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

Assembly

Fifty-Second (30th Extraordinary) Session Geneva, September 24 to October 2, 2018

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/58/1): 1, 2, 4, 5, 6, 11(ii), 12, 22, 29 and 30.
2. The reports on the said items, with the exception of item 22, are contained in the General Report (document A/58/11).
3. The report on item 22 is contained in the present document.
4. Mr. Nikoloz Gogilidze (Georgia), Chair of the Assembly, presided over the meeting.

ITEM 22 OF THE CONSOLIDATED AGENDA

MADRID SYSTEM

5. The Chair welcomed three 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 2017, namely Afghanistan, Indonesia and Thailand.

Report on the Madrid System Goods and Services Database

6. Discussions were based on document MM/A/52/1.

7. The Secretariat indicated that the document referred to the progress report on the Madrid Goods and Services Database (hereinafter referred to as “the MGS Database”) for the year 2017, contained in Annex XI to document WO/PBC/28/7 “WIPO Performance Report (WPR) 2016/17”. The Secretariat stated that, in January 2017, the MGS Database had been aligned with the 2017 version of the eleventh edition of the International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (Nice Classification), including its explanatory notes, in the 18 languages in which the MGS Database was available; and that, at the end of August 2018, the MGS Database contained 97,000 indications in English and 46,000 indications in French and Spanish which had been validated by the International Bureau. The Secretariat indicated that the International Bureau continued cooperating with Offices to display their acceptance of the indications available in the MGS Database and that acceptance information was being displayed in respect of 34 Contracting Parties and Canada, with six Contracting Parties added in 2017 and two in 2018. The Secretariat added that, with the inclusion of Georgian and Vietnamese, the number of languages in which the MGS Database was available would soon increase to 20. The Secretariat recalled that the initial project for the MGS Database, approved by the Assembly in 2009, as proposed in document MM/A/42/3 “Madrid System Database of Acceptable Indications of Goods and Services”, included a budget for the translation of the indications of goods and services into eight languages. The Secretariat further indicated that the project would close by the end of 2018, that remaining funds would be transferred to the regular budget and that future translation work would be covered under the regular budget.

8. The Delegation of South Africa, speaking on behalf of Brazil, Russian Federation, India, China and South Africa (BRICS), stated that it welcomed the linguistic expansion of the Madrid System and proposed the inclusion of both Chinese and Russian as official languages of the Madrid System.

9. The Delegation of the United Kingdom stated that the United Kingdom's decision to leave the European Union continued to be a major topic of discussion across many fora and it further indicated that developments on current negotiations were set out in the draft withdrawal agreement. The Delegation said that the United Kingdom sought to ensure that it properly fulfilled its aim of providing the greatest possible legal certainty for users, applicants and right-holders. The Delegation recalled that a designation of the European Union under the Madrid System included protection in the United Kingdom, but that, once the United Kingdom had left the European Union, this would no longer be the case. The Delegation indicated that it wished to stress that, for all scenarios, including the unlikely event of a no deal, the United Kingdom wished to ensure continuity of protection and avoid the loss of rights. The Delegation said that it was also working with WIPO to find a practical solution with a view to providing continued protection in the United Kingdom to trademarks designating the European Union under the Madrid System, including those for which protection was still pending.

10. The Delegation of Kazakhstan, speaking on behalf of the Group of Central Asian, Caucasus and Eastern European Countries (CACEEC), expressed its support for the proposal made by the Russian Federation at the Working Group on the Legal Development of the Madrid System for the International Registration of Marks (hereinafter referred to as “the Working Group”) regarding the inclusion of Russian as an official language of the Madrid System. The Delegation added that Russian was an official language in the Russian Federation and in Belarus, as well as in Kazakhstan and in Kyrgyzstan, further indicating that it was widely used as lingua franca in the Eurasian region. The Delegation stated that statistics showed growing interest in the Madrid System by applicants from countries in the above-mentioned region and noted that the number of international applications under the Madrid System filed in those countries had considerably increased. The Delegation stated that including Russian as an official language of the Madrid System would strengthen the positive trend in trademark applications originating from CACEEC countries, enhance the performance of Russian-speaking examiners and facilitate the processing of applications by intellectual property offices in the region.

11. The Delegation of China hoped that the MGS Database would continue to improve to provide more benefits to the broad users and expressed its support for the statement made by the Delegation of South Africa on behalf of BRICS.

12. The Delegation of the Russian Federation echoed the statement made by the Delegation of South Africa on behalf of BRICS. The Delegation indicated that it hoped the Secretariat would deliver an equally positive report on the functioning of the MGS Database during the next session of the Assembly, adding that the Russian Federation was prepared to continue extending its cooperation for the improvement of the MGS Database and the services it provided. The Delegation welcomed the decision to look into the possible expansion of the linguistic regime of the Madrid System taken by the Working Group. The Delegation recalled that, during the previous session of the Working Group, China and the Russian Federation had proposed the inclusion of, respectively, Chinese and Russian as official languages of the Madrid System, and underscored that Russian, one of the more widespread and most used languages in the world, spoken by some 250 million people, was the official language in several countries and was widely used as lingua franca worldwide. The Delegation stated that the Russian Federation was closely integrated with the Madrid System and was among the countries with the largest number of international registrations. The Delegation added that, over the previous three years, there had been a steady increase in the number of applications filed in the Russian Federation and that such increase had been close to 30 per cent in the previous year. The Delegation expressed its belief that the use of computerized translation technology developed by WIPO, as well as the inclusion of Russian in the MGS Database, would considerably decrease the cost of including Russian as an official language of the Madrid System. The Delegation stated that such change would make the intellectual property protection system more accessible for applicants and would help further increase the number of international applications, not only from the Russian Federation, but also from other Russian speaking countries.

13. The Delegation of Brazil expressed its support for the statement made by the Delegation of South Africa on behalf of BRICS, as well as those made by the Delegations of China and the Russian Federation. The Delegation stated that the expansion of the linguistic regime of the Madrid System was in the interest of all Member States and that Chinese and Russian were natural candidates for obvious reasons.

14. The Delegation of Switzerland stated that it was pleased with the increasing geographical coverage of the Madrid System. The Delegation explained the importance of the proper functioning of the Madrid System for Switzerland and stressed that the International Bureau should focus on the work that represented the essence itself of the international trademark registration system. The Delegation explained to mean first and foremost the development and

modernization of the Madrid System, adding that the proper functioning of the system was a key element for WIPO to fulfill its role as the provider of global trademark services. The Delegation emphasized that the attractiveness of the Madrid System for its users was closely linked to the quality of the international registrations, which implied short processing times, reliable protection titles, adequate information technology solutions and tools adapted to needs. For this reason, the Delegation welcomed the measures taken by the International Bureau and followed with interest the development of the new information technology platform. The Delegation also welcomed the performance audit made by the External Auditor and referred to its comments made under Agenda Item 11. The Delegation stated that the MGS Database was a tool that was greatly appreciated by users and Offices alike and that Switzerland supported its development and encouraged other Member States to provide acceptance information. The Delegation welcomed the increase in the number of languages in the MGS Database and added that Switzerland would be interested in adding more terms. The Delegation finally expressed its support for the changes to 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”) that were being proposed to the Assemblies.

15. The Assembly of the Madrid Union took note of the “Report on the Madrid System Goods and Services Database” (document MM/A/52/1).

Proposed Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks

16. Discussions were based on document MM/A/52/2.

17. The Secretariat indicated that the document concerned proposed changes to the Common Regulations and consequential amendments to the Schedule of Fees. The Secretariat stated that the proposed change in name from the Common Regulations to Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks was highly symbolic, as it indicated that the Madrid Protocol was the sole treaty governing the Madrid System. The Secretariat recalled that, on October 11, 2016, the Assembly had decided to freeze the application of Article 14(1) and (2)(a) of the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as “the Madrid Agreement”), as a result of which countries could no longer accede to the Madrid Agreement only. The Secretariat explained that the proposed changes mainly consisted of the deletion of obsolete reference to the Madrid Agreement or to the Madrid Protocol from certain provisions and of provisions that no longer applied; the insertion of necessary references to the Madrid Protocol in certain provisions; and, the amendment of the transitional provisions. Finally, the Secretariat said that the suggested date of entry into force of the proposed changes was February 1, 2020.

18. The Assembly of the Madrid Union adopted the proposed Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, as well as the amendments to the Schedule of Fees, as set out in the Annex to the “Proposed Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks” (document MM/A/52/2), with February 1, 2020, as their date of entry into force.

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