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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

SPECIAL UNION FOR THE INTERNATIONAL REGISTRATION OF MARKS
(MADRID UNION)

ASSEMBLY

**Thirty-Seventh (21st Extraordinary) Session
Geneva, September 25 to October 3, 2006**

REVIEW OF THE REFUSAL PROCEDURE UNDER THE MADRID PROTOCOL

Document prepared by the International Bureau

1. Article 5(2)(e) of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as “the Protocol”) provides that upon the expiry of a period of 10 years from the date of entry into force of the Protocol, the Assembly of the Madrid Union (hereinafter referred to as “the Assembly”) shall examine the refusal procedure established by that Article, after which subparagraphs (2)(a) to (d) may be modified by a unanimous decision of the Assembly.
2. With a view to, *inter alia*, facilitating such review, an *ad hoc* Working Group on the Legal Development of the Madrid System for the International Registration of Marks (hereinafter referred to as “the Working Group”) was convened by the Director General and held two sessions during the biennium 2005-2006.
3. At its first session, held in Geneva from July 4 to 8, 2005, the Working Group recommended that only Article 5(2)(c)(ii) be amended, with a view to simplifying its drafting. It also recommended that an interpretative statement be submitted to the Assembly of the Madrid Union to the effect that Article 5(2)(e) of the Protocol be understood as allowing the Assembly to examine the operation of the system established by subparagraphs (a) to (d), as last amended, and that any further modification of those provisions should require a unanimous decision of the Assembly (see paragraphs 13 to 44 of the report adopted by the Working Group (document MM/LD/WG/1/3)). However, at its first session the Working Group did not discuss specific texts to implement its recommendations on those points.

4. At its thirty-sixth session in September 2005, the Assembly of the Madrid Union decided that a second meeting of the Working Group should be convened for the purpose of considering, *inter alia*, a draft amendment of Article 5(2) of the Protocol and a draft interpretative statement concerning that Article (document MM/A/36/3).

5. At its second session, held in Geneva from June 12 to 16, 2006, the Working Group considered a draft amendment of Article 5(2)(c)(ii) of the Protocol and a draft interpretative statement concerning Article 5(2)(e) of the Protocol, both contained in document MM/LD/WG/2/2.

6. The Working Group recommended that the text of amended Article 5(2)(c)(ii) of the Protocol and the text of the interpretative statement concerning Article 5(2)(e) of the Protocol reproduced in Annex II hereto be submitted to the Assembly of the Madrid Union for adoption at its next session (see paragraphs 12 to 26 of the report adopted by the Working Group (document MM/LD/WG/2/11)). For easier reference to the proposed amendments, these are first reproduced in Annex I in “track changes” mode, i.e., with the text proposed to be deleted stricken through and the text proposed to be added appearing in bold

Article 5(2)(c)(ii) of the Protocol

7. As recommended by the Working Group, the proposed amended text of Article 5(2)(c)(ii) is a mere simplification of the current text of that article. Transitional provisions are not required as this new wording, if adopted by the Assembly, would not entail any substantive or procedural consequences.

8. Since the full name of the Protocol is currently followed by the indication “adopted at Madrid on June 27, 1989”, it would be necessary to supplement that indication with a reference to the amendment, should the proposed amended text be adopted. This addition is reflected in Annex II hereto.

9. The Assembly of the Madrid Union is invited to adopt the amendment of Article 5(2)(c)(ii) of the Protocol, as set out in Annex II hereto.

Article 5(2)(e) of the Protocol

10. As recommended by the Working Group, the proposed interpretative statement is to the effect that Article 5(2)(e) of the Protocol be understood as allowing the Assembly to undertake, at any point in time, further reviews of the operation of the system established by subparagraphs (a) to (d) and to adopt any modification of those subparagraphs subject to the voting requirements established by Article 5(2)(e).

11. This interpretative statement, if adopted by the Assembly, would be introduced in the text of the Protocol by means of a footnote to Article 5(2)(e). In addition to containing the interpretative statement itself, the footnote would also refer to the resolution of the Assembly to adopt that statement.

12. The Assembly of the Madrid Union is invited to adopt the interpretative statement concerning further review of the operation of the refusal procedure under Article 5 of the Protocol, as set out in Annex II hereto.

[Annexes follow]

PROTOCOL
RELATING TO THE MADRID AGREEMENT
CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

adopted at Madrid on June 27, 1989
and amended on [October \[..\], 2006](#)

Article 5

**Refusal and Invalidation of Effects of International Registration
in Respect of Certain Contracting Parties**

(1) [...]

(2)(a) [...]

(b) [...]

(c) Such declaration may also specify that, when a refusal of protection may result from an opposition to the granting of protection, such refusal may be notified by the Office of the said Contracting Party to the International Bureau after the expiry of the 18-month time limit. Such an Office may, with respect to any given international registration, notify a refusal of protection after the expiry of the 18-month time limit, but only if

(i) [...]

(ii) the notification of the refusal based on an opposition is made within a time limit of ~~one month from the expiry of the opposition period and, in any case, not later~~ than seven months from the date on which the opposition period begins.

(d) [...]

(e) Upon the expiry of a period of ten years from the entry into force of this Protocol, the Assembly shall examine the operation of the system established by subparagraphs (a) to (d). Thereafter, the provisions of the said subparagraphs may be modified by a unanimous decision of the Assembly*.

Supprimé : more

Supprimé : if the opposition period expires before this time limit of seven months, the notification must be made within a time limit of one month from the expiry of the opposition period

[Annex II follows]

* [Interpretative statement adopted by the Assembly of the Madrid Union:](#)
“[Article 5\(2\)\(e\) of the Protocol is understood as allowing the Assembly to keep under review the operation of the system established by subparagraphs \(a\) to \(d\), it being also understood that any modification of those provisions shall require a unanimous decision of the Assembly.](#)”

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(d) [...]

(e) Upon the expiry of a period of ten years from the entry into force of this Protocol, the Assembly shall examine the operation of the system established by subparagraphs (a) to (d). Thereafter, the provisions of the said subparagraphs may be modified by a unanimous decision of the Assembly*.

[End of Annex II and of document]

*

Interpretative statement adopted by the Assembly of the Madrid Union:

“Article 5(2)(e) of the Protocol is understood as allowing the Assembly to keep under review the operation of the system established by subparagraphs (a) to (d), it being also understood that any modification of those provisions shall require a unanimous decision of the Assembly.”