



**DATE:** 17 May 2007

**REF.:** EXCO/NL07/CET/1101

## **WORKING DOCUMENT**

**MEETING:** EXCO Meeting in Amsterdam, The Netherlands

**MEETING DATE:** 3 – 6 June 2007

**DRAWN UP BY:** Kate I. Løhren - Reporter, CET Group 1

**SUBJECT:** **Ad hoc working group on the legal development of the Madrid system for the International Registration of Marks  
Third Session – Geneva,  
January 29 to February 2, 2007**

**PURPOSE:** For information

**DISTRIBUTION:** All attendees



# W I P O

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

### Third Session

Geneva, January 29 to February 2, 2007

In the Third Session the following items were on the agenda:

- I. Introduction
- II. Review envisaged in Article 9 sexies (2) of the Madrid Protocol (safeguard clause)
- III. Replacement (national Registration with International Registration)
- IV. Other Matters

#### I. Introduction:

1). 48 contracting parties were represented at this Third Session of the Working Group 9 states were represented by observers: Brazil, Cambodia, Canada, Democratic Republic of the Congo, Haiti, Iraq, Mexico, Tunisia and Uruguay. In addition The Benelux Office for Intellectual Property (BOIP), being an intergovernmental organization took part in the session in an observer capacity. 8 organisations were represented by observers: AROPI (Association romande de propriété intellectuelle) CEIPI (Centre for International Industrial Property Studies), AIM (European Brands Association), ECTA (European Communities Trade Mark Association), ATRIP (International Association for the Advancement of Teaching and research in Intellectual Property), FICPI (International Federation of Industrial Property Attorneys, INTA (International Trademark Association and MARQUES (Association of European Trademark Owners).

2). As from the last meeting of the Working Group, which took place in Geneva, June 12 – 16, 2006 the following states has acceded to the Madrid Protocol: Azerbaijan, Botswana, Montenegro, Uzbekistan and Vietnam. At present the Protocol has 75 members.

Uzbekistan has also denounced the Agreement, with effect as from January 1, 2008. The number of Madrid Union member countries bound by the Agreement would from April 15, 2007 be reduced to eight.

3). The year 2006 registration activity showed growth of 8.6 % international applications and 12.2% registrations as compared to 2005.

4). The chair from the second meeting of the Working Group, Mr. António Campinos (Portugal) was again unanimously elected as chair of the Working Group and Mr. Vladimir Oplachko (Russian Federation) and Mr. Chan Ken Yu Louis (Singapore) as Vice-Chairs.



Mr. Campinos worked very efficiently, using the lunch- and coffee-breaks to discuss issues with individual delegates in an effort to move them towards consensus.

## **II. REVIEW OF ARTICLE 9 SEXIES OF THE MADRID PROTOCOL (Safeguard Clause of concern for Contracting Parties which are members to both the Agreement and the Protocol)**

The discussion from the last meeting, in June 2006, continued. The repeal of the safeguard clause would be that designation would be governed by the Protocol instead of by the Agreement

The discussion focused on the following subjects: 1) ensure equal treatment among all Contracting Parties, 2) to allow users bound by both Treaties to benefit from the advantages offered by the Protocol while limiting any undesired effects which might arise from the Protocol, 3) simplify as much as possible.

The Group consensus was obtained as follows:

The Working Group is requesting the International Bureau to prepare draft amendments to Article 9 sexes and the Common Regulations following the principles below:

1. The safeguard clause should be amended to the effect of clearly establishing that, in the relationship between countries bound by both the Protocol and the Agreement, the provisions of the Protocol alone shall apply.
2. The amendment should also specify that, notwithstanding the above, a declaration on individual fees by a State party to both the Protocol and the Agreement shall not be applicable to the renewal of an international registration in respect of that State if the territorial extension to that State was effective from a date prior to the amendment.
3. The Assembly would be entitled to repeal the provision only after the expiry of a period of 10 years as from the date of entry into force of the amendment, and by a special three fourths majority (only States bound by both treaties having the right to vote).

## **III. REPLACEMENT**

1). Article 4 *bis* (1) of the Madrid Agreement and of the Madrid 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 conditions, deemed to be replaced by an international registration of the same mark.

The basic principles which govern the replacement procedure are the following:

- a) both the national or regional registration and the international registration are in the name of the same holder
- b) protection resulting from the international registration extends to the Contracting Party in question
- c) all the goods and services listed in the national or regional registration are also listed in the international registration and



- d) the extension of the international registration to that Contracting Party takes effect after the date of the national or regional registration

It appears, however, that many Contracting Parties have not adopted any specific provisions and most offices have not established any fees structure.

- The Working Group concluded that the harmonization of the replacement work of offices should be pursued;
- The Working Group agreed with the establishment of an internet forum during the second part of 2007 and was requesting the International Bureau to study the feasibility of making this forum a multi-directional one;
- The International Bureau should recall the objectives of replacement in the form of a document to be posted on the forum website, with a view to ascertaining if current Office practices met these objectives;
- At the same time, and independently, the International Bureau would conduct a survey of Office practices

#### **IV. OTHER MATTERS**

##### **1. Proposal for a New Rule 1 bis**

The Agreement and the Protocol are independent, parallel treaties with separate, but overlapping memberships.

What happens if a State bound by both treaties denounces the Agreement? It is important to avoid an International Registration holder losing rights when a Contracting Party moves from one treaty to another.

A draft amendment will be prepared by the Secretariat for approval by the Working Group at its next session

##### **2. Level of services should commensurate with the Individual Fees Charged and the Length of the Applicable Refusal Period.**

Many of the delegations expressed worries due to small resources since it has been experienced that the processing of the filings through the Madrid System resulted in substantial additional work.

The discussion on the subject is continued since no agreement was obtained

#### **V. FUTURE WORK**

The Chair concluded that The Working Group was requesting the International Bureau to organize a fourth session of the Working Group, tentatively from May 30 to June 1, 2007, to consider the following agenda items:

- review the Article 9 sexies of the Madrid protocol;
- amendments to the Common Regulations;



- legal development of the Madrid Protocol, on the basis, notably, of the proposals submitted by Australia, Japan and Norway
- - Australia: Proposed: Minimum standards
  - Japan: Proposed: Flexibility in the requirement to address the linguistic diversity
  - Norway: Proposed: That the Madrid System should no longer require a prior national application/registration when filing an international trademark application.

26 March 2007  
Kate I. Løhren  
Reporter CET-Group 1