
Working Group on the Legal Development of the Madrid System for the International Registration of Marks

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POSSIBLE AMENDMENTS TO RULE 9 OF THE COMMON REGULATIONS UNDER THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS AND THE PROTOCOL RELATING TO THAT AGREEMENT

Document prepared by the International Bureau

INTRODUCTION

1. At its sixteenth session, held in Geneva from July 2 to 6, 2018, 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 types of marks, other than those explicitly mentioned in the Common Regulations Under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement (hereinafter referred to as “the Common Regulations” and “the Protocol”)¹.
2. The Working Group requested the International Bureau to prepare a document describing possible changes to Rule 9 of the Common Regulations with a view to accommodating new means of representation.

¹ See document MM/LD/WG/16/4.

I. POSSIBLE AMENDMENTS TO RULE 9 OF THE COMMON REGULATIONS

3. Rule 9(4)(a)(v) of the Common Regulations requires that the international application contain or be accompanied by a reproduction of the mark that must fit in the box provided on the official form. This Rule could be amended to require that the international application contain or be accompanied by a clear and precise representation of the mark. This amendment would make it possible to file an international application with any representation of the mark, graphic or non-graphic.
4. As a further simplification, Rule 9 could require that the representation be in color where color is claimed as a distinctive feature, in accordance with paragraph (4)(a)(vii). The requirement to furnish a second representation of the mark could be deleted from this paragraph², with the consequential removal of the box set out in item 7(b) of the official form MM2.
5. Rule 9(5)(d)(iv) could be amended to require that the Office of origin certify that the mark in the international application corresponds to the mark in the basic application or basic registration (hereinafter referred to as “the basic mark”). This change would provide more flexibility for Offices when certifying international applications and it would harmonize the Rule with the wording found in Article 3(1) of the Protocol. It would therefore remove any doubt as to whether the requirement of sameness between the basic and the international marks, currently found in this Rule, is stricter than the requirement under Article 3(1) of the Protocol, which refers to the correspondence between the particulars in the international application and those of the basic mark. Nevertheless, certification would remain a decision by the Office of origin in strict application of the Madrid Protocol and of the Rule. For example, the Office concerned would still be required to decide whether an international application with a clearer representation of the mark or with a mark represented by different means could be considered as meeting the requirements in Article 3(1) of the Protocol.
6. The Administrative Instructions for the Application of the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating Thereto (hereinafter referred to as “the Administrative Instructions”) could be amended to indicate how marks can be represented in the international application. The representation of the mark would be driven by the way in which the international application is transmitted to the International Bureau. International applications transmitted by postal or delivery service would still require a graphic representation of the mark comprising, for example, one or more images of the mark fitting on A4 paper size (i.e. 210 by 297 millimeters). International applications transmitted electronically could be presented with an electronic representation of the mark. The Administrative Instructions could indicate the acceptable formats and technical requirements for each form of electronic representation, namely, still images, moving images, sounds and moving images with sound.

² Rule 9(4)(a)(v) and (vii) of the Common Regulations reads as follows:

“(4) [Contents of the International Application] (a) The international application shall contain or indicate

“[...]”
“(v) a reproduction of the mark that shall fit in the box provided on the official form; that reproduction shall be clear and shall, depending on whether the reproduction in the basic application or the basic registration is in black and white or in color, be in black and white or in color,

“[...]”
“(vii) where color is claimed as a distinctive feature of the mark in the basic application or registration, or where the applicant wishes to claim color as a distinctive feature of the mark and the mark contain in the basic application or basic registration is in color, an indication that color is claimed and an indication by words of the color or combination of colors claimed and, where the reproduction furnished under item (v) is in black and white, one reproduction of the mark in color,”

II. FURTHER CONSIDERATION ON THE SUGGESTED AMENDMENTS

7. It is reasonable to expect that, in the not so distant future, all Contracting Parties of the Madrid System will accept various means of representation, exchanged electronically and in digital format. The Madrid System must be ready to serve its users in this evolving landscape by updating its legal framework and by adjusting its processes, practices, organization and infrastructure. Moreover, the Working Group may wish to discuss further ways in which to best support users of the Madrid System while Contracting Parties transition to that stage.

A. PRACTICAL CONSIDERATIONS

(i) Signs that Cannot Constitute a Mark

8. When considering the way forward on the amendments outlined in paragraphs 3 to 6, above, the Working Group may wish to take into account the findings of the survey on acceptable types of marks and means of representation, which are found in the Annex to document MM/LD/WG/17/4. In particular, it would be relevant to consider that for 47 of the 82 Offices that participated in the survey, marks are defined, according to their applicable laws and practices, as signs that can be represented graphically; and, that for 35 of those Offices, marks are defined as signs that are visually perceptible.

9. The above-mentioned amendments would not curtail the right designated Contracting Parties have to refuse protection where the sign that is the subject of an international registration cannot constitute a mark under their applicable laws and practices. For example, while most of the Offices that replied to the questionnaire protect word, figurative, three-dimensional and color marks, a number of Offices do not protect, for example, sound, hologram, motion or multimedia marks.

10. Therefore, holders of international registrations for, so-called, new types of marks would still face a provisional refusal where the sign that is the subject of the international registration cannot constitute a mark under the laws and practices of the designated Contracting Parties, regardless of the way in which those marks are represented.

11. The situation described in paragraph 10, above, will likely improve as Contracting Parties engage in a review of their national or regional legal frameworks and practices. The Working Group may wish to discuss whether periodically discussing the evolution of the above-mentioned situation, most likely in its Roundtable, would be useful.

(ii) Different Representation Requirements

12. The amendments outlined in paragraphs 3 to 6, above, would not remove the inconvenience holders would still face of having to comply with different representation requirements in designated Contracting Parties for a given type of mark, provided it can constitute a mark in those designated Contracting Parties. Some Contracting Parties are preparing to accept domestic applications with a non-graphic representation of the mark, while other Contracting Parties still require a graphic representation of the mark.

13. It would appear that graphic representation continues to be the most commonly accepted means of representation for most types of marks in most Contracting Parties of the Madrid System. In view of the above, the Working Group may wish to discuss whether the amendments outlined in paragraphs 3 to 6, above, by introducing the possibility to file an international application with a non-graphic representation of the mark, would complicate matters for users.

14. Holders filing international applications with a non-graphic representation of the mark would receive, in all likelihood, a provisional refusal in designated Contracting Parties that still require marks to be graphically represented. As a result, holders with a non-graphic representation in the basic mark would be limited to designating Contracting Parties that accept such non-graphic representation. The Working Group may wish to discuss how to address this situation.

15. As a solution, the Working Group may wish to consider allowing applicants to present an international application with a representation different than the one appearing in the basic mark or with an additional representation, similar to the solution currently provided for in Rule 9(4)(a)(vii) for marks in color. As discussed in previous sessions of the Working Group, some Contracting Parties require that the reproduction appearing in the international application be identical to the one appearing in the basic mark³. In those Contracting Parties, the holder would not be allowed to file an international application with a different representation of the mark, unless those Contracting Parties introduce some flexibilities in their certification practices.

16. Another solution to the situation described in paragraph 14, above, would be for designated Contracting Parties to require, in a provisional refusal, that holders furnish a representation of the mark in accordance with their applicable laws and practices. This solution may not be possible where the designated Contracting Party considers that the reproduction, as it appears in the International Register, is not sufficient to define, clearly and precisely, the object of protection.

17. For example, most international applications that indicate the mark is three-dimensional are presented with one bi-dimensional graphic or photographic reproduction of the mark, such as, for example, the picture of a bottle. Some Contracting Parties may require that applications for three-dimensional marks be represented with several views of the mark for the granting of a filing date. In these Contracting Parties, furnishing additional views may not overcome a refusal of protection against an international application filed with one bi-dimensional graphic or photographic reproduction of a three-dimensional mark.

18. In view of the above, the Working Group may wish to discuss whether establishing minimum representation requirements for each type of mark, acceptable to all Contracting Parties, would also be necessary. The above would provide holders with much desired certainty when using the Madrid System.

B. TECHNICAL CONSIDERATIONS

(i) *Technical Considerations Concerning Contracting Parties*

19. In the previous session of the Working Group, the International Bureau indicated that introducing non-graphic representation in the Madrid System would require that Contracting Parties exchange this representation in electronic format and by electronic means⁴.

20. The Office of origin can transmit a graphic representation of the mark to the International Bureau by electronic means or send it by postal or delivery services. In turn, the International Bureau can notify Offices of the designated Contracting Parties such graphic representation by electronic means (i.e. by transmitting a digital file with that representation) or by postal or delivery services (i.e. by sending a paper notification with the representation of the mark). The efficient exchange of non-graphic representation would require that all Contracting Parties exchange that representation in digital format and by electronic means; that is, without the need to deliver digital files on a physical support such as, for example, a Universal Serial Bus (USB) memory stick.

³ Please, see document MM/LD/WG/15/RT/Presentation/2.

⁴ Please, see document MM/LD/WG/16/4.

21. A number of Offices that participated in the survey referred to in paragraph 8, above, indicated that they do not receive domestic applications as either data or by electronic means; do not require or allow the applicant to submit an electronic representation of the mark; and, do not store an electronic representation of the mark in a domestic database. In view of those findings, the Working Group may wish to discuss whether establishing a time-table for all Contracting Parties to exchange data under the Madrid System by electronic means would be desirable.

(ii) Technical Considerations Concerning the International Bureau

22. In addition to the subjects presented above, there would be some technical considerations to take into account, concerning the International Bureau, with a view to implementing the amendments outlined in paragraphs 3 to 6, above.

23. While the International Bureau has the technical infrastructure to process electronic representations of the mark, it would have to change its processes and its information and communication technology (IT) systems so it can receive, examine, publish, make available to the public and notify certain representations such as, for example, those that consist of sound or multimedia digital files.

24. Accordingly, the International Bureau would be required to assess those changes and the time needed for their implementation. The International Bureau may also need to update its electronic communication technical standards. In turn, the above could prompt Offices of the Contracting Parties to undertake their own similar exercises.

25. The Working Group may wish to take into account the considerations in paragraphs 22 to 24, above, when discussing a possible time-frame for introducing the amendments outlined in paragraphs 3 to 6, above.

26. The Working Group is invited to consider this document and to provide guidance to the International Bureau on a possible way forward.

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