

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

Assembly

**Fiftieth (29th Extraordinary) Session
Geneva, October 3 to 11, 2016**

PROPOSAL REGARDING ACCESSIONS TO THE MADRID AGREEMENT ONLY

Document prepared by the International Bureau

1. On October 31, 2015, the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as “the Protocol”) entered into force in Algeria, which was the last remaining member of the Madrid Union bound exclusively by the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as “the Agreement”).
2. That event was a milestone in the history of the Madrid System, as it meant that all Contracting Parties were, as from that date, bound by the Protocol. As a result, all the designations in all the international registrations in force, as well as all international applications presented since then, are governed only by the Protocol. This follows from the fact that Contracting Parties are either bound only by the Protocol or because, according to Article 9*sexies*(1)(a) of the Protocol, this treaty applies “[...] as regards the mutual relations of States party to both this Protocol and the Madrid (Stockholm) Agreement.” Accordingly, since then, the Agreement is, *de facto*, a non-operational treaty and the Madrid System is, *de facto*, a one-treaty system.

3. During its thirteenth session, in November 2015, the Working Group on the Legal Development of the Madrid System for the International Registration of Marks (hereinafter referred to as “the Working Group”), discussed the possibility of preserving the current situation, namely, the Madrid System as, *de facto*, a one-treaty system with the Protocol as the only operational treaty¹.

4. In earlier sessions in 2005 and 2006, the Working Group outlined a plan endorsed by the Madrid Union Assembly (hereinafter referred to as “the Assembly”) to consolidate the Madrid System as a one-treaty system². In those sessions, it was stated that the Agreement would no longer be applicable, as part of the international registration procedure, if three circumstances were cumulatively met, namely that:

- (i) the Assembly decided to repeal the safeguard clause;
- (ii) the Contracting Parties bound exclusively by the Agreement became bound by the Protocol; and,
- (iii) the Assembly took a decision to “freeze” the application of the Agreement so that no country could accede to the Agreement alone in the future, and international applications could no longer be filed under such treaty³.

5. The first step towards a one-treaty system was taken in September 2007, when the Assembly approved a modification of paragraph (1) of Article 9*sexies* of the Protocol, repealing the safeguard clause. In a new subparagraph (a), the principle that the Protocol alone would apply in all relations between States bound by both the Agreement and the Protocol was established. The Assembly further established, in a new subparagraph (b), that declarations made under Articles 5(2)(b) and (c), and 8(7) would not apply in these mutual relations.

6. The second step towards a one-treaty system was taken on October 31, 2015, when Algeria, the single remaining country bound only by the Agreement, became bound by the Protocol as well.

7. In November 2015, the Working Group discussed the third and final step of the plan to preserve the one-treaty system *status quo*. The Working Group recommended that the Assembly, at its next session in 2016, “take the necessary measures to prevent accessions to the Agreement only, and requested that the International Bureau propose the most appropriate measure to the Assembly”.

8. The Working Group discussed two possible measures to achieve the aforementioned objective, namely that:

- (i) the Assembly instruct the Director General of the World Intellectual Property Organization (WIPO) not to accept any further accession to the Agreement only; and,
- (ii) the Assembly decide to “freeze” the application of Article 14(1) and (2)(a) of the Agreement.

¹ See document MM/LD/WG/13/7 “Review of the Proposal to Freeze the Application of Article 14(1) and (2)(a) of the Madrid Agreement Concerning the International Registration of Marks” (http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=316237).

² See document MM/A/37/4 “Report” (http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=72054).

³ See paragraph 112, document MM/LD/WG/1/2 “Review of the Refusal Procedure and the Safeguard Clause of the Madrid Protocol and Possible Amendments to the Common Regulations” (http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=43173).

9. The International Bureau has carefully considered the first option, that the Assembly instruct the Director General of WIPO not to accept any further accession to the Agreement only. The International Bureau considers that, as a matter of public international law, the Director General of WIPO, in his capacity as depositary, is under an obligation to act impartially; accordingly, this would normally not include the refusal of the deposit of instruments of accession, and, consequently, the International Bureau would not deem it advisable to present such a proposal to the Assembly.

10. The second option, that the Assembly decide to freeze the application of Article 14(1) and (2)(a) of the Agreement, was supported by a number of delegations during the discussion of the Working Group, is consistent with public international law and has numerous precedents at WIPO. Moreover, this option was clearly expressed in the above-mentioned plan set out by the Working Group and endorsed by the Assembly. Under this option, the Assembly would take the decision to freeze the application of Article 14(1) and (2)(a), as from the date of such decision, with the following effects:

- (i) new Contracting Parties could not ratify or accede to the Agreement alone but could ratify or accede simultaneously to the Agreement and the Protocol;
- (ii) countries that are Contracting Parties to the Protocol could accede to the Agreement;
- (iii) international applications could no longer be filed under the Agreement;
- (iv) no operations under the Agreement would be conducted, including the presentation of subsequent designations;
- (v) Article 9*sexies*(1)(b) of the Protocol would still apply in the mutual relations between Contracting Parties bound by both the Agreement and the Protocol; and,
- (vi) the Assembly could still deal with all matters concerning the implementation of the Agreement and could revert, at any time thereafter, to its decision to freeze the application of Article 14(1) and (2)(a) of the Agreement.

11. The Working Group requested the International Bureau to propose the most appropriate measure to the Assembly. After carefully considering the two available options, the International Bureau proposes that the Assembly take the decision to freeze the application of Article 14(1) and (2)(a) of the Agreement, as the most effective measure to ensure the consolidation of the Madrid System as a one-treaty system.

12. *The Assembly is invited to:*

- (i) consider the proposals made in the "Proposal Regarding Accessions to the Madrid Agreement Only" (document MM/A/50/3) and,*
- (ii) take the decision to freeze the application of Article 14(1) and (2)(a) of the Madrid Agreement Concerning the International Registration of Marks, with the effects specified in paragraph 10 of the above referred document, as from the date of such decision.*