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WORLD INTELLECTUAL PROPERTY ORGANIZATION GENEVA

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

ASSEMBLY

Twenty-Fourth Session (15th Extraordinary) Geneva, September 21 to 29, 1992

AMENDMENT TO THE REGULATIONS

UNDER THE MADRID AGREEMENT

IN CONNECTION WITH CERTAIN NEWLY INDEPENDENT STATES

Document prepared by the International Bureau

1. Certain States (hereinafter referred to as "successor States") which became independent recently and whose territory was, before their independence, part of the territory of a country party to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as "the predecessor country") have deposited, or intend to deposit, with the Director General of the World Intellectual Property Organization, a declaration of continuation. One of the effects of such declaration is that they apply the Madrid Agreement in their territory.

2. It seems to be reasonable if not indispensable that the status of each international registration which was or is in effect in the predecessor country be clarified as far as the successor States are concerned. This is in the interest of the holder of the international registration, all those who consult the International Register and the national Offices of the successor States.

3. It is to be noted that the procedure proposed in this document would not apply to the Russian Federation as a successor State of the Soviet Union. Since the Russian Federation has declared, immediately after the Soviet Union ceased to exist, that it remained responsible in full for all rights and obligations of the Soviet Union in WIPO, all the international registrations which were in force in the Soviet Union on December 24, 1991, undoubtedly have effect in the Russian Federation so that the said procedure is unnecessary with respect to that country.
4. It is proposed that, with respect to each successor State, the holder of an international registration that on a certain date (see paragraphs 5 to 8, below) was or is in force in the predecessor country be required to make a request that his international registration continue to be effective in the successor State. In order to alert holders of international registrations to the possibility of making such a request, the International Bureau would send to the holder of each international registration concerned a notice informing him of this requirement, and the request would have to be filed within six months from such notification. The request would have to be accompanied by a fee for the benefit of the national Office of the successor State (which is only equitable since such Office did not receive any share of the supplementary and complementary fees that the national Office of the predecessor country received) and a fee for the benefit of the International Bureau (for the notification of the holder, the recordal, the publication and the notification of the Office of the successor State). Any international registration concerning which the holder has filed the said request would be effective in the successor State. The Office of the successor State could not refuse protection, except where the time limit referred to in Article 5(2) has not expired with respect to the territorial extension to the predecessor country and provided that the notification of refusal is received by the International Bureau within that time limit.
5. The date referred to in the preceding paragraph would be fixed according to different rules depending on whether the predecessor country has ceased to exist (and consequently has ceased to be a contracting country) or has not ceased to exist (and consequently continues to be a contracting country).
6. In the first case, i.e., where the predecessor country has ceased to exist (for example, the Soviet Union), the date (that is, the date on which the international registration must have been in force in the predecessor country) would be the date of the last day of the existence of the predecessor country (in the case of the Soviet Union, December 24, 1991), except that any successor State could decide that the said date rather be the date of its independence, provided that the latter date is earlier than the date of the last day of the existence of the predecessor country.
7. In the second case, i.e., where the predecessor country has not ceased to exist (for example, Yugoslavia continues to exist under that name, although with a reduced territory), the date referred to in paragraph 4, above, would have to be fixed by the successor State, but such date could not be earlier than the date of the independence of the successor State. Such date could, for example, be the date on which the independent trademark law of the successor State enters into force.

8. It is proposed that a new Rule (Rule 38) incorporating the procedure outlined above be inserted, with effect on October 1, 1992, in the Regulations under the Madrid Agreement. The draft of that new Rule appears in the Annex to this document.

9. The Assembly of the Madrid Union is invited to adopt Rule 38 as proposed in the Annex to the present document and to decide that the said Rule would enter into force on October 1, 1992.

[Annex follows]

Rule 38

Continuation of Effects of International Registrations
in Certain Successor States

(1) Where any State ("the successor State") whose territory was, before the independence of that State, part of the territory of a contracting country ("the predecessor country") has deposited with the Director General of the World Intellectual Property Organization a declaration of continuation the effect of which is that the Agreement is applied by the successor State, the effects in the successor State of any international registration which was in force in the predecessor country on the date fixed under paragraph (2) shall be subject to the following conditions:

(i) the filing with the International Bureau, within six months from a notice addressed for that purpose by the International Bureau to the holder of the international registration concerned, of a request that such international registration continue its effects in the successor State; and

(ii) the payment to the International Bureau, within the same time limit, of a fee of 22 Swiss francs, which shall be transferred by the International Bureau to the national Office of the successor State, and of a fee of 40 Swiss francs for the benefit of the International Bureau.

(2) The date referred to in paragraph (1) shall be:

(i) where the predecessor country has ceased to exist, the date of the last day of the existence of that country; however, where the date of independence of the successor State is earlier than the said date, the successor State may declare that the date referred to in paragraph (1) shall be the date of its independence; such a declaration shall be made together with the declaration of continuation referred to in the said paragraph and shall specify the date of independence;

(ii) where the predecessor country has not ceased to exist, the date notified by the successor State to the International Bureau for the purposes of this Rule, provided that such date may not be earlier than the date of independence of the successor State.

(3) The International Bureau shall, upon receipt of the request and the fees referred to in paragraph (1), notify the national Office of the successor State and make the corresponding recordal in the International Register and the corresponding publication in Les Marques internationales.

(4) With respect to any international registration concerning which the Office of the successor State has received a notification under paragraph (3), that Office may only refuse protection if the time limit referred to in Article 5(2) has not expired with respect to the territorial extension to the predecessor country and if the notification of refusal is received by the International Bureau within that time limit.

(5) This Rule shall not apply to the Russian Federation as a successor State.