁸⁰ Considering the diversity and richness of each reply, the replies to this question are reproduced almost *verbatim*.

36. If an international holder wishes to make a limitation of the list of goods and/or services (e.g., in order to respond to a notification of provisional refusal), does your Office assist such holder? (*Percentage based on total number of replies received, 58*):

Yes	64%
No	34%
Blank	2%

37. Does your Office assist international holders to file subsequent designations? (*Percentage based on total number of replies received, 58*):

Yes	81%
No	19%

38. Does your Office assist international holders to file a request under Rule 25 of the Common Regulations (e.g., change in ownership, renunciation, cancellation)? (*Percentage based on total number of replies received, 58*):

Yes	74%
No	26%

[Annex II follows]

OFFICES OF CONTRACTING PARTIES TO THE MADRID SYSTEM WHICH RESPONDED TO THE QUESTIONNAIRE ON THE TASKS PERFORMED BY THE NATIONAL AND REGIONAL OFFICES⁸¹

1. Armenia (AM)
2. Austria (AT)
3. Australia (AU)
4. Azerbaijan (AZ)
5. Bosnia and Herzegovina (BA)
6. Bulgaria (BG)
7. Bahrain (BH)
8. Bhutan (BT)
9. Benelux (BX)
10. Belarus (BY)
11. Switzerland (CH)
12. China (CN)
13. Cuba (CU)
14. Cyprus (CY)
15. Czech Republic (CZ)
16. Germany (DE)
17. Denmark (DK)
18. Estonia (EE)
19. Spain (ES)
20. Finland (FI)
21. France (FR)
22. United Kingdom (GB)
23. Georgia (GE)
24. Greece (GR)
25. Croatia (HR)
26. Hungary (HU)
27. Ireland (IE)
28. Iran (Islamic Republic of) (IR)
29. Iceland (IS)
30. Italy (IT)
31. Japan (JP)
32. Kenya (KE)
33. Kyrgyzstan (KG)
34. Democratic People's Republic of Korea (KP)
35. Republic of Korea (KR)
36. Kazakhstan (KZ)
37. Lithuania (LT)
38. Latvia (LV)
39. Morocco (MA)
40. Monaco (MC)
41. Republic of Moldova (MD)
42. Madagascar (MG)
43. Mozambique (MZ)
44. Norway (NO)
45. Poland (PL)
46. Portugal (PT)
47. Serbia (RS)
48. Russian Federation (RU)
49. Sweden (SE)
50. Singapore (SG)
51. Slovenia (SI)
52. Slovakia (SK)
53. San Marino (SM)
54. Syrian Arab Republic (SY)
55. Turkey (TR)
56. Ukraine (UA)
57. United States of America (US)
58. Uzbekistan (UZ)

[Annex III follows]

⁸¹

Contracting Parties are presented in alphabetical order according to the Standard ST.3 two-letter code.

WIPO



MM/LD/WG/6/5

ORIGINAL: English

DATE: November 11, 2008

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

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

**Sixth Session
Geneva, November 24 to 28, 2008**

CONSIDERATIONS RELATING TO THE PROPOSAL BY NORWAY

Document prepared by the International Bureau

I. BACKGROUND

1. It is recalled that, in 2007, the Assembly of the Madrid Union decided to give to the *ad hoc* Working Group on the Legal Development of the Madrid System (hereinafter referred to as “the Working Group”) an ongoing mandate to analyze issues relating to the further legal development of the Madrid system. Two sessions of the Working Group were planned for 2008. The second session – the present session – was to be devoted to discussing the issues raised by the delegations of Norway, in 2006, in a document entitled “Proposal by Norway” (document MM/LD/WG/2/9), and Japan, in 2007, in a document entitled “Contribution by Japan” (document MM/LD/WG/4/5), followed by document MM/LD/WG/4/5 Corr. and a proposal submitted informally by the Delegation of the Republic of Korea, also in 2007, entitled “Proposal for Improving the Correction System”. It is to be noted, however, that the Delegation of the Republic of Korea has since withdrawn its informal proposal, so that it is no longer under discussion.

2. It is also recalled that the Working Group ended its third (January 2007) session, with a request that the International Bureau begin to study the consequences of the proposal by Norway. In the meantime, in view of the present session, Norway has submitted a revised proposal (document MM/LD/WG/6/2) which, as explained therein, is reduced essentially to the following two issues:

(a) the deletion of the requirement of a basic application or registration, and

(b) in a subsidiary manner, the possibility of designation of the holder's country of origin within the framework of the current system.

3. Furthermore, it is recalled that during the fifth session of the Working Group, held in May 2008, the Delegation of Japan, in explaining the problem of linguistic diversity underlying its own contribution, suggested that the suppression of the requirement of a basic mark, as raised in the proposal by Norway, might be the best solution. That conclusion is now clearly reached in the new contribution that Japan has tabled for the present session (document MM/LD/WG/6/3), although the document also strongly counsels caution in the consideration of such a fundamental change in the Madrid system.

4. The present paper by the International Bureau constitutes the first step in the requested study. It aims at facilitating the discussions of the Working Group on the issues contained in the revised proposal by Norway, by identifying questions, more than by seeking to provide answers. So as to follow the natural hierarchy in the issues raised, as apparent from above, the emphasis is put on the issue of the deletion of the requirement of a basic mark, with the issue of self-designation being commented upon less exhaustively, before the document ends on a number of further considerations.

II. THE REQUIREMENT OF A BASIC MARK AND ARGUMENTS EXPRESSED IN FAVOR OF ITS RECONSIDERATION

The Requirement of a Basic Mark in the Madrid System: Legal Background

5. The Madrid system is founded on the requirement of a *basic application* filed with the Office of origin or a *basic registration* recorded in the Office of origin. The mark that is the subject of such application or registration is often conveniently referred to as the "basic mark".

6. The requirement results from Article 1(2) of the Madrid Agreement Concerning the International Registration of Marks and Article 2(1) of the Madrid Protocol Relating to the Madrid Agreement¹. It is recalled that, under the Agreement, a "national"² of any of the

¹ Hereinafter referred to as "the Agreement" and "the Protocol", respectively. Similarly, the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement will be hereinafter referred to as "the Common Regulations".

Contracting Parties may file an international application for registration (“the international application”) of his mark in *all* the other countries party to the Agreement, provided that he has already obtained the registration of said mark (“the basic registration”) in the country of origin. Under the Protocol, where an application for the registration of a mark has been filed with the Office of a Contracting Party (“the basic application”), or where a mark has been registered by the Office of a Contracting Party (“the basic registration”), the person in whose name that application or that registration stands may, provided that person is a “national” of that Contracting Party, file an international application in respect of the said mark in the territory of the Contracting Parties.

7. The requirement of a basic mark implies a two-stage relationship between that mark and the international registration, which can be summarized as follows:

Relationship at the Filing Stage: Correspondence

8. The international application must be filed through the *Office of the country of origin* (as defined in Article 1(3) of the Agreement) or the *Office of origin* (referred to in Article 2(2) of the Protocol as “the Office with which the basic application was filed or by which the basic registration was made”). The Office of origin must certify that the particulars appearing in the international application correspond to the particulars appearing in the basic application or basic registration (Article 3(1) of the Agreement and of the Protocol).

9. In particular, pursuant to Rule 9(5)(d) of the Common Regulations, the Office of origin must certify that (i) the applicant is the same as the applicant named in the basic application or is the holder of the basic registration; (ii) the mark is the same as that in the basic application or basic registration; (iii) any indications, such as description of the mark, type of mark (three-dimensional mark, sound mark, etc.), mark consisting of a color or a combination of colors, appear also in the basic application or basic registration; (iv) if color is claimed as a distinctive feature of the mark, the same claim is included in the basic application or basic registration or, if color is claimed as a distinctive feature of the mark without having been claimed in the basic application or basic registration, the mark in the basic application or basic registration is in fact in the color or combination of colors claimed; (v) the goods and services indicated in the international application are covered by the list of goods and services in the basic application or basic registration (Rule 9(5)(d)(ii) to (vi) of the Common Regulations).

[Footnote continued from previous page]

² Under both the Agreement and the Protocol, those who have their domicile or possess a real and effective commercial or industrial establishment in the territory of a Contracting Party are assimilated to nationals of that Contracting Party.

Relationship as from Registration: Dependency

10. For a period of five years from the date of the international registration, the protection resulting from the international registration remains dependent on the basic application or basic registration (Article 6(2) and (3) of the Agreement and of the Protocol). As stated in the *Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol*³, “the protection resulting from the international registration may no longer be invoked if, or to the extent that, the basic registration, or the registration resulting from the basic application is canceled, renounced, revoked, invalidated or has lapsed, or if the basic application is the subject of a final decision of rejection or is withdrawn, either within that five-year period or as a result of an action commenced within that period”. This is referred to as “ceasing of effect”. Pursuant to Article 6(4) of the Agreement and of the Protocol, the Office of origin must notify the International Bureau of a ceasing of effect. The Office is required also to notify the International Bureau of a division of a basic application or a merger of several basic applications that occurs during the period of dependency (Rule 23(1) of the Common Regulations).

11. A list of the provisions of the Agreement, the Protocol and the Common Regulations in which the notions of basic application or basic registration are used is provided in Annex I.

12. The Office of origin is thus involved in the two stages described above. On the other hand, the role that the Office of origin may play in the management of the international registration has become, under the current Common Regulations, generally limited, as holders are required to present through the Office of origin their requests for further recordings affecting an international registration only in marginal circumstances⁴.

The Trademark Registration Treaty: A First Attempt at a Base-Free International Registration System

Background

13. After several drafts and examination by three Committees of Experts and a number of consultant groups, a final text of the Trademark Registration Treaty (TRT) was signed on June 12, 1973, at a diplomatic conference held in Vienna⁵. Fifty States and 31 international organizations (governmental and non-governmental) were represented at the conference. The TRT remained open for signature until December 31, 1973, by which date a total of

³ Hereinafter referred to as “the Guide”. See paragraph 77.01 of Part B.II.

⁴ Under Rule 24(2)(a)(i) and (ii), respectively, of the Common Regulations, the Office of origin must present to the International Bureau a subsequent designation where Rule 7(1) of the Common Regulations, as in force before October 4, 2001, applies – which is the case only where Sweden is the country of origin – or where any of the Contracting Parties is designated under the Agreement. Also, under Rule 25(1)(c), where a renunciation or cancellation affects any Contracting Party whose designation is governed by the Agreement, the request for the recording of such renunciation or cancellation *must* be presented by the “Office of the Contracting Party of the holder”, which would normally be the Office of origin.

⁵ Document TRT/DC 3 CU.

14 countries had become signatories. Among these were Sweden, the United Kingdom and the United States of America, all major trading countries that were not party to the Madrid Agreement. The TRT eventually entered into force in 1980, with five Contracting States, namely, Burkina Faso, Congo, Gabon, the Soviet Union and Togo.

14 During the 11 years after the entry into force of the TRT, only two registrations were effected under the treaty. Both registrations were in the name of the same holder and both expired on August 11, 1991. The holder did not seek their renewal and at its seventh session in September/October 1991, the Assembly of the Union for the International Registration of Marks (the TRT Union) submitted to the Director General of WIPO a memorandum which proposed the freezing of the treaty. This proposal was accepted and adopted by the Assembly during the same session⁶.

15. Thus, whether it was because of some inherent defects, or because it was ahead of its time, it remains that the TRT was a failure. At any rate, its conception as a base-free system makes it a relevant precedent to consider and the history of its development should be recalled.

Objectives of the TRT

16. The Trademark Registration Treaty was intended to be more modern than the Madrid Agreement and to provide more advantages for trademark owners. It sought to avoid features of the Agreement which were seen as hindering the territorial growth of the international registration system⁷. At the heart of the discussions were the requirement in the Madrid system of a basic registration and the principle of dependency, the latter being seen as leading to possibly unjust results.

17. As indicated in document MM/I/2, *Questions for Possible Consideration by the Committee of Experts*, the need for a basic registration and the concept of dependency were seen as posing the following disadvantages for users of the system:

(a) If a mark had been refused registration in the country of origin, even though the ground for refusal may not be valid in the other Contracting States, there would be no possibility of filing internationally.

(b) Similarly, even if grounds for nullity had been confined only to the country of origin, protection would be terminated in all the Contracting States.

⁶ See, respectively, documents TRT/A/VII/1 – *Situation of the TRT Union – Memorandum to the Director General* and TRT/A/VII/2 – *Report adopted by the Assembly*. In the former document it was stated in paragraph 3 that it was “obvious that the TRT ... had not “taken off” and nothing indicates that it will ever”.

⁷ At the time of the adoption of the TRT in 1973, there were just 19 Contracting States to the Agreement, namely, Algeria, Austria, Belgium, Egypt, France, Germany, Hungary, Italy, Liechtenstein, Luxembourg, Monaco, Morocco, Netherlands, Portugal, Romania, San Marino, Spain, Switzerland and Viet Nam.

(c) Applicants of marks whose country of origin subjected the marks to a stringent examination were seen to be at a disadvantage compared with applicants whose country of origin had a less strict examination.

(d) Even if a mark holder had no intention of using a mark in the country of origin (as in the case of an export mark), the holder was obliged to have the mark registered in that country.

(e) In the case of an export mark, if use were compulsory in the country of origin, the holder of the mark would be obliged to use the mark in that country simply to avoid losing protection in the country of origin and, as a result, in all the other designated Contracting States.

(f) The requirement of prior national registration involved additional formalities and increased costs.

(g) The proprietor was obliged to maintain two registrations. In the event of an assignment of the basic mark within the dependency period, the holder of the international registration would be exposed to risk, as he would no longer have control of the basic mark.

(h) Similarly, in the event of an assignment of the international registration independently of the basic mark, the assignee might lose protection in all the designated Contracting States if the assignor neglected to maintain protection in the country of origin during the dependency period.

(i) In countries of origin where examination of the mark was carried out, it was sometimes difficult to complete the examination in time for the application for international registration to reach the International Bureau within the six-month priority period from the date of the national filing.

Main Features of the Trademark Registration Treaty, as Adopted

18. The TRT was intended to establish a multilateral trademark arrangement, providing easier procedures for securing, administering and maintaining national trademark registration effects in other countries by the presentation of a single international application, leading to a single international registration recorded in a central international register. Like the Madrid system, an international registration would amount to central recording of a “bundle of national rights”, rather than a separate property right.

19. With some exceptions⁸, the substantive aspects of rights were to be regulated by each Contracting State according to its national law. The main features of the Treaty, insofar as they diverged from the provisions of the Madrid Agreement, were notably as follows:

⁸ See notably Article 19, which provided that non-use of the trademark during an initial period of three years counted from the filing date could not result in refusal or cancellation by any State.

Filing

20. A national or resident of a Contracting State could file *directly* with the International Bureau of WIPO an international application designating the States in which protection of the trademark was desired (Article 5(2)). However, the national law of any Contracting State could provide that international applications by residents of that State might be filed through the intermediary of the national office of such State (Article 5(3)⁹). In other words, unlike the Madrid system, there was no obligation to file through the intermediary of an Office of origin, as such.

Basis

21. There was no requirement for the registration of a basic mark prior to an international filing. However, the national law of any Contracting State could provide that, where entitlement to file was derived through it, an international application could be filed only if the mark that was the subject of the international application was, at the time of the filing of that application, the subject of an application for registration in the national register of marks in that State, or already registered in the national register (Article 4(6)).

Territorial Scope

22. There was not any restriction upon the scope of Contracting States that could be designated. Therefore, the applicant's home State could be designated.

Adoption of the Madrid Protocol and Requirement of a Basic Mark: Current Context

23. The Madrid Protocol was adopted in 1989 – that is, two years before the decision was taken to freeze the TRT – with the aim of removing difficulties which had been seen as preventing certain countries from acceding to the Madrid Agreement. In that regard, if the TRT was a failure, the Protocol has been an undoubted success. At 76 on the date of the present document, its membership is well surpassing – and almost entirely absorbing, that of the Agreement¹⁰. It is also worth stressing that, following the repeal of the so-called “safeguard clause”, effective September 1, 2008, it is the Protocol, and no longer the Agreement, that applies in the mutual relations between Contracting Parties bound by both

⁹ Article 7(1) further provided that the date on which an application was so filed with the Office concerned would normally become its international registration date.

¹⁰ Out of the total of 83 Contracting Parties in the Madrid system, 27 were party to the Protocol only while just seven were party to the Agreement only. On the date of release of this document, these numbers were expected to move up to 84 and 28, and down to six, respectively, as a result of the deposit of instruments of accession to the Protocol by Sao Tome and Principe and Bosnia-Herzegovina.

treaties. Thus, all indicators, including prospects of future accessions and simulations effected by the International Bureau, suggest that the Madrid system as a whole is becoming inexorably governed by one treaty only, namely the Protocol¹¹.

24. It is recalled that, in contrast to the Agreement, the Protocol introduced the possibility of filing an international application on the basis of an application with the Office of origin. The Protocol also set aside the principle of the “cascade” that applied under the Agreement, giving applicants more freedom in the selection of their country of origin. Taken independently or combined together, these features mitigate some of the problems raised in relation to the Madrid Agreement at the time the discussions for the TRT, in particular the risk of loss of priority rights (due, in particular, to an Office of origin conducting *ex officio* examination on both absolute and relative grounds).

25. It is further recalled that, with a view to softening the inconveniences of the principle of dependency, the Protocol also introduced the possibility of transformation. More precisely, Article 9*quinquies* provides that in the event of cancellation of the international registration because of ceasing of effect – a risk exacerbated in a situation where a basic application is relied on – a designation may be “transformed” into national or regional applications in the respective Contracting Parties in which the international registration had effect, each benefiting from the date of the international registration and, where applicable, its priority date¹².

26. Nevertheless, transformation is not a panacea and the number of cases of ceasing of effect (total or partial) recorded each year, though still relatively low compared to the number of international registrations, is increasing steadily¹³.

27. Even more so, the costs, unwieldiness and constraints associated with the need to file two applications, remain a reality under the Protocol, as observed in the Revised Proposal by Norway. As the fact of a contribution by Japan on linguistic flexibility suggests, the constraints for exports marks – though already recognized at the time of the TRT – appear to be becoming even more acute as the Madrid system becomes gradually a truly worldwide system.

¹¹ For example, had the safeguard clause not applied, 95% of the 199,586 designations recorded in the International Register during the first eight months of 2008 would have been governed by the Protocol.

¹² Article 9 of the TRT provided for an analogous mechanism in case the International Bureau rejected an international application.

¹³ The number of ceasings of effect recorded in the International Register for the years 2000 to 2007 increased by 1229%, from 140 to 1,861. Although no strict correlation can be made between the two sets of figures, it is to be noted that, over the same period of time, the number of international registrations recorded in the International Register increased by 67% only, from 22,968 to 38,471. However, it is interesting to note that the proportion of these international registrations that were based on a basic application as opposed to a basic registration, has increased from 6%, in 2000, to 25%, in 2007. Moreover, amongst the 1,861 ceasings of effect recorded in 2007, 56% concerned international registrations based on an application, compared to 42% in 2000.

28. In the context of the Madrid system as it operates today, a discussion on the implications of deleting the requirement of a basic mark would therefore seem to have to focus primarily on the objectives of economy, simplicity and flexibility.

III. IMPLICATIONS OF THE DELETION OF THE REQUIREMENT OF A BASIC MARK

A Preliminary Issue: Options at the Filing Stage

29. A preliminary issue that ought to be addressed is that of the filing procedure. To what extent does a base-free international registration system necessarily presuppose direct filing with the International Bureau?

30. The precedent of the TRT would tend to indicate that one feature implies the other. Yet, it is worth noting that in the course of the discussions that led to its adoption, it was suggested that while the requirement of a prior national filing might be abandoned, the international application should still be required to be filed with the Office of the country of origin, which would make a limited examination based on grounds to be set out in the treaty¹⁴. However, it was noted that such a system would oblige an Office of origin to undertake two different types of examination and that, furthermore, the decision of some of the points which would be the subject of the “international” examination would depend of national law and local conceptions, so that the outcome would vary from country to country. In the end, the TRT, as adopted, was a direct filing system, with the further possibility for the national law of any Contracting State to provide that international applications by residents of that State might be filed through the intermediary of the national office of the said State, “so as to enable residents from countries at a distance from Geneva to file as promptly as those residing close to Geneva”¹⁵.

31. The arguments for or against indirect filing need to be reconsidered in light of today’s context and in view of the overall objective of simplicity. In particular, e-filing interfaces with databases of acceptable terms and linguistic equivalents are becoming increasingly common, fostering a gradual automation of trademark prosecution. Moreover, trademark registration procedures are perhaps more homogeneous today, owing to norm setting treaties such as TRIPS, the TLT and the Singapore Treaty. In due course, the findings of the forthcoming study on the possible introduction of filing languages in the Madrid system, recently authorized by the Madrid Assembly¹⁶, will also have to be taken into account.

¹⁴ See document MM/1/7 – *Draft Report – Dependence or Independence of the International Registration*.

¹⁵ The quote is from Ladas, who adds: “the argument ... appears specious”. See *Patents, Trademarks and Related Rights*, paragraph 808. If specious at the time, the argument has lost almost entirely its value in today’s electronic world.

¹⁶ See document MM/A/40/2 – *Proposal for a Study on the Possible Introduction of Filing Languages in the Madrid System*, dated July 31, 2008.

32. At this stage of the current discussions, it is merely suggested that the Working Group should not unconsciously exclude the possibility that indirect filing might continue to be the normal procedure, even if the requirement for a basic mark were to be deleted. The question should rather be whether Offices of Contracting Parties should still have a role to play as “Offices of origin”, should the requirement for a basic mark be deleted, and if so, what that role should then be. Nevertheless, one should query whether the current role of Office of origin has not already been greatly watered down with the April 2002 amendments to the Common Regulations. In particular, as a result of this reform, holders can file direct with the International Bureau their requests for the recording of a limitation to the list of goods and services, i.e., without any control by the Office of origin¹⁷.

Implications for the Contents and the Examination of an International Application

Prescribed Contents of an International Application and Examination Authority of the International Bureau

33. Would the deletion of the requirement of a basic mark lead to more elements and documents being filed as part of the international application to be examined by the International Bureau? It is proposed to consider this question firstly from the angle of the scope of the certification provided by the Office of origin, pursuant to Rule 9(5) of the Common Regulations, as the deletion of the requirement for a basic mark would naturally entail the disappearance of that certification.

Elements Falling Within the Scope of Certification

34. Reference is made to paragraphs 8 and 9, above, detailing the certification work currently performed by the Office of origin. In respect of that work, it is first to be observed that the only situation where certification involves some degree of original examination of the international application by the Office of origin is where color is claimed in that international application whilst it was not claimed in respect of the basic mark.

35. As to all the other elements concerned, the role of the Office of origin is to certify that the contents of the international application *correspond to that of the basic application or registration*. On the one hand, to the extent that the basic application or registration is a normal domestic application or registration, elements such as the nature of the mark, a description or a color claim, would already have been the subject of some examination; the international application thus indirectly benefits from that work. On the other hand, an electronic filing system can populate an international application with the previously captured yet unexamined data of its basic application, thereby achieving certification with little, if any, human intervention. As for the International Bureau, while it will endeavor to detect flagrant

¹⁷ Rule 25(1)(b). Furthermore, that recording will not be notified to the Office of origin (Rule 27(1)(a)).

errors in the international application and raise them with the Office of origin (so as to avoid recording what would later require a correction), it has no clear legal criteria or the authority to challenge these elements, and thus does not examine them *per se*¹⁸.

36. The question, therefore, becomes what should happen to that part of “indirect” examination, should a basic mark no longer be required.

Elements Falling Outside the Scope of Certification

37. In light of the above, it may be useful to recall that Rules 9(4) and (5), dealing with the contents of the international application, already provide for a number of important elements falling outside the scope of certification; yet, in respect of these, the International Bureau is not entrusted with a substantive examination responsibility.

38. For example, where the transliteration required under Rule 9(4)(a)(xii) is missing, the International Bureau will use its general authority under Rule 11(2) to raise an irregularity so as to obtain that compulsory element directly from the applicant. However, the International Bureau will not question the accuracy of a transliteration, as such.

39. Two more examples of a somewhat different nature ought to be discussed. The first concerns the entitlement of the applicant to file (Rule 9(5)(a) or (b) and (c)). In respect of this, the International Bureau will check that the appropriate indications are provided, and that there is no inconsistency between these and the indication of the country whose office is the Office of origin, especially where the “cascade” applies. The International Bureau will not, however, challenge the indications given, nor request supporting documents. The second example is that of a priority claim. In that respect, the International Bureau will check if the required indications are provided and, in particular, if the date of the earlier filing is within the six-month time limit. However, the International Bureau itself will not challenge the substance of the claim, nor request a supporting document.

40. As stated above, both entitlement and priority fall outside the scope of certification by the Office of origin. Nevertheless, the question is open as to whether the precondition of a basic mark does not lead Offices of designated Contracting Parties to assume that the legitimacy of the indications provided by the applicant in respect of these two elements is somehow checked by the Office of origin. This is relevant, in particular, with respect to the priority claim, as such claim should logically also be contained in the basic application.

¹⁸ By contrast, despite the fact that the declaration provided by the Office of origin should certify that the international applicant is the same as the applicant named in the basic application or the holder of the basic registration, where indications allowing the identity of the applicant to be established are not provided, the International Bureau will raise an irregularity entailing the postponement of the date of the international registration.

41. The question therefore becomes whether, in the absence of an Office of origin, the International Bureau would be expected to conduct a more thorough examination as to some of these points. In that respect, it may be worth going back to the example of the TRT and to consider also the Hague Agreement Concerning the International Registration of Industrial Designs¹⁹.

Precedents of the TRT and of the Hague System

42. At the time of the discussions for the TRT, questions for consideration by the Committee of Experts included the issue as to whether, “in view of the fact that the international filing has to be published, the International Bureau should, at the same time, be authorized to carry out a brief examination of the mark, so that it may refuse certain filings which are obviously unacceptable in the contracting countries as a whole²⁰”. Examples of marks that might be refused by the International Bureau were marks that, by their very nature, could not constitute a mark, or marks that were contrary to morality or public order, or contravened Article 6ter of the Paris Convention.

43. These suggestions, however, were simply not pursued. It was concluded that the International Bureau would examine the application as to form, and that matters of substance would, in principle, be left to the countries in which protection was applied for. This is in line with the role of the International Bureau as it then was under the Madrid Agreement, and now is under the Agreement and Protocol. Interestingly enough, though, the TRT did provide that where the International Bureau had declined an international application, the applicant could, within a period of two months, either file with the national office of any designated State, a petition requesting the International Bureau to proceed, in respect of that State, with the international registration, or, as an alternative, file an application for registration directly in the national register, preserving the date of filing of the international application²¹.

44. Devised from the beginning as a base-free, direct filing system, the Hague system does not specifically provide a role for Offices of origin. Despite this, the International Bureau is not entrusted, in the context of that system, with any greater examination authority in respect of elements such as entitlement or priority than under the Madrid system. When it comes to the issues that, in the Madrid system, are covered by the certification by the Office of origin, one would note that under the Hague system, there is simply no counterpart to that certification. For example, the identity of the applicant will not be questioned by the International Bureau and there are no criteria for the acceptability of a description. The International Bureau has the general authority to raise an irregularity where it finds that the application does not fulfill the applicable requirements; thus, when it comes to description, what “fulfills the applicable requirements” becomes a question of common sense. This is in line with the way the International Bureau exercises its general authority under Rule 11(2) of the Madrid Common Regulations when, for example, it seeks a new reproduction of the mark when that filed with the application was of a poor quality.

¹⁹ Hereinafter referred to as the “Hague system”.

²⁰ See document MM/I/2.

²¹ See Article 9.

Review Mechanism and Transformation

45. Should examination by the International Bureau become more substantive than it is today and the International Bureau be granted the authority to turn down an application on specific grounds, the question arises as to whether a review mechanism ought to be introduced in the system. In this respect, one could think of an independent board, or of an alternative dispute resolution panel. These considerations are further developed below, in relation to central attack. One could also think of a provision similar to Article 9 of the TRT. As already noted, under that provision, where the International Bureau declined an international application the applicant could, within a period of two months, either file with the national office of any designated State, a petition requesting the International Bureau to proceed, in respect of that State, with the international registration, or, as an alternative, file an application directly for registration in the national register.

Correction of Irregularities Affecting an International Application

46. There are three distinct categories of irregularity affecting an international application, the remedying of which follows different rules. These are:

- irregularities with respect to classification (Rule 12(1));
- irregularities with respect to the indication of goods and services (Rule 13(1));
- irregularities “other than those concerning the classification of goods and services or their indication” (Rule 11).

47. The first two categories will involve the Office of origin. As to the third category, Rule 11(4) provides that the remedying of the following irregularities is the responsibility of the Office of origin:

- (a) application not presented on the correct official form, or not typed or otherwise printed, or not signed by the Office of origin;
- (b) in the case of an application sent to the International Bureau by facsimile, the original of the page bearing the mark has not been received;
- (c) where, on the face of the information contained in the application, the applicant does not appear to fulfill the conditions in Article 1(3) of the Agreement or Article 2(1) of the Protocol with regard to the Office of origin through which the application was filed;
- (d) one of the following elements is missing from the application:
 - indications allowing the identity of the applicant to be established and sufficient to contact him or his representative;
 - indications concerning the applicant’s connection with the Office of origin;

- the date and the number of the basic registration or application;
- a reproduction of the mark;
- the list of goods and services;
- an indication of the Contracting Parties designated;
- the certification by the Office of origin.

48. It is axiomatic that the elimination of the requirement of a basic mark would eradicate the possibility of irregularities that relate to that basic mark – such as missing data about that mark, or the absence of the certification. As to the other irregularities, the responsibility for their correction would depend on whether that base-free system were devised as a direct filing system, or not. It should be observed that it is already the case under Rule 11(2) that certain irregularities “other than those concerning the classification of goods and services or their indication” are to be remedied by the applicant. Thus, the choice of a direct filing system would present the advantage of a further simplification, as the responsibility for the correction of any irregularities would necessarily lie with a single interlocutor with the International Bureau, namely the applicant.

Implications on Grounds of Refusal Available to Offices of Designated Contracting Parties

49. Article 5(1) of the Protocol establishes the right for the Office of a designated Contracting Party to declare, in a notification of refusal, that protection resulting from an international registration cannot be granted. This provision further provides that “any such refusal can be based only on the grounds, which would apply, under the Paris Convention for the Protection of Industrial Property, in the case of a mark deposited direct with [that] Office (...)”²². This provision is usually understood to refer to the limited series of grounds of refusal listed under Article 6*quinquies*(B). However, as pursuant to the wording of paragraph (A)(1) of Article 6*quinquies*, this provision applies where the mark at issue has been *registered* in the country of origin, the concern has been raised that, if the requirement of a basic mark were eliminated, the benefit of the limitation in the list of possible grounds of refusal would be lost. On second thoughts, this concern may not be justified.

50. Obviously, the conditions laid out in paragraph (A)(1) of Article 6*quinquies* for the application of paragraph (B) are always met in respect of an international registration effected under the Agreement. Not only does the latter require a prior registration, but also, under both the Agreement and the Paris Convention, the country of origin is determined according to the same principle, that of the so-called “cascade”²³. Under the Protocol, the international registration may, however, be based on a mere application and, moreover, the country of origin may be freely chosen from among those in respect of which the applicant is entitled. Thus,

²² The wording in Article 5 of the Agreement is almost identical.

²³ See Article 6*quinquies*(A)(2) of the Paris Convention.

under the Protocol, the holder may very well have his basic mark in another country than the one that would, for the purpose of Article 6*quinquies*, be his country of origin. In fact, he may have no registration in that latter country at all.

51. Article 5 of the Protocol thus cannot be understood as incorporating Article 6*quinquies* of the Paris Convention as such. It merely establishes, by reference, what grounds of refusals are available to the Offices of designated Contracting Parties, amongst which are the limited grounds listed under Article 6*quinquies*, as well as grounds resulting from the application of other provisions of the Paris Convention²⁴. Consequently, the deletion of the requirement of a basic mark could be envisaged without any necessary impact as to the scope of the grounds of refusal already available under Article 5.

52. On the other hand, it is worth recalling that Article 6*quinquies* only refers to the form of the mark itself, and not to the ancillary elements relating to that mark, for example its description, or a color claim. As indicated previously, at present, such elements fall within the scope of the certification by the Office of origin. Furthermore, Offices of designated Contracting Parties cannot base a refusal on such formalities. However, the elimination of the requirement of a basic mark would suppress that certification and, unless greater examination responsibility is imposed on the International Bureau as to such elements, it might be worth giving more flexibility to Offices of designated Contracting Parties in terms of their right to issue a refusal. In other words, a new balance may need to be struck.

Implications for Third Parties

53. Reference is made to paragraph 10, where the principle of dependency is explained. It is axiomatic that the elimination of the requirement of a basic mark would entail the disappearance of this principle. The first question, therefore, is whether this principle is a necessary feature of the Madrid system.

54. In this respect, it should be recalled that the suppression of the concept of dependency has already been envisaged in the history of the Madrid system. When the Madrid Agreement was originally adopted in 1891, dependency was perpetual. At the Nice Conference of 1957, it was argued that this principle was hardly compatible with the Paris Convention, which provides that “when a mark has been duly registered in the country of origin and then in one or more of the other countries of the Union, each of these national marks shall be regarded, from the date of its registration, as independent of the mark in the country of origin....²⁵”. It was thus proposed to delete the words in Article 6 on which rests this principle of dependency.

²⁴ Notably, Articles 6*bis*, 6*ter* and 6*septies*, must be applied as well. See G.H.C. Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property*, BIRPI, 1969, page 114, now WIPO publication No. 611. On the other hand, the international mark should not be refused on grounds not applicable to national filings.

²⁵ Article 6D of the London Act, the equivalent of which, in the current (Stockholm) Act, is Article 6(3).

55. As reported in *The First Hundred Years of the Madrid Agreement*²⁶, “the proposal was, however, judged too radical in that it went from a situation of total dependence to one of total independence. In particular, it was considered [that] the single procedure made possible by the Madrid Agreement meant not only that there was one filing, a uniform duration, one renewal and one set of procedures for the transfer of the registration, but also that there was one procedure for attacking and bringing about the invalidation of an international registration. (...) The concern to preserve the benefits of the single procedure which in this context, has become known as the possibility of “central attack”, resulted in the adoption of the compromise of a dependence limited in time. The international registration would become independent after a period of five years from the date of the international registration”.

56. It may be observed, however, that the possibility of transformation, which was introduced under the Protocol with a view to softening (for the holder) the inconveniences of the principle of dependency in general, perhaps dilutes (for third parties) the interest of central-attack. In any event, to the extent that central-attack is still viewed as a useful feature of the system, the subsidiary question becomes, how to compensate the loss of this mechanism if the requirement of a basic mark were eliminated?

57. In the context of the development of the TRT, several alternatives to central attack were put forward, although in the end, none was retained and the TRT was adopted without any central mechanism to protect the interests of third parties. In particular, there were some proposals to entrust the International Bureau with the responsibility of screening applications with a view to detecting conflicting marks in the International Register, or any conflicting mark in general²⁷.

58. Another proposal – tabled by AIPPI – rather envisaged giving the “owners of a prior international registration the possibility to defend themselves in a simplified manner against identical or similar international registrations by other firms” by raising objections to new international registrations on account of their prior rights in simple opposition proceedings²⁸. That proposal further envisaged that any interested party should be able to oppose an international registration on the ground that it was effected by a person who lacked entitlement. However, in that respect, the proposal did not go as far as to indicate “whether and how certain proofs concerning the existence or non-existence of the necessary qualification should be requested either from the opposer or from the owner of the contested international registration”.

59. The proposal provided that the effect of decisions in successful proceedings “should be strictly limited to the formal cancellation of the international registration”. It was thus envisaged that the decision would have no effect as a legal precedent which would influence

²⁶ WIPO publication No. 880, 1991, pages 45 and 46.

²⁷ See in particular document TRT/I/8 – *Proposition submitted by the ICC delegation in considering Article 7 of the draft treaty*, TRT/WG/1/1 – *Proposal presented by the United Kingdom* and TRT/WG/1/2 – *Proposal presented by the Netherlands*.

²⁸ Document TRT/I/9 – *Tentative Suggestions for a System of Opposition Proceedings at WIPO as an Alternative to the Proposals Concerning Central Attack*.

the situation if the applicant chose to assert his claims by means of a national application. On the contrary, the proposal clearly stated that the “transformation” mechanism foreseen in Article 9 of the TRT would become available as a result of such cancellation.

60. Finally, AIPPI’s proposal envisaged that the proceedings would take place before “an authority connected with WIPO but working independently and not subject to any instructions except on matters of business administration”. What was envisaged at the time seemed to be the establishment of a permanent board, but one could also think of the establishment of an alternative dispute resolution mechanism, relying on a pool of experts accredited by the International Bureau and whose decision would be binding on the latter.

Related Considerations

Priority right

61. Without the requirement for a basic mark, it is unlikely that there will exist a first Union filing either. The TRT provided that a regularly filed international application should be equivalent to a regular national filing, for the purposes of claiming the priority under the Paris Convention of a first application to register the same trademark (Article 28). Similarly, in the Hague system, there are provisions under each of the three Acts, establishing the value of the international registration as a first filing in the other countries of the Paris Union²⁹. It will have to be considered whether, under the Madrid system, the elimination of the requirement of a basic mark would entail the need for such a provision.

Database of Acceptable Terms for the List of Goods and Services

62. The International Bureau is currently working on the establishment of a database of acceptable terms, with a view to eradicating the risk of irregularities under Rules 12 and 13 of the Common Regulations. The database builds on the alphabetical list of the *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement*, the daily flow of new terms accepted by the International Bureau in the course of its registration activities, as well as on the databases used by certain offices and with whom the International Bureau is cooperating. Despite this, there will still remain situations where the applicant would, for certain goods and services covered by his basic mark, be forced to use the terms included in the list associated with that mark instead of the equivalent accepted terms of the database. The elimination of the requirement of a basic mark would, however, allow a global database of acceptable terms to serve its goal in an optimal manner.

²⁹ Article 4(4) of the 1934 Act, in respect of which one may usefully refer to Bodenhausen’s Guide to the Application of the Paris Convention, *supra*, footnote 24, p. 39. Article 7(1) of the 1960 Act is less explicit. Article 6(2) of the Geneva Act, which, by virtue of Article 2, also extends to members of the World Trade Organization, is more explicit.

IV. SELF-DESIGNATION

63. “Self-designation” is the expression used to refer to the possibility that, with respect to a given international application or the registration resulting therefrom, the Contracting Party through which one derives his entitlement may also be a designated Contracting Party.

64. Article 3*bis* of the Protocol, second phrase, clearly prohibits the possibility for an international applicant, or the holder of an international registration, to designate the Contracting Party whose office is the Office of origin. The same principle applies under the Agreement, although there the prohibition is indirectly stated³⁰. Because of this feature, it is often said that self-designation is not allowed under the Madrid system.

65. Obviously, should the requirement of a basic mark be eliminated, this prohibition could, by the same token be lifted, inasmuch as there would no longer be an Office of origin. Alternatively, it could remain an optional feature of the system, made dependent upon a declaration by Contracting Parties, as under the Hague Agreement³¹.

66. More interesting, however, is the question as to whether the prohibition of self-designation could be lifted, whilst the requirement of a basic mark would be kept. Obviously, that could not be achieved without an amendment of Article 3*bis*. But, should the latter be envisaged, then at least two specific issues would require consideration.

67. The first issue concerns the examination of the international mark in the designated Contracting Party whose office had served as the Office of origin for that mark. In theory, simplified procedures only should apply, as the normal procedures would have already taken place in respect of the basic mark. In particular, the mark would already have been the subject of an examination of substance that the office in question normally carries out with respect to direct filings.

68. The second issue concerns replacement. It is recalled that Article 4*bis*(1) of the Agreement and of the Protocol provides that a mark that is the subject of a national or regional registration in the Office of a Contracting Party is, under certain conditions³², deemed to be replaced by an international registration of the same mark. Notably, replacement occurs in a designated Contracting Party provided that “the protection resulting from the international registration extends to the said Contracting Party under Article 3*bis*(1) or (2)”. Modifying this latter provision of the Protocol to allow self-designation would,

³⁰ This prohibition derives from the words “Nationals of any of the contracting countries may, in all the other countries, secure protection of their marks (...)”, contained in Article 1(2), first sentence.

³¹ See, in particular, Article 14(3) of the 1999 Act.

³² These conditions are made clear in the Protocol text. In the *Basic Proposal for the Madrid Protocol* submitted at the Conference of Madrid of 1989, the notes concerning Article 4*bis*(1) stated that “this provision – as well as paragraph (2) – is in essence the same as it is in the Stockholm Act but has been redrafted for greater clarity”. See document MM/DC/3, paragraph 133. Against this background, the position of the International Bureau is that the conditions under which replacement takes place are the same under the Agreement and the Protocol. See in particular the Guide, paragraph 87.01.

consequently, allow for the application of replacement in the country of origin³³, unless Article 4*bis* itself were also amended with a view to avoiding that consequence. In any event, the implications of replacement on the principle of dependency would need to be carefully considered.

V. FURTHER CONSIDERATIONS

69. If the Working Group wanted to consider further the implications of the elimination of the requirement of a basic mark, other aspects of the system could also be open to discussion.

Replacement

70. As suggested in the proposal by Norway, one of the issues is replacement. In that respect, it is to be noted that the TRT contained a rather elaborate provision establishing that if, at the date of international registration, the holder was also the holder of a national registration for the same mark and the same goods or services in any designated State, his rights under the TRT would be deemed to include all rights existing under the national registration. The provision also clearly established immunity against refusals and specified what happened following the expiration of the national registration. Unlike under the Madrid system, there was provision for the international applicant to make a declaration in the international application with respect to an earlier nationally registered mark, requiring that a certified copy be furnished. The TRT Regulations further specified the contents of that declaration, although it seems that they did not provide for a specific examination of the declaration by the International Bureau.

Designation-Specific Lists of Goods and Services

71. A broader issue that the Working Group might want to reflect upon, especially in light of the increasing automation of trademark systems, is the merit of introducing designation-specific lists. If feasible, this would give applicants and holders more flexibility in the use of the system as well as more legal certainty, and guarantee clearer information in general for the benefit of the broader trademark community. Finally, the deletion of the requirement for a basic mark would probably allow the Madrid system to evolve more easily to handle new types of marks, it being understood that the fundamental right would remain for Offices of Contracting Parties to refuse protection to something that does not correspond to the definition of a mark according to their legislation.

³³ However, as Article 4*bis*(1)(iii) requires that the extension take effect *after* the date of the national or regional registration”, replacement would not – as the text stands – occur if the self-designation is made in an international application filed on the same date as the basic application.

Freedom of Choice as to the Office of Origin

72. The Working Group may also want to consider other ways of introducing more flexibility in the system without going as far as eliminating the requirement of a basic mark. Thus, the notion of Office of origin could be revisited.

73. As indicated in paragraph 5, above, the Madrid system is founded on the requirement of a basic mark with the Office of origin. It is, however, a further requirement of the system that the applicant have the nationality of a Contracting Party (or the nationality of a member State of a Contracting Party), or that he have his domicile or possess a real and effective industrial or commercial establishment in the territory of a Contracting Party. The requirement of an “entitlement” to use the system results from Article 1(3) of the Agreement and Article 2(1) of the Protocol.

74. It should be noted that, as devised, the system links the two requirements together, so that it is in fact necessary that the applicant be entitled through a connection with the Contracting Party whose office is the Office of origin. In theory, however, the two requirements could be disconnected from one another. If so, the basic mark would not necessarily have to have been filed with the Contracting Party of entitlement of the applicant, but in any Contracting Party of the system, for example in a part of the globe where the applicant has a commercial interest, without possessing any commercial or industrial establishment.

75. To the extent that the current texts do not require the Office of origin to ascertain the legitimacy of the applicant’s assertions as to entitlement, the impact on the system should be minimal. In particular, as a basic mark would continue to be required, this should allow the whole content of the certification to continue to be provided. Moreover, the mechanism of central-attack could be preserved.

76. At the time of the TRT, however, it was felt that to adopt such a measure would result in certain countries, having a less strict examination procedure, running the risk of being bombarded with applications for registration and of having their registries cluttered with marks many of which would not be used in their territories.

Need for a Diplomatic Conference

77. The Working Group should not lose sight of the fact that the elimination of the requirement of a basic mark, the introduction of self-designation or any of the further or alternative considerations raised in this chapter, could not be developed unless a Diplomatic Conference for the revision of the Protocol were to take place.

78. The Working Group is invited to expand on the considerations above, with a view to further analyzing the implications of the proposal by Norway, as contained in document MM/LD/WG/6/2 and to indicate a course of action for future work in relation to that proposal.

List of Provisions Using the Expressions “Basic application” and “Basic registration”

Madrid Agreement	
Basic registration	
Art. 1(2)	
Art. 3(1)	
Art. 6(2)	
Art. 6(3)	

Madrid Protocol	
Basic application	Basic registration
Art. 2(1)	Art. 2(1)
Art. 2(1)(i)	Art. 2(1)(i)
Art. 2(1)(ii)	Art. 2(1)(ii)
Art. 2(2)	Art. 2(2)
Art. 3(1)	Art. 3(1)
Art. 3(1)(i)	Art. 3(1)(ii)
Art. 6(2)	Art. 6(2)
Art. 6(3)	Art. 6(3)
Art. 6(3)(i)	Art. 6(3)(ii)
Art. 6(3)(ii)	
Art. 6(3)(iii)	

Common Regulations	
Basic application	Basic registration
Rule 1(xiii)	Rule 1(xiv)
Rule 8(2)	Rule 8(1)
Rule 9(4)(a)(v)	Rule 8(2)
Rule 9(4)(a)(vii)	Rule 9(4)(a)(v)
Rule 9(4)(a)(vii bis)	Rule 9(4)(a)(vii)
Rule 9(4)(a)(viii)	Rule 9(4)(a)(vii bis)
Rule 9(4)(a)(ix)	Rule 9(4)(a)(viii)
Rule 9(4)(a)(x)	Rule 9(4)(a)(ix)
Rule 9(4)(a)(xi)	Rule 9(4)(a)(x)
Rule 9(5)(b)	Rule 9(4)(a)(xi)
Rule 9(5)(d)(ii)	Rule 9(5)(a)
Rule 9(5)(d)(iii)	Rule 9(5)(b)
Rule 9(5)(d)(iv)	Rule 9(5)(d)(ii)
Rule 9(5)(d)(v)	Rule 9(5)(d)(iii)
Rule 9(5)(d)(vi)	Rule 9(5)(d)(iv)
Rule 9(5)(e)	Rule 9(5)(d)(v)
Rule 11(4)(a)(vii)	Rule 9(5)(d)(vi)
Rule 17(2)(ii)	Rule 9(5)(e)

Common Regulations (cont'd)	
Basic application	Basic registration
Rule 22(1)(a)(iii)	Rule 11(4)(a)(vii)
Rule 23(1)	Rule 17(2)(ii)
Rule 23(1)(i)	Rule 22(1)(a)(iii)
Rule 23(3)	Rule 23(3)
Rule 24(3)(d)	Rule 36(vii)
Rule 36(vii)	

[End of Annex III and of document]