

How trade mark users helped reform the Madrid System

James Nurton, London

The introduction of statements indicating that protection has been granted through the Madrid System marks a victory for trade mark owners. The change was agreed in September 2008, and became mandatory on January 1 2011. But it had been raised by brand owners' representatives as far back as 2005.

After it was discussed in the Working Group on the Madrid System, a number of national delegations recognised the benefits, and support for the change built up over successive meetings.

One of the first organisations to raise the issue formally was MARQUES, the association of European trade mark owners. Tove Graulund (right) was chair at the time and in-house counsel for Danish company Arla Foods. She told *Managing IP* that after Denmark joined the Madrid System in 1996, applicants could choose between national, Community and international protection, which led to some confusion. "The registration in each country might have happened but you didn't know," she says.



For applicants who were not used to what was still a relatively new system, this uncertainty could be a problem, she adds. "Sometimes someone in the business would want to know what protection we had, and you would have to check." Other times, faced with no information, applicants would fear that an application had been lost or was at risk of being refused.

Requiring offices to provide a formal notification that a registration had been granted would therefore benefit both the applicant itself and third parties who want to monitor what rights are protected, Graulund explains.

But, when she attended a Working Group meeting in Geneva in her capacity as MARQUES chair in 2005, she said some member states' representatives did not see what the problem was: "They looked at me as if I'd fallen from the moon."

Ernesto Rubio, who at the time was WIPO Deputy General in charge of trade marks, says that once member states understood the problem support increased. He adds that "some thought it would provide more work for offices" but that they showed a readiness to adapt their procedures, provided there were interim measures.

Meanwhile, organisations such as INTA added their support to the plans and the International Bureau indicated that it was ready to facilitate communications between national offices and mark owners. One of the delegations that most strongly supported the proposal was that of Australia, which was represented by Michael Arblaster. The idea was soon known as the Australian proposal.

It also helped that WIPO was keen at the time to improve the electronic tools, and the statements could be added to the ROMARIN database. This meant, however, that countries would have to be encouraged or mandated to send information to WIPO, to be collected centrally, rather than direct to applicants.

Although it took six years, Graulund says the process is "a good example" of what can happen when different interests work together. "It probably helped that this was a practical not a political issue."

The change in detail

The main changes agreed in 2008 to the Madrid System were to Rule 18 on notifications of provisional refusal. Most importantly, a paragraph in Rule 18^{ter} provides that when "all procedures before an office have been completed and there is no ground for that office to refuse protection" the office shall, as soon as possible and before the expiry of the applicable refusal period, send the International Bureau a statement saying that protection is granted.

Rule 18^{ter} also says that where an office sends a notice of provisional refusal, it should send the International Bureau

information on which goods and services the mark is protected for, or a statement saying it concerns all goods and services.

Rule 18*bis* says that where there are opposition procedures an office may send "a statement to the effect that the *ex officio* examination has been completed and that the Office has found no grounds for refusal but that the protection of the mark is still subject to opposition or observations by third parties, with an indication of the date by which such oppositions or observations may be filed".

Since the rule changes were agreed by the Madrid Union, offices have been encouraged to communicate information on applications officially to the International Bureau. Ernesto Rubio said many countries have already started to do that, ahead of the January 1 deadline. Some of them have done so by sending regular lists of non-refused marks electronically.

WIPO then processes this information, which is published in the ROMARIN database. This means it is accessible to third parties as well as to the mark owners. Rubio said he is "optimistic" that all Madrid members will comply with the new rules. "They should be prepared," he said. "But if there are any difficulties we will work closely with them." The Madrid Protocol has 83 contracting parties.

