

QUESTION 52

Possible revision of the Madrid Agreement concerning the international registration of trade marks

Yearbook 1971/I, pages 130 - 131
Executive committee of Madrid, October 18 - 23, 1970

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Possible revision of the Madrid Agreement concerning the international registration of trademarks

Resolution

The Executive Committee,

I. considering that it is not expedient at the present time to make a new decision on the question of independence of the international registration with regard to the national registration of origin,

decides to pursue the study of this question.

II. As to the points III, IV, V, VI and X of the list of questions of BIRPI (MM/I/2), the Executive Committee of IAPIP approves the following report of the Working Committee:

a) Territorial limitation

With regard to question III on territorial limitation, a majority has expressed itself in favour of a generalized limitation, that is in favour of an obligation for the applicant of choosing already at the filing of the international application, those countries in which he wishes to protect his mark.

A majority has also spoken in favour of an obligation for the applicant to designate at last three countries at the filing of the application.

b) Number of classes of goods or services covered by the filing

With regard to question IV, the National Groups were agreed that the fees would be increased in one way or the other, in order to avoid a cluttering up of the registers. The majority has spoken in favour of the obligation to pay a fee for each class. A minority of delegates proposed that a supplementary fee should be paid, some of them from the third class and others from the fourth class, in order to take into account the fact that certain products fall in several classes simultaneously.

c) Transmission of the documents to the national offices

With regard to question V which concerns the transmission of certain documents to the National Patent Offices and the obligation of the WIPO to require such documents as a condition of the international registration, a majority has expressed itself against the introduction of provisions of this kind into the text of the Agreement.

d) Time limit for refusing protection

With regard to question VI which concerns the term within which the protection should be refused, the majority has expressed itself in favour of retaining the present term of one year, although counted from the date the international registration was published.

e) English as the second working language

With regard to question X, which concerns the possibility of adopting English as a second working language, a majority of the groups has spoken in favour of introducing English as a working language into the Madrid Agreement.

Countries which are members of the Agreement shall state which of the two working languages they wish to use.

As to the language to be used for the list of products, the following system has been considered and approved unanimously by the delegates.

- If among the countries indicated by the applicant, there appear only countries having chosen French as working language, the list of products shall be published in French only.
- If among the countries indicated by the applicant, there appear only countries having chosen English as a working language, the list of products shall be published in English only.
- If the applicant indicates countries falling in both preceding categories, the list shall be published both in French and English.

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QUESTION 52

Possible revision of the Madrid Agreement concerning the international registration of trade marks

Yearbook 1971/II, pages 59 - 61
Council of Presidents of Leningrad, May 25 - 28, 1971

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With respect to the date of the Diplomatic Conference for the revision of the Madrid Agreement

The Council of Presidents,

considering that there is no urgency in remodelling the Madrid Agreement but that a profound technical study on this subject is required,

expresses the wish

that the Diplomatic Conference for the revision of the Madrid Agreement scheduled for 1973 be postponed to a later date,

and invites the presidents of the national groups to approach their governments in this sense.

On the nature of the new instrument to be enacted

The Council of Presidents

is of the opinion that the new instrument, the draft of which is at present under consideration, should constitute a new, independent treaty and not a revision of the Madrid Agreement.

On the method of depositing an international trademark

The Council of Presidents

declares that it is in favour of the principle of independence and of the system of a direct registration, but under the two conditions that

1. a possibility of a "central attack" be provided, which is both sufficiently effective and limited to justified remedies, and
2. that the faculty be left to the several nations to impose upon their nationals to channel their international applications through their national administration,

and accepts as its directions for its representatives at the meeting of the Committee of Governmental Experts of October 1971 to seek for the means to institute a "central attack" which is sufficiently effective and limited, in starting out from the proposals made in the report of the Special Committee and in taking account of the suggestions which resulted from the debate of Leningrad.

The Council makes clear that this is a provisional position of IAPIP which it may eventually revise.

On joint deposition (Article 4, Rule 4.4)

The Council of Presidents

considers that in the case in which a number of persons jointly deposits an international application each applicant should have the quality of a national of the special agreement.

On certification marks

The Council of Presidents

is of the opinion that the international registration should not apply to certification marks and that, consequently, Rule 6, Section 3, should be deleted.

On the refusal of an application by a non-qualified applicant

The Council of Presidents

feels that the International Bureau should have the right to refuse an application in the case that an applicant, by his own declarations, does not appear to be entitled to the benefits of the treaty.

On the payment of fees

The Council of Presidents

expresses the opinion that the last sentence of Article 7, Section 4, should be changed so as to provide that when a fee has not been fully paid and the missing part of the fee is paid within a term of 3 months, the date of the registration shall be the date on which the application was received and not that on which the missing part of the fee was paid,

and declares that it is in favour of the system of payment of fees conforming to variant B of Rule 9 of the draft.

On the recordal of transfers of the international trademark

The Council of Presidents

is of the opinion that Article 14, Section 1 b, which confers to the recordal of transfers at the International Bureau the same effects as those following out of respective national recordals, should be completed to allow these effects only under the condition that the national administrations do not within a certain term refuse to acknowledge the recordal,

and it feels that Article 14, Section 1 c, which relates to the case where the new owner of the trademark is not qualified to deposit international trademarks, should be reviewed in respect of extending the benefits of this Article to any new owner of an international registration who is not qualified to invoke the Convention, but becomes so qualified before the expiration of the term of 2 years,

and further, as far as the part transfer of the international registration is concerned,

it proposes that Article 14, Section 2, should be changed to allow such part transfer not only by countries but also by classes or categories of products.

On the term for renewal of the international trademark (Article 16, Section 2 c)

The Council of Presidents

is of the opinion that the renewals should be due on the last day of the month in which the registration is to expire and not on the exact anniversary of the deposition.

On certain national requirements (Article 18)

The Council of Presidents

on the proof of use of an international mark (Section 3)

refers the question to further study and decides to continue with the question on the basis of the observations recorded in the minutes of the meeting, and

on the filing of a declaration stating that the owner of the international registration uses the mark in a given State expresses the opinion that it is proper to delete Section 4 b or that the application of this section should be limited to declarations to be produced on the occasion of the renewal.

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QUESTION 52

Possible revision of the Madrid Agreement concerning the international registration of trade marks

Yearbook 1972/II, pages 135 - 143
Council of Presidents of Cannes, April 24 - 28, 1972

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Examination of the Second Draft Trademark Registration Treaty (TRT)

1. General observations

Concerning the risk of erosion of the Madrid Agreement

The Council

takes note of the fact that the establishment of TRT will entail the risk of a certain erosion of the Madrid Agreement but has no observations to make on the means whereby such erosion might be avoided.

Concerning the institution of a central attack system

The Council

was divided on the principle of the institution of a central attack.

For this reason, the Council deems it necessary, before taking a definite position on this principle, to examine all possibilities for the institution of a 'central attack' system generally acceptable to countries which might adhere to TRT.

Therefore, the Council instructs the Special Committee to continue the search for a solution, particularly on the basis of the proposal made by Belgium.

Postponement of the Diplomatic Conference

The Council

believes that there is no reason to reconsider the recommendation made by the Council at Leningrad favouring postponement to a later date of the Diplomatic Conference for the revision of the Madrid Agreement planned for 1973.

2. Observations on the text of the TRT

Article 5 (3): Filing of the international application through the intermediary of a national office

The Council

expresses itself in favour of the maintenance, in the text of the Treaty, of Article 5, paragraph 3, subparagraph (iii), permitting the national law of a State to provide that the international application may be filed through the intermediary of the national office of that State, it being understood that this facility shall never constitute an obligation.

The Council however opposes maintenance of subparagraphs (i) and (ii), which grant to national law wider powers.

Article 5,1 (iv): Formalities for an application

The Council

believes that it is not in order to introduce in the Treaty a provision for a limitation of the number of classes which may be covered by an application.

Article 7 (2): Correction of a defect

The Council

approves the proposal to the effect that the term within which the applicant may correct a defect should run from the date of receipt of the registered letter informing him of this defect, and non from the date of the mailing of this letter by the International Bureau.

Article 9: Possibility of avoiding the effects of rejection

The Council

urges that, in cases of rejection by the International Bureau of an application for an international registration, the choice be left to the applicant between the procedure afforded by the new text, and the procedure afforded by the former text:

- the new text allows the applicant to request the national office of each designated State to call upon the International Bureau to proceed, so far as that State is concerned, with the international registration of the mark.

- The former text allows the applicant to request the national office of any designated State to grant registration of the mark on the national register, with the benefit of the priority date of the rejected international application.

Article 11: Effect of the international registration

The Council

declares itself in favour of Alternative A.

Article 12 (2) (a): Refusal of the effect of the international registration

The Council

- expresses preference for keeping to 12 months the term within which the national effect may be refused

- and favours keeping in paragraph 2 (a) (iii) the provision whereby a decision of a Court shall be binding even if not based upon any of the reasons stated in the notice of refusal.

Article 13 and others: Communication of notifications to the owner

The Council

urges that the International Bureau undertakes to communicate to the owner of an international mark every notification of an action relating to this mark originating with a national administration of other authority.

Article 14 (1) (c): Owner not qualified to claim the Convention but subsequently becoming qualified

The Council

reaffirms the position expressed by the 1971 Leningrad Council. It believes that the provision of Article 14, subparagraph (1) (c), dealing with the case of a new owner not qualified to file an international application, should be revised to grant the benefits of this provision to the new owner of an international registration who is not qualified to claim the Convention but who does become so qualified prior to the expiration of a term of 2 years.

Article 14 (4) (a): National law conditions for the notification of transfers

The Council

approves Article 14, paragraph 4 (a), which permits the national law of each State to require proof of compliance with the conditions required by law in respect of changes of ownership.

Article 14: Recordal of licences on the International Register

The Council

opposes the compulsory recordal of licence contracts on the International Register.

It deems that, by reason of the difficulties involved, a thorough study is necessary to enable the Council to reach a conclusion on the institution of an optional system of recordal of licences on the International Register.

Article 14: Changes in the owner's name and address

The Council

urges that provision be made in the Treaty for a means of recording on the International Register changes in the owner's name or address.

Article 16: Renewal of the mark - No obligation for a declaration of use

The Council

rejects the proposal under which an applicant who proceeds to the renewal of a mark would be required to file a declaration to the effect that he is using the mark in those countries for which he is seeking the renewal.

Article 16: Renewal application - Period of grace

The Council

notes that a period of grace has been provided only for the payment of the fee, and not for the filing of the renewal application.

It urges that a period of grace of 6 months also be set for the filing of the renewal application, this period not to be added to the period of grace for the payment of the fee.

The Council believes that a surcharge could perhaps be assessed against those taking advantage of the period of grace.

Article 17, Rules 9 and 28: Fees

The Council

confirms the decision of the 1971 Leningrad Council favouring Alternative B of Rule 9.

A majority falling short of constitutional requirements (14 votes against 7) expressed its preference for the subalternative of Alternative B of Rule 9 (1) (d) (iii), limiting the amount of a State fee to 75 % of the sum of all of the fees which would have to be paid in the case of a national application.

The Council states that it would be preferable for the provisions relating to fees, other than their amount, to appear in the Treaty itself rather than in the Regulations.

Article 18: National requirements - Effective use

The Council

approves the text of Article 18, paragraph 3 (a), prohibiting States from imposing an obligation to use the mark, save as a condition to the institution of an infringement action.

The Council

observes that the exclusion of the possibility of an action for infringement constitutes during this term the only penalty for the failure to use, and

- that the rights of the owner go back to the date of the international registration, and
- the owner may institute any legal action other than one for infringement on the basis of his international registration.

The Council

believes that the term for the imposition of user requirements should be set at 5 years.

The Council

adopts the observation that the wording of the phrase "has commenced the continuous use of the mark" (paragraph 3a) warrants review.

Article 18 (4): Declaration of intention to use a mark

The Council

approves Article 18, paragraph 4, which provides that declarations of intention to use filed with WIPO shall constitute compliance with national requirements.

Article 18 (6): Representation

The Council

draws the attention of WIPO on the necessity of making provision in Article 18, paragraph 6, in certain specific cases, for an address for service on the applicant.

Article 18bis: Changes recorded by national offices

The Council

approves the principle established by Article 18bis, providing for notification by the national office to the International Bureau of changes relating to an international mark, for the purpose of recordal on the International Register.

The Council believes that failure to comply with this formality should not entail any sanctions.

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QUESTION 52

Possible revision of the Madrid Agreement concerning the international registration of trade marks

Yearbook 1973/I, pages 164 - 166
28th Congress of Mexico, November 12 - 18, 1972

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Revision of the Madrid Agreement

The International Association for the Protection of Industrial Property

takes the following position on the question of the Revision of the Madrid Agreement:

On the Central Attack

noting that many Conferences of Experts, as well as several meetings to the IAIP, have failed to devise a generally acceptable method of Central Attack within the framework of TRT despite the desire of a substantial number of countries for a method of Central Attack;

noting that the question will be settled at the 1973 Diplomatic Conference whose participants will have the opportunity of proposing still further solutions to this question;

concludes that the TRT system is inherently difficult to reconcile with any method of Central Attack, that additional study is unlikely to lead to a solution, and that potential members of TRT must decide for themselves, in the event that the Diplomatic Conference fails to adopt a provision for Central Attack, whether it is in the interest of their nationals to adhere to TRT without such a provision.

On the options available to member countries - Articles 4 (6) and 5 (4)

noting that the text of TRT retains, in Articles 4 (6) and 5 (4), options whereby member countries may impose upon their nationals and residents the obligation to file or register first in their own countries, and may also exclude "self-designation";

emphasizes that these options are inconsistent with the direct and independent filing with the International Bureau which is a basic principle of TRT;

reaffirms the Resolution of the Council of Presidents at Cannes opposing the inclusion of these options in TRT.

On the systems of imposition of fees - Rules 9 and 28

noting that TRT relegates to Rules 9 and 28, the systems whereby the imposition of fees, and their distribution to the designated States, are fixed;

noting that under Article 33 the Regulations may be amended by three-quarters of the votes cast, which may be as few as three-eighths of the member countries;

noting that the question of fees is of vital importance to many countries and may determine their adherence to TRT;

reaffirms the Resolution of the Council of Presidents at Cannes that the main provisions relating to the systems for the imposition and distribution of fees should be a part of the text of the Treaty itself.

On the limitation of the number of classes - Article 13 (2)

noting that Article 13 (2) of TRT prohibits the imposition of a limit on the number of classes which may be covered in one international registration;

noting the great concern repeatedly expressed on behalf of many countries that TRT might lead to a proliferation of trademarks and a cluttering up of national registers;

believing that a limit on the number of classes which may be covered in one international registration would tend to deter excessive and unjustified claims, and that only a very small number of marks require protection in many classes;

reaffirms the position adopted by the Council of Presidents at Munich, favouring a limitation on the number of classes which may be covered in one international registration, and believes that the limit ought to be three classes.

On the term for refusing the national registration effect - Article 12 (2)

reaffirms the Resolution adopted by the Council of Presidents at Cannes to the effect that the term within which national registration effect may be refused under Article 12 (2) should be 12 months.

On the change of names and addresses of registrants - Article 14

reaffirms the Resolution adopted by the Council of Presidents at Cannes to the effect that Article 14 should provide for the recordal of changes of name and of address and, in general, declares that all changes affecting the identification as well as the identity of the owner of an international registration should be recorded, and

reaffirms the Resolution adopted by the Council of Presidents at Cannes to the effect that new owners of international registration not qualified under TRT to own such registration should be given a 2-year term within which to qualify.

On the effects of renewal of an international registration - Article 16

favours modification of the wording of Article 16 and the commentary thereunder to make it clear that renewal of an international registration under this article does not affect the applicability of national law in regard to the validity of the national effect resulting from such renewal.

On collective and certification marks

deeming that differences in national definitions of collective and certification marks, and in the requirements applicable to such marks, render impractical the inclusion of these marks in TRT at the present time;

reaffirms the decision of the Council of Presidents at Leningrad that collective and certification marks ought not to be included now as marks registrable under TRT.

On the suspension of the requirements of use - Article 18 (3)

reaffirms the Resolution adopted by the Council of Presidents at Cannes to the effect that the term during which national requirements for the use of a trademark are to be suspended under Article 18 (3) should be 5 years.

On the conditions for amending such term - Articles 18 (3) and 36

believing the time limit fixed in Article 18 (3) to be of vital importance,

states that its amendment under Article 36 ought to be subject to the same rule of unanimity as that Article provides for the term fixed in Article 12 (2) (a) (i).

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