

QUESTION 88

International registration of marks

Yearbook 1985/III, page 324
Executive Committee of Rio de Janeiro, May 13 - 18, 1985

Q88

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International Registration of Marks

Resolution

AIPPI

1. Takes note of the work done in the WIPO Committee of Experts on international registration of marks towards devising a new system to provide for an international registration which has a chance of being found acceptable to more countries than the 27 which have presently adhered to the Madrid Agreement;
2. Further takes note that there are several different ways of achieving such system, for example,
 - a modification of the Madrid Agreement,
 - a new treaty which would be a "variant" of the Madrid Agreement, and which would be linked to it,
 - a revival of the TRT, which up to now has been a failure,and that of these alternatives an important number of National Groups of countries presently adhering to Madrid are strongly of the opinion that the first one should be considered first;
3. Believes that any system should be linked to the Community Trade Mark System;
4. Believes it possible that any such system would be more attractive to more countries if,
 - a) the international registration could be based, not upon a home registration, but upon an application which might already have been subjected to an examination of the absolute grounds of refusal, and provided that this application matures into a registration,
 - b) the time limit granted to member countries for notifying a provisional refusal, which is now one year, could be extended,
 - c) the subject of fees could be reviewed,

d) a second language could be introduced;

5. Believes that the subject of limited time dependency (central attack) should be studied further;

6. Believes that if the above conditions could be fulfilled, such a system should have a good chance of acceptance by countries with examining trademark systems who are not at present prepared to join the Madrid Agreement as it stands;

7. Resolves to continue to study the detailed implications of such a system and possible solutions to the questions.

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Question 88

International Registration of Marks

Resolution

Yearbook 1986/VII, pages 207 - 209
33th Congress of London, June 8 - 14, 1986

Q 88

The AIPPI:

1. Takes note that, since the meeting of the Executive Committee of AIPPI at Rio de Janeiro in May 1985, the World Intellectual Property Organisation has published drafts of two Protocols to the Madrid Agreement (Protocol A and Protocol B: Document MACT/II/2);
notes that each of these Protocols would, legally speaking, constitute a new Treaty;
affirms that the first priority for achieving an international trade mark registration system with a wider membership should be by way of revising the Madrid Agreement;
believes that Protocol A could form the basis for such a revision or else could constitute an entirely new Treaty if a revision of the Madrid Agreement cannot be achieved;
believes that the relationships between countries party to the Madrid Agreement on the one hand and countries party to a new Treaty on the other would be very complex;
adopts the following resolution after study of the Protocols A and B:
 - on Protocol A (paragraphs 2 to 6 of this resolution)
 - on Protocol B (paragraph 7 of this resolution)
2. Notes that in countries that examine ex officio on absolute and on relative grounds (hereinafter referred to as "examination countries"), trade mark owners can be disadvantaged by the need for a home registration, in particular because of the length of time needed for an application to mature into a registration;
confirms the resolution passed by the Executive Committee at Rio (AIPPI Annuaire 1985/III) that an international registration could be based, not only upon a home registration, but also upon a home application, which might already have been subjected to an examination of the absolute grounds of refusal, provided that this application eventually matures into a registration;
believes that an application for international registration should continue to be made through the national office of the home country and that a self-designation of the home country should continue to be excluded;
notes that some examination countries (such as Australia, Canada, Finland, Israel, Japan and USA) are of the opinion that no national basis should be required.

3. Considers that even though some of the difficulties with Central Attack and national dependency which are anticipated by certain countries might be eased by introducing a system whereby the owner of an international registration that has lost its home base could have the option of filing national applications in the previously designated countries, all of which would retain the priority of the international registration, nevertheless believes that such a system would create further difficulties, in particular because:

a) it will be necessary to amend many of the national trade mark laws to allow for such a "transformation, as it is called;

b) it could jeopardise one of the principal advantages of Central Attack, namely that *inter partes* conflicts may be dealt with in the home country without a multiplicity of opposition or cancellation proceedings;

further believes that a period of 12 months to apply for such a "transformation» is, in any case, too long;

notes that certain countries that are not party to the Madrid agreement would be ready to accept the temporary (i.e. 5 years) dependency rule and Central Attack provided that it is attenuated by this proposed "transformation" system;

notes also that even some countries party to the Madrid Agreement could overcome their reservations about this solution if the accession of further countries to the Madrid Agreement would depend upon it.

4. Considers that the present time limit of 12 months for notifying a provisional refusal is sufficient, and prefers that this time limit should be maintained.- Indeed, such period has been found to be workable in countries such as Spain and Portugal where not only is an examination carried out on absolute and relative grounds, but there also exists the possibility of opposition by third parties;

takes note, however, of the apprehensions of some countries that a 12 months period may be too short for administrative reasons. The AIPPI could therefore accept a longer period if it led to a wider membership of the Madrid Agreement, but is strongly of the opinion that the period should not be more than 18 months.

5. Prefers the uniform rate system of fees as presently operated in the Madrid Agreement because a change to a system of different fees for different countries would detract from its simplicity which is one of its main advantages.

However, recognising that examination countries may be reluctant to accede to a system which does not fully compensate for the work carried out in the national offices, the AIPPI realizes that it may not be possible to maintain a uniform rate system and would accept that such countries could be compensated by granting them a supplement to the designating country fee paid by the applicant. The AIPPI also accepts that such a supplement should be set at a rate which would procure for the applicant a substantial financial advantage over filing nationally, and believes that once a fee is struck it should only be changed at fixed intervals.

6. Believes that the present system of having only one language for operating the Madrid Agreement gives rise to no problems and that any proposal to add another language would only give rise to demands that further languages be added. However, if it were a sticking point for attracting new countries to the Madrid Agreement, the AIPPI would accept English as a second official language, but this should be done only on the clear understanding that no more languages should be introduced.

7. Confirms the Resolution adopted by the Executive Committee at Rio de Janeiro that any system should provide for a link with the proposed Community trade mark system (AIPPI Annuaire 1985/III);

recalls that the issues involved in providing such a link have already been the subject of a detailed study by the AIPPI;

decides that this study should be pursued in respect of the proposed Protocol B, referred to in paragraph 1.

8. Resolves to continue the study of all solutions which could result in a more universal system for the international registration of marks, including the TRT and the global treaty presently contemplated by the WIPO.

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Question 88

International Registration of Marks

Resolution

Yearbook 1989/II, pages 306 - 307
Executive Committee of Amsterdam, June 4 - 10, 1989

Q88

The AIPPI

- having studied the basic proposal, submitted by WIPO for a Protocol relating to the Madrid Agreement concerning the International Registration of Marks which will be considered at the Diplomatic Conference in Madrid in 1989,
- taking into account its previous studies which led to the resolution adopted at the London Congress in 1986,

I. Considers that the proposed Protocol should, in substance, be welcomed to the extent that it might lead to some countries who have not yet adhered to the Madrid Arrangement acceding to the advantages provided by that arrangement, and that nationals of existing Madrid Union countries might obtain International Registrations extending to such non-member countries.

II. Is pleased to note that WIPO has, in its Protocol, reproduced the text of the Madrid Agreement while at the same time introduced the necessary modifications, thus making it easier to understand and interpret the proposed innovations. Considers however that such modifications should be reduced to a minimum in order to decrease as far as possible the discrimination between, on one hand, the applicants whose reciprocal relations shall be ruled by the Madrid Agreement only, and on the other, those between whom these relations shall be governed by the provisions of the Protocol.

III. Believes that nevertheless it is necessary to make certain observations regarding the Protocol and consequently adopts the following resolution in respect of the five fundamental modifications which the Protocol contains.

The AIPPI

1. Concerning the basis for an international registration.

a) Confirms the resolution passed at its London Congress that a simple application in the country of origin could be the basis for the registration of an international mark.

b) Would like it made clear, throughout the Protocol, that the definition of the country (or office) of origin should conform in all respects with the definition given in the Madrid Agreement, and that any formalities concerning the acquisition of any later modifications in an International Registration must be done through the intermediary of the office in the country of origin of the applicant, in the same way as is done presently in the Madrid Arrangement.

2. Concerning the period for notifying a provisional refusal to WIPO.

a) Notes with satisfaction that, in the Protocol, the term granted for the Office of Origin to issue a provisional refusal has not been extended to more than 18 months, which accords with its wishes expressed in the resolution passed at the London Congress.

b) Believes that allowing the possibility of a further period of time for notifying any possible oppositions is not acceptable; that the period for opposition to an International Registration should commence with its publication in „Les Marques Internationales“; that an opposition can, if necessary, be made in the form of a provisional opposition (the precise form of which can be determined by national law) which would allow for a simple notification of an eventual formal opposition and of its grounds in brief before the expiry of the aforementioned 18 month period.

c) Positively opposes the suggestion that any modification in the period of time for notifying a refusal might be passed only by the Assembly, and believes that any decision in this regard can only be determined through the medium of a diplomatic conference.

3. Concerning the fees.

Confirms the terms of its resolution at the London Congress which called for a uniform fee to be maintained, albeit with the possibility of modifying this to provide for a supplement to the designation fee so as to compensate for the higher expenses of some national offices or organizations, while remaining within limits which are reasonably acceptable to all applicants.

4. Concerning the transformation of an international registration into a series of national applications.

Repeats the reservations expressed in its resolution at the London Congress which touched on the difficulties likely to be encountered in realising the principles of this concept, but nevertheless considers that the concept is capable of alleviating the consequences of a „central attack“.

5. Concerning the safeguard clause.

Entirely approves the principle of that clause in the Protocol (9 sexies) which retains the absolute untouchability of the Madrid Agreement without the unanimous consent of its members to any modification.

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