

## **Special Union for the International Registration of Marks (Madrid Union)**

### **Assembly**

**Forty-Fourth (19<sup>th</sup> Ordinary) Session  
Geneva, September 26 to October 5, 2011**

#### **REVIEW OF THE APPLICATION OF ARTICLE 9SEXIES(1)(B) OF THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS**

*Document prepared by the International Bureau*

#### **INTRODUCTION**

1. Upon the recommendations of the *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”), the Madrid Union Assembly (hereinafter referred to as “the Assembly”), on September 2007, approved a modification of paragraph (1) of Article 9*sexies* of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as “the Protocol” and “the Agreement”), establishing, in a new subparagraph (a), the principle that the Protocol, and the Protocol alone, would, in all aspects, apply between States bound by both the Agreement and the Protocol.

2. In addition, the Assembly approved a new subparagraph (b), which rendered inoperative declarations made under Article 5(2)(b) and (c) or Article 8(7) of the Protocol in the mutual relations between States bound by both treaties. As a result, the standard regime of Article 5(2)(a), and of Articles 7(1) and 8(2) applies between such States, that is, the time limit of one year for the notification of a provisional refusal, and the payment of the supplementary and complementary fees.

3. The decision taken by the Assembly allowed users of States which are bound by both the Agreement and the Protocol to benefit from the advantages offered by the Protocol with respect to the international procedure, namely, the required basis for filing an international application, the determination of the entitlement to file, the direct presentation of subsequent designations and requests for recordings and the possibility of transformation, while maintaining the standard regime of the Protocol with respect to the refusal period and the fee system.

4. The Assembly also approved a new paragraph (2) of Article 9*sexies*, under which the Assembly, after the expiry of three years from September 1, 2008, the date on which the modifications to Article 9*sexies* entered into force, shall review the application of paragraph (1)(b) and may maintain it as it is today or, at any time thereafter, either repeal it or restrict its scope by a three-fourths majority of States which are party to both the Agreement and the Protocol.

### **RECOMMENDATIONS MADE BY THE WORKING GROUP**

5. It is recalled that, following a recommendation made during the fourth session of the Working Group, the Assembly decided, in September 2007, to give an ongoing mandate to the Working Group to consider issues relating to the legal development of the Madrid Protocol.

6. At its ninth session held in Geneva from July 4 to 8, 2011, the Working Group undertook a review of the application of paragraph(1)(b) of Article 9*sexies* of the Protocol. The discussions of the Working Group were based on document MM/LD/WG/9/5 Rev.

7. Upon discussing and assessing the information presented by the International Bureau concerning the application of paragraph (1)(b) of Article 9*sexies*, the Working Group agreed to recommend that the Assembly neither repeal nor restrict the scope of paragraph (1)(b) of Article 9*sexies* at this time. The Working Group also decided that the review of the application of paragraph (1)(b) of Article 9*sexies* should again be included in the agenda of the next session of the Working Group.

8. *The Assembly is invited to:*

*(i) take note of the content of this document and,*

*(ii) adopt the recommendation made by the Working Group as set forth in paragraph 7 of this document.*

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