

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

**Thirteenth Session
Geneva, November 2 to 6, 2015**

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”) met in Geneva from November 2 to 6, 2015.
2. The following Contracting Parties of the Madrid Union were represented at the session: African Intellectual Property Organization (OAPI), Algeria, Antigua and Barbuda, Australia, Austria, Belarus, Cambodia, China, Colombia, Cuba, Czech Republic, Denmark, Egypt, Estonia, European Union (EU), Finland, France, Georgia, Germany, Ghana, Greece, Hungary, India, Israel, Italy, Japan, Kenya, Latvia, Lithuania, Madagascar, Mexico, Montenegro, Morocco, New Zealand, Norway, Oman, Philippines, Poland, Portugal, Republic of Korea, Republic of Moldova, Russian Federation, Sao Tome and Principe, Singapore, Spain, Sweden, Switzerland, Tunisia, Turkey, Ukraine, United Kingdom, United States of America, Viet Nam, Zimbabwe (54).
3. The following States were represented as observers: Canada, Lao People's Democratic Republic, Libya, Nepal, Saint Kitts and Nevis, Senegal, Thailand, Trinidad and Tobago (8).
4. Representatives of the following international intergovernmental organizations took part in the session in an observer capacity: Benelux Office for Intellectual Property (BOIP), World Trade Organization (WTO) (2).

5. Representatives of the following international non-governmental organizations took part in the session in an observer capacity: *Association française des praticiens du droit des marques et des modèles* (APRAM), *Association romande de propriété intellectuelle* (AROPI), Centre for International Intellectual Property Studies (CEIPI), European Brands Association (AIM), European Communities Trade Mark Association (ECTA), International Association for the Protection of Intellectual Property (AIPPI), International Trademark Association (INTA), Japan Intellectual Property Association (JIPA), Japan Patent Attorneys Association (JPAA), Japan Trademark Association (JTA), MARQUES (Association of European Trade Mark Owners) (11).
6. The list of participants is contained in Annex II to this document.

AGENDA ITEM 1: OPENING OF THE SESSION

7. The Director General of the World Intellectual Property Organization (WIPO), Mr. Francis Gurry, 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 undergoing significant change and the Working Group was responsible for harnessing such change. Since the previous meeting of the Working Group, four new members had joined the Madrid System and one existing member had acceded to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as “the Protocol”). The four new members were the African Intellectual Property Organization, Cambodia, Gambia and Zimbabwe. With Algeria acceding to the Madrid Protocol, the Madrid System had now become a single treaty system, with 96 members covering 112 countries. The expansion of the system was expected to continue during the coming months and years. In particular, a number of members of the Association of South East Asian Nations (ASEAN) were close to accession, such as Brunei Darussalam, Indonesia, the Lao People’s Democratic Republic, Malaysia and Thailand. Developments were also expected from Canada, Jamaica, Malawi, South Africa and Trinidad and Tobago. Consequently, the geographical coverage of the system would be extremely good in Africa, Asia, Europe and North America. Latin America and the Gulf countries would be a focus for further work in the coming two years.
9. As far as use of the Madrid System was concerned, the Director General said that there had been a relatively modest growth when compared with the Patent Cooperation Treaty (PCT). In 2014, growth was at 2.3%, with almost 48,000 international applications filed. The two factors explaining the modest growth were the continued fragility of the world economy as well as the rise in value of the Swiss franc, which made Madrid applications more expensive. A change in filing patterns could be perceived because of the new composition of the Madrid System: for the first time, the United States of America had become the largest filer, replacing Germany. The United States of America was followed by Germany and France, who had been very significant filers over the years. Where countries of origin were considered, Australia had recorded an increase in use of around 23%, the Republic of Korea 35%, the United Kingdom 19%, whereas several large countries had seen a decline in use, notably China (5.5%), France (almost 10%) and Germany (4.8%). As far as designations were concerned, the Director General stated that China remained the most designated Contracting Party, followed by the European Union and the United States of America. The Madrid System had become a very comprehensive system and by the end of 2014, almost 600,000 international registrations were in force, representing about 5.6 million active designations and 198,000 trademark holders.
10. The Director General said that during nearly the last two years the International Bureau had focused on a reform program covering customer service, workload, resource planning, staff training, quality of transactions and efficiency. One of the visible deliverables had been a drop in pendency rates across all transactions in the Madrid System. A dashboard, tracking pendency rates, was now available on the website. The electronic environment for use of the Madrid System, both by Offices and users, continued to evolve. The new information technology (IT) platform, the Madrid International Registration Information System (MIRIS),

was planned for deployment before the end of 2015. The digital services of E-Madrid continued to evolve with a rising number of user accounts, almost 2,000. The focus would be on increasingly integrating the services with a single point of entry.

11. The Director General thanked the Offices for their cooperation in relation to electronic communications, as 52% of international applications were transmitted to the International Bureau electronically from 25 member States. There had been an increased use of electronic communication for the transmission of refusals, statements of grant of protection and modifications and, by the end of 2014, about 71% of the total of documents received by the International Bureau were transmitted electronically thus increasing productivity across the Madrid System.

12. The Director General stated that the Working Group had to deal with a number of specific proposals which demanded its immediate attention, such as division of international registrations, yet, the Working Group needed to reflect especially on the larger item of significant change in the composition of the Madrid System, its geographical reach and the electronic environment in which it operated. The Madrid System and its original treaty were more than 100 years old. Most member States were reluctant to contemplate treaty revision, so the Working Group had to work within the confines of 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") to deliver results for the continued evolution of the Madrid System, including new features. The Working Group was thus the think tank for the adaptation and evolution of the Madrid System.

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

13. Mr. Mikael Francke Ravn (Denmark) was unanimously elected as Chair of the Working Group, Ms. Mathilde Manitra Soa Raharinony (Madagascar) and Mr. Eliseo Montiel Cuevas (Mexico) were unanimously elected as Vice-Chairs.

14. Ms. Debbie Roenning acted as Secretary to the Working Group.

AGENDA ITEM 3: ADOPTION OF THE AGENDA

15. The Working Group adopted the draft agenda (document MM/LD/WG/13/1 Prov.), without modification.

16. The Chair opened the floor for opening statements by delegations.

17. The Delegation of the Republic of Korea stated that there had been many efforts to improve convenience for users of the Madrid System and encourage its use. The adopted agenda would contribute to improve the Madrid System, as it included issues such as the dependency clause, the division and merger of international registrations, etc. In particular, when it came to the introduction of division and merger, members expected different views on these issues, but considerable progress had been made in building consensus on the approach based on the proposal made by Switzerland at the twelfth session of the Working Group. The International Bureau had presented a concrete proposal based on all the input collected from member States through multiple Working Group meetings and hopefully agreement could be reached on those issues in the Working Group.

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

18. The Secretariat introduced document MM/LD/WG/13/2 and the proposals to change the Common Regulations, the Administrative Instructions and the Schedule of Fees. The proposals should be seen as part of the ongoing exercise to make the Madrid System more user friendly

and attractive to its users. Some of the proposals were also direct results of requests made by users and Offices, such as the proposal to introduce the possibility to record a change to the legal nature and state of organization of the holder, as well as the proposed revision of Rule 21 concerning replacement. Other proposals were following up on discussions from the last Working Group meeting, in particular those concerning limitations presented in international applications and requests for recording of a limitation in an international registration.

19. The Secretariat then explained that the proposed amendment to Rule 12 was following up on the previous discussions of the Working Group meeting on limitations. The purpose of the proposal was to clarify Rule 12, increasing consistency and predictability of the outcome of the examination of limitations in international applications undertaken by the International Bureau. The International Bureau controlled the classification of indications set out in limitations in the same manner as it controlled the classification of the main list in the international application. The International Bureau should not examine the indications or terms to determine if they were in fact considered to be a limitation or rather an expansion of the main list. Such determination fell entirely under the competency of the Offices of the designated Contracting Parties. Under proposed new paragraph (8) of Rule 12, the International Bureau would raise an irregularity if it considered that all the goods and services listed in a limitation could not be grouped in the classes contained in the main list of the international application. Paragraphs (1)(a) and paragraphs (2) till (6) would apply *mutatis mutandis*. If the irregularity was not remedied within the given time limit, the limitation would be deemed not to contain the goods and services mentioned in the irregularity. The proposed amendment would clarify the current examination practice.

20. The Secretariat explained that it was possible for holders to request the recording of a limitation in an international registration by submitting form MM6 under Rule 25. These limitations were different in nature from those limitations included in an international application or in a subsequent designation. Holders taking advantage of the possibility to record a limitation under Rule 25, regularly did so to satisfy a time sensitive need, such as to overcome a provisional refusal, to avoid possible third party actions, or to limit the scope of protection before the renewal of an international registration. Where the request to record a limitation under Rule 25 was a direct result of a provisional refusal, the Office would in most cases also inform the holder of which goods and services could be protected. The holder would then be able to request that proposed wording to be recorded as a limitation.

21. The Secretariat indicated that, if the International Bureau should exercise full control of the classification of the indications set out in the request, it might interfere with a wording agreed between the holder and the Office or a third party, or with a wording that might be acceptable to the Offices where the limitation was to have effect, resulting in a delay in the processing. The examination by the International Bureau of such requests should be limited to ensure that all formalities were met, without adding unnecessary complexities or delay in the processing. It was thus proposed to further clarify, in an amendment to Rule 26, that the formal examination undertaken by the International Bureau of requests for the recording of a limitation under Rule 25 should be limited to verifying the correspondence between the class numbers indicated in the limitation and those contained in the international registration concerned. This proposal would increase the consistency and predictability of the outcome of the examination of these requests. In other words, the International Bureau should not apply provisions of Rules 12 and 13, and there would be no examination on whether the indications or terms in the limitation were placed in the correct class. On the proposed paragraph (1) of Rule 26, where the class numbers indicated in a request for the recording of a limitation would not correspond to those contained in the main list of the international registration, the International Bureau would notify that fact to the holder and if the request was made by an Office to that Office. Should the International Bureau raise such an irregularity the holder would be given a time limit of three months to remedy it. Otherwise, in accordance with paragraph (2), the request would be considered abandoned.

22. The Delegation of the Republic of Korea supported the amendment on the grounds that it would improve convenience for applicants and promote use of the Madrid System. The amendment captured the applicant's view and enhanced the predictability and the consistency of the result of examination.

23. The Delegation of Japan also supported the proposal. The review of both rules clarified the scope and mandate of the International Bureau concerning limitations requested in forms MM2 and MM6. In addition, it improved the clarity of the International Bureau's examination and enhanced predictability for Madrid users. The Delegation further stated that it hoped that the International Bureau would utilize MIRIS, the Madrid International Registration Information System, which was currently in development, and the enhanced human resources, to further advance the examination undertaken by the International Bureau and better administer classification.

24. The Delegation of Germany stated that, in paragraph 25 of the document, the International Bureau indicated that it needed at least four qualified new examiners. When starting the discussion on limitations, the International Bureau said that it followed an inconsistent practice because some examiners examined whether a limitation was actually a limitation or an extension, whereas others did not examine anything, and thus the rules were intended to create a consistent practice. The Delegation did not understand why new staff should be needed and asked whether a real additional workload existed and also asked whether, under Rule 26, the International Bureau would also examine if the indications of goods and services were too vague.

25. The Delegation of the European Union said that the European Union and its member states wished to reiterate their strong support for further development of the Madrid System to make it simpler, more efficient, reliable, flexible, user friendly, as well as time and cost effective, where appropriate.

26. The Delegation of Switzerland stated that it believed that, to have a limitation in an international registration, the International Bureau, or the Office of origin, when the limitation was included in an international application, should examine to ensure that it truly was a limitation, and that this should be done systematically. However, having realized that this was not the case, the Delegation considered that it was necessary to clarify the issue to determine where the examination would be done, as this affected the extent of protection. Limitations in the international application should be considered first, then limitations under Rule 25. With regard to the international registration, as a designated Office, the Office of Switzerland would regularly receive international registrations where the list had been limited for Switzerland. The reasons for the limitations could be varied; the holder could think that there would be a refusal from Switzerland and therefore tried to ensure that the mark would be acceptable and so would limit protection in Switzerland. This limited list needed to be examined by the Office, but the Office of Switzerland, as a designated Office, did not verify that the international registration was covered by the main list, when protection was not requested for the main list. The examination of the extent of the limitation should be done either by the International Bureau or by the Office of origin. Concerning Rule 12, one of the main elements the Working Group needed to agree upon was who should be carrying out that examination: the designated Office, the Office of origin or the International Bureau.

27. The Delegation of Italy declared that it was in favor of the amendments to Rule 12, but would like to know whether the work of the four new qualified examiners would only consist in the verification of the correspondence between the class numbers indicated in the limitation and those contained in the international registration concerned, or whether they would also examine the correctness of the classification items indicated in the limitation. Furthermore, there would be a fee requested for that work and the Delegation would like to receive more information in that respect.

28. The Representative of INTA stated that, in general, INTA supported the proposed amendments. The Representative supported fully the intervention by the Delegation of Switzerland to the extent that it concerned paragraph 12 of the document. The examination of the limitations contained in an international application fell under the responsibility of the Contracting Party of origin, not of the designated Contracting Parties as stated in paragraph 12. Furthermore, only the Contracting Party of origin was in a position to certify that the main list and the limited list fell within the scope of the basic mark, i.e. of the list contained in the basic application or basic registration. Thus, it was very important to establish the principle that the responsibility of the examination, as to a possible extensiveness or broadening of the limitation which was contained in an international application, belonged to the Office of origin. The designated Contracting Parties should rely on the country of origin for that purpose.

29. The Representative of INTA recognized, on the other hand, that the International Bureau was not in a position to control the possible extensiveness of limitations in subsequent designations and that it was accepted that such control should belong to the designated Contracting Parties. For limitations under Rule 25, the International Bureau was neither in a position to examine the scope of protection in the limitation. This should better be left to the designated Contracting Parties concerned, restricting the examination by the International Bureau to checking that the class numbers indicated in the limitation did not go beyond those in the main list.

30. The Delegation of Japan supported the proposal made by the International Bureau with regard to the revision of Rules 12 and 26, as it clarified the mandate and the responsibility of the International Bureau. Furthermore, the Delegation of Japan referred to document MM/LD/WG/12/7, paragraph 123, and asked about the result of the study the International Bureau should have undertaken.

31. The Representative of CEIPI indicated it had some editorial remarks concerning the draft, basically concerning Rule 26, to be discussed once the suggestions of the Representative of INTA would have been considered.

32. The Secretariat clarified that, regarding the questions on the four extra examiners, they were meant for limitations in subsequent designations, to undertake examination of those limitations under Rules 12 and 13.

33. Concerning the question by the Delegation of Germany on Rule 26, whether the International Bureau would also examine the limitation to see whether an indication or term was considered too vague, this would not be the case. The International Bureau would only check the corresponding class numbers, not the indications themselves. With respect to the questions from the Delegation of Italy regarding the implementation issues and the examiners, these would be addressed by the Secretariat at a later moment. In relation to the proposed amendment to Rule 26, the question whether the International Bureau would just check class numbers or also would examine for the purposes of Rules 12 and 13, the Secretariat clarified that the examiners would only check the corresponding class numbers of the main list, and that no examination under Rules 12 or 13 would be undertaken. No additional fee increase was proposed for that issue on limitations. To reply to the question by the Delegation of Japan referring to a discussion in the last Working Group meeting, whether the International Bureau for a future session could prepare a study on the scope and responsibility between the interested party, the International Bureau and the Office of origin and the designated Offices, the Secretariat explained that this was on the list of future topics. The proposed amendments of Rules 12, 24 and 26 were part of the clarification of the roles and responsibilities of the parties involved. The Secretariat remarked that, regarding the role of the Office of origin on limitations presented in international applications, according to Rule 9(5)(d) of the Common Regulations, the certification process by the Office of origin did not include limitations among the indications listed for the Office to certify. If so needed, for the sake of clarity, the provision would have to be amended.

34. The Delegation of Colombia stated that it agreed with the proposed modification and considered it necessary since it guaranteed that the International Register would contain clear and accurate information on products and services. It was necessary to have a form for these purposes, including clear instructions, and a box where it would be possible to write down exactly how the limitation would take place for each of the countries, and to do the same in the rules as well. The Delegation considered it very important, when adopting the change, to define what the scope of the limitations were, since in its view that issue corresponded to the country of origin.

35. The Delegation of France expressed its support for the Delegation of Switzerland, since it had the same practice as the Office of Switzerland for examination as a designated Office. Its examination was limited to the products and services and would not include an extension of the wording in connection with the international registration. Consequently, studying the scope of limitations in international registrations should correspond to the International Bureau and not the countries of origin.

36. The Delegation of Germany asked whether, under Rule 12, where limitations in international applications were concerned, the International Bureau would only check if there was a new, additional class number compared to the original list of goods and services, thus excluding whether it actually was a limitation or an extension and also excluding examination of whether the indications were too vague. The same applied, under Rule 25, yet it could not remember that such approach had ever been discussed; rather, another way had been considered for Rule 24, paragraph (5). Germany, as country of origin, did not examine for this. When acting as a designated country, Germany had always thought that the examination was undertaken by the International Bureau and the Office would need to change its practice if it should have to check whether there really was a limitation and not an expansion of the list of goods and services.

37. The Secretariat explained that, regarding limitations presented in an international application, the International Bureau would check limitations in line with Rules 12 and 13, to ascertain if the indications in the limitations were placed in the correct class, and also whether they were specific enough and not too vague. Limitations presented in international applications would be handled in the same way as for the main list of the international application, but there would be no examination to see whether an indication went beyond what was in the main list. So, no examination on the scope of the limitation would be undertaken. For limitations presented in form MM6 and to be recorded under Rule 25, the proposed amendment was only to check if the limitation had the same class numbers as any of those mentioned in the main list; only the correspondence of class numbers would be considered. There would be no examination of the indications in the limitation under Rules 12 or 13 and no examination of scope.

38. The Representative of INTA stated that the crux of the matter was who should examine what. Reference had been made by the Secretariat to Rule 9(5)(d) of the Common Regulations, which established that the Office of origin should certify that the goods and services indicated in the international application were covered by the list of goods and services appearing in the basic application or basic registration, as the case might be. Its reading of that provision was that it did not apply only to the main list, but also to the limited lists contained in the international application. Thus, certifying that all the goods and services contained in the international application were also contained in the basic application or basic registration, implied that the Office of origin should control that there was no extension of the list of goods and services in the limitation as compared to the main list. It was very important to agree on that, and if it was not clear enough, perhaps that particular provision could be specified in more detail. When the Madrid System was based only on the Madrid Agreement Concerning the International Registration of Marks, the subsequent designations had to be filed through the Office of origin, and one could expect that the Office of origin, when forwarding the subsequent designation, controlled that there was no extension in the limited lists. Nowadays, it was no longer the case because, with the Protocol, most, if not all, designations would be governed by

the Protocol, and there was no necessity to go through the Office of origin. You could go through the Office of origin and the Office of origin could exercise a control, but that was not, the Delegation understood, the usual practice; rather, the practice was that the subsequent designation went direct from the holder of the international registration to the International Bureau. The Representative wondered who should check for a possible broadening of the scope of protection in a limitation. Obviously, the International Bureau was not in a position to do so, therefore the only party that could do it was the Office of the designated Contracting Party, as far as it was concerned. The same went for limitations under Rule 25, though for limitations in subsequent designations there was no provision to the effect that, when receiving notification of a limitation, a designated Contracting Party could refuse the limitation because it broadened the scope of protection of the international registration. The system could be considered to be balanced, provided that an understanding among the Contracting Parties existed that, as far as the international application was concerned, the certification by the Office of origin applied not only to the main list, but also to the possible limited lists in the international application.

39. The Chair concluded that, in his view, there was an agreement of principle on having the changes as outlined in the document for Rules 12 and Rule 26, though there were some issues related to the proposals that needed to be discussed, in particular, in relation to subsequent designations. The Working Group could thus move on to discuss the wording of those particular rules as drafted in the document.

40. The Delegation of Switzerland stated that it was not in favor of postponing the problem. A practical problem existed since there were limitations in the International Register that were not being examined by the Office of origin, by the International Bureau or by the designated Office. Postponing the discussion meant that you could wait one, two or three years to agree on these limitations, which could be extensive and inscribed in the International Register. The Delegation declared that it was not in favor of the proposed procedure and did want to insist on the three types of limitations. As an Office of origin, they examined the extent of protection. Sometimes, it had problems with holders, because they would not understand why that examination was undertaken; the holders wanted a specific limitation for a country with the practice of examination in that country and they expected it to be sent directly to the International Bureau, without the Office of Switzerland dealing with it. Other times, holders did not realize that they were actually extending the protection, but the Office of Switzerland could not allow extensions and considered its duty, as the Office of origin, to look at the extent of the limitation. Under Rule 25, when there were changes after registration, as a designated Office, the Office of Switzerland was interested in examining them. If an extended limitation was accepted, it amounted to providing a new right to an existing registration, which would be a legal problem, as a pre-established right existed. So, under Rule 27, the Office would have to limit those extensions. The provision was not well drafted from the viewpoint of a designated Office, so the Delegation would not be in agreement with it. With regard to limitations in subsequent designations, where such designations came through the Office of Switzerland, it examined them and looked at the extent of the limitation. The problem was that for the subsequent designation notified to the Office of Switzerland, as a designated Office, the Office of Switzerland could only consider the text of the limitation as it viewed that the main list was not something concerning them. The Delegation could not see on which legal basis it could refuse.

41. The Delegation of Germany agreed, in principle, with proposed Rule 12, but as far as proposed Rule 26 was concerned, it failed to understand why examination should be limited to determine whether or not an additional class was included. The approach under Rule 12 should also be followed here; at least, checking whether an indication of a good or service was too vague and whether the classification was correct, since the International Bureau had the required expertise to do so. Furthermore, while the Office of Germany, as a designated Office, did examine limitations to determine whether or not they implied extensions, the International Bureau should at least examine whether the classification and the indications were correct.

42. The Secretariat explained that limitations under Rule 25 were specifically crafted with certain designated Contracting Parties in mind, and it believed that the International Bureau was not in a position to second guess what would be useful in respect of those designated Contracting Parties. Furthermore, if the International Bureau were obliged to review limitations under Rules 12 and 13, it would get into a situation where it might either accept or not accept them, at the risk that the concerned designated Contracting Parties would contradict the International Bureau, since the limitations had been crafted with those designated Contracting Parties in mind. In its view, the International Bureau should not apply Rules 12 and 13 in respect of Rule 25, as it would be counterproductive for the smooth functioning of the system.

43. The Delegation of India stated that it was very much in favor of the spirit of the proposal, but had apprehensions; namely, whether it would be possible to divide an international registration already containing a limitation of the goods and services of the country concerned and what would be the procedure and consequences where an application for division was filed concerning an international registration where protection had already been obtained.

44. The Representative of INTA suggested inserting in Rule 12(8*bis*), fourth line, where it read “The classes of the international classification of goods and services listed in the international application concerned”, after “concerned”, the words “as amended pursuant to paragraphs (1) to (6) as the case may be.” The provision would then continue “[...] the International Bureau shall issue an irregularity.” The rationale for the suggestion was that, when it came to examining the classification of the limitation, the pertinent comparator would be the classification of the main list as it might have been amended, and not necessarily the classification as indicated in the international application as received by the International Bureau.

45. The Chair said the proposal made by the Representative of INTA was already implied, but making it explicit in the rule was convenient. The Chair then moved on to proposed Rule 26, where the proposal was to insert the words “where the request was for the recording of a limitation, and where the number of the classes indicated in the limitation do not correspond to those contained in the international registration concerned, and [...]”

46. The Delegation of INTA considered that it would be clearer, and certainly simpler, not to include in Rule 26 a specific requirement regarding the limitations, but rather to insert that requirement in Rule 25. The possible place for that would be a new subparagraph (d) of paragraph (2) of Rule 25, which would read as follows: “The request for the recording of a limitation of the list of goods and services may only contain the indication of classes of the international classification of goods and services included in the international registration concerned.” Rule 26 would then stand as it currently was, and if new subparagraph (d) was not complied with, it would fall under Rule 26 as an irregularity of the request for the change.

47. The Delegation of Switzerland informed that it needed more time to consider the proposal and its implications as it had trouble analyzing the proposal, especially, following the interpretation into French.

48. The Delegation of Antigua and Barbuda asked the Representative of INTA whether there was any significance in the use of the terms “may only” as opposed to “shall”.

49. The Representative of INTA deferred to all delegations of English mother tongue, but believed that, insofar as “may” was qualified by “only”, it should be equivalent to “shall”.

50. The Delegation of Antigua and Barbuda confirmed that, in its understanding “may only contain” clearly indicated that it should not contain anything else.

51. The Secretariat introduced document MM/LD/WG/13/8 entitled “Amended Rule 24(5) of the Common Regulations under the Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement: Implementation Issues”. The Secretariat explained that the document concerned a recommendation made to the Assembly of the Madrid Union by the Working Group, at its twelfth session, held in October 2014. The Working Group

recommended that the International Bureau apply Rules 12 and 13 to limitations contained in subsequent designations. The Assembly of the Madrid Union, at its forty-ninth (21st ordinary) session, held in October 2015, adopted the recommendation with an entry into force date of November 1, 2017. Unfortunately, in the course of preparing for the implementation of the amendments, the International Bureau had encountered two major stumbling blocks. First, the need to examine under Rules 12 and 13 using older versions of the International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Classification), which practically speaking, the International Bureau would find challenging to perform reliably and consistently. Secondly, even if the previous problem did not exist, additional resources, higher than originally anticipated, would be required to perform the work in light of the constantly increasing volumes of limitations, with reference to the four extra examiners already discussed. These issues were so challenging that the Secretariat felt that the most appropriate course of action was to bring them to the attention of the Working Group in a transparent manner, so that they could be openly discussed. Following its consideration of the matter, the Working Group could issue a new recommendation to the Assembly of the Madrid Union, to be held in 2016, appropriately adjusting the concerned amendment to the Common Regulations, due to enter into force in November 2017. The Secretariat regretted that those issues had not surfaced earlier, namely at the time the amendment was initially proposed to the Working Group, and, of course, took full responsibility in that regard. The Secretariat explained that the Madrid Registry receives lists of goods and services containing limitations in three different ways:

(i) in international applications, where the applicant could limit the list for some of the designated Contracting Parties; here there would be full examination according to Rules 12 and 13;

(ii) the holder could request the recording of a limitation under Rule 25, which is frequently used by holders to respond to provisional refusals. The proposal for the examination of this limitation was that the International Bureau would only check that the class numbers would correspond, between the international registration and the limitation itself; (iii) finally, the holder could present a limitation in a subsequent designation, for which purpose paragraph (5) of Rule 24 had been amended. A limitation in a subsequent designation could be for all or for some designated Contracting Parties, and the holder could delete terms or classes or also add new terms, keeping within the scope of the main list of the international registration. Since the main lists in international registrations were not reclassified upon renewal, the subsequent designations, following the classification of the international registration, could contain goods or services in a class that has been officially changed according to the current edition or version of the Nice Classification. The implementation of the full examination of those limitations was a cause for concern. The Secretariat informed that 10% of all international applications contained limitations; and, 20% of requests for subsequent designations contained limitations.

An additional point was that the average length of the lists of goods and services was increasing, with the average length in 2014 being more than 200 words. Concerning the irregularity rates for classification issues, in 2015, from January to the end of August, 35% of all applications were irregular; where 38% of those irregularities were related to Rule 13; 7% were related to Rule 12; and, 27% had multiple errors. The number of irregularities under Rule 13 was unfortunately increasing. To address the request made by several delegations for information about the additional four examiners, the Secretariat explained that currently the International Bureau could process 900 applications weekly, supported by the database of the International Bureau and the guidelines based on the current version of the Nice Classification. Added examination work would be the examination of limitations in subsequent designations, according to Rules 12 and 13, and based on figures for 2014 that would mean 3,200 extra files. The Secretariat said that if the same irregularity rates were expected for the goods and services in the limitations, at least an additional 20% could be anticipated, reaching 640 extra files. In the same year, 4,300 international applications contained one or more limitations. Thus, the extra lists of goods and services that the International Bureau would examine for international applications would be no less than 4,300, not taking into account the expected increase in the length of the lists or the filing increase. Based on those figures, the Secretariat estimated it would need a minimum of four new examiners. The Secretariat said it had not been able to calculate the increased complexity or how this would affect the work, if classification should be based on different versions of the Nice Classification. The Secretariat clarified that classification was always based on the practices of the International Bureau, not practices of designated

Contracting Parties, and it would not be possible for the International Bureau to take into account the different classification practices of all the Contracting Parties. In summarizing, the Secretariat referred to the three main issues: the first issue concerned the scope of limitations and who had the responsibility to examine the scope of those; the second issue was how to deal with older versions of the Nice Classification, where it would welcome any suggestions on how this could be managed; and, the third issue was the need for extra examiners, which would be possible provided the Organization made the necessary resources available.

52. The Delegation of Switzerland said that Switzerland had a pragmatic approach on how to deal with older versions of the Nice Classification. The International Bureau should verify whether the limitations were part of the main list and apply the most recent version of the Nice Classification to classify the limitation correctly. There would be a bit of a mix, between the international registration with an older version of the classification and the application of the new one for the limitation, but with such practical approach holders and designated Offices would no longer be misled. Furthermore, it had discussed the additional four examiners at a higher level in the Office, concluding that maybe it could support the allocation of additional resources.

53. The Delegation of the United States of America said it would prefer that limitations were not examined at all by the International Bureau, as it believed that it was for the Contracting Parties to undertake that task. However, it would support the idea of the International Bureau verifying that the classes in the subsequent designation corresponded with those in the main list.

54. The Delegation of China considered that, even though it would increase the workload of the International Bureau, it should examine the limitation contained in subsequent designations, and it suggested that the revised rule be implemented.

55. The Delegation of the Czech Republic supported the proposed amendments to Rules 12 and 25, as requests for limitations and for subsequent designation should be examined. As far as the Nice Classification was concerned, the Delegation reminded that if it was necessary to deal with national applications that dated back 10 or 20 years, it would be needed to amend the classification according to the latest version of the Nice Classification. In other words, the Delegation supported the Swiss proposal, if the limitation was registered for a certain date that should correspond to the latest version of the Nice Classification. As to the additional work, the new amendment would also give more work to the Office in terms of controlling goods and services, and also communicating with clients. The Delegation considered that better control over limitations, in the framework of subsequent designations, was a good idea.

56. The Delegation of Germany stated that it had a practical approach like Switzerland. Its Office only examined the limitation with the edition of the Nice Classification which was applicable at that moment, and the rest of the goods and services, even if they were now considered to be in a wrong class, remained in those classes. The Delegation stressed that the provision had been discussed for a long time, that it was a compromise, and that maybe it should be activated to see if it really was such a lot of work. Implementing the provision would reveal whether or not a real need for more examiners existed; otherwise, if no control at all was effected national Offices would have to do it.

57. The Delegation of Australia echoed the sentiment expressed by the Delegation of the United States of America. The Delegation supported discussion of possible solutions to the issues identified in relation to implementation of amendments to Rule 24(5), and it wondered if the approach proposed in the document, in respect of limitations under Rule 25(1), might be helpful in the circumstances. An amendment had been proposed to Rule 26 to make it clear that the International Bureau's examination of limitations under Rule 25(1) was limited to verify that the class numbers matched between the limitation and the international registration. The amendment to Rule 24(5) applied to subsequent designations for only part of the goods and services listed in the international registration, which would have been verified at the time of

registration against the edition of the Nice Classification in force at the time. In relation to subsequent designations under Rule 24, which were for, again, only part of the original list in the international registration, the Delegation considered that it should be straightforward to verify that the class numbers contained in the subsequent designation matched the class numbers of the original list. If the class numbers did not match, the International Bureau would notify the holder. Such a process would reduce the examination and training burden for the International Bureau and limit delays to holders that could arise, should the amendment to Rule 25 be implemented as currently formulated. The designated Contracting Party would then be free to determine, under its own law and practice, whether the expression of indication fell within the scope of the original claim in the international registration. The Delegation considered that there would be possible options for further amendment.

58. The Representative of INTA, representing at the same time APRAM, asked that the International Bureau provide the text of Rule 24(5), as delegations did not have this text as adopted by the Assemblies. The Representative wondered about the consequences of new Rule 24(5) in connection with different requests, made over time, under different editions of the Nice Classification and supported the proposal made by the Delegation of Switzerland as that should reduce a certain amount of uncertainty. To further reduce uncertainty, it would, perhaps, also be a good thing, when publishing the subsequent designation, to point out that this was considered in the light of the latest edition of the Nice Classification, to draw a contrast with the previous original registration.

59. The Secretariat proposed that the Working Group recommend to the Madrid Union Assembly that that implementation of Rule 24(5) be suspended until the International Bureau had confirmed that it had the necessary resources and the Working Group had an agreed position on what precisely the International Bureau would do in respect of Rule 24(5). It further proposed to submit a new document, at the next Working Group, which would be cover all limitations, elaborating on the scope of examination and the role of the International Bureau, the Office of origin and the designated Contracting Parties in respect to limitations. Following the outcome of that discussion, the Secretariat would also prepare another document on Rule 24(5), which would go into more details on the implementation issues; in particular, it would cover whether the International Bureau would have, in the meantime, secured the necessary resources to implement the proposal to apply Rules 12 and 13. Finally, it suggested that the previous two proposals, namely on Rule 12 and Rule 25 went forward, with the proposed entry into force date set out in the document. If the Working Group agreed to already implement those proposals, it would just make explicit what, to a large degree, was already the current practice, and this would help to provide some consistency. The International Bureau would be in a position to implement those two proposed changes on the date foreseen in the document submitted.

60. The Delegation of Switzerland confirmed that it agreed with the proposal made by the Secretariat, namely postponing the discussion or at least putting off the entry into force of Rule 24(5), if it was legally possible. The Delegation said it would be very pleased to receive the document on the extent of the limitation for the next session.

61. The Delegation of China supported the proposal made by the Secretariat. If the necessary conditions were given, feasible implementation would take place. Then the implementation of Rule 24(5) would begin once all its specific conditions had been met.

62. The Secretariat introduced the proposal for Rule 21 on replacement and explained that it was a follow up from the discussion of the previous session, where the Working Group discussed the findings of the questionnaire on replacement. Those findings revealed divergent interpretations, procedures and practices among members concerning replacement. As a result, the Working Group requested that the International Bureau propose amendments to Rule 21 to clarify the aspects of replacement. The proposed amendments were the following: the four key elements of replacement, set out in paragraph 31 of the document, were now included in Rule 21(1). Rule 21 was proposed to explicitly state that, unless a cancellation of

the replaced registration was requested, the earlier national or regional right would co-exist with the international registration. It was proposed that the holder could request the Office of a designated Contracting Party to take note of an international registration, by presenting the request through the International Bureau. It was further proposed that there be an official form for such requests. Paragraph (2) outlined the procedure through the International Bureau, more specifically, that it would record a received request that met the requirements and notify the Contracting Party concerned and the holder. The possible actions available for a Contracting Party being requested to take note were listed in paragraph (3). The issue of whether the Office would examine the request before taking note was left to the national and regional legislation concerned. The Office would eventually need to notify the International Bureau that it had either taken note of the international registration, listing the goods and services concerned, or that it could not take note and state the reason for that decision. The International Bureau would record any notification received from an Office, publish it and send a copy to the holder. There would be no time limit for the Office to send such notification to the International Bureau. Paragraph (4) stated that the effective date of replacement should be the date of the international registration or the subsequent designation concerned. The replacement mechanism was one of the main advantages of the Madrid System, allowing holders to consolidate their portfolio of trademark registrations. It was hoped that the proposed amendments would contribute to a common understanding and a common practice with the result of a more enhanced use of that mechanism.

63. The Delegation of Madagascar supported harmonization in the field of replacement. However, the Delegation stated that Madagascar would still feel free to notify the International Bureau of replacement only after grant of protection. The Delegation accepted the procedure before the International Bureau, even though the Office may have an adequate procedure as well. They were not in favor of a deadline, so that Contracting Parties with stricter systems could continue to operate. Concerning fees, they were of the view that it would be convenient to centralize management in the International Bureau, as well as make the fee structure uniform. Communication between the holder and the Office should be improved, as holders must, at any rate, examine all the different procedures and legal systems of the countries where they were requesting replacement. The Delegation noted that, where the holder asked for replacement, he charged his representative to do so; once the procedure was centralized, holders requesting a replacement would need to be more informed with regard to the procedures in different Offices, as such information affects their own interest.

64. The Delegation of Israel supported the proposal and acknowledged the importance of recording replacement as well as of a centralized approach. The Delegation stated that the International Bureau should also collect fees, to release the holder from direct payment to the Offices.

65. The Delegation of New Zealand supported the proposal, as it provided a simplified mechanism for users to request taking note of replacement and added clarity to the replacement procedure.

66. The Delegation of the United States of America did not support the proposal, as to the effective date of replacement, and referred to paragraph (6), setting the effective date of replacement as the date of the international registration or of the subsequent designation. The practice of the United States of America was that replacement happened as a matter of law, once the extension of protection was granted in the United States of America; the national law did not give legal effect to the international registration itself or to the subsequent designation. Extension of protection was given legal effect after grant only, and the Delegation found it problematic to give legal effect to the international registration for a date that preceded notice in the United States of America. Concerning the fee collection, the Delegation had questions about how the process would work for Offices that collected fees for taking note of replacement. For national Offices collecting fees, every request to take note of replacement would be rejected due to the fee requirement. Furthermore, it was not clear to the Delegation how the communication between the designated Contracting Party, the International Bureau

and the holder would be managed in such situations. For the Delegation, the current practice, whereby the holder communicated with the Office directly, was a more streamlined process, as the Office could request the fee from the holder and process the taking note of replacement. The Delegation said it would support discussion as to how the process could be simplified for those Offices that collected fees for replacement.

67. The Delegation of France informed that its Office did not have any internal regulations on replacement, and had not, so far, had any requests for replacement. The Delegation expressed interest in knowing what “taking note” meant and what type of examination the designated Office had to carry out, before it could authorize replacement.

68. The Delegation of Colombia said that, even though it was being proposed that the holder present the request via the International Bureau and the Delegation considered that this would simplify filing the requests, Colombia also required the payment of a fee for taking note of replacement. The Delegation expected the proposal to also provide for the International Bureau to centrally manage the collection of the fees and considered that difficulties might arise if entry into force of such provision should be delayed. The Delegation had a concern with regard to goods and services; if the scope of rights could be broadened with replacement, then third party rights would be affected.

69. The Delegation of India said it was unable to understand the rationale behind the last paragraph of Rule 21, establishing that the national or regional registration and the replacing international registration should be able to co-exist. The Delegation wondered what replacement should be useful for in such a case.

70. The Delegation of the Republic of Korea supported the proposal, as it would improve the convenience to users by making the International Bureau the entry point, where holders could request replacement in the register of the Office of the designated Contracting Party.

71. The Delegation of Spain supported the changes to Rule 21 on replacement, even though paragraph (5) implied that clarification would be needed for equivalent terms, thus avoiding confusion in the translations of the different goods and services.

72. The Representative of MARQUES supported several elements of the proposal. Replacement was not used enough and many of the elements in the proposal would help to improve the use or the functionality of replacement. Replacement was a way for users to streamline portfolios, and it was being underused. The Representative supported filing requests through the International Bureau, as well as a unified form. Regarding third parties, the proposal should create more transparency, making it visible in the national register that a registration had been replaced by an international registration; likewise, it should be visible in ROMARIN that, in a particular country, the right went back to an earlier date. Renewal of the national registration should remain optional. The Representative expressed the wish that replacement could be requested together with the filing of the actual international application, as well as at any later time. The Representative concurred with the Delegation of Israel on the issue of fees and considered that these needed to be collected by the International Bureau, thus reducing complexity.

73. The Representative of INTA supported in general the proposal of the International Bureau, as it should facilitate things not only for the users, but also for Offices, as well as provide transparency of the International Register for third parties. The Representative concurred with the Representative of MARQUES that it would be an additional facility if the request for the recording of the international registration in the national or regional register could be made with the international application or at the same time as the international application. Rule 21(1)(a)(iii) did not contemplate the case where an international registration might in effect replace several national or regional registrations in the same jurisdiction, in the same designated Contracting Party, which was often the case, and this should be allowed in the request presented through the International Bureau. To achieve this, the Representative

of INTA proposed to insert, in subparagraph (a)(iii), the words “or registrations” in the second line after “of the national or regional registration”. As pointed out by the Representative of CEIPI, it would then also be necessary to add “or have” in subparagraph (a)(iii), which would then read as follows: “The filing date and number, the registration date and number, and if any, the priority date of the national registration or regional registration, or registrations, which has or have been replaced by the international registration.” The Representative expressed doubts concerning paragraph (1)(b), since the current Rule 21 included a provision allowing Offices of the Contracting Parties concerned to provide information on other rights which accrued the national or regional registration in an agreed format, and asked the International Bureau for information on how many such formats had been agreed and with which Offices. The Representative wondered whether that particular provision should be maintained at all, if the holder of the international registration was allowed to provide unspecified information, or claim other rights which had not been confirmed in any way by a national authority.

74. The Chair explained, on the issues of the date of replacement raised by the Delegations of India and the United States of America, that, as far as the requirements in Article 4*bis* of the Protocol were met, replacement was automatic with no notification required.

75. On the issue of fees, the Secretariat clarified that the document did not propose that the International Bureau would require a handling fee as the procedure would be free of charge. The Secretariat was aware that some Offices would require a national fee to take note in their register, and that some Offices did not require such a fee. The Secretariat reminded that the International Bureau collected fees in Swiss francs, not in national currencies, so it would need information on the specific amount of fees, and then it would most likely need to have a mechanism to convert that amount into Swiss Francs. Such a mechanism already existed in the Common Regulations for the purposes of individual fees. Where a declaration for individual fees under Article 8(7) of the Protocol was made, concerned Contracting Parties provided the amount of the fees to the International Bureau in the local currency, to be converted into Swiss francs by the International Bureau. Fluctuations in the official exchange rates, of plus or minus 10% for the duration of three months, were monitored by the International Bureau in seven checkpoints, and were accounted for in the amounts in Swiss francs. The International Bureau was also aware, from discussions in the Working Group and from the questionnaire, that Offices did not receive many requests for taking note of replacement; yet, the first question was whether a mechanism for tracking the fluctuations of the exchange rates for the fees on taking note of replacement should be put in place. The other question was that Offices needed to inform the International Bureau of changes in national amounts. The beginning of the year had seen a rise in the value of the Swiss franc. That rise in value had led to a number of changes for the amounts of individual fees in Swiss francs. As a result of the increase of the value of the Swiss franc, 23 changes of individual fees for Contracting Parties had taken place. The Secretariat explained that a mechanism existed to adjust for changes in the official exchange rates, but it was not a quick mechanism, because it took five to seven months before the new amount was in place. The result of the increase of the value of the Swiss franc was that everything became more expensive for users; many complaints had been made that users found fees to be higher with the increased value in the Swiss franc than before. An option, instead of having individual fees for taking note of replacement, could be a flat fee in Swiss francs for taking note, to be distributed to the Contracting Parties concerned. That would be a fee set in Swiss francs and there would be no mechanism and neither control nor check points of the exchange rate fluctuations. The Secretariat indicated that either individual fees, or a flat fee, might imply changes in national legislations and asked for feedback on how to proceed.

76. The Chair asked the Secretariat to address the question of the Delegation of France on what taking note meant.

77. The Secretariat explained that taking note simply meant making a note in the national register of the international registration; it did not require any examination, nor prohibited it, but taking note, strictly speaking in the sense of Article 4*bis*, simply meant noting the international registration number. The Secretariat further elaborated on the finance implications referring to

the proposal by the Representative of MARQUES, which had been supported by the Representative of INTA, on the possibility to include already in the international application a request to take note of replacement. The Secretariat considered that to be a good idea, although it was too early to be implemented. From the findings of the questionnaire, the Secretariat considered it very important to first reach a common understanding on what replacement meant, developing a common practice and, once those two factors were properly working, it could be a good idea to look into the possibility of applicants being able to request replacement as early as in the international application.

78. The Delegation of Madagascar, indicating that Madagascar asked for the payment of a fee to take note of replacement, expressed agreement to study the possibility of a flat rate harmonizing fees.

79. The Delegation of India asked whether the International Bureau contemplated fees on the basis of classes of goods and services of national registrations to be replaced.

80. The Delegation of the Russian Federation expressed its appreciation that documents were available in all the official languages of the United Nations. The Delegation offered to share the experience of the Russian Office, and went on to state that, maybe, it was a bit early to make a decision on a centralized system, for a variety of reasons. First of all, no decision had been made on the question of fees; the Russian legislation established a fairly limited sum, to be paid upon making the request. Not all requests were accepted; refusals to take note of replacement might be issued. The Delegation informed that the Russian Office only transmitted to the International Bureau positive requests; therefore, exchanges of documents between the Office and the International Bureau only concerned requests that had been accepted. The Office did not communicate the refusals. The fee for placing the centralized request might be higher than what was set at present by the Russian Office.

81. The Delegation of Colombia evoked again the point of listing the goods and services of the international registration, and said that it was not clear how the international registration could have more products than those contained in the national registry; that fact might affect the rights of third parties.

82. The Representative of MARQUES elaborated on the fact that filing a request for replacement together with the actual filing of the international application might assist national Offices in that, when being notified of the designation, they would be able to immediately see that there existed an older right in their own registers. Where fees were concerned, the Representative was in favor of a flat fee, if replacement was filed through the International Bureau, provided the fee was not too high.

83. The Delegation of Switzerland stated that it was in favor of simplifying the system yet, when analyzing the document, it did not have the impression of moving towards something simpler. The replacement procedure in Switzerland was quite simple and direct, since a holder would present a request and the Office would analyze it; if the request was in order, the Office would transmit the notification to the International Bureau; only one exchange with the International Bureau would occur, whereas, in the proposed procedure, the holder would address the request to the International Bureau, who would then record in its register so the Office would have an impression of the validity of the replacement; yet, it would just be an impression because the Office concerned would not yet have examined the request. The Delegation wondered whether such approach was to the benefit of users and the transparency of the system, since the Office would still have to check and see whether replacement could in fact take place. There could be a problem for the Swiss Office, since, if replacement was not applicable, how the Office could contact the holder. The best choice would be to publish that fact in the Federal Gazette, but the Delegation did not think foreign holders would consult the Swiss Federal Registry. The Delegation further said that, whether or not the Office granted the request, it would have to once again send a letter to the International Bureau; there would thus be a period between the first and second notification, which might last months or years

according to procedures. The Delegation said there would be an International Register giving an impression of transparency, which would not correspond to reality. The Delegation concluded that the goal of simplifying the procedure would thus not be achieved.

84. The Chair said that it was quite clear that users wanted a mechanism making replacement easier to use. The Chair then offered information on how replacement was dealt with in Denmark. Upon receipt of a request from a holder to take note of a replacement, the Office would simply examine that request in view of Article 4*bis* to determine if all the requirements were met; Article 4*bis* simply stated, in paragraph (1)(i), that the protection resulting from the international registration extended to the said Contracting Party under Article 3*ter*(1) or (2); that simply meant that a designation of Denmark in relation to that mark existed, and that the mark was protected by a national registration in force, that was going to be replaced. The Chair referred to paragraph (1)(ii), that stipulated that all the goods and services listed in the national or regional registration were also listed in the international registration in respect of the said Contracting Party; the Chair said that the Office simply had to look at whether all the goods contained in the national registration were in fact covered by the international registration, which could contain more but not less. The Chair then analyzed paragraph (1)(iii), which stated that the extension took effect after the date of the national or regional registration; that meant that the national registration would have to have a date prior to the designation in the international registration or the date of the subsequent designation, if such was the case. The Chair further indicated that if all requirements were met a note would be made on both the national registration and the information on the designation of Denmark available in the Office's register, since that was considered information to third parties. The Chair turned then to the question of the Delegation of Colombia concerning the goods and services; the Chair concurred with the Delegation that the fact that identity was not required was somewhat strange; taking note was only possible if the goods and services were identical or the international registration was broader in that respect. The Chair suggested that when taking note the affected goods and services were listed, thus specifying in the register the particular goods and services in the international registration affected by replacement. The Chair then moved on to the issue raised by the Delegation of Switzerland concerning the national procedure; the Delegation had noted that in that procedure direct contact with the holder of the international registration and of the national registrations existed, and it was thus possible to deal directly with him should there be a problem with taking note of replacement. The Chair explained that the proposal provided a way for holders to go to one Office asking for a replacement taking place in several jurisdictions, making the task much easier for holders, yet such a system did not prohibit that national Offices, should there be problems with taking note of the replacement, dealt with holders directly. If taking note of the replacement posed no problem, the Contracting Party could simply make a notification to the International Bureau that note of replacement had been taken. If, after having dealt with the holder directly, it was concluded that taking note of replacement was not possible, that result could also be communicated to the International Bureau. The Chair then elaborated on the concern on the effective date raised by the Delegation of the United States of America; the Chair noted the possibility of contemplating a system whereby it would be up to the International Bureau to consider whether a request for taking note was premature. The Chair said that it would be possible to consider that the International Bureau would only accept and forward requests in situations where either the Contracting Party had issued a notification under Rule 18*ter* or where the 12- or 18-month period had expired, as the case might be. Such approach would rule out the proposal by the Representatives of MARQUES and INTA, that the request could also be filed together with the international application. Perhaps that could be a discussion for a later date, when a working system was in place. The Chair then analyzed the issue of whether a deadline for replying to the International Bureau should be considered; the Chair said that was difficult to introduce, since it was not clear what the effect of not meeting the deadline would be. It was not possible to assume that the Office had taken note in the national register. The Chair suggested that the fact that the International Bureau had received a request might be reflected in ROMARIN, which would also offer information on whether or not the Contracting Party had accepted to take note. The Chair then stated that the International Bureau would have to study the issue of fees and see if it could offer a solution.

The Chair invited Delegations to contribute ideas, especially those having already taken the floor on the issue, to provide more information on how to address the subject in the most prudent way.

85. The Delegation of the Republic of Korea stated that introducing replacement fees, either flat or individual, would increase the burden of applicants in countries that did not require fees for replacement. The Delegation considered that it was premature to discuss the matter and that the International Bureau should undertake further analysis of the approaches in Contracting Parties.

86. The Delegation of the United States of America wondered whether the International Bureau should forward a request to take note of replacement to the national Office and wondered whether the contact information of the holder would be reflected accurately. When the Office dealt with the holder directly, contact information was updated; yet, if the notification came through the International Bureau, the Delegation was concerned about the accuracy of the contact or correspondence information. The Delegation further stated that in the way the proposal was drafted, no inclusion of updated contact information existed.

87. The Delegation of China said that, where fees were concerned, it would like the International Bureau to consider which national jurisdictions required fees and which did not, as well as the variations in amounts. The Delegation stated that, should a unified fee be introduced, it should not be too high.

88. The Representative of CEIPI suggested omitting paragraph (4) of Rule 21, in order to avoid any discussions as to what the effective date of replacement was.

89. The Secretariat explained that, with respect to the question from the Delegation of the United States of America regarding updated contact details of the holder, the form could cover that element, including email addresses, thus enabling electronic correspondence. Regarding the proposal by the Representative of CEIPI on deleting paragraph (4) of Rule 21, the Secretariat said that it could be a good idea to avoid confusion. The Secretariat also considered that the proposal from the Representative of INTA on deleting in paragraph (1)(b), which was merely meant to indicate that the holder could provide that information to the Office, was pertinent.

90. The Delegation of Germany elaborated on the proposal by the Representative of CEIPI. The whole exercise was meant to achieve a certain degree of harmonization on replacement, and one of the elements of harmonization was, precisely, that the effective date of replacement was the date of the international registration or date of subsequent designation. The Delegation further stated that Germany would need to change its practice, since it had been cancelling the national mark after replacement. The Delegation further informed that, since a refusal by the Office was possible, a representative would be required.

91. The Delegation of Switzerland stated that, concerning the issue of direct contact with the holder, the problem was that in Switzerland telephone and e-mail were not legally valid means of communication. In the case of there being an opposition or disagreement by the Office, the necessary communication with the holder had to be recognized by the Swiss legal procedure. The Delegation further stated that, knowing the practices of many Offices, the holders would need a legal representative for those procedures.

92. The Chair asked the Delegation of Switzerland to clarify whether it was only contacting the holder via e-mail that might be a problem or the whole notion of having direct contact with the holder that was a problem.

93. The Delegation of Switzerland explained that, in order to be able to notify abroad with legal validity, the Office had to either go through the diplomatic pouch or publish in its Gazette. At the moment, the Office could not notify a decision abroad, since it needed to be able to attest the sending of the communication. To that effect, an address in Switzerland was required for the notification to be recognized as such. The Delegation noted, again, that surely the Swiss Office was far from being the only Office in that position.

94. The Chair asked the Delegation of Switzerland whether sending a provisional refusal to the International Bureau, rather than contacting the holder directly, would be acceptable for the Office.

95. The Delegation of Switzerland replied that it should not be called a provisional refusal, another name would be needed, but the Office could in fact address a notification to the International Bureau saying that there was a problem in taking note, and the holder had to find legal representation in Switzerland. For the Delegation that amounted to a much more cumbersome procedure, yet if that was considered an overall simplification of the system, it could be accepted, though in such a case a sizable number of communications would need to be sent.

96. The Representative of MARQUES explained that an important advantage of requesting replacement through the International Bureau would be that a local agent would not be required; if an Office needed to refuse the request, the logical action would be to send the refusal to the International Bureau, who would then send it to the holder.

97. The Secretariat stated that the International Bureau considered that users' associations were interested in a centralized way for submitting the request for replacement to Offices and that, from their perspective, this would be a significant step forward. The Secretariat said that such was the spirit of the proposal. The Secretariat estimated that it would be helpful for the debate if the private sector associations clarified what their preferences were in respect of the whole issue, so that the main objective would not be missed.

98. The Representative of MARQUES explained that users wanted simplicity, but also liked to have options. The possibility to go to a local Office was not to be excluded, thus the Representative was open to consider the problems that might arise. A positive aspect of going through the International Bureau was that a local agent would not be needed. The Representative noted that many Offices did not have any experience with requests for replacement; a solution to that problem would be to receive a request through the International Bureau, which would enable them to develop experience and practice.

99. The Delegation of Israel declared that Israel had the same problem as the Delegation of Switzerland, namely direct communication with the holder; therefore, the Office would need to be able to send a refusal to the International Bureau.

100. The Representative of INTA said that INTA was happy with the proposal of the International Bureau, as it embodied an important simplification for users. The Representative said that he would like to touch on another point made by the Secretariat earlier in the discussion, and to recall that there was no obligation in Article 4*bis* of the Madrid Protocol for the Offices of the Contracting Parties concerned to examine the request for replacement. The only requirement was, on request by the holder, to take note of the international registration. Offices could do that with whatever disclaimer they would think necessary, to warn the interested parties that the fact that they took note, did not imply any stand on whether the conditions laid down in Article 4*bis* were fulfilled or not. The Representative reminded that the discussion had revealed that certain countries did not exercise control over the conditions under Article 4*bis*, while others did so. The Representative considered it interesting to ascertain which Contracting Parties did so and which Contracting Parties did not, as well as what were the perceived advantages of examining the request for conformity with Article 4*bis*. The Representative further stated that he believed the examination did not carry much added value,

because only a few of the international registrations concerned would be later on involved in a conflict. And in that case, the decision of the Office on the fulfilment of the conditions in Article 4*bis* would be challenged again and eventually decided upon by a judge. The Representative considered that, maybe, there was too much concentration on the examination, which was not required by Article 4*bis*, and thus, perhaps, certain countries might wish to reconsider their position on that issue.

101. The Delegation of Switzerland said that it seemed that already the year before a comment had been made whereby the examination by the designated Offices was perhaps not necessary, that Rule 21 went beyond Article 4*bis* of the Protocol. Switzerland had been applying Rule 21 to the letter; but if, under the Common Regulations, examination was not mandatory, maybe the Office would not do it. In that case, Rule 21 would have to be clarified. The Delegation stated that such approach might help solve certain issues of notification and communication with the International Bureau, but the Office would have to be able to communicate that it applied a provision whereby an examination was not mandatory.

102. The Chair said that the topic would have to be revisited again at the next session of the Working Group, and that the Secretariat would have to prepare a new document based on the discussions and taking into account all views expressed.

103. The Chair proposed to consider the document on Rule 12 and Rule 25, as the discussions had prompted some proposals for amending Rule 12 and Rule 26, now 25(2)(d). The Chair opened the floor for comments on Rule 12, paragraph (8*bis*) and asked the International Bureau to present the changes made to Rule 12.

104. The Secretariat explained that the proposal in document MM/LD/WG13/2, which included a sentence saying “paragraphs (1)(a) and paragraphs (2) to (6) shall apply *mutatis mutandis*”, had been slightly reworded, and was now the first sentence of the new draft version saying that “The International Bureau shall examine limitations contained in an international application applying paragraphs (1)(a) and (2) to (6) *mutatis mutandis*.” The second sentence was the same as in the draft with the proposed amendment by INTA; so, it read “Where the International Bureau cannot group the goods and services listed in the limitation under the classes of the international classification of goods and services listed in the international application concerned, as amended pursuant to paragraphs (1) to (6), as the case may be, it shall issue an irregularity.” The Secretariat then explained that Rule 25, paragraph (2)(d) contained the proposal made by the Representative of INTA, so that, instead of the proposed amendment to Rule 26, as set out in document MM/LD/WG13/2, now an amendment to Rule 25 paragraph (2)(d) was submitted. The text would read: “The request for the recording of a limitation of the list of goods and services may only contain the numbers of the classes of the international classification of goods and services included in the international registration concerned.”

105. The Delegation of Switzerland said that it interpreted subparagraph (d), in the sense that to request for limitation it would be sufficient to indicate the numbers of the classes, without mentioning goods and services, and the Delegation wondered whether that was the goal of the proposal.

106. The Representative of INTA said the wording was an attempt to put a prohibition in the positive rather than in the negative, but perhaps one should come back, for clarity, to the negative mode, and that would give that the request for the recording of a limitation of the list of goods and services should not contain the indication of classes of the international classification of goods and services not included in the international registration concerned.

107. The Chair said that, in any case, it would be necessary to again consider whether it was appropriate to have the formula in Rule 26, since it was the scope of what the International Bureau would have to examine what was being envisaged, whereas Rule 25(2)(d) dealt with the content of the request, which was a very different matter.

108. The Chair then proceeded with the next element in document MM/LD/WG/13/2, from paragraph 47, dealing with the recording of a change in the legal nature and state of organization of the holder.

109. The Secretariat explained that the proposal concerned an amendment to Rule 25 for the recording of a change in the legal nature and State of organization of the holder. The possibility to provide information on the legal nature and State of organization of the holder, as a legal entity, was introduced in the Madrid System to enable holders to meet requirements in the laws of certain Contracting Parties. It was therefore foreseen that that information could be provided in the international application, in a request for subsequent designation, where that information had not already been provided in the international application, and in a request for the recording of a change in ownership, in respect of the new holder. The Secretariat informed that the International Bureau frequently received requests to record a change in the legal nature and State of organization of the holder. In certain Contracting Parties, a legal entity could change its legal nature without that change resulting in a new legal entity, and it was important for holders to ensure that the information contained in the International Register was correct. The Secretariat further explained that the recording of a change in the legal nature and State of the organization of the holder was not explicitly mentioned in Rule 25, which contained the exhaustive list of possible changes to an international registration that could be recorded in the International Register. It seemed clear that there was a need for a procedure to record a change in the legal nature of the holder. It was proposed that Rule 25 be amended to explicitly provide for the recording of a change in the legal nature and State of organization of the holder, where the holder was a legal entity. The Secretariat explained that official form MM9, covering change of name and address of the holder, could be amended to include the possibility to also request a recording of that change. The holder could then request a recording of a change of just that information, or do so in conjunction with a request for the recording of a change of its name or address. The proposed procedure for the recording of a change in legal nature would also cover the situation where there was no previous information recorded, as it was still a change in the international registration. The Secretariat said that, since the recorded information would be published in the *WIPO Gazette of International Marks* (the "Gazette"), a consequential amendment to Rule 32 was also proposed to include, in paragraph (1)(a)(vii), a reference to changes in the indications concerning the legal nature and state of organization of a legal entity. A consequential amendment to item 7.4 of the Schedule of Fees was also proposed, for the recording of a change in the legal nature and State of organization of a legal entity. The proposed fee was 150 Swiss francs, the same amount payable for a change in name or address of the holder. Where the holder would request a recording of changes to name, address or legal nature in the same form, only one fee of 150 Swiss francs would be payable to the International Bureau.

110. The Delegation of China said it appreciated the work done by the International Bureau, with which it agreed. The recorded information would be more accurate and the holder would thus be able to correct some or all of the entries under his name. The Delegation said that some marks could be rejected because of differences in the legal nature of holders or applicants.

111. The Representative of APRAM, speaking also on behalf of INTA, said he recognized and thanked the International Bureau very much for the efforts made with regard to change in the legal nature of the holder. On the basis of his practical experience as user, he considered that the next step would be to also offer users the possibility of recording, with regard to an international registration or several of them, information regarding the legal nature of the holder, if not already included in the International Register, and quite independently of any other operation that may be necessary or requested at the same time. In particular, the Representative said that in some jurisdictions there was the possibility to change the legal nature without changing the name of the holder, because the national legislation does not require the company name of the holder to contain an acronym or other language identifying the legal nature of the holder. Thus, it would be useful to allow for the possibility to separately record a form of incorporation that may not be contained in the International Register.

112. The Delegation of Madagascar supported the proposal, made in the interest of holders of international registrations, and stated that it clarified the current provisions of the Common Regulations. It provided for the recording of a change in the legal nature, in accordance with the jurisdiction of the holder, and allowed the holder of an international registration to properly settle the situation of his international registration in the International Register for the implementation of these rights; for example, when designating a Contracting Party, with a new legal status, with a previous mark belonging to the same holder, but with a different legal nature. For the Office of Madagascar, as a designated Office, that previous situation would have led to provisional refusal.

113. The Delegation of the United States of America stated that the proposal raised concerns for the Delegation, because it appeared to make it easier for holders mistakenly to file a change of legal nature, where a change of ownership would have been the legally appropriate option. Under the national law of the United States of America, when a party changed the legal nature, it was interpreted as a change of ownership. The Delegation expressed concerns about the litigation implications of there being a difference between the legal holder in the International Register and the legally accurate holder of the extension of protection in the United States of America. The Delegation asked for some information about those jurisdictions where a change of legal nature did not implicate a change in the holder, to have a better understanding of how they protected or safeguarded against the accidental filing of a change in legal nature when a change in ownership was actually effected. The Delegation suggested a study to be undertaken on how that practice worked in different jurisdictions, its legal effect and how it was implemented.

114. The Representative of AIPPI stated that it should be possible to record a change in the legal nature in an international registration and endorsed the proposal of APRAM, that it should be possible not only to update the information concerning the legal nature, when it was not correct, but also to complete the data when they were not initially included in the international application. The Representative considered that recording a change in the legal nature should be possible in any event, including when requested to avoid a provisional refusal. Finally, the Representative stated that, in the absence of a specific form, it should be done through a simple letter or some kind of communication.

115. The Chair pointed out that there was a question from the United States of America regarding the jurisdictions that allowed for a change in the legal nature without it being a change in ownership and requesting some information. The Chair invited Delegations to give some information about the way of dealing with the change of legal nature.

116. The Delegation of Colombia explained that its legislation allowed for the recording of a change in legal nature without involving a change in ownership. The Delegation described its legal system, where the owner could record a change of legal nature in the public registry, without there being a transferred ownership or without being considered in a differentiated manner.

117. The Delegation of Mexico considered the proposal appropriate, since it would standardize the way in which the recording of a change in the legal nature of the holder was handled, in a manner similar to the way it was done in Mexico. The Delegation explained that a change in legal nature did not lead to a change in ownership or a change in the holder; it just meant that companies, or the moral persons in Mexico, could record a change in their legal nature but that did not involve a change in ownership. The Delegation stated that, through the Madrid System, foreign holders could come to Mexico and record a change in their legal nature because that change had been effected in their country of origin. Moreover, Mexican companies holding international registration would be able to record a change in their legal nature, without involving a change of ownership. The Delegation concluded that the proposal consolidated the Madrid System, providing for more options.

118. The Delegation of Italy supported the proposal by the International Bureau and informed that its national law provided for the recording of a change in the legal nature of the applicant or the holder. The Delegation explained that it was a simple annotation, easy to effect and it was not considered to be a change in ownership.

119. The Delegation of the Czech Republic stated that its national law distinguished a change in ownership and a change in legal nature. The distinction was made also in the payment of fees, as the holder needed to pay for a change of ownership but not for a change in legal nature.

120. The Delegation of Spain explained that it was possible to record a change in legal nature, without using the transfer of ownership, and supported the proposal as it was.

121. The Representative of APRAM, speaking also on behalf of INTA, explained that, as a user, he had had several cases where he witnessed that a recording of a change in legal nature in a large trademark portfolio over a number of jurisdictions did not entail a change in ownership. The Representative also highlighted that what should prevail in those cases was the jurisdiction of incorporation of the concerned legal subject, because it was the law of that particular jurisdiction that would apply to what happened to a company in the case of a change in its legal nature; and, therefore, if under the national law such was not considered as a change in legal personality, that should probably apply also in respect of international registrations owned by that same holder.

122. The Representative of CEIPI asked the Delegation of the United States of America for clarification about its practice, specifically, whether the United States of America would consider it to be a change in ownership where a French company filed a trademark application in the United States of America, obtained registration, and then changed its legal nature.

123. The Delegation of the United States of America explained that the assumptions of the Representative of CEIPI were correct; a change in legal nature of an entity would indicate a change of ownership under the laws of the United States of America.

124. The Secretariat offered a clarification on the question of confusion. One of the reasons why the Secretariat was quite keen on the issue was because the current situation caused even more confusion. Looking at how forms MM5 and MM9 were used, there would probably be more confusion due to the inclination to trying to obtain the change in legal nature through these forms, without there being a clear way to do it in a more transparent manner. The Secretariat indicated that an explicit option for changing the legal nature as such would reduce the level of confusion, since there would be a clear method to do that in accordance with the applicable law, which would be the law of the country of the holder.

125. The Secretariat proposed to include, either in the form or in the rule, an explicit statement that by using that form the holder attested that under the applicable law there was no change in legal personality. The Secretariat suggested incorporating into the rule that the change could only occur if there was no change in legal personality under the applicable law.

126. The Delegation of Germany stated that, in Germany, there was a law of incorporation, where it was possible to change the legal nature without changing the identity of the corporation. The Delegation also pointed out that where form MM5 or MM9 were filed through the German Office, as the Office of the holder, Office examined it to check whether the proper form was being filed because quite often holder file form MM9 instead of form MM5 to avoid the payment of the higher fees for a change in ownership.

127. The Delegation of Cuba sought further clarification regarding the concept of change in legal nature and, more precisely, when it did not result in a change of ownership. The Delegation indicated that a change in legal nature could lead to a refusal in some jurisdictions.

128. The Delegation of France replied to the question raised by the Delegation of the United States of America, and said that in its national legislation a change in legal nature was not equivalent to a change in ownership. That situation could result in an inscription in the register, and consequently, the proposal by the International Bureau did not cause any problems for the Office, so the Delegation supported the proposal.

129. The Delegation of the United States of America indicated that it remained concerned about the proposal. The Delegation brought to the attention the fact that Rule 27(4) stated that the determination of the validity of an assignment corresponded to the national law of the designated Contracting Party. The Delegation considered that, in the event of an extension of protection to the United States of America, it was the law of the United States of America that would determine whether or not the change in the legal nature of the holder was an assignment, in a litigation context. The Delegation of the United States of America believed there still existed not just about which form would be more appropriate to use but about the applicable law; however, it was willing to explore the idea to include a check box in the form by which the holder declared that, under the applicable law, the recording concerned a mere change in legal nature and not a change in ownership.

130. The Secretariat clarified that Rule 27(4) did not seem to apply since the premise was that the holder stated that there was a change in its legal nature that, under the applicable law, did not entail a change in ownership. The form would specify that only a change in legal nature, not in ownership, was included. The only possibility where the rule applied, would be the cases where the applicant wrongly stated that a change in legal nature was truly a change in ownership. However, from a conceptual point of view, apart from that flawed type situation or negligence type situation, that provision would not apply.

131. The Representative of INTA, also speaking on behalf of APRAM, asked the Delegation of the United States of America to provide information on the provisions in the Trademark Manual of Examining Procedure stating that, in the case of a change in legal nature, it was not the law of the country of incorporation of the trademark holder but rather the law of the United States of America that applied when determining whether the phenomenon that took place should be considered as a change in legal entity and not just a change in the form of incorporation. In fact, the situation could be confusing if the same subject would be considered to be the same subject in a number of jurisdictions, including in its own jurisdiction, but rather a different subject under the law of the United States of America.

132. The Chair suggested that discussions on document MM/LD/WG/13/2 be postponed.

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

133. Discussions were based on document MM/LD/WG/13/3

134. The Secretariat introduced document MM/LD/WG/13/3. According to Article 9sexies(1)(a) of the Madrid Protocol, in the mutual relationships between States both bound by the two Madrid treaties, the Protocol alone should be the applicable one. Nevertheless, Article 9sexies(1)(b) rendered inoperative in these mutual relations two declarations; the declaration made under Article 5(2) of the Protocol, extending the refusal period, and the declaration under Article 8(7) of the Protocol, concerning individual fees. As a result, in these mutual relations, the standard refusal period of one year and the standard regime of complementary and supplementary fees applied. In the tenth session, when the topic was last discussed in the Working Group, it was decided that Article 9sexies(1)(b) should be neither repealed nor restricted, and that its application would be reviewed again after a period of three years, which was in 2015. So, the document provided the requested updated information with respect to the non-application of the two concerned declarations.

135. The Delegation of Switzerland said that the information provided by the International Bureau was very useful for them, as they were especially concerned by that Article. The Delegation of Switzerland expressed their support to the proposal of the International Bureau, which consisted in examining Article 9*sexies*(1)(b), only if a member of the Madrid Union or the International Bureau expressly requested it.

136. The Chair turned to paragraph 41 of the document MM/LD/WG/13/3, where it was stated that the Working Group was invited to consider the information presented in the document, indicate whether it would recommend to the Madrid Union Assembly that Article 9*sexies*(1)(b) was to be restricted in the scope or repealed, and indicate whether it would agree that any further review of the application of paragraph (1)(b) of Article 9*sexies* should be undertaken by the Working Group, at any moment thereafter, at the express request of any member of the Madrid Union or the International Bureau.

137. The Delegation of China supported the proposal of the International Bureau as it considered the document to be clear and precise.

138. The Delegation of the Czech Republic supported the proposal.

139. The Delegation of Luxembourg, speaking on behalf on the European Union and its member states, declared that the current system worked fairly well. That a positive picture had been confirmed by the review of the inoperativeness of declarations made under Article (5)(2)(b) and (c) and Article 8(7) of the Protocol. Therefore, while the European Union and its member states supported further steps towards the consolidation of the unity of the Madrid System, as proposed by the International Bureau in document MM/LD/WG/13/7, it did not see any need for further action regarding Article 9*sexies*(1)(b).

140. The Chair concluded that the Working Group had agreed that there should be no changes, and that any future work should only be undertaken insofar as there would be an express request from a member of the Union or from the International Bureau.

AGENDA ITEM 9: REVIEW OF THE PROPOSAL TO FREEZE THE APPLICATION OF ARTICLE 14(1) AND (2)(A) OF THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

141. Discussions were based on document MM/LD/WG/13/7.

142. The Secretariat explained that, on July 31, 2015, the Government of Algeria had deposited its instrument of accession to the Protocol. As from October 31, 2015, when the Protocol entered into force in respect of Algeria, the Agreement became in fact a non-operational treaty. There was now, for practical purposes, a one-treaty system, namely the Madrid Protocol. Having achieved the goal of making the Madrid System a one-treaty system under the Protocol, the purpose of the document was to discuss a possible recommendation to the Madrid Union Assembly to freeze the application of Article 14(1) and 2(a) of the Agreement. Such a decision to freeze those articles would be in line with the course charted in 2005 during the first session of the *ad-hoc* Working Group. Then, it was indicated that the Agreement would no longer be applicable as part of the international registration procedure, if the following three circumstances were cumulatively met: (1) that the Assembly decided to repeal the safeguard clause; (2) that all Contracting Parties bound by the Agreement also became bound by the Protocol; and, (3) that the Assembly decided to freeze the application of the Madrid Agreement, so that no country could accede to the Agreement alone in the future and that international applications no longer could be filed under the Agreement. This would, in fact, only have one implication, namely that a country would no longer be able to deposit an instrument of ratification or accession to the Agreement alone. A country would be able to deposit such instrument, in accordance with Article 14 of the Agreement, only with a simultaneous deposit of an instrument of ratification or accession to the Protocol. In such case, the Protocol would still be the prevailing treaty. The decision to freeze or suspend the application

of Article 14(1) and (2)(a) of the Agreement, if taken by the Madrid Union Assembly, would have effect from a certain date established by the Assembly and it could be reviewed or reversed by the Assembly at any time in the future.

143. The Chair opened the floor for comments on the document.

144. The Delegation of Luxembourg, speaking on behalf of the European Union and its member states, stated its support to the freezing of Article 14(1) and (2)(a) of the Madrid Agreement. In principle, that suspension would allow new Contracting Parties to ratify or accede simultaneously to the Agreement and to the Protocol, creating a simpler system which would benefit applicants, Offices, third parties and the International Bureau.

145. The Delegation of Madagascar supported the freezing of the application of Article 14(1) and (2)(a) of the Madrid Agreement.

146. The Delegation of the Republic of Korea supported the freezing of the application of Article 14(1) and (2)(a) of the Madrid Agreement, as it contributed to the simplification of the Madrid System.

147. The Delegation of the Russian Federation endorsed the proposal since it was not irreversible and could possibly be re-examined or cancelled by the Assembly at any time.

148. The Delegation of Mexico endorsed the proposal considering that freezing the application of Article 14(1) and (2)(a) of the Madrid Agreement would benefit the system, but, principally, it would provide the necessary legal security. The Delegation further stated that the proposal would contribute to the harmonization of the Madrid System.

149. The Delegation of Tunisia expressed its support for the proposal, which facilitated and encouraged more countries to accede to the Protocol.

150. The Delegation of China agreed with freezing the application of Article 14(1) and (2)(a) of the Madrid Agreement, as it would contribute to the simplification of the Madrid System.

151. The Chair announced that all the Delegations seemed to support the proposal, therefore he suggested to look at the Annex of the document where there was a draft decision paragraph to confirm if the Delegations agreed with the wording of that paragraph.

152. The Representative of INTA questioned the necessity to freeze paragraph (1) of Article 14, if there was no country of the Madrid Union which had signed the Stockholm Act but not yet ratified it. Should there not be such a country, it would not be necessary to freeze paragraph (1); the Representative asked the Secretariat to confirm that point. The Representative also stated that in previous occasions INTA was reluctant to a formal freezing of a clause of the Madrid Agreement, and that referred to proposals for other possible suspensions of provisions of the Madrid Agreement. Finally, the Representative of INTA drew attention to the fact that there was a precedent in the Madrid Union, referred to in paragraphs 21 and 22 of document MM/LD/WG/13/7, namely a decision by the Madrid Union Assembly asking the International Bureau to cease to implement a provision of the Madrid Agreement which had ceased to have any legal justification. The Representative proposed to proceed through a similar procedure, thus asking or inviting the Director General of WIPO not to accept an instrument of accession to the Madrid Agreement from a country which would not already be bound by the Madrid Protocol, or which would not at the same time accede to the Madrid Protocol.

153. The Secretariat answered the question of the Representative of INTA, stating that there was one country that had signed the Protocol, but not yet acceded to it, so taking that into account the freeze of paragraph (1) would be deemed to be necessary for that purpose.

154. The Representative of INTA clarified his previous question: was there any country that has signed the Stockholm Act of the Madrid Agreement and not ratified it?

155. The Secretariat confirmed that the International Bureau was not aware of any country, which had signed the Stockholm Act and not yet acceded to it.

156. The Chair said there were no more comments on the Annex, and moved to the date as from which the proposal should have affect; January 1, 2017, was the proposed date.

157. The Representative of CEIPI indicated that the date of the entry into force of such a decision should be the one when the Assembly would take the decision. The freeze should enter into force immediately after the Assembly decision. The Representative also asked for clarification regarding the inclusion of paragraph (1) of Article 14 of the Agreement in the freeze proposal; since there seemed to be no country concerned by paragraph (1), the suspension could be limited to paragraph (2), and the report of the meeting could then explain that paragraph (1) had become obsolete.

158. The Chair stated that the proposal should be as it was in the document, since there had been no reactions from the Delegations of the Contracting Parties, and all had expressed support for the proposal. The Secretariat agreed with the proposal made by the Representative of CEIPI on the date of the freeze corresponding with the date of the decision by the Assembly.

159. The Delegation of Switzerland said that no decision had been taken by it on the issue and asked for more time to consider this, as well as the proposal by CEIPI.

160. The Delegation of Germany supported the proposal by the Representative of CEIPI about the date of effect of the freeze, and echoed what was said by the Delegation of Switzerland, asking for time to think about the other proposal by the Representative of CEIPI concerning paragraph (1) of Article 14.

161. The Delegation of Hungary supported the Delegations Switzerland and Germany, asking for the necessary clarification about whether or not there was a country for which the freeze of Article 14(1) would be relevant, and agreed with the Representatives from INTA and CEIPI to further reflect on this.

162. The Delegation of Italy supported the proposal by the Representative of CEIPI and the Delegations of Germany, Hungary and Switzerland, and asked the International Bureau about the possibility that a new member join the Agreement only, between the decision by the Madrid Assembly and the entry into force of the freezing.

163. The Chair summarized the issue. The objective of the Working Group was to achieve a goal whereby there would be no accession to the Madrid Agreement without also acceding to the Protocol. There were some concerns raised regarding the decision paragraph in the document, and there were also some alternative approaches on how to achieve that goal, specifically one proposing that the Director General of WIPO should be instructed by the Madrid Union Assembly not to accept any further accession to the Agreement only. The Chair proposed that the Working Group recommended to the Madrid Union Assembly, to take the appropriate measures to prevent further accession to only the Madrid Agreement, as of the date of the next Assembly, and then the Secretariat could be asked to identify the nature of those measures to be taken by the Assembly. The Chair opened the floor for comments on the proposal.

164. The Delegation of Switzerland entirely endorsed the proposal made by the Chair.

165. The Chair stated that the proposed solution, supported by the Delegation of Switzerland, would be reflected in the Summary by the Chair and concluded the work on item 9 of the Agenda.

AGENDA ITEM 6: PROPOSAL FOR THE INTRODUCTION OF THE RECORDAL OF DIVISION OR MERGER CONCERNING AN INTERNATIONAL REGISTRATION

166. Discussions were based on document MM/LD/W D/13/4.

167. The Secretariat introduced document MM/LD/W D/13/4 on proposal for the introduction of the recording of division or merger concerning an international registration. The topic had been discussed in several sessions of the Working Group. Following a request made in the previous session of the Working Group, the International Bureau had prepared the document in consultation with the Delegation of Switzerland and with contributions made by AROPI and INTA. The Secretariat stated that the document proposed the introduction of new Rules *27bis* and *27ter* and the amendments to Rule 32 and Section 16(b) of the Administrative Instructions.

168. The Secretariat explained that paragraph (1) stated that the Office of the Contracting Party for which division was being requested should present a request to the International Bureau. Another essential feature was limited control by the International Bureau, which would have an examination role limited to ensuring that requests meet the formal requirements listed in paragraph (1), as well as other formal requirements in the Common Regulations or the Administrative Instructions. The Secretariat said that another relevant issue was the consideration on whether to divide the goods and services affected by a provisional refusal or those that were not affected. The issue for the Working Group to decide on would be which goods and services to list in the request for division. The Secretariat indicated that a fee for division was proposed, of 177 Swiss francs, as set out in new Rule *27bis*. The fee would be payable to the International Bureau for the recording of the division of the international registration in the International Register. That also implied a consequential amendment to the Schedule of Fees. The Secretariat stated that paragraph (4)(a) of proposed new Rule *27bis* instructed the International Bureau to record the division of the international registration in the International Register, following the current process for the recording of a partial change in ownership. In that sense, division would be recorded under the registration that had been divided. Paragraph (4) also required that the International Bureau create a divisional registration, which would only have as its main list the goods and services that had been set apart and as its sole designation the Contracting Party of the Office that had sent the request. The divisional registration would be identified with the same number of the registration from which it had been divided, followed by a capital letter. This would also lead to a consequential amendment to Section 16(b) of the Administrative Instructions and a consequential amendment to Rule 32 requiring that the recording of division be published in the Gazette. The Secretariat further explained that, where the legislation of a Contracting Party did not provide for division at the national or regional level, the Office would have the possibility to make a declaration opting out of the divisional procedures, as was proposed in paragraph (6). Concerning mergers, the Secretariat said that new Rule *27ter* envisaged that registrations resulting from division could be merged. The Working Group might wish to consider whether that provision be split up into one paragraph concerning merger of registrations resulting from division and another paragraph on merger of registrations concerning change in ownership. The Working Group might also wish to consider whether the request for merger of registrations resulting from division should be presented through the Office concerned. The Secretariat explained that, as it was the case for division, for publicity purposes, a proposed amendment to Rule 32 would require that mergers also be published in the Gazette.

169. The Delegation of Israel acknowledged the importance of the division of international registrations and supported the proposal. The Delegation believed it more appropriate that division concerned the goods and services affected by the provisional refusal, and stated that requests for division originated not only in oppositions, but also after refusals by Offices. Thus, it would not always be possible to include statements under Rule *18ter*. In consequence, the Delegation proposed the deletion of paragraph (1)(d) of proposed Rule *27bis*. The request for merger should be presented to the International Bureau, not directly, but by the concerned Office after examination and approval of the request.

170. The Delegation of China stated that the proposal for the recording of division and merger would affect the convenience and simplicity of the Madrid System, increase the burden on the International Bureau and cause confusion. The Delegation indicated that the fees would reduce the willingness of users to utilize that feature of the Madrid System. The Delegation further stated that the introduction of division and merger needed to be more mature.

171. The Delegation of Luxembourg, speaking on behalf of the European Union and its member states, highlighted the value for users to divide an international registration, thereby achieving coherence with international standards provided under the Trademark Law Treaty (TLT) and the Singapore Treaty on the Law of Trademarks (STLT). The Delegation also reminded that the philosophy of the Madrid System was to make the international system as simple as possible, and this should be maintained. As stated during the previous session of the Working Group, the division of an international registration should result in a new international registration. The European Union and its member states remained open to discuss the proposal to introduce division and merger of international registrations under a centralized approach.

172. The Delegation of Madagascar expressed its concerns regarding the introduction of division in the Madrid System, and explained that the legislation of Madagascar did not provide for division, but for cases of partial change in ownership. The Delegation underlined that the goal of the Madrid Union was to make the system more effective and wondered if division would be of interest to many stakeholders in the Madrid System, given the necessary mobilization to include it in the system, both for designated Offices for which division was provided, as also for the International Bureau. The Delegation also reminded that two types of fees would have to be paid for the division and that two international registrations would have to be managed until a merger took place. Finally, the Delegation foresaw the possibility that renewal might be necessary before merger took place, so two fees would need to be paid to keep the international registrations in force. Making the Madrid System effective meant also gaining in cost-efficiency ratio for the holders involved in the process.

173. The Delegation of the Republic of Korea supported the proposal, yet proposed a reduction of fees, which might be too burdening for applicants in the Republic of Korea where international applications were on the rise, as well as in developing countries.

174. The Delegation of New Zealand considered that division should be part of the Madrid System, since it could offer an effective mechanism to address a refusal in a designated country and would help users of the Madrid System. Division should concern the goods and services subject to refusal. The Delegation remarked the difficulty to send a statement of grant of protection along with the request for division.

175. The Delegation of Denmark confirmed its support for a centralized approach. The Delegation asked the Secretariat about the effect that a merger would have on any designation affected by a division. The Delegation elaborated on the question referring to the fact that the proposed draft did not contain a provision similar to the one included in document MM/LD/WG/12/3 of the previous session. The Delegation indicated that, in that previous document, Rule 27*bis*(7)(b) provided Contracting Parties with an option to declare that the notification of a merger had no effect in relation to a given Contracting Party. The Delegation suggested that if a merger of an international registration resulted also in a merger of designations, a Contracting Party would need to have the option to declare that the merger had no effect in that Contracting Party. A merger could result in a designation which had different dates of acceptance, publication dates or other dates that were relevant in relation to the calculation of the opposition period or the requirement of genuine use.

176. The Delegation of France aligned itself with the statement made by the Delegation of the European Union and its member states, and asked for clarification on the proposal in connection with the management of the divided part. The Delegation said that the document seemed to be proposing two options in paragraphs 12 to 20, and these were not completely

clear. The Delegation indicated that the possibility of merging divisional applications did not exist in France at the national level so the Delegation considered that the possibility of having them at the international level and not at the national level could be problematic. The Delegation added that its Office was in the process of dematerializing its procedures and the introduction of division and merger would imply an adaptation of IT tools that would have to be taken into account for the entry into force of a proposal.

177. The Delegation of Australia supported the proposal since the possibility of division provided benefits to users. The third neutral option was considered to provide a streamlined and cost-effective way for businesses. The Delegation underlined the fact that the different options might require changes to laws and practices in Contracting Parties, like Australia. Australia did not provide, under its national law, for the merger of divisional registration in instances where both parent and child registrations were protected; thus, that was an issue that would need to be considered further. The Delegation noted that the introduction of division and/or merger of international registrations required consultation with Australian users. Since legislative or regulatory changes would need to be analyzed, the Delegation proposed to choose a later date for entry into force, as November 1, 2017, was not realistic if legislative amendments is required, lengthy and competitive processes under the domestic arrangements of Contracting Parties would be required.

178. The Delegation of Colombia stated that because of the principle of national treatment, holders of international registrations enjoyed the same prerogatives as national applicants; therefore, in Colombia, it was possible for the holder of an international registration to divide it. The Delegation considered that the International Bureau should collect fees. The Delegation supported the proposal of the Delegation of Israel, to exclude from proposed Rule 27*bis* subparagraph (d) of paragraph (1), because a declaration of protection with the petition of the division to the International Bureau could not always be included.

179. The Delegation of the United States of America explained the way the Office handled the grant of protection under Rule 18*ter*, where a statement of a grant of protection was not issued until protection was granted; thus, the statement of grant of protection would be issued after the International Bureau had issued the divisional request, which the holder would file with the United States Patent and Trademark Office (USPTO). The International Bureau would undertake its processing and then issue the division and finally return it to USPTO with the additional number for the parent or for the child registration. The Delegation insisted that, at that point, the USPTO had not actually granted the extension of protection, so that the corresponding statement could not be included. The Delegation expressed its concerns about the implementation of merger under proposed Rule 27*ter*; in particular, the Delegation asked how that aspect of the proposal would work and how it would affect renewal processing, including the collection of renewal fees. The Delegation added that there was a divisional practice under the laws of the United States of America, but there was no merger procedure, and that it would be very difficult to implement this. The Delegation stated that in cases of division, the child was the registration against which no refusal had been issued, and that registration would have an effective date as of the registration date. The Delegation further stated that the effective date of protection in the United States of America was the date when protection was actually granted, not the filing date. For that reason, the child would have a different date of protection than the parent in the United States of America, and a merger would create a problem for determining what date would prevail, for the purposes of maintenance under the law of the United States of America. The Delegation also raised the question of the eventual confusion for holders regarding renewal dates, and for the Offices as to how fees should be collected for two registrations once the international registration had been merged. The Delegation asked how to collect the fees for the separate registrations at the national level. The Delegation further asked the International Bureau how it would process the ceasing of effect. The Delegation supported further discussion on merger practice and suggested that a survey on national Office merger practices would be very useful in developing a solution that could be universally acceptable.

180. The Delegation of Germany supported the position of the European Union, but pointed out that the division procedure would add complexity to the system. The Delegation expressed concerns about merger. In the national law of Germany, there was no merger and it was indeed expressly forbidden to merge the divided registrations. So, for renewal purposes, there would be two registrations and two renewal fees. Germany had accepted to proceed with the proposal on division of international registrations, so that international holders were not in an inferior position as compared to national ones, but that should not entail an advantageous position either. The Delegation proposed that, while the request for division should be examined under national law, only the formal requirements should be in the international law, but not substantive ones, like merger. The Delegation stated that the date in 2017 was not realistic, since Contracting Parties needed to adapt national laws and IT systems. The Delegation considered that division concerned the affected goods and services and requested that the provision include the possibility to collect a national fee.

181. The Delegation of Mexico said that Mexico shared the same problems expressed by other delegations concerning its legal system, and indicated that adopting the proposal would result in legal uncertainty if there was not a suitable national legal system able to deal with division and merger of international registrations. The Delegation highlighted the importance to continue the discussion on that issue and expressed its willingness to continue to analyze the issues of division and merger.

182. The Delegation of Japan stated that introducing both the recording of division and the merger of international registrations would improve the accessibility to the Madrid System by providing alternatives for holders of international registrations, but certain issues needed to be taken into account prior to this. The Delegation underlined, first, the fact that introducing division and merger would affect routine work in both the International Bureau and national Offices; secondly, concerning effectiveness; thirdly, whether operations were clarified and sped up; and, fourthly, if there would be any accessions by new Contracting Parties. The Delegation pointed out that it would oppose the proposal to enact Rule 27bis paragraph (1)(d), concerning the inclusion of a statement of grant of protection for the goods or services listed in the request. The Delegation said the International Bureau should examine the applicable requirement for requests for divisions as well as fees. If the requirements were not complied with within three months, the request should be considered abandoned under Rule 27bis(3)(b). In such case, the legal status of the statement of grant of protection sent by the designated Office would become unclear and unstable. The Delegation added that operating under those circumstances would significantly affect the system and the operations of the International Bureau and national Offices.

183. The Delegation of Italy was favorable to the introduction of the recording of division and merger concerning an international registration, as in fact in Italian legislation provided for such a provision. The Delegation emphasized that that would be better to harmonize the Madrid System with the TLT and the STLT, and stated that further examination should be undertaken to implement some aspects of each proposal, in particular, for the management of the Register with the possibility of two registrations for the same trademark. The Delegation requested to consider the possible consequences of multiple grants of protection for the same trademark, which could add complexity to the system, especially regarding the starting date of renewals. Therefore, the Delegation considered that entry into force in 2017 did not seem realistic.

184. The Delegation of India explained that the Indian law did not recognize mergers and that it would be very difficult to incorporate the concept of merger into its national law. The Delegation expressed concerns in cases where the registration had included limitations of certain items, and, after the grant of protection, an application for division was filed with different items. Such situations should be dealt with by the Designated Office.

185. The Delegation of the Czech Republic agreed with the payment of the fee but invited the Working Group to consider the frequency of divisions, since numerous changes in IT tools would be needed. The Delegation pointed out that it might be not desirable that division became too frequent.

186. The Delegation of the Russian Federation said that the procedure was very well established in its national legislation with an administrative regulation, which defined the various elements that should regulate division. The procedure was meant to also to be adapted to the regional system through economic co-operation with Armenia, Belarus, Kazakhstan, Kirgizstan and other countries. The Delegation considered that the proposal on merger was not pertinent at the moment, since such concept did not exist in Russian law.

187. The Representative of JPAA, as one of the users of the Madrid System, supported the proposal for the introduction of the recording of division and merger because it would allow users who designated countries where relative grounds were examined to have other options besides limitations. The Representative added that with these measures applicants could swiftly obtain registration with regard to certain goods and services, and safely argue for the goods and services that were affected by provisional refusals. At the same time, the system should be simple and cost-effective through a centralized approach, as pointed out by Delegations.

188. The Representative of INTA recognized that there were still some issues to be looked at, but some could be solved quickly, in particular, the one in paragraph (d) of Rule 27*bis*(1), while others might require attention, such as the merger of international registration after division. The Representative considered that there had been positive attitudes in most, if not all, Delegations.

189. The Representative of CEIPI endorsed the notion of dividing international registrations according to the principle that international applicants should be placed at least in the same position as national applicants. The Representative referred to comments by Delegations that the system might be difficult, complex and expensive for holders of international registrations. The Representative recalled that division would not be a mandatory procedure and a holder of an international registration, who would prefer not to proceed to a division, would be free to do so, and there would be no obligation to do it. Regarding fees, the same reasoning should apply, given that the amount of the fee could be discussed. The Representative made a proposal, due to the difficulties of some Offices in adapting their systems in time for the entry into force as proposed by the International Bureau, in November 2017, to provide flexibility and longer periods for Offices which knew division at national level but who might need a little more time to adapt the system at an international level. It might be unfortunate to delay the entry into force of the new provisions *vis-à-vis* Offices which might be able to respect the time limit of November 2017, since the International Bureau would be ready to do all the necessary preparatory steps within that time frame. The Representative raised the question of Rule 27*bis*(1)(d) and proposed to remove the provision due to the wide spread consensus. Finally, the Representative referred to the question of merger and proposed to separate a merger resulting from a division process from the one resulting from a partial change in ownership. The discussion on merger should be deferred to a later session, but without delaying the adoption of the provisions on division itself; another possibility would be to introduce in the provisions on merger a possibility, which was more or less equivalent to what was offered in division in Rule 27*bis*(6), namely a possibility of reservation.

190. The Representative of JTA supported the proposal for division and pointed out that the procedure for division should be simple and workable, to limit the increase of the workload of the International Bureau and Offices. The Representative supported, in particular, the proposal that a request by the holder for the division of an international registration should be presented to the International Bureau, by the Office of a Contracting Party, and the request should concern only one Contracting Party, only some of the goods and services, with limited control by the International Bureau. The Representative proposed that new Rule 27*bis*(1) adopt a neutral

approach, as indicated in paragraphs 19 and 20 of the document. The Representative expressed concerns regarding whether the request for division should include a statement of grant of protection for the goods and services listed in the request. The Representative exemplified its position with cases where the payment of the fee for the division had not been made, and the division was *ex post facto* declined, where it should be simpler and more economical to issue a statement of grant of protection after division was recorded in the International Register.

191. The Delegation of the Philippines said that its Office had already received request for division, following a provisional refusal, but that it had been unable to accommodate them because division was not possible under the Madrid System, even though under its national law, division of applications was possible. Regarding merger, which was not provided by the law of the Philippines, if international registrations were to be divided and merged, different statements of grant of protection would be issued, with different grant of protection dates.

192. The Delegation of Switzerland proposed to collect a list of the various problems raised to give specific responses, thus allowing Delegations to make the best possible decisions.

193. The Chair proposed to ask the Secretariat to look into the matter further and to present a simplified procedure for the recording of division and merger at the next session, taking into account all the questions raised at the meeting, and to allow Delegations to submit further information and questions to the International Bureau before the end of the year. The Chair further asked the International Bureau to seek a workable alternative for merger.

194. The Delegation of Switzerland supported the proposal.

195. The Representative of INTA proposed to discuss mergers in the next session, but suggested to reach agreement on some points regarding division; for example, draft Rule 27*bis*(1)(d) of the proposal by the International Bureau. Contracting Parties, which had a pre-registration opposition system, would not be in a position to issue a Rule 18*bis*(1) notification together with the transmission of the division request to the International Bureau. Contracting Parties might be in a position to do so where they had post-registration opposition systems. Therefore, the Representative proposed a new wording for Rule 27*bis*(1)(d), which would be an optional provision for all Offices: "Any requests presented under this paragraph may include a statement in accordance with Rule 18*ter*(1) or 18*bis*(1) for the goods and services listed in the request."

196. The Secretariat summarized the discussion based on document MM/LD/WG/13/4 and underlined some ideas raised by Delegations. Merger should be left aside until agreement on division had been met. Concerning the neutral approach on which goods or services to set apart in the divisional registration, either the Working Group decided to delete subparagraph (d), as proposed by a number of Delegations or agreed with the option raised by the Representative from INTA, turning into an optional provision, using the word "may", provision and indicating Rules 18*bis* and 18*ter*. The Secretariat indicated that it would look into that possibility in the next document but remarked that, in any case, that would be a decision taken by the Office sending the request for division, namely, which notification to submit. The Secretariat explained the result of a division of an international registration; after division, there would be one fully independent international registration, which would bear the same number as the parent, with the addition of the letter A, B, etc. Accordingly, there would be two fully independent international registrations. In one of the registrations there might be a number of Contracting Parties but for the divisional there would be one Contracting Party only, the Contracting Party where division had been requested. The divisional registration would be an independent international registration. Consequently, if the Office, when completing its procedures, would like to confirm the refusal of the goods and services covered in that registration, it would be the holder that would decide to cancel or to maintain this registration. As long as the two international registrations continued to be alive, renewal fees should be paid to the International Bureau and to the designated Contracting Parties. The Secretariat referred to the question

raised by the Delegation of the United States of America about ceasing of effect and explained that, if the basic mark ceased to have effect in the five year dependency period, the Office of origin would notify that fact to the International Bureau altogether with the list of goods and services in the international registration that was to be cancelled; and the cancellation could also affect the divisional registration.

197. The Delegation of Switzerland supported the proposal by the Representative of INTA to change the wording of Rule 27*bis*(1)(d), so as to allow the Office to issue notifications under Rules 18*bis* or 18*ter*. The Delegation concurred with the view of the International Bureau on the issue of ceasing of effect, and suggested to discuss the matter of fees.

198. The Delegation of Germany said that, since some Delegations had already mentioned that their Offices collected a national fee, this should be included in the text. The Delegation recalled that paragraph 9 of the document indicated, in its last sentence, that “Accordingly, each Contracting Party would be at liberty to determine the requirements and processes that it deem suitable, including establishing the payment of a fee to its Office for the examination and transmission of the request to the International Bureau. This fee would be independent from the fee payable to the International Bureau for the division of an international registration.” The Delegation stated that, if the Office had to examine the request before sending it to the International Bureau, a fee should be collected. The Delegation requested that the provision also state that examination would be undertaken under the national law.

199. The Representative of INTA raised the question of fees and explained that, as far as users were concerned, the international fee which was proposed was perfectly reasonable, in consonance with the amount for various modifications or changes to the international registration. The Representative said that national procedures would apply, as well as national fees for the examination and the transmission of the request for the recording of a division to the International Bureau. It would be useful to identify issues deserving further attention, to orient the International Bureau in the preparation of the next draft provisions.

200. The Delegation of Cuba noted that representatives of users of the Madrid System had clarified the issue of fees payable to Offices and declared that the Working Group was approaching consensus on the issue of division. The Delegation supported the proposal and the proposed fee approach.

201. The Secretariat clarified that the document was meant to imply that national procedures, including the payment of national fees or other national requirements, needed to be met; thus, Offices would be able to collect the national fee before submitting the request for division to the International Bureau. The Secretariat proposed, for clarity’s sake, to include in Rule 27*bis*(1) that the request should be presented to the International Bureau by the Office of the Contracting Party upon compliance with applicable requirements and payment of the national fee, if any.

202. The Secretariat catalogued the main issues, as suggested by the Representative of INTA, and identified four main issues and encouraged Delegations to take the floor, if they had an issue that had not been identified. The Secretariat indicated that the remaining issues were (i) merger; (ii) proposed draft Rule 27*bis*(1)(d); (iii) fees; and, (iv) possible need for changes in legislation. The Secretariat suggested two possible solutions; for those Contracting Parties whose national laws did not foresee division at all, the solution was the opt-out clause reflected in the document; for those where only some changes on the legislation were needed, the possible solution could be a flexible implementation date as proposed by CEIPI. Moreover, considering that the implementation of the proposal would require certain changes to IT systems and procedures, the Secretariat suggested further flexibility on the implementation date.

203. The Delegation of Kenya stated that the issue of fees was a major concern for developing countries, especially, since the fact that there would be two registrations would amount to a fee increase.

204. The Delegation of Germany asked the Secretariat about the earliest time that a request for division might be filed. Under the national law of Germany, the period to request division was after the expiry of the time limit for giving notice of opposition. The request for division was admissible only after an opposition or an action for cancellation, when this was directed against one of the parts of the original registration.

205. The Representative of AROPI agreed that it was useful to have an inventory of the technical aspects contributing to a common understanding and stated that division should be applied to the non-opposed or non-refused part of the registration and not to the part of the registration that had been opposed or refused.

206. The Chair explained that there were now six issues, with one issue just raised by the Delegation of Germany. The Chair reminded the question raised by the Delegation of Germany about the earliest time for requesting a division before an Office, as well as the issue of the basis on which a request for division could be made, namely whether division was acceptable only in situations where a provisional refusal had been issued or, at the request of the holder, without a previous provisional refusal.

207. The Delegation of Sweden expressed its concerns with the opt-out clause in Rule 27bis(6), namely the binding formulation for countries that had division at the national level. The Delegation explained that its national law established a process to divide a national application or registration but not an international registration. The Delegation, given that the current draft provision would entail an important legislative workload, proposed to change the wording of the opt-out clause to include the possibility of sending a notification to that effect, even if a given Contracting Party did have division in the national law.

208. The Delegation of Japan indicated that several points remained unclear in the proposed draft rule. The first one concerned the effective date of division, meaning whether the divisional international registration would be effective from the date on which it had been recorded in the International Register or from the date of recording of the parent international registration. The second issue concerned the effects of the divisional international registrations, meaning whether or not the priority date of the parent international registration would apply to the divisional international registration and whether or not procedures such as notifications of provisional refusals for international registrations, before the recording of division, could be taken over as it had been the case so far. The third question regarded the notification of the recording of division, which would not be sent to the Office of holder, so the information of division of the international registration might not be known by this Office. The Delegation requested that the International Bureau record information on cancellations of basic applications or basic registrations not only for the parent international registrations but also for divisional international registrations.

209. The Delegation of India asked for clarification in the draft about the role of the Contracting Party where division had effect.

210. The Delegation of Germany made two points, after holding discussions with the Delegations of France and Switzerland. When the request for division was examined by the national Office and it was not admitted, there was no need to send it to the International Bureau. That could solve the problem of the starting point of the period to request division. The Delegation further added that, according to Rule 27bis(4)(b), division would be recorded with the date of receipt by the International Bureau of the request or the date where the irregularity was remedied, whereas German law regulated that in a different way. In Germany, the divided registration would always have the date of the parent registration, which was in that case more favorable to the holder. The Delegation considered that maybe this element should be left to the law of the designated Contracting Party.

211. The Chair explained that the provision dealt with the date of the recording of division, which did not mean the date of effect of the divisional registration, and asked the Secretariat to better reflect this fact in the new draft rule.
212. The Delegation of Germany insisted that it would be unnecessary to have two dates if the date of division would not have legal effect.
213. The Chair explained that a date concerning when division took place was only something that should be reflected in the International Register to keep a proper record.
214. The Representative of INTA reassured the Delegation of Germany that the date of effect of the divisional registration was not included in the text, just the date on which division was recorded, because a divisional international registration would have the same date of effect as the parent international registration, as such was coessential to the concept of division. The Representative made it clear that the proposal dealt with the process for the recording of division and not with the substance, which remained a matter to be determined by the applicable national law. The Representative addressed the question raised by the Delegation of India, regarding the role of the designated Contracting Party concerned, and clarified that that Contracting Party would have a central role in the division procedure, because the request for division should go through the Office of the designated Contracting Party, and it would be that Office which would decide whether to transfer it to the International Bureau if it complied with its national legislation, or not, if it did not comply.
215. The Delegation of India stated that the wording of the draft provision might also suggest that the Contracting Party in question was that of the holder and not the concerned designated Contracting Party.
216. The Chair proposed adding the word “designated” before the words “Contracting Party” in Rule 27(1), so it would read: “A request by the holder for a division of international registration for some only of the goods and services, in respect of a designated Contracting Party.”
217. The Secretariat addressed the remaining issues. The Secretariat referred to the question posed by the Delegation of Japan, explaining that, where the holder wanted to divide an international registration, all the data in the international registration would be copied into the divisional registration, including the date of the international registration and the date of priority, if any. The Secretariat went on to explain to the Delegation of Germany that the date of the divisional registration would be the same as the date of the parent registration. The Secretariat answered the question of the Delegation of Japan regarding the ceasing of effect and explained that the Office of origin would not be notified of a divided registration, as it was the case with partial changes in ownership. In the event of a ceasing of effect, the Office of origin should communicate it to the International Bureau simply specifying the goods and services in the international registration to be cancelled. Yet, for the sake of clarity, it would be possible to add in the provision that the Office of origin should be notified. The Secretariat further explained that the new international registration would bear the same number as the parent registration and would have the letter “A”. Where goods and services were affected by the provisional refusal, a process before the Office would ensue in accordance with the national legislation. If protection was granted for the refused part, the holder should be able to merge the divisional and parent registrations; otherwise the holder would be left with two active international registrations. On the other hand, if refusal was confirmed, the holder might opt for a cancellation of the divisional registration.
218. The Chair opened the floor for comments regarding the opt-out clause after the issue raised by the Delegation of Sweden. The proposal after discussion was based on the assumption that the opt-out clause would apply to mergers and division. The Chair opened the debate on the possibility to opt-out from both division and merger, should merger be introduced in the future.

219. The Delegation of Cuba recalled the question posed by the Delegation of Germany and stated that clarification was still needed regarding the date of the recording of division.

Rule 27*bis*(1)(b) stated that such date would be the one on which the International Bureau received the request for division, which, in all likelihood, would differ from the date on which the national Office received the document. The Delegation explained that, when the Cuban Office received a request for division, it preserved the date of effect of the parent application but took into account the date of reception to process the request for division and to create a divisional application with a new number and a new date. The Delegation asked which date would be used by the International Bureau for the recording of division and wondered whether it would be the date on which the Office received the request for division, relevant for the purposes of the national procedures of the Office handling the request, or the date of receipt of the request for division by the International Bureau.

220. The Delegation of India proposed to include in Rule 27*bis* a clause stating that the request for division would be transferred to the Contracting Party where it would have effect, so that the Office could decide whether it was irregular or not.

221. The Representative of AROPI came back to the concept of opting out and reminded the reasons why users led AROPI to submit the introduction of division to the Working Group. There was a fundamental principle involved, which was that a user of the Madrid System would not be treated differently than users at the national level. For that reason, the proposal of Switzerland and also the document submitted by the International Bureau always made it clear that introducing division and merger was aimed at setting up a fair treatment between national users and Madrid users, but it was not binding. The Representative clarified that it did not oblige Contracting Parties to introduce a procedure that was not known at the national level. Introducing the system would not be binding for Contracting Parties which did not provide for division in the national law since these Contracting Parties could decide that the provisions would not apply to them.

222. The Secretariat replied first to the question raised by the Delegation of Cuba regarding date of effect and date of receipt. If a designated Office received a request for division, the date of receipt was known by the Office. When the request met the national requirements and the holder had paid the national fee, if applicable, the request for division could be presented to the International Bureau. Once the International Bureau had received the request and verified that it met all the formal requirements, the date of the recording of the division would be the date on which the International Bureau received the request and, on that date of recording, there would be a divisional registration. The Secretariat stated that if it was relevant for Contracting Parties to have an indication in the International Register of the date an Office received the request, that issue could be discussed. The Secretariat maintained that the date of recording of division only applied where a request had met formal requirements. The Secretariat addressed the issues raised by the Delegation of India. As an Office of origin, an Office would never be involved requests. If India was the Office of the Contracting Party of the holder, it would never see a divisional request. Where the Office was designated, the request for division could happen if a partial provisional refusal has been issued and the holder would like to request a division with that Office. The Secretariat clarified that that was the only situation where any divisional requests could be seen by an Office, as a designated Office but never as the Office of origin.

223. The Delegation of India insisted that draft Rule 27*bis*(1) should be clarified, to explicitly specify that the request for division of international registrations shall be filed in the Office of the Contracting Party where it should have effect.

224. The Delegation of Mexico reminded that Mexico did not have division and said that it valued the arguments made during the discussion, which would help its country if, in the future, it decided to consider the introduction of division in its national legislation. The Delegation referred to the simplification benefits in the proposal, but said that it was necessary to keep in mind that the effects of division at the national level were considerable and Mexico had to

assess them to decide whether division would be envisaged with the goal of keeping the registry up to date in the country. To that effect, the norms and standards of national Offices would have to be studied. The Delegation asked whether the holder would have to pay twice for the renewal, or just for the international registration, in the case of a division.

225. The Secretariat explained that, from the date of international registration, the holder would have a ten year protection period. Upon the expiry of such period, the holder could request renewal. The Secretariat clarified that the divisional registration would have to follow the 10-year cycle of an international registration, regardless of when division had been requested; there would not be a 10-year protection period from the date of effect of the division. Renewal would take place upon the expiry of every 10-year period from the date of the international registration; so, it might be that the holder would have a divisional registration and at the renewal time of the international registration, the holder might need to pay renewal fees for two international registrations. The Secretariat returned to the questions on the opt-out clause raised by the Delegation of Sweden, stating that the proposal foresaw the possibility of opting out if a country did not have division. As noted in the listing of issues, there might be countries which did have division at the national level, but still would need to make some changes to the legislation to implement the proposal. In such cases, an option for consideration could be that those countries propose an implementation date in respect of their own situation. The Secretariat said that it would lead to a situation with different dates where particular Contracting Parties could recognize the procedure, but it might offer the necessary flexibility to advance on the proposal because some countries might require some time to implement the proposal.

226. The Delegation of China asked the International Bureau to explain the numbering procedure, if division of the international registration was introduced.

227. The Chair indicated that the answer was in page 5 of the document under discussion, where it was explained that the International Bureau would use capital letters, and that it would take the first available letter; if A was already in use, then B would be the letter used, and if that was in use, then C would be the letter used, and so forth.

228. The Delegation of India stated that in its national Office, when dividing national applications or national registrations, a different number was given as the Office did not have an alphanumeric system. The Delegation asked about the possibility to have a different international registration number because maintaining an alphanumeric system would be a technical problem for India, which would force it to overhaul its systems.

229. The Secretariat replied to the Delegation of India stating that, under the proposal, the request had to go through the designated Office concerned, which would present the request to the International Bureau, and it would only be upon receipt by the International Bureau that the recording would be done and a new number given. The Secretariat recalled that it would be the International Bureau that gave the divisional registration a new number, and referred to the numbering system already in place for the recording of a partial change in ownership, where the same number was used adding a letter, A, B, C, etc. This numbering system already existed for partial change in ownership and the proposal on division would not change that and it would not cause an added burden.

230. The Chair suggested that the Working Group continued with discussions on division and merger of document MM/LD/WG/13/4, and recalled that the Working Group might achieve the objective of giving information to the Secretariat on how to proceed to prepare a document for discussion at the following session. The Chair highlighted the importance of communicating the particular issues of the Offices and wondered about the possibility of a merger of international registrations that did not result in a merger of the designations under the merged international registrations. The Chair opened the floor for comments.

231. The Representative of CEIPI considered the possibility of taking into account legislations that provided for division, but not for merger of international registrations resulting from a division, and suggested dividing Rule 27^{ter} into two: (i) one subparagraph would be on merger of international registrations resulting from a partial change in ownership, in accordance with current provisions; and, (ii) a second subparagraph would deal with merger of international registrations resulting from division of international registrations, because the problem was not the same, even though the solutions should be basically the same. The Representative proposed further to follow the example of the Patent Cooperation Treaty (PCT), where provisions requiring changes in the legislation of members (including amendments to their administrative procedures and their IT systems) often had been adopted in the Regulations. The Representative stated that a long list of cases like these could be found on the WIPO website. The Representative explained that, to achieve harmonization within the PCT, the PCT Assembly had adopted provisions with major flexibilities. For example, if on the date of adoption of a new provision, the provision was not compatible with the national legislation applied by an Office, the provision would not apply to that particular Office as long as it remained incompatible with the national legislation, provided that the Office in question informed the International Bureau within a given time limit. Subsequent to the notification, the International Bureau would publish the information in the Gazette to inform the public. In that type of situation there was no deadline due to the time needed to meet the necessary conditions to change national laws, such as the intervention of Parliament or the difficulties for a new computer system to work properly. The Representative acknowledged that the problem with the approach was the long transitional period, but at least, if the provision was adopted, the Contracting Parties concerned could start up the necessary procedures to adapt their legislation, including administrative and technological practices. Such a solution might also be adopted concerning division itself. The Representative indicated that this approach could solve the concerns expressed by some Delegations that had difficulty in adopting division immediately, even when it existed at the national level.

232. The Secretariat indicated that the proposal by CEIPI was in line with the flexible approach to the implementation date suggested in the previous meeting, and asked for clarification on whether the proposal would replace the opt-out clause or it would be a combination of the two approaches.

233. The Representative of CEIPI drew attention to the fact that the opt-out clause concerning division would be maintained since it was an opt-out clause for countries without division at the national level. The Representative said that it was an additional provision, which would be added concerning countries practicing division at the national level, but which would need changes in their legislation, their practices and their technological systems to adapt for division of international registrations. The Representative suggested proceeding equally for merger to resolve the problems of Contracting Parties such as France, Germany and Sweden.

234. The Chair asked the floor for comments on the proposal made by the Representative of CEIPI, which was to have a very flexible transitional provision combined with an opt-out option, where it was understood that the opt-out option would only be used by Contracting Parties where national laws did not provide for division of national registrations. The Chair asked for comments, including whether such an approach could also work in relation to merger.

235. The Delegation of India supported the idea of having a transitional provision with that maximum flexibility in relation to merger and division. The Delegation said that it should be made clear that the request for merger would proceed in the same way as it has been mentioned explicitly in Rule 21^{bis}.

236. The Delegation of Switzerland supported the proposal made by the Representative of CEIPI, but it said it would like to see concretely what it might mean. The Delegation explained that in Switzerland the principle of division existed, but not that of merger. In the same way, in Swiss national law, there were partial transfers of ownership, but no merger issued from partial transfers. The Delegation said that, nevertheless, the Swiss Office was aware that such merger existed in the Madrid System, and it had never been a problem not to have it at the national level.

237. The Delegation of Germany supported the proposal by the Representative of CEIPI but said that in Germany it was expressly forbidden, under the national law, to merge divided registrations, which was the reason for the preference of the opt-out possibility, as it was in Rule 27*bis*(6). The Delegation said that the biggest problem with division was complexity, especially to find out what the list of goods and services was after divisions. The Delegation proposed, as a solution, to request positive lists specifying the protected goods and services; thus, determining the contents of both the parent and the child registrations.

238. The Delegation of France said that the proposal by the Representative of CEIPI would be an interesting one to look at during the next Working Group session. It would certainly allow replying to certain questions with regard to the legislative changes that would have to be undertaken and the adaptation of the IT tools of national Offices.

239. The Representative of INTA came back to the issue of merger; in particular, whether there should be a possibility to opt-out of merger, based on the fact that this would not exist at the national level, or otherwise. Like the Delegation of Switzerland, the Representative pointed out that merger was a feature of the Madrid System, which existed as far as division resulting from a change of ownership was concerned. As far as the Representative understood, this feature had never been challenged; it had been considered as independent from the national legislation of the Contracting Parties and it should remain that way. The Representative proposed a provision of the sort suggested by the Representative of CEIPI, which would certainly facilitate the transition. That provision should be considered by the Secretariat in preparing a revised proposal, but the principle that merger existed in the international system should be maintained. It did not seem to have posed particular problems up to that moment and, if there were specificities of merger not as a result of a change in ownership but as a result of a division arising of the will of the holder, then such issues should be addressed.

240. The Secretariat said that one option would be to simply describe what the International Bureau would consider to be the consequences of that merger for the designated Contracting Parties and maybe, by looking at it more closely, it could be concluded that in fact there would not be any difference from the current system.

241. The Chair reminded of the list of topics for the next session and explained that the Secretariat should look into the proposal by CEIPI, at least in relation to division, but could also raise the question with respect to merger, with possible solutions or new proposals. The Chair continued with other topics mentioned, such as the provision in Rule 27*bis*(1)(d), introducing a reference to Rule 18*bis*.

242. The Representative of INTA stated that the reference to Rule 18*ter* could remain, because countries which had a post registration opposition system, once the opposition procedure had been completed, should be in a position to issue a Rule 18*ter* notification. On the other hand, Rule 18*bis* should also be referred to because countries with a pre-registration system, which would not be in a position to notify a Rule 18*ter* decision, would be able to make a Rule 18*bis* notification. The other change in paragraph (d) would be the inclusion of the word “may” rather than “shall”; hence, the Representative proposed as a wording: “Any request presented under this paragraph may include a statement in accordance with Rule 18*ter* (1) or Rule 18*bis*(1), for the goods and services listed in the request.”

243. The Chair recalled other topics that were raised during the discussion, such as fees, the opt-out clause, implementation date issues as well as changes to legislation and procedures. The Chair said that the last issue remaining was the one relating to IT but that no Delegation had comments on that issue. Finally, the Chair said that the Secretariat would prepare a new document for the next session of the Working Group and Delegations would have until the end of the year to send written information and comments to the Secretariat to be taken into account before preparing the documents for the next session.

AGENDA ITEM 7: REVIEW OF THE TRANSLATION PRACTICE MANDATED BY THE MADRID UNION ASSEMBLY

244. The Secretariat introduced document MM/LD/WG/13/5 and explained that the recording in the International Register and the publication in the WIPO Gazette of an international registration and of any data recorded and published under the Common Regulations related to an international registration, should be in English, French and Spanish, as a consequence of the trilingual regime under Rule 6(3) of the Common Regulations. The Secretariat recalled that there had been a translation practice in place since the ninth session of the Working Group, which had allowed the International Bureau two exceptions to the trilingual translation; namely, for the list of goods and services in a statement of grant of protection following a provisional refusal, and for those affected by a limitation. The purpose of the document was to review the current translation practice, after a three-year period mandated by the Madrid Union Assembly. More specifically, the document presented background information on the overall translation tasks undertaken by the International Bureau since that issue was last reviewed by the Working Group. The Secretariat clarified that the document described the impact of the translation practice and it reviewed the practice in light of on-going developments in information technology and automated translation. The conclusion in the document was that there would be no longer any need for that particular translation practice, since the International Bureau was able to translate also those previously excluded lists of goods and services by using machine translation and new technology.

245. The Chair opened the floor for comments on the document, in particular, about the considerations in paragraph 38 referring to information in the document and on whether the Working Group agreed with paragraphs 33 to 37 of the document.

246. The Delegation of Luxembourg, speaking on behalf of the European Union and its member states, said that technological solutions, such as Word Server and Tapta4Marks, had enabled WIPO to automatically translate a list of goods and services and statements of grant of protection sent under Rule 18*ter*(2)(ii) of the Common Regulations into all working languages. The European Union and its member states agreed with the actions proposed in paragraphs 32 to 37 of the Working Group document, and urged the International Bureau to make sure translation would be ensured, taking into account budgetary restrictions and to undertake a review of the issue after one year.

247. The Delegation of Japan supported the proposal made by the International Bureau, which would be very user friendly. Additionally, the Delegation expressed hopes that the International Bureau would continue to develop technology enhancing automatic translation.

248. The Delegation of Spain said that, after the three years of implementation of the practice, the International Bureau had succeeded in translating grants of protection under Rule 18*ter*(2)(ii) of the Common Regulations, as well as the lists of goods and services in limitations. The information provided by the document revealed that the results that had been achieved were very encouraging and that the implementation of the technological developments had been positive by reducing the delays in translation over the last three years, with considerable quality. The Delegation further stated that backlog and delays had to be dealt with.

249. The Delegation of France supported the statement made by the European Union and the proposal in the document presented by the International Bureau, and asked the Secretariat for the measures that were being taken by the International Bureau concerning quality control with regard to automatic translation.
250. The Delegation of Kenya agreed with the actions proposed by the International Bureau, as per paragraphs 33 to 37 of the document, and congratulated the International Bureau for being able to clear the backlog according to paragraph 27. The Delegation encouraged the International Bureau to continue in that spirit.
251. The Delegation of Colombia supported the proposal and congratulated the International Bureau for its translation systems, which had helped it to overcome some of the problems of the past. The Delegation further said that it would be important that the International Bureau also serve specific requests and make changes or quality control within appropriate deadlines.
252. The Delegation of Australia supported the deployment of the automatic tools as long as appropriate quality assurance or quality control mechanisms were attained. The proposed action regarding translations was very appropriate and aimed at an efficient use of the International Bureau's finite resources. The Delegation viewed actions that increased the speed and efficiency in the Madrid System as very positive and beneficial to users of the system.
253. The Delegation of China thanked the International Bureau for its efforts and agreed with paragraphs 33 to 37.
254. The Representative of MARQUES expressed overall agreement with the proposed actions and pointed out the importance that, in the future, ROMARIN display documents in the three working languages.
255. The Delegation of Georgia supported the proposal as it eliminated errors made by personnel, decreased time dependency and ensured cost-effectiveness.
256. The Chair invited the Secretariat to respond to questions over quality control.
257. The Secretariat explained that the translation process had changed enormously since 2012. With the introduction of the World Server, World Server2 and the TAPTA technology, the International Bureau now had a huge internal database of translation precedents, which had increased the translation capacity of the International Bureau. Indications that were not already in the database would be translated with the TAPTA technology and reviewed internally or externally. The main task of the internal translators was post translation editing and quality control, with quality control being the priority. The Secretariat then replied to the question from the Representative of MARQUES regarding ROMARIN and indicated that, when all the previous untranslated documents had been translated, ROMARIN would be updated accordingly in the three languages.
258. The Chair raised an additional issue on quality, namely the proposal that there should be a one-year review for quality control.
259. The Secretariat said that the proposal referred to the statement made by the Delegation of Luxembourg on behalf of the European Union and its member states. As the International Bureau understood the request, it meant that Delegations would like to have another review of the translation work, which would result in a document such as the one updating its status. The Secretariat said that if it had correctly understood the request it would do that. Yet, the Secretariat suggested that it could be done on the basis of a three-year cycle since doing it on a one-year cycle would not be too effective, as the developments from one year to another might not be sufficiently significant to warrant a document for the Working Group. Based on a three-year cycle, enough added-value would be created in terms of useful information and that approach would also be consistent with the practice of the International Bureau.

260. The Delegation of Germany stated that they were satisfied in general with the result, and they did not foresee any need for a review, neither in one nor in three years.

261. The Delegation of Switzerland said the question of quality was very important but it did not see that it would be necessary to have a study every year or every three years. If the International Bureau assured that there would be a quality control process done internally or externally, that would be enough and that if mistakes or problems of quality should appear in the future, Delegations could certainly share it with the International Bureau, and then ask for a study.

262. The Representative of MARQUES made two questions in relation with quality control. The first one was whether there existed some kind of procedure for reporting an eventual error in translation to WIPO; the second question referred to which version should prevail in the case of a possible discrepancy between the English, French, and Spanish version of the list of goods and services.

263. The Secretariat stated that the best way to give a response was to describe in more details how the process actually worked. The process was based on two systems, one called World Server, which was a database; the other system was TAPTA, which would be more like Google translate. TAPTA was a statistics-based system that produced a translation. The records in the World Server database were exact translations of terms that had been validated by human beings and had exact matches in a database. The quality control element came in through the validation by the human translator before the record went into the database and, because it had been validated, and assuming that no mistake had been made in the validation, the assurance rate of quality would be extremely high because the system just retranslated the same term exactly in the same way as it had been previously validated. The Secretariat clarified that, however, the World Server database did not cover all the terms that needed to be translated; it translated about 60% of all the terms to be translated. TAPTA would then cover the rest, and for those terms, on the basis of a statistical algorithm similar to Google translate, the system proposed a term based on a statistical analysis of a body of terms. Because those terms obviously had not been validated by a human being, they were submitted to outsourced translation agencies. The Secretariat further explained that an additional global quality check was effected by taking samples of translations throughout the year, whether they were generated from TAPTA or World Server, for which the International Bureau would verify the quality. The Secretariat summarized that there was a combination of machine-assisted translation in World Server, with totally automatic translation in TAPTA and an added layer of quality control for both, which should strike the right balance. Yet, there existed hundreds and thousands of terms and thus mistakes could arise. Occasionally, the International Bureau would receive feedback from Offices but, generally speaking, the system was sound and as more translations would be produced, the size of the World Server database would increase and further improve quality. The Secretariat answered the question regarding errors and the possibility to ask for a correction. Rule 28 dealt with corrections and the International Bureau did receive requests for corrections of translation. Yet, based on data analysis for 2014, they did not attain 3% of all corrections.

264. The Chair stated that there was one last question raised by MARQUES, namely, which language version would be the one to use if there were an error in one of the translations.

265. The Secretariat said that, in principle, the language which should prevail would be that of the international application under Rule 6 of the Common Regulations. That was also a guiding principle adopted three years earlier, upon proposal of a practice for translations to guarantee the integrity of the Register.

266. The Representative of AIM supported the proposal and the position of the Delegation of Switzerland, namely that it was not necessary to undertake a review in one year, yet should any issue arise, a proposal for review in the future could be considered again.

267. The Chair summarized the discussions stating that there existed agreement with the actions proposed in paragraphs 33 to 37 of the document. On the matter of quality, after the information provided by the Secretariat, it had been concluded that in the future Delegations could raise eventual issues, or even the Secretariat on its own motion could do so, should that be the case.

AGENDA ITEM 8: USER SURVEY ON MADRID DEPENDENCY PRINCIPLE ISSUES

268. Discussions were based on document MM/LD/WG/13/6.

269. The Secretariat introduced the document and recalled that the topic had been first discussed in the previous session of the Working Group, which had requested the International Bureau to conduct a survey of users of the Madrid System on the dependency principle and related issues.

270. The Secretariat noted that the objective of the survey was to consult stakeholders and obtain their opinions, so that the Working Group could make an informed decision on the future of dependency. The Secretariat remarked that the dependency principle affected users, so it was of vital importance to know more of their views on that issue. The Secretariat reported that the International Bureau conducted an online anonymous survey from May 18 to June 7 of that year. The sample included 1,331 users of the Madrid System who answered the entire questionnaire and who were, almost entirely, holders of international registrations or their representatives. The Secretariat recalled that the survey had achieved its objectives and that it had been possible to gather the opinion of a large and highly representative sample of users of the Madrid System. The Secretariat cited information provided in the document under discussion, underlining the seven following findings:

- (1) Cancellations of international registrations due to the ceasing of effect of the basic mark were not for the most part result of a central attack.
- (2) A significant number of users questioned the fairness of dependency and considered that it lowered the value of the Madrid System.
- (3) A majority of users did not view dependency as an advantage of the Madrid System.
- (4) A majority of users were in favor of either abolishing or restricting dependency.
- (5) A strong majority of users indicated that if dependency was abolished or restricted, they would be equally or more inclined to use the Madrid System
- (6) The use of the Madrid System to protect trademarks in a script other than the script used in the country of origin was an issue that affected users worldwide.
- (7) A large majority of users did not have an opinion on transformation, a procedure seldom employed and viewed by some users as expensive and difficult.

271. The Chair invited the Delegations to comment on paragraph 47 of the document, to provide guidance to the International Bureau on possible further actions, including a recommendation to the Madrid Union Assembly to suspend the operation of Articles 6(2), (3) and (4) of the Madrid Agreement and Protocol, as proposed in document MM/LD/WG/12/4 or in a modified form.

272. The Delegation of Luxembourg, speaking on behalf of the European Union and its member states, supported further discussion on the issue.

273. The Delegation of Madagascar recalled that, in light of the information presented in the document, it could only be noted that many users would like to suspend or abolish dependency and would be more inclined to use the system without that particular feature, while others would

be ready to continue to use it. The Delegation expressed concerns about the fact that dependency frightened small users from Madagascar due to the costs required for safe commercial use of the mark outside the country. The Delegation maintained its position of the previous year, supporting suspension of the principle of dependency while preserving the major role played by national Offices and the need for a basic mark which, as well as the conformity of the international registration, all of which provided legal security to the Madrid System.

274. The Delegation of Norway considered that the answers from users were clear, and agreed with users declaring its support for the proposal to either abolish or restrict dependency.

275. The Delegation of Japan remarked that, as seen in the report, dependency was complicated, risky and unreasonable for most of Madrid users and it was one of the obstacles for using the Madrid System. The Delegation noted that there were several issues to discuss about the proposed freeze but that it supported the approach of abolishing, restricting and suspending the dependency principle, giving three reasons: firstly, it would lead to the legal stability of international registrations and would encourage the use of the Madrid System by potential users; secondly, the abolishment of dependency would lead to the reduction of workload of both the national Offices and the International Bureau; and, finally, it would also contribute to encourage new accessions to the Madrid System.

276. The Delegation of Israel considered dependency as a disadvantage of the Madrid System and proposed a freezing of dependency period that would be necessary to examine whether there was an increase in the use of Madrid System due to that freezing.

277. The Delegation of Italy thanked the Representative of MARQUES for its contribution to the survey and noted that the survey seemed one-way oriented. The Delegation noted that the questionnaire drafted by the Secretariat and posted on the Madrid System legal forum for comments had shown a wide participation of users, trademark holders and representatives, whose country of origin was Italy, as shown in Table I. The Delegation added that, in finding number 1, dealing with the ceasing of effect of the basic mark that was not a result of a central attack, only 8% of the international registrations were affected by the recording of a partial or total cancellation due to the ceasing of effect of the basic mark. The Delegation stated that cancellations due to the ceasing of effect based on absolute grounds in the country of origin were only 27%. The Delegation further stated that, in 2015, in Italy only seven international trademarks had been cancelled due to *ex officio* examination, as compared to about 1,900 international applications that the Italian Office had sent to WIPO so far. The Delegation, referred to finding number 2 of the document, where a significant number of users questioned the fairness of dependency and considered that it lowered the value of the Madrid System. When comparing finding number 2 with finding number 4, a majority of users did not view dependency as an advantage of the Madrid System. The Delegation added that it had a comment regarding Annex I, page 5 of the document, and explained that the table on the general perception of the effects of dependency of the Madrid System showed that the percentage of no options was 17 %; no answer was 7%; a disadvantage was 35%, and both was 23 %. The Delegation stated that that was 82%, so it could not be affirmed that the users had a clear idea of the advantages and disadvantages of that modification in the system. With regard to finding number 3, about central attack as a mere incentive to bring holders of international registration into negotiation, the document stated: "Users indicated that in none of the cases of the threat of central attack it actually materialized, either because there were no grounds on which to initiate a central attack, or because matters were settled amicably." It could thus neither be affirmed that dependency caused trouble nor that users had a very clear idea about the change that was being proposed. The Delegation warned that eliminating the dependency period could be a first step toward the elimination of the basic mark requirement and recalled a proposal analyzing that issue which had been discussed in 2008. At that time, the Delegation recommended strong caution as that principle was a fundamental element of the System. The Delegation stressed that many other Delegations did not support the proposal on that occasion either and proposed to consider the introduction of greater flexibility in the Madrid System to make it more attractive and user friendly but reiterated their opposition to eliminate

the requirement of a basic trademark in the country of origin. With regard to findings number 5 and 6, the Delegation stated that it could favorably consider the reduction of the dependency period from five to three years.

278. The Delegation of the United States of America stated that, at that point, it was not prepared to move forward to a singular discussion about freezing of dependency. The Delegation referred to finding number 5, where a majority of users were in favor of either abolishing or restricting dependency, while in the survey, in Annex II, page 2, question 19, it was indicated that users were asked about a number of options, freezing of dependency being one of those options. The Delegation noted that only 6% of users supported freezing dependency, while 30% supported not changing it at all, 29% supported abolishing it completely, 21% supported reducing the term to less than five years, and 13% preferred to restrict it, so that it would be applicable only in certain cases, such as a bad faith filing. These numbers did not support any particular path forward but, in particular, did not support freezing of dependency. The Delegation stated that the content of the survey was too narrowly focused and did not fully consider all of the options; for example, the ways to make transformation more attractive, and whether those or other changes could close the gap between the different positions. The Delegation further suggested that more work needed to be done to find an effective and universally agreeable solution. Therefore, the Delegation supported a broader discussion of all of the options.

279. The Delegation of Switzerland said the results of the survey could be interpreted as being not so favorable to the elimination of the dependency principle. Furthermore, dependency was a fundamental element of the Madrid System and it would be impossible to look at the problems caused by dependency before actually questioning it; for instance, whether there was agreement between the basic mark and international registration or the length of dependency. The Delegation pointed out that it was necessary to study all of those problems, identify them and to find a less radical solution than abolishing dependency. The Delegation summarized its position saying that it was not in favor of suspending dependency but that it was willing to discuss introducing some flexibility to the system, if necessary.

280. The Delegation of New Zealand indicated that dependency was not seen as strength of the Madrid System and considered that freezing dependency would be a positive development for the Madrid System.

281. The Delegation of Australia encouraged Madrid members to consider carefully the findings of the survey, as well as the potential positive effects of freezing dependency. The Delegation indicated that some of the user views elicited by the survey echoed the views expressed by Australian users who were surveyed in-depth in 2007. The Delegation said that there had been an accelerated geographic expansion of the Madrid System in recent years, in keeping pace with the increasing globalization of markets, that geographic expansion should create greater flexibility for business in targeting markets with respect to particular goods and services. However, the Delegation noticed that in many of the export markets of choice for expansion, businesses operated in a language that was not in Latin characters and users sought to protect their brands in those territories in specific scripts. Dependency on a basic mark in the home country meant that users should file a mark in the country of origin in a foreign script and that mark would unlikely be used in the home country because it would not communicate the desired message to national consumers. Apart from being vulnerable to strategic non-use action, there was an unnecessary duplication as well as an expensive exercise for trademark owners. The Delegation added that businesses should not have to maintain two trademarks in the Register, and indicated that that was an issue for all Madrid members. The Delegation supported the freeze of the requirement for dependency, as it would open up the Madrid System for a wider range of users who would be able to take advantage of the increasing geographic coverage in a more secure and flexible way.

282. The Delegation of Germany admitted it was disappointed with the document, since it was really a one-sided interpretation of the survey and did not reflect the outcome of the survey properly. As the Delegation of the United States of America had pointed out, there were only 7% of users in favor of freezing dependency. The Delegation added that such a fundamental change should not be based on a survey of 1,300 users, which was not representative enough. The Delegation evoked the statement of the Director General of WIPO that there were over 500,000 holders of international registrations and insisted that there were also user groups who did not support the freezing. In finding number 5, it was written that a majority of users were in favor of either abolishing or restricting dependency and the Delegation noted that about one third (32%) wanted to keep dependency, 33% wanted to restrict it, and 29% desired to have it abolished, while 6% were in favor of suspending it. The Delegation further remarked that this meant about one third of the users were in favor of each of the main options, which did not offer a clear majority. The Delegation said a fundamental change in the system should be done by a diplomatic conference and specified that German users would use central attack quite often and that, reading through the comments in the survey, it could be seen that there were some examples of small and medium enterprises for which central attack was a suitable weapon *vis-à-vis* big industry. The Delegation concluded that the survey gave no basis for freezing or abolishing the dependency clause.

283. The Delegation of France said the principle of dependency was important for its users and an essential feature of the Madrid System. The position of users was, therefore, essential but they were still divided about the advantages and disadvantages of dependency. The Delegation reflected on the survey, saying that 35% of the users who answered considered that the dependency principle was a drawback; 32% were in favor of freezing or abolishing the principle; whereas, 23% wanted to maintain it. According to those results, the Delegation considered that it was not possible to conclude that a majority of users desired that the principle of dependency be abolished. The Delegation echoed the view of the Delegation of Germany, that the survey did not provide a necessary result in favor of freezing dependency. The Delegation explained that the French Office had carried out a survey among its users and the latter said that central attack was an important negotiating tool in managing their basic marks, and that dependency meant that they could centralize conflicts for a five year period. As French users were against freezing dependency, the Delegation therefore did not support that notion either.

284. The Delegation of Hungary associated itself with the interventions made by the Delegations of France, Germany, Italy, Switzerland, and the United States of America, in sharing the concerns about the clarity of the conclusions from the survey, as they did not seem to immediately support the necessity of the freeze. The Delegation stated that Hungarian users did not see dependency as a disadvantage but as a possible defense mechanism. The Delegation did not support the freeze of dependency provisions but, like the Delegations of Switzerland and the United States of America, it was flexible to explore other options to address specific problems identified and support a broader discussion of the issue.

285. The Delegation of the Republic of Korea expressed its support for any change that would make the system simpler, more user-friendly and attractive. The Delegation reminded that, under the Madrid 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. However, the Delegation of the Republic of Korea strongly supported the proposal because some users refrained from using the Madrid System, since the Korean Intellectual Property Office kept up 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 Delegation said that the fate of the international registration depending on the decision of national examiners could be unfair for users in many cases because, even though requirements for trademark registration were different in each country, the result would be the same. Transformation would be inefficient as compared to freezing dependency, since it would need an additional procedure as well as hiring a local representative, which was a burden on small enterprises. The Delegation went on to declare

that freezing dependency could increase legal certainty for users, who would not have to worry about eventual problems with basic applications. It would also simplify the Madrid System for users, for national Offices and for the International Bureau, since freezing dependency would help increase the use of the Madrid System by Korean users, the Republic of Korea strongly supported the proposal.

286. The Delegation of Colombia noted that cancelling international registrations due to the ceasing of effect of the basic mark was not usually the consequence of a central attack, as that was only 8% of such occurrences. However, even if dependency was not attractive to some users of the Madrid System, the Delegation had concerns about the impact of freezing, such an important feature of the system; mainly, the risk of self-designation and other problems even if the basic mark were eliminated. For those reasons, the Delegation insisted on continuing discussions more broadly on the theme and exploring the possibility of increasing the flexibility of the Madrid System, on the basis of additional information.

287. The Delegation of the Czech Republic said that it was unsure about abolishing the principle of dependency as such, for reasons that were already mentioned by preceding Delegations. The Delegation considered that it was necessary to reflect upon the problems that it might cause; particularly, those concerning the renewal of the basic mark. The Delegation supported the idea of simplifying transformation, which often was quite expensive, costly for users and complicated. The Delegation referred to the ceasing of effect of the basic mark for absolute grounds, which could be obvious for Offices of origin but not necessarily so for designated Offices. Yet, the Delegation had doubts whether the principle of dependency could be limited in such cases or in cases of bad faith filings as well.

288. The Delegation of Spain expressed interest in the necessary changes to make the Madrid System simple and attractive. However, the Delegation considered that the principle of dependency provided a balance between the interests of holders and those of third parties by having a centralized mechanism to enforce prior rights. The Delegation disagreed with abolishing or suspending the principle of dependency but said that it would not be opposed to consider other alternatives.

289. The Delegation of Austria declared that it was concerned about the findings in the document as expressed by previous speakers, especially Germany, Italy, Switzerland and France. The Delegation did not support a recommendation to suspend the operation of Article 6(2), (3) and (4) of the Madrid Agreement and Protocol, as proposed. The Delegation considered that the temporary freezing of dependency would create legal uncertainty and, therefore, was not a suitable option. The Delegation stated that the Austrian Office had developed the experience that central attack was used in Austria, helping to reduce the number of administrative procedures. Therefore, the basic concept of dependency was considered to be of value. Nevertheless, the Delegation was aware of the wish of some users to discuss a limitation of the dependency period or of a limitation of the effects of dependency to special cases. The Delegation said it was open to work on a user-friendly system but that it would prefer to find sustainable and legally certain solutions, even if that would imply to go to a diplomatic conference.

290. The Delegation of Cuba said that Delegations should have indicated survey criteria to the International Bureau and elaborated on the results of the survey. The Delegation stated that the sample was not relevant; although 11% of users corresponded to the United States of America (121 users), considering that in the United States of America there had been 6,595 applications in 2013, they represented 0.01% of users of the Madrid System in that country. The total number of Asian users, 122, was 0.09% of the users participating in the survey, considering the country of origin. The 30 countries of origin that represent the surveyed users constituted 31% of the total members who belonged to the Madrid System (96); there were 19 representatives that belonged to the group of 20 main countries of origin in 2013, and the rest of the users belonged to other 11 countries. The Delegation added that the survey period was too short and that the internet was an expeditious mechanism but not for all Members of the System. From a

total of 96 Contracting Parties of the system, 66 did not have any representation in the survey and the survey contained no indications about the size of the participating users, which would have been very important given that for the SMEs the system of dependency could be extremely useful, as it meant savings when their rights were affected. The Delegation went on to state that, considering the survey by regions, Europe was drawn to its attention since, in the list by country of origin, there were 613 of the users surveyed for that region; adding up the users from France, Germany, Italy and Spain totaled 318 users, which was 52% of the total of Europeans users. The Delegation doubted that those users would be against the dependency principle, since those users belonged to the countries that had stated they were in favor of that principle and considered that this issue had to be studied more in depth. The Delegation added that 1,146 of the users that replied were representatives, namely 86% of the total of users surveyed. The Delegation indicated that representatives were duly aware of technical issues; thus, the Delegation expressed doubts on the accuracy of the findings for Europe. The Delegation recalled that several Delegations had noted the necessity to analyze deeply this issue because of the concerns of users from European countries. The Delegation noted that the number of central attack cases was irrelevant and that in the statistics collected by WIPO in 2004, only 0.7% of cancellations related to central attack. The Delegation opposed abolishing dependency because it would undermine the foundations of the Madrid System, as well as eventually the basic mark requirement, which was at the basis of the international extension of the protection of a national registration. As other Delegations, the Delegation of Cuba might agree that, after an in-depth analysis, a restriction of dependency could be considered, as long as Offices of origin had the possibility of notifying *ex officio* ceasing of effect; thus, guaranteeing correspondence between the basic mark and the international registration while limiting dependency.

291. The Delegation of Kenya stated that it did not have the mandate to consider what was being requested on abolition or freezing. The Delegation stated that the survey was not holistic and that most of the users were mostly from developed countries. The Delegation expressed concern on SMEs, especially from developing countries, which used central attack. This fact was not properly captured in the survey. Looking at finding number 6, in paragraph 29, the Delegation said that dependency was not the main reason why some of the users choose the Madrid System, as they indicated that two or more valuable features of the Madrid System upon which they based their decisions, were centralized filing and centralized management. The Delegation said the Working Group should consider the rationale behind the dependency clause and stated that central attack was not being used; thus, it did not seem necessary to think of abolishing or freezing dependency. The Delegation further stated that there should be more discussions on dependency and opposed the proposed freeze of the dependency clause.

292. The Delegation of China stated that transformation was used in China; however, it complicated the system, therefore the Delegation endorsed the proposal of provisionally freezing dependency and the further evaluation of such freezing.

293. The Delegation of Mexico reflected that a survey was always going to be subject to the type of variables related to the different views of users surveyed. The Delegation endorsed the proposal of suspending dependency, which it believed was positive because the effects of the international registration were based on the fact that there would be protection in the designated Contracting Parties. The Delegation expressed his view that the Madrid System should evolve; thus, it could be positive to suspend the principle of dependency and, at a later stage, analyze the different legal effects on Contracting Parties of such freeze.

294. The Delegation of Ghana stated that it was not in a position to agree with the abolition and freezing of the dependency. The Delegation stated that an analysis of the survey suggested that a broader discussion of the issue at stake was necessary.

295. The Delegation of Australia noted that, as indicated in document MM/LD/WG/12/4, any decision to freeze or suspend the operation of dependency would be reversible and could be limited to a given period. Drawing on the views expressed by the Delegations of China and

Mexico, the Delegation stated that, after the expiry of that period, the effects of the freezing could be evaluated and a decision taken as to whether to continue to suspend the operation of the relevant provisions. The Delegation further stated that the Working Group should consider freezing dependency during a period long enough to gather meaningful data about its effects, whether positive or negative. The trial period would also need to be of sufficient duration to inspire confidence in users, who were currently discouraged from using the Madrid System due to the risk of central attack. The Delegation expressed interest in the views of other members on the possibility of such a trial period and its duration and proposed that a period of five years, at least, would be necessary to properly gauge the effect of the freeze. Any international application filed during the trial period would not ever become liable to dependency, thus enabling businesses to be confident to file international applications, even late into the five-year trial period.

296. The Representative of JPAA supported that the provisions concerning central attack should be restricted or abolished. According to JPAA's prior research of more than 50 major Japanese companies, it appeared that most companies were against the principle of central attack. If central attack was abolished or restricted, it could be reasonably expected that the number of Japanese users of the Madrid System would increase. The Representative asked that the views of Japanese users on the issue be considered.

297. The Representative of AIPPI upheld AIPPI's official position with regard to the cancellation or the elimination of the dependency principle and the basic trademark, although the latter was not the subject of debate. AIPPI was not in favor of freezing or eliminating dependency. Dependency had been criticized, in that its effects could affect countries where the reason for cancellation would not apply; yet, dependency provided a good balance between those who were holders of marks and third parties, offering the latter a centralized mechanism to ensure that prior rights would be respected. The Representative of AIPPI proposed keeping dependency but, perhaps, reducing it from five to three years, as that would provide a better balance between the interests of holders of the marks and third parties. Third parties would continue to enjoy a centralized mechanism to attack and ensure that their rights had been respected, whereas for holders a shorter period of uncertainty with regard to their marks would apply.

298. The Chair stated that there was no consensus on freezing the dependency principle and indicated that the Secretariat had a proposal for how to move forward.

299. The Secretariat thanked all the Delegations for their interventions and feedback. The Secretariat stated that all the Delegations were in favor of allowing the system to develop, so as to become more useful, and that this was linked to what the Director General had said at the beginning of the session; namely, that it was very important to think about how the system should develop in the future, so that it remained responsive to the needs of the users. The Secretariat further stated that the real question would be how that could be done and what could be made to progress in that direction and at what pace. The Secretariat said that there was a specific proposal on how to do that, a proposal to freeze dependency; yet, there was a wide variety of views and no consensus. The Secretariat added that freezing of dependency was not the only way to make the system evolve; it would be possible to introduce more flexibility in the system by working on some of its features, namely the mark itself, the lists of goods and services, the holder and dependency. The Secretariat indicated that one way forward could be to explore possibilities for making the system more flexible with respect to those features, without, at all, putting in question the basic mark; it could be possible to explore options along those lines, solving real and practical problems without necessarily having to deal with some fundamental features of the system or change them radically. The Secretariat said that the International Bureau, if so requested, could draft a document for the next session of the Working Group, where it would explore more broadly the responsible introduction of flexibility, as a fruitful ground for advancing in the future.

300. The Chair summarized the proposal from the Secretariat on a request to explore more broadly how more flexibility could be introduced in the system. The Chair indicated that certain Delegations had expressed their interest in more flexibility and opened the floor for comments on the proposal from the Secretariat, to be requested to prepare an analysis on how to introduce additional flexibility in relation to the sign, to the list of goods and services, to the holder and perhaps also to dependency.

301. The Delegation of Japan supported the proposal made by the Secretariat to be requested to prepare a new document for the next session, and asked the Secretariat what kind of flexibility could be considered at that stage.

302. The Representative of INTA indicated that the Working Group might need to look more at the future of the Madrid System and how it envisaged the system to evolve. The Representative noted that the next year would be the 125th anniversary of the Madrid Agreement and the 20th anniversary of the entry into operation of the Madrid Protocol, which would be a particularly good occasion to start that forward thinking. The Representative suggested a seminar or forum in which all the different actors could brain-storm, in an informal way, on how they visualized possibilities for evolution. The Representative pointed out that it would not exclude the proposal of the Secretariat but that, at the same time, it might be even more fruitful to have that sort of reflection or brain-storming in a more informal manner than a formal meeting of the Working Group.

303. The Secretariat answered the question about flexibility of the system raised by Japan, by giving examples; the first one would be the question of Latin or non-Latin script, namely, trying to find a way of allowing a non-Latin character version of the mark to proceed through the system. Another example could be the de-coupling of the scope of the list of goods and services from the basic mark. If, for instance, where the international application was based on a national where there was a high requirement of specificity, the scope of the basic mark might be reduce during its examination by the Office of origin; whereas, in the designated Contracting Parties, the broader list could be perfectly acceptable. The Secretariat wondered whether it would be beneficial for the system to maintain the broader lists. Another way forward could be to analyze a narrowing of the grounds for cancelling international registrations. The Secretariat said these were some examples of trying to make the system more useful while not damaging it and still respecting the fundamental features, following the declarations of Delegations that had hesitations as to the convenience of abolishing or changing fundamental features of the system.

304. The Delegation of Japan thanked the Secretariat and offered help to contribute to a further analysis of the issues at stake.

305. The Chair informed that Delegations would have the possibility, until the end of the year, to provide the Secretariat with comments or issues to be taken into account for preparation of the new document.

306. The Delegation of Japan reiterated its intention to cooperate and contribute to the exercise but stated that it would be difficult to send contributions within the year because it had just started its research, which would be finalized early next year.

307. The Secretariat expressed that it could be quite flexible about receiving contributions; the Secretariat could write a document, for the next session of the Working Group, and contributions made by any Delegation that was received on time would be introduced in the document. The Secretariat added that the document for the next session of the Working Group would not be a final document; accordingly, there would be plenty of opportunities for Delegations to contribute to the end result.

308. The Delegation of Switzerland supported the idea of further reflecting about the future of the system, taking into account a number of needs that had been voiced by Delegations, on the occasion of the anniversary of the Madrid System. The Delegation suggested that it was necessary to keep in mind the elements that gave rise to the study on dependency. The Delegation expressed readiness to participate in the exercise and offered to send contributions within a timeframe that would enable the Secretariat to take them into account.

309. The Chair concluded that there was no consensus on freezing the dependency principle, but that the Working Group had agreed to look into that issue further, as well as to give the Secretariat the mandate to prepare a document, for its next session, that would explore other routes to achieve more flexibility in the system; in particular, in relation to the sign, the list of goods and services, the holder and dependency. All Delegations would have the opportunity to provide contributions, preferably before the end of the year, although the Secretariat would also take into account information that would arrive at a later stage.

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

310. Discussions were based on new drafts for Rules 12, 25 and 26 (document MM/LD/WG/13/2).

311. The Chair said that, regarding the document on the proposed amendments to the Common Regulations, the Working Group agreed that the Secretariat prepare a document on limitations for the next meeting. When that document was discussed, it would also consider agenda item 10 in relation to the implementation of Rule 24(5), where it was agreed to recommend that the International Bureau suspended its implementation. It was also agreed to request that the Secretariat prepare a new document on replacement for the next session. The Chair reminded that discussion was pending on the rules relating to limitations and to changes in the legal nature of the holder.

312. The Secretariat introduced the document recalling that Rule 12(8)*bis* would apply to the examination of limitations, as discussed earlier. The Secretariat then elaborated on requests for limitations in international registrations, and proposed a new paragraph (2)(d) in Rule 25, following what the Representative of INTA had suggested concerning the contents of the request. The proposal was as follows: "The request for the recording of a limitation shall group the limited goods and services under the corresponding numbers of the classes of the international classification of goods and services, appearing in the international registration, or where the limitation affects all the goods and services in one or more of those classes, indicate this fact." The Secretariat added that Rule 26 would specify the exact level of examination the International Bureau would undertake in relation to such requests; proposed Rule 26, paragraph (1), would read as follows: "If a request under Rule 25(1) (a) does not comply with the applicable requirements and subject to paragraph (3), the International Bureau shall notify that fact to the holder and if the request was made by an office, to that Office. For the purposes of this Rule, where the request is for the recording of a limitation, the International Bureau shall only examine whether the numbers of the classes indicated in the limitation appear in the international registration concerned."

313. The Delegation of Germany stated that it was clear in Rule 26(1) what the International Bureau was examining but the Delegation stated that Rule 25 would need further clarification. The Delegation said that, following the proposal made by the Representative of INTA, the request for the recording of a limitation of the list of goods and services might only contain the indications of classes of the list of goods and services of the international registration before the limitation. The Delegation considered that the proposal regulated how to group goods and services, rather than stipulating that the limitation should not contain more classes than the original list of goods and services.

314. The Secretariat replied that, by introducing the obligation for the holder to group the goods and services according to the classes, it would also give the International Bureau an obligation or a possibility to raise an irregularity. The Secretariat explained that the Delegation of Germany was referring to the fact that the holder, when presenting a limitation, should use the same class numbers as he did in the main list, which was meant to be captured by the word “corresponding” in the proposed wording.

315. The Delegation of France said that the second part of the sentence of Rule 25(2)(d), when it said: “when the limitation affects all of the goods and services in one or more of those classes, indicate this fact”, was not clear. The Delegation asked if what was indicated was that there would be a complete elimination of a class or whether this referred to the case where the limitation affects several classes.

316. The Secretariat said that the wording was meant to cover the situation where the holder wanted to delete a whole class.

317. The Delegation of France replied that, in that case, it would be advisable to draft the provision in a slightly more understandable way.

318. The Chair read the new proposal of second part Rule 25(2)(d), “[...] or, where the limitation deletes all the goods and services in one or more of those classes, indicate this fact”.

319. The Delegation of France stated that the proposed wording was clearer.

320. The Delegation of Kenya asked for clarification, about who should group the limited goods and services in the request for the recording of a limitation.

321. The Chair explained the wording referred to the request, and the request was for the holder to make.

322. The Delegation of Germany communicated that it had issues with the expression “to group”, since the rule only mentioned how to group classes but it did not mention that it was not allowed to add new classes in a request for limitation.

323. The Delegation of Switzerland made a counter proposal; in English, the wording would be “when this affects all the goods and services in one or more of those classes, indicate the classes to be deleted”, and, in French “when this affects all or more than one, or several classes, indicate the classes which need to be deleted, or eliminated.” The Delegation expressed that it would like that the rule clarified that it was the classes that had to be dropped or eliminated.

324. The Chair read the proposal again, “or, where the limitation affects all the goods and services in one or more of those classes, indicate the classes to be deleted”.

325. The Delegation of France expressed agreement with the proposal.

326. The Chair said that, regarding the question raised by the Delegation of Germany, the Secretariat had tried to make things clearer in the text by inserting the word “only”, so the text would read from the top “The request for the recording of a limitation shall group the limited goods and services only under the corresponding numbers of the classes of the international classification of goods and services appearing in the international registration.” The Chair stated that the work on Rule 25(2)(d) was concluded and proposed to continue with the discussion on Rule 26(1).

327. The Delegation of Germany stated that paragraph 27 in the document had not yet been discussed, namely the date of entry into force of Rules 12 and 26. The Delegation reminded that the Secretariat proposed April 1, 2017. The Delegation stated that Germany would have problems with that date, as the Office would have to adapt its systems, and proposed as a date of entry into force July 1, 2017.

328. The Chair suggested to discuss paragraph 27, concerning the date of entry into force, after dealing with the provision regarding the legal nature of the holder and opened the floor for comments on Rule 25(1)(iv).

329. The Delegation of the United States of America expressed concerns about the likelihood of holders inadvertently filing changes of ownership, through form MM9, and, particularly, about the implications of that in jurisdictions where recording of assignments was required. The Delegation noted that it was aware that the fee structure would make it less expensive to submit the information via form MM9, than to file a change of ownership via form MM5. The Delegation said that the proposal could increase the litigation risk for foreign holders that had extended their protection to the United States of America. The Delegation conveyed that the discussions during the sessions and the off-line discussions with the Representatives of APRAM, CEIPI and INTA, demonstrated that the legal implications of that proposal were not sufficiently clear for the group to move forward with it. Therefore, the Delegation of the United States America proposed again a study on the relevant national practices, so that the Working Group would be fully informed as to the legal implications of the proposal before moving forward.

330. The Representative of APRAM and INTA said he would like to stress that, if further investigation had to be made by the International Bureau, it should not be focused only on local practices but, rather, on the application of international private law, analyzing the question of whether a change in form of incorporation was a change in legal personality under international private law.

331. The Chair said that, after taking note of the reservations and the concerns that the Delegation of the United States of America had in relation to Rule 25(1)(iv), there seemed to be consensus on the provision.

332. The Delegation of Switzerland objected to the conclusion that the change was approved as it stood. The Delegation stated that in the French version a word was missing to clarify that a recording was at stake, and that it would be necessary to include a reference to a change in the name or address of the holder, or where the holder is a legal entity, the inscription of the request or of changes in indications concerning the legal nature, or a wording to that effect.

333. The Chair repeated the proposal made by Switzerland for Rule 25(1)(iv): "A change in the name or address of the holder or, where the holder was a legal entity, the recording of or the change to the indications concerning the legal nature of the holder"; the proposal would also include a deletion of the last part of the provision, namely the last four words, "or a change thereto", that would become superfluous.

334. The Delegation of Cuba made a reservation on the issue of the change in the legal nature of the holder, as it might have legal implications in Cuba since, upon substantive examination, if the legal nature was not the right one, the mark would be refused in Cuba.

335. The Chair stated that the proposal from Switzerland was accepted and opened the floor for comments on Rule 26(2).

336. The Representative of CEIPI indicated that the whole text was underlined but that there were very few, if any, changes to the existing text. The Representative asked the Secretariat to draw the attention to the changes for the Rule being discussed as well as for Rule 27(1), which would be discussed later.

337. The Secretariat proceeded to indicate the changes; in Rule 26(2), the only change was a reference to Rule 25(1)(a), which substituted the deletion of, “for the recording of a change or the request for a recording of a cancellation”. In Rule 27, the Secretariat had shortened the title; the old proposal was “recording and notification; merger of international registrations; declaration where change in ownership or limitation has no effect.” In the new proposal, it became “recording and notification”. Rule 27(1) (a) would read “The International Bureau shall, provided that the request referred to in Rule 25(1)(a) was in order, promptly record the indications, changes, or the cancellation in the International Register, shall notify accordingly the Offices of the designated Contracting Parties in which the recording has effect, or in the case of a cancellation the Offices of all the designated Contracting Parties [...]”. The rest of the text remained unchanged. Rule 27(1)(b) would include indications, in plural, for changes in the first line.

338. The Delegation of Switzerland said that, once the title of Rule 26 had been changed, “Irregularities” seemed too vague, and a reference to Rule 25 should be included for the sake of precision.

339. The Chair proposed the following title: “Irregularities in requests for recordings under Rule 25” and moved forward to Rule 27 for comments.

340. The Delegation of Switzerland said that in English “indications” had been added, as well as “changes, or the cancellation”; the first two were in the plural but in French “indications” were in plural but “change” in the singular. The Delegation suggested changing to plural in the French version.

341. The Representative of CEIPI asked why “change”, which was in singular before had been changed to plural; obviously, there were different types of changes that could be made, but, in principle, only one could be done at a time. Perhaps, the singular could be kept in French and the English version could be modified to “the change”; that would apply to both paragraph (1)(a) and (b). The Representative considered the word “recording” to be too vague.

342. The Secretariat accepted the proposal made by the Representative of CEIPI, and stated that it should be “indications”, “change”, in singular, and “cancellation”, both in paragraph (1) and subparagraph (b).

343. The Representative of CEIPI proposed that the wording should be “the indications, the change or the cancellation.”

344. The Chair concluded that the changes had been approved and moved to Rule 32, where some consequential amendments had been made, to read “Recordings under Rule 27”, with the deletion of “changes in ownership, limitations, renunciations and changes of name or address of the holder recorded.”

345. The Delegation of Switzerland said the title of Rule 27 was too vague. The Delegation suggested “Recording and notification of requests made under Rule 25”.

346. The Chair proposed the following title to Rule 27: “Recording and notification with respect to Rule 25”.

347. The Representative of CEIPI proposed the following title to Rule 27 “Recording and notification following requests under Rule 25”, although the Representative considered that the proposed wording was equivalent.

348. The Secretariat explained the proposed fee for the recording or change in the indications concerning the legal nature of the holder; the existing amount of 150 Swiss francs was proposed.

349. The Delegation of Switzerland proposed that the text should read: “Change in the name and/or address of the holder, and/or where the holder was a legal entity recording of, or change in the indications concerning the legal nature [...]”, and then delete “where the holder is a legal entity.”

350. The Representative of APRAM noted that in the English text it was written and/or, whereas in the French and Spanish version, respectively, “o” or “ou” were included, instead of “and/or”.

351. The Secretariat stated that both the French and the Spanish wordings were correct, unless the French-speaking Delegations wanted to state otherwise. In Spanish, “or” as a conjunction, could also be used as inclusive; it implied the possibility of an option or of an inclusion, or both, it was not like in English, where you had to say and/or, whereas in French the same would apply.

352. The Delegation of Switzerland stated that it had had similar discussions in the Committee of Experts of the Nice Union, where and/or in English was usually translated as “ou” in French. The Delegation stated that in English the title of item 7 was “Miscellaneous recordings” and in French only “*modification*” while “*inscriptions diverses*” would be more accurate.

353. The Chair stated that the heading was not changed by the proposal, but the proposed heading could be included in the French version of the text.

354. The Chair stated that the Working Group had agreed to:

(i) recommend that amendments to Rules 12, 25, 26, 27 and 32 and to item 7.4 of the Schedule of fees, as well as to the French translation of item 7 of the Schedule of fees, as set out in Annex I to the present document, be adopted by the Madrid Union Assembly, with a suggested date of entry into force of July 1, 2017; and,

(ii) request that the International Bureau should prepare a new proposal for the amendment of Rule 21 to be discussed at a future session, taking into account all the views expressed during its thirteenth session; this new proposal should address, *inter alia*, the tasks required from an Office that is requested to take note of the international registration, whether national fees for such taking note could be collected and forwarded by the International Bureau and whether the request could be made when presenting the international application.

AGENDA ITEM 11: OTHER MATTERS

355. The Secretariat asked Delegations to provide the International Bureau with updated contact details to facilitate communication with Offices.

356. The Delegation of Mexico expressed a concern for situations where holders of international registrations did not have a domicile to receive notifications in Mexico, as this might affect the legal security of marks registered in Mexico because actions for cancellation might have been initiated in respect of such marks. The Delegation proposed that, for the next session of the Working Group, the Secretariat analyze the possibility that the International Bureau could notify those types of communications to the holders who did not have a domicile or an address for notifications in Mexico.

357. The Representative of CEIPI noted that it would be preferable to have the sessions of the Working Group before the summer break, so that proposals could be submitted to the Assembly in the same year. The Representative stated that he was thinking, in particular, of urgent matters such as the closure of accessions to the Madrid Agreement and the issue of Article 14, as well as the issue of division. If the Secretariat considered it did not have enough time to prepare documents on all of the items on the agenda, it could very well grant priority to certain issues.

358. The Secretariat said that it would try to organize the next session of the Working Group before the next WIPO Assemblies, but explained that that was not its decision alone, since other engagements had to be taken into consideration.

AGENDA ITEM 12: SUMMARY BY THE CHAIR

359. The Working Group approved the Summary by the Chair, as amended to take account the interventions of a number of Delegations (document MM/LD/WG/13/9).

AGENDA ITEM 13: CLOSING OF THE SESSION

360. The Chair closed the session on November 6, 2015.

[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**

(as in force on ~~January 1, 2015~~ [July 1, 2017](#))

[...]

**Chapter 2
International Applications**

[...]

*Rule 12
Irregularities With Respect to the
Classification of Goods and Services*

[...]

(8bis) [Examination of Limitations] The International Bureau shall examine limitations contained in an international application, applying paragraphs (1)(a) and (2) to (6) *mutatis mutandis*. Where the International Bureau cannot group the goods and services listed in the limitation under the classes of the International Classification of Goods and Services listed in the international application concerned, as amended pursuant to paragraphs (1) to (6), as the case may be, it shall issue an irregularity. Where the irregularity is not remedied within three months from the date of the notification of the irregularity, the limitation shall be deemed not to contain the goods and services concerned.

[...]

Chapter 5 Subsequent Designations; Changes

[...]

Rule 25

Request for Recording of a Change; Request for Recording of a Cancellation

(1) *[Presentation of the Request]* (a) A request for recording shall be presented to the International Bureau on the relevant official form, in one copy, where the request relates to any of the following:

[...]

(iv) a change in the name or address of the holder or, where the holder is a legal entity, an introduction of or a change in the indications concerning the legal nature of the holder and the State and, where applicable, the territorial unit within that State under the law of which the said legal entity has been organized;

[...]

(2) *[Contents of the Request]* (a) ~~The~~ request ~~for the recording of a change or the request for the recording of a cancellation~~ under paragraph (1)(a) shall, in addition to the requested recording change or cancellation, contain or indicate

[...]

(d) The request for the recording of a limitation shall group the limited goods and services only under the corresponding numbers of the classes of the International Classification of Goods and Services appearing in the international registration or, where the limitation affects all the goods and services in one or more of those classes, indicate the classes to be deleted.

[...]

Rule 26

Irregularities in Requests for Recording under Rule 25 of a Change and for Recording of a Cancellation

(1) *[Irregular Request]* If ~~the request for the recording of a change, or the request for the recording of a cancellation, referred to in~~ a request under Rule 25(1)(a) does not comply with the applicable requirements, and subject to paragraph (3), the International Bureau shall notify that fact to the holder and, if the request was made by an Office, to that Office. For the purposes of this Rule, where the request is for the recording of a limitation, the International Bureau shall only examine whether the numbers of the classes indicated in the limitation appear in the international registration concerned.

(2) *[Time Allowed to Remedy Irregularity]* The irregularity may be remedied within three months from the date of the notification of the irregularity by the International Bureau. If the irregularity is not remedied within three months from the date of the notification of the irregularity by the International Bureau, the request shall be considered abandoned, and the International Bureau shall notify accordingly and at the same time the holder and, if the request ~~for the recording of a change or the request for the recording of a cancellation~~ under Rule 25(1)(a) was presented by an Office, that Office, and refund any fees paid, after deduction of an amount corresponding to one-half of the relevant fees referred to in item 7 of the Schedule of Fees, to the party having paid those fees.

[...]

Rule 27

*Recording and Notification ~~of a Change or of a Cancellation~~ with respect to Rule 25;
Merger of International Registrations; Declaration That a Change in Ownership or a Limitation
Has No Effect*

(1) [~~Recording and Notification of a Change or of a Cancellation~~] (a) The International Bureau shall, provided that the request referred to in Rule 25(1)(a) is in order, promptly record the indications, the change or the cancellation in the International Register, shall notify accordingly the Offices of the designated Contracting Parties in which the ~~change~~recording has effect or, in the case of a cancellation, the Offices of all the designated Contracting Parties, and shall inform at the same time the holder and, if the request was presented by an Office, that Office. Where the recording relates to a change in ownership, the International Bureau shall also inform the former holder in the case of a total change in ownership and the holder of the part of the international registration which has been assigned or otherwise transferred in the case of a partial change in ownership. Where the request for the recording of a cancellation was presented by the holder or by an Office other than the Office of origin during the five-year period referred to in Article 6(3) of the Agreement and Article 6(3) of the Protocol, the International Bureau shall also inform the Office of origin.

(b) The indications, the change or the cancellation shall be recorded as of the date of receipt by the International Bureau of a request complying with the applicable requirements, except that, where a request has been made in accordance with Rule 25(2)(c), it may be recorded as of a later date.

**Chapter 7
Gazette and Data Base**

*Rule 32
Gazette*

(1) [*Information Concerning International Registrations*] (a) The International Bureau shall publish in the Gazette relevant data concerning

[...]

(vii) ~~changes in ownership, limitations, renunciations and changes of name or address of the holder recorded~~recordings under Rule 27;

[...]

[...]

PROPOSED AMENDMENTS TO THE SCHEDULE OF FEES

SCHEDULE OF FEES

(in force on ~~January 1, 2015~~ July 1, 2017)

Swiss francs

[...]

7. *Miscellaneous recordings*

[...]

7.4 Change ~~of~~in the name and/or address of the holder and/or, where the holder is a legal entity, introduction of or change in the indications concerning the legal nature of the holder and the State and, where applicable, the territorial unit within that State under the law of which the said legal entity has been organized ~~of~~for one or more international registrations for which ~~recordal of~~the same recording or change is requested in the same request form

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[...]

[Annex II follows]



MM/LD/WG/13/INF/1
ORIGINAL : FRANÇAIS / ENGLISH
DATE : 6 NOVEMBRE 2015 / NOVEMBER 6, 2015

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

**Treizième session
Genève, 2 – 6 novembre 2015**

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

**Thirteenth Session
Geneva, November 2 to 6, 2015**

LISTE DES PARTICIPANTS*
LIST OF PARTICIPANTS*

établie par le Secrétariat
prepared by the Secretariat

* Les participants sont priés d'informer le Secrétariat, en modifiant la présente liste provisoire, des modifications qui devraient être prises en considération lors de l'établissement de la liste finale des participants.

Participants are requested to inform the Secretariat of any changes which should be taken into account in preparing the final list of participants. Changes should be requested by making corrections on the present provisional list.

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