

Working Group on the Legal Development of the Madrid System for the International Registration of Marks

Tenth Session
Geneva, July 2 to 6, 2012

SUMMARY BY THE CHAIR

adopted by the Working Group

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”) met in Geneva from July 2 to 6, 2012.
2. The following Contracting Parties of the Madrid Union were represented at the session: Algeria, Australia, Austria, Belgium, China, Colombia¹, Cuba, Cyprus, Czech Republic, Democratic People’s Republic of Korea, Denmark, Egypt, Estonia, European Union, Finland, France, Germany, Ghana, Hungary, Iceland, Iran (Islamic Republic of), Israel, Italy, Japan, Kazakhstan, Kenya, Kyrgyzstan, Latvia, Lithuania, Madagascar, Monaco, Morocco, Norway, Philippines², Poland, Republic of Korea, Romania, Russian Federation, Sao Tome and Principe, Serbia, Singapore, Slovenia, Spain, Sweden, Switzerland, Turkey, United Kingdom, United States of America, Zambia (49).
3. The following States were represented as observers: Dominican Republic, India, Iraq, Jordan, Mexico, Nigeria, Saudi Arabia, Trinidad and Tobago (8).

¹ On May 29, 2012, the Government of Colombia deposited its instrument of accession to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks. The Madrid Protocol will enter into force with respect to Colombia on August 29, 2012.

² On April 25, 2012, the Government of the Philippines deposited its instrument of accession to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks. The Madrid Protocol will enter into force with respect to the Philippines on July 25, 2012.

4. Representatives of the following international intergovernmental organization took part in the session in an observer capacity: Benelux Office for Intellectual Property (BOIP) (1).
5. Representatives of the following international non-governmental organizations took part in the session in an observer capacity: American Intellectual Property Law Association (AIPLA), *Association des praticiens du droit des marques et des modèles* (APRAM), Association of European Trademark Owners (MARQUES), *Association romande de propriété intellectuelle* (AROPI), German Association for the Protection of Intellectual Property (GRUR), International Association for the Protection of Intellectual Property (AIPPI), International Federation of Industrial Property Attorneys (FICPI), International Trademark Association (INTA), Japan Patent Attorneys Association (JPAA), Japan Trademark Association (JTA), Union of European Practitioners in Industrial Property (UNION) (11).
6. The list of participants is contained in document MM/LD/WG/10/INF/1 Prov. 2³.

AGENDA ITEM 1: OPENING OF THE SESSION

7. The session was opened by Mr. Francis Gurry, Director General of the World Intellectual Property Organization (WIPO).

AGENDA ITEM 2: ELECTION OF THE CHAIR AND TWO VICE-CHAIRS

8. Mr. Mikael Francke Ravn (Denmark) was unanimously elected as Chair of the Working Group, and Ms. Krisztina Kovács (Hungary) and Mr. Xu Zhisong (China) were elected as Vice-Chairs.
9. Ms. Debbie Roenning acted as Secretary to the Working Group.

AGENDA ITEM 3: ADOPTION OF THE AGENDA

10. The draft agenda (document MM/LD/WG/10/1 Prov. 3) was introduced by the Chair. The Working Group adopted the draft agenda, without modification. The adopted agenda is contained in the Annex to the present document.
11. The Chair reminded delegates that the Report of the ninth session of the Working Group had been adopted electronically, and that the Report of the tenth session would follow the same procedure.

AGENDA ITEM 4: PROPOSED AMENDMENTS TO THE COMMON REGULATIONS UNDER THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS AND THE PROTOCOL RELATING TO THAT AGREEMENT

12. Discussions were based on document MM/LD/WG/10/2.
13. A number of delegations expressed support for the proposed amendments and the Working Group agreed to recommend to the Madrid Union Assembly the proposed amendments to Rules 7, 24 and 40 of the Common Regulations, as set out in the Annex to document MM/LD/WG/10/2.

³ The final list of participants will be made available as an Annex to the Report of the session.

AGENDA ITEM 5: INFORMATION RELATING TO THE REVIEW OF THE APPLICATION OF ARTICLE 9SEXIES(1)(B) OF THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

14. Discussions were based on document MM/LD/WG/10/3.

15. There was consensus among the delegations that Article 9sexies(1)(b) of the Madrid Protocol should continue to remain unchanged, pending further review in the future.

16. The discussions concluded by agreeing that Article 9sexies(1)(b) of the Madrid Protocol would be reviewed by the Working Group after a period of three years. However, it was further agreed that any member of the Madrid Union, or the International Bureau may, in the *interim*, propose that the issue of the review of Article 9sexies(1)(b) be revisited at a time that is earlier than the said period of three years.

AGENDA ITEM 6: PROPOSAL FOR THE INTRODUCTION OF THE RECORDAL OF DIVISION OR MERGER CONCERNING AN INTERNATIONAL REGISTRATION BEFORE THE OFFICE OF A DESIGNATED CONTRACTING PARTY

17. Discussions were based on documents MM/LD/WG/10/4 (prepared by the International Bureau) and MM/LD/WG/10/6 (Proposal by Switzerland).

18. A number of delegations expressed support, in principle, for the introduction of a procedure which would allow for division of international registrations, it being understood, however, that the introduction of such a procedure would not oblige the Offices of Contracting Parties that did not provide for division at all, to implement such a procedure under the Madrid system. A number of delegations also expressed concern that the introduction of a procedure that would allow for division of international registrations should not have adverse practical consequences for the operation of the Madrid system as a whole and any such procedure should avoid introducing a mechanism that would increase the complexity of the system.

19. With regard to the proposal set out in document MM/LD/WG/10/4, prepared by the International Bureau, it was noted by many delegations that in most of the Offices of Contracting Parties the absence of a parallel registry at the national level could lead to difficulty for Offices if an international registration were to be divided at the level of a designated Contracting Party.

20. Many delegations expressed gratitude to the Delegation of Switzerland for its work in the preparation of document MM/LD/WG/10/6 (Proposal by Switzerland) for consideration by the Working Group. However, concerns were expressed by some delegations with regard to the proposal set out in that document in terms of the implications in the context of renewal of a divided international registration and the possible elimination of one of the single significant benefits of the Madrid system, namely, the renewal of the entire international registration through a single procedure.

21. A number of delegations expressed a desire for further clarification of the more precise practical differences between the proposals contained in the two documents under discussion with a view to more clearly establishing the consequences of the proposals contained in each and clarifying the relative advantages and disadvantages of each proposal. Those delegations also said that further information should be made available to the Working Group in order to facilitate a wider discussion of the issue and in order that the potential impact of the introduction of a procedure for division of international registrations be better understood.

22. It was agreed by the delegations that if a procedure for the division of international registrations were to be introduced, full information concerning such division should be made available in the ROMARIN database in a centralized format.
23. Concern was also raised by some delegations on the issue of fees that might be payable in connection with the division and later merger of international registrations. More particularly, one delegation raised the issue of the implications for the payment of the second part of a two-part fee, following the division of an international registration.
24. Another delegation indicated that, thus far, implications are unclear in cases where fees for division and merger remained unpaid.
25. Other delegations raised the issue of the possible impact on compliance with time limits, in the event that a procedure for division were to be introduced.
26. One delegation also spoke of the potential impact in the context of opposition procedures.
27. The Chair took note that all Representatives from user-organizations who spoke, unanimously expressed their support for the introduction of division in the Madrid system and that the majority of them welcomed and supported the proposal by Switzerland.
28. Upon completion of the discussions, the Chair concluded as follows:
- (a) The Working Group agreed that the International Bureau should prepare a further document for consideration by the Working Group at its next session, which would contain a new proposal on how it may be possible to introduce a mechanism that would allow for the division and merger of international registrations and/or designations under the Madrid system. Such document would take into account all the comments and concerns expressed at the current and previous session of the Working Group.
 - (b) In due course, the International Bureau would issue an invitation to the Offices of Contracting Parties and to user-organizations to provide comments in advance of the preparation of the document. That invitation would request the submission of any such comments before the conclusion of 2012.

AGENDA ITEM 7: REVIEW OF THE PROPOSAL ON TRANSLATIONS REQUESTED BY THE MADRID UNION ASSEMBLY

29. Discussions were based on document MM/LD/WG/10/5.
30. A number of delegations supported the proposal contained in the document, whereas others did not.
31. Some delegations spoke of the risk of dealing with the issue solely from an economic perspective and said that non-discrimination did not equate with equal treatment. In the context of the United Nations language policy, it was also mentioned that budget constraints should not be resorted to as a justification for unequal treatment. Furthermore, it was questioned whether sufficient efforts had been made to allow for the making of an informed decision, and concerns were voiced that the proposal could be seen as a means of giving legal sanction to a practice that was in contradiction of the Common Regulations and the legal certainty that this would entail.

32. Other delegations spoke of the need to maintain simplicity and a well-functioning system, and that a point had been reached where a flexible approach was called for, which would allow for a more rational allocation of resources and, at the same time, satisfy the needs of the users of the system. They were also of the opinion that the proposal did not in their view discriminate against any individual language or provide unequal treatment of the working languages of the Madrid system and supported the proposal by the International Bureau. Furthermore, reference was made to the difference between the United Nations multilingual policy and the working languages used in the Madrid system.

33. Furthermore, some delegations expressed the need for further consultation and analysis and, in this regard, made reference to what had been said earlier by the Secretariat in the context of developments, i.e., in the field of automated translations.

34. In view of the current situation in the Working Group, many delegations expressed that they favored a solution that would give the International Bureau further time to assess the issue of translations, taking into account the views and concerns expressed by the delegations.

35. Upon completion of the discussions, the Chair concluded as follows:

(a) The Working Group agreed to recommend to the Madrid Union Assembly that it continue to take note of the practices in place concerning translation.

(b) The Working Group further agreed to recommend to the Madrid Union Assembly that it mandate the International Bureau to, after a period of three years, or earlier at the request of the Working Group, undertake a review of said practices in light of the views expressed by delegations and user-organizations in the Working Group, and in light of ongoing developments, including information technology and automated translations.

AGENDA ITEM 8: OTHER MATTERS

36. The Chair took note that the Representative of one user-organization spoke of the change in practice at the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM), as a result of case law, concerning Nice Classification class headings, and the implications of this for applicants filing applications under the Madrid system for the international registration of marks designating the European Union or any individual member State of the European Union. In response, the Secretariat confirmed that discussions would take place between the concerned parties in due course.

AGENDA ITEM 9: SUMMARY BY THE CHAIR

37. The Working Group approved the Summary by the Chair, as amended to take account of the interventions of a number of delegations.

AGENDA ITEM 10: CLOSING OF THE SESSION

38. The Chair closed the session on July 6, 2012.

[Annex follows]



MM/LD/WG/10/1
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Working Group on the Legal Development of the Madrid System for the International Registration of Marks

Tenth Session
Geneva, July 2 to 6, 2012

AGENDA

adopted by the Working Group

1. Opening of the session
2. Election of the Chair and two Vice-Chairs
3. Adoption of the Agenda
See present document.
4. Proposed Amendments to the Common Regulations Under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement
See document MM/LD/WG/10/2.
5. Information Relating to the Review of the Application of Article 9*sexies*(1)(b) of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks
See document MM/LD/WG/10/3.
6. Proposal for the Introduction of the Recordal of Division or Merger Concerning an International Registration Before the Office of a Designated Contracting Party
See documents MM/LD/WG/10/4 and MM/LD/WG/10/6.

7. Review of the Proposal on Translations Requested by the Madrid Union Assembly
See document MM/LD/WG/10/5.
8. Other matters
9. Summary by the Chair
10. Closing of the session

[End of Annex and of document]