

Study Note: This module should take around 6 hours to study. If you have less time, you could conveniently break your study just before the section on PCT, which is about halfway through the module.

Module 8: WIPO Administered Treaties on International Registration Systems and the PCT

Trademarks, Industrial Designs and Patents

Objectives

After completing the study of this module you should be able to:

1. List the systems of international registration administered by WIPO.
2. Draw a diagram explaining the process how an applicant can use the Madrid system to get protection for a trademark in different countries.
3. Describe the role of the WIPO International Bureau in the trademark registration process.
4. Explain what happens if the TM is refused in the home country after the international registration of the mark.
5. State how long a trademark can be protected for.
6. List the benefits of protecting an industrial design internationally.
7. Explain the process of International protection offered to industrial design by the Hague Agreement.
8. Explain in 100 words the purpose of the Patent Cooperation Treaty (PCT).
9. Describe in around 200 words the benefits of the PCT.
10. Draw a diagram of the process involved in using the PCT.
11. Explain in 200 words the role of WIPO in the PCT.

Introduction

Amongst the many roles that WIPO carries out to support the worldwide promotion of intellectual property rights, is its role in the administration of specific treaties and conventions. The international protection for trademarks, industrial designs and appellations of origin is carried out through three registration systems: The Madrid System for trademarks, the Hague System for industrial designs, and the Lisbon Agreement for the protection of appellations of origin. The first part of this module will focus on the role of WIPO in the administration of protection systems for trademarks and industrial designs.

The second part of this module will deal with the Patent Cooperation Treaty (PCT). This is the leading treaty administered by WIPO, in terms of generated revenue, which facilitates the application for patents in different countries.

This module starts with a description of the international registration systems.

Registration Systems

First, listen to the following audio segment.

Audio Segment 1: *How many different systems of international registration does WIPO oversee?*

There are actually three systems. There is what is known as the Madrid system, which is for the international registration of trademarks and is governed by two treaties which complement each other. They are the **Madrid Agreement and the Madrid Protocol**. Then there is the system of international registration or more correctly international deposit of industrial designs, which is governed by the **Hague Agreement**. The third is the system of international registration of appellations of origin, under the **Lisbon Agreement**. The last-mentioned, however, does not really affect private owners of industrial property rights, as appellations are registered at the request of governments (this module does not cover this Agreement). As a result, most of WIPO's activities have to do with the protection of trademarks and industrial designs and patents through international registration.

[N.B: The transcription of this audio segment has been updated]

Self-Assessment Question (SAQ)

- SAQ 1:**
- a) What are the following international intellectual property systems concerned with: the Hague System, the Madrid System and the Lisbon System?**
 - b) What two treaties form the Madrid System?**

Type your answer here:

[Click here for answer](#)

SAQ 1 Answer:

a) The Hague System covers the deposit of industrial designs, the Madrid System the registration of trademarks and the Lisbon Agreement concerns the registration of appellations of origin.

b) The two treaties in the Madrid System are the Madrid Agreement concerning the International Registration of Marks (1891) and the Madrid Protocol relating to the Madrid Agreement (1989).

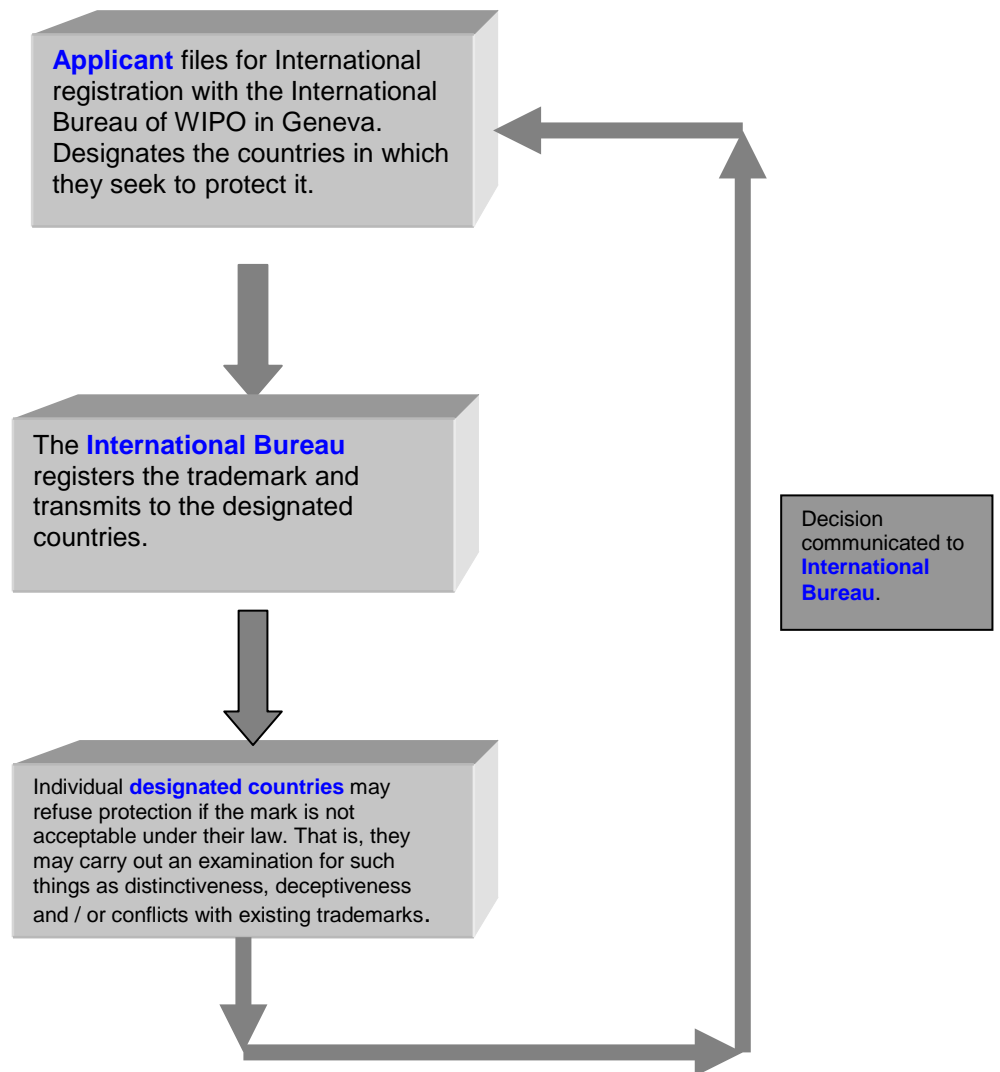
The Madrid System: International Registration of Trademarks

Now listen to the next audio to hear how the Madrid System assists the protection of trademarks internationally.

Audio Segment 2: *Can an applicant obtain an international trademark from the Madrid System?*

To answer that question, I should first explain how the international system for the registration of trademarks works. Somebody files an international application with the International Bureau of WIPO in Geneva, and in it they designate the countries that are party to the treaties in which they want the mark to be protected. We register the mark and then pass it on to the countries that have been designated, which then have the possibility of refusing protection. They would normally examine it as though it were an application filed with them directly and apply their normal national criteria accordingly. If they refuse it, the refusal is notified to us and entered against the mark for that country in the International Register. So in other words a person does secure international registration, but whether or not it is protected in a given country is determined by that country.

Figure 1 describes the process of international registration for trademarks.



Listen to the next audio to learn more about the role of the International Bureau of WIPO. [Please click here for the list of countries party to the Madrid Agreement and Protocol.](#)

Audio Segment 3: *So the International Bureau has the role of receiving international applications and then passing them on to the designated countries. Does it actually do any examination of the trademarks?*

It doesn't examine as to substance. There are basically two substantive questions which are investigated by national offices. One is whether the mark is capable of functioning as a trademark, in other words whether it is capable of distinguishing goods and services, and the other is whether it conflicts with a mark already protected in someone else's name. And countries do actually differ very much in their approach to this examination. Some conduct a full examination and some do not. The International Bureau doesn't do any examination of these substantive aspects, but rather leaves them entirely to the laws of the countries concerned. It does however examine first of all whether the application complies with the formal requirements set forth in the treaties and regulations, mainly to make sure that the necessary elements of a trademark application are there. It also carries out an examination of the lists of protected goods and services that has to accompany any trademark application. Those goods and services should be classified according to an international classification, known as the Nice Classification, and the International Bureau has general responsibility for the consistent application of the Classification. So the International Bureau does conduct an examination as to form and an examination of the classification of goods and services, which means that those tasks do not have to be carried out by the Receiving Offices, because they know that they are receiving properly filed and properly classified applications.

So the role of the International Bureau of WIPO is to receive applications for the protection of trademarks in a number of designated countries. WIPO checks to see if the application has been made in a correct manner and, if so, registers the mark, and forwards it to the designated countries. Examination as to substance may be done in the designated countries if their laws so prescribe.

Now listen to the next two audio segments to learn the importance of obtaining protection in the 'home country' of the applicant.

Audio Segment 4: *Under the Madrid system, is it necessary for a person to register his trademark in, say, his home country before he can file an international application?*

Yes, this is a fundamental requirement of the international system of registration. When the system started, over a hundred years ago, it was really intended to be a means of extending the protection provided by a domestic registration to the other countries of the Madrid Union. The system has become rather more sophisticated and more complex since then, but the principle continues that you must in the first instance, either have a registration in your country of origin or, if the international application is made exclusively under the Protocol, at least have filed an application for registration in your home country.

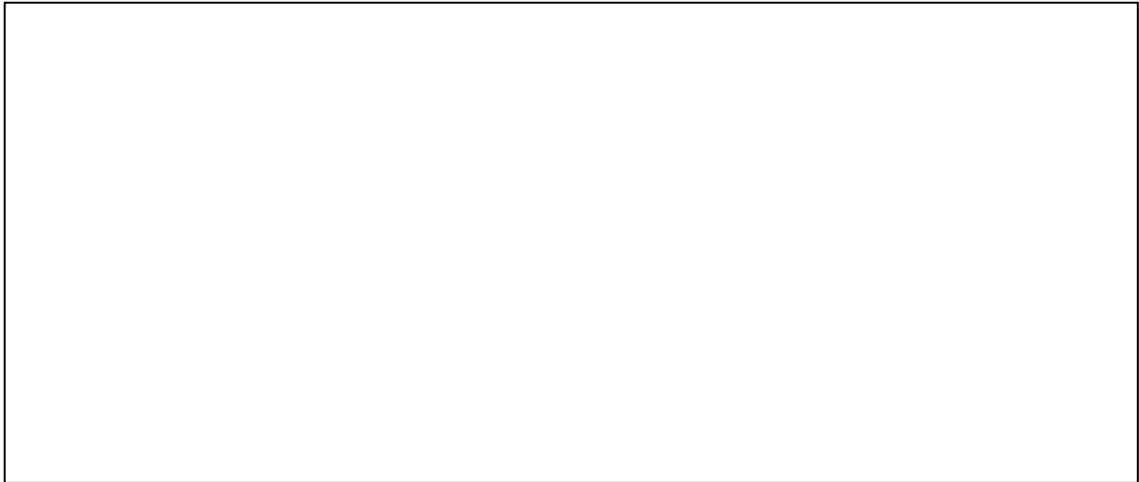
Audio Segment 5: *You use the international system by applying for a Madrid registration, but after you have filed your international application, the national one is refused. What happens in that situation?*

If the national application is refused, that will of course have the corresponding effect on the international registration. There is a dependent relationship between the national protection and the international protection for a period of five years. But in the case that you mention, where the national application is refused, presumably very soon after the international registration is applied for and therefore, within the five-year period, this would result in the international registration being cancelled. If the refusal at the national level is only partial, then the cancellation would be correspondingly partial.

Self-Assessment Question (SAQ)

SAQ 2: Imagine that you have registered a trademark in your home country and then obtained an international registration having effect in a series of other countries, including Kenya. One year after filing your international application you learn that your home country has cancelled the registration of your trademark. Do you still have protection in Kenya via the Madrid system?

Type your answer here:



[Click here for answer](#)

SAQ 2 Answer:

The answer is no, if the basic registration ceases to exist for any reason (cancellation ex officio, or at the request of a third party, or non-renewal) during the first five years of the lifetime of the international registration, this effect leads through to the international registration. This is also the case where the international registration was based on an application in the home country and that application is refused within that period. However, after the expiry of this five-year period, the international registration becomes independent of the trademark in the home country, and continues to be effective even if the home country registration is cancelled.

To find out the duration for which a trademark can be protected internationally, listen to the audio.

Audio Segment 6: *How long can you protect a trademark for?*

You can actually protect it indefinitely, but in the international system and indeed in national systems too you have to renew it from time to time. An international registration is renewed by paying the fees again every ten years, and I think ten years is becoming a standard term at the national level, but, as I say, there is no limit to the number of times that it can be renewed.

So the Madrid system is a useful way in which users of trademarks can apply for protection in a number of countries at the same time. However, the decision whether or not to refuse protection to a particular trademark in a particular country depends on the national system concerned. If protection is not refused, it can be extended indefinitely.

The system of international registration of marks offers several advantages for trademark owners. After registering the mark, or filing an application for registration, with the Office of origin, a trademark owner has only to file one application, in one language, to one office, and pay fees to one office. This is done instead of filing separate applications in trademark Offices in various countries, in different languages, and instead of paying a separate fee in each Office. Similar advantages exist when the registration has to be renewed or modified.

The Hague System: International Protection of Industrial Designs

As mentioned in the introduction to this module, the Hague System of protection deals with the international protection of industrial designs.”

Can you get worldwide protection for an Industrial Design?

As a general rule, industrial design protection is limited to the country where protection is sought and granted. If protection is desired in several countries, separate national applications (or ‘deposits’) must be made and the procedures will normally be different in each country. However the Hague agreement concerning the International Deposit of Industrial Design helps to facilitate this process.

What is the aim of the international deposit of industrial designs?

The main aim of the Hague System is to enable protection to be obtained for one or more industrial designs in a number of countries through a single deposit filed with the International Bureau of WIPO. In other words, the Hague Agreement, which is administered by WIPO, allows nationals and residents of, or companies established in a State party to the agreement, to obtain industrial design protection in a number of countries also party to the agreement through a simple procedure. A single international deposit, in one language (English, French or Spanish), involving a single payment and filed with one office is all that is needed.

The office can be the International Bureau of WIPO or possibly the national office of the contracting State if such State so permits. An international deposit does not require any national deposit.

Once the industrial design is the subject of such an international deposit, it enjoys the protection that would be obtained in each of the countries listed, as if the applicant had applied directly to that country, provided that particular country does not explicitly refuse protection.

As with all intellectual property there are advantages to ensuring its protection and the next audio gives some of the benefits of protecting industrial designs.

What are the advantages of the Hague System?

The system gives the owner of an industrial design the possibility to have his design protected in several countries by simply filing one application with the International Bureau of WIPO, in one language, with one set of fees in one currency (Swiss francs). The Hague system simplifies greatly also the subsequent management of the industrial design, since it is possible to record subsequent changes or to renew the deposit through a simple single procedural step with the International Bureau of WIPO.

Audio Segment 7: *Can you summarize what advantages there are in acquiring industrial design protection?*

Well, as with all industrial property rights, you acquire the exclusive right to the use of the design. In other words, the designer of the new-look corkscrew that I have just described, or the creator of a new furniture style or a new range of fabrics, or garments made out of those fabrics, acquires the exclusive right to make and sell them, in just the same way as a person with a patent has the exclusive right to work that patent.

A patent lasts for a fixed period of time. Is it the same for an industrial design registration?

Yes, it lasts for a fixed period of time, but the length of the period is not yet uniform. I think the shortest period in any country is probably ten years. Periods of 15 and 20 years are common, and the new European Community Directive sets a term of 25 years, so that will become the standard term in the countries in the European Union once the Directive is implemented.

Self-Assessment Question (SAQ)

SAQ 3: What is the lifetime of protection of industrial design afforded by the laws of the European Union? What is the minimum period?

Type your answer here:

[Click here for answer](#)

SAQ 3 Answer:

At present, the period of protection varies from one Member State to another but, once these States have harmonized their laws, it will be set at 25 years.

To complete this section on industrial designs listen to the next audio, which explains how the Hague System operates in this area of intellectual property.

Audio Segment 8: *Is there such a thing as worldwide industrial design protection under the Hague Agreement?*

It's not exactly worldwide, but the grant of international registration does give you protection in a number of countries. It works in the same way as the Madrid system in that you file an international application which is entered in the International Register, published by the International Bureau and notified to the countries concerned, who then have the right to grant or refuse protection. In fact, as far as the Hague Agreement is concerned, there are very few countries that actually examine applications, and consequently very, very few refusals. This is in sharp contrast to the position regarding trademarks.

Another difference between the protection of industrial designs under the Hague Agreement and the protection of marks under the Madrid Agreement and Protocol is that you don't need to start with protection in the country of origin. So for example a designer in France can make an international deposit and through it secure protection in France as well as in Switzerland, Italy, the Benelux countries and Spain, for instance.

SELF-ASSESSMENT QUESTION (SAQ)

So the Hague agreement can help to obtain industrial design protection in many countries at one time.

SAQ 4 : Can protection be obtained in all the countries in the world by means of the Hague Agreement?

Type your answer here:

[Click here for answer](#)

SAQ 4 Answer

No, only in those that are member states of the Agreement. For up to date information see "countries party to the Hague Agreement" on the WIPO web site: <http://www.wipo.int/hague/en>

Partial Summary: The Madrid and Hague Systems of Protection and Registration

So far in this module, you have heard about WIPO's two Agreements regarding the international registration systems for the protection of trademarks and industrial designs. The role of WIPO in this process is to serve as the administrator that provides the international systems of registration, which is to say, by facilitating the application process and publishing a Gazette (Madrid) or Bulletin (Hague) of actions taken within the respective system's procedures.

The Madrid System was created over in 1891 and its purpose is to encourage and facilitate the international registration of trademarks. As an individual wants protection of his trademark, he must first register it in his country of origin. If he wishes to extend that protection into other countries, one available route is provided by the Member States of the Madrid Agreement and / or Protocol. There is a dependency for the first five years, wherein if the trademark is refused *ex officio* or via the opposition of a third party in the country of origin, but had been accepted in the other designated countries, the international protection will be cancelled. After the five-year period passes, the international registrations would survive a home country cancellation. International trademark protection is indefinite; however, it must be renewed every ten years. There is no limit to the number of times a trademark is renewed.



Authorization: SWATCH Group Ltd.

The Hague Agreement created the system of international deposit of industrial designs. It works in the same way as the Madrid system in that you file an international application which is entered in the International Register, published by the International Bureau and notified to the countries concerned, who then have the right to grant or refuse protection. In fact, as far as the Hague Agreement is concerned, there are very few countries that actually examine applications, and consequently, very few refusals. This is in sharp contrast to the position regarding trademarks.

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and through it secure protection in France as well as in Switzerland, Italy, the Benelux countries and Spain, for instance.

The Patent Cooperation Treaty

The national patent system requires the filing of individual patent applications for each country for which patent protection is sought. In other words, the principle of territoriality will apply.

In order to overcome some of these problems, the Patent Cooperation Treaty (PCT) was adopted in 1970. The PCT provides a simplified procedure for an inventor or applicant to apply for, and eventually obtain, patents in a large number of countries.

The PCT has a principal objective: to simplify, make more effective and economical, in the interests of the users of the patent system and the Offices that have the responsibility for administering it, the previous or traditional methods of applying for patent protection for inventions in several countries.

[Please click here for a list of PCT Contracting States](#)

Listen to the audio for a more complete description of the purpose of the PCT.

Audio Segment 9: *Could you explain to me, in general terms, the purpose and objectives of the Patent Cooperation Treaty?*

The Patent Cooperation Treaty is a treaty that provides for the filing of applications with a view to obtaining patent protection in a large number of countries. It provides a simplified procedure for an inventor or applicant to apply for and eventually to obtain a patent. One of its other aims is to promote the exchange of technical information contained in patent documents among the countries concerned and also within the scientific community concerned, that is, the inventors and industry working in the relevant field.

So in addition to simplifying the process of getting patents, it is an aim of the PCT to disseminate more effectively the technical knowledge contained in patent documentation. It is worth stressing however that the PCT system does not provide for the grant of worldwide patents. Hear this explained as the response in this next audio.

Audio Segment 10: *Does that mean that the PCT actually grants a worldwide patent to an applicant?*

No. Two points should be made here. First, it is not the PCT that grants patents; it is in fact the national offices at the end of the process, each of which, as far as it is concerned, grants a patent based on the PCT application. And secondly, there is no such thing as a worldwide patent. The PCT doesn't provide for this at all, and the result of the procedure that I mentioned earlier, will in fact be a number of regional and/or national patents. Maybe there will be only one, if the applicant completes the procedure in only one office, but there could be 10, 25, 50 or as many as the applicant eventually wishes to obtain.

In the next segment the speaker describes the process that occurs when an applicant applies for patent protection in a series of designated countries.

Audio Segment 11: *Could you give a typical example of the procedure that an applicant would go through using the Patent Cooperation Treaty?*

First he would have to file an application with a receiving office, usually in his home country. That application would then pass through several stages. The first general stage, which is called the international phase, includes four main steps: the first is the **filing**, the second is the **international search**, then there is the **international publication** and after that the **international preliminary examination**. I should point out that the last step, examination, is only reached if the applicant expressly asks for it, but in our experience, more than 80 per cent proceed up to this point. So we can really say that in a typical case, a PCT application will pass through all four steps in the international phase. Then, but only if the applicant wishes to go ahead with his application, there is the national phase. There is a national phase for every one of the offices before which the applicant will have to complete the patenting procedure. That could mean either just one, or two or five or ten offices, including both national and regional offices, where the applicant would have designated certain countries, but for the purpose of obtaining a regional patent.

European Patent

As mentioned in this discussion, the second general stage of the PCT procedure is the national phase. In the national phase, the applicant could actually process his or her international application before a national or regional patent Office. The European Patent Office is one such example of a regional Office.

The European Patent Office is established by virtue of the European Patent Convention. Article 2(1) of the European Patent Convention provides that patents granted by virtue of the Convention "shall be called European patents." Article 2(2) further provides that the "European patent shall, in each of the Contracting States for which it is granted, have the effect of and be subject to the same conditions as a national patent granted by that State, unless otherwise provided in this Convention."

[Please click here for a list of EPC Contracting States.](#)

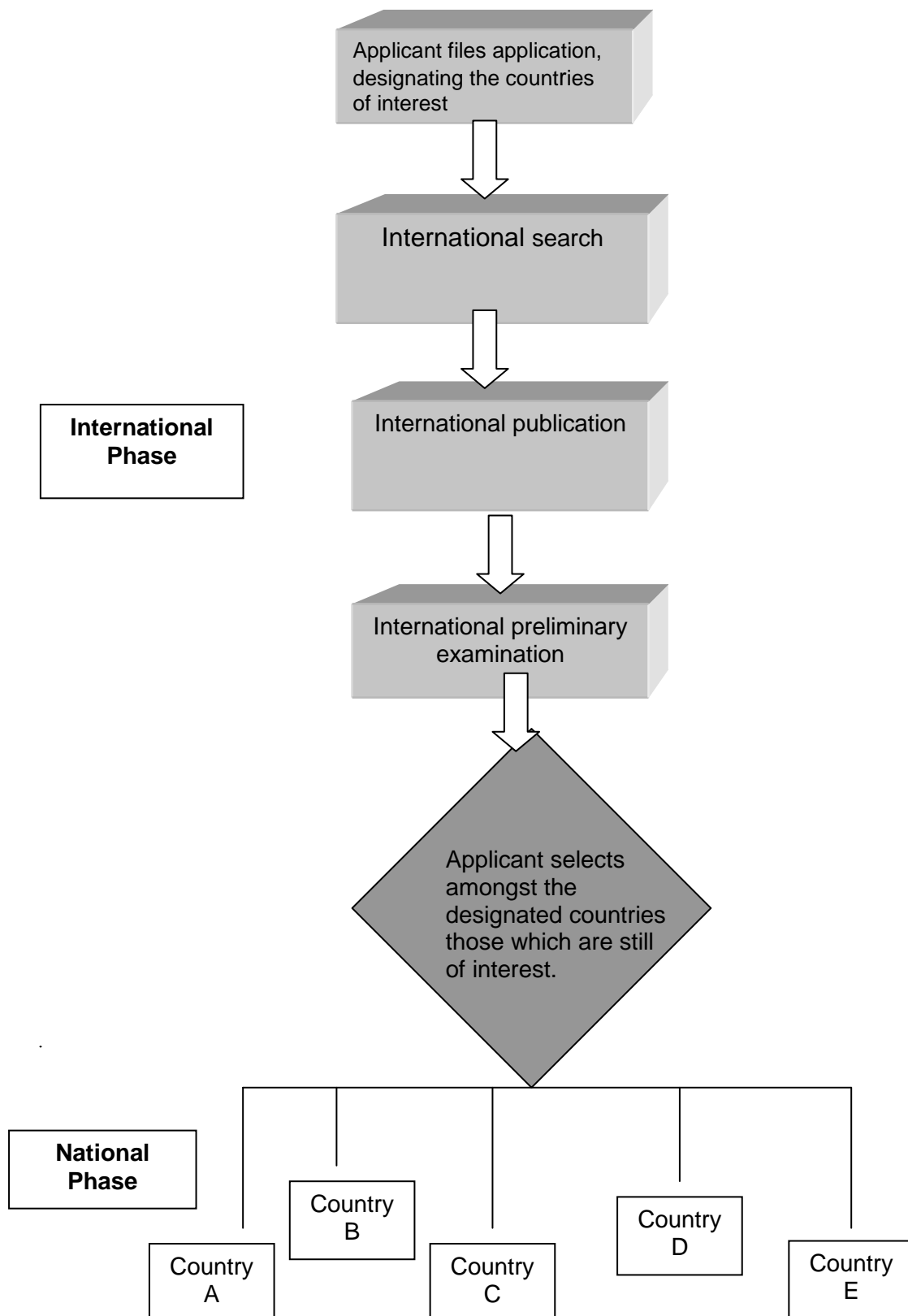
Self-Assessment Question (SAQ)

SAQ 5: Draw a diagram showing the process involved when an applicant uses the PCT.

Type your answer here:

A large, empty rectangular box with a thin black border, intended for the user to draw a diagram showing the process involved when an applicant uses the PCT.

[Click here for answer](#)

SAQ 5 Answer:

So the operation of the PCT requires a sequence of operations and the next audio explains where these take place.

Audio segment 12: *You mentioned three or four steps in the international phase, which involve searches and other things. Where does this actually happen? Is it done in Geneva?*

No. Most of what happens in the PCT process starts somewhere else, and continues somewhere else again. First, the applicant would **file the application** with a so-called receiving Office. That is usually the office in the home country of the applicant. It can however be another national office or a regional office and it can also be the International Bureau in Geneva. So, it can happen that the International Bureau gets involved at this very early stage, but it is not very common.

As for the second step, that is the **international search**, at present there are only **12 (updated to July 2004)** offices specially appointed by the PCT Assembly that are entitled to carry out international searches. These offices, called International Search Authorities, have been selected according to certain criteria, and they render services to applicants under the PCT system, depending, in the case of some of them, on the language in which they work. So they are not all available to all PCT applicants who file PCT applications. For example, the Japanese Patent Office works only in Japanese, so it is not available to applicants who file their applications in English, French, or German. The same is true of the Spanish Patent and Trademark Office, which works only in Spanish. Some other offices on the other hand work in four, five or even six different languages.

The next step, **publication**, is handled entirely by the **International Bureau** in Geneva. This is actually the only PCT function for which WIPO is exclusively responsible. The Organization publishes all PCT applications, wherever they come from and in whatever language they have been filed.

The fourth step is **international preliminary examination**, and for that WIPO would usually go back to the office that carried out the international search. I say usually because applicants can and in some cases do switch to another office, as they are given that amount of flexibility. And at the end of the international phase, or rather when moving into the national phase – and this is something else that the International Bureau is not involved in - the applicant has to approach each of the offices directly and provide the necessary documentation. One could say, however that the International Bureau has some behind-the-scenes involvement in the overall procedure, because it is responsible for making certain documents available to offices, to the applicant and so on, and for communicating certain documents at certain times under the provisions of the Treaty. So, even though the

International Bureau does not actually carry out much of the substantive work, it is nonetheless involved somehow in this phase, whatever happens to the application. It relies on the offices concerned to provide it with the documents, and then acts on them as they come in.

[N.B: The transcription of this audio segment has been updated]

Self-Assessment Question (SAQ)

SAQ 6: Which of the following acts are always performed by the International Bureau in Geneva, which may be carried out by the International Bureau and which are never carried out by the International Bureau?

- a) Receiving patent applications;**
- b) Receiving PCT applications;**
- c) International search;**
- d) International publication;**
- e) International preliminary examination;**
- f) Grant of national or regional patents.**

Type your answer here:

[Click here for answer](#)

SAQ 6 Answer:

- a) never
- b) may be
- c) never
- d) always
- e) never
- f) never

As stated in the introduction, the primary goal of the PCT is to simplify the procedures involved in getting patents in a number of different countries. One further benefit to an applicant is the decision as to whether to proceed in any particular country or delay that procedure compared with the traditional patent system.

Audio segment 13: *Okay, so what advantages are there for the individual or company applying for a patent under the Patent Cooperation Treaty?*

I would say the main advantage for the applicant is that, by filing one application at one patent office, which will in most cases be his home patent office, he will obtain an international filing date for his application, and that filing date will have the effect of a regular national filing in every country he has designated. So the mandatory requirements that the applicant has to comply with are very few – such as making a specific request for the filing of a PCT application, stating his nationality or residence, so as to confirm that he is eligible to file such an application, and filing of description and claims.

Another advantage certainly worth mentioning is that the applicant, by filing his application, basically gains time, indeed quite a lot of time, before he has to decide whether to go ahead with his application. The time gained by this process could be about a year and a half, which is what making use of the entire PCT procedure to the fullest extent possible would allow.

[N.B. The transcription of this audio segment has been updated with current information]

In addition there are advantages for the national patent Offices. Namely:

Patent Offices can handle more patent applications since those via the PCT are easier to process due, in particular, to the fact that verification as to compliance with formal requirements has generally been checked already during the international phase.

Patent Offices can save certain publishing costs. If the international application has been published in the official language of a country, it can forego publication altogether. Countries having a different official language may limit themselves to publishing only a translation of the abstract, which accompanies international applications. Copies of the full text of the international application could be supplied upon request to interested parties.

The PCT does not affect the revenue of designated Offices unless they decide voluntarily to give a rebate on national fees in view of the savings they make through the PCT and in order to make the use of the international application route more attractive to the applicant. Annual or renewal fees, the most profitable source of revenue for most Offices, are not affected by the PCT.

Examining Patent Offices benefit, in respect of most applications originating from abroad, from an international search report and an international preliminary examination report.

Non-examining Offices receive applications already examined as to form, accompanied by international search reports and generally by international preliminary examination reports. This will put an Office, and the national industry affected by a patent and/or interested in licensing, in a much better position compared to the traditional system of filing national or regional applications.

Summary

The Patent Cooperation Treaty provides a simplified procedure for an inventor or applicant to apply for and eventually obtain patents in a large number of countries. In addition it promotes and facilitates the exchange of technical information contained in patent documents to industries and workers in the relevant field.

The advantage to an applicant in using the PCT is that by filing one application at one patent office, in one language, he will obtain an international filing date, and that filing date will have effect in each of the designated countries. In addition the PCT provides a period of time in which the applicant can decide whether to proceed in each of the designated countries.

The main role of WIPO in the PCT process is to facilitate the treaty by communicating the PCT request to the designated countries and publishing all PCT applications.

The way in which a PCT application is processed is shown in the following figure:



Legislative Texts:

- Madrid Agreement Concerning the International Registration of Marks
- Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks
- Hague Agreement Concerning the International Deposit of Industrial Designs
- Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks
- Patent Cooperation Treaty (PCT).