

# WIPO



MM/XXIV/4

ORIGINAL: English/French

DATE: September 29, 1992

## 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

#### REPORT

adopted by the Assembly

#### INTRODUCTION

1. The Assembly was concerned with the following items of the Consolidated Agenda (documents AB/XXIII/1 Rev.2 and AB/XXIII/6, paragraphs 16 and 17):  
1, 2, 8, 9bis, 13 and 14.
2. The report on the said items, with the exception of item 8, is contained in the General Report (document AB/XXIII/6).
3. The report on item 8 is contained in this document.

## ITEM 8 OF THE CONSOLIDATED AGENDA:

## MATTERS CONCERNING THE MADRID UNION

Amendment to the Regulations under the Madrid Agreement in Connection with Certain Newly Independent States

4. Discussions were based on document MM/A/XXIV/1.
5. The Delegations of Austria, Croatia, Czechoslovakia, Germany, Hungary, Portugal, Slovenia, Switzerland and Ukraine proposed amendments to draft Rule 38 as appearing in document MM/A/XXIV/1 (see document MM/A/XXIV/3).
6. Following that proposal, the Secretariat withdrew its proposal of draft Rule 38 as appearing in document MM/A/XXIV/1.
7. The Delegations of the Democratic People's Republic of Korea and Poland supported the text proposed in document MM/A/XXIV/3.
8. In response to a question raised by the Delegation of Germany, the Secretariat indicated that the International Bureau would notify the national Office of the successor State, as provided in the proposed Rule 38(3), but that no notification would be made under Rule 30 to other national Offices (for example, the Office of origin). Any interested Office or person would be informed of international registrations for which the holder has made use of Rule 38 by the publication made in Les Marques internationales under Rule 38(3).
9. In response to a question raised by the Delegation of China, the Secretariat indicated that notices to be addressed by the International Bureau in accordance with the proposed Rule 38(1)(i) to holders of international registrations in China would be sent through the intermediary of the Office of that country.
10. The Delegation of France said that it did not see the legal necessity of a procedure for the confirmation, in successor States, of international registrations of marks that had effect in the predecessor State. In its view, regardless of whether or not the predecessor State had disappeared, the very status of successor State, confirmed by the declaration of continuation, made for the automatic effect, in successor States, of international registrations that had effect in the predecessor State before a certain date. Under those circumstances it seemed difficult to demand of the owners of international registrations that they apply for their registrations to have effect in successor States; indeed it did not seem that failure to comply with those formalities could be an obstacle, in law, to the validity of the registrations in successor States. Nevertheless, being aware of the need to guarantee, in practice, the protection of international registrations in successor States, the Delegation of France declared itself in favor of the adoption of Rule 38 as proposed in document MM/A/XXIV/3.

11. The Assembly adopted Rule 38 as appearing in document MM/A/XXIV/3, with an amendment in paragraph (1)(i) of the said Rule to the effect that the time limit of six months started from the date of a notice addressed for that purpose by the International Bureau. The text of Rule 38 as adopted appears in the Annex to this report.

Progress Report on the ROMARIN project

12. Discussions were based on document MM/A/XXIV/2.
13. The International Bureau specified that the Benelux Trademark Office would be treated in all respects in the same manner as a country member of the Madrid Union, in particular, as far as the ROMARIN software platform/interface is concerned (paragraph 3(a) of Annex II to document MM/A/XXIV/2).
14. The Chairman, in inviting comments on the progress report and on the proposals made therein, stated that his Office had already gained extensive experience in using ROMARIN and that it had come to the conclusion that the ROMARIN application was extremely useful and of great help to his examiners. As a result of this, the Chairman said that his Office has been able to assign a certain number of Office staff to other tasks, since the examiners were now able to do trademark novelty searches themselves using the ROMARIN CD-ROMs.
15. The Delegations of Austria, France, Slovenia, China, Hungary, Belgium and Bulgaria congratulated the International Bureau for the excellent quality of the ROMARIN CD-ROMs. They stated that the ROMARIN project proved to be fully successful and would be very helpful to their Offices.
16. The Delegation of Austria stated that the searching for images on the ROMARIN CD-ROM, using the Vienna Classification, was at present only possible on category and division level and therefore gave rise to too many "hits." It advocated the application by the International Bureau of the categories/division/section codes of the Vienna Classification for coding the figurative elements of the marks.
17. The International Bureau replied that it had already started a study of the implications of applying the Vienna Classification symbols to the figurative elements of the marks up to section level. It pointed out that its present practice was based on Rule 14.2(ix) of the Regulations under the Madrid Agreement, which provided for coding on the category/division level only.
18. All the Delegations which spoke approved the pricing policy contained in Annex II of document MM/A/XXIV/2.
19. The Delegation of France said, in respect of the said pricing policy, that it would prefer to have, as an alternative to what was provided in paragraph 2(a)(ii) of Annex II, an "all-in" price for the commercial use of the tapes equivalent to ROMARIN CD-ROMS in an on-line environment--possibly higher than the one indicated in the said paragraph--rather than the commercial vendor having to pay royalties to WIPO per down-loaded record, since the "Kiosque" system available on Minitel via the French telephone network debited its users on connect time only, and did not take into account the number of records consulted or down-loaded. It, therefore, asked the International Bureau to study the possibility of an alternative pricing structure for this type of use of the ROMARIN data.

20. The Director General said that the International Bureau would maintain the pricing for commercial vendors of ROMARIN data as indicated in the progress report, but would negotiate a special agreement with the French Office so as to take into account the specific wishes of the French Delegation. He noted, in this respect, that the French Delegation had declared its agreement that, in the event of such a special agreement, it would be willing to pay a higher price for the basic subscription than the one indicated in paragraph 2(a)(ii) of Annex II of document MM/A/XXIV/2. The International Bureau was ready to negotiate similar agreements with any Office of a member State of the Madrid Union which would have the same wishes as the French Office.

21. The Assembly noted with satisfaction the progress report contained in document MM/A/XXIV/2 and approved the pricing policy for the ROMARIN CD-ROMs and ROMARIN-related products as appearing in Annex II to document MM/A/XIV/2, as well as the proposal contained in paragraph 26 of the said document.

[Annex follows]

ANNEX

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 with a territorial extension to the predecessor country which is effective from a date prior to the date fixed under paragraph (2) shall be subject to the following conditions:

(i) the filing with the International Bureau, within six months from the date of 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 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.

[End of Annex and of document]

