

WIPO



WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

**INFORMAL LIAISON MEETING
WITH OFFICES OF MEMBERS OF THE MADRID UNION**

Geneva, May 8¹, 2008

**REPEAL OF THE SAFEGUARD CLAUSE – INFORMATION KIT FOR OFFICES OF
CONTRACTING PARTIES BOUND BY BOTH THE AGREEMENT
AND THE PROTOCOL**

¹ Morning session only.

1. At its thirty-eighth session, from September 24 to October 3, 2007, the Assembly of the Madrid Union adopted an amendment to Article 9*sexies* of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (“the Protocol”) along with a number of consequential or related amendments to the Common Regulations under the Madrid Agreement and Protocol, and a number of amendments to the Schedule of Fees annexed to the Common Regulations. The amendments will take effect on September 1, 2008.

2. Article 9*sexies* of the Protocol, commonly known as “the safeguard clause”, provides that where Contracting Parties are bound by both the Agreement and the Protocol, the provisions of the Agreement shall prevail in the mutual relations between those Contracting Parties.

3. Article 9*sexies*, as amended, and as in force from September 1, 2008, repeals the safeguard clause. Consequently, as from September 1, 2008, it will be the Protocol which will apply in the mutual relations between Contracting Parties bound by both the Agreement and the Protocol.

4. The only situations where the Agreement will continue to apply will be when the country of origin is a country bound only by the Agreement, or the country of origin is bound by both the Agreement and the Protocol and some or all of the designated Contracting Parties are bound exclusively by the Agreement.

5. However, Article 9*sexies*, as amended, limits the effects of the repeal of the safeguard clause in two respects (new sub-paragraph (1)(b)). Firstly, it renders inoperative a declaration under Article 5(2)(b) and Article 5(2)(c) of the Protocol (extension of the time limit for notifying a provisional refusal) and, secondly, it renders inoperative a declaration under Article 8(7) of the Protocol (individual fees), in the mutual relations between Contracting Parties bound by both treaties.

6. The repeal of the safeguard clause will therefore entail a number of changes concerning the operations of Offices of Contracting Parties that are bound by both the Agreement and the Protocol. Those Offices will need to adapt their procedures and automated systems in order to accommodate the changes.

7. The changes, as well as their implications, are set out in the three tables below. The tables refer, firstly, to an Office as Office of origin, secondly, to an Office as Office of origin/Office of the Contracting Party of the holder and, thirdly, to an Office as Office of a designated Contracting Party.

8. Additional comments follow in relation to the international application forms to be used, the new treatment of international applications with reference to Rule 11, the application of the trilingual regime (English, French, Spanish), and as to how to determine when Article 9*sexies*(1)(b) applies.

TABLE 1

This table concerns situations where the country of origin and the designated Contracting Party are parties to both the Agreement and the Protocol (AP – AP).

Office of origin	Up to August 31, 2008	As from September 1, 2008
	Agreement applies	Protocol applies
International applications		
Cascade	Applies	Does not apply
Form	MM1 ²	MM2 ³
Basis for filing	Registration ⁴	Application/Registration
Language	French ⁵	English, French, Spanish
Fees	Complementary and supplementary fees	Complementary and supplementary fees ⁶ No individual fees for Contracting Parties that have made the declaration under Article 8(7) of the Protocol

² Or MM3, where an international application also contains designations of Contracting Parties bound exclusively by the Protocol.

³ Or MM3, where an international application also contains designations of Contracting Parties bound exclusively by the Agreement.

⁴ See explanation in paragraphs 10, 11, 12 and 13.

⁵ See explanation in paragraph 15.

⁶ As of September 1, 2008, the complementary and supplementary fees will increase from 73 Swiss francs to 100 Swiss francs.

TABLE 2

This table concerns situations where the country of origin/Contracting Party of the holder and the designated Contracting Party are parties to both the Agreement and the Protocol (AP – AP).

Office of Origin/Office of the Contracting Party of the holder	Up to August 31, 2008	As from September 1, 2008
	Agreement applies	Protocol applies
Subsequent designations		
Basis for filing	Registration	Application/Registration
Language	French	English, French, Spanish ⁷
Fees	Complementary fees	Complementary fees ⁸ No individual fees for Contracting Parties that have made the declaration under Article 8(7) of the Protocol
Presentation of request	Mandatorily through the Office of origin/Office of the Contracting Party of the holder	Through the Office, or directly to the International Bureau
Request for the recording of a renunciation/cancellation		
Presentation of the request	Mandatorily through the Office of origin/Office of the Contracting Party of the holder	Through the Office, or directly to the International Bureau

⁷ If the international application was originally filed under the Agreement (and, therefore, in French), the trilingual regime will become available only when, after September 1, 2008, a first subsequent designation, either under the Agreement or the Protocol, has been recorded in the International Register.

⁸ As of September 1, 2008, the complementary fees will increase from 73 Swiss francs to 100 Swiss francs.

TABLE 3

This table concerns situations where the country of origin/Contracting Party of the holder and the designated Contracting Party are parties to both the Agreement and the Protocol (AP – AP).

Designated Office	Up to August 31, 2008	As from September 1, 2008
	Agreement applies	Protocol applies
International Registrations and Subsequent Designations		
Fees	Complementary and supplementary fees ⁹	Complementary and supplementary fees ¹⁰ No individual fees for Contracting Parties that have made the declaration under Article 8(7) of the Protocol
Time limit for notifying a provisional refusal	12 months	12 months, also for Contracting Parties that have made declarations under Article 5(2)(b) and (c) of the Protocol
Statements of grant of protection	12 months	12 months, also for Contracting Parties that have made declarations under Article 5(2)(b) and (c) of the Protocol
Information relating to possible oppositions (Rule 16)	Rule 16 not applicable	Rule 16 not applicable, also for Contracting Parties that have made declarations under Article 5(2)(b) and (c) of the Protocol
Transformation (Article 9quinquies of the Protocol)		
Request for transformation	Not possible	Possible
Notification of correction (Rule 28(3))		
Time limit for notifying a provisional refusal	12 months	12 months, also for Contracting Parties that have made declarations under Article 5(2)(b) and (c) of the Protocol

⁹ No supplementary fees apply in the case of a subsequent designation.

¹⁰ As of September 1, 2008, the complementary and supplementary fees will increase from 73 Swiss francs to 100 Swiss francs. See also footnote 8.

Renewal		
Fees	Complementary and supplementary fees	Complementary and supplementary fees ¹¹ No individual fees for Contracting Parties that have made the declaration under Article 8(7) of the Protocol
Notifications of provisional refusal and of other communications		
Language	French	English, French, Spanish, in respect of designations dated as from September 1, 2008 ¹²

ADDITIONAL COMMENTS

International Applications

Forms to be Used

9. In most instances, international applications presented to an Office, as the Office of origin, will have to be on form MM2 or MM3. The circumstances in which the MM1 form (international application governed exclusively by the Agreement) will have to be used will become truly exceptional.

New treatment of international applications with reference to Rule 11

10. *Premature Request (Rule 11(1)(a))*. Where the Office of origin receives, *prior* to September 1, 2008, a request to present an international application containing designations governed exclusively by the Agreement and based on an application, that Office may wish to deem the request as received on September 1, 2008, as on that date such request will no longer be “premature”, under Rule 11(1)(a) (provided, of course, that the international application does not contain a designation of a Contracting Party bound exclusively by the Agreement).

¹¹ See footnote 10.

¹² For designations bearing an earlier date, see explanation in paragraph 16.

11. *Rule 11(1)(b)*. Where the Office of origin receives, *prior* to September 1, 2008, a request to present an international application containing designations governed by the Agreement and, at the same time, designations governed by the Protocol, and based on an application, that Office may, instead of deleting the designations governed by the Agreement, as provided for by Rule 11(1)(b), retain such designations, wait until September 1, 2008, and deem the international application as received on September 1, 2008.

12. *Rule 11(1)(c)*. Where the Office of origin receives, *prior* to September 1, 2008, an international application accompanied by an express request by the applicant under Rule 11(1)(c) and, by August 31, 2008, the basic mark has not yet been registered in its Register, that Office may, on or after September 1, 2008, disregard such request, deem the international application as having been received on September 1, 2008, and submit the international application to the International Bureau.

Languages

Trilingual regime

13. From September 1, 2008, Offices will have the option to elect to use any of the three languages regardless of the treaty or the treaties governing the international application.

Transitional Situation

14. Where the Office of origin receives a request to present an international application submitted in English or Spanish, where it should have been submitted in French, that Office may consider waiting until September 1, 2008, to process such request, instead of asking the applicant to resubmit the international application in French.

15. Rule 40(4), as in force from September 1, 2008, maintains the imposition of French as the sole working language in respect of an international registration resulting from an international application governed exclusively by the Agreement and filed before September 1, 2008, unless and until that international registration has moved to the trilingual regime, following the recording of a subsequent designation in the International Register. Therefore, Offices of designated Contracting Parties that would wish, in respect of any such international registration, to present a notification of provisional refusal (or another communication) in English or Spanish are advised to first consult ROMARIN to tell if they can do so. If the list of goods and services appears only in French, it means that any communication relating to that international registration at hand must still be presented in French.

How to determine when Article 9*sexies*(1)(b) applies

16. The notifications sent to the Offices of Contracting Parties designated under the Protocol, which have made declarations under Article 5(2)(b) and (c) and Article 8(7) of the Protocol, will clearly identify the designations with respect to which these declarations will not apply, by virtue of Article 9*sexies*(1)(b).

17. A table containing a list of members which, as of April 28, 2008, are Contracting Parties to both the Agreement and the Protocol, to the Agreement only, and to the Protocol only, is annexed.

[Annex follows]

ANNEX

Members of the Madrid Union

Total: 82

Agreement (7)

Algeria
Bosnia and Herzegovina
Egypt
Kazakhstan
Liberia
Sudan
Tajikistan

Protocol (26)

Antigua and Barbuda
Australia
Bahrain
Botswana
Denmark
Estonia
European Community
Finland
Georgia
Greece
Iceland
Ireland
Japan
Lithuania
Madagascar
Norway
Oman
Republic of Korea
Singapore
Sweden
Turkey
Turkmenistan
United Kingdom
United States of America
Uzbekistan
Zambia

Agreement and Protocol (49)

Albania
Armenia
Austria
Azerbaijan
Belarus
Belgium
Bhutan
Bulgaria
China
Croatia
Cuba
Cyprus
Czech Republic
Democratic People's Republic of Korea
France
Germany
Hungary
Iran (Islamic Republic of)
Italy
Kenya
Kyrgyzstan
Latvia
Lesotho
Liechtenstein
Luxembourg
Moldova
Monaco
Mongolia
Montenegro
Morocco
Mozambique
Namibia
Netherlands
Poland
Portugal
Romania
Russian Federation
San Marino
Serbia
Sierra Leone
Slovakia
Slovenia
Spain
Swaziland
Switzerland
Syrian Arab Republic
The former Yugoslav Republic of Macedonia
Ukraine
Viet Nam

April 28, 2008

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