

Working Group on the Legal Development of the Madrid System for the International Registration of Marks

Fifteenth Session
Geneva, June 19 to 22, 2017

REVISED DRAFT REPORT

prepared by the Secretariat

1. The Working Group on the Legal Development of the Madrid System for the International Registration of Marks (hereinafter referred to as “the Working Group”) met in Geneva from June 19 to 22, 2017.
2. The following Contracting Parties of the Madrid Union were represented at the session: African Intellectual Property Organization (OAPI), Albania, Algeria, Australia, Austria, Belarus, Brunei Darussalam, Cambodia, China, Colombia, Cuba, Cyprus, Czech Republic, Denmark, Estonia, European Union (EU), Finland, France, Georgia, Germany, Greece, Hungary, Iceland, India, Israel, Italy, Japan, Kazakhstan, Latvia, Lithuania, Madagascar, Mexico, Montenegro, Morocco, Mozambique, New Zealand, Norway, Oman, Philippines, Poland, Portugal, Republic of Korea, Republic of Moldova, Romania, Russian Federation, Singapore, Slovakia, Spain, Sweden, Switzerland, Tajikistan, Tunisia, Turkey, United Kingdom, United States of America (55).
3. The following States were represented as observers: Afghanistan, Benin, Brazil, Canada, Iraq, Kuwait, Malaysia, Malta, Pakistan, Sri Lanka, Thailand (11).
4. Representatives of the following international intergovernmental organizations took part in the session in an observer capacity: Benelux Office for Intellectual Property (BOIP), Eurasian Economic Commission (EEC), World Trade Organization (WTO) (3).

5. Representatives of the following international non-governmental organizations took part in the session in an observer capacity: Association of Trade Mark and Design Law Practitioners (APRAM), *Association romande de propriété intellectuelle* (AROPI), Centre for International Intellectual Property Studies (CEIPI), European Communities Trade Mark Association (ECTA), International Trademark Association (INTA), Japan Intellectual Property Association (JIPA), Japan Patent Attorneys Association (JPAA), Japan Trademark Association (JTA), MARQUES – Association of European Trade Mark Owners (9).

6. The list of participants is contained in Annex III to this document.

AGENDA ITEM 1: OPENING OF THE SESSION

7. Mr. Francis Gurry, Director General of the World Intellectual Property Organization (WIPO) opened the session and welcomed the participants.

8. The Director General noted there had been a considerable amount of interest in the Madrid System for the International Registration of Marks (hereinafter referred to as “the Madrid System”). Since the previous session of the Working Group, Brunei Darussalam had joined the Madrid System, bringing the number up to 98 members covering 114 countries. The Director General encouraged observers to join the Madrid System and highlighted the importance of expanding its geographical reach to enable the Madrid System to become a truly global system, in particular to include countries in the Middle East and Latin America.

9. In terms of the use of the Madrid System by its existing members, the Director General said that 2016 had seen substantial growth. More than 52,500 international applications were filed in 2016, representing an increase of 7.2%, which was a much larger increase than that of more recent years. A lower growth rate of around 2.3% was expected for 2017. For the third consecutive year, the United States of America filed the highest number of applications of around 7,700, just in front of Germany, followed by France and China. In terms of geographies, the Director General stated that European countries remained the most prominent filers, filing around 62% of applications. Filings in Asia had increased, but remained a significant way behind at around 17.5%. A large number of countries had experienced very high growth rates in terms of use of the system, most notably China, where applications had risen by 68%. The Director General also noted double-digit growth in a number of European countries, including Germany (10.8%), Italy (14%), the United Kingdom (10.4%), the Russian Federation (32%), Finland (24%), and the Netherlands (14%). The Director General remarked that this was encouraging, as trademark applications tended to be a leading indicator of economic activity. A growth in trademark applications before changes in Gross Domestic Product growth rates represented new products and services and new enterprises entering the economy. The Director General further stated that China remained the most designated member, followed by the European Union and the United States of America. India and Mexico also ranked amongst the top 10 most designated members.

10. In terms of developments in the Madrid System and the International Bureau over the last year, the Director General acknowledged an unacceptable level of backlog and pendency rates. The Director General noted that significant improvement had been made in this regard during the first part of the year and that standard stock level was expected by the third quarter of the year. In terms of the information technology (IT) platform, the Director General noted that the launch of the Madrid Monitor service had been a success and that very positive feedback had been received. The Madrid Members Profiles Database, a searchable database on Madrid-related practices and procedures, now contained useful information on more than 90 Offices of the various members. A major development in the coming two to three years would be to integrate the various components of the Madrid IT environment into one single integrated platform.

11. The Director General observed that the Madrid Working Group Roundtable would provide the International Bureau with an opportunity to seek the advice of the participants on a number of relevant issues concerning the evolution of the Madrid System, in the interest of both Offices and users.

AGENDA ITEM 2: ELECTION OF THE CHAIR AND TWO VICE-CHAIRS

12. Mr. Mikael Francke Ravn (Denmark) was unanimously elected as Chair of the Working Group, Ms. Mathilde Manitra Soa Raharinony (Madagascar) and Ms. Isabelle Tan (Singapore) were unanimously elected as Vice-Chairs.

13. Ms. Debbie Roening acted as Secretary to the Working Group.

AGENDA ITEM 3: ADOPTION OF THE AGENDA

14. The Chair thanked the participants for his election and introduced a short “Year in Review 2017” video prepared by the International Bureau highlighting significant achievements from June 2016 to June 2017.

15. The Working Group adopted the draft agenda (document MM/LD/WG/15/1 Prov. 2), without modification.

16. The Working Group took note of the electronic adoption of the report of the fourteenth session of the Working Group.

AGENDA ITEM 4: REPLACEMENT

17. Discussions were based on document MM/LD/WG/15/2.

18. The Secretariat introduced document MM/LD/WG/15/2. The Secretariat informed that the revised proposed amendments concerned paragraphs (5) and (7) of Rule 21 of the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement (hereinafter referred to as “the Common Regulations”, “the Agreement” and “the Protocol”). The Working Group had previously agreed, in principle, with the proposed procedure and the proposed amendments to paragraphs (1) to (4) and (6) of Rule 21 of the Common Regulations. However, paragraphs (5) and (7) concerning the scope of replacement, the fees and the possible entry into force, remained open for discussion.

19. The Secretariat referred to the findings of a previous survey on replacement presented in the twelfth session of the Working Group and previous discussions that took place during the thirteenth session of the Working Group that disclosed the different practices amongst the Offices concerning the scope of replacement. Some Offices followed a strict literal reading of Article 4*bis*(1)(ii) of the Protocol, in so far as the goods and services listed in the national or regional registration must also be listed in the international registration. Such a strict interpretation made it difficult for trademark owners to request an Office to take note of replacement, particularly when the older national or regional rights might be broader in scope than the newer international registration. Some Offices followed a more flexible approach to Article 4*bis*(1)(ii) of the Protocol, allowing the Office to take note of the international registration for those goods and services that overlapped, thereby allowing for partial replacement. More than 40% of the 71 Offices that responded to the survey in 2014 said they would consider such partial replacement. In view of the different interpretations by the Offices, the Secretariat said that the Working Group might wish to discard proposed paragraph (5), as that would not affect current practices and it would also allow for a more flexible implementation of replacement, making it a more useful and usable mechanism for trademark holders.

20. The Secretariat explained that paragraph (7) concerned the collection of fees by the International Bureau and distribution of fees to Contracting Parties. The proposed procedure attempted to strike a balance between minimizing additional workload for the International Bureau with the advantage for the holders to pay fees for requests to take note only once. It was proposed that the International Bureau would collect the fees for Contracting Parties requiring such fees, provided the concerned Contracting Party had notified the International Bureau of the amount. There were, however, certain restrictions on the fee collection and distribution listed in paragraph (7), and the Contracting Party concerned would need to notify the International Bureau of the amount in Swiss francs only. The International Bureau would not convert amounts in local currency to Swiss francs and it would not be monitoring any fluctuation of the currency exchange rates. Where there had been a significant fluctuation of the currency exchange rate over time or where the Contracting Party wished to charge a new amount, the Contracting Party would need to inform the International Bureau of that new amount stated in Swiss francs. The Contracting Party would be able to notify new amounts twice in a given year and the new amount would be applicable three months after the date of receipt of the notification in the International Bureau. The collected fees would be credited to the concerned Contracting Party and then transferred, following the same mechanisms already in place for the standard fee regime or the individual fee regime.

21. The Secretariat stated that it would be necessary for the International Bureau to charge a fee for the work foreseen, including managing requests to take note, developing suitable IT solutions, etc. In this regard, the International Bureau would need time for internal consultations and to undertake an impact assessment to have a better understanding of all the costs involved. It would therefore be necessary to revisit the issue of the amount of the fee to be charged by the International Bureau at the next session of the Working Group.

22. The Secretariat noted that for the time being there was no proposal for a date of entry into force for the proposed amended Rule 21. The International Bureau would need time to look further into the development of the necessary IT solutions as well as to clarify any remaining issues after the session's discussions, to ascertain when the International Bureau could be ready to take on the task. In addition, Offices of Contracting Parties might also need time to amend their legislations and relevant IT processes before being ready to receive requests to take note from the International Bureau. In this regard, the Secretariat invited comments from the Offices on what they considered to be a reasonable date of entry into force.

23. The Chair clarified that the Secretariat had indicated three issues for discussion: the scope of replacement, the fee for replacement, and the entry into force. The Chair opened the floor for comments on the first issue, the scope of replacement.

24. The Delegation of Madagascar explained that while its Office interpreted Article 4*bis* in a literal sense, requiring full coverage of the products and services as listed in the national register, it would accept equivalent terms to a certain extent. The Delegation noted a preference for the divergent practices of the Contracting Parties to be respected, recognizing that 60% of Offices that replied to the survey did not accept partial replacement. As such, it should be possible for Contracting Parties to interpret replacement under the legislation and practices in their country.

25. The Delegation of the European Union and its member states agreed that replacement would benefit from a harmonization exercise and would therefore favor the discussions with a view to achieving a consensus and to having a harmonized practice in respect of the scope of replacement.

26. The Delegation of China favored the clause in proposed paragraph (5) as it allowed a more flexible approach to the implementation of replacement. The Delegation also stated that it would be more convenient and more useful for holders if the Offices had rights to review the replacement before making decisions whether to approve, rectify or deem the request not acceptable. The Delegation also suggested that replacement requests should only be processed through the International Bureau by using a standardized form. This could lead to a more harmonized approach and avoid the coexistence of parallel procedures at national and international levels.

27. The Delegation of Australia confirmed its commitment to an increased harmonization of the practices of different Contracting Parties to the Madrid System. However, the Delegation further stated that harmonization on procedures should be pursued in light of public demand and administrative burden. Additionally, considerations of harmonization among the Working Group should be balanced by an ability to resolve issues and achieve outcomes within reasonable timeframes. The Delegation argued that given the diverging opinions, it seemed most accommodating to all Contracting Parties to remove new paragraph (5) from Rule 21. The removal of that paragraph would preserve the ability for each Contracting Party to interpret and apply Article 4*bis*(1)(ii) as appropriate to its national laws and practices, and would avoid a potentially lengthy and challenging process in an effort to reach harmonization. The Delegation explained that Australia did not currently collect a fee to take note of a replacement on its national register. The Delegation supported a flexible provision for such an action and considered the inclusion of paragraph (7) of Rule 21 as proposed a suitable way to achieve this. The Delegation acknowledged that paragraph (7) as proposed would place additional burdens on the International Bureau and supported providing additional time for the International Bureau to assess any legal, operational, and information technology adjustments required to implement those proposed changes. The Delegation looked forward to hearing the International Bureau's suggested date for entry into force of paragraph (7) at the next meeting.

28. The Delegation of Israel explained that its Office interpreted Article 4*bis* literally and required all the goods and services listed in the national registration to be covered by the list in the international registration. The Delegation stated that goods and services that were equivalent in meaning, but not necessarily identical, would be accepted and stressed a preference for the legal framework as proposed in paragraph (5).

29. The Chair noted a lack of consensus.

30. The Representative of INTA stated that users favored the harmonization of practices regarding replacement and clarified the reasons why partial replacement is a feature that should be accepted by all Contracting Parties. The Representative, referred to document GT/PM/VI/3 "Comments on some of the Rules of the Draft Regulations under the Madrid Agreement and the Madrid Protocol", produced in 1994 when designing the Draft Regulations under the Madrid Agreement and the Madrid Protocol. That document, he said, showed that, at that time, it was the position of the International Bureau that Article 4*bis* of the Agreement and the Protocol allowed for partial replacement. That position had not been challenged in the meetings of the working group which elaborated the Regulations. The Representative quoted paragraph 99 of the document which, in relevant part, read as follows: "it should be emphasized that the word 'listed' [in Article 4*bis*(1)(ii) of the Protocol] should be understood as including the word 'covered'. For example, if a mark which is the subject of an international registration covers 'alcoholic beverages' and designates a Contracting Party where the same mark is registered for 'wines', the replacement should be limited to wines. [...] On the other hand, if a mark which is the subject of an international registration covers wines and designates a Contracting Party where the same mark is registered for 'alcoholic beverages' or for 'wines and spirits', the replacement would apply to 'wines'". The Representative believed, therefore, that at the time of adopting Rule 21 it was very clear that partial replacement was acceptable.

31. The Representative of INTA noted that paragraph 12 of document MM/LD/WG/15/2 on replacement offered two alternatives: to initiate discussions to see whether practices could be harmonized through an amendment of the Common Regulations, or discard paragraph (5) altogether. The Representative suggested a third alternative, namely to read paragraph (5) on the scope of replacements in the following way: “where all the goods and services listed in the national or regional registration or registrations are not listed in the international registration, the scope of replacement shall be limited to the goods and services listed in the international registration”. To conclude, the Representative believed that the core issue was not a question of goods or services being equivalent or not, but rather to try to reach a consensus to the effect that Article 4*bis* does not preclude a partial replacement.

32. The Representative of JPAA lent its support to INTA, stating that from the user’s point of view it would be beneficial if the specification of the goods or services of the original application or registration was not strictly identical to that of the international registration.

33. The Representative of MARQUES also supported INTA’s proposed rewording of paragraph (5).

34. The Delegation of the Russian Federation asked the Representative of INTA to provide examples of its proposal for a better understanding of the extent of the replacement being discussed. The Delegation questioned whether the replacement concerned identical terms of goods and services or whether the replacement involved non-identical goods and services. The Delegation was concerned that non-identical terms might give rise to a different scope of rights at a national and regional level of registration than that at an international level.

35. The Delegation of the United States of America noted that the text of proposed Rule 21 paragraph (5) used the term “equivalent to”, but there was no consensus to adopt this language at the fourteenth session of the Working Group. The Delegation explained that the United States statute used the wording “same” goods or services, but interpreted the word “same” as “equivalent to”. The interpretation was adopted to be flexible and to allow the goods and services to be viewed in the light most favorable to the holder. The Delegation also noted that the translation of the list of goods and services, from one language to another, necessitated using the equivalent standard since the translation from one language to another meant that the designation would never be equivalent to the existing national registration if the designation was in a different language. In that context, using an identical standard was overly restrictive and unfavorable to the holder. The Delegation supported the proposed wording of Rule 21(5).

36. The Delegation of the Republic of Korea agreed that replacement would benefit from a harmonization exercise, but acknowledged that such an exercise would not be an easy achievement due to the diverging practices of the Contracting Parties. A flexible implementation by Contracting Parties could accommodate different classification practices. The Delegation stated that the proposed new paragraph (5) of Rule 21 could provide a flexible implementation of replacement, making it a more useful mechanism for trademark holders. Therefore, considering the practical challenges of harmonizing diverging practices on the scope of replacement, it would be necessary to let the legal framework for Contracting Parties address this issue by adding the proposed new paragraph (5) of Rule 21.

37. The Delegation of Switzerland stated that Switzerland had always taken a non-literal interpretation of the scope of replacement; that it accepted partial replacement and believed that this was the objective of the provision. The Delegation also believed that this was confirmed by the International Bureau in its document. The Delegation referred to the Representative of INTA’s recollection and some of the other comments made by delegations that had taken the floor and concluded that it would like to see a harmonization of practice even if that was a difficult exercise. It appeared that applying the provision as initially envisaged was in favor of the holder.

38. The Delegation of Belarus believed that neither discarding nor leaving in proposed paragraph (5) of Rule 21 dealt with the main problem, because it did not allow for partial replacement. The Delegation said that as an Office it did not interpret the rule literally and allowed partial replacement. The possibility of partial replacement was absolutely necessary. The proposed wording did not allow for partial replacement in the sense that although the goods or services listed might be equivalent, all of the goods and services should still be there. In that regard, the Delegation, supported in principle the proposition of the Representative of INTA. To clarify, the Delegation reiterated that the issue was not just about the equivalence of goods and services, but rather not all the goods and services necessarily had to be on the list of the international registration.

39. The Representative of CEIPI supported the Representative of INTA's historical interpretation of replacement and its proposal concerning partial replacement. The Representative said the text proposed in the document addressed a different problem and suggested combining the approach from the Representative of INTA with the possible changes in the text in the document, given that they were not mutually exclusive and each dealt with different, very important aspects. The Representative of CEIPI agreed with the Delegation of the United States of America concerning the potential language issues that could arise.

40. The Chair noted that there was no consensus in relation to the conclusions that were proposed in the document, and further clarified that there were two issues for discussion: the proposal from the Representative of INTA that dealt with partial replacement, and the question of equivalent terms currently addressed in paragraph (5) proposed in the document under discussion. The Chair requested the Secretariat to merge these two concepts and to present a new proposal for discussion during the session.

41. The Chair opened the floor for comments on the fees.

42. The Delegation of Madagascar confirmed that it received a replacement fee to cover the costs of processing and inscription into the national register. The amount of the fee was decided by Ministerial Decree. The Delegation agreed that a fee would be payable in Swiss francs for the transfer, that the International Bureau could charge a reasonable fee for processing these requests, and that fees could be paid to the International Bureau using electronic means for payment.

43. The Delegation of Japan stated that it was aware that under other international application systems, such as the Patent Cooperation Treaty and The Hague System for the International Registration of Industrial Designs, Contracting Parties were able to notify the International Bureau of a certain amount of fees in their currencies. In that regard, it might be appropriate that the International Bureau, on behalf of the Offices of designated members would collect individual fees in Swiss francs converted by the International Bureau from national currencies notified by those Offices, along the lines of Rule 35.

44. The Delegation of Germany referred to proposed paragraph (7)(d) of Rule 21 and questioned who should pay the fee. The Delegation understood there were three possibilities: the fee would be paid by Contracting Parties who opted to charge a replacement fee and wished the International Bureau to collect the fee; or the fee would be paid by Contracting Parties that opted to charge a replacement fee but did not wish the International Bureau to collect those fees; or the fee would be paid by some Contracting Parties or applicants even where the Contracting Party did not take a fee at all, for example Germany. As such, the Delegation requested clarification on who would be obliged to pay the fee.

45. The Delegation of China believed that decisions concerning the fee for replacement should be based on national conditions. The Delegation confirmed that China did not collect any fees for replacement, but agreed in principle that the amount of the fee to be collected by the International Bureau should be reasonable and not too high.

46. The Delegation of New Zealand informed that New Zealand did not charge any fee for taking note of replacement. However, the Delegation agreed that there was merit in the proposal for an exclusive electronic form, which would result in cost-benefits for users and improvements in the quality, as well as timeliness of replacement requests.

47. The Delegation of the European Union noted that it should be an option for Contracting Parties to charge a fee. The European Union and its member states asked for clarification as to whether the potential additional fee to be charged by the International Bureau was envisaged to be charged only to those Contracting Parties that would opt for charging a replacement fee themselves under Rule 21(7), or in fact to all Contracting Parties.

48. The Representative of CEIPI noted in subparagraph (a), line 4 of paragraph (7), that the Secretariat had replaced "International Bureau" with "Director General" for harmonization with other paragraphs dealing with notifications. However the International Bureau reappeared in subparagraph (b), where reference was made to notifications under subparagraph (1), and the Delegation suggested a replacement in subparagraph (b) for consistency.

49. The Chair invited the Secretariat to address the questions raised by the delegations.

50. The Secretariat referred to the question raised by the Delegation of Japan on whether it could be possible for the International Bureau to convert fees stated in local currency to Swiss francs as was the practice for individual fees. The Secretariat explained that given the workload of the International Bureau, with regard to the declaration of individual fees and the changes to the fees as well as taking into account changes occurring due to fluctuations in exchange rates, it was preferable to have the fees stated in Swiss francs. The Secretariat further clarified that the International Bureau unlike for the individual fees, would not be monitoring fluctuations of exchange rates. This seemed to be a fair trade for accepting to collect fees on behalf of Offices to make things simple for users. Further, these fees to be collected from users were not envisaged in the legal framework.

51. The Secretariat, in reply to the Delegation of Germany concerning who should pay the fee in paragraph (7)(d), clarified that the fee would be a charge for users, the trademark owners requesting through the International Bureau that Offices take note of replacement. Where Contracting Parties were not charging any fees for taking note, a trademark holder would have the option of either presenting a request directly before that Office or to go through the International Bureau. The holder would need to balance the costs involved, in having a local agent, where the request would be presented directly before an Office, and the costs of translation of the request into the local language, with the small fee for presenting the request to the International Bureau, where the request could be presented in English, French or Spanish. In addition, it was foreseen that the web form would allow the holder to request in one form that several Offices take note. In answer to the comments made by the Representative of CEIPI, the Secretariat confirmed that it would replace the reference to the International Bureau with the Director General as suggested.

52. The Representative of INTA considered a fee to be paid by users to the International Bureau for transmitting and recording the fees reasonable. However, the Representative reiterated that a specific segment of users who wanted to have the inscription of their replacements in the national register should not have to bear the costs related to the development and maintenance of IT solutions for the implementation of the service, particularly in view of WIPO's significant budget surplus.

53. The Representative of INTA also noted an unusual formulation in paragraph 7(d) of Rule 21, referring to services rendered by the International Bureau in relation to replacement. The Representative questioned whether there would be different fees depending on whether the request for recording in the national register was presented directly to the national Office or regional Office, thereby not generating any specific costs for the International Bureau, or whether it was transmitted through the International Bureau. The Representative further noted

that there was no particular fee for Rule 21, and therefore wondered whether the intention was to introduce a fee only when the request for recording in the national register was transmitted through the International Bureau. The Representative asked whether this could be clarified by the Secretariat and then as necessary in the text.

54. The Representative of MARQUES repeated its support for the availability of filing a replacement request with WIPO, as this would add clarity to the procedure for holders. The Representative believed it was important to simplify the procedure so the holder requesting replacement needed only to pay a fee to WIPO and nowhere else.

55. The Representative of JIPA agreed with the comments made by the Representative of MARQUES in that the recipient of the fees should be made clear. Further, the Representative highlighted that Contracting Parties had different practices and policies regarding replacement, thus making it difficult for the users of the Madrid System. It would benefit the holder if information concerning each Contracting Party was collected and incorporated into a single source made available to the public.

56. The Chair invited the Secretariat to address the issues raised by some of the delegations.

57. The Secretariat clarified that the International Bureau would only charge a fee when the request to take note of replacement was presented to the International Bureau. In that regard, the International Bureau would consider the possibility of rephrasing the wording of subparagraph (d).

58. The Chair noted the support and comments on the wording in paragraph (7) and reiterated that the Secretariat would present a revised text in respect of paragraph (7), as well as paragraph (5) for further discussion.

59. The Delegation of Switzerland noted that there had been no discussion on the amount of fees and questioned why an amount had not been proposed.

60. The Secretariat explained that the International Bureau would need time for internal consultations, and possibly an impact assessment, to have a better understanding of the work and the cost involved in setting up a procedure to take requests from trademark owners, to develop suitable IT solutions like a web form, and also to have a mechanism for collecting fees. At the time of preparing the document, there was no clear understanding of the possible costs involved. Therefore, a proposal for the amount of fee to charge for receiving such requests would be presented at the next meeting.

61. The Delegation of Switzerland stressed that the fee had to be very reasonable. If aimed at covering all of the charges, it may be too high.

62. The Delegation of Germany supported the view of the Delegation of Switzerland, that the fee should be very reasonable. The Delegation also supported the Representative of INTA, noting that many Offices did not charge a fee. However, when rules were changed and new procedures needed to take place, changes in IT solutions were necessary and could be quite costly. On that basis the Delegation questioned whether a fee was needed, given that replacement was fairly straightforward with so many Offices doing it without a charge. Another solution would be for the Offices that wanted the fees to be collected by the International Bureau to pay a service fee. The Delegation believed that the Offices should pay rather than the user.

63. The Chair noted that the revised text would be presented for further discussion during the session, and indicated that a discussion concerning the amount of the fee to be charged would take place at the next meeting.

64. Concerning the possible date of entry into force, the Secretariat explained that a specific date had not been proposed because it was clear that the International Bureau needed time to get ready to take on this task. Previous discussions in the Working Group indicated that some Offices would also need time to change their legislation to be able to receive requests from the International Bureau. The Secretariat asked the Offices when they would be ready to receive requests from the International Bureau to take note of replacement.
65. The Chair opened the floor for comments on the entry into force.
66. The Delegation of Japan noted that to comply with the proposed revisions to Rule 21, some members, including Japan, would need to modify their IT systems. Therefore, the Delegation requested the International Bureau to take this into consideration when determining the effective date of the amendment.
67. The Delegation of Israel noted its flexibility as to the date of entry into force.
68. The Delegation of the United States of America stated that it recognized the desire for a centralized procedure to make replacement easier for users and uniform amongst national Offices. The Delegation explained that the United States Patent and Trademark Office (USPTO) had a national procedure in place already which worked quite well. It provided an electronic form for filing the request to take note of replacement. The USPTO received less than 20 requests a year to take note of replacement. There was a charge of 100 United States Dollars fee per class for the request, to cover the comparison of the goods and services in the national registration with the goods and services in the registered extension of protection. Although, they used the “equivalent to” standard, it did not take note of partial replacement. The USPTO understood, from users in the Working Group, that a centralized procedure would assist users when refusals were issued in respect of a request for extension of protection in a designated Contracting Party on the basis that there was an existing national registration. This was sometimes referred to as double protection. The Delegation mentioned that the USPTO did not issue a provisional refusal when a request for a later filed request for extension of protection coincided with an existing national registration in the name of the same owner. It accepted the later filed extension of protection for registration as a different type of application because it had a different filing basis. It was allowed to coexist, and it was left to the owner to decide whether to abandon the prior national registration and just maintain the extension of protection or to maintain both. However, the Delegation recognized the benefit for users in centralizing a procedure at the International Bureau and, therefore, it did not object to the draft rule introduced at the fourteenth session of the Working Group. However, the Delegation did not consider the IT implementation implications of the procedure outlined in draft Rule 21, and it confirmed that since then it had been informed that it could not make the IT changes necessary to implement the new procedure any time in the near future. IT changes were costly, time consuming and must be prioritized against other proposed IT changes.
69. The Delegation of the United States of America stated that if draft Rule 21 was to move forward, it would need to ask for one of two options to be added to the text: an opt-out for those Contracting Parties that already had a national procedure to take note of replacement; or a 10-year transition period to implement the necessary IT changes. The Delegation noted that it was in the midst of upgrading its IT system and that this process was expected to last a number of years.
70. The Delegation of the European Union considered that the envisaged amendments to Rule 21 would involve significant procedural changes also affecting IT systems of the Contracting Parties. To allow for the necessary adaptations to be done everywhere well in advance, the European Union and its member states proposed that the date of entry into force of amended Rule 21 would not be set to before 2019.

71. The Representative of MARQUES recognized that IT changes could be extremely difficult. However, the Representative stressed their disappointment on hearing that it would take 10 years. If they had to choose, they would choose the 10-year option rather than the opt-out option; otherwise some of the benefits, like the clarification of the procedure, would be lost.

72. The Delegation of Switzerland proposed July 1, 2019, as a date for implementation. The Delegation believed that the changes should not be significant. There were just a few requests per year according to the experience of the Swiss Office, and an exponential growth was not foreseen.

73. The Delegation of Germany did not consider the IT changes required significant. The Delegation explained that it was involved in a substantial project concerning a significant change in European law and its current priority was to change the IT system to adopt the new law, but this would not take years and years. The Delegation requested more time to fix a date for implementation to allow some time to consult with the relevant IT units. However, the Delegation proposed a date of entry into force date within three years.

74. The Delegation of Mexico agreed that the scope of replacement should be clarified. With regard to the fees, the Delegation believed that the Working Group could reach a consensus on the more concrete terms during the session. The Delegation believed that two to three years was a realistic timeframe for entry into force. Users really depended on having a more efficient, more agile and more flexible system for international marks.

75. The Representative of CEIPI, after having heard from various Delegations, noted that requests for replacement were very rare and believed that an entry into force could be fixed within two to three years. The Delegation proposed that the Offices that needed more time to adapt their IT systems proceeded from the date of entry into force by manually processing the requests until they were ready with their IT, so as not slow down the entry into force of the provisions.

76. The Delegation of the Russian Federation agreed with the proposal by the Delegation of Switzerland on July 1, 2019, as the date of entry into force. This appeared to be a reasonable date and adequate time for the members to adapt their systems, including IT systems.

77. The Delegation of Australia sympathized with the Delegation of the United States of America and explained that IP Australia was also in the midst of replacing its systems. The Delegation stated that an entry into force of 2019 would not be feasible for Australia, given that it would be delivering its new Trademark Internal Case Management System at that time. While Australia would not necessarily require 10 years, it would need more time to implement the system changes.

78. The Delegation of China stated that replacement was processed through the International Bureau by a standardized system and domestic procedures would also need adaptation. Given those considerations, the Delegation believed that the provisions should not enter into force before 2019.

79. The Chair concluded that the delegations were in different situations noting that some Offices would want an earlier entry into force date than others. The Chair suggested, as requested by the Delegation of Germany, that the matter be considered further and discussed again at the next session of the Working Group particularly, since the International Bureau would also have to look into a possible fee to be charged. This would provide the time needed to look into what changes were necessary and provide a better idea of when it would be possible to implement a change and discuss further a proposed entry into force.

80. The Delegation of Switzerland wondered if pushing back the discussion by a year would just result in the same problems. The Delegation stressed a preference for proceeding with a date for entry into force in two or three years, if appropriate for the majority. If a given Office

had a real problem with this proposal, then the matter could be further discussed again next year. The Delegation was concerned that not making a decision would just push the problem back and IT issues would always be an excuse for not moving forward.

81. The Chair sympathized with the Delegation of Switzerland's wish to move on with the issue, but noted that feedback received from delegations regarding what seemed to be possible differed at that point in time. The Chair believed that the Secretariat would try to put a proposal together before the next meeting and invited the Secretariat to further elaborate.

82. The Secretariat explained that it was not clear at that stage how much time and resources were needed to implement the eventual procedure. In the past, time-frames had been set prematurely and had consumed more time and resources than expected. Therefore, the preferred solution would be to give the International Bureau further time to fully assess how much time and resources were needed to avoid an agreement on an implementation date that could not be met. By way of example, the Secretariat referred to the unanticipated delay in the implementation of the two-part fee payment arrangement.

83. The Secretariat proposed to come back to the Working Group with a realistic time-frame for implementation after a comprehensive review of the processes involved. In theory, the implementation and processes involved could appear to be straightforward. However, in reality, problems could arise and the collection of fees could be quite challenging. To illustrate the point, the Secretariat referred to the outstanding issues concerning the fees involved and what might be involved following the examination of the request by both the International Bureau and the designated Contracting Parties, if that request was irregular. The entire procedure could result in a significant number of steps and time-consuming tasks. The Secretariat reiterated that it did not want to cause any artificial delay, but it wanted to be realistic about how much development work it would take before it agreed on a realistic entry into force, bearing also in mind the various comments made by some of the delegations. The Secretariat noted that some Offices believed that the implementation would be straightforward, while others had less confidence with their IT systems.

84. The Secretariat explained that the International Bureau had recently recovered from a very challenging time in respect of IT development, and requested that delegations give it the time it needed to make a reasonable and realistic assessment of the potential impact of the implementation and how much time it would take to develop the procedures internally with colleagues in Finance, as well as Operations and to then come back and make a proposal to that effect.

85. The Chair referred to the Secretariat's comments and suggested that all members undertake the same kind of analysis, to evaluate the time needed for implementation. The Chair further stated that a concrete answer to that question would be needed next year. The Chair noted that a number of delegations had indicated that they would favor a date in the year 2019 but recalled, however, that the year 2019 may be too early for some. The Chair agreed that it would be a good idea to have time, as requested by the Delegation of Germany, to look into the matter further and to have a better understanding of how long it would take to implement the change.

86. The Chair concluded that the Working Group agreed that the Secretariat would prepare a new document for further discussion at its next session.

87. The Chair informed that non-paper No. 1 dated June 20, 2017, with the new draft changes to Rule 21 was available and invited the Secretariat to introduce the non-paper.

88. The Secretariat referred to the revised text and noted a change to Rule 21 paragraph 2(a)(vi), where the text referring to paragraph (7) had been deleted. The reason for the deletion was that paragraph (7) would always apply. The Secretariat noted that paragraph (5) now had two subparagraphs, namely (a) and (b). The title of paragraph (5) had

been renamed to “[Goods, Services Concerned by Replacement]”. New subparagraph (a) clarified partial replacement while subparagraph (b) contained the wording from paragraph (5) in document MM/LD/WG/15/2 with slight amendments. The Secretariat added that the rewording would allow Offices to either use the word “same” or the words “equivalent to”, based on their practice. In paragraph 7(b), the words “International Bureau” had been replaced with “Director General” for consistency with subparagraph (a). The Secretariat noted the slight rewording of subparagraphs (b), (c) and (d). Subparagraph (d) had been clarified to say that a request presented through the International Bureau shall be subject to payment of the fees identified in paragraph 7.8 of the Schedule of Fees. Similarly, the Schedule of Fees item in 7.8 had also been reworded to now read “Request that the Office of one or more designated Contracting Parties take note of an international registration (replacement) presented through the International Bureau”.

89. The Chair recalled that the previous discussions centered on paragraph (5) and therefore opened the floor for comments on the revised paragraph (5).

90. The Delegation of Germany questioned, as a non-native speaker, the meaning of the word “may” in paragraph (5) and whether it should read “shall”.

91. The Chair agreed with Germany in that the word “may” in paragraph (5) should read “shall”.

92. The Delegation of Switzerland referred to the comments of the Delegation of Germany and stated that the French version should be adapted in the same way.

93. The Delegation of Italy favored the proposed Rule 21(5) with a modification of the word “shall” instead of “may”.

94. The Delegation of Norway supported the proposed new wording of Rule 21(5) and the word “shall” as stated by the Chair.

95. The Delegation of Spain supported the proposed change of new Rule 21 and the new wording for paragraph (5).

96. The Chair concluded there was an agreement on the proposed new Rule 21(5) and opened the floor for comments on the revised paragraph (7).

97. The Delegation of Switzerland questioned the removal of the reference to the registration date in Rule 21.

98. The Chair clarified whether the Delegation of Switzerland was referring to Rule 21(2)(a)(v), where there was a reference to the filing date and number, registration date and number.

99. The Delegation of Switzerland replied to the Chair and explained that Rule 21(2)(b) said “The indications under paragraph (1) shall be recorded as of the date of receipt by the International Bureau [...]”. The Delegation noted that the date of reception by the International Bureau was not referred to in the draft text and there was no clarification with regard to the date. The Delegation requested further time to consider this issue.

100. The Chair agreed with the Delegation of Switzerland in that there was something in current Rule 21(2)(b) missing in the draft Rule 21. The Chair considered the matter with the Secretariat and proposed a change to draft paragraph (4) to read “The International Bureau shall record, as of the date of receipt by the International Bureau, in the International Register any notification received under paragraph 3(b) and shall inform the holder accordingly”. The Chair proposed to retain the wording in Rule 21(2)(b).

101. The Secretariat advised the Chair to move the sentence to read “the International Bureau shall record in the International Register as of the date of receipt by the International Bureau any notification received [...]”.

102. The Chair asked the Delegation of Switzerland whether that addressed the issue.

103. The Delegation of Switzerland said that it had doubts about the new wording and asked what would happen if the request was received by the International Bureau and then forwarded to the designated Office to decide whether or not it was acceptable. The Delegation wondered whether the International Bureau could intervene twice, both prior to examination and after examination.

104. The Secretariat, in reply to the Delegation of Switzerland, clarified that the paragraph would apply when the International Bureau had received notification from a designated Office that it had taken note. It would not apply when the International Bureau received the request to forward to the designated Offices.

105. The Representative of INTA drew attention to the fact that there were two elements in paragraph 2(b) of current Rule 21: the date of receipt and the date on which the recording was made; and also the fact that the International Bureau recorded notifications complying with the applicable requirements. The Representative suggested adding the wording “complying with the applicable requirements” after the word “notification”.

106. In response to the suggestion by the Representative of INTA, the Chair indicated that paragraph 3(b) already referred to the applicable requirements in paragraph (2)(a)(i) to (v), and considered any additional wording in that regard unnecessary. If members wanted a direct reference in the text it could be inserted. However, as the reference was already there, the Chair suggested leaving the text as it was.

107. The Representative of INTA agreed that paragraph 3(b) definitely contained a number of requirements and pointed out that the text of proposed paragraph (4) said that the International Bureau should record any notifications received under paragraph 3(b). Whether or not they complied with the requirements was another issue. However, the Representative was aware that the current text was in line with several other provisions of the rules in which the International Bureau recorded only what complied with the applicable requirements.

108. The Delegation of Germany agreed with the Representative of INTA and considered the sentence had become very long and difficult. The Delegation suggested splitting the sentence into two subparagraphs, (2)(a) and (b), for clarity.

109. The Chair then proposed the following wording: “the International Bureau shall record in the International Register as of the date of receipt by the International Bureau, any notification under paragraph 3(b), complying with the applicable requirements and shall inform the holder accordingly”.

110. The Delegation of Switzerland considered that the proposed text fulfilled the conditions. The Delegation noted that it would like to see a French translation before confirming its agreement.

111. In reply to the Delegation of Switzerland, the Chair indicated that the text was being worked on in English, and any issues with the French translation of the text may be raised during the adoption of the Summary by the Chair.

112. The Delegation of Switzerland questioned the structure of the wording and whether the structure could be revised for clarity, as suggested by Germany.

113. The Chair, said this matter would be addressed in the Summary by the Chair. Any comments made would be taken into consideration when preparing the draft text for further discussion at the next meeting.

114. The Delegation of Switzerland referred to Rule 21(3)(c), “an Office that has not taken note may so notify the International Bureau, which shall inform the holder accordingly”. The Delegation believed that it was necessary to specify that this paragraph should only apply where the application was made via the International Bureau. The Delegation also considered the position of subparagraph (5) strange, because it came after recording a notification. The Delegation suggested positioning that paragraph earlier, perhaps where paragraph (3) was.

115. The Chair said that the comments made by the Delegation of Switzerland would be taken into account when preparing the revised text in Rule 21 for the next meeting.

116. The Delegation of Germany commented on paragraph (3)(c). The Delegation believed, irrespective of whether the request was made via the International Bureau or directly with the relevant Office, that if an Office did not take note of replacement, it should not need to inform the International Bureau.

117. The Chair noted the comments and confirmed that the Secretariat would take the comments into account when preparing the re-draft of subparagraph (3).

118. The Chair opened the floor for comments on the slight change in the text of paragraph (7) in non-paper No. 1, dated June 20, 2017.

119. The Representative of INTA suggested a minor redrafting of the third line of paragraph 7(c), on the procedure applicable to the fee. The Representative suggested that “fees” would be more appropriate, because when the standard fees were payable, the Contracting Party would receive both the designation fee and a share in the complementary fee. Therefore, “fees” would be better than “fee”.

120. The Delegation of Switzerland suggested adding a reference to the “calendar year” in paragraph 7(a), rather than a reference to the “given year” to avoid any situations where an Office might be able to communicate three times in the year. The definition of a year could give rise to problems. The Delegation questioned whether it was a year calculated as from the date of the notification or just the calendar year.

121. The Chair replied that the Secretariat agreed to add a reference to the calendar year.

122. The Chair opened the floor for comments on paragraph 7(c) concerning the Schedule of Fees.

123. The Delegation of Switzerland questioned whether or not the word “present” in the French version should have an extra “e” on the end.

124. The Chair noted that the French native speakers agreed and confirmed that the word “present” should have an extra “e” on the end of it.

125. The Representative of CEIPI agreed with the Delegation of Switzerland. The Representative also considered that in the English version there should be a comma after the word replacement, and in the French version the word “présente”.

126. The Chair concluded the Working Group discussion on agenda item 4, and noted that any proposals made would be reflected in the Summary of the Chair and in the redraft of the Rule for next year’s meeting.

127. The Working Group tentatively agreed:

(i) with the proposed amendments to Rule 21 and with new item 7.8 of the Schedule of Fees, as amended by the Working Group and as set out in Annex I to the present document; and,

(ii) to request the International Bureau to prepare a document proposing the amount of the fee to be specified in new item 7.8 of the Schedule of Fees and suggesting a date for the entry into force of amended Rule 21, to be discussed at its next session.

AGENDA ITEM 5: ANALYSIS OF LIMITATIONS IN THE MADRID SYSTEM FOR THE INTERNATIONAL REGISTRATION OF MARKS

128. Discussions were based on document MM/LD/WG/15/3.

129. The Secretariat explained that the topic was a continuation of discussions in previous sessions and reminded the Working Group that recommendations made by the Working Group in its thirteenth session in November 2015, concerning limitations, resulted in amendments to Rules 12 and 25 to 27, which would be entering into force on July 1, 2017. The upcoming changes had recently been published on the Madrid website.

130. The Secretariat noted that the amendment to Rule 12 clarified that the International Bureau, when examining an international application, would also control the classification of limitations contained in that application. It would be for the Offices of the designated Contracting Parties to determine whether the limitation was within the scope on the main list or not.

131. The Secretariat explained that the amendments to Rules 25 to 27 concerned limitations recorded as a change to the international registration. In the official form MM6 for recording limitations, the holder would need to group the limited list of goods or services under the corresponding classes appearing in the main list of the international registration. The International Bureau would examine the request to determine whether the class numbers indicated in the limitation corresponded to the class numbers in the international registration. The Office of the designated Contracting Party where the limitation was to have effect would need to determine whether the limitation was within the scope of the main list or not.

132. The Secretariat added that in the previous session, the Working Group requested that the International Bureau prepare a document analyzing the role of the Office of origin in the examination of limitations in international applications, and the possible implications therefrom. The document would also analyze the role of the Offices of designated Contracting Parties in respect to limitations in international registrations or subsequent designations affecting them, and the possible implications therefrom, including proposals in respect of both roles. The Secretariat explained that the document had three parts, covering the role of the Office of origin concerning limitations in international applications; the role of the International Bureau concerning international applications and subsequent designations containing limitations; and the role of the Offices of designated Contracting Parties concerning limitations.

133. The Secretariat further explained that the part of the document covering the role of the International Bureau, also contained a proposal to revisit the issue of Rule 24(5)(a) and 24(5)(d). The Secretariat invited the Working Group to reconsider the previously adopted amendment to the currently suspended Rule 24(5)(a) and 24(5)(d). The Secretariat said that the proposal mirrored the level of examination concerning limitations under Rule 25. With the proposal, the International Bureau would control that the limitation contained in the subsequent designation concerned only classes covered by the main list of the international registration. That approach would harmonize the level of examination by the International Bureau for limitations presented in subsequent designations and as a change under Rule 25. In the part covering the role of the Offices of designated Contracting Parties concerning limitations, there

were proposals for amending Rules 17 and 27. The proposal for amending Rule 17 would provide for the possibility that the notification of a provisional refusal include a declaration concerning the effects of a limitation in an international registration. Furthermore, Rule 27 was proposed to be amended, to clarify the legal basis for Contracting Parties to refuse the effects of a limitation recorded as a change.

134. The Chair summarized that the document was split into two parts and indicated that the first part contained three chapters: the first chapter dealt with the role of the Office of origin concerning limitations and international applications; the second chapter dealt with the role of the International Bureau concerning international applications and subsequent designations containing limitations; and the third chapter dealt with the role of the Offices of designated Contracting Parties concerning limitations. The Chair further highlighted that paragraph 28 contained suggestions for conclusions that could be drawn from the first three chapters, and the second part of the document contained the proposed amendments to the Common Regulations.

135. The Chair opened the floor for discussion on paragraphs 3 to 11, in the first part of the document.

136. The Delegation of Madagascar stated that, as an Office of origin, its Office assisted applicants in drafting limitations and it also checked the scope of the limitation. Before certifying the Office warned the applicant of any eventual expansion in a proposed limitation, so that the applicant might adjust the list of goods and services for correspondence with the basic mark.

137. The Delegation of Italy agreed with paragraph 3 of the document, and stressed that it was convinced that the central role of the examination was to be performed by the Office of origin with regard to limitations. The Office of origin could see the original protection for goods and services and ensure that the scope of protection was not changed by the limitation.

138. The Delegation of Switzerland said that its Office had believed for a number of years that the International Bureau was responsible for checking the limitations submitted subsequent to registration. The Delegation went on to say that it now realized that that many limitations might have been included without any examination, because many Offices also had believed that the International Bureau had conducted an examination prior to inscription. The Delegation stressed that the situation must be remedied and requested that the Working Group consider a solution that guaranteed that all limitations were examined. The Delegation believed that the International Bureau could play an inevitable role in the examination of limitations. However, examination prior to inscription was important for the clarity of the Register and to ensure that holders' rights were protected. As such, the Swiss Office considered that it was the duty of the Office of origin to consider the scope of the limitation.

139. The Delegation of China stated that on receipt of the application, its Office examined the scope of the limitation. The Delegation said that the Office of origin should also control the limited lists of goods and services that fell within the scope of the international registration, to help reduce the applicant's risk of receiving irregularities.

140. The Delegation of the Czech Republic stated that its Office helped applicants to draft the list of limitations. If necessary, it also examined the limitations as an Office of origin and as a recipient of subsequent requests for limitations. The Delegation believed that WIPO should check requests that did not go through the Office of origin, because very often holders asked for a limitation in several countries or Contracting Parties. This might result in a mark with 10 different limitations to be checked by different Offices. The examination of subsequent limitations should be carried out by the Office of origin, but the centralizing Office should be WIPO.

141. The Delegation of Austria confirmed that as an Office of origin it examined whether limitations fell within the main list of an international application, and therefore it supported the opinion that the Office of origin should be responsible for examining whether the limitation was a limitation or an extension. The Delegation supported the request for amending Rule 9 of the Common Regulations by explicitly including limitations as a part of the certification function.

142. The Delegation of Georgia stated that limitations must be examined by the Office of origin, to ensure that they fell within the main list of goods and services as part of the certification process. The Delegation expressed its support for the proposal to add legal basis to refuse protection based on the fact that a limitation was an extension.

143. The Delegation of France reiterated its position expressed in the previous session of the Working Group, namely that it did not agree with the principle that limitations should be examined by Offices of designated Contracting Parties. The Delegation explained that its Office, as Office of origin, examined limitations, but it also examined them when contained in subsequent designations or requested as changes to international registrations. Where limitations in international applications were concerned, the Delegation considered that the Office of origin was best placed to examine them. When limitations were contained in subsequent designations, the Delegation considered that they should be examined by the International Bureau; it was difficult for an Office of origin to examine limitations when the effect of the limitation did not apply to its territory; additionally, where a limitation concerned different Contracting Parties, refusals based on different grounds could also be issued, which would not result in a simplification or harmonization of the system; examination by Offices with different practices would render the system more difficult for users. The Delegation expressed dissatisfaction with the proposed amendments, as they did not clarify whether examination should be undertaken by the International Bureau, the Office of origin or the designated Office; if examination by national Offices were to be optional, the question of who must undertake examination would remain unanswered.

144. The Delegation of Mexico believed that the examination of limitations should be carried out by the Office of origin and the designated Office. According to Rule 9, the Office of origin should check that the goods and services indicated in the international application were also included in the basic registration. The limitation should not be considered as being secondary, but something that depended upon the basic registration. The Delegation also mentioned that it had issued refusals on the basis of the idea that a limitation could not go beyond a general or main list. In this connection, the Delegation considered that there should be some correspondence between the examination at the certification stage and an examination carried out by designated Offices, because if Offices were encountering these problems, the case might arise that a designated Office issued a provisional refusal based on a limitation and that the holder might argue that the limitation was accepted by the Office of origin. The Delegation considered that there should be a link between the function of the Office of origin and those of the designated Contracting Parties.

145. The Representative of JPAA believed that it was the Office of origin's duty to verify that the goods and services indicated in the international application were covered by the list of goods and services appearing in the basic application or basic registration. The Representative also stated that from the user's point of view, the Office of the designated Contracting Party should examine limitations. The Representative was concerned that an increased chance of obstructions at the international application stage, which may result in increased costs to register the mark, would make things more difficult for users. The Representative indicated that it favored an amendment of Rule 9(5) and any related rules to add limitations in international applications to the certification function of the Office of origin.

146. The Representative of INTA referred to his comments raised in previous sessions of the Working Group on the issue, recorded notably in paragraph 391 of document MM/LD/WG/14/7 "Report". The Representative reiterated that it is clear from Rule 9(5)(d)(vi), that the Office of origin should certify that all the goods and services indicated in the international application

were covered by the list of goods and services appearing in the basic application or basic registration; not just the goods and services of the main list, but also those of the limited list or lists that might be included in the international application. The Representative supported the view of previous speakers and further stated that it was clear that the Office of origin was the only Office, which could determine with certainty the scope of protection of the basic mark. The designated Office must be able to rely on the certification by the Office of origin. The Representative stressed that was a pillar of the Madrid System, which from its inception was meant to provide for the extension of the protection of the mark in the country of origin to other members of the Union, and the Protocol did not change that basis of the Madrid Agreement.

147. The Representative of JIPA supported the opinion of the Representative of JPAA, stating it shared the same concern regarding the examination of limitations by the designated Contracting Party.

148. The Chair referred to paragraphs 3 to 11 of document MM/LD/WG/15/3 and observed that there was some consensus from those that had spoken that the Office of origin had some role in relation to limitations in international applications. However, the Chair was not able to make a concrete conclusion on the issue.

149. The Chair referred to paragraphs 12 to 20 of the document dealing with the role of the International Bureau concerning international applications and subsequent designations containing limitations. The Chair invited a discussion based on a theoretical question, concerning a 15-year-old international registration and a subsequent designation filed directly with the International Bureau with a list of goods and services that was claimed to be a limitation. The Chair asked whether the Delegations had any opinions on who should check the limitation in a subsequent designation filed directly with the International Bureau.

150. The Delegation of Switzerland considered that limitations in subsequent designations, or the review of those limitations, could be done by the holder's Office. However, the Delegation considered the more sensible option would be for the International Bureau to have additional competencies delegated to it, to check this type of limitation. In answer to the Chair's specific question, the Delegation said that it was likely that the International Bureau, as the custodian of the system, was in the best position to understand the practice and to examine the limitations appropriately.

151. The Delegation of Italy supported the statement made by the Delegation of Switzerland with regard to the subsequent designation. Given that it was possible to file directly with WIPO, WIPO should examine the limitation and if necessary seek support from the national Office.

152. The Delegation of China stated that the International Bureau, as an expert in classification of goods and services, should examine limitations in international applications, in subsequent designations or those recorded as a change, so as to ensure that the limited list of goods and services fell within the scope of the international registration. If the registration was older than 15 years, the International Classification of Goods and Services for the Purposes of the Registration of Marks (hereinafter referred to as "the Nice Classification") would apply. The International Bureau had the best knowledge of the Nice Classification, so it was best placed to undertake the examination according to the older versions of the relevant provisions of the Nice Classification in force at that time.

153. The Delegation of France agreed that the International Bureau would be best placed to examine a limitation included in a subsequent designation for an international registration which was 15 years old. The Delegation further believed that the International Bureau should examine the limitations included in subsequent designations, where the Office of origin had not carried out such examination.

154. The Delegation of Cuba stated that examination of limitations concerned Offices of origin, the International Bureau and designated Offices. The Delegation considered that matters concerning goods and services were substantial. The Delegation stressed that, as of late, limitation issues had been the most complex issues faced by users and Offices; in that respect, the introduction of a classification tool by the International Bureau had been most useful, yet it was not adequate to refer difficult limitation matters to designated Offices. The Delegation concurred with other delegations in that examination was the special duty of Offices of origin. It was unacceptable that a registration examined by the International Bureau could reach designated Offices containing serious problems related to the classification of goods and services. The Delegation evoked the fact that a limitation fee was paid to the International Bureau and requested a bigger effort by the International Bureau concerning evaluation of limitations. The Delegation recalled that designated Offices had a role in examining the increasing number of limitations reaching them; yet, if those limitations included erroneous classifications, users should be aware that provisional refusals would be raised by designated Offices.

155. The Delegation of the United States of America supported the proposed amendments to Rule 24(3) and 24(5). The Delegation stated that it did not believe that the International Bureau should examine limitations as to the scope of the wording of the goods and services. However, the Delegation agreed that the International Bureau was in a good position to help prevent simple mistakes made by holders as to classification when filing limitations. The proposed amendments would allow the International Bureau to make some simple adjustments to the forms and to make it clear to holders that a limitation should not include classes that were not contained in the international registration.

156. The Chair noted that there was no real consensus on the matter. The Chair further noted that an important distinction needed to be made as to whether the issue of limitations concerned the classification only, or the classification and the scope of protection.

157. The Delegation of the Czech Republic explained that a distinction should be made between those limitations, which went through the Office of origin and that were checked and later certified in the application, and those limitations that did not go through the Office of origin. That was one way of distributing the workload. However, the Delegation considered that a limitation could be checked at the same time as the list of goods and services was checked for formalities, and believed the examiners in WIPO were extremely well versed in that area, whereas the Office of origin could find it difficult. It would also be a lot more work for the Offices, and it could mean that many Offices would end up doing the same work.

158. The Chair opened the floor for comments on paragraphs 21 to 27 of the document, on the role of Offices of designated Contracting Parties concerning limitations.

159. The Delegation of Australia agreed with the proposed amendments to Rules 17 and 27 as they allowed the Office of the designated Contracting Party to refuse the effects of the limitation that was not considered to be within the scope of the international registration. The Delegation believed that limitations were best examined in the Office of the designated Contracting Party, where the limitation was intended to have effect. The reasons for the limitation might be based on circumstances that existed only before that designated Office, and noting that some Offices had particular requirements. Leaving the examination of limitations to the designated Office respected the legislation of each Contracting Party. It would also avoid burdening the International Bureau unnecessarily with examination functions, and the potential of forum shopping among applicants, if an Office of origin could be used to examine limitations to be enforced in a different designated Contracting Party.

160. The Delegation of Australia supported the proposed amendments to Rule 24(5), stating that the amendment would enable the International Bureau to help Offices of the designated Contracting Parties to identify when a limitation in a subsequent designation was not contained within the classes appearing in the international registration. The Delegation referred to the

proposed date of entry into force of February 1, 2019, and said it would not provide sufficient time to consult with its stakeholders and amend its national legislation to accommodate the amendments to Rules 17, 24 and 27. Given the Madrid Union Assembly suspension of entry into force of the previously adopted amendments to Rule 24(5)(a) and (d), the Delegation supported revoking the adoption of those amendments. The Delegation recognized that there were diverging opinions among the members on the exact nature of the certification function and whether this should include limitations, and it supported the continued ability of Offices of origin to assist applicants in drafting limitations, as part of an advisory role.

161. The Delegation of Australia also maintained its view that designated Contracting Parties should have the right to examine all limitations, to determine whether they fell within the scope of the international registration. The Delegation believed that the previously proposed amendments to Rule 24(5)(a) and (d), regarding the International Bureau's control of the classification of indications listed in the limited subsequent designation, would be beyond the scope of the International Bureau's mandate as provided for in Article 3(2) of the Madrid Protocol, and would place a heavy verification burden on the International Bureau.

162. The Delegation of New Zealand agreed with many of the comments made by the Delegation of Australia, and remained of the view that the designated Contracting Party was the most appropriate to examine limitations in all situations. This meant that the country subject to the effects of limitations were always in full control and responsible for the consideration of the scope of protection. That would provide some consistency as it would not result in a situation that varied depending on when the limitation was filed and who considered it. The Delegation believed that there was value in the Office of origin looking at a limitation, noting obvious errors and suggesting possible corrections, but ultimately the designated Contracting Party should be responsible. The Delegation confirmed its agreement with the proposed amendments to Rules 17, 24 and 27.

163. The Delegation of Japan remained unconvinced that Offices of designated countries should be responsible for the examination of the limitation. The revision of Rule 17 was proposed under the premise that designated countries were responsible for the examination of the limitation. Nonetheless, before introducing a specific provision, the Delegation believed that members should come to a conclusion as to what kind of roles the Office of origin, the Offices of designated countries and the International Bureau should play in the examination of limitations. The Delegation said that when reaching a conclusion, issues such as possible inconveniences borne by users under the current system, impact on operations at Office of origin and Offices of designated countries, and ways that the International Bureau could be involved in the examination of limitations, should be discussed.

164. The Delegation of Japan understood that the revision was being proposed because a Contracting Party had pointed out at the last meeting that there was nothing in the rules that enabled the Office of designated countries to refuse designations based on deficiencies in the limitation. The Delegation also understood that the implementation of the proposed revision was optional for each designated Contracting Party, and Offices would not be forced to implement it. However, the Delegation considered that there were some important issues to be addressed before it could agree on the proposed amendment. Firstly, in relation to users, the Delegation was not aware of any problems with respect to the examination of the limitation. As pointed out earlier, if the revision came into effect to allow a new reason for refusal, workload would be expected to increase to deal with additional Office actions. However, the Delegation was of the view that user opinions had not been surveyed enough on the matter. Secondly, the revised rule could have an impact on the operations of the Offices of designated countries, and some countries, including Japan, would need to revise their domestic laws and systems.

165. The Delegation of Japan added that the proposed new responsibilities of the Offices of designated Contracting Parties would have a negative impact, such as leading to longer delays and pendency in examination, and under such circumstances, the Delegation stressed that a hasty conclusion on the matter should be avoided. Accordingly, the Delegation could not support the proposed revision to Rule 17. The Delegation believed that further careful discussions on the matter, taking into account some of the issues mentioned, were needed.

166. The Delegation of China stated that the designated Contracting Parties, the Office of origin and International Bureau all had some responsibility in the examination of limitations. The Delegation believed the first step in the examination of limitations should be by the Office of origin. However, the designated Contracting Parties had the responsibility to check that the limitation complied with their legislation. Sometimes in the country of the Office of origin, the limitation was within the scope, but in the designated Contracting Parties, it was not. Also, some of the goods and services could be unacceptable in some countries. Therefore, the Delegation believed that the designated Contracting Parties had the right to examine limitations to determine whether the limited scope fell within the international registration.

167. The Delegation from Switzerland considered that there were three aspects of limitations that should be taken into account: As to the classification, the Delegation believed that this involved a simple examination and stated it had never been confronted with a limitation, which was filed subsequently that had additional classes to those in the initial registration. Concerning the scope of the limitation, the Delegation believed that to truly harmonize and centralize the practice, the International Bureau, through an additional delegation of competence, would be best suited to carry out this task. Concerning the wording of the limitation, the Delegation acknowledged that the wording could cause problems for some designated Contracting Parties. If there was a problem with the wording and it did not comply with the national practice, then the designated Office would still be able to state that the limitation was without effect in its territory. However, the Delegation stated that it believed that the key question of scope was something that the International Bureau would be in a position to examine, if resources and competencies were assigned to it.

168. The Chair summarized the discussions, highlighting that there was no real consensus and that it was difficult to find a way forward. However, the Chair indicated that there was some consensus in respect of two issues. It was clear that there had been some consensus, at least in respect of the Office of origin and its role to play in relation to international applications. The second consensus was that the International Bureau had a role to play in relation to classification in international applications. The Chair recognized that there was no consensus in respect of subsequent designations. Some members had expressed that they wanted a full-fledged examination by the International Bureau, whereas others did not consider that as needed. The Chair could only see one common minimal denominator, in the sense that the International Bureau, in relation to subsequent designations, should consider the classification issues as it did in international applications, at least that it should check the numbers of the classes, to determine if they corresponded.

169. The Chair, after considering the other proposals in the document in relation to the Common Regulations, proposed to end the discussions on Rules 17 and 27, given that it was clear that there was no consensus, and to continue discussions on the proposal in Rule 24, where there was some chance of agreement. The Chair explained that this topic had been discussed since 2010 without any suitable solution. The Chair invited delegations to provide further information and considerations on how to continue with the discussion on the topic.

170. The Representative of CEIPI raised concerns regarding the structure of draft Rule 17. The Representative noted that the wording of the heading of Rule 17(2) was not in harmony with the wording of proposed paragraph (2)(iv)*bis*. The Representative explained that the heading of Rule 17(2) stated “A notification of provisional refusal shall contain or indicate [...]”. The wording “shall contain or indicate” implied that the notification must include the items listed in Rule 17(2)(i) to (vii) that followed. However, the wording in the proposed

subparagraph (iv)*bis* stated that “the notification of refusal may state [...]”, indicating that the contents of notification of provisional refusal were optional rather than mandatory. The Representative suggested that should the contents of the proposal of Rule 17 be presented again for review in the next session, the contents of paragraph (2) should become paragraph (2)(a), containing the mandatory wording, whereas the optional wording should result in a separate subparagraph (2)(b).

171. The Representative of INTA indicated that he was uncomfortable with limiting the control of the classification by the International Bureau to just checking that there was not a new class number appearing. The Representative believed that the International Bureau, as guardian of the Nice Classification, had a responsibility to control the classification of subsequent designations as was the case for international applications, because the Offices of designated Contracting Parties relied on the International Bureau for that, and many Offices, if not all, did not challenge the classification decided by the International Bureau. Accordingly, the Representative had great difficulty in supporting the changes proposed in Rule 24 by adding paragraph (iv)*bis* and paragraph (3) or deleting the words appearing in paragraph (5).

172. The Representative of AROPI supported the remarks made by the Representative of INTA. If the International Bureau could take action, and it believed that it must take action in examination, users would have more consistency in the classification, and that would help the Madrid System to function better.

173. The Delegation of Switzerland noted that as far as it was concerned, there was an issue with the interpretation of the rules. The Delegation believed that it was premature to change the rules when there had been no agreement on the principles. The Delegation preferred to leave a consideration of Rule 24 for a time when there was some agreement on the role and the duties of the Offices.

174. The Chair reiterated that the Working Group had been trying to achieve full agreement on the principles for the last 10 years or so, without success. The Chair suggested taking a step forward, where at least there was some consensus. It was obvious that there was no consensus for the most part, and the Chair questioned the delegations on what should be done next, and asked again for ideas on how to proceed with the topic. The Chair invited the Secretariat to remind the Working Group of the history of the discussions, to help clarify the position and support the Chair’s proposed way forward to discuss Rule 24.

175. The Secretariat explained that the International Bureau had previously proposed a change to Rule 24(5) concerning the International Bureau’s examination of the classification of goods and services in a limited subsequent designation, set to come into force in 2017. However, the implementation of Rule 24(5) was suspended as it became clear that the International Bureau did not have the resources nor the skill set required to undertake such an examination. Furthermore, the control envisaged by revised Rule 24(5) would go beyond what is currently provided for in the legal framework, and the International Bureau did not have the mandate to conduct that kind of examination of limitations or to determine the scope of protection. The designated Offices would determine whether they could grant protection for a set of goods and services taking into account the limitation; the International Bureau would check that the class numbers corresponded with the main list of the international registration. Any further examination would result in a heavy burden on workload and a need for further IT and staff resources. It would be difficult to find resources having that kind of expertise to undertake a classification check going back many editions and versions. It was clear that there were also opposing interests there; some Offices considered that deciding on the scope was clearly and exclusively a role for an Office of a designated Contracting Party, while other Offices felt that should be a role for the International Bureau.

176. The Secretariat agreed with the Chair's conclusion that the only consensus was that the International Bureau could check that the class numbers corresponded with those of the main list of the international registration. The topic had been discussed for a number of years without any progress and the Secretariat doubted whether returning to the topic the following year would result in an agreement, given the number of opposing interests. Therefore, it was proposed that the International Bureau would only check the class number. The Secretariat made it clear that not agreeing to that proposal would not result in Rule 24(5) being revived. The Secretariat suggested, as a first step, hearing from the delegations further on how they wished to move forward.

177. The Delegation of Switzerland stated it would not like a change of the rule. Technically, the International Bureau could not record a limitation with a new class number, therefore the rule made no sense. The Delegation preferred to proceed with a more substantive discussion on the issue, following a better understanding of the practices of different Offices. When the challenges faced by the different Offices were better understood, a compromising solution might be found.

178. The Delegation of Switzerland acknowledged that it was the only Office against the adoption of amendments to Rule 24. The Delegation said that if there was no support from other Offices, it would reconsider whether or not it could accept the change. If, however, there was support, it would stand by its position.

179. The Delegation of France shared the desire of the Delegation of Switzerland to better understand the principal roles of each Office before progressing any further. The Delegation agreed that some form of survey or questionnaire to find out more about the practices of the different Offices of origin would be helpful before taking any further decisions.

180. The Chair stated that there was no consensus and there would be no need to look at the draft rules in the Annex of document MM/LD/WG/15/3. The Chair referred to comments made by the Delegations of Switzerland and France concerning a survey or questionnaire, and asked for input from the Secretariat as to what it was going to prepare for future meetings on the topic.

181. The Delegation of Italy considered 10 years a long time to spend on one issue and believed that steps forward should be made if possible. The Delegation supported the proposal put forward by France. Only after having a clearer background on the position taken in national Offices, would it be possible to move forward.

182. The Delegation of Germany recalled a previous question being asked about the range and level of services provided and tasks carried out by Offices of origin, where 69% stated that they assisted applicants in drafting limitations. The Delegation stressed it would rather not answer the same questions again and wondered whether the answers to the earlier questions could be utilized.

183. When responding to the Delegation of Germany, the Chair noted the questions were asked a long time ago, and asked the Secretariat to recall the details of the questionnaire.

184. The Secretariat recalled that the questionnaire was based on a proposal to delete the basic mark, to help determine the role of the Office of origin if the basic mark was deleted. It was possible to review the questionnaire to check whether any of the answers to the questions would be useful, however, a complete view was needed of the roles of the designated Offices, as well as the role of the International Bureau to have the complete picture concerning limitations.

185. The Representative of INTA noted earlier comments made by the Delegation of Japan, emphasized that the impact on users should be taken into consideration, and suggested that any questionnaire or invitation for comments should involve not only Offices or members, but also users, if that was possible.

186. The Chair concluded the discussions.

187. The Working Group agreed to request the International Bureau to:

(i) submit to the Offices of the Contracting Parties of the Madrid System and to users' organizations a draft questionnaire on the role of those Offices and of the International Bureau on limitations;

(ii) conduct a survey among Offices of the Contracting Parties of the Madrid System and users' organizations on the role of those Offices and of the International Bureau on limitations; and

(iii) prepare a document on the findings of that survey to be discussed by the Working Group at its next session.

AGENDA ITEM 6: OTHER MATTERS

188. Discussions were based on document MM/LD/WG/15/4.

189. The Chair invited the Delegation of the United Kingdom to present its position paper.

190. The Delegation of the United Kingdom stated that the paper set out the changes that the United Kingdom believed could happen quickly and that would have most benefit for users, Contracting Parties and the International Bureau itself. The paper followed the International Bureau's future paper and the Road Map, and many of the suggestions were contained in both, with the exception of the proposal to introduce full statements of grants of protection from all Contracting Parties, which the Delegation believed would strongly assist users and make the Madrid System even more popular. The Delegation noted that the second part of the proposal regarding the replacement and the list of registration numbers, might require a rule change and recognized that was not the straightforward procedural change that it had anticipated. Regardless, it invited Offices to share their thoughts, but noted that if there was little demand to make the change, it believed that the first part of the proposal still stood alone. The second proposal not contained in the future paper concerned the inclusion of an option for a search on a designation of the European Union, which would again provide greater certainty for users of the system. The Delegation thanked those delegations who had spoken and invited the thoughts of other delegations and user groups.

191. The Chair opened the floor for comments on document MM/LD/WG/15/4.

192. The Delegation of Singapore supported the proposal by the Delegation of the United Kingdom concerning the harmonization of timelines, as it would provide certainty to users. The Delegation had received feedback from its users that the provision of very tight timelines put them in a very difficult situation. This was especially so when the provisional refusal related to absolute grounds or relative grounds of refusal, whereby they would have to appoint a local representative in the designated country, as well as to collate evidence or perhaps obtain a letter of consent or negotiate with the owner of the earlier cited mark. This would require time, and if the timeline provided for the response was very tight, it put them in a very difficult situation.

The Delegation added that it would propose a reasonable time limit of at least one or two months for the holder to respond to provisional refusals. The Delegation also supported the proposal to provide a full statement of grant of protection to users. The Office of Singapore would issue a statement of grant of protection to holders once the mark was protected in Singapore, with the relevant details, regardless of whether it had been accepted for full protection or partial protection in respect of some goods and services.

193. The Delegation of the Czech Republic supported the proposal for harmonization of the response timelines, noting that its users had sometimes complained about the timing of the transmission of refusals by WIPO. Provisional refusals needed to be transmitted as rapidly as possible. Regarding fees, the Delegation believed that it would be good for WIPO to actually inform its users what the amount was going to be, and questioned whether it was possible to see the amount within the Madrid Monitor, as that would help with the problem of fake invoices.

194. The Delegation of Italy commented that the proposals provided some points for reflection and ideas that would make the Madrid System more user friendly, and it considered this to be the most important mission of the Working Group. The Delegation of Italy agreed with the proposal of clear deadlines of response in relation to WIPO notifications, and it would like to discuss the matter further. However, given that the document dealt with many different topics, the Delegation believed it would be beneficial to discuss each point separately; for instance, the Delegation did not agree with full statements of grant of protection. The Delegation asked for the thoughts of other delegations as to whether to divide the discussions and address each point separately.

195. The Delegation of China noted the request of the Delegation of Italy for a proposal by proposal discussion and asked the Chair for clarification.

196. The Chair clarified that all points might be addressed together.

197. The Delegation of China referred to the proposal by the Delegation of the United Kingdom concerning deadlines to respond to provisional refusals. The Delegation stated that those deadlines were mainly set out in the domestic laws of Contracting Parties. The International Bureau could strengthen its communication with Contracting Parties and, most importantly, improve its efficiency in transmission of correspondence, to ensure that holders did not miss the deadline to respond. The Delegation also believed that the information related to deadlines in Contracting Parties could also be made available online. The Delegation referred to the proposal concerning the second part fee, and stated that it believed that adding a box to form MM2 would make this more complicated. Furthermore, as the accounts of both applicants and the Office were involved, fees might be charged from the wrong account leading to confusion. The Delegation believed that it would be feasible to add a link in Madrid Monitor so that the applicant could make the payment. With regard to divergence of the classification of goods and services, the Delegation believed this, in most cases, was due to different understandings of the goods and services in question by the International Bureau, the applicants and the competent Offices, or due to language differences. To better serve the users and reduce unnecessary losses, the Delegation suggested that all relevant parties strengthen the communication to reduce, as far as possible, those cases. The Delegation believed that the fundamental solution was to harmonize the classification standards. With regard to statements of grant of protection, the Delegation believed it unnecessary to add detailed information in the local language in the statement, because even if information was added it could not be used as a certificate of registration. The China Office could not add the information in Chinese at that stage. However, the Delegation stated it could further explore its feasibility. With regard to the option for requesting a search upon designation of the European Union, the Delegation believed it was better not to add more boxes on the MM2 or MM4 forms, because that would only make the forms more complicated and lead to more errors; the forms should just set out the most basic requirements. Furthermore, the proposed boxes also involved fees and the calculation of such fees would add more work for the competent Offices and the International Bureau.

198. The Delegation of New Zealand said that it had received similar feedback from users in relation to a clear indication of timeframes and full statements of grant of protection. The Delegation believed that those would be welcome additions to the Madrid System.

199. The Delegation of Japan referred to paragraphs 6 to 8 of the document under discussion and noted that Japanese users had requested that the date of reply to Offices of designated countries be clearly marked on communications, such as provisional refusals. The Delegation referred to paragraphs 14 to 16 of the document and noted that it was aware that its industries wished that each designated Office would issue the statement of grant of protection, to facilitate the enforcement of trademark rights in each country. Therefore, the Delegation supported the proposal concerning the possibility of providing users, upon request, with international registration certificates to reflect the status of the mark in each designated country. With respect to the proposal regarding the statement of grant of protection, the Delegation recognized the fact that some Offices did not necessarily issue such statements. Therefore, the Delegation supported the idea that all Offices should provide such statement of grant of protection. However, the Delegation said that the contents of such statements and languages in which they were prepared should be carefully considered, taking into account the current practices of Offices of designated countries. The Delegation explained that the Japan Patent Office currently prepared the statement of grant of protection only in English, and it believed that it would be necessary to discuss whether there was a need for users to be provided with such statements in the three languages, namely English, French, and Spanish, in addition to the initial language of the host concerned.

200. With regard to paragraphs 17 and 18 of the document, the Delegation of Japan noted its support to the proposal which would provide useful options for Japanese users to have their trademark rights protected in the European Union. With regard to paragraphs 9 to 11 of the document, the Delegation considered that automated payment would not only facilitate users practice, but also streamline internal operation of Offices and therefore it supported the proposal described in paragraph 9 of the document. With respect to paragraph 10 of the document, the Delegation shared the view expressed by some users in that payment of the second part of the individual fee could sometimes be overlooked. Therefore, to address such unfortunate cases, the Delegation supported, in principle, the idea outlined, namely to provide a check box to allow the International Bureau to automatically charge the applicant's account or to add a pay reference to Madrid Monitor. The Delegation believed however that the details of such services needed to be further discussed.

201. The Delegation was of the opinion that a review of the two part payment system itself, mentioned in paragraph 11 of the document, needed to be carefully addressed. Removing the two-part payment system would result in additional work on the part of the applicant, who might have to request a refund when the protection was not granted. The Delegation highlighted that the system had been introduced in 2001, for the purpose of aligning the Madrid System with national trademark protection systems of some member countries. Japan's Trademark Act underwent the necessary amendments in 2002, to bring it in line with the modification of the Common Regulations. Restoring the current trademark Act to the original version before the 2002 amendment would be very difficult. To conclude, the Delegation suggested that the International Bureau should offer an improvement to its online services by adding another function, which automatically allowed or informed the applicant of the second payment, while maintaining the current two-part payment system of individual fees.

202. The Delegation of Denmark considered the harmonization of deadlines the right way forward as a benefit to users and the system as a whole. The Delegation noted that the document contained many topics also referred to in the Road Map, discussed at the last Working Group session, and therefore sought clarification from the International Bureau whether the topics contained in the document should be reviewed together with the Road Map.

203. The Delegation of Switzerland agreed that the proposals made by the United Kingdom would contribute to improving the Madrid System. The Delegation said, however, that it shared the reservation voiced by the Delegation of China concerning the additional option of searching upon a designation of the European Union. The Delegation considered adding this option to the form could further complicate the calculation of fees. The Delegation stated that, in general, it was open to an in-depth discussion on these points at the next meeting.

204. The Delegation of Belarus said that it was in favor of the proposal of harmonization of deadlines and it would also like to further discuss the harmonization of the specification of the goods and services, because that was a frequent problem for its users. The Delegation said it understood that the holder would like a specific document indicating its trademark rights, however, it was not currently in a position to issue full statements of grant of protection. The Delegation would work towards providing full statements, but that would take some time and it would not happen in the near future. As far as an automatic deduction of fees and a search for European Union designations were concerned, the Delegation said that its holders were less sensitive to those proposals.

205. The Delegation of Hungary supported in general the proposals set out in the document. However, the Delegation referred to the harmonization of the classification and explained, that as a country with a small language group, it had already put in a lot of effort in relation to the classification procedure with the European Union Intellectual Property Office (EUIPO). It proposed that the Madrid System started harmonization work with the trademark class system to make it easier for several countries to work together. The Delegation also mentioned that it was not clear whose workload it would be to prepare the full statements in all the working languages. It would be too much of a workload for the Office of origin to prepare every statement in three or maybe four languages.

206. The Delegation of the Russian Federation believed that it would be very difficult to resolve the issue of harmonization of deadlines, because such deadlines were set out in national legislation. The Delegation referred to paragraph 14 of the document and said that in accordance with the Protocol, the International Register was managed by the International Bureau, and that all applicants could request a statement of the status of the international registration. However, there was no obligation with regard to the protection of rights across different territories.

207. The Delegation of France supported the harmonization of deadlines for response to provisional refusals; however, the Delegation explained its Office was bound by national legislation that set out minimum and maximum time limits for responding to provisional refusals. Providing full statements for every designation would be extremely burdensome and would be very difficult to implement, therefore the Delegation could not support this proposal.

208. The Delegation of Italy agreed that the harmonization of time limits needed to respond to provisional refusals would be good for users. The Delegation also agreed to the proposal concerning the second part fee, even though that did not apply to Italy. The Delegation considered the harmonization of the classification a good proposal, and the Delegation mentioned that the examination guidelines concerning the classification of goods and services in the international application was a good instrument that WIPO had provided to national Offices and to users. With regard to the statement of grant of protection, the Delegation agreed with the comments made by the Delegations of Hungary and Belarus, and it believed that it was a good idea to provide users with a specific document for the grant of protection. However, the Delegation was concerned that it would cause an impossible amount of work for national Offices, and it suggested that the International Bureau provide such documents once it had received the list of the designations approved in the international registration. The International Bureau could produce a single statement of grant of protection, in three languages, English, French and Spanish.

209. The Delegation of the United States of America said that it had consulted the Road Map for future discussion topics and noted that the Working Group had already prioritized future discussion topics. The Delegation further noted that the document at hand raised some topics already considered and some new topics that the Working Group had not discussed. The topic of deadlines and classification discussions were already included in the Road Map for future work. The topic of universal statements of grant of protection was not included, but the Delegation would support its inclusion for discussion, as it had long supported this concept in the interest of increasing transparency of the system for users. As to the automatic deduction of the second part of the fees, the Delegation was concerned about the problem that would occur with an automatic process when, for example, there had been a change of ownership of an international registration or even a change in credit card information. On the topic of request for a search when designating the European Union, the Delegation noted that it had not received a similar request for such a feature from its users, and it would be interested in getting more input from its users and from the International Bureau to evaluate whether the benefits to users would outweigh the costs of implementation.

210. The Delegation of the Czech Republic remarked that in relation to the provision of full statements, it did not consider it necessary to include all of the products and services listed in the three languages, because this was already included in the registration by WIPO. Sometimes, the lists were very long, stretching to 10 pages per language. An international registration covering many designations could result in a sizable document; however, a statement relating to each country would be helpful.

211. The Delegation of Australia said it was heartening to see that many of the things that had been raised in the paper had already been considered in preparation of the Road Map. The Delegation stated that during the fourteenth session of the Working Group, the Delegation of Australia had made it clear that its focus for some time had been on user-centered design. The Australian Office engaged regularly with its users and conducted user research, to ensure that it responded to the needs of its stakeholders. The Delegation believed that this was reflected in the position paper, and, on that basis, it supported many of the topics that were raised and looked forward to discussing the issues in detail as part of the Working Group's consideration of the Road Map and in the Roundtable, if there was time.

212. The Delegation of Mexico noted its interest in making the deadlines for response to provisional refusals very clear. The Delegation explained that its users also found the procedures very complex. Regarding the automatic deduction of fees, the Delegation considered this very important, because it would facilitate the use of the Madrid System. With regard to the specification of goods and services, on the basis of its recent experience in studying international applications, the Delegation believed it necessary for Offices to collaborate with WIPO to obtain better lists of goods and services and to give assistance to users. The Delegation found other Offices thoughts on full statements of grant of protection interesting, given that it was quite new to the Madrid System and particularly as it had already been sending statements of grant of protection for every international registration.

213. The Representative of JPAA said that most issues discussed in the document were faced by users on a day-to-day basis. The Representative welcomed the proposal regarding provision of clear deadlines as well as statements of grant of protection. More accurate deadlines for response were important for users. For statements of grant of protection, the Representative of JPAA believed that there were two issues: despite Rule 18ter(1) of the Common Regulations, in some cases, applicants did not receive statements of grant of protection; and users needed a document equivalent to the certificate of registration, especially in countries where a certificate of registration was necessary to enforce rights.

214. The Representative of JTA, speaking on behalf of the users in Japan, supported the proposal in paragraphs 6 to 8 of the document. The cover page of a provisional refusal was in the language of the international application, in English for most Japanese users. However, the language of the provisional refusal could be Spanish. If the deadline was written in English on the cover page, this would be helpful for the users to recognize the deadline quickly.

215. The Representative of JIPA, on behalf of Japanese companies, welcomed the proposal by the United Kingdom and expected further proposals to be made in the next Working Group. The Representative also supported the expressed views by the Representatives of JPAA and JTA, that an additional box be added to the MM2 form, allowing WIPO to automatically charge the applicant for the second part of the fees, as this would be very beneficial for users.

216. The Representative of MARQUES referred to the harmonization of deadlines and reiterated that it believed that the first priority was clarity. The Representative highlighted that unclear deadlines caused serious concern for users and it would be appreciated if all Offices could indicate the actual deadline on the refusal notice. Given that the harmonization of deadlines could be a long term discussion, indicating such deadlines on refusals would be a good practical solution to help create some clarity. The Representative said that the issue of the second part fee was also a key issue of concern, particularly as there was a risk that rights could be lost where payment of fees were not received. Anything to help resolve that concern would be appreciated. The issue of whether there should be a second part payment could be discussed in accordance with the Road Map. The Representative noted from a user perspective that the more guidance on the classification of goods and services the better. In terms of the statement of grant of protection, the Representative was happy to see this being discussed. The Representative reiterated that clarity was a priority and certainty that a designation had been protected successfully was important. Also, clarity on the list of goods and services if there had been a limitation was necessary, either in the grant or protection documentation or online. The Representative considered clarity and certainty more of a priority than languages. Users needed to be aware of what was required to rely on the international registration in court. Some countries did not recognize an international certificate that might not be printed in its own script, so in those countries the users needed to go to the Office to obtain a proper certificate to actually prove that they had the rights. The Representative concluded by saying further discussions were needed on the issue.

217. The Delegation of Cuba shared the concerns raised by other delegations, regarding harmonization of deadlines, stressing that the issue had an impact on national law. The Delegation recalled that it had asked the International Bureau to publish the date on which it notified documents; the Office of Cuba then calculated the one-month deadline under its national law as from that date. Additionally, the provisional refusal document would clearly state that the one month-deadline should be computed from the date of notification by the International Bureau. The Delegation stated that such approach had not generated complaints from users. In some cases, the International Bureau had mentioned issues with certain international registrations and late notification to holders of provisional refusals. The Delegation said that it had been very useful for the Office to transmit to the International Bureau a statement of protection for each mark. The Office of Cuba would include the statements in the corresponding files, and when cases were discussed in the Courts of Justice, upon requests of holders, the Office would issue special certificates of registration on the basis of statements of protection. Where the classification of products and services was concerned, the Delegation stressed the need to intensely discuss in the Working Group and reach agreement on it. The Delegation mentioned the difficulties faced by Offices, which had to make decisions on files that would not contain correct classifications. Discussions with the International Bureau were needed to reach clarity on whether errors were attributable to the International Bureau or to the user.

218. The Representative of INTA found the document put forward by the Delegation of the United Kingdom interesting and believed that the proposals should be discussed further in more detail. The Representative agreed with comments made by other delegations and recalled that some of the proposals were already contained in the Road Map. The Representative further acknowledged that the Road Map contained a number of issues that had been prioritized as projects to be addressed in the short term, medium term and long term. However, the Representative believed that the outstanding issues in the Road Map should be prioritized with a high degree of flexibility, to take into account new requirements that might arise, and suggested that some time could be set aside in each session to determine what should be discussed at the next session. The Representative wished to draw specific attention to two of the items that were on the Road Map namely, new types of marks listed for discussion in the short term and the possible reduction in the dependency period listed for discussion in the medium term. The Representative explained that from October 2017, the EUIPO would no longer require graphic representation of certain non-traditional marks and, for example, audio or video files for sound and motion marks would be accepted. Audio files were also accepted by other countries. As such, the Representative believed it necessary to consider the consequences such practice would have on international registrations designating the European Union or other countries accepting audio or video files, and questioned how and when the International Bureau would be in a position to accept this type of representation. Given the potential consequences for applicants that wished to use their European Union or national mark with that type of representation as a basis for an international registration, the topic had now become urgent and should remain on the short term list of the Road Map.

219. The Representative of INTA questioned whether priority should be given to the review of a possible reduction of the dependency period to be discussed in the medium term only. The Representative explained that the Board of Directors of the INTA in March that year had adopted a Resolution recommending the reduction of the dependency period from five to three years. Though the dependency discussion was set to take place in the medium term, it would take some time to be discussed and it would be beneficial to initiate this discussion early. Many issues could be combined, for example, many of those raised by the Delegation of the United Kingdom could be dealt with fairly quickly. Other issues, however, would require longer consideration. The Representative concluded that it would be beneficial if the Working Group could devote some time to establishing priorities for its future work.

220. The Delegation of Germany supported the comments made by the Representative of INTA, and it also wished to mention the European Union Directive concerning graphical representation. The Delegation explained that the Office of Germany would also be changing its law soon to accept audio or video files. It appeared from discussions between the Office of Germany and the International Bureau that there could be issues concerning the use of the MM2 form and its requirement of graphic representation. As far as the Delegation understood, it would not be possible to apply for an international registration for a trademark that could not be graphically represented, accordingly, it was important to discuss the issue and find a solution to this problem.

221. The Delegation of Colombia expressed interest on the discussion of all the subjects included in the document presented by the Delegation of the United Kingdom, and prioritizing them. For the Delegation, harmonization of deadlines should be the first priority.

222. The Representative of JIPA agreed with the Representative of INTA on discussing the reduction of the dependency period from five to three years. Such a reduction in the dependency period would be welcomed and would encourage more use of the Madrid System.

223. The Chair invited the Secretariat to address the comments made by the delegations and to summarize its position.

224. The Secretariat referred to the previous session of the Working Group and the discussion concerning the future development paper. The Secretariat explained that the Road Map was the result of those discussions, and the topics set out in the Road Map were listed for discussion in the short term, the medium term and the long-term perspectives. The short term was initially set to cover meetings in 2017 and 2018; the midterm would continue from 2019 and onwards; there was no timing on the long-term perspective. In the short-term perspective, the topics listed for the Working Group were replacement, transformation, new types of marks and limitations. While the discussions on replacement and limitation had taken place during the current session, the Secretariat stated that discussions on replacement would continue at the next meeting, as well as discussions on new types of marks and transformation. Topics, such as harmonized time limits, fee revision and payment options, and the possible reduction of the dependency period were set for discussion in the medium term.

225. The Secretariat noted that some of the proposals, in the document presented by the Delegation by the United Kingdom, overlapped with topics already listed in the Road Map. The Secretariat noted that though a number of delegations had voiced a preference of the topics they would like to prioritize, there was not a consensus on the order of topics to be discussed in the future.

226. The Secretariat believed that the proposal, set out in paragraphs 6 to 8 of the document, covering clear deadlines and response to provisional refusals, could be linked to harmonized time limits to reply to provisional refusal set to be discussed in the midterm perspective in the Working Group. Further, paragraphs 9 to 11 of the document, concerning the proposal for automatic deduction of second part fees, could be linked to the discussion on fee revision and payment options set to be discussed in Working Group midterm perspective. The proposal for increased collaboration concerning goods and services specification, in paragraphs 12 and 13 in the document, could be linked to the discussion concerning reducing inconsistencies of classification practices, set to be discussed in the Roundtable in the midterm perspective, as well as the discussion on the classification principles in the Roundtable.

227. The Secretariat noted that there were two proposals that were not covered by the Road Map: the proposal for universal provision of full statements of grant of protection, described in paragraphs 14 to 16 in the document; and the proposal to request a search in the MM2 and MM4 forms when designating the European Union, as described in paragraphs 17 and 18 in the document. Given that some delegations had expressed support for those two proposals, the Secretariat proposed to add these two topics to be discussed in the Roundtable, in the midterm perspective.

228. The Secretariat concluded by saying that there was no clear border between the short term and the midterm perspective, and time permitting, it could be possible to move up topics from the midterm for discussion. However, topics, such as replacement, transformation, new types of marks and limitations would remain on the agenda for discussion next year. Should there be any time left for discussion of additional topics, the first prioritized topic for the midterm perspective would be the harmonized time limit to reply to provisional refusal, given the high level of support from those delegations who had spoken. The following order of the midterm perspectives would then be the possible reduction of dependency period, the fee revision and payment options, and finally the topic of correction, which would be the last topic to be discussed in the midterm perspective.

229. The Chair opened the floor for comments on the Secretariat's proposed way forward.

230. The Delegation of Denmark agreed with the Secretariat's proposed way forward and welcomed, in particular, the proposed Roundtable and midterm discussions.

231. The Delegation of Australia also agreed with the Secretariat's proposed way forward.

232. The Delegation of the United Kingdom thanked everyone for their comments and the International Bureau for its flexible approach.

233. The Delegation of Italy supported the Road Map as explained by the Secretariat, but highlighted the further need to consider and prioritize some of the important issues.

234. The Representative of INTA agreed with the comments made by the Delegation of Italy and the need to speed up discussions on some of the issues, particularly the issues that could be dealt with expeditiously. The Representative recalled that in the past there were two yearly sessions of the Working Group and suggested that some thought be given to having two yearly sessions in the future.

235. The Representative of MARQUES agreed with the suggestion by the Representative of INTA for two Working Group sessions a year, particularly in view of the outstanding issues to be addressed.

236. The Working Group agreed to amend the Road Map including a list of subjects to be discussed by the Working Group or its Roundtable, as set out in Annex II to the present document.

AGENDA ITEM 7: SUMMARY BY THE CHAIR

237. The Working Group approved the Summary by the Chair, as amended to take account the interventions of a number of delegations.

AGENDA ITEM 8: CLOSING OF THE SESSION

238. The Chair closed the session on June 22, 2017.

[Annexes follow]

PROPOSED AMENDMENTS TO THE COMMON REGULATIONS UNDER THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS AND THE PROTOCOL RELATING TO THAT AGREEMENT

See document MM/LD/WG/14/6, paragraph 13(iii) and Annex II. The text of Rule 21, as tentatively agreed by the Working Group at its fourteenth session, is reproduced below in a clean version. The proposed amendments under discussion are indicated in track-changes.

**Common Regulations under
the Madrid Agreement Concerning
the International Registration of Marks
and the Protocol Relating to that Agreement**

(as in force on [to be determined])

[...]

Rule 21

Replacement under Article 4bis of the Agreement or the Protocol

(1) *[Presentation of the Request]* The holder may, from the date of the notification of the designation, present a request for the Office of a designated Contracting Party to take note of the international registration in its Register. The request may be presented directly to that Office or through the International Bureau. Where presented through the International Bureau, the request shall be effected on the relevant official form.

(2) *[Contents of a Request Presented Through the International Bureau and Transmission]* (a) The request referred to in paragraph (1), where presented through the International Bureau, shall indicate:

- (i) the number of the international registration concerned,
- (ii) the name of the holder,
- (iii) the Contracting Party concerned,
- (iv) where replacement concerns only one or some of the goods and services in the international registration, those goods and services,
- (v) the filing date and number, the registration date and number, and, if any, the priority date of the national or regional registration or registrations which are deemed to be replaced by the international registration; and,
- (vi) ~~where paragraph (7) applies,~~ the amount of the fees being paid, the method of payment, or instructions to debit the required amount of fees to an account opened with the International Bureau and the identification of the party effecting the payment or giving the instructions.

(b) The International Bureau shall transmit the request referred to in subparagraph (a) to the Office of the designated Contracting Party concerned and inform the holder accordingly.

(3) *[Examination and Notification by the Office of a Contracting Party]* (a) The Office of a designated Contracting Party may examine the request referred to in paragraph (1) for compliance with the conditions under Article 4bis(1) of the Agreement or of the Protocol.

(b) An Office that has taken note in its Register of an international registration shall so notify the International Bureau. Such notification shall contain the indications specified in paragraph (2)(a)(i) to (v). The notification may also contain information relating to any other rights acquired by virtue of the national or regional registration or registrations concerned.

(c) ~~An~~ Where the request has been presented through the International Bureau and the Office ~~that has~~ of the designated Contracting Party concerned has decided not ~~take~~ to take note, ~~it~~ may so notify the International Bureau, which shall inform the holder accordingly.

~~(4) [Recording and Notification] The International Bureau shall record in the International Register any notification received under paragraph (3)(b) and shall inform the holder accordingly.~~

~~{(54) [Scope of Goods and Services Concerned by Replacement] The names of the goods and services listed in (a) The international registration is deemed to have replaced the national or regional registration or registrations shall be equivalent, but not necessarily identical, to those listed in only in respect of the goods and services covered by both the international registration that has replaced them and the national or regional registration or registrations.~~

~~(b) The names of the goods and services in the national or regional registration or registrations concerned by replacement shall be the same or equivalent to those covered by the international registration.}~~

(65) [Effects of Replacement on the National or Regional Registration] A national or regional registration or registrations shall not be cancelled or otherwise affected by the fact that they are deemed to be replaced by an international registration or that the Office has taken note in its Register of the latter.

(6) [Recording and Notification] (a) The International Bureau shall record in the International Register, as of the date of receipt by the International Bureau, any notification under paragraph (3)(b) complying with the applicable requirements.

(b) The International Bureau shall inform the holder of any notification recorded under subparagraph (a).

~~{(7) [Fees] (a) Where a Contracting Party requires a fee for the presentation of a request under paragraph (1), the request is presented through the International Bureau, and the Contracting Party wishes the International Bureau to collect that fee, it shall so notify the International Bureau Director General, indicating the amount of the fee in Swiss currency or in the currency used by the Office. A Contracting Party can notify changes in the required fee twice in a given calendar year. Rule 35(2)(b) shall apply mutatis mutandis.~~

~~(b) Fees or changes thereto will be applicable three months from the date of receipt by the Director General of any notification under subparagraph (a).~~

~~(c) Fees collected by the International Bureau on behalf of a Contracting Party under subparagraph (a) shall be credited to the account of that Contracting Party according to the procedure applicable to the fees payable for the designation of such Contracting Party.~~

~~(d) A request under paragraph (2) shall be subject to the payment of the fee specified in item 7.8 of the Schedule of Fees.}~~

PROPOSED AMENDMENTS TO THE SCHEDULE OF FEES

SCHEDULE OF FEES

(in force on [\[to be determined\]](#))

Swiss francs

7. *Miscellaneous recordings*

[...]

[7.8 Request presented through the International Bureau that the Office of one or more designated Contracting Parties take note of an international registration \(replacement\)](#) [\[to be determined\]](#)

[Annex II follows]

PROPOSED REVISED ROAD MAP – JUNE 2017

SHORT TERM

WORKING GROUP	ROUNDTABLE
Replacement	Classification principles ¹
Transformation	Correction
New types of marks	Correspondence of marks for certification purposes
Limitations	Marks in different scripts Fulfillment of requirements Examination practices of the International Bureau (publication of)

MEDIUM TERM

WORKING GROUP	ROUNDTABLE
Harmonized time limit to reply to a provisional refusal ²	Examination practices of the International Bureau (publication of)
Possible reduction of the dependency period	Reducing inconsistencies of classification practices ¹
Fee revision and payment options ³	Updated International Registration Certificates
Correction	Universal provision of full statements of grant of protection from all Contracting Parties ⁴ Option for requesting a search upon designation of the European Union ⁵

LONG TERM

Entitlement to file
Issues listed in IV of document MM/LD/WG/14/4 "Options Concerning Offices"
Review procedure
Scope of the list of goods and services (possible de-linking)

REPORTING TO ROUNDTABLE

Geographical coverage of the Madrid System

Performance framework

Time to process regular transactions (maximum processing time)

E-Madrid

[Annex III follows]

¹ Including "Divergent practices around goods and services specification – potential for increased collaboration between WIPO and designated Offices" (MM/LD/WG/15/4, paragraphs 12 and 13).
² Including "Provision of clear deadlines of response in relation to WIPO notifications, with these listed on the front page of communication" (MM/LD/WG/15/4, paragraphs 6 to 8).
³ Including "Automatic deduction of second part fees when designating countries with this requirement" (MM/LD/WG/15/4, paragraphs 9 to 11).
⁴ New topic (MM/LD/WG/15/4, paragraphs 14 to 16).
⁵ New topic (MM/LD/WG/15/4, paragraphs 17 and 18).



MM/LD/WG/15/INF/1
ORIGINAL : FRANCAIS / ENGLISH
DATE : 22 JUIN 2017 / JUNE 22, 2017

**Groupe de travail sur le développement juridique du système
de Madrid concernant l'enregistrement international des marques**

**Quinzième session
Genève, 19 – 22 juin 2017**

**Working Group on the Legal Development of the Madrid System for
the International Registration of Marks**

**Fifteenth Session
Geneva, June 19 to 22, 2017**

**LISTE DES PARTICIPANTS
LIST OF PARTICIPANTS**

*établi par le Secrétariat
prepared by the Secretariat*

I. MEMBRES/MEMBERS

(dans l'ordre alphabétique des noms français des membres/in the alphabetical order of the names in French of the members)

ALBANIE/ALBANIA

Rudina BOLLANO (Ms.), Director of Examination, General Directorate of Patents and Trademarks, Ministry of Economic Development, Trade and Industry, Tirana

ALGÉRIE/ALGERIA

Fayssal ALLEK, premier secrétaire, Mission permanente, Genève

ALLEMAGNE/GERMANY

Carolin HÜBENETT (Ms.), Head, International Registrations Team, Trade Marks, Utility Models, Designs, German Patent and Trade Mark Office, Munich

AUSTRALIE/AUSTRALIA

Celia POOLE (Ms.), Deputy Registrar General Manager, Trade Marks and Designs Group, IP Australia, Department of Industry, Canberra, ACT

AUTRICHE/AUSTRIA

Young-Su KIM, Legal Advisor, International Trademark Affairs, The Austrian Patent Office, Federal Ministry for Transport, Innovation and Technology, Vienna

BÉLARUS/BELARUS

Halina LIUTAVA (Ms.), Head, International Registrations Division, Trademarks Department, National Center of Intellectual Property (NCIP), Minsk

BRUNÉI DARUSSALAM/BRUNEI DARUSSALAM

Mohammad Yusri YAHYA, Second Secretary, Permanent Mission, Geneva

CAMBODGE/CAMBODIA

HENG Sombo, Deputy Director, Intellectual Property Department, Department of Industrial Property Rights, Ministry of Commerce, Phnom Penh

CHINE/CHINA

CAO Lina (Ms.), Deputy Researcher, International Registration Division, China Trademark Office (CTMO), State Administration for Industry and Commerce (SAIC), Beijing

CHYPRE/CYPRUS

Demetris SAMUEL, Counsellor, Deputy Permanent Representative, Permanent Mission, Geneva

Christina TSENTA (Ms.), Second Secretary, Permanent Mission, Geneva

COLOMBIE/COLOMBIA

Jorge Mario OLARTE COLLAZOS, Director, Dirección de Signos Distintivos, Superintendencia de Industria y Comercio (SIC), Ministerio de Industria, Comercio y Turismo, Bogotá D.C.

Juan Camilo SARETZKI-FORERO, Consejero, Misión Permanente, Ginebra

Daniela Carolina PÉREZ MAHECHA (Sra.), Pasante, Misión Permanente, Ginebra

CUBA

Clara Amparo MIRANDA VILA (Sra.), Jefa, Departamento de Marcas y otros Signos Distintivos, Oficina Cubana de la Propiedad Industrial (OCPI), Ministerio de Ciencia, Tecnología y Medio Ambiente, La Habana

DANEMARK/DENMARK

Hannah Holm OLSEN (Ms.), Director, Trademarks and Designs, Danish Patent and Trademark Office, Ministry of Industry, Business and Financial Affairs, Taastrup

Mikael Francke RAVN, Chief Legal Advisor, Trademarks and Designs, Danish Patent and Trademark Office, Ministry of Industry, Business and Financial Affairs, Taastrup

ESPAGNE/SPAIN

María del Carmen FERNÁNDEZ RODRÍGUEZ (Sra.), Jefa, Servicio de Examen de Marcas, Departamento de Signos Distintivos, Oficina Española de Patentes y Marcas (OEPM), Ministerio de Industria, Energía y Turismo, Madrid

Oriol ESCALAS NOLLA, Consejero, Asuntos Exteriores y Cooperación, Misión Permanente, Ginebra

ESTONIE/ESTONIA

Janika KRUUS (Ms.), Chief Examiner, Trade Mark Department, The Estonian Patent Office, Tallinn

ÉTATS-UNIS D'AMÉRIQUE/UNITED STATES OF AMERICA

Attiya MALIK (Ms.), Attorney-Advisor, Office of Policy and International Affairs, United States Patent and Trademark Office (USPTO), Department of Commerce, Alexandria

Karen STRZYZ (Ms.), Attorney-Advisor, Office of the Deputy Commissioner for Trademark Examination Policy, United States Patent and Trademark Office (USPTO), Department of Commerce, Alexandria

Theodore ALLEGRA, Chargé d'Affaires ad interim, Permanent Mission, Geneva

Robert WALLER, Minister-Counsellor, Multilateral Economic and Political Affairs, Permanent Mission, Geneva

Yasmine FULENA (Ms.), Intellectual Property Advisor, Permanent Mission, Geneva

Deborah LASHLEY-JOHNSON (Ms.), Intellectual Property Attaché, Permanent Mission to the World Trade Organization (WTO), Geneva

Kristine SCHLEGELMILCH (Ms.), Intellectual Property Attaché, Permanent Mission to the World Trade Organization (WTO), Geneva

FÉDÉRATION DE RUSSIE/RUSSIAN FEDERATION

Anna PHILIPPOVA (Ms.), Expert, Trademarks Division, Federal Institute of Industrial Property (FIPS), Federal Service for Intellectual Property (ROSPATENT), Moscow

Tatiana ZMEEVSKAYA (Ms.), Head, Means of Individualization Division, Department of Provision of State Services, Federal Service for Intellectual Property (ROSPATENT), Moscow

FINLANDE/FINLAND

Olli TEERIKANGAS, Head of Unit, Patents and Trademarks, Finnish Patent and Registration Office, Helsinki

FRANCE

Indira LEMONT SPIRE (Mme), chargée de mission, Direction juridique, Pôle international, Institut national de la propriété industrielle (INPI), Courbevoie

GÉORGIE/GEORGIA

Medea TCHITCHINADZE (Ms.), Head, Division of Trademarks and Geographical Indications, Department of Trademarks, Geographical Indications and Designs, National Intellectual Property Center (SAKPATENTI), Tbilisi

GRÈCE/GREECE

Dimitrios GIAGTZIDIS, Expert, Directorate of Commercial Property, General Secretariat of the Trade and Consumer Protection, Ministry of Economy, Development and Tourism, Athens

Christina VALASSOPOULOU (Ms.), First Counsellor, Permanent Mission, Geneva

HONGRIE/HUNGARY

Katalin LADANYI (Ms.), Trademark Examiner, Trademark, Model and Design Department, Hungarian Intellectual Property Office (HIPO), Budapest

INDE/INDIA

Virander Kumar PAUL, Ambassador, Deputy Permanent Representative, Permanent Mission, Geneva

Pawan Kumar PANDEY, Assistant Registrar of Trade Marks and Geographical Indications, Trade Marks Registry Ahmedabad, Office of the Controller General of Patents Designs and Trade Marks, Department of Industrial Policy and Promotion, Ministry of Commerce and Industry, Ahmedabad

Sumit SETH, First Secretary, Permanent Mission, Geneva

ISLANDE/ICELAND

Margrét HJÁLMARSDÓTTIR (Ms.), Head, Legal Affairs, Icelandic Patent Office, Ministry of Economic Affairs, Reykjavik

ISRAËL/ISRAEL

Sharon NIR-SHALOM (Ms.), Team Leader, Trademarks and Appellations of Origin, Israel Patent Office (ILPO), Ministry of Justice, Jerusalem

Merav BARON (Ms.), Senior Trademarks Examiner, Israel Patent Office (ILPO), Ministry of Justice, Jerusalem

ITALIE/ITALY

Renata CERENZA (Ms.), Expert, Trademarks Department, Italian Patent and Trademark Office (UIBM), Directorate General of Combating Counterfeiting, Ministry of Economic Development, Rome

JAPON/JAPAN

Takeshi MIKI, Director General, Trademark and Customer Relations Department, Japan Patent Office (JPO), Ministry of Economy, Trade and Industry, Tokyo

Kazuhiro KIMURA, Director, Trademark Policy Planning Office, Japan Patent Office (JPO), Ministry of Economy, Trade and Industry, Tokyo

Shinichiro HARA, Deputy Director, International Policy Division, Japan Patent Office (JPO), Ministry of Economy, Trade and Industry, Tokyo

Yuka TSUKAMOTO (Ms.), Deputy Director, Office for International Design Applications under the Geneva Act of the Hague Agreement and International Trademark Applications under the Madrid Protocol, Japan Patent Office (JPO), Ministry of Economy, Trade and Industry, Tokyo

Kenji SAITO, First Secretary, Permanent Mission, Geneva

KAZAKHSTAN

Natalya PAN (Ms.), Director, Department on Intellectual Property Rights, Ministry of Justice of the Republic of Kazakhstan, Astana

LETTONIE/LATVIA

Līga RINKA (Ms.), Head, International Trademark Division, Patent Office of the Republic of Latvia, Riga

LITUANIE/LITHUANIA

Jūratė KAMINSKIENĖ (Ms.), Head, Examination Subdivision, Trademarks and Designs Department, State Patent Bureau of the Republic of Lithuania, Vilnius

MADAGASCAR

Mathilde Manitra Soa RAHARINONY (Mme), cheffe, Service de l'enregistrement international des marques, Office malgache de la propriété industrielle (OMAPI), Antananarivo

MAROC/MOROCCO

Mouna KARIE (Mme), cheffe, Service des marques, Office marocain de la propriété industrielle et commerciale (OMPIC), Casablanca

Hassan BOUKILI, représentant permanent adjoint, Mission permanente, Genève

Khalid DAHBI, conseiller, Mission permanente, Genève

MEXIQUE/MEXICO

Jorge LOMÓNACO, Embajador, Representante Permanente, Misión Permanente, Ginebra

Juan Raúl HEREDIA ACOSTA, Embajador, Representante Permanente Alterno, Misión Permanente, Ginebra

Miguel Ángel MARGÁIN GONZÁLEZ, Director General, Instituto Mexicano de la Propiedad Industrial (IMPI), Ciudad de México

Eliseo MONTIEL CUEVAS, Director Divisional de Marcas, Dirección Divisional de Marcas, Instituto Mexicano de la Propiedad Industrial (IMPI), Ciudad de México

Pedro Damián ALARCÓN ROMERO, Subdirector Divisional de Procesamiento Administrativo de Marcas, Instituto Mexicano de la Propiedad Industrial (IMPI), Ciudad de México

María del Pilar ESCOBAR BAUTISTA (Sra.), Consejera, Misión Permanente, Ginebra

Magali ESQUINCA GUZMÁN (Sra.), Asistente, Misión Permanente, Ginebra

MONTÉNÉGRO/MONTENEGRO

Ana RUTOVIĆ (Ms.), Advisor, Industrial Property Department, Intellectual Property Office of Montenegro, Podgorica

MOZAMBIQUE

José Joaquim MEQUE, Director General, Industrial Property Institute (IPI), Ministry of Industry and Commerce, Maputo

Nacivia Safina GONÇALVES MACHAVANA MANJAMA (Ms.), Director for Information and Communication, Industrial Property Institute (IPI), Ministry of Industry and Commerce, Maputo

NORVÈGE/NORWAY

Sissel BØE-SOLLUND (Ms.), Senior Legal Advisor, Design and Trademark Department, Norwegian Industrial Property Office (Patentstyret), Oslo

Pål LEFSAKER, Senior Legal Advisor, Design and Trademark Department, Norwegian Industrial Property Office (Patentstyret), Oslo

NOUVELLE-ZÉLANDE/NEW ZEALAND

Steffen GAZLEY, Principal Trade Mark Examiner, Intellectual Property Office of New Zealand (IPONZ), Ministry of Business, Innovation and Employment, Wellington

OMAN

Sulaiman AL ZAABI, Legal Researcher, Legal Department, Ministry of Commerce and Industry, Muscat

ORGANISATION AFRICAINE DE LA PROPRIÉTÉ INTELLECTUELLE (OAPI)/ AFRICAN INTELLECTUAL PROPERTY ORGANIZATION (OAPI)

Jacqueline Taylord BISSONG EPSE HELIANG (Mme), cheffe, Service des affaires juridiques et du contentieux, Yaoundé

PHILIPPINES

Jesus Antonio ROS, Officer-in-Charge Assistant Director, Bureau of Trademarks, Intellectual Property Office of the Philippines (IPOPIL), Taguig City

POLOGNE/POLAND

Ała GRYGIEŃC-EJSMONT (Ms.), Expert, Trademark Department, Patent Office of the Republic of Poland, Warsaw

Ewa MROCZEK (Ms.), Expert, Receiving Department, Patent Office of the Republic of Poland, Warsaw

PORTUGAL

Rui SOLNADO DA CRUZ, Legal Expert, Legal Affairs Department, External Relations and Legal Affairs Directorate, National Institute of Industrial Property (INPI), Ministry of Justice, Lisbon

Vanessa SEMEDO (Ms.), Trademarks Examiner, Trademarks, Designs and Models Department, Trademarks and Patents Directorate, National Institute of Industrial Property (INPI), Ministry of Justice, Lisbon

João PINA DE MORAIS, First Secretary, Permanent Mission, Geneva

RÉPUBLIQUE DE CORÉE/REPUBLIC OF KOREA

SONG Kijoong, Deputy Director, Trademark Examination Policy Division, Korean Intellectual Property Office (KIPO), Daejeon

LIM Seongyong, Assistant Deputy Director, Design Examination Policy Division, Korean Intellectual Property Office (KIPO), Daejeon

RÉPUBLIQUE DE MOLDOVA/REPUBLIC OF MOLDOVA

Galina BOLOGAN (Ms.), Acting Head, International Marks, State Agency on Intellectual Property (AGEPI), Chisinau

RÉPUBLIQUE TCHÈQUE/CZECH REPUBLIC

Zlataše BRAUNŠTEINOVÁ (Mme), examinatrice, Marques internationales, Office de la propriété industrielle, Prague

ROUMANIE/ROMANIA

Catalin NITU (Ms.), Director, Legal and International Cooperation, State Office for Inventions and Trademarks (OSIM), Bucharest

Gratiela COSTACHE (Ms.), Head of Service, Legal and International Cooperation, State Office for Inventions and Trademarks (OSIM), Bucharest

ROYAUME-UNI/UNITED KINGDOM

Clare HURLEY (Ms.), Head of International and Brands Policy, UK Intellectual Property Office (UK IPO), Newport

Sian SIMMONDS (Ms.), International Team Manager, UK Intellectual Property Office (UK IPO), Newport

SINGAPOUR/SINGAPORE

Isabelle TAN (Ms.), Director, Registry of Trade Marks, Intellectual Property Office of Singapore (IPOS), Singapore

Constance LEE (Ms.), Senior Trade Mark Examiner, Intellectual Property Office of Singapore (IPOS), Singapore

SLOVAQUIE/SLOVAKIA

Anton FRIC, Counsellor, Permanent Mission, Geneva

SUÈDE/SWEDEN

Kristian BLOCKENS, Legal Officer, Designs and Trademarks Department, Swedish Patent and Registration Office, Swedish Patent and Registration Office (SPRO), Söderhamn

Johan NORDLUND, Legal Officer, Designs and Trademarks Department, Swedish Patent and Registration Office, Swedish Patent and Registration Office (SPRO), Söderhamn

SUISSE/SWITZERLAND

Tanja JÖRGER (Mme), conseillère juridique, Division du droit et des affaires internationales, Institut fédéral de la propriété intellectuelle (IPI), Berne

Julie POUPINET (Mme), juriste, Division des marques, Institut fédéral de la propriété intellectuelle (IPI), Berne

Sébastien TINGUELY, coordinateur marques internationales, Division des marques, Institut fédéral de la propriété intellectuelle (IPI), Berne

TADJIKISTAN/TAJIKISTAN

Farhad BOIROV, Head, Law Department, National Center for Patents and Information (NCPI), Ministry of Economic Development and Trade of the Republic of Tajikistan, Dushanbe

Mirzobek ISMAILOV, Head, Trademark Department, National Center for Patents and Information (NCPI), Ministry of Economic Development and Trade of the Republic of Tajikistan, Dushanbe

TUNISIE/TUNISIA

Nasreddine NAOUALI, conseiller, Mission permanente, Genève

TURQUIE/TURKEY

Elif YASIYAN OZMEN (Ms.), Trademark Examiner, Turkish Patent and Trademark Office (TURKPATENT), Ankara

Tuğba CANATAN AKICI (Ms.), Legal Counsellor, Permanent Mission to the World Trade Organization (WTO), Geneva

UNION EUROPÉENNE (UE)/EUROPEAN UNION (EU)

Kate HOGAN (Ms.), Political Officer, European Union Intellectual Property Office (EUIPO), Alicante

Myriam TABURIAUX (Ms.), Political Officer, European Union Intellectual Property Office (EUIPO), Alicante

II. OBSERVATEURS/OBSERVERS

AFGHANISTAN

Tariq Ahmad SARFARAZ, Director General, Afghanistan Central Business Registry and Intellectual Property, Ministry of Commerce and Industry (MoCI), Kabul

BÉNIN/BENIN

Chite Flavien AHOVE, conseiller, Mission permanente, Genève

BRÉSIL/BRAZIL

Fernando CASSIBI, Intellectual Property Researcher, National Institute of Industrial Property (INPI), Ministry of Industry, Foreign Trade and Services, Rio de Janeiro

CANADA

Iyana GOYETTE (Ms.), Manager, Policy and Legislation, Trademarks Branch, Canadian Intellectual Property Office (CIPO), Innovation, Science and Economic Development Canada, Gatineau

Stephanie GOLDEN (Ms.), Policy Analyst, Trademarks Branch, Canadian Intellectual Property Office (CIPO), Innovation, Science and Economic Development Canada, Gatineau

IRAQ

Nawar ALMAHMODI, Official, International Organizations and Conferences, Ministry of Foreign Affairs, Baghdad

M. Baqir Bahir Rasheed RASHEED, Second Secretary, Permanent Mission, Geneva

KOWEÏT/KUWAIT

Abdulaziz TAQI, Commercial Attaché, Permanent Mission, Geneva

MALAISIE/MALAYSIA

Zaitilakhtar Binti MOHAMED YUNUS (Ms.), Intellectual Property Officer, Trademark Division, Intellectual Property Corporation of Malaysia (MyIPO), Kuala Lumpur

MALTE/MALTA

Hubert FARUGIA, Counsellor, Permanent Mission, Geneva

PAKISTAN

Muhammad Irfan TARAR, Director General, Intellectual Property Organization of Pakistan (IPO-Pakistan), Islamabad

Mariam SAEED (Ms.), First Secretary, Permanent Mission, Geneva

SRI LANKA

Geethanjali RUPIKA RANAWAKA (Ms.), Director General, National Intellectual Property Office, Colombo

THAÏLANDE/THAILAND

Khachaphorn THIENGTRAKUL, Trademark Registrar, Department of Intellectual Property (DIP), Ministry of Commerce, Nonthaburi

III. ORGANISATIONS INTERNATIONALES INTERGOUVERNEMENTALES/
INTERNATIONAL INTERGOVERNMENTAL ORGANIZATIONS

EURASIAN ECONOMIC COMMISSION (EEC)

Samat ALIEV, Deputy Director of the Member of the Board, Minister for Economy and Financial Policy, Moscow

Elena IZMAYLOVA (Ms.), Head, Intellectual Property Protection Section, Business Development Department, Moscow

Ekaterina MYASNIKOVA (Ms.), Advisor, Intellectual Property Protection Section, Business Development Department, Moscow

OFFICE BENELUX DE LA PROPRIÉTÉ INTELLECTUELLE (OBPI)/BENELUX OFFICE FOR INTELLECTUAL PROPERTY (BOIP)

Camille JANSSEN, juriste, Département des affaires juridiques, La Haye

ORGANISATION MONDIALE DU COMMERCE (OMC)/WORLD TRADE ORGANIZATION (WTO)

Wolf MEIER-EWERT, Counsellor, Intellectual Property, Government Procurement and Competition Division, Geneva

Leticia CAMINERO (Ms.), Young Professional Program, Intellectual Property, Government Procurement and Competition Division, Geneva

IV. ORGANISATIONS INTERNATIONALES NON GOUVERNEMENTALES/
INTERNATIONAL NON-GOVERNMENTAL ORGANIZATIONS

Association communautaire du droit des marques (ECTA)/European Communities Trade Mark Association (ECTA)

Claire LAZENBY (Ms.), Trade Mark Attorney, Member of ECTA's WIPO-Link Committee, London

Association française des praticiens du droit des marques et des modèles (APRAM)/Association of Trade Mark and Design Law Practitioners (APRAM)

Mathieu PROT, observateur auprès de l'OMPI, Paris

Association japonaise des conseils en brevets (JPAA)/Japan Patent Attorneys Association (JPAA)

Chikako MORI (Ms.), Member, Tokyo
Yoshiki TOYANA, Member, Tokyo

Association japonaise pour les marques (JTA)/Japan Trademark Association (JTA)

Reiko HASE (Ms.), Member, Nagoya

Association romande de propriété intellectuelle (AROPI)

Eric NOËL, membre, Genève

Centre d'études internationales de la propriété intellectuelle (CEIPI)/Centre for International Intellectual Property Studies (CEIPI)

François CURCHOD, chargé de mission, Genolier

International Trademark Association (INTA)

Bruno MACHADO, Geneva Representative, Rolle

Japan Intellectual Property Association (JIPA)

Yuka KOBAYASHI (Ms.), Vice-Chairperson, Trademark Committee, Tokyo
Toru SUGISAKI, Vice-Chairperson, Trademark Committee, Tokyo

MARQUES – Association des propriétaires européens de marques de commerce/
MARQUES – Association of European Trade Mark Owners

Tove GRAULUND (Ms.), Member, MARQUES International Trade Mark Law and Practice Team, Copenhague

V. BUREAU/OFFICERS

Président/Chair: Mikael Francke RAVN (Danemark/Denmark)

Vice-présidents/Vice-Chairs: Isabelle TAN (Mme/Ms.) (Singapour/Singapore)

Mathilde Manitra Soa RAHARINONY (Mme/Ms.) (Madagascar)

Secrétaire/Secretary: Debbie ROENNING (Mme/Ms.) (OMPI/WIPO)

VI. SECRETARIAT DE L'ORGANISATION MONDIALE DE LA PROPRIÉTÉ INTELLECTUELLE (OMPI)/SECRETARIAT OF THE WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO)

Francis GURRY, directeur général/Director General

Binying WANG (Mme/Ms.), vice-directrice générale/Deputy Director General

Marcus HÖPPERGER, directeur, Service d'enregistrement Madrid, Secteur des marques et des dessins et modèles/Director, Madrid Registry, Brands and Designs Sector

Debbie ROENNING (Mme/Ms.), directrice, Division juridique, Service d'enregistrement Madrid, Secteur des marques et des dessins et modèles/Director, Legal Division, Madrid Registry, Brands and Designs Sector

Diego CARRASCO PRADAS, directeur adjoint, Division juridique, Service d'enregistrement Madrid, Secteur des marques et des dessins et modèles/Deputy Director, Legal Division, Madrid Registry, Brands and Designs Sector

Asta VALDIMARSDÓTTIR (Mme/Ms.), directrice, Division des opérations, Service d'enregistrement Madrid, Secteur des marques et des dessins et modèles/Director, Operations Division, Madrid Registry, Brands and Designs Sector

Glenn MAC STRAVIC, directeur par intérim, Division des systèmes informatiques de Madrid, Service d'enregistrement Madrid, Secteur des marques et des dessins et modèles/Acting Director, Madrid Information Systems Division, Brands and Designs Sector

Juan RODRÍGUEZ, juriste principal, Division juridique, Service d'enregistrement Madrid, Secteur des marques et des dessins et modèles/Senior Legal Officer, Legal Division, Madrid Registry, Brands and Designs Sector

Lucy HEADINGTON-HORTON (Mme/Ms.), juriste principale, Division juridique, Service d'enregistrement Madrid, Secteur des marques et des dessins et modèles/Senior Legal Officer, Legal Division, Madrid Registry, Brands and Designs Sector

Kazutaka SAWASATO, juriste, Division juridique, Service d'enregistrement Madrid, Secteur des marques et des dessins et modèles/Legal Officer, Legal Division, Madrid Registry, Brands and Designs Sector

Marie-Laure DOUAY (Mme/Ms.), juriste adjointe, Division juridique, Service d'enregistrement Madrid, Secteur des marques et des dessins et modèles/Assistant Legal Officer, Legal Division, Madrid Registry, Brands and Designs Sector

[End of Annex III and of document]