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WORLD INTELLECTUAL PROPERTY ORGANIZATION
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WORKING GROUP ON THE MODIFICATION OF THE COMMON REGULATIONS UNDER THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS AND THE PROTOCOL RELATING TO THAT AGREEMENT

Geneva, October 9 to 13, 2000

REPORT

adopted by the Working Group

I. INTRODUCTION

1. The Working Group on the Modification of the Common Regulations Under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement (hereinafter “the Working Group”) held its first session in Geneva from October 9 to 12, 2000.

2. The following member States of the Madrid Union were represented at the session: Austria, Bulgaria, China, Croatia, Denmark, Egypt, Estonia, Finland, France, Germany, Greece, Hungary, Italy, Japan, Kenya, Latvia, Morocco, Norway, Portugal, Romania, Russian Federation, Slovakia, Slovenia, Spain, Sweden, Switzerland, The former Yugoslav Republic of Macedonia, Turkey, Ukraine, United Kingdom (30).

3. The following States were represented by observers: Australia, Canada, Congo, Côte d’Ivoire, Indonesia, Iraq, Ireland, Madagascar, Mexico, Philippines (10).

4. Representatives of the following intergovernmental organizations took part in the session in an observer capacity: Benelux Trademark Office (BBM), Commission of the European Communities (CEC) (2).
5. Representatives of the following international non-governmental organizations took part in the session in an observer capacity: European Communities Trade Mark Association (ECTA), International Association for the Protection of Industrial Property (AIPPI), International Chamber of Commerce (ICC), International Federation of Industrial Property Attorneys (FICPI), International Trademark Association (INTA), Licensing Executives Society (International) (LES) (6).
6. The list of participants is given in the Annex to this report.
7. Mr. François Curchod, Deputy Director General, opened the session and welcomed the participants on behalf of the Director General of WIPO.
8. The Working Group unanimously elected Mrs. Debbie Rønning (Norway) as Chair, and Mrs. Pei Xiaoling (China) and Mr. Željko Topic (Croatia) as Vice-Chairs. Mr. Malcolm Todd (WIPO) acted as Secretary of the Working Group.
9. Discussions were based on the following documents drawn up by the International Bureau: “Notes concerning proposals for the modification of the Common Regulations under the Madrid Agreement and Protocol” (document MM/WG/1/2), “Proposals for the modification of the Common Regulations under the Madrid Agreement and Protocol” (document MM/WG/1/3) and “Refusal of protection in the framework of the Madrid system” (document MM/WG/1/4).
10. The Secretariat noted the interventions and recorded them on tape. This report summarizes the discussions without necessarily reproducing all the comments that were made.

II. GENERAL OBSERVATIONS

11. The Delegation of Japan recalled that Japan had joined the Protocol as from March 14, 2000, and that this had been an important step for that country. It observed that, up to the end of August 2000, over 100 applications of Japanese origin had been filed while the Japanese Patent Office had received 980 designations. The activity related to the international registration of marks was expected to increase in the future and Japan hoped that an increasing number of countries would join the Madrid Protocol. Japan was willing to provide assistance to attain this goal.
12. The Representative of INTA welcomed the proposals that had been made by the International Bureau to amend the Common Regulations under the Madrid Agreement and Protocol. Although these Regulations had been operating satisfactorily for four and a half years, this was a good opportunity to clarify a number of issues.
13. The Delegation of China expressed its hope for a successful outcome of the first session of the Working Group.

14. The Representative of ICC and FICPI expressed support for the simplification of procedures under the Madrid Agreement and Protocol, in the interest of users.

III. PROPOSALS FOR THE MODIFICATION OF THE COMMON REGULATIONS UNDER THE MADRID AGREEMENT AND PROTOCOL

15. Discussions were based on documents MM/WG/1/2 and 3.

Presentation of Requests and Other Communications to the International Bureau: Interested Office

16. The Delegations of Switzerland, Portugal and Romania expressed their support for the amendments proposed by the International Bureau which aimed at clarifying the provisions which at present use the expression “interested Office.” The Delegations of Switzerland and Spain further stated that they were favorable to a liberalization of the rules on presentation of requests to the International Bureau.

Rule 1(xxvibis)

17. While expressing its support to the insertion of the proposed definition in Rule 1, the Delegation of Switzerland suggested using the expression “the Contracting Party of the *new* holder” instead of “the Contracting Party of the holder.” The International Bureau drew attention to the fact that the word “holder” used in the Common Regulations always referred to the holder recorded in the International Register, and that using the expression “new holder” could create confusion.

Rule 3(2)(b)

18. The Representative of INTA noted that the possibilities presented in sub-paragraphs (i) and (ii) were alternative and that the conjunction “or” should therefore be inserted at the end of sub-paragraph (i).

Rule 7(1)

19. In reply to the question raised in footnote 3 of document MM/WG/1/3 as to whether there was any justification for this provision, the Delegation of Italy, recalling that Italy was one of the countries that had made the declaration provided for in Rule 7(1), stated that it had no authority to withdraw that declaration and that the matter deserved further consideration. In response to a question from the International Bureau, the Delegation of Sweden said that it was not yet prepared either to take a stand on this matter. As a result, it was agreed that the International Bureau would consult the Offices of those Contracting Parties which had made the declaration under this Rule in order better to assess the need for maintaining this provision.

Rules 16(2), 17(5), 18(1)(c) and 19(2)

20. While in favor of the drafting change proposed by the International Bureau, the Delegation of Japan suggested maintaining the requirement to transmit the information referred to in these Rules to the Office of the Contracting Party of the holder. The International Bureau recalled that information concerning refusals and invalidations was accessible to everyone through ROMARIN and that in addition the Offices had access to the International Register online. It wondered therefore whether maintaining this requirement in Rules 16, 17, 18 and 19 did not result in a redundant work for the Offices themselves and for the International Bureau.

21. As regards Rule 17, the Delegations of Finland and Italy pointed out that the information concerning the grounds for a refusal, which could be of interest for Offices, was not accessible through ROMARIN or through online consultation of the International Register.

22. It was agreed that the requirement to send a copy to the Office of the Contracting Party of the holder, when that Office so wished, would be retained in Rule 17(5) but omitted from Rules 16(2), 18(1)(c) and 19(2).

23. Concerning Rule 19(2), the Delegation of Japan stated that, under the Japanese trademark law, the invalidation of an international registration in Japan took effect as from the date on which the said invalidation was recorded in the International Register. It was therefore important for the Japanese Office to know as soon as possible the date of recordal of the invalidation in the International Register.

24. The International Bureau said that a new text for Rule 19(2), taking into account the point made by the Delegation of Japan, would be submitted to the next session of the Working Group.

Rule 24(2)(a)

25. There were no comments on the proposed amendments to this Rule.

Rule 25(1)

26. The Delegation of Switzerland stated that it was favorable to according the greatest flexibility to holders in the presentation of requests to the International Bureau, and expressed therefore its support to the omission of subparagraph (c) of Rule 25(1), as suggested in version D of the proposal by the International Bureau.

27. The Delegation of Spain said that, while it too favored greater liberalization, it had doubts about the compatibility of version D with certain provisions of the Agreement which seemed to require a request for recordal of a renunciation or a cancellation to be presented through an Office. However, it expressed its support to the proposed version C of subparagraph (c).

28. In reply to a question of the Delegation of Italy concerning the requirements for the presentation of a request for limitation and change in ownership under Articles 9(3) and 9*bis*(1) of the Agreement, respectively, the International Bureau said that, considering their lack of clarity, these Articles allowed for different interpretations, thereby permitting a pragmatic approach to the problem.

29. The Delegation of Italy said that, from its point of view, the most sensitive issue was the presentation of a request to record a change in ownership. Should the liberalization of this communication be agreed upon, it saw no obstacle to interpreting the provisions of the Agreement in a flexible way which allowed for liberalizing the presentation of other requests as well. However, the delegation requested more time to consider this question and proposed that the discussions be postponed until the next meeting of the Working Group. This point of view was shared by the Delegation of Hungary, which further stated that, at the moment, it was rather favorable to version A of the proposal by the International Bureau, and by the Delegation of Spain.

30. The Representative of INTA expressed its satisfaction for the opening of discussions on this matter and supported the suppression of the requirement for users to present requests through an Office.

Rules 27(1) and (3), 34(1) and (5)(b) and 35(1)

31. There were no comments on the proposed amendments to these Rules.

The Treaty Governing a Given Designation

*Rule 1(xvii**bis**) and (xviii**bis**)*

32. There were no comments on the proposed new definitions.

Administrative Instructions

*Rules 1(xx**xi**) and 41*

33. The Delegation of Spain requested clarification as to the type of consultations which would be carried out by the Director General in order to establish or amend the Administrative Instructions, and in particular whether they would always be carried out before making any decision. The International Bureau indicated that, in the framework of the Hague system, interested Offices were always consulted before the Administrative Instructions were amended by the Director General and that it could not recall any instance where an amendment had been objected to by an interested Office. The International Bureau further stated that it would make it clear in Rule 41(1)(a) that consultation would take place before the Administrative Instructions are established or modified. Furthermore, the International Bureau pointed out that, in any event, as specified under paragraph (2) of Rule 41, the Assembly could invite the Director General to modify the Administrative Instructions and he would then be obliged to proceed accordingly.

34. The Delegation of Italy asked whether the Administrative Instructions referred merely to matters internal to the International Bureau and its functioning or whether they related also to issues which had an impact on national Offices and users. The International Bureau replied that the Administrative Instructions would address matters of detail which would pertain not only to the International Bureau, but also to national Offices and users.

35. The Representative of LES expressed the view that the current wording of paragraph (4) of Rule 41 in the English version might be taken to mean that the provisions of the Common Regulations prevailed over those of the Madrid Agreement and Protocol. The International Bureau noted that the French version of the text did not pose the same problem and said it would consider amending the English text accordingly.

36. The Delegation of the United Kingdom and the Representative of AIPPI expressed their full support for the transfer of detailed requirements from the Common Regulations, which would thus be greatly simplified and more user-friendly, to the Administrative Instructions.

Appointment of a Representative

Rule 3(2)(b)

37. There were no comments on the proposed amendments to this Rule.

Requirements Concerning the International Application

Rule 9(4)(a)(i), (ii) and (iii)

38. There were no comments on the proposal made by the International Bureau to remit part of the requirements contained in these subparagraphs to the Administrative Instructions.

Claim to color as a distinctive feature of the mark: Rule 9(4)(a)(vii)

39. The Delegation of Germany stated that it generally agreed with the proposed amendment but sought confirmation that the holder would not be required to claim color in the international registration where the basic mark was in color but did not include a color claim. The International Bureau replied that the proposal required a claim to color to be included in the international application only where such a claim was included in the basic application or registration. The fact that the basic mark was in color did not necessitate the inclusion of such a claim, but the proposal would allow the applicant the option of including such a claim.

40. The Delegation of Germany further proposed to add the words “as a distinctive feature of the mark” after the words “where color is claimed.”

41. The Delegations of Spain, Italy, Portugal and Greece expressed concern that the proposal by the International Bureau allowed for the possibility of claiming color in the international application where it had not been claimed in the basic application or registration. The Delegation of Turkey, noting that the trademark law of its country did not provide for color claim, expressed also some concern and requested more time to consider the proposal.

42. The Delegations of France, Switzerland and Ireland, along with the Representatives of AIPPI and ICC, supported the proposal made by the International Bureau.

43. The International Bureau explained that the proposed amendment *required* that color be claimed in the international registration where it had been claimed in the national application or registration and that it *allowed* for color to be claimed in the international application only where the basic mark was in color but not where the basic mark was in black and white. It was up to the national Offices to determine *when* it had to be considered that color had been claimed in the national application or registration; for example, an Office could consider that the mere fact of submitting a reproduction in color in the national application was equivalent to a claim to color, and the Office was therefore free to require that an equivalent claim to color be also present in the international application. The proposed amendment aimed at solving a problem for users in certain Contracting Parties, for example France, where color could not be claimed in a national application. At present, these users were prevented from making a color claim in the international registration and were therefore unable to forestall objections that could arise in certain designated Contracting Parties.

44. Following the explanation by the International Bureau, the Delegations of Italy and Spain stated that they could accept the proposed amendment as modified by the suggestion of the Delegation of Germany.

Description of the mark: Rule 9(4)(a)(xi)

45. The Delegations of Japan and France stated that they were not in favor of the proposed amendment insofar as they considered that it was not up to an applicant to decide whether or not it was appropriate to maintain a description in the international registration which was present in the national application or registration. The Delegation of France pointed out that the description could contain matter which affected the scope of protection, such as a disclaimer.

46. The Delegation of Australia, stating that Australia was actively considering accession to the Protocol, expressed concern with the proposal. Descriptions were frequently required by the Australian Office, which would not be able to certify that the mark in the international application was the same as in the national application or registration if a description appearing in the latter did not also appear in the former.

47. The International Bureau suggested that the proposal could be amended to provide for the inclusion in the international application of a description contained in the basic application or the basic registration either where the applicant wished to include such description or where the Office of origin so required. This suggestion was supported by the Delegations of Italy and, subject to seeing the final draft, Australia, as well as by the Representative of AIPPI. The Delegation of France stated that it could also accept it in a spirit of compromise.

48. Arising out of the remarks by the Delegation of France, the International Bureau observed that disclaimers of non-distinctive elements were required by some Contracting Parties and said that a proposal concerning the possibility to include a disclaimer in an international application would be submitted to the Working Group at its next session.

Rule 9(5), (6) and (7)

49. There were no comments on the proposal to modify the general structure of these provisions.

Date of the International Registration in Special Cases: Rule 15

50. There were no comments on the proposed amendments to this Rule.

Restriction of the Holder's Right of Disposal: Rule 20

Rule 20(1)

51. The Delegations of Italy, Spain, Austria, Switzerland and France, along with the Representative of LES, declared that they were in favor of the proposal to amend Rule 20(1). Following a question from the Delegation of Japan as to the purpose of this proposal, the International Bureau confirmed that it aimed, among other things, at increasing the information concerning international registrations that was accessible to users.

Rule 20(4)

52. The Delegations of Italy, Spain, Slovenia, Switzerland and France, along with the Representatives of LES, AIPPI, FICPI and ICC, were also strongly in favor of deleting paragraph (4) of Rule 20 and providing for the possibility of recording licenses in the International Register.

53. The Delegations of Finland, Sweden and Norway stated that, although they were in principle in favor of this possibility, they had a doubt as to the conformity of such a possibility with their national laws, which provided that the recordal of a license could be refused if the use of the mark was liable to be deceptive.

54. The Delegation of Germany noted that, since the German Law did not provide for the recordal of licenses, it would be favorable to the recordal of licenses in the International Register only if it remained an option for the holder and not an obligation.

55. The Representative of AIPPI observed that no-one seemed to object to the principle whereby there should be the possibility of recording licenses in the International Register, but that the actual contents of the proposal had yet to be determined. In drafting the proposal, the International Bureau would have to take account of the problems mentioned and find a solution permitting to reconcile the different systems. A possible solution could be to provide for the possibility for a designated Contracting Party to declare that the recordal of a license had no effect in its territory, as was provided for in the case of a partial change in ownership.

56. The Representative of FICPI and ICC was of the opinion that the provisions concerning the recordal of licenses should be included in a separate rule rather than in a rule on restrictions on the right of disposal.

57. Replying to the preceding interventions, the International Bureau said that a proposal would be submitted to the next session of the Working Group, which would consist in more than simply deleting paragraph (4) of Rule 20 and would take account of the problems raised by the Delegations of Germany, Finland, Norway and Sweden, as well as consider the suggestions made by the Representatives of AIPPI, FICPI and ICC.

58. The International Bureau informed the meeting that it had received written comments from AIM, which supported Rule 20(4) in its present form on the grounds that bureaucracy should be kept at its minimum. The International Bureau added that a reply had been sent to AIM pointing out that the possibility to record licenses in the International Register had been proposed precisely with the aim of reducing bureaucracy.

Merger of the Basic Applications or Basic Registrations: Rule 23

59. In reply to a concern expressed by the Delegation of Spain, the International Bureau said that mergers of the basic applications or basic registrations would be published in the same way as divisions of the basic application or basic registration.

60. There were no further comments on the proposed amendments to this Rule.

Subsequent Designations: Rule 24(1), (3)(d) and (5)(c)

61. There were no comments on the proposed amendments to this Rule.

Merger of International Registrations: Rules 27(3) and 32(1)(a)(xi)

62. There were no comments on the proposed amendments to these Rules.

Declaration that a Limitation or a Cancellation has no Effect: Rule 27(4)

63. The Delegations of Finland and Denmark fully supported the proposal.

64. The Delegations of Italy and Spain stated that, although they had no substantive objection to the proposal, they had difficulty with the title of paragraph (4) which used the broader term “change” to refer to a change in ownership and a limitation. Moreover, the Delegation of Italy wondered whether it would not be more appropriate to deal with the corresponding declarations relating to a change in ownership and declarations relating to a limitation in two separate paragraphs.

65. In response to an intervention by the Representative of AIPPI, the International Bureau said that the proposed paragraph (4) followed the terminology used in Rule 25, in which the expression “change” comprised, among others, both a change in ownership and a limitation. However, a distinction could be made between the refusal of effects of a change in ownership and the refusal of effects of a limitation. The International Bureau would therefore submit a new proposal in which the provisions concerning the refusal of effects to a change in ownership would be separate from those concerning the refusal of effects of a limitation or a cancellation.

66. In reply to a question raised by the Delegation of Turkey, the International Bureau said that the proposed amendment did not refer to the possibility of refusing the effects of a change in the name of the holder, since it was believed that this type of change could not be objected to.

67. As regards the possibility of applying the same principles to partial cancellations made under Rule 22, while this was supported by the Delegation of Finland, the Delegations of Italy and France considered that it would not be appropriate to object to a decision taken by the Office of origin. Taking into account the concern expressed by these delegations and that partial cancellations made under Rule 22 were very rare, the International Bureau suggested not to modify Rule 22 at this stage, but to keep the matter under review.

Corrections in the International Register: Rule 28

68. Replying to a question by the Delegation of Austria, which expressed its agreement in principle to the proposed amendment, the International Bureau said that the time limit to request a correction which had featured in Rule 23 of the former Regulations had been omitted from the present Rule 28, possibly because it had been felt that having a time limit was too restrictive. Whatever the reason might have been, however, experience had shown that not having a time limit created excessive legal uncertainty for third parties.

69. Following a question by the Delegation of Spain, the International Bureau confirmed that the proposed amendment would consist in introducing a time limit to correct errors attributable to a national Office only, as was provided for under the former Rule 23. The Delegation of Finland expressed the view that, for the sake of legal certainty, any time limit should also apply to errors made by the International Bureau.

70. The Delegations of Norway, Denmark, France, Japan and Portugal, and the Representative of AIPPI supported the adoption of a six-month time limit, while the Delegations of Germany, Italy and China favored a one-year time limit.

71. The Representative of FICPI pointed out that, for the sake of legal certainty, a six-month time limit would be more favorable for third parties, whereas a one-year time limit would be more convenient for holders. The International Bureau observed that holders had, through the registration certificate and the publication, the possibility to check the data recorded in the International Register, and that a six-month time limit seemed sufficient to that end.

72. It was agreed that the International Bureau would make a proposal to amend Rule 28 in order to introduce a time limit.

The Gazette: Rule 32(2)(v), (3) and (4)

73. As regards Rule 32(2)(v), the Delegation of Japan, and the Representative of FICPI referring to the interests of small companies, expressed the view that the information concerning the days on which Offices of the Contracting Parties were not open to the public was useful and should therefore be maintained. The Delegations of the United Kingdom and Germany, and the Representative of AIPPI were of the opinion that, while the information concerning the opening days of the International Bureau should be published, the requirement to publish the information concerning the days on which Offices of the Contracting Parties were not open to the public could be deleted.

74. The International Bureau noted that many Offices failed to communicate the information referred to in Rule 32(2)(v). The information published in the Gazette was therefore incomplete and often out of date. Publication of the source where such information could be found, such as the internet addresses of the Offices, would probably prove to be more useful for users. The Delegation of Romania and the Representative of AIPPI agreed with this suggestion.

75. As regards Rule 32(4), the Delegation of Japan considered that this provision should remain in the Regulations, while the Delegation of Spain wondered whether remitting it to the Administrative Instructions would not be inconsistent with Article 3(5) of the Agreement and the Protocol.

76. With respect to a further doubt expressed by the Delegation of Spain concerning the effect of transferring this provision to the Administrative Instructions, the International Bureau stated that it was not its intention to reduce the number of copies sent to the Offices of the Contracting Parties. The aim of remitting this provision to the Administrative Instructions was rather to give more flexibility to the procedure required to amend it, so as to be able to keep up with the technological developments in the form of publication of the Gazette.

IV. REFUSAL OF PROTECTION IN THE FRAMEWORK OF THE MADRID SYSTEM

77. Discussions were based on document MM/WG/1/4.

Terminology

78. The Representative of AIPPI welcomed the suggestion of the International Bureau consisting of replacing the terms "refusal" and "refusal based on an opposition" by, respectively, the terms "provisional refusal" and "opposition." In connection with the term "provisional refusal," the Representative of AIPPI also pointed out that such a change would restore the situation which existed before the Common Regulations came into force on April 1, 1996, and he expressed the view that it would satisfy the users.

79. The Delegation of Austria, supported by the Delegations of Hungary, Switzerland and Australia, as well as the Representative of INTA, expressed its full support to the proposed new terminology, which would give the Offices and users a clearer understanding as to the state of protection of the mark concerned in a given Contracting Party.

80. The Delegation of France said that it supported the new terminology suggested by the International Bureau, but expressed a reservation as to whether the separate publication of oppositions in the Gazette would be compatible with Rule 32(1)(iii), which provided that the International Bureau shall publish in the Gazette relevant data concerning refusals without the grounds for refusal.

81. The Representative of FICPI indicated that, while the issue of terminology in connection with refusals was appropriately addressed by the International Bureau, it was important to preserve as much as possible the traditional terminology used in the Madrid system.

82. The Delegation of Spain said that it supported the proposed definition. However, since the practice of its Office was to group all grounds for refusals (including oppositions) in one single notification of refusal, it expressed concern that separate publication of oppositions might entail a requirement for Offices to notify separately refusals based on *ex officio* examination and refusals based on oppositions.

83. The Delegation of China said that the use of the term “provisional refusal” could cause some problems since the Chinese Office issued a single decision of refusal. Such a refusal could then be the subject of a review before the re-examination board which is independent of the Chinese Office.

Facts and Decisions Subsequent to the Notification of Refusal

84. The Delegation of Spain stated that its system was of the type (b) mentioned in paragraph 13 of document MM/WG/1/4. Its practice was to issue in all cases a final decision (which was still subject to appeal before the Office) even where the time limit for requesting a review of the provisional refusal had expired without a review having been requested.

85. The Delegation of Switzerland said that its system also came under type (b). However, its practice was to send the “TLE” information when the time limit had expired without a request for review having been filed against the final refusal of protection notified to the International Bureau. It favored retention of the “TLE/RAL” information or of any other way of communicating the final nature of the decision.

86. The Delegation of France, supported by the Delegations of Austria, Germany and Sweden, favored the idea of discontinuing the notification of “RAL” and “TLE” information since this information in itself had no legal effects and since it appeared that numerous Contracting Parties did not currently communicate it. Moreover, it was apparent that, even when this information was sent, it had different implications according to the Contracting Parties concerned, which led to legal uncertainty for users.

87. The Representative of AIPPI said that it was of great interest for the users to maintain the “TLE” information especially since it could take several years before the notification of the final decision is sent to the International Bureau.

Requirements for the Sending of Refusals Based on Opposition After the Expiry of the 18-Month Time Limit

88. There were no comments on the proposal of the International Bureau to re-examine the wording of Rule 16.

Multiple Refusals

89. The Delegations of Germany and China supported the idea of sending a single communication comprising grounds for refusal raised *ex officio* and oppositions. However, in case of multiple oppositions, the corresponding notification should not be consolidated since this would entail a burden for the Office and could be source of errors.

90. The Representative of LES favored the sending of a single notification of refusal to the extent that it would allow the holder of the international registration to take a better informed decision as to whether or not to respond to the objections raised by the Office and to the oppositions.

91. The Delegation of France said that, as a general rule, it was satisfied with the suggestions of the International Bureau consisting, firstly, of notifying a single notification of provisional refusal (based only on *ex officio* grounds), secondly, of sending a distinct notification for each opposition, and, lastly, of sending a single statement setting out the final state of the protection of the mark after all the objections and oppositions have been disposed of. However, the Common Regulations should leave some room for exceptions in particular cases.

92. The International Bureau, in answer to a question raised by the Delegations of Norway and Finland, confirmed that it would be possible for an Office to notify a further provisional refusals within the applicable refusal period where additional grounds came to light, though this practice should be exceptional.

Meaning of “final decision”

93. The Delegation of Spain indicated that the current practice of its Office consisted of sending to the International Bureau notifications referred to as “final decisions” even though a further appeal could still be lodged. This, however, did not mislead the holder of the international registration concerned since the “final decisions” in question expressly indicated the possibility and the conditions to lodge such an appeal. Moreover, if the Office of Spain were to send to the International Bureau a final decision only after the time limit for filing an appeal has expired, the holder of the international registration would be deprived of the possibility to lodge the said appeal and would not therefore be offered the same remedies as if he had filed his mark directly with the Office of Spain.

94. The Delegation of France indicated that it interpreted the term “final decision” as meaning final decision *before the Office* and explained that such a view was prompted by two reasons. First, the final decision reached by its Office could not be sent directly to the holder of the international registration (and had therefore to be transmitted through the International Bureau) since the French legislation prohibited the sending of communications directly to

holders who did not have an address in France. Secondly, it would be problematic to send only “final decisions” (as this term was understood by the International Bureau) because the information concerning the filing of an appeal before a Court was not always communicated to the Office.

95. The Delegation of Austria said that its practice also consisted of interpreting the term “final decision” as meaning “final decision before an Office,” so that its Office notified to the International Bureau decisions referred to as “final decision” even though a further appeal before a Court could still be lodged. However, only around 10 appeals were lodged each year against the final decisions before the Office, out of which only one or two eventually reversed such decisions. In these rare cases, the Office then notified a second “final decision.” Given the infrequency of such occurrences, the risk of third parties being misled was minimal.

96. The Delegation of Finland commented that the final decision it communicated to the International Bureau was not a decision as such, but only an indication of the fact that the initial refusal had become final or has been reviewed and is no longer subject to any further review or appeal.

97. The Delegations of Slovenia and Sweden said that their Office notified to the International Bureau as final decisions, only decisions which were no longer subject to *any* review or appeal (either before the Office or before another administrative or judicial tribunal).

98. The Delegation of Greece said that it supported the proposal of the International Bureau.

99. The Delegation of Portugal proposed that all the decisions taken by an Office within the framework of the refusal procedure be notified to the International Bureau.

100. The Delegation of Switzerland indicated that the sending of the intermediate decisions directly to the holder of an international registration whose address is outside the territory of Switzerland was not possible under its legislation, other than by using diplomatic channels, which was long and complicated. Supported by the Delegation of Spain, the Delegation of Switzerland further expressed the idea of transmitting all such intermediate decisions to the holder through the intermediary of the International Bureau, but without the need for the latter to record or to publish them.

101. The International Bureau replied that this course of action was not possible under the Common Regulations as they currently stood.

102. The Representative of AIPPI said that, following the notification of a provisional refusal, there should be two further pieces of information to be notified to the International Bureau, namely, on the one hand, the final decision *reached by the Office* (which could take the form of the “TLE” information), and, on the other hand, the final decision being not subject of any further review or appeal (whether administrative or judicial). Recognizing, however, that it might not always be possible to communicate the latter, he suggested that one might explore the possibility to refer, rather than to “final decisions” to any decision having a bearing on the scope of protection of the mark.

103. The International Bureau stated that it would study all the suggestions made with a view to devising, for the next session of the Working Group, a proposal that would ensure the notification, recording and publication, on the one hand, of all decisions that must be

communicated to the holder of the international registration before he pursues the procedure before the Office of a designated Contracting Party through a local representative and, on the other hand, of decisions that are relevant for third parties to reliably form an opinion on the status of protection of the international registration in a given Contracting Party.

Publication of Refusals

104. The Delegation of Spain supported the proposal in paragraph 36 of document MM/WG/1/4 that the publication of a provisional refusal should not list the goods and services affected.

105. The Delegation of Japan considered that such information would be of interest to third parties.

106. In reply to questions raised by the Delegation of Finland, the International Bureau explained that the intention was that the list of goods and services affected by a provisional refusal would not be recorded in the International Register. The notification, however, would be kept. At the final decision stage, where the Office that pronounced the refusal would simply state that the refusal was confirmed, the list of goods and services affected would be included in the Register. Ideally, of course, it would be preferable if the Office of the Contracting Party concerned would communicate a list indicating the state of protection of the mark.

Possibility of Requesting Review or Appeal of a Refusal

107. The Delegation of Germany and the Representative of AIPPI expressed their support for the deletion of the words “whether the refusal may be subject to review or appeal and, if so,” in the text of Rule 17(2)(vii).

108. The Representative of AIPPI further proposed incorporating into the Common Regulations a minimum time limit of two months to respond to a (provisional) refusal.

Correction of Irregular Refusals

109. The Delegation of Austria, supported by the Delegation of Switzerland, favored the inclusion in Rule 18 of a requirement that any communication remedying a defective refusal contain a specific indication to that effect.

110. The Delegation of Switzerland asked the International Bureau whether in such a case the date of the initial refusal or the date of the remedied refusal should be indicated. The International Bureau replied that this latter date should be indicated.

111. The International Bureau further pointed out that, compared to the position existing under the previous Regulations, the consequences of a defective notification of refusal which was not remedied were more stringent under the current Common Regulations. In fact, in

such a case, the Common Regulations provided that the refusal in question was not considered as such. The opportunity could be taken to review this sanction which did not necessarily benefit holders since, even though a refusal was not considered as such and therefore not recorded in the International Register, the grounds for this refusal still existed.

Invalidation

112. The Representative of AIPPI questioned the statement in paragraph 43 of document MM/WG/1/4 that the result of a post-registration opposition could be notified as an invalidation. In his view, such oppositions had to be notified within the time limit allowed for refusals. The International Bureau replied that the interpretation of the Madrid Agreement and Protocol may vary from country to country, and that, if invalidation is regarded as a mechanism whereby protection which was already granted is subsequently taken away, then it is very difficult to prevent countries having a post-registration opposition system from following the above practice if they so wished.

113. The Delegations of Italy, Spain and Greece fully supported the proposal of the International Bureau to introduce a definition of invalidation in Rule 1, but considered that such definition should not include a reference to oppositions, which in accordance with the views expressed by the Delegation of AIPPI, were different in kind from invalidations.

V. MISCELLANEOUS

114. The Delegation of China proposed to amend the Regulations in order to provide for the registration certificate to be sent to the Office of origin rather than to the holder where the Office of origin so requested. The proposal was motivated by the fact that Chinese companies had complained to the Chinese Trademark Office that they had not received such certificate, possibly owing to the addressing of such certificate using latin script. The International Bureau, noting that this seemed to be a problem particular to certain countries, indicated that a text along the lines suggested by the Delegation of China would be submitted to the next session of the Working Group.

115. The Delegation of Spain proposed to amend Rule 6 in order to introduce the Spanish language as a further procedural language for the Madrid system. Such a change would in particular facilitate and encourage a possible expansion of the Madrid system to Latin American countries. The International Bureau replied that this proposal would be duly reflected in the report of the session. It required however a policy decision by the Assembly of the Madrid Union before any text could be submitted to the Working Group as appropriate.

116. The Delegation of Denmark pointed out that the current practice of the International Bureau whereby lists of international registrations affected by certain changes are notified to the Offices of all members of the Madrid Union that are concerned by any of those changes, increases the burden of Offices. They therefore requested that such changes be notified exclusively to the Offices of designated countries. The International Bureau replied that this practice would be reviewed and that this would not require a modification of the Common Regulations.

117. The Delegation of Finland asked whether any of the present Rules precluded the electronic transfer of data. The International Bureau agreed to look into this question.

118. The International Bureau indicated that it would also propose at the next session of the Working Group a correction of the date of October 2, 1979, appearing in Rule 1(i) of the Regulations to read instead "September 28, 1979."

VI. FUTURE WORK

119. Closing the meeting, the Chair noted that the International Bureau had indicated that it intended to convene a second session of the Working Group, tentatively arranged for June 11 to 15, 2001.

120. This report was unanimously adopted by the Working Group on October 12, 2000.

[Annex follows]

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