

Special Union for the International Registration of Marks (Madrid Union)

Assembly

Fifty-Seventh (25th Ordinary) Session
Geneva, July 6 to 14, 2023

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/64/1): 1 to 6, 9, 10(ii), 12, 15, 21, 26 and 27.
2. The reports on the said items, with the exception of item 15, are contained in the General Report (document A/64/14).
3. The report on item 15 is contained in the present document.
4. In the absence of the Chair of the Assembly, Mr. Willie Mushayi (Zimbabwe), Vice-Chair of the Assembly, presided as Acting Chair over the meeting; Ms. Loreto Bresky (Chile) was elected Chair of the Assembly; Ms. Anna Barbarzak (Poland) and Mr. Jérémie Fénichel (France) were elected Vice-Chairs.

ITEM 15 OF THE CONSOLIDATED AGENDA

MADRID SYSTEM

5. The Acting Chair welcomed two new Contracting Parties for which the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as “the Protocol”) had entered into force since the Madrid Union Assembly held its previous session in July 2022, namely, Belize and Mauritius.

6. Discussions were based on document MM/A/57/1.

7. The Secretariat indicated that document MM/A/57/1 proposed a number of amendments to the Regulations Under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as “the Regulations”) that were either technical or editorial in nature and highlighted those amendments that trademark holders would highly appreciate. Contracting Parties would be required to provide holders with a minimum time limit of two months, or 60 days, to respond to a notification of provisional refusal. This amendment would make it simpler for trademark holders to manage their portfolios. Understanding that some Contracting Parties might not be ready to implement the proposed change upon its entry into force, the amendment provided for a transitional period to give Contracting Parties time to amend their legal framework or their information technology systems. Contracting Parties that required a longer transitional period could notify the International Bureau accordingly. In addition, the proposed amendments would require that Contracting Parties indicate in the notification of provisional refusal the start and end dates of the time limit to respond to this notification. When the time limit started on the date on which the International Bureau had sent the copy to the holder, or the date on which the holder had received the copy, the International Bureau would indicate these dates in the communication of transmittal of a copy of the notification to the holder. This new provision would give holders clear information regarding the last day on which they could respond to a notification of provisional refusal. Furthermore, under the proposed amendments, all Contracting Parties would be free to send to holders, through the International Bureau, communications not covered by the Regulations, which would ensure that holders become aware, without delay, of actions initiated against their international registrations in the designated Contracting Parties and could take appropriate action. The Secretariat stated that other proposed amendments were editorial in nature. The document proposed that amendments to Rules 17, 18, 32 and 40 of the Regulations enter into force on November 1, 2023, while amendments to Rules 21, 23*bis* and further amendments to Rule 32 of the Regulations enter into force on November 1, 2024.

8. The Delegation of Serbia supported the adoption of the proposed amendments to the Regulations because their aim was to enhance the efficiency and effectiveness of the Madrid System. The adoption of the proposed amendments would provide right holders with further clarity and increased legal certainty. In particular, the adoption of the amendment that provided for a minimum time limit to respond to a notification of provisional refusal was another step forward in the right direction that would improve the international procedure.

9. The Delegation of the Russian Federation supported the work undertaken by the International Bureau to improve and enhance the convenience of the Madrid System by making it more user-friendly and attractive. The Delegation stated that work needed to continue on the expansion of the language regime of the Madrid System, in the context of the introduction of the Arabic, Chinese and Russian languages, and welcomed the intersessional technical consultations the Secretariat held on this subject. The Delegation stated that it hoped that those consultations and the information prepared by the Secretariat would help to move resolution of this very important matter forward.

10. The Representative of the Intellectual Property Latin American School (ELAPI) indicated that the proposed amendments would bring forward significant benefits because they would provide right holders with a minimum time limit to respond to a notification of provisional refusal, which would deliver certainty, give holders adequate time to present their responses effectively, and simplify the management of their portfolios. The requirement to notify the International Bureau of the length of the time limit to respond to a notification of provisional refusal and the fact that the International Bureau would publish this information would deliver increased legal certainty and transparency to holders and Contracting Parties alike. The adoption of the proposed amendments would strengthen the international trademark registration system. The Representative reiterated ELAPI's readiness to support the work of the Assembly of the Madrid Union, as well as the work of the various permanent committees and of the Member States, in particular, those in the Group of Latin American and the Caribbean Countries (GRULAC).

11. The Delegation of Jamaica announced that the Jamaican Parliament had adopted amendments to trademark rules that would allow the Madrid System to become fully operational in Jamaica. The Delegation indicated that it recognized the value and importance of the Madrid System and would constantly promote the use of the System on its website as well as on its social media platforms.

12. The Delegation of Morocco supported the proposed amendments to the Regulations, as they would provide holders with further clarity, and thanked the International Bureau for its support in promoting the Madrid System in Morocco.

13. The Madrid Union Assembly adopted the amendments to:

(i) Rules 17, 18, 32 and 40 of the Regulations Under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, as set out in Annexes I and III to document MM/A/57/1, with November 1, 2023, as their date of entry into force; and

(ii) Rules 21, 23*bis* and 32 of the Regulations Under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, as set out in Annexes II and IV to document MM/A/57/1, with November 1, 2024, as their date of entry into force.

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