

Sarah Matheson
Reporter General

By e-mail

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Re Madrid Consultation Group - Request for Feedback

Dear Anna

You have asked us for our input on two proposals.

I. Recordal of a change in the legal nature of the holder

The first one pertains to the recordal of a change in the legal nature of the holder (not resulting in a change of owner) in the International Register.

AIPPI's Standing Committee on Trademarks and the AIPPI Bureau (hereinafter AIPPI) agree that it should be possible to update this information and record a change of the legal nature of the holder in the international Register.

AIPPI considers that there should be a procedure to record a change in legal nature and also to provide information of the legal nature if it is missing or is not accurate. AIPPI agrees that the recordal be voluntary, by simple letter (in the absence of a specific form) and free of charge.

AIPPI therefore approves the new practice you have proposed and would only suggest the following modifications (outlined in the text in blue) in order to allow to also record information on the legal nature when it is missing or is not accurate (and not only when it needs to be changed) and for any reason (even if it is not to avoid a provisional refusal).

New practice: Updating the legal nature of the holder

The International Bureau is considering implementing the following change in its practice.

The information concerning a change in the legal nature of the holder should not be seen as information involving a change to the mark itself or to the international registration as such. The omission of information of the legal nature would not lead to an irregularity in the examination undertaken by the International Bureau. Where the legal nature has changed or where information of the legal nature is missing or is not accurate, the holder should be able to update this information voluntarily, in particular to avoid a provisional refusal in a designated Contracting Party. By

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allowing such update, the holder would ensure that the International Register accurately reflects the particulars of the holder.

The holder (or his representative) may send a simple letter to the International Bureau informing of this change or providing this information, in the absence of a specific procedure in the Common Regulations. Forms MM5 or MM9 should not be used for this purpose. When the International Bureau receives such information, it should update the corresponding entry in the International Register, free of charge, publish the new information and inform the Offices of the designated Contracting Parties, who may take note of this update.

AIPPI would be happy to provide its views in the event the International Bureau decides to introduce in the Common Regulations a specific procedure to record the change of the legal nature of the holder.

II. Recordal of a declaration that a change in ownership has no effect

The second pertains to the recording of a declaration that a change in ownership has no effect, in accordance with the procedures set out in Rule 27(4) of the Common Regulations.

AIPPI considers that the International Bureau should record any declaration received that a change of ownership has no effect on a designated party, inform both the transferor and the transferee and record the part affected by the declaration as a new international registration (even if such declaration is not final).

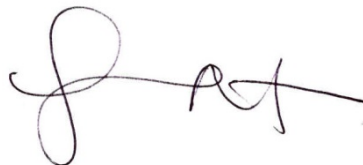
Indeed, AIPPI considers that even when the declaration of refusal is not final, the transferor should be put in a position that allows it to manage and maintain the international registration until a final decision is made. The change proposed by WIPO allows the transferor to continue to manage and maintain the international registration until a final decision is made, so that transferor and/or transferee do not lose rights in the international registration in this. Furthermore, it is consistent with Rule 27 (4) of the Common Regulations.

As a result, AIPPI agrees with your proposed change of practice.

Yours sincerely



Eléonore Gaspar
Chair of the Standing Committee on
Trademarks



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