

Industrial Property

Published monthly
Annual subscription:
180 Swiss francs
Each monthly issue:
18 Swiss francs

28th Year - No. 12
December 1989

Monthly Review of the
World Intellectual Property Organization

Contents

NOTIFICATIONS CONCERNING TREATIES

Nice Agreement. New Member of the Nice Union: Japan 410

WIPO MEETINGS

Madrid Union. Diplomatic Conference for the Conclusion of a Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Madrid, June 12 to 28, 1989) . . . 411

NEWS ITEMS

Chile 460

Switzerland 460

CALENDAR OF MEETINGS 461

INDUSTRIAL PROPERTY LAWS AND TREATIES (INSERT)

Editor's Note

CHINA

Law on Technology Contracts (adopted by the Twenty-First Session of the Standing Committee of the Sixth National People's Congress on June 23, 1987) Text 6-001

MULTILATERAL TREATIES

African Regional Industrial Property Organization (ARIPO)

Agreement on the Creation of the African Regional Industrial Property Organization (ARIPO) (as adopted by the Diplomatic Conference for the Adoption of an Agreement on the Creation of an Industrial Property Organization for English-Speaking Africa at Lusaka (Zambia) on December 9, 1976, and amended by the Administrative Council of ARIPO on December 12, 1986) (*This text replaces the one previously published under the same code number*) Text 1-002

Protocol on Patents and Industrial Designs Within the Framework of the African Regional Industrial Property Organization (ARIPO) (adopted on December 10, 1982, at Harare (Zimbabwe), and amended by the Administrative Council of ARIPO on December 12, 1986) (*This text replaces the one previously published under the same code number*) Text 1-008

Regulations for Implementing the Protocol on Patents and Industrial Designs Within the Framework of the African Regional Industrial Property Organization (ARIPO) (text entered into force on April 25, 1984, and amended by the Administrative Council of ARIPO on December 12, 1986) (*This text replaces the one previously published under the same code number*) Text 1-010

© WIPO 1989

Any reproduction of official notes or reports, articles and translations of laws or agreements published in this review is authorized only with the prior consent of WIPO.

Notifications Concerning Treaties

Nice Agreement

New Member of the Nice Union

JAPAN

The Government of Japan deposited, on November 17, 1989, its instrument of accession to the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of June 15, 1957, as revised at

Stockholm on July 14, 1967, and at Geneva on May 13, 1977, and as amended on October 2, 1979.

Japan has not heretofore been a member of the Special Union for the International Classification of Goods and Services for the Purposes of the Registration of Marks ("Nice Union"), founded by the Nice Agreement.

The Nice Agreement, as revised and amended, will enter into force, with respect to Japan, on February 20, 1990. On that date, Japan will become a member of the Nice Union.

Nice Notification No. 69, of November 20, 1989.

WIPO Meetings

Madrid Union

Diplomatic Conference for the Conclusion of a Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks

(Madrid, June 12 to 28, 1989)

NOTE*

Since 1892, date of its entry into force, the Madrid Agreement Concerning the International Registration of Marks, which constitutes a "special Agreement" within the framework of the Paris Convention for the Protection of Industrial Property, provides for the possibility of obtaining the protection of a trademark in several countries by a single registration called "international registration." The application for such an international registration has to be filed with a single administrative authority—the International Bureau of WIPO—in a single language, through the intermediary of the Office of the country of origin of the mark. The International Bureau registers any mark that is the subject of such an application—provided that the application complies with the provisions of the Madrid Agreement and the Regulations thereunder—, publishes the registration in a monthly review and notifies it to the national Offices of the countries designated by the applicant, such Offices having the right to declare, within one year, that they cannot grant protection to the mark which is the subject of the notification.

Although the system established by the Madrid Agreement has been extensively used for almost 100 years, the number of countries party to that Agreement remained relatively small and was unlikely to grow very much since some features of the Madrid system had proved to be an obstacle for its acceptance by several countries, including countries with a high number of mark registrations at the national level, like Japan, the United Kingdom and the United States of America.

The features regarded as unacceptable by those countries were in particular: the necessity to register the mark at the national level prior to the international registration, the dependency of the international registration on the prior national registration, the relative

shortness of the time limit during which a national Office has the possibility of examining the mark and refusing to grant protection for the international registration, the system of fees which was considered detrimental to countries having a high level of national fees, those countries receiving a lesser amount for a mark registered under the Madrid system than for a mark registered at the national level.

It is for these reasons that, since the late 1960s, the International Bureau has been trying to change this unsatisfactory situation. One of the attempts consisted in the drafting of the Trademark Registration Treaty (TRT). That Treaty, adopted in Vienna on June 12, 1973, entered into force on August 7, 1980, with five contracting States (Burkina Faso, Congo, Gabon, Soviet Union, Togo) but, in view of the low number of registrations made since that date and the absence of new accessions, it had become clear that the TRT was not really viable.

In order to find new solutions, the Assembly of the Paris Union for the Protection of Industrial Property decided, in September 1984, that the International Bureau of WIPO should convene a Committee of Experts on the International Registration of Marks. The first session of that Committee took place from February 11 to 14, 1985. During that session, a memorandum by the International Bureau entitled "Some Ideas on a Possible Treaty on the International Registration of Marks" was discussed (see documents IRM/CE/I/2 and 3). The main subjects dealt with were the following: the relinquishment of the dependency of the international registration on a national registration and the relinquishment of the "central attack" system, the designation of States, the time limit for refusal, the regional marks, the working languages and the financial aspects.

A second session of the Committee of Experts on the International Registration of Marks was held from December 11 to 13, 1985, in order to discuss a document entitled "Detailed Outline of a Proposed

* Prepared by the International Bureau.

New Treaty on the International Registration of Trademarks" (see documents IRM/CE/II/2 and 3), prepared by the Director General of WIPO. The main subjects dealt with were the following: Should international applications be required to be based on a national (or regional) registration, or on a national (or regional) application? Should direct or indirect filing be allowed? Should the possibility for a central attack of the international registration be provided for? What should the effects of international registration be? Fees, time limit for provisional refusal, co-existence of the new treaty and the Madrid Agreement, languages, planned continuation of the work.

The third session of the Committee of Experts was held from November 11 to 14, 1986. It discussed a memorandum by the Director General entitled "Detailed Outline of a Proposed Treaty on International Trademark Applications and the Centralized Renewal and Modification of National Trademark Registrations ('Trademark Cooperation Treaty' (TCT))" (documents IRM/CE/III/2 and 3). The draft of that treaty suggested, as a basis for discussion, three proposals in order to facilitate trademark registration all over the world. The *first* proposal was related to the beginning of the procedure, namely the filing of applications. There would be no international registration in the proposed system. Consequently, everything would remain at the national level, except that the procedure for obtaining several national registrations could be started with one centrally filed international application at the International Bureau. This application would be communicated to the trademark office of each designated country (meaning a country in which registration was desired). Each designated country would treat such an internationally filed application as a national application. The *second* proposal dealt with a centralized renewal system. A single act performed through the International Bureau would cause the renewal of all the national registrations for the same trademark in all the member States where it was registered and for which renewal was requested. The *third* proposal concerned centralized modifications; again by one single act performed through the International Bureau, the owner of a trademark registered in several countries could effect certain changes in those national registrations, for example, changes indicating the transfer or assignment of the ownership of the registration.

In the meantime, the countries members of the European Communities had started to work on the establishment of what is called the Community trademark system. That system would consist in registering marks at what would be the (European) Community Trade Mark Office and Community trademarks so registered would have identical effects throughout the European Community.

The future existence of a European Community trademark registration system was of direct concern to the system established by the Madrid Agreement, since eight of the member countries of the Madrid Union

(Belgium, France, Germany (Federal Republic of), Italy, Luxembourg, Netherlands, Portugal, Spain) are members of the European Community (the four countries members of the European Community but not of the Madrid Union are Denmark, Greece, Ireland and the United Kingdom).

The desirability of establishing links between the Madrid registration system and the future European Community registration system was recognized as long ago as in the early 1980s. It led to the setting up, by the Assembly of the Madrid Union, of a special committee entitled "Working Group on Links Between the Madrid Agreement and the Proposed (European) Community Trade Mark." The meaning of "links" is that (i) an application for registration filed with, or a registration at, the (European) Community Trade Mark Office would be recognized as a basis for an international registration under the Madrid system, provided that the applicant was a national of a Community country or assimilated to such a national, and (ii) the effect of a Community registration could be obtained through an international (Madrid) registration. In other words, it should be possible, under the Madrid Agreement, to designate not only individual member countries of the Community but also the Community as a whole.

It was also realized that the establishment of those links would be facilitated if the above-mentioned four States were to join the Madrid Union. However, the four States stated that they could do this only if they were allowed to depart from the Madrid Agreement on certain points. The four main changes asked for were the following:

(i) it would be possible for an international registration to be based not on a national registration ("basic registration"), but on a national application ("basic application");

(ii) a period of 18 months (instead of one year) would be allowed for refusals;

(iii) national Offices would be allowed to receive the full amount, or a substantial percentage of the amount, of the fees that they charge for a national registration (instead of a uniform fee fixed by the Assembly of the Madrid Union);

(iv) an international registration cancelled following the failure of the basic registration or application ("central attack") could be transformed into national applications in the countries where the international registration had effect, such national applications retaining the date of the international registration (this possibility of transformation could be used where the grounds on which the trademark has been cancelled in the country of origin are not relevant in all or some of the designated countries).

The Working Group on Links met three times, in January 1986, July 1986 and June 1987, to examine the draft of two protocols (documents MACT/I/3, MACT/II/2 and MACT/III/2). One of the two protocols (Protocol A) was intended to amend the

Madrid system to make it acceptable in particular to the four countries of the European Communities not party to the Madrid Agreement. The second protocol (Protocol B), in addition to the same amendments, was designed to establish links between the Madrid system and the future (European) Community trademark system.

It was understood that the substantive changes in the Madrid system effected by the Protocols would not be applicable in the relations between the countries party to the Madrid Agreement, even if such countries adhered to the Protocols (principle of the "safeguard clause").

In view of the degree of agreement reached at the June 1987 session of the Working Group, the Assembly of the Madrid Union decided, in September 1987, the convocation of a diplomatic conference in the first half of 1989 for the adoption of Protocols A and B. The convocation of a Preparatory Committee for that conference to meet in December 1988 was also decided upon.

The Preparatory Committee for the Diplomatic Conference, which met from December 5 to 7, 1988, decided that the document to be prepared for the Diplomatic Conference should consist of the draft of a *single* Protocol, instead of two, and that the said Protocol should be open not only to States and the European Community but also to any intergovernmental organization maintaining a regional trademark registry (see document MM/PC/6). Furthermore, the Preparatory Committee established the list of the States and organizations to be invited to the Diplomatic Conference, as well as the draft Agenda and the draft Rules of Procedure of the Diplomatic Conference. Finally, it decided that the invitation of the Government of Spain

to hold the Diplomatic Conference in Madrid, which had been received in the meantime, should be accepted and that the Diplomatic Conference should be held from June 12 to 28, 1989.

In accordance with the above-mentioned decisions, the Diplomatic Conference for the Conclusion of a Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks was convened and organized by WIPO, at the facilities offered by the Spanish authorities, in Madrid, from June 12 to 28, 1989.¹

The Diplomatic Conference adopted, on June 27, 1989, a Protocol consisting of 16 articles under the title "Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks." The Protocol was opened for signature on June 28, 1989, and signed by the following 19 States: Belgium, Democratic People's Republic of Korea, Denmark, Egypt, France, German Democratic Republic, Germany (Federal Republic of), Hungary, Italy, Liechtenstein, Luxembourg, Mongolia, Morocco, Portugal, Soviet Union, Spain, Switzerland, United Kingdom, Yugoslavia. It remains open for signature until the end of 1989.

The text of the Protocol as appearing in the basic proposal and as adopted by the Diplomatic Conference is reproduced hereinafter with explanatory notes. Wherever the text of the Protocol as adopted is identical (at least on substance) with the text of the Stockholm Act of the Madrid Agreement, the reader may usefully consult the *Guide to the International Registration of Marks* published by the International Bureau.

¹ A note on the Diplomatic Conference was published in the July/August 1989 issue of *Industrial Property*, pp. 253.

Notes Concerning Article 1

1.01 The instrument that has been adopted is called "Protocol" relating to the Madrid Agreement. The latter was concluded in 1891 and was last revised in Stockholm in 1967 ("the Stockholm Act"). The Protocol relates to this, the latest, Act of the Madrid Agreement. In order to underline that fact, the Protocol refers to it as the "Madrid (Stockholm) Agreement." The present Notes refer to it as "the Stockholm Act."

1.02 The Protocol—unlike the new Acts or "revisions" of the various treaties administered by WIPO—is *not* intended to replace the Stockholm Act. This is why it is called a Protocol rather than an Act. It is to be noted that even if all the States party to the Stockholm Act acceded to the Protocol, that Act—and not the Protocol—will continue to apply in what generally is called the relations among States party to the Stockholm Act as long as Article 9*sexies* is not modified.

1.03 The Protocol is open for adherence not only to States but also to certain intergovernmental organizations (see Article 14(1)(b)). Once they adhere, they are called "Contracting States" and "Contracting Organizations," respectively. The expression "Contracting Parties" covers both Contracting States and Contracting Organizations.

1.04 Article 1 of the Protocol parallels Article 1(1) of the Stockholm Act which states that "The countries to which this Agreement [i.e., the Madrid (Stockholm) Agreement] applies constitute a Special Union for the international registration of marks."

1.05 Although the Protocol, as already indicated, is not applicable in the relations among States that are party to both the Stockholm Act and the Protocol, it applies in the relations (i) between, on the one side, such States and, on the other side, States or Organizations that are party only to the Protocol and (ii) between States or Organizations that are party only to the Protocol.

Because of this fact, and because the international registration system resulting from the Protocol is basically the same as the one existing under the Stockholm Act, it is logical and practical that both kinds of States (as well as the Organizations) be members of the same, the Madrid, Union. This is the idea that Article 1 expresses.

1.06 It is recognized that the rights and obligations of the States bound by the Stockholm Act and the rights and obligations of the Contracting Parties (an expression that covers, as already indicated, both States and Organizations) under the Protocol are not always the same, since the Stockholm Act and the Protocol differ from each other in certain respects. Although all will be members of the same Union, it is necessary that if there are questions to be decided by the Assembly—the intergovernmental organ of the Union—that are of interest to Contracting Parties only, or to States party to the Stockholm Act only, they do not interfere with each other. This is achieved by Article 10(3)(a). Nevertheless, it had to be recognized that the admission to the Assembly of Contracting Parties that are not party to the Stockholm Act could not be resolved without the consent of its present members. Therefore, the States party to the Stockholm Act, convened in an extraordinary session during the Diplomatic Conference, have adopted a resolution to the effect that even those of them which are not party to the Protocol accept the membership in the Union of States and Organizations that are party to the Protocol but not to the Stockholm Act. This is a transitional measure, since once all the States party to the Stockholm Act adhere to the Protocol, the acceptance, as members of the Union, of States and Organizations party only to the Protocol will result from Article 1 rather than from the above-mentioned Resolution.

Notes Concerning Article 2

2.01 This Article parallels Article 1(2) and (3) and Article 2 of the Stockholm Act.

2.02 *Ad paragraphs (1), (2) and (3):* These paragraphs give answers to four main questions:

(i) What must be the basis of an application for international registration (hereinafter referred to as "an international application")?

(ii) Who is entitled to file an international application?

(iii) Where must the international application be filed?

(iv) In what territory has the international registration effect?

2.03 As to the question what must be the basis of an international application, the answer is given in paragraph (1) of Article 2 of the Protocol: it must be an application filed with the (national) Office of a Contracting State or an application filed with the (regional) Office of a Contracting Organization (both are called "basic application") or it must be a registration effected by the (national) Office of a Contracting State or a registration effected by the (regional) Office of a

Draft
Protocol Relating to
the Madrid Agreement Concerning
the International Registration of Marks

(as contained in the basic proposal
(document MM/DC/3))

Article 1
Membership in the Madrid Union

The States party to this Protocol (hereinafter referred to as "the Contracting States"), even where they are not party to the Madrid Agreement Concerning the International Registration of Marks as revised in Stockholm in 1967 and as amended in 1979 (hereinafter referred to as "the Madrid (Stockholm) Agreement"), and the organizations referred to in Article 14(1)(b) of this Protocol which are party to this Protocol (hereinafter referred to as "the Contracting Organizations") shall be members of the same Union of which countries party to the Madrid (Stockholm) Agreement are members. Any reference in this Protocol to "Contracting Parties" shall be construed as a reference to both Contracting States and Contracting Organizations.

Article 2
Securing Protection Through
International Registration

(1) Where an application for the registration of a mark has been filed with the Office of a Contracting Party, or where a mark has been registered in the register of the Office of a Contracting Party, the person in whose name that application (hereinafter referred to as "the basic application") or that registration (hereinafter referred to as "the basic registration") stands may, subject to the provisions of this Protocol, secure protection for his mark in the territory of the Contracting States and the territory of the States members of the Contracting Organizations, by

Protocol Relating to
the Madrid Agreement Concerning
the International Registration of Marks

(as adopted by the Diplomatic Conference
on June 27, 1989)

Article 1
Membership in the Madrid Union

The States party to this Protocol (hereinafter referred to as "the Contracting States"), even where they are not party to the Madrid Agreement Concerning the International Registration of Marks as revised at Stockholm in 1967 and as amended in 1979 (hereinafter referred to as "the Madrid (Stockholm) Agreement"), and the organizations referred to in Article 14(1)(b) which are party to this Protocol (hereinafter referred to as "the Contracting Organizations") shall be members of the same Union of which countries party to the Madrid (Stockholm) Agreement are members. Any reference in this Protocol to "Contracting Parties" shall be construed as a reference to both Contracting States and Contracting Organizations.

Article 2
Securing Protection Through
International Registration

(1) Where an application for the registration of a mark has been filed with the Office of a Contracting Party, or where a mark has been registered in the register of the Office of a Contracting Party, the person in whose name that application (hereinafter referred to as "the basic application") or that registration (hereinafter referred to as "the basic registration") stands may, subject to the provisions of this Protocol, secure protection for his mark in the territory of the Contracting Parties, by obtaining the registration of that mark in the register of the International Bureau of the

(Notes Concerning Article 2, continued)

Contracting Organization (both are called "basic registration"). The applicant for the international application must be the same person who is the holder of the basic application, or the same person as the holder of the basic registration; the mark must be the same; and the goods and services in the list of the international application must be covered by the basic application or basic registration.

2.04 Whereas, under the Stockholm Act, an international application must be based on a national registration, under the Protocol an international application may be based also on a national (or regional) application. THIS IS THE FIRST OF THE FOUR MAJOR INNOVATIONS THAT THE PROTOCOL HAS INTRODUCED IN THE MADRID SYSTEM. (For the other three, see paragraphs 5.08, 8.10 and 9quinquies.02, below.) It removes what is generally considered a decisive obstacle to adherence to the existing Madrid system by some countries. The obstacle resides in the fact that the obtaining of a national (or regional) registration frequently takes too much time; in particular, it is frequently not possible within six months from the filing of the national (or regional) application and, whenever it is obtained only after that period, the right of priority (under Article 4A of the Paris Convention) is lost. By allowing—as the Protocol does—the filing of an international application on the basis of a national or regional application, the problem disappears; in particular, the risk of losing the right of priority is non-existent since six months is amply sufficient for the preparation and filing of the international application.

2.05 *Ad paragraph (1)*: As to the question who is entitled to file an international application, the answer is given in paragraph (1) of Article 2 of the Protocol. It is to be noted that the nationality of those persons referred to in items (i) and (ii) of that paragraph who are entitled to file international applications by virtue of the location of their domiciles or their industrial or commercial establishments is irrelevant; in other words, such persons can be nationals of Contracting States or of non-Contracting States. Furthermore, it is to be noted that the State referred to in item (ii) must be a member of the Contracting Organization concerned but need not be a Contracting Party. Finally, it is to be noted that the expression "national" is defined neither in the Stockholm Act nor in the Protocol but, traditionally, it covers not only natural persons but also legal entities, the latter being considered "nationals" of the State the law of which governs them.

2.06 Following a decision of the Diplomatic Conference, the words "or has a real and effective industrial or commercial establishment in such a State" (i.e., a State member of the Contracting Organization), which

appeared at the end of paragraph (1), item (ii) of the basic proposal, have been replaced in the final text by "or has a real and effective industrial or commercial establishment in the territory of the said Contracting Organization" because the territory of a Contracting Organization does not always include the whole of the territory of each of its member States (see paragraph 2.08, below).

2.07 As to the question in what territory the international registration has effect, the answer is given in paragraph (1) of Article 2 according to which the effect of the international registration ("the protection") extends to the territory of the Contracting Parties, provided, naturally, that the required designations are made at the time of the filing of the international application (see Article 3ter(1)) or thereafter (see Article 3ter(2)). However, there is an exception: according to the second sentence of Article 3bis, it is not possible to designate the Contracting Party whose Office is the Office of origin (see paragraph 3bis.01, below).

2.08 It has also to be noted that the Diplomatic Conference decided to replace the words "the territory of the Contracting States and the territory of the States members of the Contracting Organizations" appearing in paragraph (1) of Article 2 of the basic proposal by the words "the territory of the Contracting Parties" in the final text. Furthermore, a definition of "territory of a Contracting Party" has been introduced in (new) paragraph (4) of the final text. That modification is not only a question of drafting; indeed, where the Contracting Party is an intergovernmental organization, its territory does not always include the whole of the territory of each of its member States; it only covers the territory in which the constituting treaty of the Contracting Organization applies.

2.09 It is to be noted that the rule contained in paragraph (1) of Article 2 is subject not only to the exception contained in the second sentence of Article 3bis (see paragraph 2.07, above) but also to a further exception. That exception, contained in Article 9sexies, consists of what is called the safeguard clause of the Stockholm Act. See the notes accompanying that Article.

2.10 *Ad paragraph (2)*: As to the question where the international application has to be filed, the answer is given in paragraph (2) of Article 2 of the Protocol: it must be filed with—or, more precisely, must be filed "through the intermediary" of—that Office with which the basic application was filed or by which the basic registration was effected. That Office is called the "Office of origin."

2.11 *Ad paragraph (3)*: This paragraph defines "Office" and "mark." It seems to be self-explanatory.

2.12 *Ad paragraph (4)*: This paragraph, that has been introduced in the final text by the Diplomatic Conference following the modification introduced in paragraph (1) (see paragraph 2.08, above), defines what is meant by "territory of a Contracting Party."

*Basic Proposal**(Article 2(1), continued)*

obtaining the registration of that mark in the register of the International Bureau of the World Intellectual Property Organization (hereinafter referred to as “the International Register” and “the International Bureau,” respectively), provided that,

- (i) where the basic application has been filed with the Office of a Contracting State or where the basic registration has been made by such an Office, the person in whose name that application or registration stands is a national of that Contracting State, or is domiciled, or has a real and effective industrial or commercial establishment, in the said Contracting State,
- (ii) where the basic application has been filed with the Office of a Contracting Organization or where the basic registration has been made by such an Office, the person in whose name that application or registration stands is a national of a State member of that Contracting Organization, or is domiciled, or has a real and effective industrial or commercial establishment, in such a State.

(2) The application for international registration (hereinafter referred to as “the international application”) shall be filed with the International Bureau through the intermediary of the Office with which the basic application was filed or by which the basic registration was made (hereinafter referred to as “the Office of origin”), as the case may be.

(3) Any reference in this Protocol to an “Office” or an “Office of a Contracting Party” shall be construed as a reference to the office that is in charge, on behalf of a Contracting Party, of the registration of marks, and any reference in this Protocol to “marks” shall be construed as reference to trademarks and service marks.

*Text Adopted**(Article 2(1), continued)*

World Intellectual Property Organization (hereinafter referred to as “the international registration,” “the International Register,” “the International Bureau” and “the Organization,” respectively), provided that,

- (i) where the basic application has been filed with the Office of a Contracting State or where the basic registration has been made by such an Office, the person in whose name that application or registration stands is a national of that Contracting State, or is domiciled, or has a real and effective industrial or commercial establishment, in the said Contracting State,
- (ii) where the basic application has been filed with the Office of a Contracting Organization or where the basic registration has been made by such an Office, the person in whose name that application or registration stands is a national of a State member of that Contracting Organization, or is domiciled, or has a real and effective industrial or commercial establishment, in the territory of the said Contracting Organization.

(2) The application for international registration (hereinafter referred to as “the international application”) shall be filed with the International Bureau through the intermediary of the Office with which the basic application was filed or by which the basic registration was made (hereinafter referred to as “the Office of origin”), as the case may be.

(3) Any reference in this Protocol to an “Office” or an “Office of a Contracting Party” shall be construed as a reference to the office that is in charge, on behalf of a Contracting Party, of the registration of marks, and any reference in this Protocol to “marks” shall be construed as a reference to trademarks and service marks.

(4) For the purposes of this Protocol, “territory of a Contracting Party” means, where the Contracting Party is a State, the territory of that State and, where the Contracting Party is an intergovernmental organization, the territory in which the constituting treaty of that intergovernmental organization applies.

Notes Concerning Article 3

3.01 *Ad paragraph (1)*: It is Article 10(2)(iii) of the Protocol that speaks of the Regulations. The Regulations established under the Stockholm Act will have to be adapted, when the Protocol comes into force, to provide also for rules necessary for the implementation of the Protocol. The present Regulations provide for the form of the applications in Rule 8. The "particulars" to be certified are "all the particulars" (Rule 8(2)(xvii)), in particular that the applicant for the international registration is the same as the applicant of the basic application or the owner of the basic registration, as the case may be, as well as that the mark and that the goods and/or services are covered in the application for international registration as in the basic application or basic registration, as the case may be. The requirements as to (serial) numbers and dates, contained in the last two sentences of this paragraph, seem to be self-explanatory. It has been specified, during the Diplomatic

Conference, that an international registration of a mark could be based on several basic applications or several basic registrations of the said mark. That situation may occur for instance where a basic application or a basic registration covers only one class and the international registration is intended to cover several classes.

3.02 *Ad paragraph (2)*: This paragraph seems to be self-explanatory.

3.03 *Ad paragraph (3)*: This paragraph seems to be self-explanatory.

3.04 *Ad paragraph (4)*: This paragraph seems to be self-explanatory. The drafting of the third sentence of the basic proposal, that has been modified in the final text, does not imply any modification in substance.

3.05 *Ad paragraph (5)*: This paragraph seems to be self-explanatory.

Article 3 International Application

(1) Every international application under this Protocol shall be presented on the form prescribed by the Regulations. The Office of origin shall certify that the particulars appearing in the international application correspond to the particulars appearing, at the time of the certification, in the basic application or basic registration, as the case may be. Furthermore, the said Office shall indicate,

- (i) in the case of a basic application, the date and number of that application,
- (ii) in the case of a basic registration, the date and number of that registration as well as the date and number of the application from which the basic registration resulted.

The Office of origin shall also indicate the date of the international application.

(2) The applicant must indicate the goods and services in respect of which protection of the mark is claimed and also, if possible, the corresponding class or classes according to the classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks. If the applicant does not give such indication, the International Bureau shall classify the goods and services in the appropriate classes of the said classification. The indication of classes given by the applicant shall be subject to control by the International Bureau, which shall exercise the said control in association with the Office of origin. In the event of disagreement between the said Office and the International Bureau, the opinion of the latter shall prevail.

(3) If the applicant claims color as a distinctive feature of his mark, he shall be required

- (i) to state the fact, and to file with his international application a notice specifying the color or the combination of colors claimed;
- (ii) to append to his international application copies in color of the said mark, which shall be attached to the notification given by the International Bureau; the number of such copies shall be fixed by the Regulations.

(4) The International Bureau shall register immediately the marks filed in accordance with Article 2 of this Protocol. The international registration shall bear the date on which the international application was received in the Office of origin, provided that the international application has been received by the International Bureau within a period of two months from that date. If the international application has not been received within that period, the International Bureau shall record it as at the date on which it received the said international application. The International Bureau

Article 3 International Application

(1) Every international application under this Protocol shall be presented on the form prescribed by the Regulations. The Office of origin shall certify that the particulars appearing in the international application correspond to the particulars appearing, at the time of the certification, in the basic application or basic registration, as the case may be. Furthermore, the said Office shall indicate,

- (i) in the case of a basic application, the date and number of that application,
- (ii) in the case of a basic registration, the date and number of that registration as well as the date and number of the application from which the basic registration resulted.

The Office of origin shall also indicate the date of the international application.

(2) The applicant must indicate the goods and services in respect of which protection of the mark is claimed and also, if possible, the corresponding class or classes according to the classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks. If the applicant does not give such indication, the International Bureau shall classify the goods and services in the appropriate classes of the said classification. The indication of classes given by the applicant shall be subject to control by the International Bureau, which shall exercise the said control in association with the Office of origin. In the event of disagreement between the said Office and the International Bureau, the opinion of the latter shall prevail.

(3) If the applicant claims color as a distinctive feature of his mark, he shall be required

- (i) to state the fact, and to file with his international application a notice specifying the color or the combination of colors claimed;
- (ii) to append to his international application copies in color of the said mark, which shall be attached to the notifications given by the International Bureau; the number of such copies shall be fixed by the Regulations.

(4) The International Bureau shall register immediately the marks filed in accordance with Article 2. The international registration shall bear the date on which the international application was received in the Office of origin, provided that the international application has been received by the International Bureau within a period of two months from that date. If the international application has not been received within that period, the international registration shall bear the date on which the said international application was received by the International Bureau. The International Bureau shall

Notes Concerning Article 3bis

3bis.01 This Article completes the evolution of the answer to the question in which territories any given international registration has effect or, to use the traditional terminology (preserved also in the Protocol), "to" which territories the "protection" (given by the international registration) "extends." In the first stage of that evolution, that is from the beginning of the Madrid Agreement (1891) to the revision effected in Nice in 1957, every international registration had an effect in all Contracting States. In the second stage of that evolution, introduced by the Nice Act (1957), and still applicable in this respect, any Contracting State may require that it be expressly mentioned in the international application, with the consequence that if it is not so mentioned, the international registration has no effect in its territory. (This mentioning is sometimes called "designation," and although the term is not used in the Protocol, it is used—for the sake of simplicity—in the present Notes; the term used in the Nice and Stockholm Acts and the Protocol is "express request" to "extend"—hence the expression "territorial extension"—"the protection" to a Contracting State or to a Contracting Party.) All the present member States of the Madrid Union have made use of this faculty so that, in this second phase, one needs, in fact, to designate each and every one of those

States in which one desires protection. In the third phase of the evolution of this Article—the phase which has been introduced by the adoption of the Protocol—the Contracting Parties are not required to indicate that protection can extend to their territory only if they are designated in the international application. The requirement of designation automatically applies to all Contracting Parties. This requirement is worded in the Protocol as follows: "The protection resulting from the international registration shall extend to any Contracting Party only at the request of the person who files the international application or is the holder of the international registration." However, as already indicated in connection with Article 2 (see paragraph 2.07, above), it is not possible, under the second sentence of Article 3bis, to designate the Contracting Party whose Office is the Office of origin as defined in Article 2(2).

3bis.02 It is because of the automaticity of the requirement of designation that the introductory words of paragraph (1) and the totality of paragraph (2) of Article 3bis of the Stockholm Act are omitted in the Protocol.

*Basic Proposal**(Article 3(4), continued)*

shall notify the international registration without delay to the Offices concerned. Marks registered in the International Register shall be published in a periodical gazette issued by the International Bureau, on the basis of the particulars contained in the international application.

(5) With a view to the publicity to be given to marks registered in the International Register, each Office shall receive from the International Bureau a number of copies of the said gazette free of charge and a number of copies at a reduced price, under the conditions fixed by the Assembly referred to in Article 10 of this Protocol. Such publicity shall be deemed to be sufficient for the purposes of all the Contracting Parties, and no other publicity may be required of the applicant.

Article 3bis
Territorial Effect

The protection resulting from the international registration shall extend to any Contracting Party only at the request of the person who files the international application or who is the holder of the international registration. However, no such request can be made with respect to the Contracting Party whose Office is the Office of origin.

*Text Adopted**(Article 3(4), continued)*

notify the international registration without delay to the Offices concerned. Marks registered in the International Register shall be published in a periodical gazette issued by the International Bureau, on the basis of the particulars contained in the international application.

(5) With a view to the publicity to be given to marks registered in the International Register, each Office shall receive from the International Bureau a number of copies of the said gazette free of charge and a number of copies at a reduced price, under the conditions fixed by the Assembly referred to in Article 10 (hereinafter referred to as "the Assembly"). Such publicity shall be deemed to be sufficient for the purposes of all the Contracting Parties, and no other publicity may be required of the holder of the international registration.

Article 3bis
Territorial Effect

The protection resulting from the international registration shall extend to any Contracting Party only at the request of the person who files the international application or who is the holder of the international registration. However, no such request can be made with respect to the Contracting Party whose Office is the Office of origin.

Notes Concerning Article 3ter

3ter.01 Ad paragraph (1): This paragraph confirms what Article 3bis already provides for. The resulting redundancy is caused by the change that Article 3bis of the Protocol brings about in what is Article 3bis(1) in the Stockholm Act.

3ter.02 Ad paragraph (2): This paragraph deals with what is sometimes called "later designation," that is, the designation of a Contracting Party not in the interna-

tional application but in a separate document filed later, that is, *after* the international registration. It is to be noted that a later designation *under the Protocol* is possible only in respect of an international registration effected *under the Protocol*. In other words, it is not possible to make a later designation under the Protocol in respect of an international registration that was effected under the Stockholm Act.

Notes Concerning Article 4

4.01 Ad paragraph (1)(a): This paragraph is the provision that is the most important one of the Madrid system since it creates the legal effect of an international registration. The basic proposal provided that the said effect should be, from the date of the international registration, the same as that of a national or regional registration. After a long debate, the Diplomatic Conference adopted the final version of paragraph (1)(a) of Article 4, according to which from the date of the registration or recordal effected in accordance with the provisions of Articles 3 and 3ter, the protection of the mark in each of the Contracting Parties concerned shall be the same as if the mark had been deposited direct with the Office of that Contracting Party. It is only if no refusal has been notified to the International Bureau in accordance with Article 5(1) and (2) or if a refusal notified in accordance with the said Article has been later withdrawn that the protection of the mark in the Contracting Party concerned shall, as from the said date of the registration or recordal, be the same as if the mark had been registered by the Office of that Contracting Party.

4.02 Ad paragraph (1)(b): The indication of classes of goods and services has to conform to the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (see Article 3(2) of the Protocol). Paragraph (1)(b) of Article 4 means that the classification of

the goods and services as given by the applicant or corrected by the International Bureau (see Article 3(2) of the Protocol) has no binding effect on the designated Contracting Parties as regards the scope of protection.

4.03 Ad paragraph (2): The right of priority provided for in Article 4 of the Paris (Stockholm) Convention is six months for trademarks (Paris (Stockholm) Convention, Article 4C(1)), starting from the date of filing of the first application (Paris (Stockholm) Convention, Article 4C(2)). The formalities required by Article 4D of the Paris (Stockholm) Convention include, in particular, the production of a certified copy of the first application. The effect of paragraph (2) of Article 4 is, in essence, that if an international application claims the priority of an earlier national or regional application and is filed within six months, its effect will be retroactive to the filing date of the national or regional application. Furthermore, there will be no need for producing a certified copy of the national or regional application (since that application will be the application referred to in Article 3(1)(i) or (ii) of the Protocol, and the said Article already requires the indication of the date and serial number of the national or regional application and a corresponding certification by the Office of origin).

*Basic Proposal**Text Adopted***Article 3ter**
Request for "Territorial Extension"

(1) Any request for extension of the protection resulting from the international registration to any Contracting Party shall be specially mentioned in the international application.

(2) A request for territorial extension may also be made subsequently to the international registration effected under this Protocol. Any such request shall be presented on the form prescribed by the Regulations. It shall be immediately recorded by the International Bureau, which shall notify such recordal without delay to the Office or Offices concerned. Such recordal shall be published in the periodical gazette of the International Bureau. Such territorial extension shall be effective from the date on which it has been recorded in the International Register; it shall cease to be valid on the expiration of the international registration to which it relates.

Article 4
Effects of International Registration

(1)(a) From the date of the registration or recordal effected in accordance with the provisions of Articles 3 and 3ter of this Protocol, the protection of the mark in each of the Contracting Parties concerned shall, subject to Article 5 of this Protocol, be the same as if the mark had been registered by the Office of that Contracting Party.

(b) The indication of classes of goods and services provided for in Article 3 of this Protocol shall not bind the Contracting Parties with regard to the determination of the scope of the protection of the mark.

(2) Every international registration shall enjoy the right of priority provided for by Article 4 of the Paris Convention for the Protection of Industrial Property, without requiring compliance with the formalities prescribed in Section D of that Article.

Article 3ter
Request for "Territorial Extension"

(1) Any request for extension of the protection resulting from the international registration to any Contracting Party shall be specially mentioned in the international application.

(2) A request for territorial extension may also be made subsequently to the international registration. Any such request shall be presented on the form prescribed by the Regulations. It shall be immediately recorded by the International Bureau, which shall notify such recordal without delay to the Office or Offices concerned. Such recordal shall be published in the periodical gazette of the International Bureau. Such territorial extension shall be effective from the date on which it has been recorded in the International Register; it shall cease to be valid on the expiry of the international registration to which it relates.

Article 4
Effects of International Registration

(1)(a) From the date of the registration or recordal effected in accordance with the provisions of Articles 3 and 3ter, the protection of the mark in each of the Contracting Parties concerned shall be the same as if the mark had been deposited direct with the Office of that Contracting Party. If no refusal has been notified to the International Bureau in accordance with Article 5(1) and (2) or if a refusal notified in accordance with the said Article has been withdrawn subsequently, the protection of the mark in the Contracting Party concerned shall, as from the said date, be the same as if the mark had been registered by the Office of that Contracting Party.

(b) The indication of classes of goods and services provided for in Article 3 shall not bind the Contracting Parties with regard to the determination of the scope of the protection of the mark.

(2) Every international registration shall enjoy the right of priority provided for by Article 4 of the Paris Convention for the Protection of Industrial Property, without it being necessary to comply with the formalities prescribed in Section D of that Article.

Notes Concerning Article 4bis

4bis.01 Ad paragraph (1): This paragraph—as well as paragraph (2)—is in essence the same as it is in the Stockholm Act but has been redrafted for the sake of clarity. It will be particularly important for the nationals of Contracting Parties that will become party to the Madrid system through adhering to the Protocol (and which are not party to the Stockholm Act): they will have the possibility of replacing their registrations (national or regional) existing in Contracting Parties by an international registration and will, thereafter, have to monitor the renewal of only one registration (i.e., the international registration), instead of having to monitor the renewals of each national or regional registration that the international registration replaces. This simplified monitoring and, in many cases, lesser fees,

are among the advantages of replacing by an international registration earlier national or regional registrations. It is to be noted that the Diplomatic Conference decided to reintroduce, after the words “shall be deemed to have replaced the national or regional registration,” the words “without prejudice to any rights acquired by virtue of the latter” that appear in the Stockholm Act.

4bis.02 Ad paragraph (2): This provision guarantees that, by consulting the national and regional registers, the consulting party cannot be misled as to the true situation: he will be warned that he must, to know that situation, also consult the international register.

Notes Concerning Article 5

5.01 This, rather long, article is subdivided into six paragraphs; the content of each paragraph may be summarized as follows: paragraph (1) establishes the right of any designated Office to refuse the effect of the international registration (“refusal”) on the basis of certain grounds, some grounds being expressly excluded; paragraph (2) provides to whom the notification of refusal must be sent and fixes the time limit within which refusal may be notified by a designated Office; paragraph (3) deals with the communication of a refusal, or the possibility of a refusal, by the International Bureau to the holder of the international registration as well as with the right to appeal against refusals; paragraph (4) deals with the publicity of the grounds for refusal; paragraph (5) provides for the consequence of any non-refusal within the time limit prescribed for refusal; paragraph (6) deals with the invalidation of a non-refused international registration.

5.02 *Ad paragraph (1):* “Applicable legislation,” in the case of a regional Office, means the rules applicable to

that Office; for example, in the case of the future (European) Community Trade Mark Office, it, probably, will be the Regulation that the Council of the European Communities will adopt.

5.03 “Extension to [a] ... Contracting Party, under Article 3ter(1) or (2), of the protection resulting from the international registration” will, in the present Notes—for the sake of brevity—be described by the word “designation.” Article 3ter(1) deals with the designations contained in the international application, whereas Article 3ter(2) deals with “later” designations.

5.04 The notification is called a “notification of refusal” and its contents are described as a notification that says “that protection cannot be granted.”

5.05 The Paris Convention enumerates certain grounds for which the registration of a mark cannot be refused (Articles 6, 6quinquies A and C), must be refused (Articles 6bis, 6ter) or may be refused (Article 6quinquies B). The last sentence of paragraph (1) deals with

*Basic Proposal**Text Adopted***Article 4bis****Replacement of a National or Regional Registration by an International Registration**

(1) Where a mark that is the subject matter of a national or regional registration in the Office of a Contracting Party is also the subject matter of an international registration and both registrations stand in the name of the same person, the international registration shall be deemed to have replaced the national or regional registration, provided that

- (i) the protection resulting from the international registration extends to the said Contracting Party under Article 3ter(1) or (2) of this Protocol,
- (ii) all the goods and services listed in the national or regional registration are also listed in the international registration in respect of the said Contracting Party,
- (iii) such extension took effect after the date of the national or regional registration.

(2) The Office referred to in paragraph (1) shall, upon request, be required to take note in its register of the international registration.

Article 5**Refusal and Invalidation of Effects of International Registration in Respect of Certain Contracting Parties**

(1) Where the applicable legislation so authorizes, any Office of a Contracting Party which has been notified by the International Bureau of an extension to that Contracting Party, under Article 3ter(1) or (2) of this Protocol, of the protection resulting from the international registration shall have the right to declare in a notification of refusal that protection cannot be granted in the said Contracting Party to the mark which is the subject of such extension. Any such refusal can be based only on the grounds which would apply, under the Paris Convention for the Protection of Industrial Property, in the case of a mark filed direct with the Office which notifies the refusal. However, protection may not be refused, even partially, by reason only that the applicable legislation would permit registration only in a limited number of classes or for a limited number of goods or services.

(2)(a) Any Office wishing to exercise such right shall notify its refusal to the International Bureau, together

Article 4bis**Replacement of a National or Regional Registration by an International Registration**

(1) Where a mark that is the subject of a national or regional registration in the Office of a Contracting Party is also the subject of an international registration and both registrations stand in the name of the same person, the international registration is deemed to replace the national or regional registration, without prejudice to any rights acquired by virtue of the latter, provided that

- (i) the protection resulting from the international registration extends to the said Contracting Party under Article 3ter(1) or (2),
- (ii) all the goods and services listed in the national or regional registration are also listed in the international registration in respect of the said Contracting Party,
- (iii) such extension takes effect after the date of the national or regional registration.

(2) The Office referred to in paragraph (1) shall, upon request, be required to take note in its register of the international registration.

Article 5**Refusal and Invalidation of Effects of International Registration in Respect of Certain Contracting Parties**

(1) Where the applicable legislation so authorizes, any Office of a Contracting Party which has been notified by the International Bureau of an extension to that Contracting Party, under Article 3ter(1) or (2), of the protection resulting from the international registration shall have the right to declare in a notification of refusal that protection cannot be granted in the said Contracting Party to the mark which is the subject of such extension. Any such refusal can be based only on the grounds which would apply, under the Paris Convention for the Protection of Industrial Property, in the case of a mark deposited direct with the Office which notifies the refusal. However, protection may not be refused, even partially, by reason only that the applicable legislation would permit registration only in a limited number of classes or for a limited number of goods or services.

(2)(a) Any Office wishing to exercise such right shall notify its refusal to the International Bureau, together

(Notes Concerning Article 5, continued)

legislations—still existing in some countries—which have, in their national laws, the requirement of “one registration per class” or which put limits on the number of goods or services or on the number of classes that can be covered by one and the same national registration. Such limitations are not applicable to international registrations. “Class” means class according to the International (Nice) Classification or any other (e.g., “national”) classification (see Article 3(2) of the Protocol).

5.06 *Ad paragraph (2)*: This paragraph provides that any notification of refusal must be sent to the International Bureau, and it fixes the time limit within which any refusal must be notified to be effective. It follows from paragraph (5) that the refusal need not be “final” but may be merely “provisional,” that is, it may need confirmation or it may be changed (by the national or regional Office or by a quasi-judicial or judicial authority). The notification must contain “a statement of all grounds”; in other words, grounds not notified within the prescribed time limit cannot serve as a basis for a refusal.

5.07 *Ad paragraph (2)(a)*: As to the time limit within which a refusal—to be effective—must be notified, it is to be noted that the Diplomatic Conference decided to reintroduce, after the words “with a statement of all grounds,” the words “within the period prescribed by the law applicable to that Office and” that appear in the Stockholm Act and had been omitted in the basic proposal; this means that the said law can fix a time limit shorter than one year which, subject to subparagraphs (b) and (c), is the maximum time limit. This maximum time limit is the rule also under the Stockholm Act. The year is to be counted from the date on which the international registration or the territorial extension made subsequently to the international registration has been notified by the International Bureau to the designated Offices. Under the Stockholm Act, the rule cannot suffer any exception. Under the Protocol, the rule may suffer exceptions. Subparagraphs (b) and (c) provide for the exceptions.

5.08 SUCH EXCEPTIONS REPRESENT THE SECOND OF THE FOUR MAJOR INNOVATIONS OF THE PROTOCOL. (For the other three, see paragraph 2.04, above, and paragraphs 8.10 and 9*quinquies*.02, below.) The exceptions are intended to allow adherence to the Protocol by States that find that one year is too short for their Offices to notify even provisional refusals.

5.09 *Ad paragraph (2)(b)*: Any Contracting Party can make a declaration to the effect that the one-year time limit is replaced by 18 months. The modalities of the declaration are provided for in subparagraph (d) (see below).

5.10 Such a declaration is applicable “to international registrations made under this Protocol”; this means that

the 18-month time limit may be applied (i) by any Contracting Party (having made the declaration) that is a party only to the Protocol (that is, is not a party also to the Stockholm Act) in respect of any and all international registrations and (ii) by any Contracting Party (having made the declaration) that is a party to both the Stockholm Act and the Protocol in respect only of international registrations whose Office of origin is an Office of a Contracting Party that is a party to the Protocol only. This is so because, for any State party to both the Stockholm Act and the Protocol, an international registration whose Office of origin is an Office of another State party to both the Stockholm Act and the Protocol is *not* an international registration “made under this Protocol” but one made under the Stockholm Act. This follows from the “safeguard clause” contained in Article 9*sexies* of the Protocol.

5.11 *Ad paragraph (2)(c)*: This subparagraph provides, in effect and in certain cases, for a time limit even longer than 18 months. It is available only if the refusal is based on an opposition, that is, is the result of a request made by a third party that the protection be refused. Although the refusal may, as already stated, be notified after the 18-month period, it may be so notified *only if, before* the expiration of that period, the possibility that oppositions may be filed later is notified and the refusal will be effective *only if* it is notified within a time limit of not more than seven months from the date on which the opposition period begins. However, if the opposition period expires before this time limit of seven months, the refusal will be effective *only if* it is notified within a time limit of one month from the expiration of the opposition period. For example, if the law allows oppositions to be filed within three months from the publication of the mark by the national Office, the refusal must be notified within four months (three plus the said one) from such publication. The maximum of seven months, which did not appear in the basic proposal, has been introduced by the Diplomatic Conference to reduce the length of the period of uncertainty.

5.12 This extended (more than 18-month) time limit is applicable in the same cases, and only in those cases, that are described in paragraph 5.10, above. This is so because the extension for cases of opposition is part of the declaration made under subparagraph (b) (“*Such declaration [i.e., the declaration under subparagraph (b)] may also specify ...*”).

5.13 *Ad paragraph (2)(d)*: As already indicated, the modalities of the declaration concerning the use of the exception permitted by subparagraph (b), or of the exceptions permitted by subparagraphs (b) and (c), are provided for in subparagraph (d). This subparagraph also indicates the effective date of such declaration. The provisions seem to be self-explanatory. The modifications made in the last part of subparagraph (d) by the Diplomatic Conference are of a purely drafting nature.

*Basic Proposal**(Article 5(2), continued)*

with a statement of all grounds, at the latest, subject to subparagraphs (b) and (c), before the expiration of one year from the date on which the extension referred to in paragraph (1) has been notified to that Office by the International Bureau.

(b) Notwithstanding subparagraph (a), any Contracting Party may declare that, for international registrations made under this Protocol, the time limit of one year referred to in subparagraph (a) is replaced by 18 months.

(c) Such declaration may also specify that, when a refusal of protection may result from an opposition to the granting of protection, such refusal may be notified by the Office of the said Contracting Party to the International Bureau after the expiration of the 18-month time limit. Such an Office may, with respect to any given international registration, notify a refusal of protection after the expiration of the 18-month time limit, but only if

- (i) it has, before the expiration of the 18-month time limit, sent information to the International Bureau to the effect that there was a possibility of oppositions being filed after the expiration of the said 18-month time limit, and
- (ii) the notification of the refusal based on an opposition is made within a time limit of one month from the date of the expiration of the period allowed by the applicable law for filing oppositions.

(d) Any declaration under subparagraphs (b) or (c) may be made in the instruments referred to in Article 14(2) of this Protocol, and the effective date of the declaration shall be the same as the date of entry into force of the Protocol with respect to the State or intergovernmental organization having made the declaration. Any such declaration may be made also later, in which case the declaration shall have effect three months after its receipt by the Director General of the World Intellectual Property Organization (hereinafter referred to as "the Director General"), or at any later date indicated in the declaration, in respect of international registrations effected on or after the date of effect of the declaration.

(e) The time limits referred to in subparagraphs (b) and (c) may be modified by a unanimous decision of the Assembly referred to in Article 10 of this Protocol.

(3) The International Bureau shall, without delay, transmit one of the copies of the notification of refusal

*Text Adopted**(Article 5(2), continued)*

with a statement of all grounds, within the period prescribed by the law applicable to that Office and at the latest, subject to subparagraphs (b) and (c), before the expiry of one year from the date on which the notification of the extension referred to in paragraph (1) has been sent to that Office by the International Bureau.

(b) Notwithstanding subparagraph (a), any Contracting Party may declare that, for international registrations made under this Protocol, the time limit of one year referred to in subparagraph (a) is replaced by 18 months.

(c) Such declaration may also specify that, when a refusal of protection may result from an opposition to the granting of protection, such refusal may be notified by the Office of the said Contracting Party to the International Bureau after the expiry of the 18-month time limit. Such an Office may, with respect to any given international registration, notify a refusal of protection after the expiry of the 18-month time limit, but only if

- (i) it has, before the expiry of the 18-month time limit, informed the International Bureau of the possibility that oppositions may be filed after the expiry of the 18-month time limit, and
- (ii) the notification of the refusal based on an opposition is made within a time limit of not more than seven months from the date on which the opposition period begins; if the opposition period expires before this time limit of seven months, the notification must be made within a time limit of one month from the expiry of the opposition period.

(d) Any declaration under subparagraphs (b) or (c) may be made in the instruments referred to in Article 14(2), and the effective date of the declaration shall be the same as the date of entry into force of this Protocol with respect to the State or intergovernmental organization having made the declaration. Any such declaration may also be made later, in which case the declaration shall have effect three months after its receipt by the Director General of the Organization (hereinafter referred to as "the Director General"), or at any later date indicated in the declaration, in respect of any international registration whose date is the same as or is later than the effective date of the declaration.

(e) Upon the expiry of a period of ten years from the entry into force of this Protocol, the Assembly shall examine the operation of the system established by subparagraphs (a) to (d). Thereafter, the provisions of the said subparagraphs may be modified by a unanimous decision of the Assembly.

(3) The International Bureau shall, without delay, transmit one of the copies of the notification of refusal

(Notes Concerning Article 5, continued)

5.14 The Regulations (which will be adopted by the Assembly of the Madrid Union once the Protocol enters into force) will have to fix other details concerning the declaration referred to in subparagraphs (b) and (c). The present intent of the International Bureau is to propose to the Assembly (once the Protocol comes into force) to fix the said details as follows:

“(a) Where the declaration referred to in Article 5(2)(b) or (c) of the Protocol is not made in the instruments referred to in Article 14(2) of the Protocol, it shall be sent to the Director General and shall be communicated by him to all Contracting Parties.

(b) Any declaration referred to in Article 5(2)(b) or (c) of the Protocol may be withdrawn at any time. The decision of withdrawal shall be sent to the Director General and shall be communicated by him to all Contracting Parties. It shall have effect three months from the date of its communication, or at any later date indicated in the decision of withdrawal, in respect of international registrations effected on or after the date of effect of the withdrawal.”

5.15 *Ad paragraph (2)(e)*: Experience may show that the exceptional time limits are too short or unnecessarily long. They should, then, be changed. For that reason, the basic proposal provided that such change should not require an amendment of the Protocol, which would necessitate the holding of a diplomatic conference and the deposit of instruments of adherence, but could be effected by “a unanimous decision of the Assembly.” The final text of the Protocol adopted by the Diplomatic Conference provides that it is all the provisions of subparagraphs (a) to (d) that could be modified by a unanimous decision of the Assembly. However, such modifications could take place only after the Assembly has examined the operation of the system established by subparagraphs (a) to (d), upon the expiration of a period of ten years from the entry into force of the Protocol.

5.16 *Ad paragraph (3)*: Whereas paragraph (2) deals with the notification of the refusal by the national or regional Office to the International Bureau, the first sentence of this paragraph deals with the notification of the refusal by the International Bureau to the holder of the international registration. Such notification is effected through the transmittal of a copy of the notification made by the national or regional Office. Natu-

rally, if the holder of the international registration has appointed a representative, the notification of refusal will be notified to that representative. Indeed, if the applicant or the holder of the international registration has appointed a representative, each reference to the applicant or holder has to be understood, throughout the Protocol, as a reference to the representative (see Rule 2(2) of the Regulations under the Stockholm Act). The only exception is to be found in Article 7(4): under that provision, both the holder of the international registration and his representative are reminded in advance of the date of expiration of the international registration.

5.17 The second sentence of paragraph (3) provides that the holder of the international registration has the right to the same remedies against any refusal (provisional or definitive) that he would have if he had filed a national or regional application with the Office making the refusal (rather than using the Protocol).

5.18 The third sentence of paragraph (3) deals with the notification of the information referred to in paragraph (2)(c)(i) by the International Bureau to the holder of the international registration. The notification consists of the transmittal of copies of the papers containing the information. The information referred to in paragraph (2)(c)(i) relates to the “possibility that oppositions may be filed after the expiry of the 18-month time limit.”

5.19 *Ad paragraph (4)*: The official gazette of the Madrid Union publishes the fact that a refusal has been notified to the International Bureau but does not—at least under the present system—publish the grounds. This paragraph enables any person to request the International Bureau to let him know what the grounds are, and the International Bureau must then satisfy the request on the basis of the information that it received from the refusing Office.

5.20 *Ad paragraph (5)*: This paragraph provides, in essence, that if the time limit(s) of notifying a refusal or a possibility of refusal are missed, the right to refuse is lost.

5.21 *Ad paragraph (6)*: Whether the right to refuse was lost (under paragraph (5)) or not, the effects of an international registration may always be taken away (“invalidated”), but not without the holder of the international registration having been offered the opportunity of defending his rights. This is what, in essence, this paragraph means. It goes without saying—since it follows from the Paris Convention—that invalidation cannot be pronounced in cases in which the Paris Convention prohibits it.

*Basic Proposal**(Article 5(3), continued)*

to the holder of the international registration. The said holder shall have the same remedies as if the mark had been filed by him direct with the Office which has notified its refusal. Where the International Bureau has received information under paragraph (2)(c)(i), it shall, without delay, transmit the said information to the holder of the international registration.

(4) The grounds for refusing a mark shall be communicated by the International Bureau to any interested party who may so request.

(5) Any Office which has not notified, with respect to a given international registration, any provisional or final refusal to the International Bureau in accordance with paragraphs (1) and (2) shall lose the benefit of the right provided for in paragraph (1), with respect to that international registration.

(6) Invalidation, by the competent authorities of a Contracting Party, of the effects, in that Contracting Party, of an international registration may not be pronounced without the holder of such international registration having, in good time, been afforded the opportunity of defending his rights. Invalidation shall be notified to the International Bureau.

*Text Adopted**(Article 5(3), continued)*

to the holder of the international registration. The said holder shall have the same remedies as if the mark had been deposited by him direct with the Office which has notified its refusal. Where the International Bureau has received information under paragraph (2)(c)(i), it shall, without delay, transmit the said information to the holder of the international registration.

(4) The grounds for refusing a mark shall be communicated by the International Bureau to any interested party who may so request.

(5) Any Office which has not notified, with respect to a given international registration, any provisional or final refusal to the International Bureau in accordance with paragraphs (1) and (2) shall, with respect to that international registration, lose the benefit of the right provided for in paragraph (1).

(6) Invalidation, by the competent authorities of a Contracting Party, of the effects, in the territory of that Contracting Party, of an international registration may not be pronounced without the holder of such international registration having, in good time, been afforded the opportunity of defending his rights. Invalidation shall be notified to the International Bureau.

Notes Concerning Article 5bis

5bis.01 Article 5bis of the basic proposal incorporated in the Protocol, by reference and *mutatis mutandis*, Article 5bis of the Stockholm Act. In the final text

adopted by the Diplomatic Conference, Article 5bis has been redrafted for the purposes of the Protocol and introduced in the text of the Protocol.

Notes Concerning Article 5ter

5ter.01 Article 5ter of the basic proposal incorporated, by reference and *mutatis mutandis*, Article 5bis of the Stockholm Act. In the final text adopted by the Diplomatic Conference, Article 5ter has been redrafted for the purposes of the Protocol and introduced in the text of the Protocol.

present time by the International Bureau because the International Bureau found that its search service was redundant with the search services of numerous official and private services in the various countries and that its own service, from a financial viewpoint, was not self-supporting.

5ter.02 It should be noted that the authorization provided for in paragraph (2) is not made use of at the

Notes Concerning Article 6

6.01 This Article is subdivided into four paragraphs; the content of each paragraph may be summarized as follows: paragraph (1) fixes the term of validity of international registrations; paragraph (2) provides for the independence—subject to “central attack”—of the international registration from the basic application or the basic registration (as the case may be); paragraphs (3) and (4) deal with what is generally referred to as “central attack.”

6.02 *Ad paragraph (1)*: The initial validity of an international registration is ten years. The ten years start with the date of the international registration. (The date

of the international registration is defined in Article 3(4) of the Stockholm Act and of the Protocol and, as far as the Stockholm Act is concerned, is further elaborated in Rule 15 of the Regulations under the Stockholm Act.) The validity of the international registration, beyond the initial ten years, requires that the international registration be renewed. Renewal is regulated in Article 7 (see below).

6.03 *Ad paragraph (2)*: To understand this paragraph, one has to note that the subsequent paragraph (paragraph (3)) provides, in essence, that if the basic application or basic registration fails before the expiration of

*Basic Proposal***Article 5bis****Documentary Evidence of Legitimacy of Use
of Certain Elements of Mark**

Article 5bis of the Madrid (Stockholm) Agreement shall apply *mutatis mutandis*.

Article 5ter**Copies of Entries in International Register;
Searches for Anticipation;
Extracts from International Register**

Article 5ter of the Madrid (Stockholm) Agreement shall apply *mutatis mutandis*.

Article 6**Period of Validity of International
Registration; Dependence and Independence
of International Registration**

(1) Registration of a mark at the International Bureau is effected for ten years, with the possibility of renewal under the conditions specified in Article 7 of this Protocol.

(2) Upon expiration of a period of five years from the date of the international registration, such registration shall become independent of the basic application or the registration resulting therefrom, or of the basic registration, as the case may be, subject to the following provisions.

*Text Adopted***Article 5bis****Documentary Evidence of Legitimacy of Use
of Certain Elements of the Mark**

Documentary evidence of the legitimacy of the use of certain elements incorporated in a mark, such as armorial bearings, escutcheons, portraits, honorary distinctions, titles, trade names, names of persons other than the name of the applicant, or other like inscriptions, which might be required by the Offices of the Contracting Parties shall be exempt from any legalization as well as from any certification other than that of the Office of origin.

Article 5ter**Copies of Entries in International Register;
Searches for Anticipations;
Extracts from International Register**

(1) The International Bureau shall issue to any person applying therefor, upon the payment of a fee fixed by the Regulations, a copy of the entries in the International Register concerning a specific mark.

(2) The International Bureau may also, upon payment, undertake searches for anticipations among marks that are the subject of international registrations.

(3) Extracts from the International Register requested with a view to their production in one of the Contracting Parties shall be exempt from any legalization.

Article 6**Period of Validity of International
Registration; Dependence and Independence
of International Registration**

(1) Registration of a mark at the International Bureau is effected for ten years, with the possibility of renewal under the conditions specified in Article 7.

(2) Upon expiry of a period of five years from the date of the international registration, such registration shall become independent of the basic application or the registration resulting therefrom, or of the basic registration, as the case may be, subject to the following provisions.

(Notes Concerning Article 6, continued)

five years from the date of the international registration, the international registration loses its effect, and it loses it in *all* the designated States or Organizations. In other words, before the expiration of that five-year period, the fate of the international registration depends on the fate of the basic application or basic registration. After the expiration of that period, even if the basic application or the basic registration fails, the international registration remains valid, i.e., it becomes "independent" from the fate of the basic application or the basic registration. This is the independence which paragraph (2) establishes.

6.04 *Ad paragraph (3)*: As already stated, this paragraph establishes the said dependence until the expiration of the first five years: the effects of the international registration are lost ("the protection ... may no longer be invoked") if the basic application or the basic registration fails before the expiration of five years from the date of the international registration. This is provided for in the first sentence of the paragraph. Such failure may be caused, as far as a national or regional application is concerned, typically by that application's withdrawal or rejection and, as far as a national or regional registration is concerned (whether that registration is the basic registration or results from the basic application), typically by that registration's lapse, renunciation, revocation, cancellation or invalidation.

6.05 The loss of the effect of the international registration is only partial if the basic application's or the basic registration's failure is partial, e.g., concerns only some of the goods and services. This is the case not only if the limitation of the goods and services in the basic application or registration occurs after the international registration but also if it occurs before the international registration.

6.06 The second sentence of paragraph (3) of the basic proposal provided for the same results in cases where proceedings that were in course before the expiration of the five-year period result after the expiration of the said period in a final decision of rejection, revocation, cancellation or invalidation of the basic application or the registration resulting therefrom, or the basic registration, as the case may be. In the final text adopted by the Diplomatic Conference, the second sentence of paragraph (3) has been replaced by a detailed text taking into account all the relevant cases where this provision applies.

6.07 *Ad paragraph (4)*: This paragraph has been redrafted by the Diplomatic Conference following the modification of paragraph (3). The Office of origin must notify the International Bureau of the facts and decisions relevant under paragraph (3) and, where applicable, request the International Bureau to cancel, to the extent applicable, the international registration. As regards the International Bureau, it must notify the interested parties and effectuate any publication as provided for in the Regulations, and cancel the international registration where it is requested to do so by the Office of origin.

*Basic Proposal**(Article 6, continued)*

(3) The protection resulting from the international registration, whether or not it has been the subject of a transfer, may no longer be invoked if, before the expiry of five years from the date of the international registration, the basic application or the registration resulting therefrom, or the basic registration, as the case may be, has been withdrawn, has lapsed, has been renounced or has been the subject of a final decision of rejection, revocation, cancellation or invalidation, in respect of all or some of the goods and services indicated under Article 3(2) of this Protocol. The same applies if proceedings that were in course before the expiration of the five-year period result after the expiration of the said period in a final decision of rejection, revocation, cancellation or invalidation of the basic application or the registration resulting therefrom, or the basic registration, as the case may be.

(4) Where paragraph (3), first sentence, applies, the Office of origin shall request the International Bureau to cancel the international registration. Where paragraph (3), second sentence, applies, the Office of origin shall, within the five-year period, notify the International Bureau that the proceedings referred to in that provision are in course and, once the decision has become final, inform the International Bureau accordingly and, where applicable, request it to cancel the international registration. Where requested by the Office of origin to do so under the first or the second sentence of this paragraph, the International Bureau shall cancel the international registration.

*Text Adopted**(Article 6, continued)*

(3) The protection resulting from the international registration, whether or not it has been the subject of a transfer, may no longer be invoked if, before the expiry of five years from the date of the international registration, the basic application or the registration resulting therefrom, or the basic registration, as the case may be, has been withdrawn, has lapsed, has been renounced or has been the subject of a final decision of rejection, revocation, cancellation or invalidation, in respect of all or some of the goods and services listed in the international registration. The same applies if

- (i) an appeal against a decision refusing the effects of the basic application,
- (ii) an action requesting the withdrawal of the basic application or the revocation, cancellation or invalidation of the registration resulting from the basic application or of the basic registration, or
- (iii) an opposition to the basic application

results, after the expiry of the five-year period, in a final decision of rejection, revocation, cancellation or invalidation, or ordering the withdrawal, of the basic application, or the registration resulting therefrom, or the basic registration, as the case may be, provided that such appeal, action or opposition had begun before the expiry of the said period. The same also applies if the basic application is withdrawn, or the registration resulting from the basic application or the basic registration is renounced, after the expiry of the five-year period, provided that, at the time of the withdrawal or renunciation, the said application or registration was the subject of a proceeding referred to in item (i), (ii) or (iii) and that such proceeding had begun before the expiry of the said period.

(4) The Office of origin shall, as prescribed in the Regulations, notify the International Bureau of the facts and decisions relevant under paragraph (3), and the International Bureau shall, as prescribed in the Regulations, notify the interested parties and effect any publication accordingly. The Office of origin shall, where applicable, request the International Bureau to cancel, to the extent applicable, the international registration, and the International Bureau shall proceed accordingly.

Notes Concerning Article 7

7.01 *Ad paragraph (1)*: The Stockholm Act provides for a term of 20 years both for the initial registration (Article 6(1)) and for each renewal (Article 7(1)). (However, the Regulations under that Act allow the payment of the basic fee in two installments, each of them covering ten years. About 25% of the applicants make use of such a possibility.) Paragraph (1) of Article 7 of the Protocol provides for a term of ten years both for the initial registration and any renewal. That term is not only the term provided for by the legislations of most (i.e., 21) of the 27 States party to the Madrid (Stockholm) Agreement at the time of the Diplomatic Conference but it is the term chosen by most of the countries adopting new legislation on marks, whether members or not of the Madrid Union.

7.02 Paragraph (1) of the final text has been the subject of modifications in drafting.

7.03 *Ad paragraphs (2), (3) and (4)*: Paragraph (2) of the basic proposal incorporated in the Protocol, by reference, paragraphs (2), (4) and (5) of Article 7 of the Stockholm Act. (Paragraph (3) of Article 7 of the Stockholm Act was a transitional provision which has been inapplicable since 1987; this is why it is not incorporated in the Protocol.) In the final text adopted by the Diplomatic Conference, the said paragraphs have been redrafted for the purposes of the Protocol and introduced in the text of the Protocol under numbers (2), (3) and (4).

7.04 *Ad paragraph (2)*: Article 7(2) of the Stockholm Act provides that "Renewal may not include any change

in relation to the previous registration in its latest form." The expression "previous registration" was justified as long as the Madrid Agreement regarded each renewal as a new registration. Since the revision of Nice (1957), a renewal does not create a new registration but merely prolongs the validity of ("renews") the international registration with the content which that registration has at the moment of the renewal. The Diplomatic Conference decided to redraft paragraph (2) for the purposes of the Protocol to reflect that modification of the concept of renewal.

7.05 *Ad paragraph (3)*: This paragraph, which corresponds to Article 7(4) of the Stockholm Act, seems to be self-explanatory.

7.06 *Ad paragraph (4)*: This paragraph, which corresponds to Article 7(5) of the Stockholm Act, provides that "Subject to the payment of a surcharge fixed by the Regulations, a period of grace of six months shall be allowed for renewal of the international registration." In other words, if the fees payable for renewal are paid after the expiration of the validity of the registration, but not later than six months after that expiration, the validity of the international registration will not be lost, that is, will be maintained. One of the consequences of this provision is that one cannot assume that the validity of the international registration was lost because of failure of the payment of the renewal fee by the date on which that fee was due; one must wait six months to know whether the said validity was really lost.

Notes Concerning Article 8

8.01 *Ad paragraphs (1) to (6)*: In the basic proposal, paragraph (1) incorporated in the Protocol, by reference and *mutatis mutandis*, Article 8 of the Stockholm Act. In the final text adopted by the Diplomatic Conference, the said Article has been redrafted for the purposes of the Protocol and introduced in the text of the Protocol as paragraphs (1) to (6) of Article 8.

8.02 *Ad paragraph (1)*: This paragraph seems to be self-explanatory. It corresponds to Article 8(1) of the Stockholm Act, but is somewhat more explicit.

8.03 *Ad paragraph (2)*: This paragraph, which corresponds to Article 8(2) of the Stockholm Act, provides that "Registration of a mark at the International Bureau

shall be subject to the advance payment of an international fee which shall, subject to the provisions of paragraph (7)(a), include ... a basic fee ... a supplementary fee [per class beyond three classes] ... [and] a complementary [i.e., designation] fee [per designated country]." It follows from Article 7(1) that those fees are payable both for the (initial) international registration and also for each of its renewals.

8.04 In certain cases, the complementary fee and, under certain conditions—see paragraph 8.12, below—the supplementary fee are replaceable by what is called the designated Office's "individual" fees. The "individual" fees system is provided for in paragraph (7); it is analyzed in paragraph 8.08, below. In cases where those

*Basic Proposal**Text Adopted***Article 7****Renewal of International Registration**

(1) Any registration may be renewed for a period of ten years from the expiration of the preceding period, by payment only of the basic fee and, subject to Article 8(2) of this Protocol, of the supplementary and complementary fees provided for in Article 8 of the Madrid (Stockholm) Agreement.

(2) Paragraphs (2), (4) and (5) of Article 7 of the Madrid (Stockholm) Agreement shall apply.

Article 7**Renewal of International Registration**

(1) Any international registration may be renewed for a period of ten years from the expiry of the preceding period, by the mere payment of the basic fee and, subject to Article 8(7), of the supplementary and complementary fees provided for in Article 8(2).

(2) Renewal may not bring about any change in the international registration in its latest form.

(3) Six months before the expiry of the term of protection, the International Bureau shall, by sending an unofficial notice, remind the holder of the international registration and his representative, if any, of the exact date of expiry.

(4) Subject to the payment of a surcharge fixed by the Regulations, a period of grace of six months shall be allowed for renewal of the international registration.

Article 8**Fees for International
Application and Registration**

(1) Subject to paragraph (2), Article 8 of the Madrid (Stockholm) Agreement shall apply *mutatis mutandis*.

Article 8**Fees for International
Application and Registration**

(1) The Office of origin may fix, at its own discretion, and collect, for its own benefit, a fee which it may require from the applicant for international registration or from the holder of the international registration in connection with the filing of the international application or the renewal of the international registration.

(2) Registration of a mark at the International Bureau shall be subject to the advance payment of an international fee which shall, subject to the provisions of paragraph (7)(a), include,

(i) a basic fee;

(Notes Concerning Article 8, continued)

two fees are not replaceable and, in fact, are not replaced by the "individual" fee, paragraphs (2), (3), (4), (5) and (6) apply. Even under the "individual" fee system, the provisions of paragraph (2) remain applicable as far as the basic fee is concerned.

8.05 *Ad paragraph (3)*: This paragraph, which corresponds to Article 8(3) of the Stockholm Act, deals with the supplementary fee. It seems to be self-explanatory.

8.06 *Ad paragraph (4)*: This paragraph, which corresponds to Article 8(4) of the Stockholm Act, deals with the division—among the members of the Madrid Union—of the excess receipts of the International Bureau. "Excess receipts" are the receipts (particularly the basic fees) of the International Bureau connected with the international registration system (except the supplementary and complementary fees, since they do not belong to the International Bureau) *minus* the costs of the International Bureau. The excess is divided equally among the Contracting Parties.

8.07 *Ad paragraphs (5) and (6)*: These paragraphs deal with the division, among the Contracting Parties concerned which have not chosen the individual fee system, of the supplementary and complementary fees. They seem to be self-explanatory.

8.08 *Ad paragraph (7)(a)*: This provision introduces the "individual fee system." It permits any Contracting Party to choose between (i) having the right to determine the amount of the fee applicable to it (provided that the said amount is not higher than the equivalent of the amount of the national or regional fee diminished by the savings resulting from the international procedure) and (ii) having the right to a share in the revenues produced by the supplementary and complementary fees. However, the individual fee system cannot be applied in respect of a Contracting Party having chosen it if that Party is also party to the Stockholm Act, in respect of international registrations that originate in another Contracting Party that, too, is also party to the Stockholm Act. This restriction flows from Article 9*sexies* of the Protocol.

8.09 It is the right of the Contracting Party that chooses the individual fee system to fix the amount of the individual fee. The basic proposal provided that there should be a ceiling that the amount could not exceed and

proposed the choice between two ceilings. After discussions on the two ceilings between which the Diplomatic Conference had to choose, it was decided that the amount of the individual fee should not be higher than the equivalent of the amount which the Contracting Party's Office would be entitled to receive from an applicant for a ten-year registration, or from the holder of a registration for a ten-year renewal of that registration in the register of the said Office, *the said amount being diminished by the savings resulting from the international procedure.*

8.10 IT IS TO BE NOTED THAT THE INTRODUCTION OF THE "INDIVIDUAL FEE SYSTEM" IS THE THIRD OF THE FOUR MAJOR INNOVATIONS OF THE PROTOCOL. (For the other three, see paragraphs 2.04 and 5.08, above, and paragraph 9*quinquies*.02, below.)

8.11 The amount of the individual fee for each registration or renewal would, for the Offices of some Contracting Parties, be higher than the (per registration, or per renewal) amount of the share of those Contracting Parties in the supplementary and complementary fees. This is particularly true for Offices which have or will have much higher fees than the world average. Some of the Offices in that position argue that it is impossible for them to accept amounts that are less, or much less, than their own fees, both for budgetary reasons and on account of a policy according to which foreigners should not get registrations and renewals for less money than nationals. On the other hand, the traditional system is defended by arguing that Offices have less costs with international registrations (since they do not have to register them in their own registries, since they do not have to publish them in their gazettes and since they can examine them with less effort) and that it is in the interest of domestic industry to pay less for international registrations and serving that interest fully deserves a sacrifice by those Offices which, after all, should have the good of their own public uppermost in their mind. Naturally, where the traditional system will yield more income for the Office than the individual fee system, it may be expected that the Office will *not* choose the individual fee system.

8.12 Items (i) and (ii) of subparagraph (7)(a) indicate the cases where no supplementary fees and/or complementary fees have to be paid.

8.13 *Ad paragraph (7)(b)*: This provision seems to be self-explanatory.

Basic Proposal

(Article 8, continued)

Text Adopted

(Article 8(2), continued)

- (ii) a supplementary fee for each class of the International Classification, beyond three, into which the goods or services to which the mark is applied will fall;
- (iii) a complementary fee for any request for extension of protection under Article 3ter.

(3) However, the supplementary fee specified in paragraph (2)(ii) may, without prejudice to the date of the international registration, be paid within the period fixed by the Regulations if the number of classes of goods or services has been fixed or disputed by the International Bureau. If, upon expiry of the said period, the supplementary fee has not been paid or the list of goods or services has not been reduced to the required extent by the applicant, the international application shall be deemed to have been abandoned.

(4) The annual product of the various receipts from international registration, with the exception of the receipts derived from the fees mentioned in paragraph (2)(ii) and (iii), shall be divided equally among the Contracting Parties by the International Bureau, after deduction of the expenses and charges necessitated by the implementation of this Protocol.

(5) The amounts derived from the supplementary fees provided for in paragraph (2)(ii) shall be divided, at the expiry of each year, among the interested Contracting Parties in proportion to the number of marks for which protection has been applied for in each of them during that year, this number being multiplied, in the case of Contracting Parties which make an examination, by a coefficient which shall be determined by the Regulations.

(6) The amounts derived from the complementary fees provided for in paragraph (2)(iii) shall be divided according to the same rules as those provided for in paragraph (5).

(2)(a) Any Contracting Party may declare that, in connection with each international registration under this Protocol in which it is mentioned under Article 3ter of this Protocol, and in connection with the renewal of any such international registration having effect in its territory, it wants to receive, instead of the share in the revenue produced by the supplementary and complementary fees—a share which it would otherwise be entitled to under Article 8(5) and (6) of the Madrid (Stockholm) Agreement—a fee (hereinafter referred to as “individual fee”) whose amount shall be indicated in the declaration, and can be changed in further declarations, but may not be higher than [80% of] the equivalent of the amount which the said Contracting Party’s Office would be entitled to receive from an applicant for a ten-year registration, or from the holder of a registration for a ten-year renewal of that registration, of the

(7)(a) Any Contracting Party may declare that, in connection with each international registration in which it is mentioned under Article 3ter, and in connection with the renewal of any such international registration, it wants to receive, instead of a share in the revenue produced by the supplementary and complementary fees, a fee (hereinafter referred to as “the individual fee”) whose amount shall be indicated in the declaration, and can be changed in further declarations, but may not be higher than the equivalent of the amount which the said Contracting Party’s Office would be entitled to receive from an applicant for a ten-year registration, or from the holder of a registration for a ten-year renewal of that registration, of the mark in the register of the said Office, the said amount being diminished by the savings resulting from the international procedure. Where such an individual fee is payable,

Notes Concerning Articles 9, 9bis and 9ter

The subject matter treated in these three Articles (9, 9bis and 9ter) of the Protocol is the same as that treated in the Articles bearing the same numbers in the Stockholm Act and in Article 8bis of the said Act.

However, the order and the coverage of some of the Articles have been somewhat changed in order to render the Articles simpler.

Notes Concerning Article 9

9.01 This Article concerns the subject matter regulated in Articles 9bis and 9ter of the Stockholm Act. It permits the recordal, in the International Register, of a change in the ownership of the international registration, provided that the new holder is a person who has the right to file applications for international registrations, that is, is a national of, is domiciled in, or has a real and effective industrial or commercial establishment in, a State that is a Contracting Party, or is a national of a member State of an Organization that is itself a Contracting Party, or is domiciled, or has a real and effective industrial or commercial establishment, in the territory of that Organization (see Article 2(1)).

9.02 The Article under consideration provides that the recordal of the change of ownership may be requested

either by the person whose name is recorded in the International Register as the name of the holder, in other words the assignor, or by an "interested Office." In any case, the assignee cannot himself present a request for recordal of the assignment to the International Bureau. He has either to convince or oblige by contract the assignor to do it or, if this is not possible, to ask an "interested Office" to do it. It is the reason why the Diplomatic Conference introduced, after the words "interested Office," the words "made *ex officio* or at the request of an interested person," which did not appear in the basic proposal. The Regulations will specify the circumstances under which the "interested Office" is the Office of origin or is one of the Offices of the designated Contracting Parties and, in the latter case, which of those Offices it is. Furthermore, the Regulations will

*Basic Proposal**(Article 8(2), continued)*

mark in the register of the said Office. Where such an individual fee is payable, no complementary fee referred to in Article 8(2)(c) of the Madrid (Stockholm) Agreement shall be payable in respect of the said Contracting Party, and no supplementary fee referred to in Article 8(2)(b) of the Madrid (Stockholm) Agreement shall be payable if only Contracting Parties which have made a declaration under this subparagraph are mentioned under Article 3ter of this Protocol.

(b) Any declaration under subparagraph (a) may be made in the instruments referred to in Article 14(2) of this Protocol, and the effective date of the declaration shall be the same as the date of entry into force of the Protocol with respect to the State or intergovernmental organization having made the declaration. Any such declaration may be made also later, in which case the declaration shall have effect three months after its receipt by the Director General, or at any later date indicated in the declaration, in respect of international registrations effected on or after the date of effect of the declaration.

Article 9**Recordal of Change in the Ownership
of an International Registration**

At the request of the person in whose name the international registration stands or of an interested Office, the International Bureau shall record in the International Register any change in the ownership of that registration, in respect of all or some of the Contracting Parties in whose territories the said registration has effect and in respect of all or some of the goods and services listed in the registration, provided that the new holder is a person who, under Article 2(1) of this Protocol, is entitled to file international applications.

*Text Adopted**(Article 8(7), continued)*

- (i) no supplementary fees referred to in paragraph (2)(ii) shall be payable if only Contracting Parties which have made a declaration under this subparagraph are mentioned under Article 3ter, and
- (ii) no complementary fee referred to in paragraph (2)(iii) shall be payable in respect of any Contracting Party which has made a declaration under this subparagraph.

(b) Any declaration under subparagraph (a) may be made in the instruments referred to in Article 14(2), and the effective date of the declaration shall be the same as the date of entry into force of this Protocol with respect to the State or intergovernmental organization having made the declaration. Any such declaration may also be made later, in which case the declaration shall have effect three months after its receipt by the Director General, or at any later date indicated in the declaration, in respect of any international registration whose date is the same as or is later than the effective date of the declaration.

Article 9**Recordal of Change in the Ownership
of an International Registration**

At the request of the person in whose name the international registration stands, or at the request of an interested Office made *ex officio* or at the request of an interested person, the International Bureau shall record in the International Register any change in the ownership of that registration, in respect of all or some of the Contracting Parties in whose territories the said registration has effect and in respect of all or some of the goods and services listed in the registration, provided that the new holder is a person who, under Article 2(1), is entitled to file international applications.

(Notes Concerning Article 9, continued)

make it clear that, if the assignment concerns only part of the goods and services, the international registration will be split into two independent international registrations (both retaining, naturally, the date of the original international registration).

9.03 It is to be noted that since the Protocol provides that the recordal of the change of ownership may be asked for by the holder of the international registration or by an "interested Office" (to be specified in the Regulations), the Protocol does not say (as the Stockholm Act does in its Article 9*bis*(1) and (3)) that it can be asked for

only by a certain Office and, in certain cases (including the case covered by Article 9*ter*(3) of the Stockholm Act), only with the consent of another Office. Furthermore, the Protocol does not say that "No transfer of a mark registered in the International Register for the benefit of a person who is not entitled to file an international mark shall be recorded" (Stockholm Act, Article 9*bis*(2)) since this idea is clearly implied in the proviso of Article 9. Finally, the Protocol does not take over what are, in Article 9*ter* of the Stockholm Act, paragraph (1), second sentence, and paragraph (4). Those provisions simply recall rights and obligations that exist independently of the Madrid Agreement or its Protocol.

Notes Concerning Article 9*bis*

9*bis*.01 This Article covers subject matter regulated in Articles 8*bis* and 9(3) of the Stockholm Act and gives a treaty basis to some of the provisions contained in Rule 20 of the Regulations under the Stockholm Act.

9*bis*.02 Items (i) to (iv) seem to be self-explanatory. Other relevant facts, mentioned in item (v), could include, for example, licenses. The Regulations will specify, in particular, who is entitled to request the recordals referred to in Article 9*bis* of the Protocol.

Notes Concerning Article 9*ter*

9*ter*.01 This Article covers subject matter regulated in Articles 8*bis* and 9(4) of the Stockholm Act. The Regulations that will be established under the Protocol will have to specify which recordals are subject to the payment of a fee and which are not. Since the Stockholm Act makes the recordal of renunciations exempt from

the payment of fees, the Regulations under the Protocol will certainly allow a similar exemption from fees. For the other recordals, the Regulations under the Stockholm Act will certainly serve as a model for the Regulations that will be established under the Protocol.

*Basic Proposal**Text Adopted***Article 9bis****Recordal of Certain Matters Concerning
an International Registration**

The International Bureau shall record in the International Register

- (i) any change in the name or address of the holder of the international registration,
- (ii) the appointment of a representative of the holder of the international registration and any other relevant fact concerning such representative,
- (iii) any limitation, in respect of all or some of the Contracting Parties, of the goods and services listed in the international registration,
- (iv) any renunciation, cancellation or invalidation of the international registration in respect of all or some of the Contracting Parties,
- (v) any other relevant fact, identified in the Regulations, concerning the rights in a mark that is the subject matter of an international registration.

Article 9ter**Fees for Certain Recordals**

Any recordal under Article 9 or under Article 9bis of this Protocol may be subject to the payment of a fee.

Article 9bis**Recordal of Certain Matters Concerning
an International Registration**

The International Bureau shall record in the International Register

- (i) any change in the name or address of the holder of the international registration,
- (ii) the appointment of a representative of the holder of the international registration and any other relevant fact concerning such representative,
- (iii) any limitation, in respect of all or some of the Contracting Parties, of the goods and services listed in the international registration,
- (iv) any renunciation, cancellation or invalidation of the international registration in respect of all or some of the Contracting Parties,
- (v) any other relevant fact, identified in the Regulations, concerning the rights in a mark that is the subject of an international registration.

Article 9ter**Fees for Certain Recordals**

Any recordal under Article 9 or under Article 9bis may be subject to the payment of a fee.

Notes Concerning Article 9*quater*

9quater.01 Article 9*quater* of the basic proposal incorporated in the Protocol, by reference and *mutatis mutandis*, Article 9*quater* of the Stockholm Act which provides for the possibility for a group of Contracting States of substituting a common Office for their national Offices, to regard the whole of their territories as one country and to declare that all or part of the other substantive provisions of the Stockholm Act will apply accordingly. Belgium, Luxembourg and the Netherlands have made use of this possibility, and the office that replaced their national Offices is the Benelux Trademark Office.

9quater.02 Following a decision of the Diplomatic Conference, Article 9*quater* of the Stockholm Act has

not been incorporated in the Protocol, by reference and *mutatis mutandis*, but has been redrafted for the purposes of the Protocol and introduced into the text of the Protocol.

9quater.03 It is to be noted that if the trademark system of the European Communities is established, it will not be—if it is going to be as presently planned—a system to which Article 9*quater* (whether as in the Stockholm Act or as in the Protocol) will apply, since in that system neither the domestic legislations on marks will be unified nor will the Community Trade Mark Office replace the national Offices; in that system, the domestic and the regional legislations, and the regional Office and the national Offices, will co-exist.

Notes Concerning Article 9*quinquies*

9quinquies.01 This Article institutes what is generally called the possibility of “transformation,” that is, the transformation of an international registration that has been cancelled as a result, in particular, of a successful “central attack” into national or regional applications. A possibility of transformation is not provided in the Stockholm Act.

9quinquies.02 THE POSSIBILITY OF TRANSFORMATION IS INSTITUTED BY THE PROTOCOL, AND IT IS ONE OF THE FOUR MAJOR INNOVATIONS THAT THE PROTOCOL HAS INTRODUCED IN THE MADRID SYSTEM. (For the other three, see paragraphs 2.04, 5.08 and 8.09, above.)

9quinquies.03 The possibility of transformation exists not only when the international registration has been cancelled as a result of a successful “central attack,” but also in any other case where the basic application, the registration resulting therefrom or the basic registration has failed under Article 6(3) of the Protocol and the corresponding international registration has been cancelled under Article 6(4). The Diplomatic Conference made it clear that the possibility of transformation also exists where the cancellation of the international registration is a partial one by introducing into the final text, after the words “is cancelled at the request of the Office of origin under Article 6(4),” the words “in respect of all or some of the goods and services listed in the said registration.”

9quinquies.04 The reason for instituting this possibility of transformation is that the failure of the basic application, the registration resulting therefrom or the basic registration may be peculiar to the law of, or the circumstances prevailing in, the State or Organization of the said application or registration and may be irrelevant under the law of, or the circumstances prevailing in, the designated Contracting Parties. If and where they are irrelevant, it is unreasonable and unjust to extend the failure to the international registration. The present system of “central attack” nevertheless so extends the failure; Article 9*quinquies* mitigates the unreasonable and unjust result by allowing “transformation.”

9quinquies.05 The basic proposal offered the choice to limit the possibility of transformation to the sole case of a failure of the basic application, the registration resulting therefrom or the basic registration under Article 6(3)—mainly as a result of a successful “central attack”—or to open it to any case where the international registration is cancelled. To open the broad possibility of transformation, the words appearing in square brackets in the basic proposal (“or in case the international registration is cancelled for any other reason”) would have had to be retained and the square brackets deleted; otherwise, the said words would have had to be omitted. A typical case which would have been covered by the words appearing within square brackets would be the cancellation of the international registration due to the loss of the right to file international applications

*Basic Proposal**Text Adopted*

Article 9^{quater}
Common Office of Several Contracting States

Article 9^{quater} of the Madrid (Stockholm) Agreement shall apply *mutatis mutandis*.

Article 9^{quater}
Common Office of Several Contracting States

(1) If several Contracting States agree to effect the unification of their domestic legislations on marks, they may notify the Director General

- (i) that a common Office shall be substituted for the national Office of each of them, and
- (ii) that the whole of their respective territories shall be deemed to be a single State for the purposes of the application of all or part of the provisions preceding this Article as well as the provisions of Articles 9^{quinquies} and 9^{sexies}.

(2) Such notification shall not take effect until three months after the date of the communication thereof by the Director General to the other Contracting Parties.

Article 9^{quinquies}
Transformation of an International Registration into National or Regional Applications

Where, in case the international registration is cancelled at the request of the Office of origin under Article 6(4) of this Protocol [or in case the international registration is cancelled for any other reason], the person who was the holder of the international registration files an application for the registration of the same mark with the Office of any of the Contracting Parties in the territory of which the international registration had effect, that application shall be treated as if it had been filed on the date of the international registration according to Article 3(4) of this Protocol and, if the international registration enjoyed priority, shall enjoy the same priority, provided that

- (i) such application is filed within three months from the date on which the international registration was cancelled,
- (ii) the goods and services listed in the application are in fact covered by the list of goods and services contained in the international registration in respect of the Contracting Party concerned, and
- (iii) such application complies with all the requirements of the applicable law, including the requirements concerning fees.

Article 9^{quinquies}
Transformation of an International Registration into National or Regional Applications

Where, in the event that the international registration is cancelled at the request of the Office of origin under Article 6(4), in respect of all or some of the goods and services listed in the said registration, the person who was the holder of the international registration files an application for the registration of the same mark with the Office of any of the Contracting Parties in the territory of which the international registration had effect, that application shall be treated as if it had been filed on the date of the international registration according to Article 3(4) or on the date of recordal of the territorial extension according to Article 3^{ter}(2) and, if the international registration enjoyed priority, shall enjoy the same priority, provided that

- (i) such application is filed within three months from the date on which the international registration was cancelled,
- (ii) the goods and services listed in the application are in fact covered by the list of goods and services contained in the international registration in respect of the Contracting Party concerned, and
- (iii) such application complies with all the requirements of the applicable law, including the requirements concerning fees.

(Notes Concerning Article 9quinquies, continued)

(defined in Article 2(1) of the Protocol) by the holder of the international registration; such loss may occur, for example, when the holder loses the nationality, the domicile or the establishment that qualified him to own international registrations; or it may occur if the State or Organization to the territory of which his eligibility for owning international registrations was attached ceases to be a party to the Protocol. Another typical case which would have been covered by the words appearing within square brackets would be the cancellation of the international registration due to the transfer of the rights of the holder—transfer, for example, through assignment or succession *mortis causa*—to another person who happens to be a person who is not entitled to own international registrations. Finally, the Diplomatic

Conference decided not to opt for the broad possibility of transformation and, consequently, omitted the words in square brackets.

9quinquies.06 To make use of the possibility of transformation, the (*ex*) holder of the international registration must file a national or a regional application for the national or regional registration of the same mark (i.e., the same as the one that is the subject matter of the lost international registration) with the designated Office.

9quinquies.07 The effect of such national or regional application is the same as the effect of any national or regional application except that such effect is *retroactive* to the date of the international registration and that, where the international registration enjoyed priority, the said national or regional application enjoys the same priority.

Notes Concerning Article 9sexies

9sexies.01 This Article is entitled "Safeguard of the Madrid (Stockholm) Agreement" because it preserves the *status quo* in certain situations. It does that by providing that where the Office of origin of an international application or registration is the Office of a State that is party to both the Protocol and the Madrid (Stockholm) Agreement, the provisions of the Protocol have no effect (i.e., the Protocol is inapplicable and, consequently, only the Stockholm Act—that represents the *status quo*—applies) as regards a State that is also party to both the Protocol and the Madrid (Stockholm) Agreement. In other words, in such a case, no request for territorial extension can be made under Article 3ter(1) or (2) of the Protocol with respect to such State. It is to be noted that, naturally, the Protocol does apply in the relations between a State that is party to both the Protocol and the Stockholm Act and any State or Organization that is party to the Protocol but is not party to the Stockholm Act (Organizations cannot even become a party to the Stockholm Act).

9sexies.02 The Regulations will provide for the possibility of using one form only where international registration is applied for both under the Protocol and the Madrid (Stockholm) Agreement on the basis of the same basic registration.

9sexies.03 Among the consequences of such a maintaining of the *status quo* between parties to both the Stockholm Act and the Protocol are the following: (i) an international application *cannot* be based on a national application (but only on a national registration) (see

Article 2(1) of the Protocol), (ii) the time limit of the refusal *cannot* be longer than one year (see Article 5(2)(b) and (c) of the Protocol), (iii) the designated Office *cannot* receive an "individual fee" (but only a share in the revenue produced by supplementary and complementary fee) (see Article 8(7) of the Protocol) and (iv) one *cannot* "transform" an international registration into national applications (see Article 9quinquies of the Protocol).

9sexies.04 The reason for the safeguard clause resides in the often repeated statements of the governments of the present member States of the Madrid Union, and the representatives of private associations using the present Madrid system, that the present system fully satisfies them *as it is* and that they wish that it continue, among themselves, without any change whatsoever. In particular, (i) the trademark owners say that the fact that they have to wait for a national registration is not detrimental to them, (ii) the trademark owners say that they see no need for the possibility of "transforming" an international registration into national applications, (iii) the trademark offices say that the one-year time limit for communication of (provisional) refusals is sufficient for them, and the trademark owners naturally prefer that period to a longer period (since applicants will sooner receive an indication of the chances of survival of their registrations) and, finally, (iv) the trademark owners look with disfavor on individual fees whose amount would be fixed by a Contracting Party having made the declaration provided for in Article 8(7)(a)—because, in most cases, they will probably be

*Basic Proposal**Text Adopted***Article 9sexies****Safeguard of the Madrid (Stockholm) Agreement**

Where, with regard to a given international application or a given international registration, the Office of origin is the Office of a State that is party to both this Protocol and the Madrid (Stockholm) Agreement, the provisions of this Protocol shall have no effect in the territory of any other State that is also party to both this Protocol and the Madrid (Stockholm) Agreement and, consequently, no request for territorial extension can be made, under Article 3ter(1) or (2) of this Protocol, with respect to any such State.

Article 9sexies**Safeguard of the Madrid (Stockholm) Agreement**

(1) Where, with regard to a given international application or a given international registration, the Office of origin is the Office of a State that is party to both this Protocol and the Madrid (Stockholm) Agreement, the provisions of this Protocol shall have no effect in the territory of any other State that is also party to both this Protocol and the Madrid (Stockholm) Agreement.

(2) The Assembly may, by a three-fourths majority, repeal paragraph (1), or restrict the scope of paragraph (1), after the expiry of a period of ten years from the entry into force of this Protocol, but not before the expiry of a period of five years from the date on which the majority of the countries party to the Madrid (Stockholm) Agreement have become party to this Protocol. In the vote of the Assembly, only those States which are party to both the said Agreement and this Protocol shall have the right to participate.

(Notes Concerning Article 9sexies, continued)

higher than the internationally fixed fees and because the calculation of the fees due in any given case is simpler if the fee is uniform (as it is under the Stockholm Act)—while the national Offices say that they are ready to continue to receive the smaller amounts not only because international registration reduces their work load but also because it is in the interest of the country that its trademark owners obtain protection abroad at a lower fee even if, as a price of such advantage, the income of the national Office is somewhat lower than it would be if it could charge its national fee.

9sexies.05 *Ad paragraph (1)*: The words “and consequently, no request for territorial extension can be

made, under Article 3ter(1) or (2) of this Protocol, with respect to any such State” have been deleted by the Diplomatic Conference, because it was felt that they only serve to illustrate the provision.

9sexies.06 *Ad paragraph (2)*: This paragraph, that did not appear in the basic proposal, has been introduced by the Diplomatic Conference into the final text in order to give the possibility to the Assembly, under certain conditions, of repealing the safeguard clause or of restricting its scope, without it being necessary to convene a Diplomatic Conference. The second sentence clarifies that only those States may vote on such a measure which are party both to the Stockholm Act and the Protocol, since States which are party only to the Stockholm Act or Contracting Parties which are party only to the Protocol are not affected by such decisions.

Notes Concerning Article 10

10.01 Article 10 of the basic proposal incorporated in the Protocol, by reference and *mutatis mutandis*, as well as subject to two understandings, Article 10 of the Stockholm Act. Following a decision of the Diplomatic Conference, the text of Article 10 of the Stockholm Act has been redrafted for the purposes of the Protocol and introduced into the Protocol.

10.02 *Ad paragraph (1)*: Subparagraph (a) flows from Article 1 of the Protocol, whereas subparagraphs (b) and (c) correspond to the provisions of Article 10(1)(b) and (c) of the Stockholm Act and seem to be self-explanatory.

10.03 *Ad paragraph (2)*: This paragraph completes paragraph (2) of the Stockholm Act in dealing with matters relating specifically to the Protocol.

10.04 *Ad paragraphs (3) and (4)*: The second sentence of subparagraph (a) of paragraph (3) recognizes that the

rights and obligations of the States bound by the Stockholm Act and the rights and obligations of the Contracting Parties under the Protocol are not always the same, since the Stockholm Act and the Protocol differ from each other in certain respects. Although all will be members of the same Union, it is necessary that if there are questions to be decided by the Assembly that are of interest to Contracting Parties only, or to States party to the Stockholm Act only, they do not interfere with each other. Subparagraphs (b) and (c) of paragraph (3) and paragraph (4) take into account that situation when determining the quorum and other conditions relating to the vote in, and the convocation of, the Assembly, by using the expression “members of the Assembly having the right to vote on a given matter,” or similar expressions, instead of the words “countries members of the Assembly,” which are used in the Stockholm Act.

**Article 10
Assembly**

Article 10 of the Madrid (Stockholm) Agreement shall apply *mutatis mutandis*, it being understood

- (i) that Contracting States, even where they are not party to the Madrid (Stockholm) Agreement, and Contracting Organizations shall be members of the same Assembly of which countries party to the Madrid (Stockholm) Agreement are members;
- (ii) that, on matters concerning only countries that are party to the Madrid (Stockholm) Agreement without being Contracting States, Contracting States that are not party to the Madrid (Stockholm) Agreement and Contracting Organizations shall not vote in the Assembly, whereas, on matters concerning only Contracting Parties, only the latter shall vote in the Assembly.

**Article 10
Assembly**

(1)(a) The Contracting Parties shall be members of the same Assembly as the countries party to the Madrid (Stockholm) Agreement.

(b) Each Contracting Party shall be represented in that Assembly by one delegate, who may be assisted by alternate delegates, advisors, and experts.

(c) The expenses of each delegation shall be borne by the Contracting Party which has appointed it, except for the travel expenses and the subsistence allowance of one delegate for each Contracting Party, which shall be paid from the funds of the Union.

(2) The Assembly shall, in addition to the functions which it has under the Madrid (Stockholm) Agreement, also

- (i) deal with all matters concerning the implementation of this Protocol;
- (ii) give directions to the International Bureau concerning the preparation for conferences of revision of this Protocol, due account being taken of any comments made by those countries of the Union which are not party to this Protocol;
- (iii) adopt and modify the provisions of the Regulations concerning the implementation of this Protocol;
- (iv) perform such other functions as are appropriate under this Protocol.

(3)(a) Each Contracting Party shall have one vote in the Assembly. On matters concerning only countries that are party to the Madrid (Stockholm) Agreement, Contracting Parties that are not party to the said

Notes Concerning Article 11

11.01 Article 11 of the basic proposal incorporated in the Protocol, by reference and *mutatis mutandis*, Article 11 of the Stockholm Act. The Diplomatic Conference

decided to redraft Article 11 for the purposes of the Protocol and to introduce it into the Protocol.

Basic Proposal

Text Adopted

(Article 10(3), continued)

Agreement shall not have the right to vote, whereas, on matters concerning only Contracting Parties, only the latter shall have the right to vote.

(b) One-half of the members of the Assembly which have the right to vote on a given matter shall constitute the quorum for the purposes of the vote on that matter.

(c) Notwithstanding the provisions of subparagraph (b), if, in any session, the number of the members of the Assembly having the right to vote on a given matter which are represented is less than one-half but equal to or more than one-third of the members of the Assembly having the right to vote on that matter, the Assembly may make decisions but, with the exception of decisions concerning its own procedure, all such decisions shall take effect only if the conditions set forth hereinafter are fulfilled. The International Bureau shall communicate the said decisions to the members of the Assembly having the right to vote on the said matter which were not represented and shall invite them to express in writing their vote or abstention within a period of three months from the date of the communication. If, at the expiry of this period, the number of such members having thus expressed their vote or abstention attains the number of the members which was lacking for attaining the quorum in the session itself, such decisions shall take effect provided that at the same time the required majority still obtains.

(d) Subject to the provisions of Articles 5(2)(e), 9*sexies*(2), 12 and 13(2), the decisions of the Assembly shall require two-thirds of the votes cast.

(e) Abstentions shall not be considered as votes.

(f) A delegate may represent, and vote in the name of, one member of the Assembly only.

(4) In addition to meeting in ordinary sessions and extraordinary sessions as provided for by the Madrid (Stockholm) Agreement, the Assembly shall meet in extraordinary session upon convocation by the Director General, at the request of one-fourth of the members of the Assembly having the right to vote on the matters proposed to be included in the agenda of the session. The agenda of such an extraordinary session shall be prepared by the Director General.

Article 11
International Bureau

Article 11 of the Madrid (Stockholm) Agreement shall apply *mutatis mutandis*.

Article 11
International Bureau

(1) International registration and related duties, as well as all other administrative tasks, under or concerning this Protocol, shall be performed by the International Bureau.

Notes Concerning Article 12

12.01 Article 12 of the basic proposal incorporated in the Protocol, by reference and *mutatis mutandis*, Article 12 of the Stockholm Act and dealt also with the fixation of the contribution class of Contracting Organizations. The Diplomatic Conference decided to redraft Article 12 for the purposes of the Protocol and to introduce it into the Protocol. That Article provides that the finances of the Union shall be governed by the same provisions as those contained in Article 12 of the Stockholm Act, except that any reference to Article 8 of

the said Act, dealing with fees, shall be deemed to be a reference to Article 8 of the Protocol, which establishes a different system of fees. In addition, Article 12 fixes a contribution class according to the Paris Convention for the unlikely case that a payment to the working capital fund would have to be made by a Contracting Party that is an Organization. The class would be No. I (one), unless the Assembly fixes another class by a unanimous decision; since class I is the highest, the Assembly could only fix a class lower than class I.

Notes Concerning Article 13

13.01 Article 13 of the Stockholm Act allows the amendment of certain provisions of that Act by the Assembly (rather than by a revision conference) and fixes the procedure of amendment. Those provisions are Articles 10, 11, 12 and 13.

13.02 Following a decision of the Diplomatic Conference, the text of Article 13 of the Stockholm Act has not been incorporated in the Protocol, by reference and *mutatis mutandis*, as provided for in the basic proposal, but has been redrafted for the purposes of the Protocol and introduced into the text of the Protocol.

Basic Proposal

Text Adopted

(Article 11, continued)

(2)(a) The International Bureau shall, in accordance with the directions of the Assembly, make the preparations for the conferences of revision of this Protocol.

(b) The International Bureau may consult with intergovernmental and international non-governmental organizations concerning preparations for such conferences of revision.

(c) The Director General and persons designated by him shall take part, without the right to vote, in the discussions at such conferences of revision.

(3) The International Bureau shall carry out any other tasks assigned to it in relation to this Protocol.

Article 12
Finances

Article 12 of the Madrid (Stockholm) Agreement shall apply *mutatis mutandis*, provided that, for the purposes of paragraph (6) of the said Article, any Contracting Organization shall, subject to a unanimous decision to the contrary by the Assembly, be considered to belong to contribution class I (one) under the Paris Convention for the Protection of Industrial Property.

Article 12
Finances

As far as Contracting Parties are concerned, the finances of the Union shall be governed by the same provisions as those contained in Article 12 of the Madrid (Stockholm) Agreement, provided that any reference to Article 8 of the said Agreement shall be deemed to be a reference to Article 8 of this Protocol. Furthermore, for the purposes of Article 12(6)(b) of the said Agreement, Contracting Organizations shall, subject to a unanimous decision to the contrary by the Assembly, be considered to belong to contribution class I (one) under the Paris Convention for the Protection of Industrial Property.

Article 13
Amendment of Certain Articles of this Protocol

Article 13 of the Madrid (Stockholm) Agreement shall apply, *mutatis mutandis*, to the amendment of Articles 10, 11, 12 and the present Article of this Protocol.

Article 13
Amendment of Certain Articles of the Protocol

(1) Proposals for the amendment of Articles 10, 11, 12, and the present Article, may be initiated by any Contracting Party, or by the Director General. Such proposals shall be communicated by the Director General to the Contracting Parties at least six months in advance of their consideration by the Assembly.

(2) Amendments to the Articles referred to in paragraph (1) shall be adopted by the Assembly. Adoption shall require three-fourths of the votes cast, provided that any amendment to Article 10, and to the present paragraph, shall require four-fifths of the votes cast.

Notes Concerning Article 14

14.01 This Article establishes what entities may become Contracting Parties to the Protocol (paragraph (1)); furthermore, it provides that such entities may sign the Protocol (paragraph (2), first sentence); it then establishes the act that triggers becoming a party, namely, the deposit of an instrument of ratification, acceptance, approval or accession (paragraph (2), second sentence) and says where such instrument has to be deposited (namely, with the Director General; see paragraph (3)); it then establishes when the Protocol comes into force in respect of any entity that has deposited the required instrument (paragraph (4)); finally, it contains a provision as to the applicability of the Protocol to international registrations under the Protocol which were effected before the entity has become a party to the Protocol (paragraph (5)).

14.02 This Article of the Protocol differs from Article 14 of the Stockholm Act in two important respects: one is that it allows not only States but also certain intergovernmental organizations to become party to the Protocol, and the other is that the entry into force requires not only that a certain number of entities deposit their instruments of adherence but that at least one of those instruments must come from an entity (a State) that is already a member of the Madrid Union and at least one other of those instruments must come from an entity (a State or an intergovernmental organization) that is not member of the Madrid Union.

14.03 *Ad paragraph (1)*: Tradition prevailing in WIPO is that only States may become party to a treaty administered by WIPO. The Protocol allows also certain intergovernmental organizations to become a party to the Protocol. This is one of the major innovations intro-

duced by the Protocol. Any intergovernmental organization that wishes to become a Contracting Party has to meet two conditions; they are spelled out in subparagraph (b).

14.04 The first condition (contained in subparagraph (b)(i)) is that at least one of the member States of the organization must be a party to the Paris Convention; the provision parallels, albeit only to a limited extent, the requirement applicable in respect of each Special Union administered by WIPO according to which only States that are members of the Paris Union can join the Special Union.

14.05 The second condition (contained in subparagraph (b)(ii)) is that the organization must have "a regional Office for the purposes of registering marks with effect in the territory of the organization, provided that such Office is not the subject of a notification under Article 9*quater*." The future (European) Community Trade Mark Office will meet these requirements because it will not replace the national Offices of the States members of the European Communities.

14.06 Enabling the European Community to become a member of the Madrid Union is one of the two main objectives of the creation of the Protocol. (The other main objective is to enable certain non-member States to join the Madrid Union.) By enabling the European Community to be a Contracting Party, the Protocol puts the future (European) Community Trade Mark Office—the trademark office of the European Community—on the same footing as the national trademark offices. This is indispensable since, from an operational viewpoint, the Madrid Union is a cooperative venture of

*Basic Proposal**Text Adopted**(Article 13, continued)*

(3) Any amendment to the Articles referred to in paragraph (1) shall enter into force one month after written notifications of acceptance, effected in accordance with their respective constitutional processes, have been received by the Director General from three-fourths of those States and intergovernmental organizations which, at the time the amendment was adopted, were members of the Assembly and had the right to vote on the amendment. Any amendment to the said Articles thus accepted shall bind all the States and intergovernmental organizations which are Contracting Parties at the time the amendment enters into force, or which become Contracting Parties at a subsequent date.

Article 14
Ratification and Accession;
Entry into Force

(1)(a) Any State that is a party to the Paris Convention for the Protection of Industrial Property may become party to this Protocol.

(b) Furthermore, any intergovernmental organization may also become party to this Protocol where the following conditions are fulfilled:

- (i) at least one of the member States of that organization is a party to the Paris Convention for the Protection of Industrial Property;
- (ii) that organization has a regional Office for the purposes of registering marks with effect in all States members of such organization, provided that such Office is not a common Office within the meaning of Article 9^{quater} of this Protocol.

(2) Any State or organization referred to in paragraph (1) may sign this Protocol. Any such State or organization may, if it has signed this Protocol, deposit an instrument of ratification, acceptance, approval or formal confirmation of this Protocol or, if it has not signed this Protocol, deposit an instrument of accession to this Protocol.

(3) The instruments referred to in paragraph (2) shall be deposited with the Director General.

(4)(a) This Protocol shall enter into force three months after four instruments of ratification, acceptance, approval, formal confirmation or accession have been deposited, provided that at least one of those instruments has been deposited by a State party to the Madrid (Stockholm) Agreement and at least one of those instruments has been deposited by a State not

Article 14
Becoming Party to the Protocol;
Entry into Force

(1)(a) Any State that is a party to the Paris Convention for the Protection of Industrial Property may become party to this Protocol.

(b) Furthermore, any intergovernmental organization may also become party to this Protocol where the following conditions are fulfilled:

- (i) at least one of the member States of that organization is a party to the Paris Convention for the Protection of Industrial Property;
- (ii) that organization has a regional Office for the purposes of registering marks with effect in the territory of the organization, provided that such Office is not the subject of a notification under Article 9^{quater}.

(2) Any State or organization referred to in paragraph (1) may sign this Protocol. Any such State or organization may, if it has signed this Protocol, deposit an instrument of ratification, acceptance or approval of this Protocol or, if it has not signed this Protocol, deposit an instrument of accession to this Protocol.

(3) The instruments referred to in paragraph (2) shall be deposited with the Director General.

(4)(a) This Protocol shall enter into force three months after four instruments of ratification, acceptance, approval or accession have been deposited, provided that at least one of those instruments has been deposited by a country party to the Madrid (Stockholm) Agreement and at least one other of those instruments has been deposited by a State not party to the Madrid

(Notes Concerning Article 14, continued)

trademark registries or offices: international applications must be based on an application or registration effected in one of *them*, and the refusal, if any, of the effects of the international registration must be notified by *them*.

14.07 The proviso excludes the Benelux Trademark Office and any other organization having made a declaration under Article 9 *quater* from eligibility for membership in the Madrid Union.

14.08 Item (ii) of paragraph (1)(b) has been the subject of two modifications by the Diplomatic Conference. The first one is a consequence of the modification of Article 2 (the words "in the territory of the organization" replace the words "in all States members of such organization"). The second one was made in the proviso for the sake of clarity and facilitates the application of the provision.

14.09 *Ad paragraphs (2), (4) and (5)*: The words "formal confirmation" appearing in the basic proposal were considered superfluous by the Diplomatic Conference and were deleted in the final text.

14.10 *Ad paragraph (2)*: This is a provision of the traditional kind and seems to be self-explanatory.

14.11 *Ad paragraph (3)*: This is a provision of the traditional kind and seems to be self-explanatory.

14.12 *Ad paragraph (4)(a)*: According to this provision, the initial entry into force of the Protocol requires *four*

adherences out of which at least one must be an adherence by a State member of the Madrid Union and out of which at least one adherence must be an adherence by an entity (State or Organization) *not member of the Madrid Union*. These requirements are justified by one of the main objectives that the Protocol has, namely, that it should enable entities outside the Union to join the Madrid Union. If the Protocol did not require that at least one adherence be the adherence of a non-member, the objective of seeing outsiders enter the Union would not be fulfilled, whereas if the Protocol did not require that at least one adherence be the adherence of a member, what new members would join would not be the Madrid Union but an entity that, as far as its membership is concerned, would be completely new, and not overlapping with the present Madrid Union.

14.13 The fact that a total of four (and not only two) adherences is required is justified only by the fact that the Protocol is intended to be a multilateral treaty, and not a treaty between two entities only.

14.14 *Ad paragraph (5)*: This provision enables a newly adhering entity to exclude the possibility of its (necessarily "later") designation in respect of international registrations effected under the Protocol before that entity became a Contracting Party to the Protocol. The provision corresponds to the principle embodied, as far as the Stockholm Act is concerned, in Article 14(2)(d) and (f) of that Act. It is to be noted that creating a possibility of exclusion in respect of international registrations effected under the Stockholm Act is not necessary since parties to the Protocol have no obligations whatsoever in respect of international registrations effected under the Stockholm Act (and not under the Protocol).

Notes Concerning Article 15

15.01 *Ad paragraph (1)*: This provision is of the usual kind and corresponds to Article 15(1) of the Stockholm Act. It seems to be self-explanatory.

15.02 *Ad paragraph (2)*: This provision is of the usual kind and corresponds to the first sentence of Article 15(2) of the Stockholm Act. It seems to be self-explanatory.

15.03 *Ad paragraph (3)*: This provision is of the usual kind and is identical with Article 15(3) of the Stockholm Act. It seems to be self-explanatory.

15.04 *Ad paragraph (4)*: This provision is of the usual kind and corresponds to Article 15(4) of the Stockholm Act. It seems to be self-explanatory.

15.05 *Ad paragraph (5)(a)*: This provision corresponds to Article 15(5) of the Stockholm Act but establishes a system different from the system under the Stockholm Act which was to be retained under the basic proposal. Under the Stockholm Act and the basic proposal, international registrations registered up to the date on which denunciation becomes effective, and not refused within the period applicable under Article 5, continue throughout the period of international protection (i.e., until the first renewal or the next renewal, as specified in the basic proposal) to enjoy the same protection as if they had been registered by the Office of the denouncing party. No specific procedure was required for the implementation of the said provision. The Diplomatic

*Basic Proposal**(Article 14(4), continued)*

party to the Madrid (Stockholm) Agreement or by any of the organizations referred to in paragraph (1)(b).

(b) With respect to any other State or organization referred to in paragraph (1), this Protocol shall enter into force three months after the date on which its ratification, acceptance, approval, formal confirmation or accession has been notified by the Director General.

(5) Any State or organization referred to in paragraph (1) may, when depositing its instrument of ratification, acceptance, approval or formal confirmation of, or accession to, this Protocol, declare that the protection resulting from any international registration effected under this Protocol before the date of entry into force of this Protocol with respect to it cannot be extended to it.

**Article 15
Denunciation**

(1) This Protocol shall remain in force without limitation as to time.

(2) Any Contracting Party may denounce this Protocol by notification addressed to the Director General.

(3) Denunciation shall take effect one year after the day on which the Director General has received the notification.

(4) The right of denunciation provided for by this Article shall not be exercised by any Contracting Party before the expiration of five years from the date upon which this Protocol entered into force with respect to that Contracting Party.

*Text Adopted**(Article 14(4), continued)*

(Stockholm) Agreement or by any of the organizations referred to in paragraph (1)(b).

(b) With respect to any other State or organization referred to in paragraph (1), this Protocol shall enter into force three months after the date on which its ratification, acceptance, approval or accession has been notified by the Director General.

(5) Any State or organization referred to in paragraph (1) may, when depositing its instrument of ratification, acceptance or approval of, or accession to, this Protocol, declare that the protection resulting from any international registration effected under this Protocol before the date of entry into force of this Protocol with respect to it cannot be extended to it.

**Article 15
Denunciation**

(1) This Protocol shall remain in force without limitation as to time.

(2) Any Contracting Party may denounce this Protocol by notification addressed to the Director General.

(3) Denunciation shall take effect one year after the day on which the Director General has received the notification.

(4) The right of denunciation provided for by this Article shall not be exercised by any Contracting Party before the expiry of five years from the date upon which this Protocol entered into force with respect to that Contracting Party.

(Notes Concerning Article 15, continued)

Conference decided to specify the conditions required for the continuation of the protection of marks which are the subject of an international registration having effect in a denouncing State or intergovernmental organization. The first of those conditions is the filing of an application for the registration of that mark with the Office of the denouncing State or intergovernmental organization within two years from the date on which the denunciation becomes effective (item (i)). Such application must be treated as if it had been filed on the date of the international registration or on the date of

recordal of the territorial extension and, if the international registration enjoyed priority, will enjoy the same priority. The other conditions (items (ii) and (iii)) seem to be self-explanatory.

15.06 *Ad paragraph (5)(b)*: Furthermore, the Diplomatic Conference decided to provide in subparagraph (b) that protection of a mark that is the subject of an international registration having effect in Contracting Parties other than the denouncing State or intergovernmental organization at the date on which denunciation becomes effective must continue, subject to the same conditions as those laid down in subparagraph (a). Such a provision did not exist in the Stockholm Act.

Notes Concerning Article 16

16.01 *Ad paragraph (1)(a)*: Whereas the Stockholm Act was signed only in one language (French) (see Article 17(1) of that Act), the Protocol can be signed also in English and Spanish. The addition of English seems to be justified by the fact that, in international relations, English has now the same importance as French. This was not so when the Madrid Agreement was concluded almost a century ago, in 1891. The addition of Spanish, which did not appear in the basic proposal, has been decided by the Diplomatic Conference. The words "when it ceases to be open for signature at Madrid,"

which did not appear in the basic proposal, were added by the Diplomatic Conference for the sake of clarification and of consistency with paragraph (2).

16.02 *Ad paragraph (1)(b)*: Whereas the Stockholm Act (Article 17(1)(b)) leaves the determination of the languages in which the official texts have to be established entirely to the Assembly, the Protocol itself names seven languages (Arabic, Chinese, German, Italian, Japanese, Portuguese, Russian) as languages in which official texts will have to be established. The

*Basic Proposal**(Article 15, continued)*

(5) International marks registered up to the date on which denunciation becomes effective, and not refused within the period applicable under Article 5 of this Protocol, shall continue, until the first renewal or the next renewal, as the case may be, to enjoy the same protection as if they had been registered by the Office of the denouncing party.

*Text Adopted**(Article 15, continued)*

(5)(a) Where a mark is the subject of an international registration having effect in the denouncing State or intergovernmental organization at the date on which the denunciation becomes effective, the holder of such registration may file an application for the registration of the same mark with the Office of the denouncing State or intergovernmental organization, which shall be treated as if it had been filed on the date of the international registration according to Article 3(4) or on the date of recordal of the territorial extension according to Article 3ter(2) and, if the international registration enjoyed priority, enjoy the same priority, provided that

- (i) such application is filed within two years from the date on which the denunciation became effective,
- (ii) the goods and services listed in the application are in fact covered by the list of goods and services contained in the international registration in respect of the denouncing State or intergovernmental organization, and
- (iii) such application complies with all the requirements of the applicable law, including the requirements concerning fees.

(b) The provisions of subparagraph (a) shall also apply in respect of any mark that is the subject of an international registration having effect in Contracting Parties other than the denouncing State or intergovernmental organization at the date on which denunciation becomes effective and whose holder, because of the denunciation, is no longer entitled to file international applications under Article 2(1).

Article 16**Signature; Languages; Depositary Functions**

(1)(a) This Protocol shall be signed in a single copy in the English and French languages and shall be deposited with the Director General. The texts in the two languages shall be equally authentic.

(b) Official texts of this Protocol shall be established by the Director General, after consultation with the interested governments and organizations, in the Arabic, Chinese, German, Japanese, Portuguese, Russian and Spanish languages, and in such other languages as the Assembly may designate.

Article 16**Signature; Languages; Depositary Functions**

(1)(a) This Protocol shall be signed in a single copy in the English, French and Spanish languages, and shall be deposited with the Director General when it ceases to be open for signature at Madrid. The texts in the three languages shall be equally authentic.

(b) Official texts of this Protocol shall be established by the Director General, after consultation with the interested governments and organizations, in the Arabic, Chinese, German, Italian, Japanese, Portuguese and Russian languages, and in such other languages as the Assembly may designate.

(Notes Concerning Article 16, continued)

choice of those languages is based on statistics: those are the languages in which the overwhelming majority of trademarks registered in the world are registered and published. The Italian language, which was not mentioned in the basic proposal, has been added in the final text by the Diplomatic Conference. Otherwise, the provision seems to be self-explanatory.

16.03 *Ad paragraph (2)*: This provision is of the usual kind and corresponds to Article 17(2) of the Stockholm Act. "At Madrid" means, in practice, at the Ministry of External Affairs of Spain, in Madrid. Otherwise, this provision seems to be self-explanatory.

16.04 *Ad paragraph (3)*: This provision is of the usual kind and corresponds to Article 17(3) of the Stockholm

Act. It seems to be self-explanatory. The word "text" appearing in the basic proposal has been replaced by "texts" to be in conformity with the last sentence of paragraph (1)(a).

16.05 *Ad paragraph (4)*: This provision is of the usual kind and corresponds to Article 17(4) of the Stockholm Act. It seems to be self-explanatory.

16.06 *Ad paragraph (5)*: This provision is of the usual kind and corresponds to Article 17(5) of the Stockholm Act. It seems to be self-explanatory. The words "formal confirmation" appearing in the basic proposal have been deleted in the final text, following the deletion of the same words in Article 14(2), (4) and (5). The words "and any amendment thereto, any notification of denunciation" have been added by the Diplomatic Conference after the words "the entry into force of this Protocol."

*Basic Proposal**(Article 16, continued)*

(2) This Protocol shall remain open for signature at Madrid until December 31, 1989.

(3) The Director General shall transmit two copies, certified by the Government of Spain, of the signed text of this Protocol to all States and intergovernmental organizations that may become party to this Protocol.

(4) The Director General shall register this Protocol with the Secretariat of the United Nations.

(5) The Director General shall notify all States and international organizations that may become or are party to this Protocol of signatures, deposits of instruments of ratification, acceptance, approval, formal confirmation or accession, the entry into force of this Protocol and any declaration provided for in this Protocol.

*Text Adopted**(Article 16, continued)*

(2) This Protocol shall remain open for signature at Madrid until December 31, 1989.

(3) The Director General shall transmit two copies, certified by the Government of Spain, of the signed texts of this Protocol to all States and intergovernmental organizations that may become party to this Protocol.

(4) The Director General shall register this Protocol with the Secretariat of the United Nations.

(5) The Director General shall notify all States and international organizations that may become or are party to this Protocol of signatures, deposits of instruments of ratification, acceptance, approval or accession, the entry into force of this Protocol and any amendment thereto, any notification of denunciation and any declaration provided for in this Protocol.

News Items

CHILE

*Head,
Industrial Property Department*

We have been informed that Mr. Jaime Palma Oyedo has been appointed Head of the Industrial Property Department.

SWITZERLAND

*Director,
Federal Intellectual Property Office*

We have been informed that Mr. Roland Grossenbacher has been appointed Director of the Federal Intellectual Property Office.

Calendar of Meetings

WIPO Meetings

(Not all WIPO meetings are listed. Dates are subject to possible change.)

1990

- January 29 to February 2 (Geneva)** **Committee of Experts on the Interface Between Patent Protection and Plant Breeders' Rights** (jointly organized by WIPO and the International Union for the Protection of New Varieties of Plants (UPOV))
- The Committee will examine the interface between patent protection and plant breeders' rights, on the basis of documents of the International Bureau of WIPO and the Office of UPOV.
Invitations: States members of WIPO, UPOV or the United Nations and, as observers, certain organizations.
- February 19 to 23 (Geneva)** **Committee of Experts on the Settlement of Intellectual Property Disputes Between States (First Session)**
- The Committee will examine whether the preparation of a new treaty on the settlement of disputes between States in the field of intellectual property should start and, if so, with what content.
Invitations: States members of the Paris Union, the Berne Union or WIPO or party to the Nairobi Treaty and, as observers, certain organizations.
- March 12 to 16 (Geneva)** **Working group on the application of the Madrid Protocol of 1989 (First Session)**
- This working group will consider the draft of new Regulations under the Stockholm Act of the Madrid Agreement Concerning the International Registration of Marks and the Protocol (adopted in Madrid in June 1989) relating to the said Agreement and will suggest other measures required by the co-existence of the Madrid (Stockholm) Agreement and the said Protocol.
Invitations: States members of the Madrid Union, States having signed or acceded to the Protocol, Greece, Ireland, the European Communities and, as observers, other States members of the Paris Union expressing their interest in participating in the Working Group in such capacity and certain non-governmental organizations.
- May 29 to June 1 (Geneva)** **Committee of Experts on the International Protection of Indications of Source and Appellations of Origin**
- The Committee will advise the International Bureau of WIPO on the possible conclusion of a new treaty on the international protection of indications of source and appellations of origin or the possible revision of the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration and on the possibilities of increasing the use of the registration facilities of that Agreement.
Invitations: States members of the Paris Union and, as observers, certain organizations.
- June 5 to 8 (Geneva)** **Consultative meeting of developing countries on the harmonization of patent laws**
- This consultative meeting will, on the basis of working documents prepared by the International Bureau of WIPO, study problems of particular relevance to developing countries in connection with the preparation of a treaty on the harmonization of certain provisions in laws for the protection of inventions.
Invitations: Developing countries members of the Paris Union or WIPO.
- June 11 to 22 (Geneva)** **Committee of Experts on the Harmonization of Certain Provisions in Laws for the Protection of Inventions (Eighth Session)**
- The Committee will continue to examine a draft treaty on the harmonization of certain provisions in laws for the protection of inventions.
Invitations: States members of the Paris Union and, as observers, States members of WIPO not members of the Paris Union and certain organizations.
- June 11 to 22 (Geneva)** **Preparatory meeting for the diplomatic conference on the adoption of a treaty on the harmonization of patent laws**
- The preparatory meeting will prepare the organization of the diplomatic conference which will negotiate and adopt a new treaty on the harmonization of patent laws. The preparatory meeting will, in particular, establish the draft rules of procedure of the diplomatic conference and decide which States and inter-governmental and non-governmental organizations should be invited to the diplomatic conference and in what tentative capacity.
Invitations: States members of the Paris Union.

- June 25 to 29 (Geneva)** **Committee of Experts on the Harmonization of Laws for the Protection of Marks (Second Session)**
The Committee will continue to examine draft treaty provisions on the harmonization of laws for the protection of marks.
Invitations: States members of the Paris Union, the European Communities and, as observers, States members of WIPO not members of the Paris Union and certain organizations.
- July 2 to 6 (Geneva)** **PCT Committee for Administrative and Legal Matters (Third Session)**
The Committee will examine proposals for amending the Regulations under the Patent Cooperation Treaty (PCT), in particular in connection with the procedure under Chapter II of the PCT.
Invitations: States members of the PCT Union and, as observers, States members of the Paris Union not members of the PCT Union and certain organizations.
- July 2 to 13 (Geneva)** **Committee of Experts on Model Provisions for Legislation in the Field of Copyright (Third Session)**
The Committee will continue to consider proposed standards in the field of literary and artistic works for the purposes of national legislation on the basis of the Berne Convention for the Protection of Literary and Artistic Works.
Invitations: States members of the Berne Union or WIPO and, as observers, certain organizations.
- September 24 to October 2 (Geneva)** **Governing Bodies of WIPO and of the Unions Administered by WIPO (Twenty-First Series of Meetings)**
Some of the Governing Bodies will meet in ordinary session, others in extraordinary session.
Invitations: As members or observers (depending on the body), States members of WIPO or of the Unions and, as observers, other States and certain organizations.
- October 15 to 26 (Geneva)** **Committee of Experts Set up under the Nice Agreement (Sixteenth Session)**
The Committee will complete the fifth revision of the classification established under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks.
Invitations: States members of the Nice Union and, as observers, States members of the Paris Union not members of the Nice Union and certain organizations.
- *October 22 to 26 (Geneva)** **Committee of Experts on the Interface Between Patent Protection and Plant Breeders' Rights (Second Session)** (jointly organized by WIPO and UPOV)
The Committee will continue to examine the interface between patent protection and plant breeders' rights.
Invitations: States members of WIPO, UPOV or the United Nations and, as observers, certain organizations.
- October 29 to November 2 (Geneva)** **Committee of Experts on a Protocol to the Berne Convention (First Session)**
The Committee will examine whether the preparation of a protocol to the Berne Convention for the Protection of Literary and Artistic Works should start, and—if so—with what content.
Invitations: States members of the Berne Union and, as observers, States members of WIPO not members of the Berne Union and certain organizations.
- October 29 to November 2 (Geneva)** **Working group on a possible revision of the Hague Agreement (First Session)**
This working group will consider possibilities for revising the Hague Agreement Concerning the International Deposit of Industrial Designs, or adding to it a protocol, in order to introduce in the Hague system further flexibility and other measures encouraging States not yet party to the Hague Agreement to adhere to it and making it easier to use by applicants.
Invitations: States members of the Hague Union and, as observers, States members of the Paris Union not members of the Hague Union and certain organizations.
- *November 5 to 9 (Geneva)** **Committee of Experts on Measures Against Counterfeiting and Piracy (Second Session)**
The Committee will continue to consider draft model provisions for national laws on protection against counterfeiting and piracy.
Invitations: States members of the United Nations or specialized agencies and, as observers, certain organizations.
- *November 19 to 23 (Geneva)** **Committee of Experts on the Settlement of Intellectual Property Disputes Between States (Second Session)**
The Committee will continue the work started during its first session (February 19 to 23, 1990).
Invitations: States members of the Paris Union, the Berne Union or WIPO or party to the Nairobi Treaty and, as observers, certain organizations.

* Dates particularly subject to possible change.

- November 26 to 30 (Geneva)** **Working group on the application of the Madrid Protocol of 1989 (Second Session)**
 The working group will continue the work started during its first session (March 12 to 16, 1990).
Invitations: States members of the Madrid Union, States having signed or acceded to the Protocol, Greece, Ireland, the European Communities and, as observers, other States members of the Paris Union expressing their interest in participating in the working group in such capacity and certain non-governmental organizations.
- December 10 to 14 (Geneva)** **PCT Committee for Administrative and Legal Matters (Fourth Session)**
 The Committee will continue the work started during its third session (July 2 to 6, 1990).
Invitations: States members of the PCT Union and, as observers, States members of the Paris Union not members of the PCT Union and certain organizations.
- 1991**
- January 28 to 30 (Geneva)** **Information meeting(s) on the revision of the Paris Convention**
 An information meeting of developing countries members of the Paris Union and China and, if it is so desired, information meetings of any other group of countries members of the Paris Union will take place for an exchange of views on the new proposals which will have been prepared by the Director General of WIPO for amending the articles of the Paris Convention for the Protection of Industrial Property which are under consideration for revision.
Invitations: See the preceding paragraph.
- January 31 and February 1 (Geneva)** **Assembly of the Paris Union (Fifteenth Session)**
 The Assembly will fix the further procedural steps concerning the revision of the Paris Convention and will take cognizance of the aforementioned proposals of the Director General of WIPO. It will also decide the composition of a preparatory meeting which will take place in the first half of 1991.
Invitations: States members of the Paris Union and, as observers, States members of WIPO not members of the Paris Union and certain organizations.
- *June 3 to 28** **Diplomatic Conference for the adoption of a treaty on the harmonization of patent laws**
 This diplomatic conference will negotiate and adopt a treaty on the harmonization of patent laws, which will supplement the Paris Convention as far as patents are concerned.
Invitations: To be decided by the preparatory meeting to be held from June 11 to 22, 1990 (see above).
- September 23 to October 2 (Geneva)** **Governing Bodies of WIPO and the Unions Administered by WIPO (Twenty-Second Series of Meetings)**
 All the Governing Bodies of WIPO and the Unions administered by WIPO meet in ordinary sessions every two years in odd-numbered years.
 In the sessions in 1991, the Governing Bodies will, *inter alia*, review and evaluate activities undertaken since July 1990, and consider and adopt the draft program and budget for the 1992-93 biennium.
Invitations: States members of WIPO and the Unions and, as observers, other States members of the United Nations and certain organizations.
- *November 18 to December 6** **Diplomatic Conference on the Revision of the Paris Convention for the Protection of Industrial Property (Fifth Session)**
 The Diplomatic Conference will negotiate and adopt a new Act of the Paris Convention.
Invitations: States members of the Paris Union and, without the right to vote, States members of WIPO or the United Nations not members of the Paris Union as well as, as observers, certain organizations.

UPOV Meetings

(Not all UPOV meetings are listed. Dates are subject to possible change.)

1990

- April 23 to 27 (a.m.) (Geneva)** **First Preparatory Meeting for the Revision of the UPOV Convention**
Invitations: Member States of UPOV.
- April 27 (p.m.) (Geneva)** **Consultative Committee (Forty-First Session)**
 The Committee will mainly discuss the outcome of the First Preparatory Meeting for the Revision of the UPOV Convention.
Invitations: Member States of UPOV.

- June 25 to 29 (Geneva)** **Second Preparatory Meeting for the Revision of the UPOV Convention**
Invitations: Member States of UPOV.
- October 15 and 16 (Geneva)** **Third Preparatory Meeting for the Revision of the UPOV Convention**
Invitations: Member States of UPOV.
- October 17 (Geneva)** **Consultative Committee (Forty-Second Session)**
The Committee will prepare the twenty-fourth ordinary session of the Council.
Invitations: Member States of UPOV.
- October 18 and 19 (Geneva)** **Council (Twenty-Fourth Ordinary Session)**
The Council will examine the reports on the activities of UPOV in 1989 and the first part of 1990 and approve documents for the Diplomatic Conference to Revise the UPOV Convention.
Invitations: Member States of UPOV and, as observers, certain non-member States and intergovernmental organizations.

Other Meetings Concerned with Industrial Property

1990

- May 8 to 11 (Washington, D.C.)** **Foundation for a Creative America: Bicentennial Celebration of the Enactment of the United States Patent and Copyright Laws**