

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

Assembly

Fifty-Eighth (33rd Extraordinary) Session Geneva, July 9 to 17, 2024

REPORT ON THE WORKING GROUP ON THE LEGAL DEVELOPMENT OF THE MADRID SYSTEM FOR THE INTERNATIONAL REGISTRATION OF MARKS

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”) held its twenty-first session, in hybrid format, from November 13 to 17, 2023.
2. The session was chaired by Ms. Marija Božić (Serbia). In total, 86 delegations from members of the Madrid Union, 13 delegations from other WIPO Member States and 16 observer organizations participated in the session. The Summary by the Chair of the twenty-first session of the Working Group is contained in document [MM/LD/WG/21/9](#).

FUTURE ELECTIONS OF CHAIRS AND VICE-CHAIRS

3. The Working Group adopted, with immediate effect, a transitional measure (document [MM/LD/WG/21/2](#)) to align the election cycle of its officers with Rule 9 of the General Rules of Procedure of WIPO, which consisted of electing officers to preside over both its twenty-first and twenty-second sessions.

4. The Working Group elected Ms. Marija Božić (Serbia) as Chair of the Working Group, Mr. Long Kemvichet (Cambodia) and Mr. Dustyn Taylor (Australia) as Vice-Chairs under the above-mentioned transitional measure. The Working Group agreed to elect its officers in accordance with Rule 9 of the General Rules of Procedure of WIPO as from its twenty-second session.

RECALCULATION OF INDIVIDUAL FEES

5. The Working Group discussed a proposal concerning the recalculation of the amounts of individual fees in Swiss francs, which concerned proposed amendments to Rules 35(2)(c) and (d) of the Regulations Under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to, respectively, as “the Regulations” and “the Protocol”).

6. Individual fees declared in a currency other than Swiss francs are converted at the most recent exchange rate. The proposed amendments (document [MM/LD/WG/21/3](#)) would require a recalculation of individual fees into Swiss francs if the currency in which they were declared devalues more than five per cent relative to the Swiss franc for longer than three consecutive months. Currently, a recalculation is required only when the currency devalues more than 10 per cent for longer than three consecutive months.

7. The proposed amendment aims to guarantee that holders of international registrations pay amounts equivalent to what they would have paid if they had filed a domestic application. There was broad support for this proposal and the Working Group decided to continue discussions at its following session.

DEPENDENCY

8. The Working Group took note of document [MM/LD/WG/21/4](#), in which the International Bureau stated that, as requested by the Working Group at its previous session, it would solicit proposals regarding dependency. In addition, the Working Group encouraged Contracting Parties, other WIPO Member States, and observer organizations to submit proposals or observations regarding dependency for their consideration at its twenty-second session. On February 12, 2024, the International Bureau sent Note C. M 1526 inviting recipients to submit the said proposals or observations no later than June 3, 2024.

9. The Working Group discussed a proposal presented by the Delegations of Australia, Chile, Ghana, the Philippines, the Republic of Korea, and the United States of America (document [MM/LD/WG/21/8 Rev.](#)) to introduce declarations in the Protocol that would provide for flexibilities regarding dependency and the basic mark requirement. The document also discussed other possible considerations regarding the principles of indirect filing, self-designation, and third-party central attack. The Working Group agreed to continue discussing this proposal at its twenty-second session.

10. The Working Group continued discussions on document [MM/LD/WG/20/5](#), which dealt with the possible amendment of Article 6 of the Protocol to reduce the dependency period to three years, described the procedure for convening a diplomatic conference and listed other possible amendments to modernize the text of the Protocol. The Working Group agreed to continue discussing the possibility to convene a diplomatic conference at a later session, based on possible proposals and observations regarding dependency submitted for its consideration.

UPDATED INFORMATION ON THE TIME LIMIT TO RESPOND TO NOTIFICATIONS OF PROVISIONAL REFUSAL AND ON THE WAY TO CALCULATE THEM

11. The Working Group took note of document [MM/LD/WG/21/5 Rev.](#), in which the International Bureau presented information it had compiled on the time limit to respond to notifications of provisional refusal in Contracting Parties and the way in which to calculate those time limits. Furthermore, the Working Group encouraged Contracting Parties to continue notifying the International Bureau of the information required under Rule 17(7) of the Regulations, as well as any change thereof, without delay.

UPDATED VERSION OF THE ROADMAP FOR THE EVOLUTION OF THE MADRID SYSTEM

12. The Working Group took note of document [MM/LD/WG/21/6](#), in which the International Bureau presented a new version of the Roadmap for the Evolution of the Madrid System, which had been updated to reflect contributions made by several delegations during the twentieth session of the Working Group. In addition, the Working Group requested that the Secretariat include the topics discussed in document MM/LD/WG/21/6 in the agenda of its future sessions.

REPORT ON TECHNICAL CONSULTATIONS HELD ON THE POSSIBLE INTRODUCTION OF NEW LANGUAGES AND PROPOSAL FOR A POSSIBLE WAY FORWARD

13. The Working Group discussed document [MM/LD/WG/21/7](#), in which the International Bureau reported on the technical consultations it conducted on the possible introduction of new languages and proposed a possible way forward. The document presented statistical information and proposed the introduction of technical measures that would be valuable for trademark holders independent of the possible introduction of new languages.

14. The Working Group requested that the Secretariat prepare a detailed draft implementation plan for the aforesaid technical measures for discussion at its twenty-second session. The draft implementation plan should cover, *inter alia*, cost estimates, source of funding and quality assurance, in particular with a view to making an enhanced goods and services terminology database available to the public, and for the possible introduction of new languages into this database.

15. In addition, the Working Group further requested the Secretariat to prepare, for its next session, a document containing updated statistics concerning paragraphs 88 to 101 of document MM/LD/WG/21/7, as well as an update on the development of specifications for the transmission of machine-readable data in communications from Offices described in paragraph 122 of document MM/LD/WG/21/7.

16. Finally, the Working Group agreed to continue discussing the possible introduction of new languages, including Arabic, Chinese and Russian, and requested that the Secretariat continue conducting technical consultations with interested Contracting Parties, WIPO Member States, and users' organizations.

MADRID WORKING GROUP ROUNDTABLE

17. Together with its twenty-first session, the Working Group organized its Madrid Working Group Roundtable, in which participants, over the course of one and a half days, exchanged information on legal, operational, and technical matters, such as, for example, electronic data exchange, classification practices, improving customer experience and developing promotional activities. The Program of the Roundtable and the presentations shared therein are available at the [meeting's webpage](#).

CORRECTION OF TYPOGRAPHICAL ERROR

18. The Working Group discussed the correction of a typographical error in Rule 32(2)(i) of the Regulations which contains a reference to Rule 40(7) of the Regulations (document [MM/LD/WG/21/3](#)) instead of one to Rule 40(8) thereof. The Regulations will be updated after the closing of the Assembly of the Madrid Union accordingly.

19. The Assembly of the Madrid Union is invited to take note of the "Report on the Working Group on the Legal Development of the Madrid System for the International Registration of Marks" (document MM/A/58/1).

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