



MARQUES' comments on the Summary by the Chair (MM/LD/WG/13/9) concerning the Thirteenth Session of the Working Group on the Legal Development of the Madrid System for the International Registration of Marks held in Geneva from November 2 to 6, 2015

31st December 2015

Introduction

MARQUES is the European association representing brand owners' interests. The **MARQUES** mission is to be the trusted voice for brand owners.

Established in 1986 and later incorporated in the United Kingdom as a not-for-profit company limited by guarantee, **MARQUES** has no shareholders, issues no dividends and its directors are expressly prohibited from being paid for their services. **MARQUES** unites European and international intellectual property rights owners worldwide in the protection and utilization of IPRs as essential elements of commerce. Its current membership crosses all industry lines and includes IPR owners and legal practitioners representing IPR owners in more than 80 countries.

MARQUES is an official non-governmental organisation that was granted observer status at the World Intellectual Property Organization - WIPO in 1989 by the Governing Bodies at their Twentieth Series of Meetings (cf. paragraph 213 of General Report, document AB/XX/20).

More information about **MARQUES** and its initiatives is available at www.marques.org.

The Summary by the Chair of November 6, 2015 (MM/LD/WG/13/9)

A delegation of **MARQUES** representatives attended the Thirteenth Session of the Working Group on the Legal Development of the Madrid System for the International Registration of Marks held in Geneva from November 2 to 6, 2015. During the Working Group meeting, the representatives of all Delegations, including those of the User Associations admitted to the Session in an observer capacity, were asked to submit any further comments or proposals until the end of 2015. **MARQUES** has made serious efforts to meet this deadline and by the present, **MARQUES** would like to submit the following written comments, in particular related to the issues of Replacement and Future Accessions.

1. Replacement / Rule 21 (Agenda Item 4, numbered paragraph 13. (ii) of the Summary by the Chair)

MARQUES is of the opinion that the discussion of any proposed amendments to Rule 21 regarding the procedures of taking note of an international registration will be beneficial to users. With respect in particular to two of those issues that were raised in the Working Group meeting, **MARQUES** wishes to submit the following observations.

MARQUES Ltd - Unit Q, Troon Way Business Centre, Humberstone Lane,
Thurmaston, Leicester LE4 9HA United Kingdom
Phone +44 116 274 7355 Fax +44 116 274 7365 Email: info@marques.org – aromeo@marques.org

a) **Filing a Request for taking note of the international registration through the International Bureau**

One point raised during the discussion was that, if in the future it was possible to file a request for taking note of the international registration through the International Bureau, then the procedure should be centralised at the International Bureau's level and it should no longer be possible to file similar requests through any national or regional IP Offices.

Although it is appreciated that a solution in that direction could assist the right holders by making the procedure of submitting this kind of requests much easier, on the other hand, as a matter of principle, **MARQUES** would generally prefer that the users of the Madrid system may have alternative options rather than limited choices. However, **MARQUES** has to concede that limiting the filing of those requests only through the International Bureau may all in all prove beneficial as this limitation would not only simplify the formalities of submitting the request but it would also bring a substantive harmonisation in the relevant procedure, thus a higher level of legal certainty especially for the users.

Moreover, as a request to take note of an international registration could reasonably relate - in the vast majority of cases - to more than only one designation, accordingly, the filing of any such request through the unique channel of the International Bureau would be more efficient, certainly for the users. Consequently, it should be assumed that the option to file such request or even a plurality of requests through the different IP Offices would be neither needed nor used in practice, and keeping that option in place could prove more confusing than beneficial in the end.

MARQUES also wishes to confirm that - as already mentioned in its official position of May 7, 2014 - the filing of a request for taking note of the international registration should already be made available when presenting the international application.

b) **Collection of fees for the Request filed with the International Bureau for taking note of the international registration (replacement) by the interested IP Offices**

MARQUES would like to see that those individual fees that might become due for filing a request to take note of an international registration could be collected and forwarded by the International Bureau, i.e. in those cases where a Contracting Party would require a fee for recording that request in the trademark register of its IP Office. Any other fee collection procedure would be too much burdensome, especially for the users. Since the International Bureau has been able to provide the same service with respect to many other official fees, including those individual fees as requested for the designation of certain Contracting Parties, it should also be possible for the International Bureau to collect and forward those individual fees that were connected to the filing of a request for taking note of an international registration.

2. **Future accessions to the Madrid Agreement (Agenda item 9, numbered paragraph 23 of the Summary by the Chair)**

In the current circumstances, **MARQUES** supports the Working Group's recommendation to the Madrid Union Assembly, that - at its next session - should take the necessary measures to

prevent accessions to the Madrid Agreement only. The Working Group also requested that the International Bureau should propose the most appropriate measure to the Assembly.

MARQUES opines that in the future any new Contracting Parties would have to also join the Madrid Protocol, as only this requirement can ensure that the users will continue to benefit from those advantages that the Madrid Protocol has brought forward. Nevertheless, **MARQUES** has not yet reached any final conclusion on whether, on the contrary, any new acceding States should be encouraged to join the Madrid Agreement (in addition to the Madrid Protocol) so that the users can benefit from the conditions of the *safeguard* clause (Article 9sexies of the Madrid Protocol). On this specific subject matter, **MARQUES** would thus reserve the submission of any additional comments to a later stage.

3. Norwegian Proposal / Basic Mark Requirement / Dependency Clause (Agenda item 8, numbered paragraph 21 of the Summary by the Chair)

It is quite disappointing to see that some Member States are opposing any substantial changes to the Madrid System, such as the freeze of the dependency clause (Article 14(1) and (2)(A) of the Madrid Agreement) or even the removal of the basic mark requirement (originally known as the Norwegian Proposal). However, the opposing arguments do not appear to be convincing.

MARQUES appreciates that the Working Group had agreed to request that the International Bureau presented a new document, to be discussed at the Working Group's next session, with other proposals to make the Madrid system become more flexible and effective to meet the needs of both its Members and the users of the system.

However, it seems to be particularly difficult, in practice, to overcome the disadvantages connected with the dependency clause. Notably, the main reason against the elimination - or even a provisional freeze of the dependency - appears to reside in the fact that the option of filing a so-called "*central attack*" would be lost. Accordingly, proposals may have to be mainly looked at which are unrelated to the *central attack*. Any other solutions should not only have to focus on a reduction of the dependency term to e.g. 2 years and on the streamlining of transformation procedures, but they should likewise address other major issues, such as the question of trademarks in different scripts (Latin, Chinese, etc.), or of the effects of limitations, e.g. on the list of goods and services of the basic mark when this latter is refused on absolute grounds by the Office of origin, and the like. **MARQUES** intends to further look into these issues in more detail and would thus reserve the submission of any additional comments to a later stage.

Respectfully submitted,

On behalf of **MARQUES**

A handwritten signature in blue ink, appearing to read "J. Höhfeld", is written over a light blue rectangular stamp.

Jochen Höhfeld, Chair of the **MARQUES** International Trademark Law and Practice Team