

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

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

### SUMMARY BY THE CHAIR

*adopted by the Working Group*

1. The Working Group on the Legal Development of the Madrid System for the International Registration of Marks (hereinafter referred to as “the Working Group”) met in Geneva from 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 of European Trade Mark Owners (MARQUES), *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) (11).

6. The list of participants is contained in document MM/LD/WG/13/INF/1 Prov. 2\*.

#### **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.

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

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

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

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

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

11. The Working Group took note of the electronic adoption of the report of the twelfth session of 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**

12. Discussions were based on document MM/LD/WG/13/2.

13. The Working Group 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 the Annex 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 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.

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\* The final list of participants will be made available as an Annex to the report of the session.

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

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

15. The Working Group agreed:

- (i) to recommend to the Madrid Union Assembly that paragraph (1)(b) of Article 9sexies of the Madrid Protocol be neither repealed nor restricted in its scope; and,
- (ii) that any further review of the application of the said Article 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.

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

16. Discussions were based on document MM/LD/WG/13/4.

17. The Working Group:

- (i) requested that the International Bureau, on the bases of the proposal contained in document MM/LD/WG/13/4, prepare a new proposal for the introduction of the recording of division and merger of an international registration, to be discussed at its next session, addressing all the questions raised during its thirteenth session; in particular, whether a proposed new rule should provide for:
  - the option to require the payment of a fee and the fulfillment of other requirements, according to the applicable law, before an Office transmit a request for division;
  - the option for this Office to transmit statements regarding the status of protection of the mark along with a request for division;
  - an opt-out provision and a delayed implementation transitional provision modeled after provisions in the Patent Cooperation Treaty (PCT) System; and,
  - similar provisions in the case of merger of registrations resulting from division; and,
- (ii) invited delegations and observers to make further contributions to be delivered to the International Bureau within two months following the closing of its thirteenth session.

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

18. Discussions were based on document MM/LD/WG/13/5.

19. The Working Group agreed:

- (i) with the actions proposed in paragraphs 33 to 37 of document MM/LD/WG/13/5; and,
- (ii) that any further review of this matter 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.

**AGENDA ITEM 8: USER SURVEY ON MADRID DEPENDENCY PRINCIPLE ISSUES**

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

21. The Chair concluded that there was no consensus on the suspension of the operations of Articles 6(2), (3) and (4) of the Agreement and of the Protocol and that the Working Group had agreed to request that the International Bureau present a new document, to be discussed at its next session, with other proposals to make the Madrid System evolve to meet the needs of all its members and be more flexible and effective, without questioning its fundamental principles, for which the Chair invited delegations and observers to make further contributions to the International Bureau.

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

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

23. The Working Group recommended that the Madrid Union Assembly, at its next session, take the necessary measures to prevent accessions to the Madrid Agreement only and requested that the International Bureau propose the most appropriate measure to the said Assembly.

**AGENDA ITEM 10: AMENDED RULE 24(5) OF THE COMMON REGULATIONS UNDER THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS AND THE PROTOCOL RELATING TO THAT AGREEMENT: IMPLEMENTATION ISSUES**

24. Discussions were based on document MM/LD/WG/13/8.

25. The Working Group agreed to:

(i) recommend to the Madrid Union Assembly that the entry into force of amended Rule 24(5)(a) and (d) be suspended until the Working Group had further reviewed the implications of its implementation;

(ii) request that the International Bureau analyze, in a document to be discussed at its next session, limitations requested in international applications, subsequent designations and as a request for the recording of a change; in particular, the roles and responsibilities of the Office of origin, the International Bureau and the Office of the designated Contracting Parties in the examination of the scope of limitations; and,

(iii) request that in another document the International Bureau propose, in light of the findings of the previous document, implementation options for amended Rule 24(5)(a) and (d) and indicate the additional resources that would be required for the implementation of said options.

**AGENDA ITEM 11: OTHER MATTERS**

26. The Secretariat invited delegations to provide to the International Bureau or, as the case may be, update their Office's contact information.

27. The Delegation of Mexico requested that the International Bureau prepare, for the next session of the Working Group, a document analyzing the possibility that an Office could transmit to the holder, through the International Bureau, communications concerning actions that might affect the protection of the mark in a designated Contracting Party following the sending of statements of grant of protection.

28. The Representative of CEIPI suggested that, to the extent possible, the International Bureau schedule upcoming sessions of the Working Group so that its recommendations could be submitted to the Madrid Union Assembly within the shortest delay.

**AGENDA ITEM 12: SUMMARY BY THE CHAIR**

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

**AGENDA ITEM 13: CLOSING OF THE SESSION**

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

[Annex follows]

**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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[...]

[End of Annex and of document]