

**Report
of the Ad Hoc Conference of Directors
of the National Industrial Property Offices
of the Madrid Union (Trademarks)**

(Geneva, December 13 and 14, 1966)

and

**General Report
of the Session of the Committee of Directors
of the National Industrial Property Offices
of the Madrid Union (Trademarks)**

(Geneva, December 15 and 16, 1966)



**United International Bureaux
for the Protection of Intellectual Property (BIRPI)
GENEVA 1967**

E 224:160

DE LA
FUCH ET PROTECTION DE LA
PROPRIÉTÉ INTELLECTUELLE
BIBLIOTHÈQUE

Madrid Union
Ad Hoc Conference of Directors
of the National Industrial Property Offices
of the Madrid Union (Trademarks)

(Geneva, December 13 and 14, 1966)

Report

1. The Ad Hoc Conference of Directors of National Industrial Property Offices of Member countries of the Madrid Union met in Geneva, on December 13 and 14, 1966.

2. The participants at the session of the Ad Hoc Conference were the same as those who participated in the meeting of the Committee of Directors of National Industrial Property Offices of the Separate Madrid Union, which met in Geneva on December 15 and 16, 1966. The list of participants is annexed to the General Report of the Committee.

3. At its first session, the Ad Hoc Conference elected as Chairman, Mr. F. Savignon (France), and as Vice-Chairmen, Mr. K. Haertel (Federal Republic of Germany) and Mr. V. Savić (Yugoslavia).

4. The Ad Hoc Conference, in preparing the first meeting of the Committee, discussed certain amendments to the draft Transitional Regulations of the Madrid Agreement, the draft Internal Rules of Procedure of the Committee, and certain questions of a legal or administrative nature on which BIRPI requested advice. The results of the debates are recorded in the General Report of the Committee and in its annexes.

5. The Ad Hoc Conference unanimously decided that, should the surplus receipts for the financial year 1966, in respect of the Madrid Union, exceed 220,500 Swiss francs, (a) the

application of its decision of November 1963 (quoted in paragraph 1 of Document MJ/DO/VIII/4) would be suspended; (b) that the same sum would be distributed for 1966 as was distributed for 1965; (c) that the balance of the surplus receipts for the year 1966 would be paid into the reserve fund of the Madrid Union.

6. *This report was unanimously adopted by the Ad Hoc Conference.*

Committee of Directors of the National Industrial Property Offices of the Madrid Union (Trademarks)

(Geneva, December 15 and 16, 1966)

General Report

Introduction

1. The Committee of Directors of National Industrial Property Offices of the Separate Madrid Union, set up under Article 10 of the Madrid Agreement, as revised at Nice on June 15, 1957, and which came into force on December 15, 1966, met for the first time on December 15 and 16, 1966, at the Headquarters of BIRPI, in Geneva.

2. The Industrial Property Offices of the following countries, Members of the Separate Madrid Union, were represented: Austria, Belgium, Czechoslovakia, France, Federal Republic of Germany, Hungary, Italy, Luxembourg, Monaco, Netherlands, Portugal, Rumania, San Marino, Spain, Switzerland, Yugoslavia.

3. The Industrial Property Offices of the following countries, Members of the Paris Union but not members of the Separate Madrid Union, were represented by observers: Algeria, Norway, Poland, United States of America.

4. The African and Malagasy Industrial Property Office (OAMPI) was also represented by an observer.

5. The list of participants is annexed to this General Report (Annex I).

6. The session was opened by Professor G. H. C. Bodenhäusen, Director of BIRPI.

7. The Committee elected as Chairman by acclamation Mr. François Savignon (France), and, as Vice-Chairmen, Messrs.

Kurt Haertel (Federal Republic of Germany) and Vladimir Savić (Yugoslavia).

8. Professor Bodenhausen, Director of BIRPI, appointed Deputy Director Ch.-L. Magnin as Secretary of the Committee.

Internal Rules of Procedure

9. The Committee unanimously adopted its Internal Rules of Procedure, the text of which is reproduced in an Annex¹⁾.

Transitional Regulations for Implementing the Madrid Agreement

10. By way of amendment to the Transitional Regulations, the Committee unanimously decided to adopt the text according to the decision contained in Annex II. The Austrian delegation abstained from voting.

11. Before adopting the Regulations, the Committee rejected, by a majority vote, a proposal designed to insert in the Regulations, the following text as a second paragraph to Article 31: “ (2) Within the limits provided for by Articles 3 (4) and 8 (3) of the Nice Act and by the provisions of these Regulations, a registration may bear a date prior to December 15, 1966, if the application for registration has reached BIRPI on or after that date.”

Reserve Fund

12. The Committee unanimously confirmed the decision taken by the Ad Hoc Conference of Directors, at its session of December 13 and 14, 1966, providing that if the surplus receipts for the financial year 1966, in respect of the Madrid Union, exceeds 220,500 Swiss francs, (a) the application of its decision of November 1963 (quoted in paragraph 1 of Document MJ/DO/VII/4) would be suspended; (b) that the same sum would be distributed for 1966 as was distributed for 1965; (c) the balance of the surplus receipts for the year 1966 would be paid into the reserve fund of the Madrid Union.

13. The Austrian delegation abstained from voting.

¹⁾ Omitted. (*Ed.*)

Opinion Relating to Certain Provisions of the Nice Act

14. The Committee expressed its opinion on certain questions of a legal and administrative nature relating to certain provisions of the Nice Act. The Committee agreed with the opinion expressed by BIRPI in Documents MJ/DO/VIII/7 and 9¹).

15. With regard to Document MJ/DO/VIII/6, the Committee was of the opinion that when an international registra-

1) Text of Document MJ/DO/VIII/7; -

NOTE

concerning the validity in the country of the assignee of an international registration previously recorded in the name of an assignor established in another country

1. BIRPI has been asked whether, in the event of a transfer of an international registration by an assignor established in one country to an assignee established in another country, the international registration would be valid in the country of the assignee, under the Nice Act of the Madrid Agreement.

2. This question did not arise under the London Act.

3. In effect, although under both the London Act and, for that matter, the Nice Act, an international registration is not valid in the country of origin, under the London Act the country of origin changed when an international registration was transferred by an assignor established in one country to an assignee established in another country. In this case, the country of the assignee became the new country of origin and, as a result, the international registration was no longer valid there after its transfer. The mark which was the subject of the transferred international registration had to be protected in the new country of origin by means of a national registration intended to serve as a basis for the international registration transferred to the name of the assignee.

4. On the other hand, under the Nice Act, in the case of a transfer of an international registration, the country of origin never changes but remains that of the assignor, that is to say, the country where the national registration which served as a basis for the first international registration of the mark was effected. It is therefore in the country of the assignor, which remains the sole country of origin, that the international registration is not valid. It will, on the other hand, be valid in the country of the assignee which, under the Nice Act, is not a new country of origin and which the Act calls the country of the person in whose name the international registration stands, or the country of the proprietor.

5. Such will be the position during the period of five years fixed by Article 6 of the Nice Act, during which an international registration will be dependent on the national registration in the country of origin. This position will continue on the expiration of the period of five years, because although, after its expiration, the country of origin will cease to have any effect as far as the validity of the international registration in the hands of the assignee is concerned, it will nevertheless remain the sole country of origin and, consequently, the only country where the international registration is not valid.

tion was transferred by an assignor established in one country to an assignee established in another country, the period of five years during which, under Articles 9^{bis} and 9^{ter}, BIRPI shall seek the consent of the Administration of the country of the new owner, should be calculated in the following manner:

- (a) for international registrations effected prior to December 15, 1966, date on which the Nice Act came into force, the period would be calculated as from that date;
- (b) for registrations effected after December 15, 1966, the period would be calculated as from the date of such registrations.

Text of Document MJ/DO/VIII/9:

NOTE

concerning the effect of Article 9^{quater} of the Nice Act on the application of Article 8 (4), (5) and (6)

1. Article 9^{quater} of the Nice Act of the Madrid Agreement contains the following provisions:

"If several countries of the Special Union agree to effect the unification of their domestic laws relating to marks, they may notify the Government of the Swiss Confederation:

- (a) that a common Administration is substituted for the national Administration of each of them, and
- (b) that the whole of their respective territories must be considered as a single country for the purposes of the application of all or part of this Agreement.

2. BIRPI has been asked whether, in the event of the accession to the Madrid Agreement of the twelve member countries of the African and Malagasy Industrial Property Office (OAMPI) which severally pay their contributions towards the expenses of BIRPI, pursuant to Article 13 of the Paris Convention, these countries would each be entitled to receive a share in the distribution of receipts from the international registration of marks, according to the provisions of Article 8 (4), (5) and (6) of the Nice Act, or whether, on the contrary, under the provisions of Article 9^{quater} of the Act, they would be entitled, as a whole, to only a single share of the receipts referred to in the above-mentioned paragraphs of Article 8.

3. It is to be noted in this connection that Article 9^{quater} does not impose any obligation on countries which have effected the unification of their domestic laws relating to marks. It simply offers them a possibility, namely, that of addressing to the Government of the Swiss Confederation a notification in two mutually independent parts.

4. They may notify the Government of the Swiss Confederation that a common Administration is substituted for the national Administration of each of them, and they may also add, if they so wish, that the whole of their respective territories must be considered as a single country for the purposes of the application of all or part of the Madrid Agreement.

5. Several courses are thus open to the OAMPI countries:

- (1) they may not address any notification to the Swiss Government;

16. The Committee was also of the opinion that this consent should be sought even after the expiration of this period, as long as a country, party to the Agreement, had not acceded to the Nice Act, in order to prevent the validity of the transfer being contested in that country, for which the consent of the new country of "origin" would still be required, in accordance with the London Act.

17. It was understood that the question of the interpretation of the provisions of Article 6 (2) of the Agreement should remain within the competence of the courts of each Member country.

Recommendation

18. With regard to the problem contained in Document MJ/DO/VIII/8 and 12, the Committee, on a proposal made by

-
- (2) they may notify the Swiss Government that a common Administration is substituted for the national Administration of each of them;
 - (3) they may notify the Swiss Government that the whole of their respective territories must be considered as a single country for the purposes of the application of part of the Madrid Agreement, which part they may choose as they wish;
 - (4) they may notify the Swiss Government that the whole of their respective territories must be considered as a single country for the purposes of the application of all of the Madrid Agreement.

6. From the foregoing it follows that:

- (a) if no notification is addressed to the Swiss Government, each OAMPI country will receive its share of the returns from the international registration of marks (case No. 1);
- (b) the situation will be the same if only the notification provided for under (2) is addressed to the Swiss Government; the sole consequence of this notification will then be that all administrative communications of BIRPI will have to be addressed to the common Administration;
- (c) the situation will also be the same in the case of the notification provided for under (3), if the countries notify that the whole of their respective territories must be considered as a single country for the purposes of that part only of the Agreement which does not concern the distribution of receipts from international registration;
- (d) lastly, in the case provided for under (4), the OAMPI countries as a whole would receive only a single share in the distribution of receipts from the international registration of marks.

7. It may therefore be concluded from the foregoing that if the OAMPI countries contemplated acceding to the Madrid Agreement it would be possible, if they so wished, for each of them to receive its share in the distribution of receipts from the international registration of marks, just as each of them shares in the expenses of BIRPI, pursuant to Article 13 of the Paris Convention.

the French Delegation, unanimously adopted the following Recommendation:

“ Where the date — as indicated in the application for international registration referred to in Article 2 (2) (*k*) of the Regulations — on which the application for international registration is received by the Administration of the country of origin is prior to December 15, 1966, the international registration shall bear the date on which BIRPI received the application for registration.

“ The date of reception of this application by the national Administration shall be recorded for information in the international register and shall be mentioned in *Les Marques internationales*.”

Possible Revision of the Nice Act

19. On a proposal made by Mr. Hoffmann (Luxembourg), and supported by Mr. Labry (France), the Committee requested the Director of BIRPI to study the advisability of revising the Nice Act at the next Conference of Vienna if the Austrian Authorities agreed. The results of this study would be submitted to the Committee, which, if necessary, could meet for this purpose in extraordinary session.

20. *This General Report was unanimously adopted by the Committee on December 16, 1966.*

ANNEX I

List of Participants

I. States Members of the Madrid Union

Austria

Mr. Gottfried Thaler, President of the Patent Office, Vienna.
Dr. Thomas Lorenz, Ratssekretär, Patent Office, Vienna.

Belgium

Mr. A. Schurmans, Director of the Industrial Property Service,
Brussels.

Czechoslovakia

Dr. Miloslav Špunda, Head of the Trademarks Department, Office of
Patents and Inventions, Prague.

**Dr. Vladimír Šulc, Head of the International Trademarks Section,
Office of Patents and Inventions, Prague.**

France

Mr. François Savignon, Director of the National Institute of Industrial Property, Paris.

Mr. Roger Labry, Counsellor of Embassy, Ministry of Foreign Affairs, Directorate of Economic and Financial Affairs, Paris.

Mr. Maurice Bierry, Civil Administrator in the Ministry of Industry, Paris.

Germany (Fed. Rep.)

Dr. Kurt Haertel, President, Patent Office, Munich.

Dr. Romuald Singer, Senatsrat, Federal Patent Tribunal, Munich.

Mr. Willy Miosga, Regierungsdirektor, Patent Office, Munich.

Mr. Peter Schönfeld, First Secretary, Permanent Delegation of the Federal Republic of Germany, Geneva.

Hungary

Mr. Emil Tasnádi, President, National Office of Inventions, Budapest.

Dr. Georges Pálos, Legal Advisor, National Office of Inventions, Budapest.

Italy

Mr. Aldo Pelizza, Inspector-General, Ministry of Industry, Patent Office, Rome.

Luxembourg

Mr. Jean-Pierre Hoffmann, Head of the Industrial Property Service, Luxembourg.

Monaco

Mr. Jean-Marie Notari, Director of the Industrial Property Service, Monaco.

Netherlands

Mr. Enno Van Weel, Member of the Patent Council, The Hague.

Mr. A. M. de Geus, Assistant Chief of the Trademarks Section, Industrial Property Office, The Hague.

Portugal

Mr. Ruy Serrão, Director of the Industrial Property Office, Lisbon.

Rumania

Mr. Nicolai Gheorghiu, Director-General, National Office of Inventions, Bucharest.

Mr. Costel Mitran, Second Secretary, Permanent Mission of Rumania, Geneva.

San Marino

Mr. Jean Charles Munger, Chancellor, Permanent Delegation of the Republic of San Marino to the United Nations Office, Geneva.

Spain

Mr. Antonio Fernandez Mazarambroz y Martin-Rabadán, Director of the Industrial Property Registration Office, Madrid.

Switzerland

Mr. Joseph Voyame, Director of the Federal Office of Intellectual Property, Berne.

Mr. Paul Braendli, Federal Office of Intellectual Property, Berne.

Yugoslavia

Mr. Vladimir Savić, Director, Patent Office, Belgrade.

II. Observers

Algeria

Mr. Azzedine Bendiah, Head of the Industrial Property Division, National Industrial Property Office, Algiers.

Mr. Salah Bouzidi, Head of the Trademarks Office, National Industrial Property Office, Algiers.

Norway

Mr. Roald Røed, Assistant Comptroller, Patent Office, Oslo.

Poland

Mr. Jan Dalewski, Head of the Legal Section, Patent Office, Warsaw.

United States of America

Mr. David B. Allen, Acting Director, Office of International Patent and Trademark Affairs, U. S. Patent Office, Washington, D. C.

African and Malagasy Industrial Property Office (OAMPI)

Mr. Richard Raparson, Chief of the Patent Service, African and Malagasy Industrial Property Office, Yaoundé.

III. BIRPI

Professor G. H. C. Bodenhause, Director.

Dr. Arpad Bogsch, Deputy Director.

Mr. Ch.-L. Magnin, Deputy Director.

Mr. L. Egger, Counsellor.

Mr. E. Margot, Head of the Registration Service (Marks).

IV. Bureau of the Committee

Chairman: Mr. François Savignon (France).
Vice-Chairmen: Dr. Kurt Haertel (Federal Republic of Germany).
Mr. Vladimir Savić (Yugoslavia).
Secretary: Mr. Ch.-L. Magnin (BIRPI).

ANNEX II

Decision relating to the Transitional Regulations

The Committee of Directors of the National Industrial Property Offices of the Madrid Union concerning the international registration of trademarks, within the framework of which, under Article 30 (1) of the Transitional Regulations, the Directors of National Industrial Property Offices of countries in respect of which the Nice Act has not yet come into force, also participate,

Considering that the Regulations, of December 16, 1966, came into force at the beginning of that day,

Desiring to amend the Regulations on certain points,

Unanimously decides, by way of amendment of the said Regulations, to establish the text as contained in the document annexed to this decision.

Annex to the Decision Relating to the Transitional Regulations

Subject to the modifications indicated hereafter, the Transitional Regulations are those reproduced in the *Guide du déposant* (Provisional edition of June 1, 1966), pp. 75 to 95¹⁾.

Article 20

Entry in the Register

(1) [no change]

(2) Nevertheless, renewals for which the application has been transmitted by the Administration of a country party to the Nice Act shall be entered in respect of all the countries to which they apply, on the date provided for by the said Act.

¹⁾ The Transitional Regulations as reproduced in the *Guide du déposant* (provisional edition of June 1, 1966) were published in the June 1966 issue of *Industrial Property*, pages 131 to 140. (Ed.)

Article 28

Fees and Other Charges

(1) to (10) [no change] *

(11) The fee for entry in the International Register of a change made to the entry of a mark in the national register and which also affects the international registration [Article 9 of the Agreement; Article 22 (1) of these Regulations], and the fee for entry of a transfer or assignment of an international mark (Article 9^{bis} and 9^{ter} of the Agreement; Article 21 of these Regulations) is 40 francs per entry and per mark; figures (8), (9), (12) and (13) of this article are reserved.

(12) to (21) [no change]

CHAPTER X

Distribution of Certain Fees and Surplus Receipts

Article 29

Distribution of Certain Fees and Surplus Receipts

(1) The coefficient referred to in Article 8 (5) of the Agreement shall be three ²⁾.

(2) (a) Any surplus receipts from the Registration Service shall be divided equally among the member countries of the Separate Union; however, the share of any country which is not bound on July 1 of the financial year by the Nice Act shall be reduced by 25 per cent and the total of the amounts thus deducted shall be distributed equally among the countries which, on the said date, are bound by the Nice Act.

(b) The provisions of the preceding sub-paragraph shall be put into effect for the financial year 1967; any surplus receipts from the financial year 1966 shall be distributed equally among the member countries of the Separate Union.

Article 31

[Paragraph (2) is suppressed]

²⁾ The following nine countries are "countries which make a preliminary examination" for the application of Article 8 (5) of the Nice Act: Austria, Czechoslovakia, Federal Republic of Germany, Hungary, Netherlands, Portugal, Spain, United Arab Republic, Yugoslavia.