

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

Assembly

**Forty-Fifth (26th Extraordinary) Session
Geneva, October 1 to 9, 2012**

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/50/1): 1, 3, 4, 5, 6, 7, 8, 10, 11, 12, 15, 16, 17, 18, 19, 20, 21, 30, 37 and 38.
2. The report on the said items with the exception of item 30 is contained in the General Report (document A/50/18).
3. The report on item 30 is contained in the present document.
4. Ms. Alexandra Grazioli (Switzerland), Chair of the Assembly, presided over the meeting.

ITEM 30 OF THE CONSOLIDATED AGENDA

MADRID SYSTEM

5. Discussions were based on documents MM/A/45/1, MM/A/45/2, MM/A/45/3 and MM/A/45/4.

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

6. The Chair opened the session and announced that three accessions to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as “the Madrid Protocol”) had taken place since the previous session of the Assembly. The Madrid Protocol had entered into force on July 25, 2012, with respect to the Philippines and on August 29, 2012, with respect to Colombia. Regarding New Zealand, the Chair added that the Madrid Protocol would enter into force on December 10, 2012. The Chair remarked that those accessions would bring the total number of Contracting Parties to the Madrid Protocol to 87, and the total number of members of the Madrid system to 88, with only one member bound exclusively by the Madrid Agreement. The Chair congratulated the new members of the Madrid Union.

7. In the absence of the Chair of the Working Group on the Legal Development of the Madrid System for the International Registration of Marks (hereinafter referred to as “the Working Group”), the Chair informed the Assembly of the recommendations of the Working Group, as set out in document MM/A/45/1. The Chair said that the document contained proposals for the amendment of three Rules 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of Marks and the Protocol Relating to that Agreement (hereinafter referred to as “the Common Regulations”), which were no longer applicable, namely, Rules 7(3)(b), 24(2)(a)(i) and 40(5).

8. The proposed date of entry into force of the amendments, if adopted, would be January 1, 2013.

9. The Delegation of China expressed its support for the proposed amendments.

10. The Assembly adopted the proposed amendments to Rules 7(3)(b), 24(2)(a)(i) and 40(5) of the Common Regulations, with a date of entry into force of January 1, 2013.

Madrid System Goods and Services Database: Progress Report

11. Discussions were based on document MM/A/45/2.

12. The Chair presented document MM/A/45/2: Madrid System Goods and Services Database Progress Report.

13. The Chair said that a new version of the Madrid System Goods and Services Database (G&S Database) had been made available on January 1 of this year in 10 languages and in full compliance with the tenth edition of the Nice Classification and she recalled that the objective of 40,000 terms had been reached. The Chair also indicated that a proposal had been made at the end of the progress report concerning the use of remaining funds to increase the linguistic diversity of the database.

14. The Delegation of China expressed its satisfaction at having a G&S Database in Chinese and stated that this database was of great importance since it would be much easier for Chinese applicants to prepare international trademark applications. The Delegation congratulated the Secretariat for the important progress that had been made in the preparation of the Chinese G&S Database. The Delegation of China said that it would continue to support the International Bureau of WIPO in the use of remaining project funds to assist certain national offices in the translation of the database and to continue to extend linguistic diversity and improve the relevancy of the database.

15. The Delegation of Sudan pointed out the importance of making available the G&S Database in Arabic and questioned the Secretariat on the fact that the Arabic language was not mentioned in paragraph 35 of document MM/A/45/2. The Secretariat explained that the Arabic language had been available online in the Goods & Services Manager since January 1 of this year, and that paragraph 35 was related only to the progress made in some languages between January 1 and the end of May 2012.

16. The Delegation of Switzerland stated that it had always encouraged initiatives designed to improve the predictability and speed of decision-making in the context of preparing and examining lists of goods and services in trademark applications and, therefore, strongly supported the creation of the G&S Database and congratulated the International Bureau for the progress that had been made to date. The Delegation added that the development of the G&S Database and the G&S Manager was of great interest not only to users, but also to offices. The Delegation of Switzerland indicated that given the usefulness of this tool for the daily work of offices and users of the Madrid system, it was vital that the necessary financial and human resources continue to be made available to ensure the smooth functioning and subsequent development of the tool and that the highest quality standards be maintained with respect to both. The Delegation of Switzerland added that it supported the efforts made by the International Bureau of WIPO to strengthen the relevance and linguistic diversity of the G&S Database, including the continued use of the remaining project funds to support the development and introduction of new languages, and the postponement of the related study on the introduction of new languages in the Madrid system.

17. The Assembly:

- (i) took note of the progress made in the implementation of the project of the Madrid System Goods and Services Database, as described in document MM/A/45/2;
- (ii) approved the use of the remaining cooperation funds (paragraph 37 of document MM/A/45/2), in order to financially help some offices to finalize the translation of the G&S Database for the purposes of making it available in languages not included in the pilot project relating to the feasibility of introducing additional languages in the Madrid system;
- (iii) approved the postponement of the study on the introduction of additional filing languages in the Madrid system (see paragraph 38 of document MM/A/45/2) and supported the efforts of the International Bureau of WIPO in further increasing the relevancy and linguistic diversity of the G&S Database; and
- (iv) took note of the proposal by the Secretariat to report to the Assembly in 2013 on the operational status of the implementation of the G&S Database.

Information Technology (IT) Modernization Program (Madrid International Registration System): Progress Report

18. The Chair presented document MM/A/45/3: Information Technology (IT) Modernization Program (Madrid International Registration System): Progress Report. The document outlined progress on the IT Modernization Program since the last Assembly of the Madrid Union. The document also served to update Madrid Union members on any change to the overall approach to the completion of the Program, as well as to notify any change to the Program schedule.

19. In presenting the document, the Chair reminded the Assembly of the request to endorse the transfer of the loan from the PCT Union to the Madrid Union for the financing of the Hague Union's contribution of the IT Modernization Program.

20. The Assembly:

- (i) took note of the status of implementation of Phase I of the Program;
- (ii) took note of the progress of Phase II of the Program;
- (iii) took note of the possibility of the reintroduction of Phase III of the Program; and
- (iv) endorsed the transfer of the loan from the PCT Union to the Madrid Union.

Review of the Proposal on Translations Requested by the Madrid Union Assembly

21. The Chair presented document MM/A/45/4: Review of the Proposal on Translations Requested by the Madrid Union Assembly.

22. The Chair noted that document MM/A/45/4 concerned two standing practices with respect to the translation of certain documents, which the Assembly, at its previous session, had requested the Working Group to review. The Chair stated that the Working Group had agreed to recommend that the Assembly continue to take note of the aforementioned practices, as described in the document under discussion, and that the Working Group had further agreed to recommend to the Assembly that it mandate the International Bureau of WIPO to undertake a review of the said practices after a period of three years, or earlier, at the request of the Working Group.

23. The Delegation of Spain stressed the importance of multilingualism in the United Nations system and reminded the Assembly of two basic principles clearly contained in report JIU/REP/2011/4, issued by the Joint Inspection Unit of the United Nations, concerning multilingualism. First, the equality of all official languages, which implied not just non-discrimination, but that the necessary efforts be undertaken to guarantee the equality of said languages, further taking into account the current trend towards monolingualism. Second, as had already been noted by the Delegation in its general statement, the risk of equating linguistic policy with inefficient spending susceptible to cuts which would deprive the former of

content. The Delegation recalled these as fundamental principles to be borne in mind when analyzing the current situation, which involved a translation backlog and practices which were contrary to the Common Regulations. The Delegation stated that it did not believe that the solution to the aforesaid situation was to continue insisting on a change to the Common Regulations, which would be the easy solution. The Delegation said that it wished always to be constructive and expressed its belief that the proposal to reap the benefits and advances afforded by technology and informatics, included in the recommendation made by the Working Group, would present the opportunity to try to resolve the challenge posed by the translation backlog, while at the same time fully implementing the Common Regulations. Moreover, the Delegation stated that information technology solutions could also facilitate the future transition to a Madrid system which would consider the use of additional official languages.

24. The Assembly:

- (i) continued to take note of the practice of the International Bureau concerning translation upon request of statements of grant of protection, following a provisional refusal, as well as the translation of the list of goods and services affected by a limitation, as described in document MM/A/45/4; and
- (ii) mandated the International Bureau, after a period of three years, or earlier at the request of the Working Group, to undertake a review of said practices in light of the views expressed by delegations and user-organizations in the Working Group, in light of ongoing developments, including information technology and automated translations.

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