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WORLD INTELLECTUAL PROPERTY ORGANIZATION  
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## WORKING GROUP ON THE LEGAL DEVELOPMENT OF THE MADRID SYSTEM FOR THE INTERNATIONAL REGISTRATION OF MARKS

**Fifth Session**  
**Geneva, May 5 to 9, 2008**

CONTRIBUTION BY AUSTRALIA (PART 1)

*Document prepared by the International Bureau*

1. In a communication dated January 2, 2008, the International Bureau received a contribution from Australia on the subject of improving the accessibility of information regarding the fate of international registrations in designated Contracting Parties, for consideration by the Working Group on the Legal Development of the Madrid System for the International Registration of Marks, at its fifth session to be held in Geneva from May 5 to 9, 2008.

2. The said contribution is annexed to this document.

3. *The Working Group is invited to note the contents of the attached contribution by Australia.*

[Annex follows]

ANNEX

**IMPROVING ACCESS TO INFORMATION ON THE STATUS OF  
INTERNATIONAL REGISTRATIONS IN DESIGNATED COUNTRIES**

**Establishing an interim standard for the provision of information**

**Part 1 of a contribution by Australia**

**to assist preparation for 2008 meetings of the *Ad Hoc* Working Group on the Legal Development  
of the Madrid Protocol**

These notes have been prepared in response to the Working Group's invitation to contracting parties to contribute comments to assist the Secretariat's preparation of a paper on accessibility of information on international registrations.

This is an issue which has been the subject of a paper (MM/LD/WG/4/4) presented by Australia at the 2007 sessions of the Working Group and the Australian delegation provided some additional suggestions on implementation of the proposal during those meetings. As some of the circumstances surrounding the earlier discussions have changed, we wish to take this opportunity to note where this affects the approach we had proposed earlier. In addition we will provide some amplification and clarification of earlier comments.

BACKGROUND

**Discussion of repeal or restriction of the safeguard clause**

The proposal by Australia regarding the provision of information on designations was developed as a contribution to the Working Group's consideration of the repeal of the safeguard clause. One major driver was to address the Working Group's objective to allow users in states bound by both the Agreement and the Protocol to benefit from advantages offered by the Protocol while limiting undesired effects of its application. We saw the proposal as offering a form of counterbalance to the increases in fees and longer refusal periods which, at that time, we believed would result if international registrations which would previously have been governed by the Agreement (in accordance with the safeguard clause) were instead to come under the provisions of the Protocol. However, our proposal focused on provision of information on international registrations because we strongly believe that there is an urgent need to address deficiencies in this area of the system's operation.

Recommendations made following later discussions of the Working Group have now been agreed by the Madrid Assembly. Repeal of the safeguard clause will take effect next year but, for at least the following three years, declarations for individual fees and a longer refusal period will not apply to international applications and registrations affected by the repeal. This change in approach means that application of the Protocol will not introduce undesired effects.

**Working Group's consideration of the Australian proposal**

Our proposal included a two-stage approach.

Stage 1:

- Making known an intention for later work on the development of the Madrid system to include establishing standards in provision of information which will apply throughout the Madrid system.
- A minimum standard in provision of information being adopted as an interim measure with all parties to the Protocol being required to comply within a specified period.

Stage 2:

- Standards which will apply across the system being decided in the context of later discussions on the future development of the Madrid system.
- Implementation of the standard.

The 3rd meeting of the Working Group adopted the Chair's proposal: '- that the Working Group declare its intention that standards be established in the provision of information, which would apply throughout the membership of the Protocol' (MM/LD/WG/3/5, paragraphs 152-153).

The Working Group (following its decision on the repeal of the safeguard clause) agreed to ask the Secretariat to prepare a paper addressing the issue of the accessibility of information regarding the fate of international registrations in designated countries, and to discuss that paper at the first meeting of the Group in 2008.

**Objectives and approach in establishing standards for the provision of information**

Although effects of the amendments to the safeguard clause no longer require any counterbalance, we believe that the need to improve accessibility of information on international registrations should continue to be an important objective for the Working Group.

Trade mark owners, their representatives and others with interests of a third party have reported difficulty in utilising the Madrid system effectively as they are frequently unable to find out details regarding an international registration in designated countries. Users have mentioned that:

- this acts as a disincentive to using the Madrid system
- additional costs are incurred if local agents are required to ascertain the status in designated countries, and
- improving the accessibility of this information is likely to increase use of the Madrid system and may encourage additional membership.

We remain of the view that the standards to be set should ensure all parties interested in an international registration are able to access information regarding its status in all designated countries. This would include:

- information being published to ensure it is available to third parties, and
- the holder being informed of the progress of international registrations in designated contracting parties.

It seems appropriate for the Working Group to develop aspects of such a ‘final’ standard in association with its consideration of other proposals for development of the system. However, this work may take some time.

The aim of setting a standard to apply in the interim would be to assist users by introducing measures which:

- provide appreciable improvements in accessibility of information
- can be implemented quite speedily, and
- do not constrain other aspects of development of the Madrid system.

We continue to favour a 2-stage approach to establishing standards which will ultimately apply throughout the Madrid system. The remainder of this paper will deal with issues relating to introduction of an interim, minimum standard. We will also provide a second paper which deals with issues relevant to establishing a ‘final’ standard in provision of information on international registrations.

## SETTING AN INTERIM STANDARD FOR PROVISION OF INFORMATION

Our earlier paper proposed that there should be two aspects to the minimum requirements of the interim standard:

- (1) Offices of Contracting Parties must advise the International Bureau when protection is extended to all or some of the goods and services of the international registration.
- (2) The International Bureau would then publish the information.

We believe the aims outlined above would be achieved if these requirements were implemented.

If this approach is to be adopted, decisions must be made on the following matters.

- i. Mechanisms for notifying the IB when a mark becomes protected:
  - what information (data) must be sent, and
  - the period within which it must be sent.
- ii. Implementation issues, including:
  - identification of all steps required to support introduction of the new requirements, and
  - establishing the date by which contracting parties will be required to comply with the interim standard.

### **Mechanisms for notifying the IB when a mark becomes protected**

#### Information to be provided

The Common Regulations already include some provisions regarding notification of the IB that a mark has become protected. In other situations, additional methods would be required.

#### *Protection following provisional refusal*

If a mark becomes protected following a provisional refusal, notifications under Rule 17(5)(a) are required.

- At the end of proceedings before it, an office must send a statement to the IB indicating
  - that the mark is protected for all the goods and services requested,
  - the goods and services for which the mark is protected, or
  - protection is refused for all goods and services.
- The IB must record this statement and send a copy to the holder.

Compliance with Rule 17(5)(a) is not a new requirement but using this means to notify protection of some or all of the specified goods and services is clearly a key aspect of the minimum standard as proposed.

#### *Protection where there is no provisional refusal*

Offices which have not issued a provisional refusal may notify the IB within the period for provisional refusal that the mark has become protected.

- Under Rule 17(6), issuing this ‘statement of grant of protection’ is optional.
- The IB must record such a statement and send a copy to the holder.
- This mechanism may be adopted by more offices as a means of complying with the interim standard.

Compliance with the interim standard will require additional mechanism(s) to cater for all instances where the mark becomes protected without earlier provisional refusal and a statement of grant of protection is not issued. This would cover situations where:

- the period provided for provisional refusal elapses and no refusal has been issued,
- a notice under Rule 16 has advised that opposition may occur after the 18-month period for provisional refusal but no opposition eventuates.

We suggested in earlier discussions that the requirement for notification might be met by the office sending the IB a list of numbers of international registrations which have become protected

- An additional item of data might be included for each mark to prevent errors in recording.
  - the name of the holder might be suitable.

At its 4<sup>th</sup> session, the Working Group started to discuss the potential for a list being used for this purpose. While no decision was taken, some delegations indicated that they would be able to adopt this fairly straight-forward method of notifying that marks had become protected.

Part 3 of the Administrative Instructions dealing with communications with the IB would appear to cover transmission of such a list.

#### Period for sending notifications

For such an interim standard to be effective, it must include establishing a period within which the required data is to be sent to the IB and an additional period within which publication will occur. Together, these times would indicate the longest delay which should occur before the database reflects a change in status. This will also allow users to view published information with confidence that, within that period, they will know that a mark has become protected in the designated contracting party.

Our earlier paper proposes that notifications of protection sent as a list should be sent as soon as practicable after a mark becomes protected or, in any case, within 1 month from the time protection is extended.

Some of the issues we considered in proposing this timeframe are listed below.

- a) All marks included in the list would have become protected without any grounds for provisional refusal having been raised within the 12- or 18-month period.
- b) There will be variation in office procedures leading up to the change in status of the international registration in designated countries.
  - Notifications of provisional refusal must be sent to the IB before the end of the applicable refusal period [Rule 18(2)].
    - If there is no provisional refusal, it may be most suitable for an office to notify the IB that it has protected a mark at the time it would otherwise have sent a notification of provisional refusal [under Rule 17(1)].
  - Notices under Rule 16 stating that opposition may occur after the end of the 18-month period may issue without any provisional refusal having been notified previously.
    - Where there is a declaration under Art 5(2)(c), notifications of provisional refusal based on opposition must be sent to the IB within 1 month of the end of the opposition period.
      - If notification is given under Rule 16 but no opposition is filed, it seems appropriate that the IB would be advised of protection at the time that a notification of provisional refusal would otherwise have been sent.

- In some offices a change in status of the international registration may be triggered when the refusal period ends without any notice under Rule 17 having issued. It may be simpler for those offices to meet the new requirement by recording the change to ‘protected’ status in a list after the end of the applicable refusal period.
  - It may be most convenient for offices using a list to notify protection to send that periodically.
- c) While there are obvious advantages for users in having prompt advice of protection, we see these issues as indicating the interim standard should:
- recognise that successful implementation for some offices will depend on allowing a period from the time the status changes to send a notification to the IB
  - encourage notification of protection as soon as is practicable for an office, and
  - provide a time limit for the notification.
- d) A period of one month for notifying that protection has occurred seems to be indicated for some situations and appears to allow for varying procedures of offices.
- e) We have noted that the IB has stated its aim of being able to publish information within four weeks of receipt.
- This would mean that information that a mark has become protected in a particular designated country should be published within 2 months of it attaining that status.

However, if users are to have confidence in the system, and to avoid any confusion, information regarding protection of a mark should be provided within the same period irrespective of the manner of its notification.

This point has led us to extend the view expressed in our earlier paper to explicitly propose that all notifications of protection should occur within one month of a mark achieving that status in a contracting party. This relates particularly to two situations.

1. ‘Statements of grant of protection’ which, under Rule 17(6), must be sent ‘within the period for provisional refusal’.

It is appropriate that these statements are sent within the same timeframe as required for any list of numbers of protected marks, ie as soon as practicable and within one month from the time protection is extended. If this is not done, inclusion of those numbers on such a list would provide information on protection more speedily.

2. Notifications under Rule 17(5)(a) which are required following a provisional refusal may notify full or partial protection of a mark in a designated contracting party. These notices are required ‘when all procedures before the said office are completed’.

This situation is distinguished from others where a mark may become protected in a designated country because a provisional refusal will have been published and the holder notified. However, notices under Rule 17(5) which may effectively advise protection of a mark may come at the conclusion of many different procedures before an office. These will include situations where it may be particularly important for the holder and other interested parties to be aware of the status of the mark eg where opposition is withdrawn or where a notice under Rule 16 issued but no opposition is filed.

### Proposal

Following from this discussion, we believe it is appropriate to modify the proposal in our earlier paper (MM/LD/Working Group/4/4 at paragraph 19) as follows:

The interim standard will be met if, in relation to each mark to which protection is extended, the International Bureau is notified of the protection:

- either by a notice under Rule 17(6), a notice under Rule 17(5), or by including the mark in a list of protected marks, and
- such notification is sent as soon as is practicable after the mark becomes protected and in any case within 1 month from the end of the applicable refusal period.

To ensure clarity in the interpretation of any provisions developed along these lines, it may be helpful if a note could be included to state that failure to notify the International Bureau will in no way affect the status of the International Registration in that designated contracting party (see footnote 4 of our earlier paper).

### A matter for further consideration

It is important to note that discussions in Australia have stressed the importance to users in having a mechanism on which they can place some reliance. Consequently they believe that, if contracting parties are not confident that they will be able to comply with a period of one month for notifying protection of a mark, it would be preferable to allow slightly more time for that action rather than increasing risks of inconsistencies throughout the system. However, they would not want this to involve a total time to publication going beyond 3 months.

We think it is important that this view is kept in mind if discussions within the Working Group reveal concerns over the one-month period proposed for notification of protection



### Implementation issues

#### Time for compliance

In our earlier paper we proposed an implementation strategy which staggered the times by which contracting parties would be required to comply. The differences in the requirement to comply were based on whether or not contracting parties had made declarations opting for individual fees or a longer refusal period. We no longer believe this part of our proposal to be appropriate.

- This aspect of the proposal arose principally from the aim of providing a counterbalance to the effects of repeal of the safeguard clause as they appeared at that time. As noted earlier in this paper, those conditions will no longer be applicable.
- Prescribing different times for requiring compliance with the interim standard would increase the inconsistencies in the operation of the Madrid system.

We now propose all contracting parties be required to meet requirements of the interim (minimum) standard by set date.

The following matters are also relevant to times for compliance with the interim standard.

- Some contracting parties already meet the proposed requirements by issuing notices under Rules 17(6) and 17(5).
  - Proposals on the timing of sending these notices may cause some concerns.
- Other contracting parties may wish to commence additional forms of notification of protection currently anticipated by the Common Regulations as soon as they have that capacity.
- Offices will have different needs in relation to changes in procedures and systems which might allow or facilitate their compliance.
  - The mechanism proposed to meet the minimum standard is intended to keep necessary processes as simple as possible

#### Amendment of the Common Regulations

Changes to the Common Regulations will be necessary to require compliance with the interim standard and the publication of the information. Users will benefit from improvements in accessibility of information occurring as speedily as possible.

In relation to amendment of the Common Regulations, this might be met by:

- text of amendments being agreed at the first meeting of the Working Group in 2008,
- recommended amendments being approved by the Madrid Assembly in September 2008, and
- agreement on as early a date for commencement as is practicable for contracting parties and the IB.

## Proposal

We would like to propose that the Working Group adopts this time table for amendment of the Common Regulations and that the provisions indicate a single date by which all contracting parties must comply with the interim standards on information.

We also suggest that the amending Regulations commence in March or April 2009 and apply to marks which are protected in designated contracting parties after the commencement date.

- If the Working Group meets in May 2008, and agrees on the text of amendments as mentioned above, that timing will allow around 10 months from the meeting which effectively finalises the necessary amendments to the Common Regulations (including commencement date).
  - It will be longer from the time offices commence consideration of proposals included in the papers for the Working Group meeting.

## SUMMARY AND CONCLUSION

These comments largely provide additional detail regarding the proposals for establishing standards in provision of information which Australia made previously in Working Group meetings.

However, following changes in the Working Group's approach to the repeal of the safeguard clause, and further consideration of aspects of the issues, we have modified two aspects of our earlier proposal.

In this paper we propose:

1. That the interim standard will be met if, in relation to each mark to which protection is extended, the International Bureau is notified of the protection:
  - either by a notice under Rule 17(6), a notice under Rule 17(5), or by including the mark in a list of protected marks, and
  - such notification is sent as soon as is practicable after the mark becomes protected and in any case within 1 month from the end of the applicable refusal period.
2. A note could be included to state that failure to notify the International Bureau will in no way affect the status of the International Registration in that designated contracting party.
3. The Working Group may need some additional discussion of the proposed period for notification of protection.
4. There should be a single date by which all contracting parties must comply with the interim standards on information.

5. The Working Group should adopt a timetable for development of amendments to the Common Regulations along the following lines:
  - finalisation of recommendations on the text of amendments at the first meeting of the Working Group in 2008, and
  - approval of recommended amendments by the Madrid Assembly in September 2008.
6. The amendments to the Common Regulations commence in March or April 2009.

As noted above, we are also providing a separate paper dealing with setting a final standard in provision of information on international registrations.

We appreciate the general support which the Working Group and the IB has given to the proposals put by Australia and the opportunity for user groups and contracting parties to contribute to the preparation of the next discussion paper on this subject.

[End of Annex and of document]