

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

**Twelfth Session  
Geneva, October 20 to 24, 2014**

### REPORT

*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”) held its twelfth session, in Geneva, from October 20 to 24, 2014.
2. The following Contracting Parties of the Madrid Union were represented at the session: Algeria, Antigua and Barbuda, Australia, Austria, Belarus, China, Colombia, Cuba, Cyprus, Czech Republic, Denmark, Estonia, European Union, France, Germany, Hungary, India, Iran (Islamic Republic of), Israel, Italy, Japan, Kenya, Latvia, Lithuania, Madagascar, Mexico, Montenegro, Morocco, New Zealand, Norway, Poland, Portugal, Republic of Korea, Romania, Russian Federation, Singapore, Spain, Sweden, Switzerland, Turkey, Ukraine, United Kingdom and United States of America (43).
3. The following States were represented as observers: Afghanistan, Bolivia (Plurinational State of), Brazil, Cameroon, Canada, Fiji, Honduras, Jordan, Libya, Malaysia, Panama, Saudi Arabia, Thailand and Togo (14).
4. Representatives of the following international intergovernmental organizations took part in the session in an observer capacity: African Intellectual Property Organization (OAPI), Benelux Office for Intellectual Property (BOIP) and World Trade Organization (WTO) (3).
5. Representatives of the following international non-governmental organizations took part in the session in an observer capacity: *Association des praticiens du droit des marques et des modèles* (APRAM), Association of European Trade Mark Owners (MARQUES), *Association romande de propriété intellectuelle* (AROPI), Centre for International Intellectual Property Studies (CEIPI), International Association for the Protection of Intellectual Property (AIPPI),

International Federation of Intellectual Property Attorneys (FICPI), International Trademark Association (INTA), Japan Patent Attorneys Association (JPAA) and Japan Trademark Association (JTA) (9).

6. The list of participants is contained in Annex II to this document.

## **AGENDA ITEM 1: OPENING OF THE SESSION**

7. Mr. Francis Gurry, Director General of the World Intellectual Property Organization (WIPO), opened the session and welcomed the participants.

8. The Director General stated that the Madrid System for the International Registration of Marks (hereinafter referred to as “the Madrid System”) was at an important stage in its more than 120-year history, as it was evolving into a truly global system with respect to the number of participants and in the degree of use of the system. The internal dimension in the transformation of the Madrid System was the need to improve service quality. During the last 12 months, the International Bureau had embarked on a major strategic plan for improving the Madrid System operation. This should lead in the course of the next two or three years to concrete results in terms of improved customer service, simplified procedures, increased productivity, a simplified fee structure and to an enhanced electronic operating framework, making it easier for users. The Madrid System had 92 Contracting Parties, of which 91 belonged to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as “the Protocol”). Algeria, the sole country which was party to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as “the Agreement”) only, would hopefully join the Protocol in the near future, thus making a unified and single system possible. A number of countries had advanced plans towards accession, namely Cambodia, the Gambia, Zimbabwe and OAPI. The Association of Southeast Asian Nations (ASEAN) had identified adherence to the Madrid System as one of the goals in the Intellectual Property Strategic Plan.

9. The Director General indicated that the Madrid System had its fourth successive year of activity growth after a decline following the global financial crisis in 2009. International applications had risen to over 46,000, which was an increase of 6.4 per cent compared to the preceding year. This year, the growth was not as high, but it was expected in the order of around 3 per cent. Germany, once again, was the country of origin from which the most number of applications were filed, followed by the United States of America and France. There was an increase in designations last year of 8.3 per cent. The average number of designations per international registration was 6.9. China remained the most designated country, followed by the Russian Federation and the European Union. The International Register had about 584,000 active registrations at the end of last year; they represented 5.6 million active designations and involved 192,000 trademark holders around the world. The electronic environment continued to evolve as a major part of WIPO’s strategic plan for improving the performance of the Madrid System. Fifty-two per cent of the international applications last year were transmitted electronically, involving 24 member States. Overall, the number of refusals, statements of grant of protection and modifications that were transmitted to the International Bureau electronically increased to about 420,000 documents last year. Sixty-five Offices had opted to receive communications electronically. The Working Group was to take the leadership improving the Madrid System as a truly global, practical and user-friendly system, as well as the preferred way of seeking and managing trademark protection internationally.

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

10. Mr. Mikael Francke Ravn (Denmark) was unanimously elected as Chair of the Working Group, Ms. Maria José Lamus Becerra (Colombia) and Ms. Mathilde Manitra Soa Raharinony (Madagascar) were unanimously elected as Vice-Chairs.
11. Ms. Debbie Roenning (WIPO) acted as Secretary to the Working Group.

## **AGENDA ITEM 3: ADOPTION OF THE AGENDA**

12. The Working Group adopted the draft agenda (document MM/LD/WG/12/1 Prov.), without modification.
13. The Chair reminded that the report of the eleventh session of the Working Group had been adopted electronically on September 18, 2014, and announced that the report of the current session would follow the same procedure.

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

14. The discussions were based on document MM/LD/WG/12/2.
15. The Secretariat introduced the proposals to change 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”), the Administrative Instructions and the Schedule of Fees, as a part of the ongoing exercise to make the Madrid System more user-friendly and attractive. Some proposals were based on requests from users and Offices, like the inclusion of a voluntary description of the mark in the application form as proposed for Rule 9, or to channel requests to Offices to take note of replacement through the International Bureau, as proposed for Rule 21. Proposed Rule 5 provided a relief if the electronic communication with the International Bureau had been disrupted and was beneficial for applicants, holders and Offices. The proposals concerning subsequent designations and limitations addressed Offices’ and users’ comments in previous Madrid Working Group Roundtables. The proposed amendments provided sufficient legal basis and insured a harmonized examination in the International Bureau without interfering with the substantive examination in the designated Contracting Parties. Some proposals were the result of IT modernization in the procedures of the International Bureau, like facilitating the use of e-forms or had a more technical character like the numbering of parallel designations.
16. The Chair invited general comments on the proposals.
17. The Delegation of Madagascar supported the introduction of a relief for failure of electronic communications and Internet services since they were increasingly used in the international registration of marks.
18. The Delegation of the European Union, on behalf of the European Union and its member states, reiterated strong support for the Madrid System to become simpler, more efficient, reliable, flexible, user-friendly as well as time- and cost-effective, where appropriate. The Delegation welcomed and supported some proposed amendments to the Common Regulations as an appropriate contribution to making the Madrid System more user-friendly and attractive. Two proposals required further clarification in order to better assess their merits: the proposals to examine the classification of subsequent designations under Rule 12 and

whether this classification was done in accordance with the International Classification of Goods and Services for the Purposes of the Registration of Marks (hereinafter referred to as the “Nice Classification”) in force at the time of the original filing. If not, there could be cases where the original application contained only 42 classes while the subsequent designation contained more.

19. The Chair opened the discussion on the proposal to amend Rule 5 relating to failure in electronic communications.

20. The Secretariat explained that Rule 5 provided for remedies where an interested party failed to meet a time limit for sending a communication to the International Bureau through a postal or delivery service. More and more communications were sent electronically, which was not covered by Rule 5. The previous session of the Working Group had requested the International Bureau to examine the possibility of including electronic communications in Rule 5. The proposed amendments provided for remedies for the late receipt of communications as the result of failure in electronic services. This placed electronic communications on equal footing with communications sent through postal and delivery services. New paragraph (3) applied when an interested party, meaning an applicant, holder, representative or an Office, failed to meet a time limit when sending a communication to the International Bureau by electronic means, such as email, fax or electronic forms. Current paragraphs (3) and (4) were proposed to be renumbered as paragraphs (4) and (5) and to include references to new paragraph (3). Rule 5 with its current wording had never been applied in practice. This did not mean that there had not been situations where it could have been used, rather that the International Bureau had been flexible with the time limits towards Offices and users when *force majeure* events had occurred. There were examples of an earthquake in Italy, ash clouds over Europe, a tsunami in Japan and an incident in WIPO where the communications services had been down during three days due to fire. The proposed amendments applied to failure due to a disruption of Internet services in the locality of the interested party. This could, for example, be a power failure, blackouts in a geographical region or that the Information and Communications Technology (ICT) provider in the geographical area was unable to provide services. It also applied to the electronic communication system of the International Bureau where examples could be disruption of downtime with online services, such as the e-Forms. If the applicant, holder or the Office wished to apply Rule 5 there needed to be evidence explaining the reason for the late receipt of a communication. Examples of evidence could be newspaper articles referring to power failure or an attestation by the ICT provider for failed services. There was no burden of proof on the applicant, holder or Office for submitting evidence to show that the failure was due to the electronic communication system of the International Bureau.

21. The Delegation of Italy remembered that Italy had been affected by an earthquake and climate problems, and voiced its support to the introduction of this measure for Internet failure, and also said that evidence and proof of *force majeure* events should not be required.

22. The Delegation of Switzerland stated that it would not need any further elements in the proposed Rule regarding the evidence that had to be provided. The relatively vague provision suited the Delegation. The Delegation requested the International Bureau to publish examples of documents that allowed using the provision to have a list of best practices of the application of this Rule.

23. The Delegation of Denmark asked for clarification on the scope of proposed Rule 5(3). Paragraph 6 of the document stated that the new Rule also applied to failure on account of a disruption of Internet services in the locality of the interested party; would this mean that the provision applied in any situation where an Internet service provider failed to deliver its services or would it only apply in special circumstances, for instance, if a whole region was without Internet access due to war, natural calamity or the like.

24. The Delegation of Kenya concurred with the Delegations of Switzerland and Denmark that the proposal addressed a real need. The Delegation was concerned that this provision could be abused since it was vague. If the mere indication of failure of the Internet provider services sufficed, that was the easiest excuse for an applicant or Office, and it would be important to have specific examples and provide limitations to this excuse for the failure to communicate in time.

25. The Delegation of Colombia agreed with the new Rule. The Delegation supported some paragraphs, but had comments on implementation. It was not the interested party that should have to prove to the satisfaction of the International Bureau that the system of the International Bureau had failed. This was a matter for the International Bureau and a declaration by the user should be enough. A limitation of the justification to six months was too long because communications were immediate nowadays. The delay could be reduced to a maximum of two months. Long time limits affected legal security, particularly the right of priority, and were not attractive for users.

26. The Delegation of Spain supported the proposed change to Rule 5, as it provided guarantees to users who had missed a time limit, and removed uncertainty when electronic communications with the International Bureau were disrupted. But there should be more about the evidence that the International Bureau considered to be satisfactory to prove the breakdown in the electronic communication system or the *force majeure*.

27. The Delegation of Mexico said that it had to be assessed whether the relief brought another burden to the Madrid System. Users could argue about legal security, but it was the responsibility of each Contracting Party's Office to determine whether arguments were valid. The International Bureau had certain criteria in place for events disrupting communications, such as war. Careful thought should be given to whether a criterion could be introduced without having to make far-reaching changes to the whole system.

28. The Delegation of New Zealand supported the proposal to provide safeguard for failure in electronic communication. As the Delegation of Denmark had said, paragraph 6 of the document noted that the new Rule could be used where an interested party provided evidence that their Internet service was not available, but that was not specifically stated in the proposed Rule. The failure on the part of the Internet provider might be one of the other reasons stated, as war, revolution, civil disorder, etc. Secondly, the Delegation wondered whether grounds, such as war, revolution etc. or local circumstances might be excluded. There could be something specific to the location of the party; it could be on the street or building that may not comfortably fall within the descriptions listed in the proposed Rule.

29. The Delegation of Morocco explained that users in Morocco mostly used electronic communication means, and the Delegation supported the proposal to include in Rule 5 irregularities in electronic communications affecting the time limit.

30. The Delegation of the United States of America sought clarification about whether the failure in the electronic communication system of the International Bureau encompassed the Office of the Contracting Party. If it did not, the Delegation suggested adding the language "or the Office of the Contracting Party" to the Rule.

31. The Representative of INTA supported the amendment to Rule 5 in general. However, as the Delegations of Denmark and New Zealand had said, the text of proposed Rule 5(3) did not address everything which was intended by the International Bureau. It addressed only failure in the electronic communication system of the International Bureau and not of the sender, except on account of war, revolution, civil disorder and the like. The intention to extend the Rule to failure in the communication system in the locality of the sender should be spelled out. One of the most important deadlines to be met in the Madrid System was the two-month deadline for

the Office of origin to forward the international application or subsequent designation to the International Bureau. This was not covered and should be covered by the proposed amendment. Besides, under Rule 5(1) and (2), which concerned the failure to meet a deadline due to disturbances in postal or similar services, one of the conditions for the excuse was that the communication be made not more than five days after the postal or delivery service is resumed. A similar condition should apply to electronic communications, otherwise the deadline would be automatically extended to six months as stated in draft Rule 5. This was not desirable. In Rule 5(3), the words "to send the communication" should be deleted. Most deadlines for communications were deadlines for receipt by the International Bureau. Finally, the Representative of INTA recalled that, at the last meeting of the Working Group, it had been suggested that the amendment to Rule 5 could possibly be harmonized with the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement Concerning the International Registration of Industrial Designs.

32. The Representative of JPAA concurred with the Representative of INTA that the proposed amendment to Rule 5 was not clear. This Rule should be applied to system failure in the locality of the users. Users hoped that Rule 5 addressed the communication failure in the area of the interested parties.

33. The Chair suggested that the Secretariat introduced the needed changes to the proposed Rule 5.

34. The Secretariat summarized the comments. The time limit of six months was considered too long. The last Working Group had expressed the thought that this new relief should correspond to the provision for postal and delivery services without looking at the time limits. Senders of electronic communications expected the delivery, but received a notification from the International Bureau that something was considered abandoned due to non-reply. This might take months after sending the communication. For this reason six months had been considered as sufficient for postal and delivery services as well as for electronic communications. The text in Rule 5(3) should clarify that something had an extraordinary character beyond the control of the interested party. The Rule would not apply if the wireless network in the Office was down because the service was not paid, for example. The situation had to be important and beyond control. The words "interested party" covered the applicant, the holder, the representative or the Office. The text would read: "Failure by an interested party to meet the time limit for a communication addressed to the International Bureau and submitted by electronic means shall be excused if the interested party submits evidence showing to the satisfaction of the International Bureau that the time limit was not met on account of war, revolution, civil disorder, strike, natural calamity, or any other like reason, or that the time limit for the communication was not met because of an extraordinary occurrence beyond the control of the interested party including failure in the electronic communication with the International Bureau".

35. The Chair said that two things were not covered by the rewording of Rule 5(3): the six-month period, which was seen as too long, and the five days. The Chair invited comments on these issues and the proposal by the International Bureau.

36. The Delegation of Canada suggested including a phrase referring to failure of the electronic communication system within the International Bureau and the locality of the interested party.

37. The Delegation of New Zealand suggested removing the reference to war, revolution, civil disorder, strike, natural calamity, etc. and to just retain the extraordinary occurrence aspect.

38. The Delegation of Colombia considered that six months might be too long for a decision of abandonment given that this was a situation of an extraordinary incident. It would accept five days, as indicated in Rule 4.

39. The Representative of INTA suggested that the Secretariat distribute a written proposal and that discussion on that basis be resumed at a later stage.

40. The Chair requested the Secretariat to prepare a written proposal for the afternoon session taking account of the comments made during morning.

41. The Delegation of Switzerland asked for clarification whether the proposal included text that already had been discussed in the Assembly of the Hague Union.

42. The Chair, being also the Chair of the Working Group on the Legal Development of the Hague System for the International Registration of Industrial Designs (hereinafter referred to as "the Hague Working Group"), did not recall that the issue had been discussed at the Hague Working Group though it should be discussed in the future. The decision in the Madrid Union Assembly could serve as example for the Hague Working Group. There should not be two different rules.

43. The Chair opened the discussion on the proposed amendment to Rule 9 regarding a voluntary description of the mark.

44. The Secretariat recalled that current Rule 9(4)(a)(xi) allowed including a description of the mark in an international application only when this description was present in the basic application or registration and when the applicant wished, or the Office of origin required it to be included. Some Contracting Parties required a description of the mark where the mark was in non-standard characters. When the description was not provided, the Office of such designated Contracting Party issued a provisional refusal. Then the holder might need to appoint a local representative, with additional costs, to overcome the refusal. A number of Contracting Parties had no requirement for a description of marks in the domestic law; there was no basic mark with a description and, therefore, no possibility for the applicant to include a voluntary description in the international application. Mexico, in the last Working Group, had identified this problem for users when they designated Contracting Parties having such requirement. Three amendments to Rule 9 were proposed: first, to delete Rule 9(4)(a)(xi) which linked the possibility to provide the description to the presence of such description in the basic application or registration; second to delete in Rule 9(5)(d)(iii) the reference to Rule 9(4)(a)(xi); and third to introduce a new Rule 9(4)(b)(vi) to allow the applicant to provide in the international application a voluntary description of the mark which may or may not be identical to the one in the basic application or registration. The applicant was free to include a description of the mark of his choice to meet the requirements of certain designated Contracting Parties regardless of whether such description was contained in the basic mark or had a different wording.

45. The Delegation of Madagascar supported the proposal. The obligation of certifying that an existing description was in line with the description in the basic registration led to difficulties in designated Contracting Parties where regulations were more rigorous resulting in constraints of the applicant. The proposal helped Offices to respect their rules and gave applicants better chances to have their applications approved.

46. The Delegation of Denmark supported the proposal to delete Rule 9(4)(a)(xi) and to insert a new Rule 9(4)(b)(vi). This change would provide a needed opportunity for applicants to respond to objections from designated countries requiring a description of the mark.

47. The Delegation of Italy stated that it was necessary in Italy to include a description of the mark in the basic application. The Delegation understood that the modification of Rule 9 solved problems for users and supported particularly the third proposal to introduce Rule 9(4)(b)(vi). It was important that the description did not need to be identical with the national description because Italy had problems in translating the description of the trademark correctly which caused many irregularity notices. It would be easier for Italy if the description could be slightly different, but still be the same, because the trademark was the same.

48. The Delegation of Switzerland was not in favor of the change. Even though a voluntary description was useful, it should not replace a description considered mandatory by an Office of origin to determine the object of protection. The Delegation suggested keeping Rule 9(4)(a)(xi) and adding the possibility for the right holder to propose a voluntary description of the mark in an international registration to avoid provisional refusals.

49. The Delegation of China supported the proposed changes to Rule 9 and the possibility to include a voluntary description of the mark which would allow meeting the requirements of a designated Contracting Party and which make the Madrid System more flexible.

50. The Delegation of Colombia supported the proposed amendments to this Rule because, in practice, there could be old marks with descriptions which should not be obstacles for users in other countries.

51. The Delegation of Cuba agreed with Switzerland that it was preferable to keep what the Rule already said and to introduce also a voluntary description. The Delegation expressed concerns that the International Bureau would not check whether the description was accurate, which should be done as a part of a formal examination.

52. The Delegation of the Republic of Korea supported the proposal. Besides, for non-standard characters, this proposal solved the cases of non-traditional marks. The Republic of Korea required a description for non-traditional marks and that might not be the same for all countries.

53. The Delegation of Kenya supported the proposed amendment because it accommodated different registration regimes in different countries. The International Bureau should not check the accuracy of such descriptions. The descriptions addressed different Offices and, therefore, the designated Contracting Parties should check if the descriptions met their requirements. This could be considered a more substantive examination rather than a formality examination.

54. The Delegation of Ghana declared that the application should mandatorily provide a description of the marks in the international application, whether it was in the basic application or not. A description in an international application could not vary from a description in the basic application for those countries where it was a requirement.

55. The Delegation of Norway agreed with Kenya and supported the entire proposal. The proposal introduced flexibility where there were divergent practices. Whether the description was sufficiently accurate was a matter for a designated Contracting Party and at the risk of the applicant.

56. The Delegation of Morocco stated that Morocco did not require a description of the mark and the domestic forms had no field for a description. When applicants wanted to extend the protection of their mark to other Contracting Parties, they often faced provisional refusals. The Delegation strongly supported this proposal to make the Madrid System more user-friendly and more used.



57. The Delegation of Germany supported the proposal in principle, but expressed the same doubts as the Delegation of Switzerland. Rule 9(4)(a)(xi) should not be deleted, but left as it was. There should also be an option for a voluntary description because, in Germany, some marks, especially non-traditional or color marks, needed a description. Otherwise, they could not be protected.

58. The Delegation of the United Kingdom supported both proposals for Rule 9. The question of whether the description was voluntary or mandatory seemed superfluous because if anything was voluntary, but if not done an irregularity was received, it became mandatory by nature. Therefore the Delegation supported the deletion of Rule 9(4)(a)(xi) and the inclusion of Rule 9(4)(b)(vi).

59. The Representative of INTA recalled that, the year before, INTA had supported the introduction of the possibility to include a description not subject to certification by the Office of origin where no description was contained in the basic application or registration. The proposal of the International Bureau went further. First, the Office of origin could no longer require that the description contained in the basic mark appeared also in the international application. Second, the description contained in the international application was no longer necessarily the same as in the basic mark. The Representative recalled the legislative history of Rule 9. In the original version of the Common Regulations, which were adopted in January 1996, before the entry into force of the Trademark Law Treaty, Rule 9(4)(a)(xi) required that, where the basic mark contained a description, that same description be indicated in the international application. That was an absolute requirement. In 1997, after the entry into force of the Trademark Law Treaty, the International Bureau had proposed to the Assembly of the Madrid Union that the applicant should be free to choose whether to include the description of the mark in the international application. However, where such description was included in the basic application or registration, the use of the same description continued to be obligatory. Some applicants and member States had had difficulties with this proposal and it had been postponed. In 2000, the International Bureau had referred the matter back to the Working Group and a compromise was reached which was the current text of Rule 9(4)(a)(xi). This was approved by the Assembly in 2001 and entered into force in 2002. The evolution of the provision coincided with the take-off of the Trademark Law Treaty which, as the Singapore Treaty on the Law of Trademarks (hereinafter referred to as "the Singapore Treaty"), prohibits the requirement of a description in the application. There was an expectation that, as the membership of the Trademark Law Treaty and the Singapore Treaty grew, the requirement of a description in the application progressively phased out. As the document pointed out, this requirement still existed in some Contracting Parties and, as long as it existed, it had to be accommodated. The merit in the proposal of the International Bureau was that it allowed the applicant to tailor the description given in the international application to the specific requirements of the designated Contracting Parties concerned, irrespective of the formulation of the description in the basic application, if there was any. It resulted from Rule 24(3)(c)(i) of the Common Regulations that a voluntary description could also be included in a subsequent designation. It could then be asked whether such a description was specific to that subsequent designation and, if so, whether it could differ from one subsequent designation to another. Obviously, that had consequences downstream, which had to be carefully monitored by the applicants. The Representative of INTA asked the Delegation of Switzerland to clarify whether the Representative's understanding was correct that the Swiss Office required that the description appearing in the basic application or basic registration also be included in the international application, but that, in addition, the applicant could have a complementary or additional description included in the international application.

60. The Delegation of Switzerland confirmed that it liked to have the option of requiring a description if it was in the basic mark and if it was considered necessary, but it also liked to authorize holders to include a voluntary description if they so wished.

61. The Chair summarized that a majority supported the proposal, but some Delegations wanted to keep in the Rule that a description in the basic application or registration should also be reflected in the international registration.
62. The Secretariat responded to the Delegation of Cuba that the wording or the scope of a description was not examined by the International Bureau. A description was recorded as received and notified to the designated Offices. The International Bureau ensured a translation into the working languages. The description was meant for the designated Offices. Some Delegations had supported the proposed amendments to Rule 9 and some Delegations wanted to keep the mandatory description, but also welcomed the introduction of a voluntary description. The common denominator was to keep the mandatory description, if the Office had such a practice, but to introduce the possibility for the applicant to provide a voluntary description, because this was meant to overcome a potential problem in a designated Office. A worst case scenario was to have two descriptions in the application form: the description in the basic mark, certified by the Office of origin, and another description that did not need to receive attention because the applicant provided it. Both could be different and the designated Office had to look at what they had received as notified, and take into account which of them it used for the determination of the scope of protection.
63. The Delegation of Italy asked whether there were two different fields for the description in the MM2 form, one checked by the International Bureau and the voluntary one.
64. The Chair confirmed the understanding of the Delegation of Italy.
65. The Delegation of Switzerland confirmed that the solution presented by the Secretariat was what the Delegation wanted. There were no problems for the holder, the Office of origin or the designated Office. The designated Office itself decided which value it gave to either description.
66. The Secretariat, in response to the comment from INTA that there was an effect on subsequent designations under Rule 24, stated that the provision just referred back to Rule 9(4)(b). Whatever description was in the international registration, it was there for the subsequent designations as well. The initial intention was to allow holders to include a description where there was none. The now proposed solution of a mandatory and voluntary description allowed holders to introduce any voluntary description in the form MM4 for a subsequent designation that appeared fit to overcome potential issues in designated Contracting Parties.
67. The Chair summarized that the proposal was to keep Rule 9(4)(a)(xi). Where the basic mark contained a description of the mark by words and the applicant wished to include the description, or the Office of origin had such requirement, that same description had to be included. Where the description was in a language other than the language of the international application, it had to be given in the language of the international application. That provision remained unchanged and in Rule 9(4)(b)(vi) it was added: "a voluntary description of the mark by words, in the international application or in any subsequent designation following that international application."
68. The Representative of CEIPI sought to understand the interest of both positions, that of the International Bureau which had received broad support and that of the Delegation of Switzerland, supported by the Delegation of Germany. Regarding the Swiss proposal, the Representative asked whether it was of practical interest to applicants and Offices or whether it just wished to retain the long established principle that there should be a perfect correspondence between the basic mark and the international mark. The Representative asked whether it was worthwhile sticking to this old principle if there was no practical interest for the applicant. The risk with that proposal was to introduce confusion in designated Offices which

could receive two descriptions, one as certified by the Office of origin and a supplementary description which was different. One possible solution could be to adopt the Swiss proposal, but to return to the issue within a time of two to four years and see whether it was working out in practice or whether the system should be simplified by adopting the International Bureau's proposal. Perhaps it should be clarified in Rule 9(4)(b)(vi) that this provision applied in two different circumstances, either where there was no description at all in the basic mark, or where there was a supplementary description.

69. The Delegation of France requested to receive the written text of the proposal of the International Bureau including the Swiss proposal.

70. The Chair explained that that proposal was simply not to delete what had been proposed to be deleted in Rule 9(4)(a)(xi) and to keep the proposed Rule 9(4)(b)(vi).

71. The Delegation of the Russian Federation said that the proposals were really aimed at simplifying the Madrid System and making it easier to use. Therefore, the Delegation supported the proposal to delete Rule 9(4)(a)(xi) because the applicant had the possibility of submitting a voluntary description under Rule 9(4)(b)(vi). This had not to be word for word the description as in the national registration, but could be a more detailed description.

72. The Chair summarized that there was no consensus on the deletion of Rule 9(4)(a)(xi), but there was consensus on the proposed Rule 9(4)(b)(vi). The Chair asked the Delegations for their views on the suggestion for further clarification made by the Representative of CEIPI.

73. The Delegation of Hungary supported the idea to add text to the current version of the proposed Rule 9(4)(b)(vi) because there could be uncertainty whether the criterion related only to the situation where there was a description in the basic application or registration or where there was no such description, but the applicant wished to add a voluntary description. The Delegation agreed with the Delegation of the United Kingdom. The Delegation thought that the Delegations of Switzerland and Germany wanted to keep the requirement, where there was such requirement by the Office of origin. On the other hand, where no such requirement existed, or no description was in the basic application or registration, there should be a way for the applicant to include a description.

74. The Delegation of Cuba recalled that this issue had been analyzed and discussed without agreement since the sixth session of the Working Group. The Delegation wondered about the situation where the original description and the description in the international application were different and the International Bureau would not carry out a formal examination. When a description of a mark went far beyond its reproduction, this might have repercussions on legal certainty.

75. The Chair agreed that the Delegation of Cuba had raised an important issue as had the International Bureau earlier. The International Bureau did not verify whether the description was accurate or correct; it was a matter for each designated Office to consider whether the description met the requirements under the national law. That could result in a refusal of the designation. The proposal was to make it possible for applicants to make a description of the mark tailor made to the jurisdictions that they had chosen to designate, as an improvement of the system which would make it easier for applicants to have their designations accepted in all designated countries.

76. The Chair opened the discussion on the proposal to amend Rule 21.

77. The Secretariat explained that also document MM/LD/WG/12/5 related to replacement. The proposal in document MM/LD/WG/12/2 concerned only the proposed amendment to Rule 21. Replacement was not effected by national or regional Offices, but was deemed to be automatic if the conditions were met. Articles 4*bis* of the Agreement and the Protocol required Offices to take note of replacement in their registers upon request. Under the current procedure of Rule 21, holders had to address each Office concerned. Offices, having taken note of replacement, were required to notify the International Bureau accordingly. The International Bureau recorded and published that fact in the WIPO Gazette of International Marks. Users had had troubles when they requested Offices of designated Contracting Parties to take note of replacement. The users association MARQUES had confirmed this problem in previous Working Group meetings. This was the background for the proposed amendment to Rule 21. It was a procedural change meant to simplify the procedures for users and Offices. The advantage for holders was the capacity to request Offices through the International Bureau to take note using an official form in one of the three working languages of the Madrid System and providing all sufficient information. Upon receipt of this form, the International Bureau recorded in the International Register that the holder had requested the Office concerned to take note of replacement, and notified the Offices concerned. The Office concerned had the possibility to send to the International Bureau a notification indicating that it had taken note of replacement or that it could not take note of replacement and stating the reasons for this decision. The proposed amendment should channel the requests through the International Bureau. It was not meant to entail more notifications from the designated Contracting Parties. Under the current procedure, Offices should notify the International Bureau and reply to holders directly, since the request was presented directly to them by the holders. The proposed procedure set out one notification only from the Offices concerned to the International Bureau which notified the holder.

78. The Delegation of Japan supported the proposal and suggested limiting the items to be filled in in the request form to the international registration number, the Contracting Party and the national registration number to be replaced.

79. The Delegation of Denmark welcomed the centralized approach for the notification of replacement. It asked for clarification whether the proposal took into account possible requirements under national law, particularly national administrative law which obliged a designated Office to hear the holder in situations where it found, upon examination of the request, that the conditions for replacement were not fulfilled and consequently had to refuse to take note of replacement. The administrative law in Denmark required the Danish Office to hear the holder making the request and to give an opportunity to appeal the decision to the Danish board of appeals.

80. The Delegation of Germany concurred with the Delegation of Denmark in having problems with this proposal. The Office also heard the holder before making a negative decision and the holder had the right to appeal. The proposal resulted in more work for the Office and caused high costs for the necessary procedural changes in the electronic system and for a new form. It added complication for the Office because the processes at WIPO did not run smoothly. For example, if the Office said that replacement could not take place, the file would have to be resubmitted to check whether WIPO had recorded in the register that the Office did not accept it. Usually this was not done. The file was not resubmitted to the official dealing with the case either. The Office had to send an email and did not receive a response, thus needing to send a reminder. It took very long to record something in the International Register and the Office needed to work on the file for two, three or four times which was burdensome for the Office and not useful for the holder. Germany had few cases, about two cases a year. Usually, the lists of goods and services were different in different countries. It might not help much to go via the International Bureau because the national mark to be replaced might not be exactly the same.

81. The Delegation of the United States of America supported regularizing the practice of replacement to promote more uniform use and interpretation. The USPTO offered a form to take note of the replacement of a national registration and charged a fee. The Delegation was comfortable with the International Bureau offering a standard form for users to request particular designated Contracting Parties to take note of replacement rather than have the USPTO collect the form, but it did not want the centralization of this process to be more complicated. The Delegation asked the International Bureau to collect the fee on behalf of the national Office and to forward the fee to the Contracting Party so that the process did not become more complex. The fee for replacement to be noted needed to be included in a new subparagraph (v).

82. The Representative of INTA saw merit in the proposal of the International Bureau insofar as it allowed the request to be filed in a working language of the international system, English, French or Spanish. The Representative remarked that it would have been preferable that the discussion on the question of replacement (under item 7 of the agenda) had taken place before. It had to be absolutely clear that the fact that the recording was not made in the national registers of the Contracting Parties concerned would not prejudice in any way the automaticity of the replacement under Article 4*bis*. The Representative suggested keeping in Rule 21(1) a reference to Article 4*bis* of both Treaties, as was the case now. Under Article 4*bis*, the Office of the Contracting Party did not note replacement, it noted the international registration. Some Offices examined the request for taking note in the national register and might rebut it if they considered that the conditions for replacement were not met, others did not. If they did not, the international registration was noted, the replacement was deemed to have taken place under Article 4*bis* and if there was litigation, the matter was decided by the judge. This reference in Rule 21 was absolutely essential and the text of Rule 21 should be corrected and refer to taking note in the register of the international registration under those Articles and not of the replacement. The remark by the Delegation of Denmark was essential. Those Offices examined the request for noting the international registration and rebutted the replacement after having given the holder of the international registration an opportunity to ask for review or appeal of the decision by the Office. A question of detail might be that Rule 21(1) stated that the request should be presented to the International Bureau on the relevant official form in one copy. That referred back to the paper filing system. In the future, the opportunities for filing electronically would develop. The Representative suggested deleting the words "in one copy". The Representative had sympathy for the remarks by Japan on Rule 21(1)(iv) which referred to any other rights acquired by virtue of that national or regional registration. This came from the text of Article 4*bis* and should be spelt out in more detail because the door could not be opened to anything being noted. In the proposed recording and publication by the International Bureau, these other rights acquired by virtue of the national original registration were not referred to, so this fell into a hole somewhere. The Representative confirmed that, if a fee had to be paid to a national Office for taking note, it was in the interest of all parties that the fee be collected centrally by the International Bureau. Regarding a time limit for sending the notification of note having been taken or not and the question of what the possible consequences or the failure to send that notification should be, the Representative believed that there should be no time limit and no consequence. Users expected that Offices did it and that helped third parties to get information. But at the same time, users feared that this would introduce the unnecessary requirement for a national Office to examine the request for the recording, and that was not a proper interpretation of Article 4*bis*.

83. The Delegation of Mexico said that the proposal helped centralize the administration of the International Register. Like the United States of America, Mexico had a fee to take note of replacement and would like to have it clarified in the form what the effects of replacement were.

84. The Delegation of Colombia supported the proposal to have a centralized system for replacement. Possibly the time of decision for a designated Office could be increased because if the International Bureau did not examine the mark, this burden was with the designated Office which might have an impact on the decision time for the designated Office.

85. The Secretariat responded to INTA that the reference in Rule 21(1) to Article 4*bis* could be kept and the words "one copy" could be deleted. Presumably, a paper request was sent in one copy. Preferably electronic forms were used. The last sentence of paragraph (1), relating to any other rights, could be deleted. A new small subparagraph (v) concerning fees, where required by a Contracting Party, could be added. Offices needed to inform the International Bureau about the respective fees. Regarding the recording and notification, today, when receiving a request from a holder to take note of the international registration in the register, an Office eventually informed the International Bureau. First, there might have been correspondence with the holder. Now it was proposed that an Office sent the notification to the International Bureau which informed the holder. Offices might have a system of provisional refusal giving the holder an opportunity to request a review or file an appeal. The final decision might still be subject to appeal in other judicial bodies and lead to a definitive final decision. Under draft Rule 21, Offices could inform the International Bureau of all decisions, including provisional refusals, indicating it being subject to review or appeal. The International Bureau informed the holder, who needed to get in touch with the Office. There might be other requirements as well, for example, that the discussion would be continued in the local language. The Office informed the International Bureau of the final decision, the International Bureau inscribed it and informed the holder. Everything could go through the International Bureau. An Office could wait until a final decision was taken before notifying the International Bureau and the International Bureau would have model forms available for the notification from the Office to the International Bureau like for other notifications to the International Bureau. These forms would have fields for information, such as review or appeal. The intention was to make it easier for the holder to request Offices to take note. It was already a simplification if the request could be channeled through the International Bureau to the Offices which decided what decisions were reported back to the International Bureau. In response to the remarks by the Delegation of Germany, the Secretariat said that there was now an opportunity to establish new streamlined procedures, including electronic communication, official forms and model forms, and reporting possibly through the Madrid Office Portal. The new and improved system could be in place though it would not be implemented right away. If there was agreement on this, the Assembly in 2015 could decide and give effect as of 2016. If Offices needed more time to change internal IT systems and procedures, transitional periods could be discussed.

86. The Chair added that that the real change was that the request came from the International Bureau on behalf of the holder. As today, every Office had an obligation to notify the replacement to the International Bureau. That meant centralization and, in addition, there was the proposal to include fees. It was for the respective Offices whether they sent provisional refusals or decisions directly to the holder or to the International Bureau, as long as the International Bureau was informed of the final decision.

87. The Delegation of Germany was not satisfied with the explanations because the internal procedures were not streamlined yet. The Delegation thought that the procedure resulted in much more complication for the holder because three parties were involved: the International Bureau, the national Office and the holder. Before, it was straightforward: the Office could communicate with the holders, inform them if the conditions for replacement were not met, discuss in the language of the Office and make a decision. Eventually, one notification was sent to WIPO without any explanations. If replacement was refused, nothing had to be sent to WIPO and nothing had to be recorded. If there was a uniform form for this procedure, the Office would have to change its electronic system which was costly for two cases a year.

88. The Chair asked the Delegation of Germany for clarification whether it disagreed with the requirement in Rule 21(3)(iii) that the Office states the reasons why it cannot do so or whether it disagreed with the entire proposal. The main gist of the proposal was to enable holders to make one request through the International Bureau which might involve different designated member States. One part of the proposal was whether designated Offices accepted to receive such request from the International Bureau. The other issue was, and that might be the reason for the problem, that the Offices should come back to the International Bureau either to inform that the Office had taken note of the replacement or, where the Office could not take note of the replacement, of the reasons why.

89. The Delegation of Germany clarified that it did not see any advantage in centralization because only few national trademarks had the same list of goods and services. Now the Offices could discuss with the holder directly without need for a notification to the International Bureau and without a third party involved. It would take much longer than before. Procedures at WIPO were not yet in place and Offices had to return repeatedly to WIPO until WIPO had recorded a notification that the Office did not accept replacement.

90. The Delegation of Italy accepted the proposal in general and agreed with a centralized approach to replacement. Also Italy had only few cases, maybe two to four a year. The Delegation could accept the centralized approach because it did not yet have an IT system installed and all documents were sent on paper to WIPO.

91. The Chair did not see consensus and asked for views of users since the proposal wanted to address their needs.

92. The Representative of MARQUES supported the revised proposal. It was meant to help users, even though it might help Offices less. Regarding the remarks by the Delegation of Germany on its preference to communicate with the holder in his own language, the Representative stated that, for the user, it was much better to communicate in only one language. The register helped to create transparency and transparency was helpful for users.

93. The Representative of AROPI supported the comment made by MARQUES. A centralized recording centralized information and made it possible to get these rights respected which might not happen if the information was not centralized. The small number of cases was due to the uncertainty in the present system and the difficulty for a user to streamline the portfolio to avoid having a multiplication of national and international rights. Further thought should be given to how this would be applied to ensure that the introduction of the system would not create problems for the delegations.

94. The Representative of CEIPI stated that it was obvious that the proposed procedure was useful for users and the fact that there were few cases did not mean that the proposal should be turned down.

95. The Chair informed that, in an informal discussion during the coffee break, it had been suggested having an implementation date for the amended Rule 21 not earlier than January 1, 2017. The Delegation of Germany reserved its position and was hopefully prepared in the General Assembly next year to confirm support for the proposal.

96. The Chair asked whether any Delegation had further comments or proposals on the wording of Rule 21.

97. The Representative of INTA, in view of the proposed implementation date to be not before January 1, 2017, suggested coming back to the proposal after the discussion on the more important question of the harmonization of the interpretation and practices regarding Article 4*bis* of the Agreement and the Protocol. There might be an opportunity to revert to Rule 21 at a later stage before January 2017.

98. The Chair responded that this meeting needed to decide on Rule 21. His preference was to finish this before starting discussion on the document on replacement. The Chair asked the Secretariat to prepare a new draft of Rule 21 taking into account the comments made.

99. The Chair opened the discussion on the proposal to amend Rule 24.

100. The Secretariat explained that Rule 24(3) specified the content of a request for a subsequent designation and that, under Rule 24(3)(a)(iv), an indication was required whether the request was for all the goods and services or for only a part of the goods and services listed in the international registration. Rule 24(5) spoke about irregular requests for subsequent designations. The Office of the Contracting Party of the holder did not have the same institutional role in remedying irregularities as the Office of origin, mainly because the holder could present a subsequent designation directly to the International Bureau. When the holder presented the request through the Office, the main function of that Office was to correct specific irregularities, for example, the lack of a signature by the Office. There were no specific references to Rules 12 and 13, relating to irregularities in the classification of goods and services or the indications of those goods and services. Two amendments to Rule 24 were proposed. The first proposal clarified the level of examination to be undertaken by the International Bureau. The proposed addition in Rule 24(5)(a) enabled the International Bureau to address irregularities concerning the classification or the indication of the goods and services mentioned in the subsequent designation. Should there be any irregularity, whether an indication was not properly classified or was considered too vague, the holder needed to remedy the irregularity which was a difference compared to the procedures under Rules 12 and 13. If the form had been presented through the Office, the holder still needed to remedy the irregularity but the Office received a copy of the irregularity notice. Where an indication of goods and services was properly classified and sufficiently clear, hence was in line with Rules 12 and 13, the request should be inscribed by the International Bureau. The International Bureau adhered to an inscription approach which did not imply any interpretation on the scope of the indication. Under the proposed amended Rule 24(5), where the International Bureau considered that the goods and services as indicated in the subsequent designation were not listed in the international registration, the subsequent designations should be deemed not to contain those goods and services. This addressed a situation where an indication provided in a limited subsequent designation, when properly classified, objectively fell outside the main list. Considering that the International Bureau did not have an interpretive mandate and was limited to apply Rules 12 and 13, this objective determination could only be reached where a term in the limited subsequent designation fell within a class number that did not correspond to any class in the main list. This proposal reflected comments made during previous Roundtables and ensured a harmonized examination in the International Bureau. The designated Contracting Parties could refuse protection of the mark, namely when they did not consider that a limitation was a limitation, but an expansion, compared to the main list. The second proposal to Rule 24 limited the consequences resulting from an irregularity related to a missing or defective MM18 form. If an irregularity was not remedied under the current system, the entire request for subsequent designation was abandoned for all the Contracting Parties indicated, and not just for the United States of America. The proposal intended to limit the consequences so that, in case of abandonment due to an irregularity concerning the missing or defective MM18 form, the designation of the United States of America would be deleted, but the subsequent designation would be processed for any other designated Contracting Party.

101. The Delegation of Denmark supported the proposed changes.



102. The Delegation of Japan pointed out that, if the International Bureau did not check whether there was an inclusive relationship between the main list and individual indications of goods and services for an international registration, the proposed amendment to Rule 24(5)(a) was not consistent with the explanation that the subsequent designation should be deemed not to contain those goods and services. The Delegation asked which Office determined whether the goods and services were limited compared to the main list. As for any irregularities, for subsequent designations it needed to be clarified in Rule 24(5)(a) that the Office that received the subsequent designation had to address the irregularities.

103. The Representative of INTA concurred with the first remark by the Delegation of Japan that the text which was proposed in Rule 24(5)(a) did not translate the explanations given in the document and by the Secretariat regarding the scope of the examination by the International Bureau of subsequent designations. In particular, the last sentence of Rule 24(5)(a) should be rethought and redrafted. The previous sentence saying that the irregularity should be remedied directly with the International Bureau was understandable, but the wording should be refined to clarify that all communications under Rules 12 and 13, normally addressed to the Office of origin, should be addressed to the applicant and replied to by the applicant. The Representative of INTA wanted to come back to the second remark made by the Delegation of Japan after hearing the reply of the Secretariat.

104. The Chair said that the last sentence of Rule 24(5)(a) could simply be deleted and asked the Secretariat for further explanations.

105. The Secretariat agreed that the last sentence of Rule 24(5)(a) could be deleted because it might be confusing. The inscription approach of the International Bureau needed to be clarified: the International Bureau classified according to Rule 12 and ensured a proper classification; if a particular indication was in accordance with Rule 13, the request was inscribed and the recording was notified to the designated Contracting Parties. The International Bureau could not interpret whether a particular indication in the list fell within another indication in the main list; that was for the designated Contracting Parties because they decided on the scope of protection. In the same way, the International Bureau did not reclassify at the time of renewal. Designated Contracting Parties might be designated for class numbers that had a different scope. There could be a subsequent designation for class 42, whereas, if an international application had been filed today, the services might be in classes 43, 44, 45. This was how the system worked. The International Bureau followed the Nice Classification version at the time of inscription of the international application and no reclassification was done later. During the Roundtable the year before, when the role of the Office of origin, of the International Bureau and of the designated Contracting Party had been discussed, a number of Offices had said that they examined a limitation whether it fell within the scope of the main list. At the time of filing a request for a subsequent designation, the Office of origin might not be involved. Upon notification of designations, whether in an international registration or a subsequent designation, the Office of the designated Contracting Party had to determine the scope of protection and it might have a view that a particular indication did not fall within the main list, but outside. Regarding the comment made by the Delegation of Japan and the Representative of INTA, that the text should specify clearer that the Office of origin was not involved with remedying the irregularities, it was said that this should be remedied by the holder. It could be discussed whether this needed to be stated in a more specific way.

106. The Delegation of Switzerland confirmed that the amendment to Rule 24 was discussed at the Roundtable last year. For the Delegation, the examination whether the goods and services in the main list were limited or not was essential. The first list was never notified to the Swiss Office. When the International Bureau received a request for a subsequent designation, the International Bureau should examine. Therefore, the Delegation of Switzerland was in favor of the initial proposal together with the last sentence. If the last sentence was deleted, the examination by the International Bureau did not go far enough.

107. The Delegation of Lithuania followed the Delegation of Switzerland and added that its Office, and maybe other Offices as well, had only the possibility to refuse the protection of international marks on absolute grounds. In such situation, it had to refuse protection as the only possibility to react to the list of goods and services.

108. The Delegation of Germany asked for clarification whether, according to the proposal, the International Bureau only checked the classification under Rules 12 and 13. The Delegation remembered that in earlier Roundtables, it had been said that the International Bureau had to check whether all goods and services were listed identically in the subsequent designation, whether it was a limitation or it was broader than the international registration.

109. The Delegation of Kenya agreed with the Delegation of Switzerland that this amendment should maintain consistency. Only the International Bureau knew the original list in the first application and the list of the subsequent designation. The Office of a designated Contracting Party did not have the original list. The Delegation supported that the International Bureau ensured consistency in the lists. Therefore, the Delegation supported the amendment as it stood, including the last sentence.

110. The Representative of INTA said that the question of who checked whether the limited list was not extensive was important. Three parties could do that: the Office of origin, the International Bureau and the Offices of the designated Contracting Parties. The Offices of designated Contracting Parties relied on the determination of the Office of origin that the limited list in the international application was, indeed, a limitation and not a broadening of the scope of protection of the basic application or registration. Subsequent designations reached the Offices of the designated Contracting Parties through two channels. One was through the Office of origin: the check by the Office of origin could be sufficient evidence for designated Contracting Parties that the limitation was indeed a limitation. The other route was through the International Bureau: the International Bureau said that it did not have the capacity to assess the extensiveness of the limitation except insofar as the limitation resulted in adding new classes to the subsequent designation. That made sense. The International Bureau was not in a position to do it, even with all the expertise, because the only Office that could confirm that the limited list fell within the basic list was the Office of origin. The current discussion around the decision of the Court of Justice of the European Union relating to IP Translator made it clear why. Only the Office of origin knew what was meant or what they understood was meant by the applicant when filing for a class heading, for example. For users, it was evident that the decision of the Office of the designated Contracting Party was not the optimum solution because some had said that they could not do it. If they needed access to the basic list, certainly, they could be given access to the basic list through ROMARIN or other practical means. Users preferred a one-stop shop and not to have different decisions of designated Contracting Parties as to whether the limited list was, or not, extensive. Where the subsequent designation was not channeled through an Office of origin, the International Bureau, when it had a doubt that the limited list could be extensive, could call on the Office of origin for determination. Users in general were reluctant to leave the determination to the International Bureau because there was no appeal against its decisions. In that case, it was preferable to go to the designated Contracting Parties where users had remedies. It could be considered to ask the Office of origin to determine whether the limitation was extensive or not. That determination could be accepted by all designated Contracting Parties and not questioned by them. Otherwise, there was a loss of effort and time for everybody.

111. The Chair stated that the proposal assumed that the designated Offices, rather than the Office of origin, should deal with this complicated issue. He wondered whether this could be wrong. Some delegations had felt that the original list of goods and services was not available to Offices when they were subsequently designated for only a limited list of goods and services. The Chair explained that in a notification of subsequent designation both lists, the full and the limited list, appeared. Therefore, the Offices had the information available. The Representative of INTA had made good points. There were three paths: the Office of origin, the International Bureau and the Contracting Parties. There was no basis for the International Bureau to make a decision that a list of goods and services was not a limitation. If, for example, the original list said "clothing" and the limited list covered different kinds of footwear, the International Bureau could not decide which type of footwear fell within the general indication "clothing" and which did not. The number of different approaches to that question was the same as the number of Offices. The question was whether the Office of origin or the Office of the designated Contracting Parties decided this.

112. The Secretariat agreed that this was a difficult question. The Secretariat asked whether it should contact the Office of origin in any situation of doubt if something fell within or outside, except where a different class was indicated because this case was clear. In any other case, the International Bureau needed to go into details to see whether one particular indication really fell within or outside, which added to the workload. The International Bureau had no mandate to interpret, but could only objectively look at the classification and whether an indication was clear enough. The Secretariat asked the Offices whether they wanted to be involved as Office of origin to determine the scope when someone from their country requested a subsequent designation. The last sentence of the proposed text had been drafted to address the situation where the subsequent designation should be deemed not to contain goods and services and that was only in the clear cases of a limitation. The International Bureau determined whether they referred to different classes than the classes mentioned in the international registration. The Secretariat confirmed that a notification of a subsequent designation contained the main list as well as the limitations that might apply to a designated Contracting Party. Both texts were available allowing the determination whether something fell within or outside.

113. The Delegation of the United Kingdom saw several principal starting points. First, it had to be asked who had the information to make the judgment. The information was held by the Office of origin, by the International Bureau and by any designated Offices in a subsequent designation. Technically all three could deal with it. Then the issue became more refined because the International Bureau was not in a position to say what classification practice was applied by the Office of origin when certifying that the international registration corresponded to the current registration. Different Offices had different practices, and even within the European Union there existed significant different practices in a number of areas. The International Bureau should be excluded. Regarding the Office of the subsequently designated Contracting Party, again different Offices had different practices and if each of the Contracting Parties had to figure out whether it fell within the scope of the original international specification by applying their own classification practices and interpretation, this could end up with several acceptances or several refusals given the same designation package. The Delegation wondered whether this was in the interest of the user and the Madrid System. Users were disappointed by the uncertainty added to the system by the need to interpret the classification practice of each designated Contracting Party when submitting a reduced specification and a subsequent designation. The conclusion was that if there was any certification to be done to a subsequent designation, the logical source was, as suggested by the Representative of INTA, the Office of origin.

114. The Delegation of New Zealand said that the question of who was the best to check limitations was often challenging. Probably none of the three should be doing it: it was a challenge for an examiner in the Office of the designating Contracting Party to access the basic list. The problem was that this basic list had never been recorded in the local register. From

the designated Contracting Party's point of view, the list was not a limitation, but a list of goods and services applied for in that country. It was challenging for some jurisdictions to say that this was not a limitation. The International Bureau faced challenges with checking the limitations. From an Office of origins' experience, virtually every subsequent designation went directly to the International Bureau and the Office had virtually no procedures built in in terms of examining a subsequent designation. The legislation in New Zealand did not mention the possibility of refusing a subsequent designation on the basis of a limited list. That decision might add to the workload and that confirmed the challenges to be faced with the three options.

115. The Delegation of Turkey explained that the Office looked at the classification and asked the applicant to limit the list of goods and services. This was more practical. The Delegation supported the proposal of INTA.

116. The Delegation of Germany saw a dilemma for the International Bureau and for the Office of the designated Contracting Party. The German Office did not have any legal basis to reject a subsequent designation because the list was broader than the one in the international registration since it only checked the classification of the list of goods and services. The statement made by the Delegation of the United Kingdom was logical. Examiners in the Office of origin did not check if there was a limitation or not and they were expecting that a designated Office or the International Bureau did it. The other reason was that they were no classification experts. The national classification section was different. The wording of the proposal as it stood was perhaps the best compromise in this difficult situation.

117. The Delegation of Italy saw good reason behind each of the different views expressed. The Office of a designated Contracting Party should not be involved with accepting a limitation in subsequent designations. The question was, as had been said by the Delegation of the United Kingdom and the Representative of INTA, whether the Office of origin or the International Bureau had to check the limited list. If the application for the subsequent designation came from the country of origin to the national Office, there was no problem for the Office to check the two lists, the limited and the original one. But if the request for subsequent designations could be filed directly with the International Bureau, the International Bureau should be in a position to examine the subsequent designations. A legal way of procedure should be found that did not complicate the system, but gave the International Bureau the possibility to check the limited list and take the decision.

118. The Representative of the JPAA reminded that users wrote the list of goods and services based on the local practice. The Office of origin had the expertise to judge whether or not the scope of goods and services was broader than in the original list. If the International Bureau provided a different taxonomy than the Office of origin, users might get confused. Users needed the support from the Office of origin for the list of goods and services in the subsequent designation.

119. The Delegation of Switzerland supported the statement made by the Delegation of Italy. The provision could entitle the International Bureau to examine the scope of the list of goods and services. The Contracting Parties had already delegated a part of their powers regarding the classification under Rules 12 and 13, and such further delegation was a logical consequence. Switzerland, as a Contracting Party, was not against that.

120. The Delegation of the United Kingdom concluded that there was not one outstanding, obvious or correct answer. The proposal from the Delegation of Italy as supported by the Delegation of Switzerland deserved further discussion. Despite having highlighted the Office of origin as the one to analyze the subsequent designation, it might not have the ability to reject a subsequent designation, as the Delegation of Germany had pointed out. It could involve an additional mandatory step in the process. Some would see it was warranting an additional fee, and the Delegation asked whether this was wanted. Regarding the suggestion made by the

Delegation of Switzerland and Italy, the International Bureau already had powers to analyze specifications, but that was in clarity and not determining the scope of protection that emanated from the Office of origin. This meant taking a step further and users, certainly in the United Kingdom, would want to think about it carefully before seceding it from the Office of origin practice in which the original application was accepted.

121. The Chair resumed that it was not yet possible to draw a clear conclusion on the discussion. Users should still say whether they thought that it was the right solution to file any subsequent designation containing limitations through the Office of origin. Analysis by the International Bureau on the different avenues might be needed.

122. The Delegation of Switzerland reminded that the Office of origin was not always the Office of the holder. If the Office of origin had to examine, it might not have seen the international registration for 20 or 30 years. The Office of origin might not exist any longer.

123. The Secretariat concluded that this issue was not ripe for decision and proposed two things. The first was to give the International Bureau the mandate to verify compliance with Rules 12 and 13 and whether there was any class added to the classes in the main list. This concurred with the proposal from the Delegation of Germany and should not go further. This was not a complete verification of whether the limitation was an expansion, but went in the right direction. Second, the International Bureau analyzed in more detail what the roles of the Offices of origin, the International Bureau and the Offices of the designated Contracting Parties were. Presumably, the number of instances where a limitation was an expansion was small so that one could ask whether it was economical to check this systematically for all cases. One option could be to leave it for third party challenge. For now, the International Bureau would not go further. For a future session, a comprehensive study would be made with the pros and cons of each approach for consideration by the Working Group.

124. The Delegation of Madagascar supported the proposal of the International Bureau.

125. The Delegation of Switzerland recalled that the problem had existed for a number of years. The Delegation suggested discussing this at the next session based on further information.

126. The Delegation of Italy agreed with this good compromise solution.

127. The Delegation of Hungary supported the proposal of the International Bureau.

128. The Delegation of France supported the proposal from the International Bureau.

129. The Delegation of the United Kingdom said that this was a pragmatic proposal where there was no solution at the moment.

130. The Delegation of Colombia supported the proposal by the International Bureau.

131. The Delegation of Germany supported the proposal since it had made it. The Delegation clarified that it was in favor of changing Rule 24 as it had been initially proposed by the International Bureau. The International Bureau checked Rules 12 and 13 and only if the subsequent designation was obviously broader than the international registration, because a new class was added, the International Bureau checked that, but nothing more.

132. The Representative of INTA supported this proposal and asked whether it was clear from the document whether the International Bureau checked the limited list for compliance with Rules 12 and 13 only and discarded, after consultation with the applicant of course, any goods or services that fell outside the classes listed in the original list. The Representative asked

whether that corresponded to the current practice of the International Bureau or whether that implied a change in the practice. If it was the practice of the International Bureau, the Bureau should continue that until the matter was further reviewed. It might not be necessary to amend Rule 24. If it was not the practice, this definitely needed to be written in Rule 24.

133. The Secretariat responded that the practice today was not fully harmonized and this was an attempt to harmonize the practice in this line. There had been examples where more had and less had been done. Today, there was no reference to Rules 12 and 13 for which reason the International Bureau had difficulties with issuing irregularity letters for classification and indication. The International Bureau had received complaints from users saying that there was no legal basis and requesting the inscription of the limitation.

134. The Delegation of Cuba reiterated that the issue was extremely important for Offices.

135. The Chair concluded that the draft Rule 24 required further consideration and requested the Secretariat to redraft the text for later discussion.

136. The Chair reopened the discussion on Rule 5.

137. The Secretariat explained that the redraft mentioned specifically the failure in the locality of the interested party and the time limit of five days after the electronic communication services were resumed as said the similar paragraph for postal and delivery services. The new draft Rule 5(3) read: "Failure by an interested party to meet a time limit for a communication addressed to the International Bureau and submitted by electronic communication means shall be excused if the interested party submits evidence showing, to the satisfaction of the International Bureau, that the time limit was not met because of failure in the electronic communication with the International Bureau or in the locality of the interested parties owing to circumstances beyond the control of the interested party, and that the communication was effected not later than five days after the electronic communication service was resumed". The references to certain events of *force majeure* had been deleted in favor of mentioning extraordinary circumstances beyond the control of the interested party.

138. The Delegation of Denmark supported the revised proposal.

139. The Delegation of Colombia said that the proposal was satisfactory and complied with expectations. The Spanish translation said that the communication took place in the past, whereas a future or present tense should be used.

140. The Secretariat responded that the past tense was correct because the evidence to be submitted had to demonstrate that the communication took place not later than five days.

141. The Delegation of New Zealand suggested splitting the two reasons that may disrupt electronic communications. An item (i) could spell out the failure of the electronic communication system of the International Bureau and an item (ii) could reflect the failure because of circumstances for the interested party. That clarified that the extraordinary circumstances related to the interested party and not the International Bureau.

142. The Delegation of Switzerland said that the sentence was changed to refer to electronic communication with the International Bureau which meant the communication in both ways. The reference to the locality of the interested party did not make sense anymore because the communication back and forth was already covered. Regarding the French translation, the Delegation asked whether the sentence about the five days should end with the word "communication".

143. The Delegation of Cameroon asked whether rules existed on how to examine the evidence to be presented to the International Bureau. The Delegation asked whether the examination needed to be in conformity with national rules and what meant satisfactory evidence for the International Bureau.

144. The Delegation of Belarus agreed with the Delegation of Switzerland that the electronic communication with the International Bureau or the interested party was already mentioned. At the end of the paragraph, it was not clear which communication was effected no later than five days.

145. The Delegation of Australia supported the text under discussion. The meaning of the English text was clear. However, the extraordinarily long sentence was prone to confusion when translated. The Delegation responded to the remarks from the Delegation of New Zealand that it mattered little whether an item (a) communication with the International Bureau or (b) communication in the locality of the interested party was inserted. What mattered was that there had been a failure and there was evidence to substantiate that within five days the communication had been given effect.

146. The Delegation of the United States of America asked how the five-day limit after the electronic communication was resumed impacted on situations where something was sent out but for a computer glitch was not received and there was no awareness of it until later, for example two months.

147. The Representative of AIPPI drew attention to the use of the word “demonstrate” in the Spanish version, “submits evidence” in English, which should be in the subjunctive.

148. The Representative of CEIPI asked whether the deletion of the word “system” from “communication system” was deliberate or not. Communication meant two things: information sent by the International Bureau to the applicant or *vice versa*, and the failure in the communication was rather in the communication system. If the word “system” was retained, the remark of the Delegation of Switzerland had a reason, the communication went in two ways and there was no need for reference to the locality of the interested party.

149. The Delegation of Mexico asked regarding the submission of evidence which had to be effected no later than five days after the electronic communication service was resumed whether the party had to say that the service resumed then, before or after.

150. The Chair said that the purpose of the proposal was clear and all agreed on that. It considered the situation where a failure was at the International Bureau. Where the failure was at the locality of the interested party, the Rule should only apply in extraordinary circumstances that resulted in the failure to meet the time limit. While the proposal was clear, there was ambiguity when it was translated. As suggested by the Representative of INTA, the paragraph should be rephrased to say that failure by an interested party to meet a time limit for a communication addressed to the International Bureau and submitted by electronic communication should be excused if the interested party submitted evidence showing to the satisfaction of the International Bureau that the time limit was not met because of failure in the electronic communication system of the International Bureau or in the locality of the interested party owing to extraordinary circumstances beyond the control of the interested party and that the communication was effected not later than five days after the electronic communication service was resumed. The change was “electronic communication with the International Bureau” to “system of the International Bureau”. Hopefully, that worked in French and Spanish as well. To make it clear that the failure was in the electronic communication system in the International Bureau that simply could not receive messages, extraordinary circumstances were not needed. But, if the failure was at the locality of the interested party, the Rule required extraordinary circumstances.

151. The Secretariat responded to the question of the Delegation of Cameroon that Rule 5 had not been applied so far, for which reason there were no evidence Rules in place. The International Bureau had been flexible with issues in Contracting Parties due to *force majeure* or extraordinary circumstances. The International Bureau had a flexible practice with electronic communication. Evidence meant a newspaper article, an attestation from a power company about a blackout, or from the ICT provider in the locality of the interested party. To set up clear guidelines, it had to be seen how the practice evolved. When an interested party had issues with sending electronic communications because of a failure at the International Bureau, the International Bureau had the information. For something outside, beyond the control of the interested party, they needed to submit evidence. The reference to the five days had been proposed because, without this delay after the resumption of the electronic communication, the time limit could be indefinite or it was six months. This aimed at treating electronic communication and postal and delivery services the same. Both had the reference to the five days.

152. The Delegation of Italy suggested specifying that five days meant five working days.

153. The Delegation of Switzerland suggested discussing the issue of five days further and, regarding the expression "locality of the interested party", asked what happened if only the Swiss Office had a problem and not the city of Berne and whether the word "locality" posed a problem.

154. The Representative of CEIPI said that the comma preceding the words "owing to" should be deleted to show that this sentence "owing to extraordinary circumstances" *et cetera* only applied in the case of a failure in the locality of the interested party and not to problems with the communication system of the International Bureau.

155. The Chair agreed with the remark from CEIPI. He reminded that this provision had not been used by the Secretariat so far. The questions to be addressed included the five days referred to in the last sentence of the drafted provision as raised by the Delegation of the United States of America. Legal certainty required that the Rule could not apply indefinitely. The International Bureau usually sent a confirmation of receipt of a communication. The five days allowed reacting. In other cases, there were six months, which was mentioned in Rule 5 as well. The Delegation of Italy had suggested clarifying that the delay should be five working days. Rule 4 defined the calculation of time. It did not speak about working days, but days. Also Rule 5(1)(i) said "five days", not five working days. Based on the proposal from the Representative of INTA with input from the Representative of CEIPI and the Delegation of Switzerland, Rule 5 should read "Failure by an interested party to meet a time limit for a communication addressed to the International Bureau, and submitted by electronic means shall be excused if the interested party submits evidence showing, to the satisfaction of the International Bureau, that the time limit was not met because of failure in the electronic communication system of the International Bureau, or which affects the locality of the interested party owing to extraordinary circumstances beyond the control of the interested party, and that the communication was effected not later than five days after the electronic communication service was resumed". There was agreement on two things. First, this provision should take into account a problem at the International Bureau that was the reason why a communication sent by an interested party was not received by the International Bureau. Second, it should take into account a problem outside the International Bureau. In that situation, an interested party should be able to send evidence that it was beyond their control and due to extraordinary circumstances that a time limit was not met.

156. The Delegation of the Republic of Korea supported the new proposal and asked for clarification of "effected" and whether that meant that the communication was sent no later than five days.



157. The Delegation of Hungary supported the new proposal.

158. The Delegation of Switzerland commented on the French version that “locality” should not be translated as “*localité*” but another French word, rather as “*lieu*”.

159. The Delegation of Morocco supported the comments made and recalled that the evidence concerned two points: the reasons for the delay, for example a breakdown in the ICT system, and the communication to be made within five days after the service was restored. The Delegation asked when the party had to make the evidence available. It seemed to be after the communication had taken place because that appeared in past tense. The Delegation asked, if that was the case, what the grace period was wherein that communication could be sent.

160. The Delegation of France preferred to keep the word “*localité*” to the word “*lieu*” in French. The Delegation asked whether “failure” meant a failure in the electronic communication system or another kind of failure

161. The Delegation of the United Kingdom was satisfied with the proposal. Like Switzerland, the United Kingdom had an issue with the word “locality”. Locality could simply mean Office. The Collins’ English dictionary gave three definitions: an area, site or scene of an event, or fact or condition of having a location and position in space. Its usual definition could simply mean Office and the IT system went down. The Delegation asked whether this was intended.

162. The Delegation of Kenya referred to the statements made by the Delegations of the United Kingdom and France regarding the word “locality” that included all other circumstances within which the Office lied, including the Office itself or earthquakes and fires. The word comprised the entire environment. Regarding the five days, the Delegation understood that the structure was trying to impose upon the applicant or Offices affected two sets of evidence: one where there was a failure of communication and the second that the communication was done within five days upon restoration of the communication channels. It became difficult for Offices to prove because it was not clear what kind of evidence could be given. After the communication was restored, it was ensured that the communication was effected within five days.

163. The Chair responded to the question from the Delegation of the Republic of Korea that “effected” meant that it had been sent or tried to send without success so that it had to be resent. Regarding the question from the Delegation of Morocco about the time limit for the evidence, Rule 5(3) knew already a deadline of six months. Rule 5(3) would be renumbered to Rule 5(4). The time limit for providing evidence should be six months. Regarding the question about “locality”, the proposal said “which affects the locality”. That did not mean that something had to have occurred in that locality. It could be something that occurred some way off, such as a cable cut in the middle of the sea, which affected the locality of the interested party. It could also be something where the place of business of the interested party was the epicenter of this event. The change to “affects the locality” was important. This was linked to the requirement of extraordinary circumstances, hence, not just any event that affected the locality of the interested party. Whether the word was locality, location, place of business or another word, was not important because the question was whether it affected the locality, location or place of business. Then, it was assumed that this was the reason why the time limit was not met. That answered also the question from the Delegation of France regarding the failure and where the failure should be. It was a failure to meet the time limit and it was due to a failure in the electronic communication.

164. The Chair concluded that the proposed Rule 5 was adopted.

165. The Chair reopened the discussion on Rule 9.

166. The Secretariat explained that there were two options for Rule 9. Common in both options was that in Rule 9(4)(xi) the words “the applicant wishes to include this description or” were deleted. This meant that where the basic application or registration contained a description, and the Office of origin required to include the description, that same description. With this, it was left exclusively to where the Office of origin required the description in the basic mark to be included in the application form. In Rule 9(4)(b)(vi), Option A proposed any description of the mark and Option B listed any description or, if the applicant so wished, the description of the mark contained in the basic application or registration where it had not been provided under Rule 9(4)(a)(xi). This left it to the applicant to either include any description if wished or, if the Office had not required the description of the basic mark, to include that description.

167. The Delegation of Japan reminded that the discussion had clarified that in the case of Option A there could be two descriptions in the form while in the case of Option B there was only one description. If this understanding was correct, Japan supported Option B.

168. The Delegation of Hungary supported Option B for two reasons. One was the same reason as raised by the Delegation of Japan. The other reason was the point raised by the Representative of CEIPI which was addressed by this version.

169. The Delegation of Germany supported Option A because there could be two descriptions in Option A and in Option B. One, where the Office of origin required the description and then another voluntary description. There might be very few cases. Option A had the shorter text. It was clear and it made a clear cut between the description which was required by the Office of origin and the voluntary description which the applicant wanted to have.

170. The Chair asked the Delegation of Germany whether it objected to option B since Option B included Option A.

171. The Delegation of Germany confirmed that it accepted option B though it was more complicated.

172. The Chair concluded that Rule 9 was adopted with option B.

173. The Chair reopened the discussion on Rule 21.

174. The Secretariat explained that in the redraft of Rule 21(1) the reference to Article 4*bis* had been reinserted, the words “one copy” had been deleted as well as the last sentence saying that a notification might include information relating to any other rights acquired by virtue etc. A new subparagraph (b) had information concerning fees, particularly the collection of fees on behalf of the Contracting Parties requiring that. These fees had to be indicated in Swiss francs, whatever the currency in the Contracting Party was. Whenever the Contracting Party changed fees, this information had to be given to the International Bureau. The International Bureau needed three months to adapt the IT system and the web site. The decision paragraph determined January 1, 2017, as date of entry into force at the earliest.

175. The Delegation of Switzerland said that in both French and English, the wording, that a request was addressed to an Office and presented to the International Bureau, was complicated. The Delegation suggested revising the text.

176. The Delegation of Mexico saw an inconsistency between the Spanish and the English version. The Spanish text said “*toda tasa exigida por una parte contratante interesada*” what was in English “*to the Office of the designated Contracting Party*”.

177. The Representative of CEIPI asked for clarification of the time limit for the fees to apply and whether the wording that the new fees were applicable no less than three months meant that the Contracting Party could determine a longer period.

178. The Delegation of Madagascar asked when a fee for replacement had to be paid, whether it was when the holder submitted the request for replacement or later, and whether the fee was paid back if replacement could not take place.

179. The Chair invited the Secretariat to revise the translations for the issues raised by the Delegations of Switzerland and Mexico. An Office could determine a later date of effect of the fee changes. The delay should be at least three months so that the International Bureau had time to implement the change.

180. The Secretariat, in response to the Delegation of Madagascar, explained that the fee had to be paid when the request was presented to the International Bureau. Any reimbursement of the fee was an issue for the Office to determine and to effect.

181. The Delegation of Switzerland explained that the French version had been correctly translated from English. The Delegation suggested deleting the first sentence "In accordance with Article 4*bis*(2) of the Agreement or Article 4*bis*(2) of the Protocol, a request that a national or regional registration has been replaced by an international registration shall be presented by the holder to the International Bureau on the relevant official form and shall indicate [...]". Then followed the four points which had to be retained. In any case the Contracting Party was mentioned in item (ii) so that the first half of the section was not necessary. The beginning should refer to the Articles and continue with the request that at a national or regional registration had been replaced.

182. The Delegation of Cuba asked the Secretariat for clarification on the procedure for fee payment, in particular when the Office did not accept the replacement.

183. The Secretariat explained that a new subparagraph (b) allowed the International Bureau to collect a fee for the Offices that required a fee for taking note of replacement and to forward the fees to those Offices. The respective Offices informed the International Bureau of the amount to be paid in Swiss francs. If there was a procedure in place to reimburse fees if the Office could not take note, the Office did that directly with the holder.

184. The Representative of INTA repeated that he would have preferred to discuss this Rule after having had an exchange on the practice of Offices regarding the implementation of Articles 4*bis*(2) of the Agreement and the Protocol because the proposed Rule went beyond Articles 4*bis*(2) which required that the Office took note in its register upon request of the international registration. The proposal introduced instead a requirement for the Office to record the replacement, which implied the examination of the request by the Office because it had to take a decision on replacement. This was not implied by Article 4*bis*. Under the current text of Rule 21, an Office could take note of replacement, now the Office was officially requested to take note of the replacement. The Representative wanted to return to this during the broader discussion on the practice because there was an implication which was not evident from the Madrid Agreement and Protocol. No requirement for the Offices should be introduced to examine the request for noting the international registration in the national register when this was not required by the Agreement and the Protocol and when this was not the practice.

185. The Delegation of Cuba stressed that the statement of the Delegation of INTA addressed an important point that had to be remembered in the further discussion.

186. The Chair said that the proposal from the Delegation of Switzerland needed time for consideration and that the suggestion from the Delegation of Cuba to postpone the discussion on Rule 21 until having had discussed the document on replacement was a reasonable way forward.

187. The Chair opened the discussion on the proposal to introduce a fee for limitation.

188. The Secretariat explained that since 2003, the number of limitations presented to the International Bureau as part of international applications, subsequent designations and in requests for the recording of limitations in the MM6 form had substantially increased in line with the geographical expansion of the Madrid System and as the mechanism which provided applicants and holders the opportunity to tailor their lists of goods and services to specific Contracting Parties. There was a fee of 177 Swiss francs per limitation presented in form MM6, but there was no fee for limitations presented in international applications or subsequent designations. Almost 10 per cent of all international applications filed in the last three years contained one or more limitations, while around 18 per cent of all subsequent designations filed in the same period were for only part of the main list. This had a direct impact on the workload of the International Bureau. Also the number of words used to express the limited list had increased: the average number of words in a limitation was exceeding the number of words in the main list of goods and services. The proposed fee for limitation in general harmonized the situation, so that all limitations regardless of how they were presented were subject to a fee which helped covering the added workload of the examination and processing of these limitations. It was also proposed to modify Rule 10 accordingly, delete paragraph (v) from Rule 36 and specify in items 1, 2, 3 and 5 of the Schedule of fees the fee of 177 Swiss francs. Finally, in item 7 of the Schedule of fees, it should be clarified that the fee applied per limitation.

189. The Delegation of China stated that it had also noted, in recent years, the increasing number of limitations presented in international applications and subsequent designations with a reduced number of goods and services. Collecting a fee per limitation in international applications not only complicated the Madrid System, but also increased the economic burden for applicants. It reduced the attractiveness of the system for a large majority of developing countries, including China. Therefore, the Delegation opposed the amendment to Rule 36 and any amendment regarding the fees.

190. The Delegation of France supported the statement made by the Delegation of China. The Delegation of France wanted the Madrid System to be easily accessible to companies and would not like to see any increase in the fees.

191. The Delegation of Denmark supported the proposed changes.

192. The Delegation of Madagascar had noted an increase in limitations in applications, up to several pages. It understood that the situation, which was borne out by the statistics in the document, led to an increased workload for the International Bureau. However, introducing such a fee made the Madrid System less attractive to users. Developing countries were trying to promote the use of the Madrid System and the question of costs was decisive. The Delegation of Madagascar suggested further studying the matter.

193. The Delegation of Italy, like other delegations, was against the introduction of new fees.

194. The Delegation of Norway concurred with the Delegation of Denmark in support of the proposal. It understood the position of the International Bureau.

195. The Delegation of Kenya confirmed that in most cases limitations were introduced to accommodate countries. But Kenya and maybe Africa aimed at encouraging small and medium-sized enterprises (SMEs) to use this system. If more fees were introduced, it became punitive to use the system and many users could be discouraged. The Delegation of Kenya opposed the introduction of fees.

196. The Delegation of New Zealand was concerned about the proposal. The ability for a user to limit the specification per country was a great strength of the Madrid System. This proposal had the potential to discourage its use. New Zealand used limitations more than the average. Approximately 17 per cent of international applications received in New Zealand had at least one limitation. These users faced increased costs in using the system and additional complications when calculating their fees. There was also potential for inequity in fee calculation. For example, the basic fee was the same regardless the number of classes. An international application with 20 classes with no limitations had a lower fee from the International Bureau than an international application with only two classes and one limitation.

197. The Representative of INTA doubted that the Working Group should discuss budgetary issues. According to his calculation, this was a 1.5 million dollar question. The Director General had referred to an ongoing study on a possible restructuring and the amount of fees. Rather than introducing piecemeal new fees for various operations, like for limitations contained in the international application and subsequent designation, one should look at the question within the context of that general study. The introduction of that proposed fee meant an additional fee for the applicants of 1.235 million Swiss francs in 2013. That represented about 2 per cent of the fee income of the International Bureau. This should be seen in the overall context of measures to yield additional resources needed by the International Bureau and discussed in the Program and Budget Committee. According to the financial report for 2013, the excess of income of the Madrid Union over expenditure was more than two million Swiss francs. The issue should be considered in the overall context of the resources of the Madrid Union.

198. The Chair concluded that the proposal was rejected.

199. The Secretariat made a statement addressing records, resources at the International Bureau, and fees. It was undeniable that the numbers of limitations and words were increasing. The Delegation of Germany had correctly mentioned misgivings. The representative of INTA had rightly pointed out that that debate was more properly held within the Program and Budget Committee. Nevertheless, a separate debate should be held, because it was not *per se* a requirement to increase the fees to make more resources available to the International Bureau to process the Madrid applications and service requests. The increasing workload at the International Bureau was significant and the growth of the system needed to be addressed, probably in the Program and Budget Committee.

200. The Chair opened the discussion on the proposal to exempt certain recordings from fees.

201. The Secretariat recalled that Rule 36 stipulated the gratuity of certain recordings. Under item (ii), the recording of any change concerning the telephone and telefacsimile numbers of the holder was exempted from fees. The proposal was to amend Rule 36 to explicitly exempt changes in the address of correspondence and changes in the e-mail address from fees. The International Bureau had never charged fees for these changes and there was no legal basis to do so either. The proposal aimed at clarifying this. It was important to have updated information in the records for the communications with the holder.

202. The Delegation of Colombia supported this proposal.

203. The Delegation of Kenya welcomed the proposal.

204. The Representative of INTA asked what should be covered by "any other means of communication" besides the address for correspondence and the e-mail address. It did not apply to the change of address of the holder of an international registration, because there was a fee for that and the Representative supposed that this was not proposed to be deleted. Of course, also item (v) remained as it stood.

205. The Chair assumed that a reference to any other means of communication should address that it was not known what means of communication existed in the future.

206. The Chair concluded that the proposal to change Rule 36 was adopted by the Working Group.

207. The Delegation of Cuba agreed that any future medium would have to be analyzed, but it was not known what this future medium could be.

208. The Chair opened the discussion on the proposal to amend the signature requirement under Section 7 of the Administrative Instructions to facilitate the use of e-Forms (item VII of document MM/LD/WG/12/2).

209. The Secretariat explained that the International Bureau had recently developed an electronic form for subsequent designations. Other e-Forms were under development and would be available in the near future to request recording of specific changes, such as limitations, cancellations, and changes in the name or address of the holder. The proposed amendment allowed replacing the signature by a mode of identification determined by the International Bureau. This only concerned forms to be sent directly to the International Bureau.

210. The Delegation of New Zealand supported the proposal and the International Bureau's continued efforts in facilitating greater use of electronic communication.

211. The Delegation of Sweden supported the proposal and reminded that the electronic signature standards were a matter for the CWS.

212. The Delegation of Italy supported the proposal.

213. The Delegation of France expressed a reservation due to legal security concerns, because the national legislation required for subsequent designations a signature corresponding to certain criteria. The Delegation did not accept the proposal and asked for information about other possible solutions to replace signatures and what was planned.

214. The Secretariat responded that these forms had nothing to do with national Offices and did not interfere with whatever forms or requirements Offices had for digital signatures. The International Bureau had an online form for subsequent designations available. Holders could submit it directly to the International Bureau either on paper or using the online form. The other forms under development were for requests, sent directly to the International Bureau, to record limitations, changes in the name or address of the holder or cancellations. These forms were accessible through a secure log in via the Madrid Portfolio Manager. The International Bureau knew who submitted the form because an account had to be opened to use the system.

215. The Delegation of France said that a subsequent designation of France had an impact on the national level and thus France required a signature satisfying certain criteria.

216. The Chair replied that this proposal concerned only subsequent designations that were sent directly to the International Bureau and not through the Office of origin. This could not impact on national law signature requirements. When a subsequent designation was sent to the French Office, national law regarding signatures had to be complied with.

217. The Delegation of France reiterated that a subsequent designation, even though sent to the International Bureau directly, was dealt with on the national level. If such subsequent designation involved France, it was dealt with by the French Office. In this case, France had a difficulty accepting an electronic signature if it did not correspond to French requirements.

218. The Representative of CEIPI asked how France was informed of the decision when a subsequent designation was sent to the International Bureau and whether it received a notification from the International Bureau with a signature from the holder of the international registration. The Representative asked what the relevance of the signature was in this case.

219. The Chair replied that no designated Office received a notification that included the original signature by the holder or the applicant. France would not see the signature as a designated Office. The subsequent designation was received by the International Bureau. It was inscribed and a notification was sent. The Chair confirmed with the Delegation of France that the Delegation of France maintained a reservation, but would look further into the matter.

220. The Chair opened the discussion on the proposal to amend the Administrative Instructions to provide for a unique reference code for designations of Contracting Parties (item VIII of document MM/LD/WG/12/2).

221. The Secretariat explained that a Contracting Party could be designated more than once, namely when a previous designation had been the subject of a limitation, renunciation, final refusal or invalidation. When the same Contracting Party was designated repeatedly, determining the scope of protection was difficult because the Offices concerned had no means to indicate to which designation a particular decision applied. It was proposed to amend the Administrative Instructions to provide for a simple, but unique reference code for each designation of a Contracting Party. This code appeared in the notification to the Office of the designated Contracting Party. It was for the Contracting Party to use this code or not when notifying something to the International Bureau.

222. The Chair stressed that the use of this option was voluntary.

223. The Delegation of Germany said that while, in principle, having a clear reference was a good idea, there was a technical problem. The German IT system could not process a longer number which was followed after DE for Germany by, for example, E1 or 2. The Delegation suggested to further discuss the technical considerations with IT specialists.

224. The Delegation of Japan supported the proposal and requested the International Bureau to provide more technical details for implementation in the national system.

225. The Delegation of Denmark supported the proposal.

226. The Delegation of Sweden supported the proposal. Like Germany, Sweden needed time to prepare its system. The technical issues should be passed to the SCIT.

227. The Representative of CEIPI asked whether it was correct to speak about territorial extension. This terminology had been abandoned in the Common Regulations and the Administrative Instructions. One should speak about designations. The Director General was responsible for the drafting of the Administrative Instructions so that there was no need for a formal agreement unless there was a specific reason for not using the concept of "designation". This was only a formal aspect. Agreement on the substance was needed first.

228. The Secretariat explained that several designations might be made for different goods or services. They might overlap or be for the same goods and services. This posed a problem to Offices and the International Bureau. When there were, for example, two designations for one Contracting Party, and the International Bureau received a full statement of grant of protection under Rule 18ter(1) referring to the same international registration number, the International Bureau would not necessarily know whether protection was granted to both designations or just one of them. The proposal allowed informing Offices that there were in fact two designations. The notification continued to have the international registration number, but there was information that this was the designation number 1 or 2 for a Contracting Party. When the Office made a particular notification back to the International Bureau on the scope of protection, it might wish to inform the International Bureau that this applied to the national registration as such designating that Contracting Party, or that it only related to one of the designations. Offices did not have to use these numbers. The International Bureau suggested introducing them to give more information.

229. The Delegation of Germany repeated that, in principle, this was a good proposal. But this should not be decided without any input from IT experts on what needed to be changed, because the Delegation could not foresee the impact on the national system. In Germany, there were consequences for the system. The proposal should also be discussed in a technical forum.

230. The Chair summarized that a number of delegations supported the proposal in principle, although technical issues had been raised. The Chair considered that the proposed system was not mandatory and asked whether it was possible to postpone implementation until January 1, 2017.

231. The Delegation of Germany reiterated that the problem was not that the system did not have to be used, but that the electronic communication with that number could not be read by the system. It did not help that the numbers would not need to be used. It only helped if the new numbers were not sent. The Delegation doubted that the International Bureau could make that difference. At least, there should be a new document, or it should better be discussed in a technical forum, or a technical expert should explain the consequences of this proposal.

232. The Secretariat saw an agreement in principle, with remaining technical issues. The Secretariat suggested adopting the proposal in principle with an implementation date in 2017. In the meantime, consultations under the umbrella of the Administrative Instructions could provide more technical detail, so that the Offices could consult their IT staff. Alternatively, there could be an earlier implementation date, and Offices could opt in to receive this notification. The purpose was to help Offices and to give more information so that Offices could better identify on what they made decisions and what the International Bureau recorded.

233. The Delegation of Colombia concluded that a majority of Delegations had agreed on the basic principle of introducing the proposal and suggested that the International Bureau undertook a survey among the Offices to explore whether each Office from the technical point of view was able to introduce this system. With the responses, it could be decided next year whether all were ready to include this code in the subsequent designations.



234. The Delegation of Denmark asked whether it was correct that there were concerns about not being able to identify the documents from the International Bureau and that the identification code was only an addition, so that the international registration number was still there, Offices were still able to identify the documents, even though they did not know the new identification codes.

235. The Chair confirmed that understanding. It was something additional and the same international registration number was used.

236. The Delegation of Germany repeated that if the number was longer than it was defined, the system could not read just the international registration number. It could either read the complete number or nothing. The second alternative proposed by the Secretariat was an option for the Delegation of Germany, if it was clear. The Delegation wanted to see a text that confirmed that the Office only received the information for which it had opted so that additional information was only received if the Office opted in. Technical experts of WIPO and the German Office needed to undertake exchanges on this.

237. The Chair clarified that it was not proposed to renumber the international registrations. The code should be included somewhere in the communication, not in the international registration number. It showed that this related to one of the designations relating to that international registration. There was agreement in principle with pending technical issues. The Chair referred to Rule 41 of the Common Regulations under which the Director General established and modified the Administrative Instructions after consultation with the Offices having a direct interest in the proposed Administrative Instructions. The Chair suggested concluding an agreement to in principle allow the International Bureau to explore the ways of implementation in consultation with each Office individually.

238. The Delegation of Cuba invited the International Bureau to include in the expected consultations the development of the system that Cuba was using. Cuba was not satisfied with some aspects of the system and the Delegation was not sure whether this system could work with the new codes.

239. The Delegation of Germany welcomed the future consultations and stressed that the Office needed a certain period of time. It was clear that a decision on the Administrative Instructions was not a task for the Madrid Union, but the Director General would consult the Offices.

240. The Secretariat said that the consultation would show what needed to be modified and there would be a late implementation date if necessary. If Offices did not need to do anything, the International Bureau decided on the implementation date after the consultation.

241. The Chair concluded that the Administrative Instructions were not changed now, but consultations followed.

## **AGENDA ITEM 5: PROPOSAL FOR THE INTRODUCTION OF THE RECORDAL OF DIVISION OR MERGER CONCERNING AN INTERNATIONAL REGISTRATION**

242. The discussions were based on document MM/LD/WG/12/3.

243. The Secretariat explained that the document set out various options for decision, the obvious one being whether to introduce division of international registrations. The document proposed a new Rule 27*bis* and primarily a centralized approach. It dealt with how division should be recorded, whether as parallel designations or as new international registrations. The different ways of recording had consequences and determined the possible actions for the

Contracting Parties where division was effective. Rule 27bis(1) to (4) set out the procedure covering the request, fees, irregularities, the recording and the notification. Paragraph (5) provided that an Office could declare within a time limit of 18 months that a recording of division in a given international registration had no effect in the Contracting Party. This suggestion followed declarations which already existed in the Common Regulations for changes in ownership, limitations and for licenses. Paragraph (8) provided that a Contracting Party could make a general declaration to the Director General that divisions of international registrations had no effect. Paragraph (7) provided for mergers of international registrations resulting from division. This was only possible if the Working Group wished the division to be identified in the International Register by a new international registration. The proposed fee for division corresponded to the general fee for subsequent designations, a basic fee of 650 Swiss francs and either complementary fees of 100 Swiss francs or individual fees for each designated Contracting Party indicated in the request for division. Those Contracting Parties requiring individual fees needed to determine the amount of fees to be paid.

244. The Delegation of China assessed that a division or merger might be welcomed by certain parties, but affected the user-friendliness of the system and created a burden for the International Bureau. It led to confusion in the registration management, discouraged users and would not reach its objectives. The Delegation of China did not support the proposal.

245. The Delegation of Japan stated that the primary purpose of introducing a division system was to separately deal with parts of applications which had grounds for refusal and parts that could be registered in Contracting Parties to help applicants acquire rights earlier for these parts. Making use of existing procedures could achieve similar effects. Applicants could request a limitation for a part that could be registered (form MM6) and file a subsequent designation for the partial refusal (form MM4). Using existing procedures was less expensive than the proposed division fee of 650 Swiss francs.

246. The Delegation of Switzerland reminded that division met a need for savings of users. The problem occurred when a designated Office objected to a part of the goods and services. The holder had to wait for a decision on all goods and services which could last years. The solution was division. The system could copy the partial transfer which already existed under the Madrid System with adjustments.

247. The Delegation of Kenya said that, in principle, it had no problem with mergers and divisions for various reasons that had already been raised. The Delegation was concerned about costs because the fee might be too burdening for applicants in Kenya and probably other developing countries.

248. The Delegation of Italy supported the proposal. It was in the interest of the system and users. All Contracting Parties that already had this mechanism in their national legislation would accept division and merger. The others could declare that they did not accept it. The Delegation was more favorable to the centralized approach. The Delegation agreed with the Delegation of Kenya that the fees should be more user-friendly and suggested reducing the fee of 650 Swiss francs.

249. The Delegation of the Republic of Korea supported introducing division and merger and the centralized approach and thought that the basic fee was too high.

250. The Delegation of the Russian Federation recalled that, at previous sessions, it had been in favor of introducing this procedure into the Madrid System. The Delegation opted for the centralized approach. However, it was not clear from the document who produced the list of goods and services. At the same time, the question of division was key for those Offices where the procedure existed under the national legislation. The Russian civil code provided for a mandatory requirement that a request for registration should include the list of goods and services in the original filing. In other words, the original filing remained valid. The Delegation was flexible on the fees without having a particular position in this meeting.

251. The Delegation of Germany recalled that the European Union had repeatedly requested that the system should not be made complex. The proposed procedure was complex and it meant much more work for the International Bureau. Higher fees might need to be paid for more work, more staff, a new computer system etc. Other national Offices had division only for national marks, but not for international applications. This meant also workload for the national Offices which had to introduce a new process in the electronic system. The fee for the national Office was not nearly enough, as the Office had to do a substantial examination whether the division was possible according to the national law. This led to higher costs and workload. Before charging the International Bureau with another complex process, it was necessary to wait until the processes in the International Bureau worked smoothly.

252. The Delegation of Israel acknowledged the importance of the proposal for division and merger under a centralized approach, but predicted problems with this procedure. The holder could not always know the exact scope of the goods and services accepted in the relevant designated Contracting Party, especially when the division took place after a request for a limitation which was accepted only partially by this Office. Therefore, the Delegation preferred that the division took place in the Contracting Parties concerned and that they notified the International Bureau for the recording of the division as a new international registration. The Delegation found the basic fee was high.

253. The Delegation of Mexico said that simplicity should be a feature of the Madrid System. Mexico was concerned about administrative costs for Offices and the need to make a statement that division did not have effect. In practice, in the case of licenses, Mexico had realized that, even when Mexico had made a declaration, holders of international registrations still requested a license to be recorded for Mexico. It caused concern that there was no detail about the declaration that division was not valid or did not take effect in a Contracting Party's territory.

254. The Delegation of Spain did not see any real need for the introduction of division or merger, given that the use of division in an application for the registration or in registrations of a mark was limited. As the International Bureau was reorganizing its IT system, there was no urgency to do this now.

255. The Delegation of China agreed with the Delegations of Germany and Spain. The Delegation of Japan had correctly stated that submitting forms MM4 and MM6 could resolve the majority of cases.

256. The Delegation of Australia stated that the introduction of a formal structure for division of international registrations added complexity to the Madrid System and the costs associated might be significant. However, users seeking such an approach benefited from it. Time should be provided to for the IT development in national Offices, particularly for those Offices which had integrated international registrations in their register and wished to indicate the links between parent and child for the sake of transparency and to explain the earlier priority for filing. If a centralized approach was pursued, the Delegation preferred Option 1.

257. The Delegation of France, like the Delegations of Germany and Spain, had doubts about the need to implement a division procedure, given the low number of cases. As the Delegation of Germany had stressed, this led to increased workload, not only for the International Bureau, but also for national Offices.

258. The Delegation of Madagascar said that the issue led to questions about complicating the International Register. The Delegation maintained the position that, given the low number of requests for division, the costs for the International Bureau and applicants and the investment in infrastructure, this would not pay off if it did not interest many users. The Delegation supported the views of the Delegation of France that there were many other areas that needed additional funds, such as translations or limitations in international applications.

259. The Delegation of the United Kingdom was open to the proposal. The discussions around costs and benefits were peripheral to the question whether it improved the system for the benefit of users. The Delegation asked for the views from the user organizations. As to fees, the Delegation assumed that there was a cost/benefit analysis; whether they were too high was a matter to be looked at in the context of the benefits of the proposal. It was more interesting looking at the details of the system and look for efficiencies to reduce costs if possible.

260. The Delegation of Italy, speaking on behalf of the European Union and its member states, reiterated that the European Union and its member states had repeatedly stressed the value for users of the possibility to divide an international registration, thereby achieving compliance with international standards provided for under the Trademark Law Treaty and the Singapore Treaty. The European Union and its member states remained open to discussing the proposal to introduce division and merger of international registrations under a centralized approach. For the sake of legal certainty and to ensure that users obtained a distinct enforceable title in respect of the divided part, the division of an international registration should result in a new international registration, as long as the process remained simple.

261. The Delegation of Montenegro associated itself with the proposal.

262. The Representative of AROPI said that the proposal was the simplest and most appropriate to respond to the concerns of users regarding effectiveness and costs. AROPI had prepared a document summarizing the concerns of users. The Representative thanked the Delegation of the United Kingdom for its comments because users were worried about the user-friendliness, costs and complexity of the Madrid System. The Representative of AROPI emphasized the amazing simplicity in this proposal. The designated Offices did not have to make any investment to develop and implement the necessary procedures and infrastructure for division. This was dealt with in the framework of the existing procedures. The designations were treated as new registrations, no more, no less. No new mechanism was introduced and no domestic legislation needed to be adapted.

263. The Representative of INTA stated that the document was based on the Working Group discussions during the last five years. Some delegations went back to questions which had been properly elucidated, such as the Delegation of Italy on behalf of the European Union and its member states, underlining that there was an international standard applied at the national level by a great majority of the members of the Madrid Union. The Representative of INTA supported the proposal because it contained all the ingredients of the solution that INTA had been advocating for many years and that had been found in the Swiss proposal made last year. Such support, however, was not without reservation. The principles listed in paragraph 2 of the document afforded holders of international registrations the same opportunities for division as provided by the national laws of designated Contracting Parties, while not imposing any obligation on Contracting Parties not providing division at the national level. Hence, the proposed opting out provision should be restricted to Contracting Parties that did not provide for the possibility of division at the national level. Another point was whether merger should be

treated in the same way as division. Obviously, there could not be a merger without a division. One could imagine a division without a merger, but merger had been a feature of the international registration system for decades without any relation to national legislation and without an involvement of the Contracting Parties. All Members of the Madrid System accepted the division of the international registration when it resulted from a partial assignment or transfer of the international registration. The merger after such a division was a matter for the International Bureau only. Offices had no interaction on this particular procedure. Some delegations still remained to be convinced that users really were seriously in need of division. That discussion might still need time. As to the options in the document, a division should be the division of the international registration for the obvious reason that this gave immediately, or within a reasonable period of time, a title to the holder of the divided international registration. Fees could be discussed later when there was agreement on the basic principles. It should not be forgotten that the proposed mechanism for recording division, modifying it and merging divided parts later was something that already existed for the partial transfers of the mark.

264. The Representative of CEIPI said that CEIPI, like before, supported the introduction of division of international registrations in the Madrid System. This was on the basis of two principles. The first was that users of the Madrid System should not be treated less favorably than users of the national or regional system. If this was not respected to the extent possible, the Madrid System was less attractive. The second principle was that of consistency across the Madrid System with the existing WIPO Treaties, the Trademark Law Treaty and the Singapore Treaty. Addressing the statement of the Delegation of Japan, there was a major difference between the existing procedures for limitations followed by subsequent designation and the procedure for division. The date of the international registration was maintained for the new registration resulting from the division, which was not the case for the subsequent designation. This was important for users. A detail in decision paragraph 74(ii) was that the Administrative Instructions did not have to be submitted to the Madrid Union Assembly. Furthermore, the Representative of CEIPI supported the statements made by the Representatives of AROPI and of INTA.

265. The Representative of the JPAA stated that the implementation of division and merger was welcomed by users because it created more options to seek broader protection in certain designated countries, as mentioned by AROPI. The Representative of JPAA considered the proposal made by the Delegation of Japan as interesting and worth considering.

266. The Delegation of Hungary concurred with the Delegation of Italy speaking on behalf of the European Union and its member states and supported the proposal and the centralized approach.

267. The Secretariat recalled that the Working Group had requested the Secretariat to produce a practical paper describing how this process could work. The Working Group could now give guidance as to how to proceed. Users generally appeared to be in favor of the paper and the options formulated therein. Some member States were in favor, some were not in favor at all and some had doubts. The Secretariat made two observations regarding the workload for the International Bureau. The assumption in the paper was that only few requests were made. This was an important factor in determining the complexity and the approach by the International Bureau. The second point was that it was true that the process was rather complex. Some IT functionality had to be built without doubt. Use was made of the partial change in ownership process, but this was not the simplest process; that had to be recognized. On the other hand, it had just been decided that the International Bureau should proceed with the verification of the reduced lists in subsequent designations. The fact that this implied more work for the International Bureau had not been considered *per se* an objection. The fees had been proposed on the basis of a certain calculation which was reflected in paragraphs 54 to 56 of the document. There were two components to the fee. The fee of 650 Swiss francs had a fixed cost component for processing the request and another component to amortize the

investment in the IT system. The amortization period was assumed to be from one to two years. It was possible to foresee a longer amortization period to reduce the fee. But it would always be more than the estimated fixed cost.

268. The Chair summarized that there was no consensus. Some delegations had concerns in relation to fees. At this meeting, fees could not be discussed further. Fees depended on the type of notification or system that would be introduced. Some delegations had concerns about the complexity of the system. Users were very interested in introducing such mechanism. The Chair invited the Working Group to look further into the document, particularly into the options described therein to identify issues for further work of the Secretariat. The first question was on a centralized or decentralized approach. Some delegations had expressed their preference. The Chair invited any further comments, namely from those delegations who preferred a decentralized approach.

269. The Delegation of Switzerland said that it had realized that “centralized” or “decentralized” could mean different things at different levels. Therefore, the Delegation of Switzerland underlined its preference for a centralized approach and for the creation of new international registrations under Option 2.

270. The Delegation of the Czech Republic, like most Offices, was not against the proposal, but found that the system was already rather complex. If a choice had to be made, it was a centralized approach, Option B. A new registration was clearer for the holder when managing the system. A subsequent designation fee of 300 Swiss francs was right, but this could be discussed later.

271. The Chair saw a preference for the centralized approach described in Option 2 of the document which was the division resulting in a new international registration and was the basis for proposed Rule 27*bis*. But there was no consensus on this. The Chair asked the delegations what was considered too complex and how this could be simplified to meet the needs of users.

272. The Delegation of China, based on its earlier statement, said that the introduction of division should satisfy two requirements: first, the International Bureau should improve the logistics of the current mechanism, such as reducing the time for notifications, and should review and increase its efficiency. Second, most Offices, especially Offices in developing countries, when dealing with division or merger, should have more mature conditions, such as human resources, etc. It should be ensured that the workload resulting from division did not increase for developing country Offices.

273. The Delegation of Germany repeated its view that the discussion should wait until the processes in the International Bureau worked more efficiently. Before that, no other process should be introduced. Division was too complex because the scope of protection had to be decided and this was difficult; it was worse in case of a merger.

274. The Delegation of Mexico supported the statements by the Delegations of China and Germany. Division was a concept that sought to give advantages and protection. But it had to be analyzed more thoroughly as had been said by INTA. The International Bureau focus should now be on having the current procedures of the Madrid Protocol working. Introduction of division should continue as a work in progress.

275. The Delegation of Switzerland reminded that the procedure was wished by a number of Offices and by all users. Some delegations were concerned with additional work resulting from introducing division. The procedure could be simplified if the request was presented to the designated Office affected by the division and not to the International Bureau. The Office was the best to distinguish problematic from non-problematic goods and services; it could receive the request for division, examine and validate it before sending it to the International Bureau.

To simplify the procedure, the Office submitted the non-problematic goods and services as the divided part, in other words, the new international registration. Once the Office and the holder had agreed, the designated Office transmitted the request for inscription of the division to the International Bureau. The International Bureau would simply have to inscribe this registration. The Office transferred the division to the International Bureau only once it was deemed admissible. The non-problematic goods and services, the divided part, were considered as accepted and approved by the affected Office. This proposal had major advantages: it simplified the procedure compared to the proposal by the International Bureau. First, the non-problematic part was inscribed in the new registration resulting from division; second, because this part had been submitted to the International Bureau by the affected Office, it could be considered as admissible for registration without a new examination by this Office; third, the work of the International Bureau was limited to inscribing the division. There was no need to carry out an examination and to receive a statement giving the division legal effect. The lower workload had, in turn, an impact on the amount of fees; fourth, the new Rule of the Common Regulations would be simple.

276. The Delegation of Israel repeated its view that division should take place in the Contracting Parties concerned. They notified the International Bureau for the recording of the division as a new international registration. The Delegation supported the Swiss proposal.

277. The Delegation of the United Kingdom repeated that users felt that division was a useful feature for the Madrid System. There was nothing complex about a division process. It was an added complication that the process did not just involve the right holder in one Office, but the International Bureau, the holder, the designated Contracting Parties and possibly the Office of origin. But that was not a complexity that could not be dealt with. The Swiss proposal seemed sensible and workable. The only uncertainty was that the International Bureau, if the division was notified to it, simply accepted it and did not question whether it was correctly classified. It had to be in the correct class since it originated from the correct class and it was not too vague, otherwise the situation became complex.

278. The Delegation of Italy agreed with the Delegation of United Kingdom. The workload or the complications were not too much to afford in the interest of users and the Madrid System. The Delegation agreed with the position of the Delegations of Israel and Switzerland, but the Delegation wanted to read it on paper to have a deeper discussion.

279. The Delegation of the Russian Federation supported the proposal from the Delegation of Switzerland. It wanted to see this procedure introduced and not be put off for later. Experience could demonstrate the efficiency of the system. The Russian Federation had had a division procedure for the last 10 years. Users went further and presented divisions for registrations that had already been divided. The Delegation agreed with the Delegation of Italy and requested to see the proposal on paper because there were many details. Problematic goods could be divided while the registration was kept for the non-problematic goods and services, for example, those that were protected.

280. The Delegation of Montenegro associated itself with the statement of the Delegation of the United Kingdom.

281. The Delegation of Hungary supported the statements from the Delegations of the United Kingdom and Italy.

282. The Delegation of Switzerland offered to make its notes available and to translate them into English.

283. The Delegation of Kenya supported the statement by the Delegation of the United Kingdom. To have a centralized division enabled Kenya to accommodate the national law. If the system was managed at the International Bureau, it was possible for the Office to maintain the uniformity which was an important principle of international registration.

284. The Delegation of Mexico wanted to hear more about the new Swiss proposal that the designated Office dealt with division. The Delegation suggested sharing of opinions about studies under national regulations and the best practices and a possible analysis on the ground.

285. The Delegation of Germany thought that the Swiss proposal was preferable. Without knowing the proposal, it was the same as the Delegation of Germany had said for replacement. It was easier and less complex if the Offices did the examination and only had to send one notification to the International Bureau. Without knowing the concrete implications, it might be that the national law needed to be changed because it knew division only for national marks and not for international marks. The Delegation asked the Delegation of Switzerland for its thoughts about the new international registration which would be needed for the non-problematic goods and services, because the others were further examined. The Delegation asked whether it would be an international registration just for one designated country and whether there was a new application for an international registration with the non-problematic goods and services only designating that country.

286. The Delegation of Colombia felt that the idea of division brought changes to the structure for which reason it was useful to continue studying this in line with the new proposals.

287. The Delegation of Switzerland, in response to the question from the Delegation of Germany, said that the idea was indeed to create a new international registration for goods and services that were not problematic for one country. This was a procedure that already existed for the partial transfer where an international registration resulting from a partial transfer concerned one country with limited goods and services.

288. The Representative of AROPI appreciated the open-mindedness of Delegations about the need for division. The priority for users was having a clear title, which required action by Offices that determined the rights of the applicant. This particularity was included in the International Bureau's proposal that the Representative of AROPI had supported. The same guarantee and similar benefits were offered by the Swiss proposal. Regarding the certificate, holders benefited from the necessary security to protect their rights. The Representative supported the proposals made by the International Bureau and the proposal by the Delegation of Switzerland.

289. The Chair concluded that the Secretariat should prepare a document for the next meeting analyzing the new proposal. Therefore the Secretariat needed more information on the specifics from the Delegation of Switzerland and any problems that might be foreseen. The Chair asked the Delegation of Switzerland to provide information to the Secretariat, preferably within the next month.

#### **AGENDA ITEM 6: PROPOSAL TO FREEZE THE OPERATION OF ARTICLES 6(2), (3) AND (4) OF THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS AND OF THE PROTOCOL RELATING THERETO**

290. The discussions were based on document MM/LD/WG/12/4.

291. The Secretariat said that the document analyzed all aspects of freezing of dependency and addressed the questions raised previously. The document informed about the background, the principle and the effects of dependency on the Madrid System, in particular on dependency and bad faith, the effects on the workload of Offices, on the flexibility to file an international



application, on legal certainty, on increased use, and the effect on the costs for preserving protection, namely transformation. The document informed about precedents of decisions by WIPO Union Assemblies on freezing, including in the Madrid Union Assembly, regarding the Madrid Agreement. The document discussed in particular effects on the legal framework and other implications covering the preservation of the basic mark requirement. The balance of interests between holders and third parties and between holders and Offices should be preserved. This could lead to an increased use of the Madrid System. The document proposed a temporary freeze of dependency for a period of five years. This was a trial period after which the Working Group and the Madrid Union Assembly would evaluate the results to determine the way forward, whether to continue the freeze or going back to the dependency provision.

292. The Delegation of Japan appreciated the study on the legal concerns of member States. Japanese users had concerns with regard to language issues in trademarks used in non-Latin alphabet based countries. Therefore, the Delegation of Japan shared the understanding of the issue raised in the document. On the other hand, the Delegation had concerns with a limited revision of practices through freezing the operation of dependency for five years. This might cause confusion for users and Offices.

293. The Delegation of Norway said that freezing the dependency in a trial period was a good way forward to modernize the Madrid System. The Delegation of Norway supported the proposal. First, this could increase legal certainty for users. They did not have to fear for the mark because of problems with the basic application. International registrations were treated less favorably than national marks in that in national systems, if registrations were filed abroad, one did not have to fear that the mark might fall because of something that happened in the home country. It simplified the system for users, for national Offices and for the International Bureau. It was favorable for applicants that wanted to have the international registration protected in other countries than their own. If, for example, a Norwegian applicant filed a registration in Japanese letters, taken away the dependency, there was no need to fear non-use and cancellation of the mark in Norway which could affect the designation of Japan. This might lead to increased use of the system. If it did not work, one simply reverted to the current situation.

294. The Delegation of Israel argued that freezing dependency would make the Madrid System more flexible and more attractive for potential Israeli users, especially because some did not use Latin characters in Israel, but needed a basic application in Latin characters to file an international application. Therefore, the Delegation of Israel strongly recommended the suspension of Articles 6 (2), (3) and (4).

295. The Delegation of Madagascar did not raise any particular objection to the proposal as long as the requirement of a basic mark was maintained as one of the fundamental principles of the Madrid System; the Delegation was in favor of the proposal in the interest of the holder.

296. The Delegation of the Russian Federation reported that it had carried out a survey with the following result: most users were in favor of freezing the Articles of the Madrid System during the five-year trial period. The respondents had seen positive effects and expected more international applications from SMEs. Therefore, the Delegation supported the proposal. The Delegation suggested that the International Bureau organized a follow-up survey to evaluate the effects on international registrations.

297. The Delegation of Italy was in favor of changes that made the system simpler, more user-friendly and attractive. The Delegation was favorable to the proposal, but underlined that it could not weaken the important role of national Offices. The freezing of dependency could increase the legal certainty of the trademark right and this met the interests of owners and third parties.

298. The Delegation of the United States of America was interested in exploring this idea further with its stakeholder community and stated that it needed some time to reach out to stakeholders to see if they were open to a trial period for this proposal. The Delegation certainly could get feedback for the next Madrid Union Assembly in September 2015. The Delegation suggested considering to schedule the next session of the Working Group prior to the Madrid Union Assembly so that the Working Group could recommend to the Assembly a trial period to suspend the operation of dependency.

299. The Delegation of Spain saw the principle of dependency as one of the main advantages of the Madrid System. Moreover, transformation following the ceasing of effect of a registration was rarely used. Therefore, freezing dependency was not a convincing argument.

300. The Delegation of Australia said that the analysis in the document was comprehensive and thorough, the proposals were concrete and their ramifications were usefully explored. The Delegation supported the proposal and agreed with the analysis of potential ramifications. As background to this support, Australian users were surveyed in depth about various features of the Madrid System in the last decade and comments received were that the potential for central attack was a risk that clients needed to be advised of and that could discourage the use of the system. Protection under the Madrid System should be the same as filing under the national system and the risk of central attack should not be present. The Protocol should assist in protection and this should not depend on unrelated events elsewhere. Small enterprises might not be able to afford the repercussions of a central attack and the costs of transformation. As indicated in the document, any decision to freeze the operation of dependency was reversible and after a given period, its effects were evaluated and a decision was taken whether to continue the operation of the relevant Articles. The trial period had to be considered carefully. It had to have sufficient duration to gather meaningful data about its effects, whether positive or negative, and to inspire confidence in users who were currently not confident. The Delegation thought that at least five years, possibly more, were necessary to gauge the effect of freezing dependency on greater use of the system by businesses. A declaration might be needed that any international application made during this trial period would not become liable to dependency to enable businesses to be confident to file international applications in the five-year trial period. The Delegation was concerned about the significant cost involved with the reporting on the basic mark for five years, particularly where there was little evidence to suggest that this activity served a purpose for the bulk of international registrations. In addition, there was a burden on the International Bureau to notify all designated Contracting Parties and a burden on those designated Contracting Parties in respect of actions to effect limitations or ceasing of effect. All these transactions were currently required under the Madrid System, even though they might be unnecessary. Circumstances in the country of origin might be different to those in the designated countries and limitation or ceasing of effect in designated countries might not be warranted.

301. The Delegation of Switzerland referred to the remarks by the Director General that the Madrid System was very attractive for many countries. The Agreement and the Protocol had the important feature of dependency. Dependency did not seem to be a deterrent to accession. The Delegation was not in favor of the proposed freezing. It could lead to a lack of quality in the registration and a lack of legal certainty. The Delegation wanted alternatives to be studied. The duration of dependency could be reduced. Improvement to transformation could be considered. One could speak about non-Latin scripts. Something could be done about the identity of the trademark, the basic registration and the extension of registration, etc. The Delegation wanted to be able to consult its stakeholders who were not only specialists in trademarks but also SMEs who liked having access to their Office of origin when filing.

302. The Delegation of China said that freezing dependency allowed modernizing the Madrid System, strengthening legal certainty, helping to preserve the holder's and third parties' interests and bring in more users. The Delegation supported the proposal.

303. The Delegation of Germany did not support the proposal. In Germany and the European Union, central attack was widely used and users wanted to retain it. The question of legal certainty for an international registration was legitimate. Under the Protocol, an international registration could be based on an application. An application for a national mark had no legal certainty until the mark had been examined and registered. Without dependency, there were many descriptive signs in the register. Dependency led to more legal certainty. The Delegation understood well the problems for countries with non-Latin alphabetic characters. But, as the Delegation of Switzerland had said, there might be other ways to solve the problem. In Germany, the mark could only be challenged due to non-use after five years. The dependency period was already over in this case. The Delegation asked other delegations, for example those of Japan, China or Israel, how they handled this situation.

304. The Delegation of the Republic of Korea supported the proposal. Dependency was a major reason for Korean users not to use the Madrid System. Since the Korean Intellectual Property Office (KIPO) performed a substantive examination, both on absolute and relative grounds, and Korean users increasingly filed international applications based on basic applications, rather than basic registrations, the fate of the international registration depended on the decision of the national examiners in many cases. This was unreasonable for users because even though the requirements for trademark registration were different in each country, the result was the same. Transformation was inefficient compared to the freezing of dependency because it needed an additional procedure. Freezing dependency increased the use of the Madrid System for Korean users and the Republic of Korea strongly supported this proposal.

305. The Delegation of Austria favored changes that made the system more user-friendly. However, dependency and central attack were important features and advantages of the Madrid System in the view of Austrian users. The Delegation concurred with the concerns raised by the Delegation of Italy that the role of the national Offices could not be weakened and it shared the concerns of the Delegations of Switzerland, Germany and other Delegations. Therefore the Delegation was not in favor of this proposal.

306. The Delegation of Sweden stressed that the users' perspective was important. Users were not only applicants or holders of registrations, but also third parties. The Delegation of Sweden had requested the International Bureau in the last Working Group meeting to carry out a user survey about what benefits this proposal brought to users. The Delegation stressed that a rare use of central attack did not mean that users wanted to abandon it. The current system was well-balanced and should remain as it was. This could be reviewed if users gave clear signals that central attack should be removed. Thus, the Delegation could not support the proposal.

307. The Delegation of the Czech Republic concurred with the Delegation of Germany. One might think of shortening the dependency period of five years to two years so that national Offices could finish their procedures and check whether descriptions were too vague, for example.

308. The Representative of AIPPI referred to the AIPPI resolution on freezing of dependency which did not support neither the freeze nor the abolition of the dependency on the basic mark. The Resolution did support a reduction of the dependency period from five to three years. Although dependency was at times criticized, for example, for having effect in countries where the reasons for cancellation of the basic mark did not apply, it provided a fair balance between the interests of trademark owners and those of third parties, in particular, by providing a centralized mechanism for the assertion of earlier rights. Further studies should be undertaken in relation to potential changes of the basic mark requirement.

309. The Delegation of Cuba referred to the argument that the dependency period was a limitation which made the system less attractive. Nevertheless in the last few years, an extraordinary increase in the number of applications and Members States had been observed. The statistics published by WIPO had shown that Asian Countries, which needed dependency to be removed, had become important Offices of origin with an increasing number of applications. Therefore, it was hard to understand why the existence of dependency hindered accession. The Delegation did not agree with the suppression for five years of the dependency period because that attacked the basis of the international registration system. The Delegation agreed that the period of dependency could be reduced.

310. The Representative of INTA agreed with the Delegation of Sweden that this initiative required a clear signal from users in the broad sense, as holders of international registrations and as third parties. At this stage, INTA had no clear view. INTA needed more time to consult its constituency as was the case for some delegations regarding national users. The Representative of INTA said that it remained unconvinced that a decision of the Madrid Union Assembly could achieve the suspension of the dependency clause: it needed more than that. Regarding the precedents, which might not be so relevant, and the Vienna Convention on the Law of Treaties (the "Vienna Convention"), the last sentence of paragraph 25 of the document stated that a suspension could be achieved by consent of all Parties. All Parties meant not just a majority decision in the Madrid Union Assembly, but a positive decision by all parties of the Union. The relevant provision of the Vienna Convention addressed the suspension of a Treaty provision between two or a limited number of Parties because it said "after consultation with the other contracting states". This might not be relevant to a suspension here. INTA cautioned against thinking that a suspension of Articles 6 of the Agreement and the Protocol could be achieved through a mere decision of the Madrid Union Assembly.

311. The Representative of MARQUES recalled that MARQUES was an association of brand owners, particularly representing their interests. MARQUES strongly supported the proposal of freezing dependency. The Madrid System had been developed, improved and modernized over the years and one should continue to modernize it and make it fit for the future, for the accession of further countries. This was a good first step to do it. MARQUES was glad that the user surveys in the Russian Federation and Australia had confirmed what MARQUES confirmed, that users supported the freeze of dependency. Use of the Madrid System was not made because of, but despite dependency and its great negative impact. Most of all, increased legal certainty was gained from freezing or abolishing dependency. In many cases, the applicants or holders of international registrations suffered unnecessary losses in designated countries. There was no advantage for Offices to maintain dependency. Offices had less work if dependency was frozen or abolished. For users, the sole advantage from dependency was central attack, but it was rarely used. If there was no central attack, a third party had other remedies against the international registration in the designated countries. The disadvantage for users was that designations were affected from a cancellation of the basic mark in the country of origin even though the attacker had no rights in the designated countries. Similarly, a central attack was effective in designated countries even where the attacker had a prior trademark registration but this registration was not genuinely used. If the basic mark was refused in the country of origin, for example for likelihood of confusion, there might be no likelihood of confusion in the designated countries. Nevertheless, central attack killed that registration also in those countries. It was not right that by one single procedure in the country of origin, the entire international registration was killed. This was a violation of the right to be heard in the designated countries. Central attack was the only advantage of the five year dependency period. There were further disadvantages. For instance, an *ex officio* rejection or cancellation, without a central attack, could kill the international registration. That was not right because there might be no reason for such rejection in the designated countries. There was uncertainty for five years. Where the proceedings were not concluded within the five years, this could be even longer. The uncertainty was an important argument for MARQUES to support the freeze of dependency. The document prepared by WIPO had not stated that the Paris

Convention excluded discrimination in Article 6. The Paris Convention said that the application for the registration of a mark could not be refused, nor invalidated on the ground that filing, registration or renewal had not been effected in the country of origin. Article 6 was not in place when the Madrid System had been established. But if the Madrid System had been established after Article 6 of the Paris Convention was enacted, there were certainly no basic mark requirement or central attack or dependency. This was another reason why the system should be improved by freezing or abolishing dependency.

312. The Representative of APRAM, a vocational association of professionals working with marks and design rights, said that APRAM, like other users' organizations, did not have a specific mandate for the proposed freezing or support of the dependency. APRAM, as INTA, continued to have doubts about the legal security of the solution to adopt the freezing of the dependency clause by a majority decision of the Assembly. This could lead to legal uncertainty that was not beneficial for the users. A temporary regime of five years required to evaluate the date of the international registration and to look at the impact of it. This was not of interest to users.

313. The Chair summarized that there was no consensus on the proposal. A number of Delegations were willing to discuss this further. The Delegation of Sweden would like to see a user survey on whether there was support from users. Linguistic diversity and the complexity of transformation were mentioned to be looked into; this needed further discussion. The Secretariat could be asked to make a survey, prepare a paper on possible solutions, raising the non-Latin script or linguistic diversity issues, looking into transformation and its complexity and into reducing complexity. User organizations, particularly MARQUES, that had supported this proposal, should describe the problems of maintaining dependency. The delegations supporting the proposal could do the same and describe the problems in detail. The Chair invited the Delegations to give more information on how to proceed with the debate in future meetings. One solution could be reducing the dependency period from five years to either three or two years. That required a diplomatic conference. It should be kept in mind whether this was really wanted.

314. The Delegation of the United Kingdom confirmed that the Chair had clearly outlined the options and challenges for the potential work ahead. The Delegation agreed to carry out a survey because the Delegations were not fully informed by their own users about their views on freezing or reducing dependency. It was useful to gather that information in a structured way which could translate to this meeting and contribute to the way forward. Clearly, transformation was part of the question. Any analysis on how the transformation process could be simplified was welcomed. The question of scripts worked both ways, particularly in the non-Latin script countries, when a basic registration had to be filed in a Latin script and onward, in the international system, the Latin script was not used and the registration became vulnerable. Reducing the dependency period to three years might be a solution because in the United Kingdom a mark became vulnerable for non-use after five years.

315. The Delegation of Australia supported the views of the Delegation of the United Kingdom.

316. The Delegation of Lithuania supported the statement made by the Representative of MARQUES that it could affect only formal examination cases on absolute grounds. Consideration could be given to restrictions relating to cases of lapse of trademarks, and maybe also to restrictions to unfair competition or other cases.

317. The Delegation of Germany was mostly interested in the problems of Asian countries with non-Latin script of having a mark in Latin script. China was the most designated country and there was a good business relationship with China. Many German applicants applied for international registrations in China and there was no case where a mark in Asian script was canceled due to non-use. That was probably because non-use could only be challenged after five years when the dependency period was over.

318. The Delegation of Hungary appreciated the useful summary of the Chair and agreed with the Delegations of United Kingdom and Australia about how to go forward.

319. The Delegation of Germany said that a survey should be worldwide. If there were only few users who wanted to have dependency and central attack, it was as for division. It might be rarely used but it might be an important instrument for some users, for example in Germany and the European Union. The majority of the interested circles, such as AIPPI, INTA and AIPLA did not have a clear position because their constituency was divided about the advantages and disadvantages. The Delegation did not see whether a survey of users, which was a big undertaking, could bring a clear solution.

320. The Chair responded that a clear picture could not be known until there was the result of the survey.

321. The Delegation of Norway supported having a survey. That would be useful in finding what users thought about the issue.

322. The Chair summarized that there was support for having something prepared for the next meeting, to look into transformation and simplification of the procedures and the issues of the different types of scripts and that the International Bureau should prepare a survey.

323. The Secretariat said that a survey targeted users in general. The questions to be asked would be posted in the Madrid Legal Forum. The Delegations were invited to access the forum; delegations which had signed up would be alerted when the survey was posted. There would be an opportunity to provide comments. The findings of that survey would be presented in the next meeting. It would cover the issue of simplifying transformation. Many Delegations had raised the issues of non-Latin script. The Secretariat would look into this and invited user organizations to contribute testimonials on dependency, in particular those who were in favor of freezing because they experienced difficulties with dependency.

324. The Representative of MARQUES said that it was important that the questions in the survey did not lead into the wrong direction. It had been seen with the discussion at AIPPI that Members were speaking only about central attack and its advantages. The discussion was not about the disadvantages of dependency. It was important not to focus on central attack. If a question on central attack was formulated, it was important to address the disadvantages so that the questionnaire was not biased.

325. The Delegation of Germany suggested discussing the questionnaire in the Working Group.

326. The Secretariat responded that the draft questions were published on the Madrid Legal Forum so that comments could be made in that forum.

327. The Chair concluded that there was no consensus on the proposal and the issue had to be discussed further. He asked the Secretariat to prepare a survey and make that available for comments before the survey was made, and to prepare a document looking particularly into transformation and the issue of the use of Latin- and non-Latin script.

## AGENDA ITEM 7: REPLACEMENT

328. The discussions were based on document MM/LD/WG/12/5.

329. The Secretariat reported about frequent questions by users and Offices on how replacement worked and the difficulties it generated. Replacement was last discussed in the fifth session of the Working Group based on a questionnaire sent out to the Offices of the Contracting Parties. Since then, new Members had joined. As the second questionnaire was identical to the first one, the information received could be compared. By March 2014, 57 members had responded. In addition, the information from 14 members received in the previous exercise was considered which gave a total 71 Contracting Parties. The document recalled the basic elements of replacement and examined how the applicable provisions had been implemented by the Contracting Parties based on information provided by them. The document summarized the divergent interpretations of the principles of replacement among the Members of the Madrid System. The findings showed that there still existed different interpretations of key elements of replacement, such as the effective date of replacement, the time at which a request under Article 4*bis* could be filed with the Office, the goods and services listed in the national or regional registration, and what were the effects of replacement on the national or regional registration. The document proposed that the Working Group discussed these key elements with a view to simplify and harmonize the practices of the Offices of the Contracting Parties on replacement to make the Madrid System more user-friendly.

330. The Delegation of Italy, on behalf of the European Union and its member states, said that the document provided valuable insights into the different implementation and interpretation by Contracting Parties of the applicable provisions of the Treaties of the Madrid System.

331. The Delegation of Madagascar informed that Madagascar had had its first case of replacement. It had been successfully processed. The way of implementation in Madagascar corresponded to the suggestions in the document. Replacement took effect as of the date of the international registration and subsequent designation, even if the Office took note later, namely after issuing a statement of grant of protection. The request for replacement could be made as of the date of the notification by the International Bureau of the international registration or subsequent designation. Partial replacement was not accepted. The list of goods and services had to be in conformity with the international list. The coexistence of both registrations was allowed. The Delegation agreed with the proposal to harmonize the procedures of replacement.

332. The Chair invited comments on item 5 in the document, the key elements. The first element was the effective date of replacement. Paragraph 26 of the document had mentioned that there were two relevant dates, the effective date of replacement and the date of recording in the national or regional register taking note that replacement had occurred.

333. The Delegation of Switzerland stated that the right date was the date in the national register. That was the date of effect. The Delegation asked what happened if the international registration was refused, which had not been clarified in the document, and what happened when a provisional or final refusal was registered, in which case, the date to move forward was in general the date that the International Bureau had proposed.

334. The Representative of INTA said that, under Articles 4*bis* of the Agreement and the Protocol, the international registration, when the conditions were met, was deemed to replace the national or regional registration without prejudice to the rights acquired by virtue of the latter. This meant that the international registration enjoyed the rights supplied previously by virtue of the national or regional registration. It was obvious, since replacement was automatic, that under Article 4*bis*, the international registration could not enjoy these rights before it had become effective itself. In all cases, it acquired those rights from the moment in which the

international registration became effective. It was tautological that the date of replacement was the date on which the international registration took effect because it is as of that date that it enjoyed prior rights.

335. The Delegation of China indicated that the effective date of replacement was the date of the international registration or subsequent designation. The Chinese Office accepted the request to take note under Article 4*bis* after the date of notification by the International Bureau of the international registration or subsequent designation and took note, upon request, of the entirety of the goods and services listed in the national or regional registration which should be covered by it. The national registration and the international registration deemed to replace it should be allowed to coexist. It was not necessary to cancel the national registration *ex officio*. The holders had to decide whether or not to renew the national registration.

336. The Delegation of Norway commented that the document was useful as it showed the different practices of the different Offices regarding replacement. It would be interesting for the Working Group to make the key elements a reference document in the interest of a harmonized practice.

337. The Chair concluded that there was agreement that the date of replacement was the date of the international registration or subsequent designation.

338. The Chair opened the discussion on the key element regarding the time when the request under Article 4*bis*(2) could be filed with the Offices. Paragraph 27 said that the Office should accept requests as from the date of the notification of the international registration or the subsequent designation by the International Bureau.

339. The Delegation of Cuba considered replacement to be automatic when the requirements had been met. It only took effect when the Contracting Parties had been requested to take note of the international registration in their register. The Office did not act *ex officio*. The effective date should be, in accordance with Article 4*bis*, the date of notification of the international registration or the subsequent designation.

340. The Chair drew attention to paragraph 11 of the document which underlined that the fact that an Office took note in its register of an international registration pursuant to Articles 4*bis* of the Treaties was a precondition for replacement. The Chair understood the Protocol in this direction as well. The Chair asked whether there were different views.

341. The Delegation of Switzerland reported that it had not had any cases to decide on requests for replacement before the end of the period for a notification of a provisional refusal or of a grant of protection. The problem was that the Office took note of the replacement of a valid Swiss mark by a pending application. Before issuing a notification of a provisional refusal or of a grant of protection, the international registration or the designation of a country had not yet been accepted by the Office. Luckily, the Swiss Office did not have had to deal with such a case. Taking into account the date of notification as the only criterion, the Office would be taking note of the replacement of a valid national mark by an international registration that was being examined. The delegation asked whether that was the goal of replacement.

342. The Delegation of Cameroon said that paragraph 26 should have tried to provide answers on the questions on the two dates. The discussion had been about the effective date of replacement, but there were no clear ideas about the date when the recording took effect. The Delegation asked whether it was the date when it was received or the date when it was sent. At least this paragraph had given an answer only to the first date whereas the second date had not been dealt with.



343. The Representative of INTA said that the fundamental ambiguity was that paragraph 27 spoke about the request to take note in the national Register of replacement. Article 4*bis*(2) of the Protocol required the Office to take note upon request of the international registration which, under Article 4*bis*(1), was deemed to have replaced the national registration when the conditions were met. Article 4*bis*(2) did not require an Office to examine the request for the recording of the international registration in its national register. The Office was not required by Article 4*bis*(2) to examine whether the triple identity was met. It was simply required to record the number of the international registration concerned. The Swiss practice was to examine the requests for recording and take a decision on whether the conditions were met and whether, in the opinion of the Office, replacement had effectively taken place. This was not implied by Article 4*bis*(2). It might well be that Offices of other Contracting Parties took a different position and merely took note of the international registration. If one day the question of prior rights belonging to the national registration that had been deemed to be replaced by the international registration arose, a decision would have to be taken at that time on whether the replacement had taken place and whether the triple identity condition had been met. Throughout the document and in the proposed amendment, that fundamental ambiguity could be seen: the assumption was that a request to note the replacement implied a decision by the Office. That decision was not required by Article 4*bis*(2). Under Article 4*bis*(2), note could be taken at any time. It was not a condition for replacement since replacement was automatic and did not imply a decision by the Office. Therefore, note could be made immediately after the notification of the international registration to the Office because the Office knew at that time that it had been designated in that international registration whose number it had recorded in the national register. In the future, the request to take note could even be made in the international application. That could help the transparency of the system, because it would be immediately published to the knowledge of all interested parties. There should not be too much concern about where the notification request could be placed because this request was in effect a request to note the international registration in the national register.

344. The Chair appreciated that the Representative of INTA had referred to Rule 21 and the requirement therein that the national or regional Office notified the International Bureau that replacement had taken place. That requirement forced the Office to take a decision. It was important to keep in mind the wording of Article 4*bis*. In practice, this might not be a conflict. The Danish Office received sometimes requests for replacement before having finally accepted the designation. Then the Office waited until it had accepted the designation before notifying, in accordance with Rule 21, that replacement had taken place. Denmark had an opposition period after the final acceptance. If the opposition period was before the final acceptance, problems might occur. That might be the reason for these questions. If Offices did not accept the notification at the early stage and did not take it into account, they would not allow the holder of an international registration to have the benefit of replacement in an opposition case. Offices had to accept that replacement was automatic, also in opposition cases, even though the mark was not yet accepted. Offices had to allow the holder to notify them of replacement. It might be that an Office could not send a notification to the International Bureau in accordance with Rule 21 before it had made a final acceptance. It could not work otherwise if it was accepted that replacement was automatic.

345. The Secretariat summarized the issues raised: the question of the Delegation of Switzerland whether a provisional refusal affected replacement; the comment from the Representative of INTA that Articles 4*bis* required an Office to take note in the national register; and the question whether the designated Office should examine whether the requirements for replacement were met. On the issue raised by the Delegation of Switzerland, two points should be made. Replacement, *ipso iure*, was automatic under Article 4*bis* of the Agreement and the Protocol. This was not contested. There was agreement that this was effective as of the international registration date. The Secretariat asked whether this meant that, to have effect for a designated Office, Article 4*bis*(i) required that the protection was extended to the designated Contracting Party, the protection had to be final, and the designated Office had to have

completed the examination of the international registration and issued a notification of provisional refusal or statement of grant protection. It did not mean any of this. It meant, as was said under Article 3*bis* of the Protocol that the protection of the international registration was extended to all Contracting Parties upon the request of the applicant. Article 3*bis* said that the territorial effect should extend and that was the same expression under Article 4*bis*(1)(i) of the Protocol. The answer to the Swiss Office was that replacement had effect when the extension of protection of the international registration had effect by way of the designation. But it did not affect any later provisional refusal or grant of protection. Referring to the statement by the Representative of INTA, the Secretariat stated that under Article 4*bis*(2), the national Office was required to take note in its register of the international registration upon request while Rule 21 spoke about taking note of replacement. This wording was not presented by the International Bureau to the Working Group, but this had been said many years before. There seemed to be a contradiction between the Article and the Rule. But again, this was not the case. Under Article 4*bis*(2), the designated Office had to take note of the international registration number and of nothing else. Rule 21 gave an explanation why note was taken of the international registration. That was obviously for the purpose of replacement. Rule 21 did not go beyond Article 4*bis*(2) and explained what the Article said. Otherwise, it was not understandable why note was taken of the international registration by the designated Office. That was for the purpose of replacement. Article 4*bis* did not say that the designated Office had to examine whether the conditions for replacement had been met. The designated Office could analyze the request to take note of the replacement, but it could not take a substantive decision, it should simply take note that there is an international registration for the purpose of a replacement. When a designated Office had completed its substantive examination of the international registration and had issued either a total or partial provisional refusal or a statement of grant of protection under Rule 18*ter*(2) or a further decision under Rule 18*ter*(4), the holder could request a cancellation of the national registration that was replaced. Replacement did not imply substitution. Articles 4*bis* of the Agreement and the Protocol gave a right to replace. It gave the option that, if at the right time the conditions were met, replacement took place in the national registry by the international registration. This did not happen until there was certainty that all the rights of the international registration had been duly consolidated.

346. The Delegation of Switzerland said that this could be a topic for the Roundtable. The problem was to inscribe taking note of an international registration without examination. Switzerland kept both numbers in the national registry. Often, the holders' names were incomplete or unclear. If the Office took note of an international registration which was not identical to the national mark, there were issues with legal security and third parties' rights. There was a risk of linking two marks which had nothing to do with each other. It was not in the interest of the system, the holders or of third parties. The Swiss practice had always been to examine the request before registering it. The Delegation of Switzerland did not want to question that principle. This was not in the interest of the concerned parties and did not resolve the problem of the date when the Office should take note, but was an additional problem.

347. The Representative of INTA, referring to the explanations of the Secretariat, said that he had not suggested that Article 4*bis*(2) prohibited or prevented an Office from examining whether the requirements of Article 4*bis*(1) were met: it could do so. It was in the interest of users to know what the standard of the Office to accept replacement was. He wanted to say that the Article did not require the examination, not that it prohibited that examination. The Representative of INTA suggested clarifying in Rule 21 that, when receiving a request for recording the international registration which was deemed to have replaced the national registration, the Office of the designated Contracting Party concerned could notify that it had taken note. The Office should be allowed to examine and, in that case, should notify the result of its examination after all the procedures which were in place had been exhausted. It might notify that it had refused the replacement and, therefore, it was clear that the Office had made that decision at that time. INTA would have a clear text on that when the discussion came to

Rule 21. The point to be made was that the Protocol required the Offices only to note the international registration in their register. This was something that could be done at any time. As was said by the Secretariat, the Office could keep that request in abeyance until they were satisfied that they took a decision on replacement.

348. The Chair opened the discussion on the key element relating to the goods and services listed in the national or regional registration. This was described in paragraph 28, which stated among other things that the international registration did not need to have an identical list of goods and services. The list could be broader in scope but not narrower and the names of the goods and services used in the international registration did not need to be the same, but they had to be equivalent.

349. In the absence of interventions, the Chair concluded that there was agreement on paragraph 28.

350. The Chair opened the discussion on the key element described in paragraph 29, regarding the effects of replacement on the national or regional registration. It stated that replacement itself did not necessarily imply or require a cancellation of the national or regional registration, but they could coexist.

351. The Delegation of Germany stated that the German Office canceled the national mark automatically in case of replacement. There had never been a doubt about it because of the wording of Article 4*bis*. There only had been discussion in the legal literature if the cancellation took place right away when the two marks existed or only upon request. The Office applied the more generous opinion and cancelled only upon request. For Germany, it had always been clear: replacement was substitution. The Delegation was willing to accept the coexistence, but needed to have legal arguments. The benefits for the holder were not satisfactory legal arguments.

352. The Delegation of Mexico stated that Mexico had carefully studied the issue of replacement. Other Offices, namely the United States Patent and Trademark Office (USPTO) had helped Mexico to understand the legal nature of replacement. The document had stated that the purpose of replacement was to avoid a refusal in a designated Contracting Party. The Office should not refuse protection because a mark had already been registered. Following analysis of the legal department, Mexico had concluded that there was room for two marks, one in the national framework, and one in the international framework. After having heard the discussion, the Delegation of Mexico sought more clarity on replacement. It had been said that replacement was effective *ipso iure*, but the problem was what happened when the request was made and replacement was effective automatically under the Protocol. The Delegation understood that both registrations coexisted, but the Office had to do something more, it had to indicate that the national mark had been replaced under the Protocol. There were two moments to consider: one was the moment when the mark was replaced and the other was when the holder requested the office to take note of the replacement.

353. The Secretariat responded to the Delegation of Germany that, under a teleological interpretation, the provision on replacement wanted to enable the holder of an international registration to manage the trademark portfolio in the most efficient way. In this case, an earlier national or regional mark met the international mark in the same designated Contracting Party. The international registration had a long time of dependency during which it was not legally consolidated. Although there was a right to replacement, during the dependency period, it was not in the interest of the holder of the International registration to cancel the earlier national or regional mark because that meant to change an already established right with a right which was not yet firm. That was why paragraph 29 of the document stated that earlier national or regional rights should be able to coexist with the international registration. It was logical that they coexisted during the vulnerability of the international registration. Afterwards, the holder of the

international registration could decide to give up the national or regional registration. In any case, that was a decision of the holder of the international registration in the context of an efficient trademark portfolio management. This efficient management of the marks was the background to the provision on replacement. The automatic effect of replacement could not bring the holder of an international registration into a worse situation than before the international registration. Therefore, the earlier registration of the mark should not be automatically cancelled. Replacement could never result in the detriment of the holder. That was the reason for the co-existence.

354. The Representative of INTA said that this was the most important issue reviewed in this document. Article 4*bis* had been introduced by the Brussels Act to allow the coexistence between the international registration and the national registration. Users were concerned that, according to page 16 of the document, four out of 58 Contracting Parties had responded that they cancelled the national registration *ex officio* or that holders needed to renounce the national registration. The Secretariat had underlined that, if the international registration was canceled as a result of a central attack or because it was refused in the country of origin during the dependency period, the holder of the national registration lost all rights in the designated Contracting Party concerned. The International Bureau should propose an interpretive statement on Article 4*bis* to the effect that the Contracting Parties had to allow co-existence between the international registration and the national registration at least during the dependency period. There was too much of a risk for holders of international registrations.

355. The Delegation of Germany said that all that had been said was already known. The Delegation was willing to follow this interpretation that it was too risky for the holder and that coexistence was good for the holder. However, these were not legal arguments at all. An analysis of the text was required that explained the situation in legal terms. The practical argument that it was good for the holder was insufficient.

356. The Secretariat considered two arguments: One argument, *de lege lata*, was to ask where in the Protocol, the Agreement or the Rules it was said that the consequence of replacement had to be the cancellation of the previous registration by the designated Office. There was no basis for the designated Office to take the radical decision and deprive a holder of prior rights if the holder did not want to give up the prior rights. It might be considered to include in Rule 21 that replacement did not imply the *ex officio* cancellation of the previous registration by the designated Office. Those were the real legal arguments.

357. The Delegation of Switzerland requested to receive the minutes of the Conference that introduced replacement. The notes could support the interpretation of the International Bureau. The Delegation was not challenging that interpretation, but there was no basis to interpret it in that way. An extract from the minutes would be useful and could be included in the Report of the Working Group. The Delegation asked whether changes to Rule 21 would be discussed in the Working Group or during the Roundtable.

358. The Delegation of Cuba commented that it was not against the idea and it wanted to see if the International Bureau could notify replacement in a centralized manner. Cuba was not among the countries with the largest number of replacements but there was a certain experience. The holder had gone to the Office and the Office had validated the data. Then, the international registration replaced the national registration and the holder decided what happened. The practice, unfortunately, had been that all holders of an international registration had let the marks expire.

359. The Chair said that further discussion on Rule 21 was needed. The Secretariat should prepare a revised draft of Rule 21 for the next meeting which considered the principles and key elements discussed and include them in Rule 21. That document should include something from the minutes of the Conference where replacement was introduced as suggested by the Delegation of Switzerland so that more information was available.

360. The Delegation of Germany suggested that the interpretations on which consensus had been achieved, regarding paragraphs 24 to 29, were included in the Guide. The Guide was a valuable resource. The Delegation questioned whether these interpretations needed to be included in the Rule, but it was useful to have them in the Guide to support Offices' decisions.

361. The Chair concluded that there was agreement on the further work and invited the Secretariat to prepare a redraft of Rule 21 for the next meeting of the Working Group and to look into whether information could be included in the Guide.

#### **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**

362. The Chair reopened the discussions on document MM/LD/WG/12/2 and the redraft of Rule 24.

363. The Secretariat explained that the text in Rule 24(5)(d) was meant to clarify the level of examination by the International Bureau. When the International Bureau received a subsequent designation containing a limitation, it examined in accordance with Rules 12 and 13, meaning that the text was properly classified and not too vague, etc. In addition, the International Bureau made sure that no indication of any class was added which was not already in the main list.

364. The Delegation of the European Union, on behalf of the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM), asked the Secretariat to explain how subparagraph (d) worked in practice, in particular what the wording "deemed not to contain the goods and services concerned" implied. Did this mean that the International Bureau deleted those goods and services from the specification, or would it, as it currently did, indicate that those goods and services were considered too vague in a between brackets indication.

365. The Delegation of Germany was surprised about the redraft because it had understood that it had been decided to retain the text as it stood before, to have examined at least obvious cases. Now, there was only the case that in the subsequent designation was an additional class. If there was an addition within the same class, for example in the international registration was only clothes and then appeared clothes and shoes, although this was an obvious broadening of the scope, it could not be examined with this text. With the previous text, examination would have been possible.

366. The Representative of INTA said that in Rule 24(5)(a), in the middle, it should read "regarding any irregularity to be remedied" and the word "to" should be deleted. The Representative had the same question regarding Rule 21(5)(d) as OHIM. The Representative of INTA had understood that the intention of the International Bureau was to delete goods and services that did not fall under the classes of the original list, but that it would not affect the application *mutatis mutandis* of Rules 12 and 13. Under Rule 12, where the International Bureau disagreed with the applicant or the Office of origin on the classification of a particular good or service, there was an exchange with this Office. If they could not agree, the International Bureau determined the proper classification, but it did not delete the good or service in question. Under Rule 13, where the International Bureau considered a term too

vague, it maintained that term with an explanation that it considered the term too vague. This should not be affected by the proposal to treat differently the goods and services which did not fall under paragraph 5(a) in the classes existing in the original list. In fact, both Rules 12 and 13 should not be applied *mutatis mutandis* with the consequence that the goods, that were misclassified or expressed in too vague terms, were deleted. The deletion of the goods and services should apply only when the irregularity consisted in adding words that did not fall within the classes of the original list and was not remedied.

367. The Chair suggested that the text could be simplified by simply deleting in subparagraph (d) the reference to Rule 13 so it said that notwithstanding subparagraph (b) if an irregularity under Rule 12 was not remedied, etc.

368. The Representative of INTA responded that this would not help completely solve the problem because the irregularity under Rule 12 could be a misclassification that was corrected, in a class that already existed in the original list. If it was remedied, subparagraph (d) did not apply, that was clear. Subparagraph (a) could be kept as it was and say that where an irregularity relating to paragraph (5)(a) was not remedied, the goods and services concerned should be deleted from the subsequent designation.

369. The Secretariat explained that, when keeping the reference to Rule 12, this covered an irregularity not being remedied. That irregularity could be that either it had not been properly classified, even though it was in the class mentioned in the main list, or that it was belonging to a class not mentioned in the main list. For both reasons, this could be as it was, just the reference to Rule 13 being deleted and to Rule 12 kept.

370. The Chair added that it also covered the last part of subparagraph (a).

371. The Representative of INTA concurred with the Chair.

372. The Delegation of Switzerland stated that it needed more time to think about this issue. If the reference to Rule 13 was deleted in subparagraph (d), it said what would be done if the holder and International Bureau did not agree. There could be a problem of classification, where the International Bureau decided, or there could be a problem with a too vague term, where the International Bureau added a remark in brackets, or there could be a problem of the extension of goods and services in which case the goods and services were deleted. There were three different scenarios which the Delegation wanted to appear in subparagraph (d) because subparagraph (d) was there to resolve all problems if the holder and the International Bureau did not agree.

373. The Chair responded to the Delegation of Switzerland that paragraph (5)(a) already said that Rules 12 and 13 applied *mutatis mutandis* and an irregularity was raised anyhow. As proposed by the Representative of INTA, to make things clearer, the reference to Rules 12 and 13 could be deleted. It could refer to a situation where any irregularity under the last sentence of subparagraph (a) was not remedied. This should take into account all possible situations. This was so in paragraph (5)(a) and also in subparagraph (d). In subparagraph (d) it said "Notwithstanding subparagraph (b), where an irregularity under the last sentence of paragraph (5) subparagraph (a) is not remedied, the subsequent designation shall be deemed not to contain the goods and services concerned".

374. The Delegation of Italy suggested that the simplest way to solve the problem could be to cancel in subparagraph (b) and to add in subparagraph (a) after words “the International Bureau cannot satisfy itself that all the goods and services listed in the subsequent designation can be grouped in the classes of the international classification of goods and services listed in the international registration concerned, the International Bureau should raise an irregularity. If the irregularity is not remedied, the International Bureau will delete the goods and services concerned”. This could be a part of subparagraph (a).

375. The Chair responded that if this was put in subparagraph (a), there was a problem when moving to subparagraph (b); (a) was of general nature and (b) said that if irregularities were not remedied within three months from the notification of the irregularity by the International Bureau, the subsequent designation was considered abandoned. That was a general part. There was a special situation to deal with in subparagraph (d) thus it needed to be kept in that order.

376. The Delegation of the European Union said that its main concern was with the reference to Rule 12 in paragraph (5)(a). It said that, where the International Bureau found that certain goods were incorrectly classified and asked the holder to reclassify in a different class and the holder did not do so, the International Bureau proceeded. In that case, the International Bureau automatically put the goods in the other class. In the case of a subsequent designation, there could never be an additional class because it had to have been in the original registration. The concern was that by specifically making reference to Rule 12, expansion of the original list of goods and services was allowed. The original classes were extended.

377. The Chair responded to the Delegation of the European Union that the answer to that question was in subparagraph (d). If the International Bureau raised an irregularity under Rule 12 in a situation where the goods should be classified in a class not covered by the international registration, it was caused by the last sentence of subparagraph (a) which in (d) resulted in it being taken out. It would not just simply add a new class to the subsequent designation, but it was covered by subparagraph (d).

378. The Delegation of the European Union responded that this was not what Rule 12 said. By precisely citing Rule 12 in Rule 24(5)(a), Rule 12 applied. In that particular case, Rule 12 would not apply. Rather than specifically referring to Rules 12 and 13, the situations in Rules 12 and 13 should be described, the classification of the goods or the examination as to vague terms.

379. The Representative of INTA stated that under the proposed text of paragraph (5)(a), the International Bureau applied Rules 12 and 13 *mutatis mutandis*. Under Rule 12(1)(a) the International Bureau considered that the requirements of Rule 9(4)(a)(xiii) were not complied with. Rule 9(4)(a)(xiii) required the names of the goods and services to be grouped in the appropriate classes of the International Classification of Goods and Services, each good preceded by a number and presented in the order of the classes of that classification. If this was not met, the International Bureau made a proposal for the classification and grouping. If the applicant or the person requesting the subsequent designation made a proposal that was accepted by the International Bureau, and that proposal could be to maintain the goods and services in a class that fell in the original list, the International Bureau accepted it. If, on the other hand, the International Bureau did not agree with the holder of the international registration, it determined that it fell in another class. In the latter case, the International Bureau applied the last sentence of subparagraph (a) and acknowledged that it could not put those goods and services in one of the existing classes in the international registration. Therefore, it applied subparagraph (d). If that sequence was followed, there was an examination under Rule 12 that applied not only to the proper classification but also to the grouping, which is what Rule 12 required. There was an examination regarding Rule 13: if the International Bureau was not satisfied with the reply of the holder under Rule 13, it applied the last sentence of paragraph 5(a) and drew the consequences.

380. The Chair confirmed that understanding.

381. The Chair concluded that the Working Group had agreed on Rule 24.

382. The Chair reopened the discussion on Rule 5.

383. The Secretariat explained that the redraft proposed that, where the time limit was not met because of a failure in the communication with the International Bureau, all failures of communication were covered, whether with the International Bureau, with the Office or elsewhere. The earlier discussed amendment had been seen as restricting, not in the holders' favor, and creating a more difficult situation for the interested party by referring to the failure in the electronic communication system within the International Bureau. The Secretariat proposed going back to the previous proposal of a failure in the electronic communication with the International Bureau leaving it as broad as possible.

384. The Chair read out the change in the text of Rule 5(iii) starting with the fourth line: "[...] that the time limit was not met because of failure in the electronic communication with the International Bureau"; thus "with" replaced the word "system of".

385. The Delegation of Colombia asked for clarification about the limitation of the justification by the five days and six months.

386. The Secretariat responded that paragraph (4) introduced a restriction to the right of the interested party. Under paragraph (3), the communication had to be effected, not later than five days after the communication was resumed, which meant that it had to be resent. Under paragraph 4, the International Bureau needed to receive this not later than six months after the expiration of the time limits. That was the final deadline.

387. The Chair concluded that the amendments to Rule 5 were approved.

#### **AGENDA ITEM 9: SUMMARY BY THE CHAIR**

388. The Representative of the JTA asked with respect to paragraph 13 of the draft Summary by the Chair for clarification on the amendment of Rule 9 related to the description of a mark whether the understanding was correct that, after the amendment of Rule 9 was implemented, it was possible for the users to write two descriptions of a mark in form MM2. The Representative asked whether, if the two descriptions were inconsistent or one was redundant, the applicant could express which description should have priority when the designated Contracting Party examined the international application.

389. The Secretariat responded that the whole purpose was to allow the applicant to provide information in a form of a description to possibly overcome a potential refusal down the road. Offices of origin might require putting in the same description that was in the basic mark. The applicant might add supplementary information because there may be the situation where the basic mark was old and information should be added in the international application which a possible designated Contracting Party might be looking for.

390. The Delegation of Morocco reported that the Ministry of Handicrafts of Morocco had had difficulties with the Madrid Agreement. The Ministry, via the Madrid Agreement, had requested to protect its certification marks in the United States of America and the European Union. It had ticked the box on certification marks under item 9(d) of the form MM2 and sent these to WIPO saying that it was a collective mark of guarantee. The Ministry had received a notification from the European Union because they thought that under their legislation, when the new registration said that it was based on a basic mark relating to a certification mark, it was dealt with like a community mark. There was the same notification from the United States of America saying



that the type of mark had not been specified. The Delegation asked whether it was a collective mark or a certification mark because guarantee marks were not allowed for registration in the United States of America. The Ministry had to be represented in the Washington Office just to indicate that it was not a collective mark and had to engage in extra expenses and go to extra trouble. The Minister wondered, since provisional refusals were inevitable in this case, why not use the national or regional law to ask for protection directly to those countries concerned and avoid this complicated procedure. The Delegation asked whether one could think about preventive measures to avoid difficult situations for users who decide sometimes to abandon the international route. The Delegation remarked that one could specify exactly the type of mark, collective, certification or guarantee mark, when sending it by electronic means, because the standard ST 66, under which the data were structured, specified this.

391. The Working Group approved the Summary by the Chair, as contained in document MM/LD/WG/12/6 and recommended that the proposed amendments to Rules 5, 9, 24 and 36, as set out in Annex I to the present document, be adopted by the Madrid Union Assembly.

#### **AGENDA ITEM 9: CLOSING OF THE SESSION**

392. The Chair closed the session on October 24, 2014.

[Annexes follow]

**PROPOSED AMENDMENTS TO THE COMMON REGULATIONS UNDER THE MADRID  
AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS AND THE  
PROTOCOL RELATING TO THAT AGREEMENT**

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

**Chapter 1  
General Provisions**

[...]

*Rule 5  
Irregularities in Postal and Delivery Services  
and in Communications Sent Electronically*

[...]

(3) [Communication Sent Electronically] Failure by an interested party to meet a time limit for a communication addressed to the International Bureau and submitted by electronic means shall be excused if the interested party submits evidence showing, to the satisfaction of the International Bureau, that the time limit was not met because of failure in the electronic communication with the International Bureau, or which affects the locality of the interested party owing to extraordinary circumstances beyond the control of the interested party, and that the communication was effected not later than five days after the electronic communication service was resumed.

~~(3)~~(4) [Limitation on Excuse] Failure to meet a time limit shall be excused under this Rule only if the evidence referred to in paragraph (1), ~~or (2)~~ or (3) and the communication or, where applicable, a duplicate thereof are received by the International Bureau not later than six months after the expiry of the time limit.

~~(4)~~(5) [International Application and Subsequent Designation] Where the International Bureau receives an international application or a subsequent designation beyond the two-month period referred to in Article 3(4) of the Agreement, in Article 3(4) of the Protocol and in Rule 24(6)(b), and the Office concerned indicates that the late receipt resulted from circumstances referred to in paragraph (1), ~~or (2)~~, or (3), paragraph (1), ~~or (2)~~ or (3) and paragraph ~~(3)~~(4) shall apply.

## Chapter 2 International Applications

[...]

### *Rule 9 Requirements Concerning the International Application*

[...]

- (4) *[Contents of the International Application]* (a) The international application shall contain or indicate
- (i) the name of the applicant, given in accordance with the Administrative Instructions,
  - (ii) the address of the applicant, given in accordance with the Administrative Instructions,
  - (iii) the name and address of the representative, if any, given in accordance with the Administrative Instructions,
  - (iv) where the applicant wishes, under the Paris Convention for the Protection of Industrial Property, to take advantage of the priority of an earlier filing, a declaration claiming the priority of that earlier filing, together with an indication of the name of the Office where such filing was made and of the date and, where available, the number of that filing, and, where the earlier filing relates to less than all the goods and services listed in the international application, the indication of those goods and services to which the earlier filing relates,
  - (v) a reproduction of the mark that shall fit in the box provided on the official form; that reproduction shall be clear and shall, depending on whether the reproduction in the basic application or the basic registration is in black and white or in color, be in black and white or in color,
  - (vi) where the applicant wishes that the mark be considered as a mark in standard characters, a declaration to that effect,
  - (vii) where color is claimed as a distinctive feature of the mark in the basic application or basic registration, or where the applicant wishes to claim color as a distinctive feature of the mark and the mark contained in the basic application or basic registration is in color, an indication that color is claimed and an indication by words of the color or combination of colors claimed and, where the reproduction furnished under item (v) is in black and white, one reproduction of the mark in color,
  - (vii**bis**) where the mark that is the subject of the basic application or the basic registration consists of a color or a combination of colors as such, an indication to that effect,
  - (viii) where the basic application or the basic registration relates to a three-dimensional mark, the indication “three-dimensional mark,”
  - (ix) where the basic application or the basic registration relates to a sound mark, the indication “sound mark,”
  - (x) where the basic application or the basic registration relates to a collective mark or a certification mark or a guarantee mark, an indication to that effect,
  - (xi) where the basic application or the basic registration contains a description of the mark by words and ~~the applicant wishes to include the description or~~ the Office of origin requires the inclusion of the description, that same description; where the said description is in a language other than the language of the international application, it shall be given in the language of the international application,

(xii) where the mark consists of or contains matter in characters other than Latin characters or numbers expressed in numerals other than Arabic or Roman numerals, a transliteration of that matter in Latin characters and Arabic numerals; the transliteration into Latin characters shall follow the phonetics of the language of the international application,

(xiii) the names of the goods and services for which the international registration of the mark is sought, grouped in the appropriate classes of the International Classification of Goods and Services, each group preceded by the number of the class and presented in the order of the classes of that Classification; the goods and services shall be indicated in precise terms, preferably using the words appearing in the Alphabetical List of the said Classification; the international application may contain limitations of the list of goods and services in respect of one or more designated Contracting Parties; the limitation in respect of each Contracting Party may be different,

(xiv) the amount of the fees being paid and the method of payment, or instructions to debit the required amount of fees to an account opened with the International Bureau, and the identification of the party effecting the payment or giving the instructions, and

(xv) the designated Contracting Parties.

(b) The international application may also contain,

(i) where the applicant is a natural person, an indication of the State of which the applicant is a national;

(ii) where the applicant is a legal entity, indications concerning the legal nature of that legal entity and the State, and, where applicable, the territorial unit within that State, under the law of which the said legal entity has been organized;

(iii) where the mark consists of or contains a word or words that can be translated, a translation of that word or those words into English, French and Spanish, or in any one or two of those languages;

(iv) where the applicant claims color as a distinctive feature of the mark, an indication by words, in respect of each color, of the principal parts of the mark which are in that color;

(v) where the applicant wishes to disclaim protection for any element of the mark, an indication of that fact and of the element or elements for which protection is disclaimed;

(vi) any description of the mark by words or, if the applicant so wishes, the description of the mark by words contained in the basic application or the basic registration, where it has not been provided under paragraph (4)(a)(xi).

(5) *[Additional Contents of an International Application]* (a)

[...]

(d) The international application shall contain a declaration by the Office of origin certifying

[...]

(iii) that any indication referred to in paragraph (4)(a)(vii*bis*) to (xi) and appearing in the international application appears also in the basic application or the basic registration, as the case may be,

[...]

[...]

## Chapter 5 Subsequent Designations; Changes

### Rule 24

#### *Designation Subsequent to the International Registration*

[...]

(5) *[Irregularities]* (a) If the subsequent designation does not comply with the applicable requirements, and subject to paragraph (10), the International Bureau shall notify that fact to the holder and, if the subsequent designation was presented by an Office, that Office. Where the subsequent designation is for only part of the goods and services listed in the international registration concerned, Rules 12 and 13 shall apply, *mutatis mutandis*, with the exception that all communications regarding any irregularity to be remedied under these Rules shall be between the holder and the International Bureau. Where the International Bureau cannot satisfy itself that all the goods and services listed in the subsequent designation can be grouped in the classes of the International Classification of Goods and Services listed in the international registration concerned, the International Bureau shall raise an irregularity.

(b) If the irregularity is not remedied within three months from the date of the notification of the irregularity by the International Bureau, the subsequent designation shall be considered abandoned, and the International Bureau shall notify accordingly and at the same time the holder and, if the subsequent designation was presented by an Office, that Office, and refund any fees paid, after deduction of an amount corresponding to one-half of the basic fee referred to in item 5.1 of the Schedule of Fees, to the party having paid those fees.

(c) Notwithstanding subparagraphs (a) and (b), where the requirements of paragraphs (1)(b) or (c) or (3)(b)(i) are not complied with in respect of one or more of the designated Contracting Parties, the subsequent designation shall be deemed not to contain the designation of those Contracting Parties, and any complementary or individual fees already paid in respect of those Contracting Parties shall be reimbursed. Where the requirements of paragraphs (1)(b) or (c) or (3)(b)(i) are complied with in respect of none of the designated Contracting Parties, subparagraph (b) shall apply.

(d) Notwithstanding subparagraph (b), where an irregularity under the last sentence of subparagraph (a) is not remedied, the subsequent designation shall be deemed not to contain the goods and services concerned.

[...]

## Chapter 8 Fees

[...]

### *Rule 36 Exemption From Fees*

Recording of the following shall be exempt from fees:

- (i) the appointment of a representative, any change concerning a representative and the cancellation of the recording of a representative,
- (ii) any change concerning the telephone and telefacsimile numbers, [address for correspondence, electronic mail address and any other means of communication](#) of [with the applicant or](#) holder, [as specified in the Administrative Instructions](#),
- (iii) the cancellation of the international registration,
- (iv) any renunciation under Rule 25(1)(a)(iii),
- (v) any limitation effected in the international application itself under Rule 9(4)(a)(xiii) or in a subsequent designation under Rule 24(3)(a)(iv),
- (vi) any request by an Office under Article 6(4), first sentence, of the Agreement or Article 6(4), first sentence, of the Protocol,
- (vii) the existence of a judicial proceeding or of a final decision affecting the basic application, or the registration resulting therefrom, or the basic registration,
- (viii) any refusal under Rule 17, Rule 24(9) or Rule 28(3), any statement under Rules 18*bis* or 18*ter* or any declaration under Rule 20*bis*(5) or Rule 27(4) or (5),
- (ix) the invalidation of the international registration,
- (x) information communicated under Rule 20,
- (xi) any notification under Rule 21 or Rule 23,
- (xii) any correction in the International Register.

[Annex II follows]



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MM/LD/WG/12/INF/1  
ORIGINAL : FRANÇAIS / ENGLISH  
DATE : 24 OCTOBRE 2014 / OCTOBER 24, 2014

## **Groupe de travail sur le développement juridique du système de Madrid concernant l'enregistrement international des marques**

**Douzième session  
Genève, 20 – 24 octobre 2014**

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

**Twelfth Session  
Geneva, October 20 to 24, 2014**

**DEUXIÈME LISTE PROVISOIRE DES PARTICIPANTS  
SECOND PROVISIONAL LIST OF PARTICIPANTS**

*établie par le Secrétariat  
prepared by the Secretariat*

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