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**MEETING :** FICPI Meeting in Geneva, Switzerland

**MEETING DATE :** May 30 – June 1, 2007

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**SUBJECT:** Ad Hoc Working Group on the Legal Development of  
the Madrid System 4<sup>th</sup> Session held in Geneva  
(May 30 – June 1)

**PURPOSE:** Information

**TABLED TO:** All Attendees



## W I P O

### AD HOC WORKING GROUP ON THE LEGAL DEVELOPMENT OF THE MADRID SYSTEM 4<sup>TH</sup> SESSION HELD IN GENEVA (MAY 30 – JUNE 1, 2007)

#### **Background**

At the third Meeting of the *ad hoc* Working Group on the Legal Development of the Madrid System for the International Registration of Marks (Working Group) delegates and observers undertook work on the “safeguard clause” and Article 9*sexies*(2) of the Protocol Relating to the Madrid Agreement.

During the preceding second session of the working group it was determined that five options for development of the Madrid system existed. These included:

1. Maintain safeguard clause as present;
2. Repeal safeguard clause;
3. Repeal of the safeguard clause with measures aimed at limiting undesirable effects;
4. Restriction of the scope of the safeguard clause to cover only certain features of the international procedure (refusal and fees);
5. Restriction of the Safeguard Clause to cover only existing international registrations (freezing).

Delegates concurred that simplification of the system, to the extent possible, was essential and recognized the ultimate goal was having one treaty to govern states. Also identified as important was recognition of the importance of equal treatment among contracting parties. Finally, it was felt that end users of the Agreement and Protocol systems should benefit from the advantages of the Protocol while limiting any negative effects of that instrument. Possible repeal, or at least discussion of the possible repeal, of the safeguard clause was contemplated. It was thought that repeal could possibly be accompanied by provisions aimed at ensuring quality of services provided by Offices of designated Contracting Parties. Fixing fees charged to users was also considered.

At the third session of the Working Group it was determined that the recommendation in respect of the safeguard clause should be such that the Protocol alone would apply. However, notwithstanding the foregoing, the old fee schedule would apply to renewal of a registration. It was also considered that there should be provision for the possible repeal of the new provision in 10 years. The International Bureau (IB) was invited to prepare draft revisions to article 9*sexies*, draft of a new rule 1*bis* and revision to the common regulations under the Madrid Agreement for discussion at the 4<sup>th</sup> session.

#### **The 4<sup>th</sup> Session of the Working Group**



The International Bureau prepared and distributed the contemplated draft revisions required to enact the compromise solution decided upon at the 3<sup>rd</sup> session. In particular, a draft of Article 9*sexies* of the Protocol incorporating the compromise principles agreed to at the 3<sup>rd</sup> session was tabled. Also prepared and circulated to delegates and observers were draft revisions pertaining to contemplated implementation of amendments to the Common Regulations. A new rule 1*bis* would become the key implementing provision of the recall of the safeguard clause. Rule 1*bis* would also apply in the event that a Contracting party denounces one of the two treaties and would apply in certain cases of change in ownership. Consequential amendments flowing from revisions to Article 9 *sexies* and transitional provisions were also drafted and rounded out the proposed changes.

The final study topic for the 4<sup>th</sup> session of the working group was a proposal by Australia in relation to further work on the future development of the Madrid System. A paper comprising essentially the same information was distributed informally at the 3<sup>rd</sup> meeting of the Working Group. The new paper differed from the earlier one only at paragraphs 9, 12, 16, 19 and 22, those revisions being clarification only. Australia put forth for discussion purposes the proposal that, in discussing the development of the Madrid system, priority should be given to considering improving accessibility of information regarding international registrations. This was a position put forth by the Australian delegation and others through the Working Group series of meetings.

If agreement was reached within the Working Group, the International Bureau would prepare a draft amendment of the Protocol, for report to, and adoption by the Madrid Assembly in September 2007.

### **CET Group 1 Consideration of the Proposed Topics**

CET Group 1 members, particularly from countries who are signatories to both the Agreement and Protocol, were not generally supportive of the proposed “freeze” option for which consensus had been reached during the 3<sup>rd</sup> session of the Working Group. The need for a simplified system was clearly recognized however considered equally important was maintenance of the 12 month refusal period and the need to keep fees low. It was felt that during the Working Group meeting it was essential to, as much as possible, move away from the “freeze” option towards one more acceptable to those in countries subject to the safeguard clause.

Insofar as the Australian proposal was concerned, as might be imagined, all efforts towards raising the level of services were strongly supported.

May 31, 2007  
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