

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

Assembly

**Fifty-First (22nd Ordinary) Session
Geneva, October 2 to 11, 2017**

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/57/1): 1, 2, 3, 4, 5, 6, 10, 12, 22, 30 and 31.
2. The reports on the said items, with the exception of item 22, are contained in the General Report (document A/57/12).
3. The report on item 22 is contained in the present document.
4. Mr. Nikoloz Gogilidze (Georgia) was elected Chair of the Assembly; Mr. Cui Shoudong (China) and Mr. Sumit Seth (India) were elected Vice-Chairs.

ITEM 22 OF THE CONSOLIDATED AGENDA

MADRID SYSTEM

5. The Chair opened the session and welcomed two new Contracting Parties that had acceded to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as “the Madrid Protocol”) since the last session of the Madrid Union Assembly (hereinafter referred to as “the Assembly”) in October 2016, namely Brunei Darussalam and Thailand. The Chair also congratulated Indonesia for the deposit of its instrument of accession to the Madrid Protocol and remarked that Indonesia would become the one-hundredth member of the Madrid Protocol, once its accession had entered into force on January 2, 2018. Finally, the Chair invited the Secretariat to introduce the only document for the Madrid Union Assembly, MM/A/51/1.

6. The Secretariat indicated that document MM/A/51/1 contains a progress report on the Madrid System Goods and Services Database and outlined the progress made during the period from June 2016 until June 2017 in the following main areas:

- The MGS Database replaced the former operational database of goods and services in order to alleviate all differences between the International Bureau acceptance status displayed externally in MGS and the acceptance status displayed to International Bureau examiners in the internal operational environment.
- As of March 2017, the MGS contained some 91,000 English terms acceptable by the International Bureau.
- Between June 2016 and August 2017, eight new countries joined the list of MGS-participating countries, thus bringing the number of Contracting Parties of the Madrid System displaying acceptance information in MGS to a total of 33. These countries are Australia, Brunei Darussalam, Canada (in the process of joining the Madrid System), Georgia, Iceland, Latvia, New Zealand and Viet Nam.
- Early January 2017, MGS was published in a version aligned with the 2017 version of the 11th edition of the Nice Classification (NCL11-2017), including the updated Explanatory Notes of the Nice Classification, in the 18 languages then available online.

7. The Delegation of Indonesia recalled that, on October 2, 2017, the first day of the Assemblies, the Minister for Law and Human Rights of Indonesia deposited Indonesia’s instrument of accession to the Madrid Protocol, which would make this country the one-hundredth member of the international trademark system. The Delegation said that the continued expansion of the Madrid System made it an increasingly important tool for trademark holders seeking to expand their businesses abroad and added that Indonesia’s accession to the Madrid System meant that Indonesian enterprises, in particular small and medium-sized enterprises (SMEs), would enjoy the benefits of centralized trademark registration and management, which would allow them to seek protection for their brands in more than 115 territories across the globe. The Delegation indicated that Indonesia, as a growing leader in the global marketplace and the fourth fastest growing G-20 economy, trusted that the Madrid Protocol would further contribute to Indonesia’s economic development. The Delegation stated that trademark registrations by Indonesian enterprises had remarkably risen from 12,000, in 2013, to nearly 26,000, in 2016. The Delegation added that Indonesian trademark applications accounted for 42 per cent of the total number of applications filed in the region of the Association of South East Asian Nations (ASEAN). The Delegation said that Indonesia hoped that its participation in the Madrid System would further increase those figures and that Indonesia looked forward to strengthening its cooperation with WIPO in the implementation of the Madrid Protocol.

8. The Delegation of the European Union, speaking on behalf of the European Union and its member states, welcomed Indonesia as the newest member of the Madrid System and congratulated Brunei Darussalam and Thailand on their accession to the Madrid Protocol. The Delegation noted that, as from October 1, 2017, the new European Union Trademark Regulation No. 2017/1001, had entered into force and added that, in parallel, all European Union member states were working towards implementing the new Trademark Directive No. 2015/2436, in their national trademark laws. The Delegation said that, deriving from a need for modernization, both the European Union Trademark Regulation and the Trademark Directive had repealed the requirement of graphical representability and replaced it with a general condition that the trademark must be capable of being represented on the register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor. The Delegation said that this change involved the introduction of technical alternatives to graphic representation in line with new technologies, which would bring the registration process closer to technical developments. The Delegation stated that the above-mentioned changes were expected to result in an increased number of applications and registrations of non-traditional trademarks in the European Union. The Delegation added that, following from the above, the European Union and its member states considered it of the utmost importance that European Union trademark applicants and holders had the opportunity to seek extended protection for non-traditional trademarks by using the Madrid route according to the same modernized conditions that would be available for them under the new European Union legislation. The Delegation stated that embracing the use of latest technologies in actual application practices would also facilitate the modernization, digitalization and enhanced user-friendliness of the Madrid System. The Delegation indicated that a potential situation in which there was lack of legal certainty on how WIPO would treat such non-traditional trademarks should be avoided. The Delegation stated that the European Union and its member states stood ready to work with the International Bureau and the members of the Madrid Union to find technical and legal solutions for adequate protection of non-traditional trademarks *via* the Madrid System.

9. The Delegation of the Russian Federation indicated that it had taken note of the document under discussion and requested the International Bureau to submit to the next session of the Assembly a new Report on the Madrid System Goods and Services Database, including information on its use. The Delegation said that the Russian Federation was prepared to continue its cooperation to improve the database and added that it supported the Secretariat's information and technology (IT) initiatives for the Madrid System.

10. The Delegation of Mexico congratulated Brunei Darussalam, Indonesia and Thailand for joining the Madrid System. The Delegation noted that the accession of these three countries not only confirmed the importance and usefulness of the Madrid System in the ASEAN region but, the Delegation added, the accession of Indonesia meant that two thirds of the member economies of the Asia-Pacific Economic Cooperation (APEC) forum were also members of the Madrid System, which confirmed the usefulness, importance and the trustworthiness of this system.

11. The Assembly of the Madrid Union:

(i) took note of the “Report on the Madrid System Goods and Services Database” (document MM/A/51/1), including its paragraph 33 related to the remaining project funds; and

(ii) requested the International Bureau to submit to the Assembly in 2018 a new Report on the Madrid System Goods and Services Database, including the use of remaining project funds.

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