

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

**Fourteenth Session
Geneva, June 13 to 17, 2016**

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 June 13 to 17, 2016.
2. The following Contracting Parties of the Madrid Union were represented at the session: African Intellectual Property Organization (OAPI), Albania, Algeria, Antigua and Barbuda, Australia, Austria, Belarus, Cambodia, China, Colombia, Cuba, Czech Republic, Denmark, Estonia, Finland, France, Germany, Ghana, Greece, Hungary, India, Israel, Italy, Japan, Kenya, Lao People’s Democratic Republic, Latvia, Lithuania, Madagascar, Mexico, Montenegro, Morocco, Mozambique, New Zealand, Norway, Philippines, Poland, Portugal, Republic of Korea, Republic of Moldova, Romania, Russian Federation, Serbia, Singapore, Spain, Sweden, Switzerland, Tajikistan, The former Yugoslav Republic of Macedonia, Ukraine, European Union (EU), United Kingdom, United States of America, Viet Nam (54).
3. The following States were represented as observers: Brazil, Canada, El Salvador, Honduras, Indonesia, Jordan, Kuwait, Malaysia, Malta, Thailand (10).
4. Representatives of the following international intergovernmental organizations took part in the session in an observer capacity: Benelux Office for Intellectual Property (BOIP), Eurasian Economic Commission (EEC), World Trade Organization (WTO) (3).

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 Communities Trade Mark Association (ECTA), European Law Students' Association (ELSA International), 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 V to this document.

AGENDA ITEM 1: OPENING OF THE SESSION

7. The Deputy Director General of the Brands and Designs Sector of the World Intellectual Property Organization (WIPO) opened the session and welcomed the participants.

8. The Deputy Director General stated that since the previous meeting of the Working Group, the Lao People's Democratic Republic had joined the Madrid System for the International Registration of Marks (hereinafter referred to as "the Madrid System"); three to five additional members were expected by the end of the year, namely, Brunei Darussalam, Indonesia, Malaysia, Thailand, and Trinidad and Tobago. The Deputy Director General informed that, while in 2015, filings had increased by 2.9 per cent, even better figures could be expected for 2016, given the increase trend of 7 per cent to 8 per cent.

9. The Deputy Director General highlighted that in 2016, the Madrid System was turning 125 years old and that 2016 also marked the 20th anniversary of the entry into force of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as, respectively, "the Protocol" and "the Agreement"). The Deputy Director General further remarked that with the accession of Algeria to the Protocol, the Madrid System had *de facto* become a one-treaty system; this would pave the way for further streamlining of the system.

10. The Deputy Director General noted that some issues were rising with the deployment of the new Madrid International Registrations Information System (MIRIS) . Operations in the International Register were being affected, and this impacted national Offices as well. The Deputy Director General announced that the International Bureau was making all possible efforts to stabilize the system and bring the operational level back to normal and even improve it.

11. The Deputy Director General observed that the Madrid Working Group Roundtable would provide the International Bureau with an opportunity to seek the advice of the participants on a number of relevant issues concerning the evolution of the Madrid System in the interest of both Offices and users.

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

12. Mr. Mikael Francke Ravn (Denmark) was unanimously elected as Chair of the Working Group, Ms. LI Dongxiao (China) and Ms. Mathilde Manitra Soa Raharinony (Madagascar) were unanimously elected as Vice-Chairs.

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

AGENDA ITEM 3: ADOPTION OF THE AGENDA

14. The Working Group adopted the draft agenda (document MM/LD/WG/14/1 Prov. 2), without modification.
15. The Working Group took note of the electronic adoption of the report of the thirteenth session of the Working Group.
16. The Chair opened the floor for opening statements by delegations.
17. The Representative of CEIPI expressed satisfaction at the fact that the session of the Working Group was being held before the autumn session of the Assemblies of the Member States of WIPO, particularly the Madrid Union Assembly, which would allow the early adoption of the proposed amendments to the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement (hereinafter referred to as "the Common Regulations"). The Representative of CEIPI expressed his wish that future sessions of the Working Group would continue to be held immediately before the sessions of the Assemblies of the Members States of WIPO.
18. The Delegation of the Republic of Korea expressed appreciation for the efforts of both Contracting Parties and WIPO to develop the Madrid System. The Delegation stated that the meeting of the Working Group would be an invaluable opportunity for Contracting Parties to discuss in detail issues regarding the design of the system, as well as specific matters such as limitations, replacement, transformation as well as the modification of the Common Regulations; there would be differences among Contracting Parties, but the discussions would be for the advantage of users. The Delegation declared it was ready to cooperate during the debates to this effect.

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

19. Discussions were based on document MM/LD/WG/14/2 Rev.
20. The Secretariat introduced document MM/LD/WG/14/2 Rev. The Secretariat informed that the proposed amendments concerned Rules 3, 4, 18~~ter~~, 21, 22, 27 and 32 of the Common Regulations, as well as Section 16 of the Administrative Instructions for the Application of the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating Thereto (hereinafter referred to as the "Administrative Instructions"). A new Rule 23~~bis~~ was proposed. The proposal supported the ongoing process of making the Madrid System more user-friendly and attractive to users, Offices and interested parties.
21. The Delegation of the European Union expressed support for the proposed amendments. The Delegation stated that the proposed amendment concerning the final disposition on the status of the mark might increase legal uncertainty for users as to the scope of protection of the international registration. The Delegation further said that in order to gain flexibility while avoiding changes to national Information Technology (IT) systems, the option of sending information on decisions after tacit acceptance applied should be included in Rule 19. Where the proposed amendment on ceasing of effect was concerned, the Delegation saw value in option A. The Delegation also supported the proposed date of entry into force, with the exception of the proposed amendment to Rule 21; for that provision, the Delegation suggested further analysis and a recommendation by the International Bureau for a date of entry into force that should take into account the significant procedural changes that might be needed at the national level.

RULE 3

22. The Secretariat introduced the amendments to paragraph (4)(b) of Rule 3, dealing with the recording of the appointment of a representative before the International Bureau. If the request for recording was presented through an Office, the International Bureau would notify such Office, but not the Offices of designated Contracting Parties. There could be situations where the Office of the designated Contracting Party would need to contact the holder to provide information on maintenance requirements to be complied with before the Office, or on cancellation actions initiated by third parties, for instance. Where in such occasions the holder did not have a local address, it could be useful to have information on the appointment of a representative recorded in the International Register. It was thus proposed to amend Rule 3(4)(b), including notifications to the Offices of designated Contracting Parties of the recording of the appointment of a representative.
23. The Delegation of Madagascar supported the proposal and stated that it would help its Office in cases where it needs to contact a representative, for instance in cases of provisional refusals, since the current legal framework did not provide a mechanism to do so.
24. The Delegation of the Republic of Korea also supported the proposal, arguing that it would provide clarity on representation to all interested parties.
25. The Delegation of the Republic of Moldova outlined the relevance of the information provided through the proposed amendment and supported it.
26. The Delegation of Norway wondered whether the appointment of a new representative should not rather be notified as a change in name or address of an existing representative, and suggested to enlarge the proposal to encompass notifications of changes in name and address of existing representatives; designated Contracting Parties would thus enjoy updated information on representatives.
27. The Representative of INTA supported the proposal, as well as the suggestion of the Delegation of Norway. The Representative of INTA observed that where the appointment of a representative was effected in the international application, the combined reading of Rules 14 and 32 revealed that its recording in the International Register was published; yet where a new appointment or change of the appointed representative was effected, Rule 32 would not foresee its publication; since that information was useful not only for Offices but for third parties as well, the Representative of INTA suggested to provide for the publication of the appointment of a new representative or a change thereof.
28. The Delegation of Tajikistan supported the proposed amendments.
29. The Representative of APRAM considered that it was necessary to notify Contracting Parties of the recording of the appointment of a representative; consequently, the removal of the representative should also be notified.
30. The Secretariat elaborated on the issues raised by the Representatives of INTA and APRAM. The Secretariat saw merit in INTA's suggestion to amend Rule 32. Concerning APRAM's suggestion that the removal or change of the recorded representative, current Rule 25 would cover changes in the recorded representative; where removals or new recordings were concerned, a procedure would be established to notify designated Contracting Parties.

31. The Delegation of Norway found it reasonable that changes should be covered by Rule 25.

32. The Representative of APRAM asked for clarifications on how Rule 25 would cover the recording of changes in name and address of the representative, as well as an extensive interpretation concerning the renewal or cancellation of the appointment of a representative.

33. The Chair concluded that the Secretariat should submit a redrafted proposal on Rules 3 and 25 (continued on paragraph 226).

RULE 4

34. The Secretariat presented the proposal on Rule 4(4), on the calculation of time limits. The Secretariat explained that Rule 4(4) established that where a time limit expired on a day on which the International Bureau or the Office concerned were not open to the public, the time limit would expire on the first subsequent day that the International Bureau or the Office would be open to the public. The proposal to amend paragraph (4) would also include the situation where the time limit would expire on a day where ordinary mail would not be delivered in the locality where the International Bureau or Office concerned were situated; in such case the time limit would expire on the first subsequent day on which delivery of ordinary mail would be resumed. The Secretariat remarked that the proposal would be beneficial for users, Offices and the International Bureau, as it would clarify when the timing concerned expired.

35. The Delegation of Japan asked for clarifications on how it would be possible to obtain information on mail delivery in other countries in order to ascertain expiry dates. The Delegation asked for further clarifications on the range of deliveries covered by the proposed provision, particularly whether it would also cover deliveries addressed to Offices of designated Contracting Parties or only deliveries addressed to the International Bureau.

36. The Delegation of Germany asked whether the proposed provision would cover other situations, for example strikes in the postal services.

37. The Representative of INTA asked for clarifications on time limits that would expire upon receipt by the Office of a Contracting Party, and intended to be covered by the proposed provision. The Representative of INTA recalled that, under the Common Regulations, usually a time limit concerning a Contracting Party would be calculated from the date of sending, not the date of receipt, of a communication; there were time limits calculated from the date of receipt, such as requests for review after a provisional refusal, but such time limits were regulated by the national law of the designated Contracting Party concerned, not the Common Regulations.

38. The Delegation of Australia noted that the proposal would require amendments to its domestic regulations and even perhaps the trademark law. The Delegation said that the proposed amendment seemed to be broadly drafted, and thought that it did not appear to limit the application of the provision to just one day of disruption nor to a public holiday situation. The Delegation stated that it was interested in views of other Madrid members on the proposal and whether there might be other ways to achieve the same aim. It seemed to the Delegation that existing Rule 5 could perhaps cover the envisaged situation, if it could be amended to apply to time limits for Offices as well as the International Bureau even though it might appear to be burdensome for use in Offices.

39. The Secretariat elaborated on the proposal. Replying to the question by the Delegation of Japan, the Secretariat explained that the International Bureau received information from Offices on days they would be closed; such information was published, and was also available in the International Bureau's data systems. The Secretariat further clarified that the proposal was only meant to address situations where there would be no postal delivery; the substance of the provision was not meant to be changed. The proposal was intended to also cover *force majeure* cases, like earthquakes, where there could be issues with postal delivery in Contracting

Parties, thus avoiding detrimental situations to holders. The Secretariat further stated that the envisaged time limits were those in the Common Regulations, not national time limits, normally covered by domestic laws. As to the question from the Delegation of Australia whether an alternative means to achieve the same goal could be found, the Secretariat said that it was open to explore it.

40. The Representative of INTA said that the *force majeure* situations contemplated by the Secretariat were already covered by Rule 5 of the Common Regulations. It would be possible to consider a review of Rule 5, if needed. The Representative of INTA repeated his question about the time limits for receipt by an Office envisaged in the proposed amendment.

41. The Delegation of Japan reiterated its concern on the difficulty for Offices to exactly determine expiry dates in Contracting Parties.

42. The Delegation of Germany remarked that strikes and other *force majeure* situations already were contemplated in Rule 5, and thus the proposal could incur duplications of irregular situations where postal services were concerned. The Delegation further elaborated that the proposal seemed to address cases of interruptions in postal services affecting the International Bureau and possibly international organizations, but not Offices of Contracting Parties. The Delegation concluded that very likely the proposed amendment was not necessary.

43. The Secretariat explained that the proposed amended provision would cover responses to the International Bureau by holders, applicants or Offices; replying to the question on time limits by the Representative of INTA, the Secretariat offered the example of provisional refusals: in cases where the time limit for issuing the refusal would expire on a day where the International Bureau was open for business but there would be no postal delivery, the Office would benefit from the proposed amendment. The Secretariat further stated that where an Office of origin would need to reply to an irregularity letter, it could also benefit from the proposal; a time limit expiring on a day where the International Bureau would be open for business, but there would be no postal delivery would be postponed until postal delivery resumed; in such situations, Rule 5 would not apply.

44. The Representative of INTA clarified that he had no difficulty as far as receipts by the International Bureau were concerned; the issue for the Representative of INTA was that he could not see any circumstance where a time limit under the Common Regulations would expire on the date of receipt by the Office of a Contracting Party. The Representative of INTA further stated that if absolute clarity were to be served, it would be necessary to specify in Rule 4 that only communications sent by mail were envisaged, since the fact that mail was not delivered on the 1st of August in Switzerland did not affect electronic communications. The Representative of INTA summarized that it would be necessary to specify that only delivery by mail was envisaged by the proposed rule and that the words “or the Office” in the fourth line should be deleted.

45. The Secretariat suggested a re-wording of the proposal; since the word “delivered” seemed to be causing concern, it could be replaced by, for example, “operational”; the proposal would then read “[...] or on a day when ordinary mail is not operational in the locality in which the International Bureau or the Office is situated.” The Secretariat explained that the re-wording would clarify that the Office could not send communications to the International Bureau because the postal service was not operational on a particular day.

46. The Chair read the re-wording as proposed by the Secretariat: “If a period expires on a day in which the International Bureau or the Office concerned is not open to the public or on a day when ordinary mail is not operational in the locality in which the International Bureau or the Office is situated, the period shall notwithstanding paragraphs (1) to (3) expire on the first subsequent day on which the International Bureau or the Office concerned is open to the public or on which ordinary mail is resumed.”

47. The Delegation of Japan stated that it needed to analyze whether the new proposed wording complied with its national law and regulations; it would also need to consider the impact it would have on its IT system and procedures. As a consequence, the Delegation declared that it could not accept the new proposal in the current session of the Working Group.
48. The Chair asked the Delegation of Japan whether its concerns related to the reference to the Office in the fourth line in the proposal; the Chair recalled that the Representative of INTA also had an issue with that reference.
49. The Delegation of Japan confirmed that its concern related to the reference in question.
50. The Chair asked the Delegation of Japan whether the deletion of the reference in question would dissipate the concerns of the Delegation.
51. The Delegation of Japan replied to the question by the Chair that it would need a clarification that the proposal applied to the International Bureau only.
52. The Representative of CEIPI esteemed that in view of the concerns raised by the Delegation of Japan and the Representatives of APRAM and INTA, the proposal could not be considered to be ripe for submittal to the Madrid Union Assembly. Further reflection and consultation were needed. The Representative of CEIPI suggested that the proposal should be postponed for the next session of the Working Group.
53. The Chair asked delegations whether they felt comfortable with the new proposal that would delete the reference to the Office in the fourth line, and replace the word “delivered” with “operational”.
54. The Delegation of Germany said it was not comfortable with the fact that in the first part of the provision both the International Bureau and the Office were mentioned, whereas in the second part only the International Bureau was; for the Delegation, that might lead to interpretations that would not be correct, as it could be concluded that a different regime would apply to Offices if they were not mentioned in the second part of the sentence. The Delegation of Germany concluded that it would be advisable that the Working Group did not make a decision during that session.
55. The Delegation of Switzerland said that since there were serious issues raised, particularly those mentioned by the Delegation of Japan and the Representative of INTA, it preferred that the proposal be postponed until the next session of the Working Group.
56. The Chair concluded that the Secretariat should submit a new proposal at a future session of the Working Group, taking into account all the comments and concerns raised at the meeting.

RULE 18~~TER~~

57. The Secretariat introduced a proposal on the final disposition of the status of the mark in a designated Contracting Party. The Secretariat referred to paragraph (4) of Rule 18~~ter~~, which provided for the sending of further statements following the sending of a statement in accordance with either paragraph (2) or (3) of the same provision; such further statements could be decisions by the Office itself or by a judicial body such as a court or board of appeal. The Secretariat explained that where the decision was by a judicial body and affected the protection of the mark, the Office should notify that to the International Bureau to the extent that it was aware of the decision; to that effect, the Office first needed to verify whether it had already sent a provisional refusal followed by a statement under Rule 18~~ter~~ for the concerned international registration. If such was the case, the Office could notify the later decision as a further decision under Rule 18~~ter~~(4); should that not be the case, but the Office had, for example, notified a statement of grant of protection under Rule 18~~ter~~(1) or tacit acceptance had

applied, the Office could only notify the later decision affecting the scope of protection of the mark as an invalidation under Rule 19. The Secretariat said that the proposal would allow the sending of a further decision regardless of the prior history of the particular international registration; that would mean that this provision could also be used where there had been a statement of grant of protection sent under Rule 18*ter*(1) or the mark was considered to be protected under the principle of tacit acceptance. The sole purpose of the proposal was to make it easier for Offices to notify the International Bureau of any later decision affecting the scope of protection and was not intended to provide Offices with an extended refusal possibility.

58. The Delegation of Germany asked for explanations on the advantages of the proposal and stated that it did not see how it would simplify Office procedures; additionally, the proposal could affect IT procedures at the national level. Moreover, the relation between the new proposed rule and Rule 19 would not be clear; there seemed to be two ways to notify the same thing.

59. The Delegation of the Republic of Moldova found merit in further discussing the proposal, as it would be applicable, for instance, to cases of invalidation for non-use.

60. The Delegation of the Russian Federation asked the Secretariat for further explanations on the cases where Rule 18*ter*(4) would apply. The Delegation explained that in the Russian Federation, Rule 18*ter*(4) only applied when the mark benefited from a protection by virtue of a previous decision. Where a positive decision was amended afterwards as a consequence of a legal action, the Russian Federation would apply Rule 19.

61. The Representative of INTA concurred with the delegations which considered that the proposal should not introduce a substitute or an alternative to notifications under Rule 19. Yet the Representative of INTA deemed the proposal useful, as there might be other examples of further decisions affecting the scope of protection, such as the notifications from the European Union Intellectual Property Office (EUIPO) under Article 28 of the European Union Trademark Regulations, recorded in the International Register by applying Rule 18*ter*(4) by analogy.

62. The Secretariat explained that increasingly Offices were given delegated authority by the legislation to make decisions that used to be made by the courts only; certain Offices could make decisions on cancellations for non-use; other Offices did not have an opposition period, and could have a possibility to decide on cancellation actions after a specific period. The Secretariat concurred with the Representative of INTA that notifications under Article 28 of the European Union Trademarks Regulations were an appropriate example; yet the proposal was not meant to open new possibilities for refusal by Offices, additional to the existing ones.

63. The Representative of INTA observed that Rule 19 dealt with invalidations, whether pronounced by an administrative authority or a court, and suggested additional wording elaborating on the fact that the proposal was effected without prejudice to Rule 19, thus clarifying that Rule 18*ter*(4) could not be used as a substitute for Rule 19.

64. The Secretariat explained that notwithstanding the fact that a further decision had been sent, there could be even new further decisions in the future; yet when an invalidation was notified there could be no appeal. Nevertheless, in practice, decisions from Offices called "Rule 19 invalidations" were received and recorded in the International Register; then further decisions were sent. Therefore an amendment to Rule 18*ter*(4) could assist Offices by enlarging the range of possible decisions they would send to the International Bureau.

65. The Delegation of Germany requested further clarification. The Delegation explained that after protection had been granted to the mark, if there were any further proceedings, Rule 19 would apply; the Delegation further stated that provisional refusals could result in a final decision to totally or partially deny protection to the mark. Any eventual subsequent proceeding should follow Rule 19. Furthermore, the Delegation esteemed that the proposal did not cover

all possible scenarios, as it only envisaged statements indicating the goods and services for which the mark was protected in the Contracting Party concerned, whereas especially for cancellations due to non-use, usually a full invalidation would apply, and that would not be covered by the proposal.

66. The Delegation of the Russian Federation expressed agreement with the Delegation of Germany, and asked whether the proposal referred to notifications of cancellation.

67. The Delegation of Montenegro fully supported the reasoning by the Secretariat and considered the proposal as a pragmatic approach to the need for Offices to notify the envisaged decisions.

68. The Delegation of the Republic of Moldova asked whether the new provision would apply to cases where by mistake a statement under Rule 18*ter*(1) had been sent and the protection needed to be limited to only a part of the goods and services.

69. The Delegation of Austria shared the concerns of the Delegations of Germany, the Republic of Moldova and the Russian Federation, observing that the example of cancellation due to non-use did not fit systematically in Rule 18*ter*.

70. The Delegation of Belarus explained that for its Office Rule 18*ter*(4) would not be operational, since it would either send statements under Rule 18*ter*(1) for marks that are protected or provisional refusals under Rule 17, eventually followed by statements under Rule 18*ter*(2) or (3) and, where applicable, by decisions of the board of appeals and the supreme court. Yet, where a mistake was made by the Office, it would not apply Rule 18*ter*, but the procedure for the correction of errors. Where non-use was concerned, Belarus would send a decision under Rule 19. Nevertheless, the Delegation understood that other Offices could make use of the proposed amended rule, maybe in cases where a court of appeals had rendered its decision and then the supreme court, or an equivalent authority could issue a decision as well. Accordingly, the Delegation of Belarus supported the proposal.

71. The Secretariat clarified that the Delegation of Germany could continue with its practice of sending decisions under Rule 19 for final decisions without further appeal. The Secretariat elaborated on the diversity of the legal frameworks of Contracting Parties, and the need for their Offices to be able to notify a final decision, whether by the Office or by the courts; such further decisions could either limit or expand protection, in accordance with the national legislation. Replying to the question of the Delegation of the Republic of Moldova on mistakes, the Secretariat explained that the proposed provision did not automatically provide with the possibility of sending a further decision: such possibility would depend on the national legislation; under the Common Regulations, corrections by Offices had to comply with the applicable time limit, and the intention of the proposed amendment was not to expand the possibility of the Office to refuse protection.

72. The Delegation of Germany asked for a further clarification on whether or not the proposed new provision would apply to cases where, after a grant of protection, a mark was invalidated because of non-use for all goods and services.

73. The Secretariat replied that the issue was for national laws to decide upon.

74. The Delegation of Germany explained that, under current Rule 18*ter*, further statements should indicate the goods and services for which the mark was protected. The Delegation thus wondered whether it would now be possible to send a further statement under Rule 18*ter*(4) where the mark was no longer protected because it had been canceled for all goods and services.

75. The Secretariat clarified that Rule 18*ter*(4) was now meant to cover both cases; whether protection would be expanded or restricted would depend on national law; a total cancellation could then be reported under Rule 18*ter*(4); cases of complete refusal of protection as well as cases of grant of protection would fall under the proposed provision.
76. The Chair elaborated on the fact that the approach in the proposal had already been interpreted as included in the current wording of the provision; the real issue was whether or not a better wording was necessary.
77. The Delegation of the Russian Federation expressed surprise at the interpretation of Rule 18*ter*(4); in principle, the decision should refer to protected goods and services. Yet in case of complete cancellation, a notification to that effect should be sent to the International Register, and it seemed that Rule 18*ter*(4) would not apply. The Delegation concurred that the same interpretation could be drawn from both the existing text of Rule 18*ter*(4) and the new one.
78. The Delegation of Cuba considered that the aim of the proposal was to make the work of Offices easier, and ensure consistency with national law. The Delegation elaborated on the issue of eventual errors, raised by the Delegation of the Republic of Moldova; to this effect, and from a practical perspective, the proposal could contribute to correct decision making by the same concerned administration. The Delegation concluded that, in practical terms, the proposal was useful for national Offices.
79. The Delegation of Norway remarked that the proposal aimed at making it possible for Offices to notify about changes affecting protection at any stage where a decision was made on the life of the international registration in a given designated Contracting Party. Consequently, the proposal to expand Rule 18*ter*(4) to situations where the international registration was not refused made it possible for Offices to notify decisions affecting protection, but which might not necessarily be final due to the possibility of an eventual appeal; that would not be the case under Rule 19, since that provision covered cases where the possibility to appeal had been exhausted. Therefore the Delegation supported the proposal.
80. The Delegation of Japan concurred with the rationale of the Delegation of Norway.
81. The Delegation of Colombia supported the proposal. The Delegation explained that the proposal facilitated the communication and recording of subsequent decisions, including cases where statements concerning protection after refusal had been sent.
82. The Delegation of China requested more background information from the Secretariat, as it considered that the proposal would entail additional uncertainties.
83. The Representative of JPAA supported the proposal; the Representative declared that the proposal would be beneficial, as it would provide for the recording in the International Register and the Office of the Contracting Party of the holder of further statements reflecting the final and correct scope of protection.
84. The Secretariat offered additional elaboration on the meaning of the proposal. The Secretariat insisted that the proposed amendment was not intended to provide Offices with additional chances to send provisional refusals; time limits under Article 5 of the treaties remained applicable; the objective was to make it easier for Offices to notify a further decision. The Secretariat explained that under the current wording of the provision, a further decision could only be notified where a provisional refusal followed by a final decision had already been made; yet some Offices had delegated competence to also make decisions in cancellation actions; if the Office was meant to notify such a decision, it needed to consider the prior history of that particular international registration in order to determine the nature of the notification to the International Bureau. The Secretariat said that if the Office had issued a provisional refusal followed by a final decision, the notification could be a further decision under Rule 18*ter*(4),

whereas if only a statement to grant protection had been issued or no decision had been sent, the Office needed to make sure that due process had been followed and eventually issue an invalidation under Rule 19, which was a decision not subject to appeal. The proposal would make it easier for Offices to notify a decision without having to reconsider the history of the particular international registration.

85. The Secretariat explained that the proposal had been reviewed to include in the draft provision a reference to a further decision either by the Office or other authority, as well the provision “[...] and without prejudice to Rule 19”; the wording would then include a reference to the indication of the status of the mark and where applicable the protected goods and services.

RULE 21

86. The Secretariat elaborated on the proposal on Rule 21 concerning replacement; the proposal was a follow up on the discussion had in the previous Working Group session, and included additional features and changes suggested by delegations and representatives. The proposal now included the option for the holder to present the request directly with the designated Office concerned or through the International Bureau. The Secretariat indicated that an official form would be established for presentations through the International Bureau and where requests would be presented directly to an Office, that Office could use a specific official form; the proposal stipulated that an international registration might replace not only one but several national or regional registrations. The Secretariat clarified that where the request would be presented through the International Bureau, it would simply transmit it to the designated Office concerned and inform the holder; the International Bureau would not undertake the examination of the request. The Secretariat elaborated on the fact that the Office might examine requests to take note of an international registration; thus it was now explicit that examination by Offices was not mandatory; an Office having taken note in its register of an international registration should notify the International Bureau accordingly; the International Bureau would record the notification and inform the holder. The Secretariat informed that the International Bureau would not charge a fee for its work. Yet Contracting Parties might require the payment of a fee for the presentations of requests to take note in their registers; proposed paragraph (7) contemplated a procedure for establishing the amount of the fee, through a simpler process than the one for establishing the amounts of individual fees; should the International Bureau collect the fees, it would distribute them on a periodical basis, maybe once or twice a year. The Secretariat indicated that the proposed procedure might entail changes to domestic laws, thus requiring time for legislative change; additionally, the International Bureau would need to adjust its financial processes for the collection, management and distribution of fees; the implications of these factors required further analysis both by the International Bureau and Contracting Parties. Consequently, the document proposed an exercise on amended Rule 21 with a view to reaching an agreement on the principles of the provision and that the eventual recommendation for the adoption of paragraph (7) of Rule 21 be addressed at the next session of the Working Group.

87. The Delegation of Israel supported the proposal, and acknowledged the convenience of recording replacement under a centralized approach; the Delegation considered that the collection of fees by the International Bureau was a useful feature of the proposal.

88. The Delegation of New Zealand agreed in principle with the new proposal, which it had previously supported. The Delegation considered that the additional features and changes were positive and should improve the replacement procedure.

89. The Delegation of the United States of America explained that the Office received about 20 to 30 requests for replacement per year, and thus replacement was not a major part of its work. The Delegation stated that the Office would not issue refusals in respect of requests for extension of protection where there existed an otherwise identical national registration, since under the domestic law the national registration and the request for extension of protection were considered to be sufficiently different. The Delegation stated that requests to take note of

replacement were dealt with once the extension of protection had been registered; fees for such requests were collected; in instances where protection was ultimately not granted, fees for the request to take note were not refunded. Concerning the date of effect of replacement, the Delegation said it was aware of the different views and expressed concern about the confusion created when an extension of protection was refused after a request to take note had been processed; the Delegation proposed a re-wording of draft Rule 21(1) to address the problem, envisaging that the holder might present a request for the Office of the designated Contracting Party to take note of the international registration in its register in accordance with Article 4(2) of the Agreement or the Protocol from the date the mark was deemed protected.

90. The Delegation of Madagascar expressed agreement with the proposal as a whole.

91. The Representative of INTA noted that the new text envisaged that the new amount of the fee calculated applying the United Nations official exchange rate would enter into force as soon as it was published; the Representative of INTA considered that that might pose a problem regarding requests in transit for which the amount previously fixed would apply. Therefore, the Representative suggested that the International Bureau should consider a period of three months before the new fee became applicable; otherwise, unnecessary irregularities and complications for users might arise. Regarding the date of effect, the Representative of INTA acknowledged the difficulty to find a single date suitable for every Contracting Party. The Representative of INTA recalled that at the last session of the Working Group INTA had suggested that the easiest procedure for applicants would have been to include the request for replacement in the international application, although such solution might not satisfy all the designated Contracting Parties. The Representative of INTA suggested a drafting proposal on the penultimate line of Rule 21(1): instead of “[...] with that Office [...]”, the text should read “[...] directly to that Office or through the International Bureau [...]”, since in any case the request would be placed with the Office of the Contracting Party concerned, so the sentence “[...] directly to or through the International Bureau [...]” would clarify that whatever the route, the request would arrive at the same place in the end. The Representative of INTA further suggested to limit the indications in paragraph 2(a)(v) to the registration date and number of the national or regional registration, deleting the reference to its filing date and number, since the trademark had already been registered in the Contracting Party concerned.

92. The Representative of MARQUES noted that some of the suggestions made by MARQUES had been included and supported the proposal.

93. The Delegation of Montenegro asked for a clarification on the scope of replacement, and the fact that the goods and services should not be necessarily identical.

94. The Delegation of Colombia also expressed concern about the issue of equivalence, which could give rise to difficulties when interpreting the scope of replacement. The Delegation wondered how Offices would proceed in practice to establish the equivalence between goods and services.

95. The Delegation of the Republic of Korea supported the proposal. The Delegation considered that the proposal introduced flexibility in respect of the indication of the names of goods and services listed in the national and international registration, since they should not be necessarily identical. Nevertheless, the Delegate asked for a clarification of the notion of equivalence.

96. Following a question by the Chair on how the United States Patent and Trademark Office (USPTO) would process a request to take note of replacement under the proposed rule, the Delegation of the United States of America explained that it would require a change of practice and possibly modifications of the IT systems of the Office; the Delegation stated that that would possibly require a transition period, but it was willing to show flexibility and withdraw its proposal, since the problem did not seem to affect other delegations having a more substantial number of requests than the USPTO.

97. Upon request from the Delegation of Australia, which wished to verify the construction of the new language in the proposal, the Chair read the wording of paragraph (1) of Rule 21 with the changes suggested by the Representative of INTA.
98. The Representative of CEIPI proposed to write the reference to Articles 4(2) of the Agreement and the Protocol in the singular, since only one of them would apply.
99. The Chair explained that further re-wording would be necessary, as well as a splitting of the long paragraph as well, in order to make it clearer.
100. The Delegation of Germany supported the new proposal in principle, and made a contribution to the effect that the holder might, from the date of the notification of the designation, present a request to the Office of a designated Contracting Party, or through the International Bureau, to take note of the international registration in the register of that Office in accordance with Article 4*bis*(2) of the Agreement or the Protocol.
101. The Chair explained that the proposal of the Delegation of Germany might shed some doubt on which was the concerned register.
102. The Chair opened the discussion on the deletion of the reference to filing date and number in paragraph (2) of Rule 21.
103. The Delegation of Belarus doubted that the reference to the filing date could be deleted, since it determined the priority date.
104. The Chair reminded that the issue at stake was the content of the request for replacement, and the indications needed to identify the concerned registrations; this determination of the content of the request would not have an impact on any other right.
105. The Delegation of the Republic of Moldova asked for a clarification on the non-mandatory nature of the examination of the request by the Office.
106. The Secretariat explained that in the last session of the Working Group, agreement had been reached on the fact that the articles of the treaties did not prescribe mandatory examination, although certain Offices wished to be able to examine requests; that was the reason why a “may” provision had been introduced in the proposal.
107. The Delegation of Norway noted that paragraph (3) of Rule 21 contained a reference to paragraph 2(a)(i) to (v), thus including the filing date and number.
108. The Delegation of Madagascar asked how a notification to the holder by the Office would be effected where replacement would not apply.
109. The Delegation of Japan asked for a clarification about the applicable procedure where Offices of designated Contracting Parties considered that the request for replacement was not admissible.
110. The Secretariat recalled that, in its previous session, the Working Group had discussed a much more detailed provision envisaging notifications to the International Bureau both where note had been taken and when it had not. Analysis of Article 4 of the treaties had led to the conclusion that only cases where note was taken were to be considered. The provision had been simplified accordingly; that implied there would be cases where note would not be taken and the issue of informing the holder would arise. To address that situation, it was agreed that the replacement form should foresee provision by the holder of sufficient contact details. The Secretariat further clarified that Offices would be able to either contact the holder directly or inform the International Bureau that they could not take note, so that the International Bureau could transmit that information to the holder. The Secretariat referred to the proposal of a new

Rule 23*bis*, envisaging the possibility for Offices to send certain communications to the International Bureau so that the International Bureau would in turn forward them to holders; that option could also be borne in mind. The Secretariat indicated that another option would be to re-insert the paragraph in the previous draft foreseeing that Offices should communicate to the International Bureau cases where they could not take note.

111. The Chair informed delegations of a new proposal that would include a subparagraph (3)(c) envisaging that an Office which had not taken note might notify the International Bureau, which would in turn inform the holder accordingly.

112. The Delegation of Madagascar expressed agreement with the new proposal.

113. The Delegation of Germany agreed with the proposed “may” provision while requesting that the proposal should not be made further complex.

114. The Chair invited the Secretariat to elaborate on paragraph (5) of Rule 21, dealing with the scope of replacement, particularly on the notion of equivalence.

115. The Secretariat proposed to replace the word “equivalent” with “covered”; accordingly, the text would read “[...] the names of the goods and services listed in the national or regional registration or registrations shall be covered by those listed in the international registration that has replaced them”.

116. The Chair stated that a further amendment to the text was necessary; the draft read “[...] the names of the goods and services”. The Chair said that “the names of” should be deleted; the draft would then read “[...] the goods and services listed in the national or regional registration or registrations shall be covered by those listed in the international registration that has replaced them”.

117. The Delegation of Germany raised the issue where the international registration would contain goods which would be broader whereas the national registration would cover only a specific part of such goods; should there be a priority claim, the Delegation considered that the earlier filing date would only apply to the more specific goods which would be covered by the broader indication.

118. The Delegation of Australia proposed that the suggestions by the Secretariat should be considered to overcome the concern in respect of the correspondence between the goods and services listed in the national or regional registration or registrations and those listed in the international registration that had replaced them.

119. The Chair recalled that former discussions had concluded that there needed not be identity in the strictest sense between the international registration and the national or regional registration being replaced. The Chair stated that the proposed wording seemed to simply mirror Article 4*bis* of the Protocol and thus be redundant; it might be worth considering to delete paragraph (5) altogether.

120. The Delegation of the Republic of Moldova agreed with the suggestion by the Chair.

121. The Representative of CEIPI considered that paragraph (5) was superfluous and perhaps contrary to the article itself, thus it would be better to omit it.

122. The Delegation of Denmark also supported the deletion of paragraph (5).

123. The Chair opened the discussion on paragraph (6) of Rule 21.

124. The Delegation of Colombia asked the Secretariat about the eventual cancellation of the national registrations and its effect, or whether they would remain in force.

125. The Secretariat clarified that no *ex officio* cancellation should occur; any cancellation of prior rights should be a decision by the holder, who might be interested in renewing his national registration until the designated Office had granted protection to his Madrid designation.

126. The Chair invited the Secretariat to elaborate on the issue of fees.

127. The Secretariat explained that, since certain Contracting Parties required a fee for taking note, the proposal included the choice that the International Bureau could collect the fee on behalf of them; the proposed procedure envisaged that either Contracting Parties would indicate the amount of the fee in Swiss francs or in the local currency, to be converted into Swiss francs by the International Bureau. The fee would be published in WIPO's website. The Secretariat further stated that the proposal contained a procedure for the conversion of fees that would be simpler than the existing one for individual fees; it would be up to the Contracting Parties to monitor eventual fluctuations in exchange rates and ask the International Bureau to publish new amounts in Swiss francs or provide the amount in the local currency for the International Bureau to effect another conversion. As suggested by the Representative of INTA, the procedure would foresee, in the interest of users, a sufficient period before entry into force of the new amounts. The Secretariat requested feedback from delegations on the main issues of the establishment of the amount of the fees, fee collection and distribution.

128. The Delegation of Madagascar informed that its Office requested a fee and agreed with the proposal as a whole. The Delegation further informed that fee payment was a requirement for reviewing a request and taking note of replacement.

129. The Chair asked the Delegation of Madagascar whether a notification to the Office that fees had been paid would be sufficient guarantee for the Office to take note.

130. The Delegation of Madagascar replied in the affirmative, since a request would not be receivable if no fee had been paid.

131. The Delegation of Germany asked when new Rule 21 would eventually enter into force.

132. The Chair clarified that the goal of the discussion was to achieve agreement on the principles on replacement; moreover, the fee issue would be revisited in the next session, where –should the provision be agreed upon– a decision on entry in force would need to be made.

133. The Delegation of Germany noted that, in the document, the postponed entry into force only referred to fees, but not to the whole Rule 21; otherwise, entry into force was foreseen for November 1, 2017. The Delegation explained that the proposal involved significant procedural changes for Germany, also affecting IT systems; should the provision be approved in the next session of the Assembly, there would not be time enough to deal with the required changes.

134. The Chair clarified that the current session should only agree in principle on the proposed procedure; in the next meeting, paragraph (7) of Rule 21, would be further discussed, as well as the entry into force of the rule as a whole.

135. The Delegation of Germany was satisfied with the explanation and asked that the Summary by the Chair specify that Rule 21 would not enter into force on November 1, 2017.

136. The Delegation of Japan stated that the proposal might impinge on the IT system and procedures of its Office, and that that fact should be borne in mind by the International Bureau when proposing the date of entry into force.

137. The Delegation of Cuba elaborated on the scope of replacement and noted the relation with the notion of equivalence of goods and services, which had been extensively discussed in the previous sessions of the Working Group.

138. The Chair informed the Delegation of Cuba that the Secretariat would consider the issue and eventually integrate in the next proposal the result of the previous discussions.

139. The Delegation of Switzerland observed that in item (v), the information regarding the registration date and number had been deleted in English but not in the French version.

140. The Chair confirmed the agreement to delete the reference to date and number of the registration.

141. The Delegation of Germany asked whether, according to the previous discussion, item (v) should have been deleted from the draft.

142. The Chair recalled the intervention of the Delegation of Cuba on the need to consider earlier discussions on the issue, and the conclusion that the Secretariat should review the matter in view of adapting the text accordingly for the next session of the Working Group.

143. The Delegation of Belarus pointed out the need to reconsider the deletion of the reference to the filing date and number, since it would mean that such information would not appear in the International Register; as a consequence, the priority date of the trademark would be missing.

144. The Delegation of Cuba observed that paragraph (2)(a)(i) referred to the international registration number, whereas in item (v) there was not a repetition of that number. The Delegation clarified that, in her intervention during the previous discussion of the proposal, she had elaborated on the relationship between paragraphs (2)(a)(iv) and (5).

145. The Delegation of the Russian Federation clarified that, on the issue of the need to include the filing date and number of the national or regional registration or registrations to be replaced, the registration number would be essential. The Delegation further stated that, regarding the priority date of the registrations, the application date and number would be relevant, because they would help determine the priority date of the national or regional registration; the Delegation considered that they should be retained in the new draft.

146. The Delegation of Belarus explained the need to keep the application date and number, thus ensuring correspondence with the information to be notified under paragraph (3)(b) after examination by the Office to the International Bureau.

147. The Delegation of Norway supported the views expressed by the Delegations of Belarus and the Russian Federation. The Delegation esteemed it was important that at least the application date be included in the notification from the Office to the International Bureau, and that it should appear in the International Register.

148. The Delegation of Algeria supported the inclusion of the application date and number.

149. The Chair concluded that there was agreement on the re-introduction of the reference to the application date and number and recalled that, in the next session of the Working Group, the Secretariat would present a new proposal including the revised wordings of paragraphs (5) and (7).

150. The Delegation of Germany recalled that the Working Group, in its next session, should focus on paragraphs (5) and (7) as well as the date of entry into force of the amended provision.

RULE 22

151. The Secretariat elaborated on the two proposals to amend Rule 22; the first proposal (option A), was to delete paragraph 1(b) and the second one (option B), to amend paragraph 2(b). The Secretariat explained that paragraph 1(b) provided that where a judicial action or proceeding began before the expiration of the five year pendency period but had not resulted in a final decision or withdrawal or renunciation before the expiration of that period, the Office of origin should, where it was aware of that fact, notify accordingly the International Bureau which would record the notification and transmit a copy to the Offices of the designated Contracting Parties and to the holder. The Secretariat further explained that should the actions or proceedings not result in a decision of ceasing of effect, the information remained in the International Register, since there was no obligation for an Office to withdraw the information; holders of international registrations might thus find it difficult to exercise their rights, for example, to transfer their international registrations because the information recorded in the register would indicate that there existed ongoing proceedings which might result in the cancellation of their rights. The Secretariat noted that the proposal to delete paragraph 1(b) would improve the current situation by requiring that an Office send a notification and request a cancellation of the international registration only once the basic mark had ceased to have effect following a final decision. The proposal might also reduce the workload of both Offices of Contracting Parties and the International Bureau, since they would not be obliged to effect notifications and recordings regarding non final decisions concerning the fate of the basic mark. However, as an alternative, if there would be a wish to preserve in the International Register the information concerning ongoing actions that might result in the ceasing of effect of the basic mark, the Working Group might wish to maintain paragraph 1(b); in such case, in order to mitigate the uncertainty for the holder, paragraph 1(c) might be modified to require that the Office of origin also send a notification when the final decision did not result in the ceasing of effect of the basic mark.

152. The Delegation of Japan expressed its preference for option B, with a view to ensuring legal predictability.

153. The Delegation of Norway recalled that in its view, the principle of dependency had a negative impact on legal certainty. The Delegation further recalled that it supported proposals that would contribute to reduce uncertainty by providing information about ongoing actions and their final results, which were valuable information for holders and third parties; information about ongoing actions that might threaten protection in many jurisdictions was better than no information at all; eventually, ceasing of effect would to a lesser degree come as a surprise. Consequently the Delegation supported the proposal to keep paragraph 1(b) of Rule 22 and to amend paragraph 1(c).

154. The Delegation of Germany stated that it preferred option A, since it reduced legal uncertainty. The Delegation said its Office only sent notifications concerning final decisions, not procedures underway or not finalized and indicated that that solution was also the most practical one for holders, allowing them to safely manage the trademark portfolio, for instance for transfer of the mark purposes. The Delegation further stated that only notifications of final decisions could guarantee that the register was certain and trustworthy.

155. The Delegation of France supported option A and the explanations of the Delegation of Germany; that option would simplify the work of Offices and the International Bureau, enabling Contracting Parties to notify ceasing of effects once the Office had been made aware of the final decision.

156. The Delegation of Denmark expressed preference for option A, as it considered it to be the most practical solution.

157. The Delegation of Italy favored option A. The Delegation indicated that non-final decisions might create confusion and risks for holders; clarity and simplicity advised to only inscribe final decisions.
158. The Delegation of the United States of America considered that option A resulted in a loss of transparency and thus favored option B.
159. The Delegation of Australia declared it was in favor of transparency, as it esteemed it was preferable to have more complete and timely information available; the Delegation thus favored option B.
160. The Delegation of New Zealand considered that, as had been noted by previous delegations, option B did seem to be the preferable choice if transparency was desired.
161. The Delegation of the Republic of Korea supported option B on the grounds that it would enhance legal certainty and transparency through notification of judicial actions and proceedings after they had been completed. The Delegation further stated that Offices of origin were mandated to notify decisions to the International Bureau promptly.
162. The Delegation of Colombia supported option B in the interest of transparency.
163. The Delegation of Montenegro favored option B, as it considered it was both pragmatic and transparent.
164. The Delegation of the Russian Federation supported option A; the Delegation considered that option was clearer and more precise, whereas option B would make it more difficult to satisfactorily use the Madrid System.
165. The Delegation of Mexico supported option A, which it considered simpler; the Delegation stated that notifications of non-final decisions contributed to create confusion.
166. The Delegation of the Czech Republic expressed support for option A, since it added certainty on the basis of a final decision.
167. The Delegation of Spain supported option A.
168. The Representative of MARQUES considered that further reflection was convenient, yet it also esteemed that owners would have interest in having all relevant information and thus supported option B.
169. The Representative of JPAA also supported option B, as it would increase legal certainty and transparency of international registrations through the provision of information on the current status of the mark, and would assist in foreseeing the evolution of that status.
170. The Representative of APRAM favored option B, since it provided more information, especially given the fact that information in the databases of Offices of origin was not always as easy to consult, due to linguistic reasons, as the information in the International Register.
171. The Delegation of Cuba favored option B.
172. The Delegation of the Czech Republic stated that, upon further reflection, it had come to the conclusion that it would be best to have full information on the evolution of the concerned mark. However, the Delegation noted that sometimes Offices were not in a position to provide the International Bureau with timely information simply because such information was not available to the Office in due time; the Delegation wondered whether it would be possible to devise an option C.

173. The Delegation of OAPI considered that option B provided the best security for right holders and users; yet, as indicated, by the Delegation of the Czech Republic, a problem for conveying information did exist: OAPI had 17 member states and the analysis of the validity of titles sometimes meant processes before the courts in member states; this fact sometimes made it difficult to obtain information on the decisions made by member states. Still the Delegation thought that option B provided the best guarantees.

174. The Delegation of Italy remarked that the system had to be user-friendly, and so opinions of users ought to be considered. The Delegation also considered there was merit in the observations of the Delegation of OAPI: option B would not provide a harmonized approach. Consequently, the Delegation still thought option A provided the best possible solution, through the notification of a final decision.

175. The Delegation of Germany recalled that, where decisions outside the Office were concerned, the Office would only be aware of final decisions. Only final court decisions were available to the Office, thus legal certainty for users would be better served if final decisions were notified. Yet the Delegation stated that proper legal certainty required that all final decisions were notified to the International Bureau.

176. The Delegation of the Republic of Moldova considered that option A might be more interesting for Offices, in terms of clarity of the information provided, yet for users option B might be preferable, since it envisaged the provision of complete information.

177. The Representative of APRAM stated that, as an organization of users, it was not looking for certainty in the information provided by the International Register; it was looking for knowledge of the evolution of the basic mark that might be of use to ascertain its situation at the national level, instead of only having information at the end of a process possibly undertaken several years earlier; that was why the Representative still thought that the availability of as much information as possible was the best avenue.

178. The Secretariat recalled the intervention of the Delegation of the Republic of Moldova and stated that users were, in general, well aware of the different transactions operated in the system; the long-term goal should be to provide detailed information on operations effected in Contracting Parties. The Secretariat reflected that the availability of more granular information, even if initially incomplete, was a step that was consistent with such approach.

179. The Chair recalled that the objective of the proposal was that, where the International Bureau had been notified of a given proceeding, it should be informed of the outcome of such proceeding even in situations where the result would not affect the basic mark and the international registration. The Chair recalled the interest of detailed information for users and suggested a reconsideration of option B, with a view to accommodating the interests of users while facilitating the work of Offices; to that effect, the Chair proposed to amend paragraph (c) of Rule 22 by including the possibility for holders to also notify the International Bureau. The Chair explained that any defective information provided by holders would eventually be corrected by the Office once a final decision would have been made.

180. The Delegation of Cuba expressed agreement with the line of thought of the Chair. The Delegation further suggested the insertion of the obligation of the Office to send a final decision not resulting in a ceasing of effect of the basic mark, thus remedying any eventual uncertainty.

181. The Representative of MARQUES supported the proposal by the Chair. The Representative considered that it would ensure the availability of full and continuous information.

182. The Delegation of Ghana said that though the Delegation had initially supported option B, it could now favor the proposal by the Chair, since it seemed to be in line with the interests of users.

183. The Representative of INTA considered that the proposal by the Chair might raise an issue for certain operators of the system reluctant to see information unchecked by an authority included in the International Register. The Representative suggested a reformulation of the last sentence of paragraph (c), to envisage that the Office of origin should notify the International Bureau where it had been made aware by an authority of the country or an interested party; in that way, the information would come from the Office of origin.

184. The Chair proposed to seek inspiration in Article 6 of the Madrid Agreement, which envisaged the possibility for a holder to ask the Office to send information about the outcome of a judicial process to the International Bureau; the Chair suggested to go along that line, by including the case where the Office of origin, at the request of the holder, should notify the International Bureau. The Chair explained that holders would have to inform Offices that proceedings had concluded without affecting the international registration; Offices would then have an opportunity to consider the final decision and make sure that such would be the case, subsequently sending the relevant information to the International Bureau.

185. The Delegation of Italy supported the proposal by the Chair.

186. The Delegation of Germany asked for clarifications on the wording and whether the Office should notify the International Bureau where no information from the holder had been received.

187. The Chair clarified that his proposal consisted in the insertion of an additional possibility of notification by the Office sent at the request of the holder.

188. The Delegation of Belarus supported option B, as it considered that the wording proposed by the Chair could raise issues, at least in the case of its country. The Delegation explained that the supreme court had jurisdiction in intellectual property cases; once a case was decided upon, the court would notify the Office. Consequently, the proposal might best be worded as an option, indicating that also where the Office of origin was made aware by the holder, it would promptly notify the International Bureau accordingly.

189. The Representative of INTA suggested a wording to the effect that the Office of Origin should, on its own motion or at the request of the holder, notify the International Bureau accordingly.

190. The Delegation of Belarus stated that a reference to the awareness of the Office was an indispensable element in the proposed provision.

191. The Delegation of Algeria supported option B. The Delegation explained the preferred option provided greater clarity as to the background of the mark, as well as access to the full history of the mark from the beginning to the end. The Delegation also supported the proposal by the Chair as to the request by the holder, but asked whether there would exist a deadline for the holder to provide the relevant information.

192. The Chair replied to the question of the Delegation of Algeria, and provided the example of court proceedings, that were subject to appeals and could take years to be finalized. The Chair confirmed the difficulty to introduce deadlines; only a reference to the fact that the notification should be effected promptly could be included.

193. The Representative of MARQUES said that introducing deadlines would not be helpful and observed that information was relevant not only for holders, but to third parties as well; thus the availability of information for all interested parties was the essential element of the discussion.

194. The Delegation of Antigua and Barbuda supported option B in the form it had been presented.

195. The Delegation of Germany asked for a clarification whether the additional wording related only to situations where a decision had not affected the protection of the international registration, as other kinds of decisions had to be notified to the International Bureau.

196. The Chair confirmed the interpretation of the Delegation of Germany.

197. The Representative of INTA stated that holders were interested in the first place, yet the mention of interested parties related to the fact that there might also be other interested parties in having the information recorded, such as licensees.

198. The Delegation of Belarus stated that the original proposal could cover all cases, since the Office of origin would act where it would be aware, regardless how it had been made aware, either by the licensee, the holder or a court.

199. The Chair concluded that there was no objection to option B as proposed amended and thus the International Bureau should propose a text accordingly.

200. The Secretariat presented a second proposal concerning an amendment to paragraph 2(b) of Rule 22: The proposed amendment was meant to clarify that a ceasing or effect of the basic mark would affect not just the parent international registration, but any international registration resulting from partial change of ownership recorded under the international registration mentioned in the notification of ceasing of effect, as well as those resulting from their merger.

201. The Delegation of Denmark supported the proposed amendment.

202. The Delegation of Switzerland also supported the proposed amendment.

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

204. The Representative of INTA supported the proposal. The Representative observed that the expression “to the same extent” might introduce ambiguity, since where the partial change in ownership covered only some of the goods and services included in the international registration, under Section 16(b) of the Administrative Instructions, those goods and services were canceled from the parent international registration. The Representative of INTA suggested to replace “to the same extent” by “to the extent applicable”.

205. The Chair accepted the suggestion of the Representative of INTA.

PROPOSED NEW RULE 23BIS

206. The Secretariat presented new proposed Rule 23*bis*; the background of the proposal was the latest session of the Working Group, where some Offices had informed that they had no means to send certain communications to non-resident holders who had indicated neither an address for service in their territory nor appointed a local representative. The Secretariat explained that, in order to assist Offices, new proposed Rule 23*bis* would enable designated Offices to transmit communications through the International Bureau. Where the International Bureau would receive such communications, it would not examine their contents, nor inscribe it in the International Register but simply transmit the concerned communication to the holder or to the recorded representative.

207. The Delegation of Israel informed that Israeli law did not permit sending direct communications to non-resident holders and thus the proposal was useful as it allowed contact with holders not yet having appointed a representative in Israel.

208. The Delegation of Mexico supported the proposal, as Mexican law did not provide with the possibility to contact non-resident holders either.

209. The Delegation of the Republic of Moldova supported the proposal.

210. The Delegation of Japan supported the proposal and asked for clarification whether the means of the communication would include e-mail, postal service or both.

211. The Secretariat explained that it would be necessary to further discuss the issue with Offices, as well as analyze implementation with the concerned IT and operational units in the International Bureau. Yet the Secretariat clarified that electronic communication was the preferred option.

212. The Delegation of Cuba supported the proposal and indicated that electronic communication should not exclude the use of other means such as ordinary mail or fax.

213. The Secretariat said that though the medium to long term goal was to communicate electronically, it would make sure that countries needing to use other types of communications would also get the information required.

214. The Delegation of Kenya expressed concern on paragraph (1) of the proposed provision, where it referred to the law of a Contracting Party; the Delegation asked whether cases other than the law of a Contracting Party not allowing communications were included in the proposal.

215. The Chair clarified that the proposal only covered cases where the law of the designated Contracting Party did not allow the Office to communicate directly with the holder.

216. The Delegation of Italy favored the proposal as well as electronic communication. The Delegation asked whether the communication should be sent to the competent Madrid Processing Team or whether the subject of the communication would determine the addressee.

217. The Chair explained that the question of the Delegation of Italy would be addressed once the draft rule had been adopted.

RULE 27 AND ADMINISTRATIVE INSTRUCTION 16

218. The Secretariat explained that Rule 27, paragraph (2), which provided for the creation of a new international registration following the recording of a partial change in ownership, and also established a numbering of such registration, was deleted on April 1, 2002; the rule then became Section 16 of the Administrative Instructions. The Secretariat said that the numbering of international registrations was better dealt with in the Administrative instructions, but the provisions for the creation of a new international registration and for the merger of such registrations should be comprehensively dealt with in the Common Regulations. The Secretariat explained that proposed new Rule 27(2) envisaged the reintroduction of the creation of a new international registration, following the recording of a partial change in ownership, whereas Section 16 of the Administrative Instructions would be amended to deal exclusively with the numbering of the international registration.

219. The Representative of INTA observed that the substantive part of Section 16 of the Administrative Instructions had been transferred to Rule 27, and asked for an explanation from the Secretariat on the change of language introduced on the occasion of that transfer and its possible implications, since paragraph (b) of Section 16, as it currently stood, read “[...] any assigned or otherwise transferred part shall be canceled under the said international registration and recorded as a separate international registration”, whereas, the Representative noted, the proposal read “[...] shall be separated from”.

220. The Secretariat clarified that by replacing the word “cancelled” with “separated” the intention was not to change the substance of the provision, but merely trying to avoid the word “cancellation” as it had a very specific meaning in the Madrid System.

221. The Representative of INTA further asked whether his understanding that the parent registration would no longer carry the separated goods and services, as they would have been deleted or separated from the parent registration was correct.

222. The Chair confirmed the assumption of the Representative of INTA.

223. The Delegation of Germany concurred with the Representative of INTA that “separate” was not an adequate legal term; its meaning was not clear for the Delegation who observed that it might be better to use the expression “canceled from the international registration and recorded as a separate international registration”.

224. The Chair suggested to replace the word “separated” with “deleted”. The delegations accepted the suggestion of the Chair and the rest of the proposal.

RULE 32

225. The Secretariat went on to explain a proposed amendment to Rule 32(3); the provision envisaged that the *WIPO Gazette of International Marks* (“the Gazette”) should be published on the WIPO website. The Secretariat stated that the existing format of the Gazette might change in the future and be published in a way that better took advantage of the available technology; to anticipate such possibility, it was proposed that Rule 32(3) be modified to simply indicate that publications should be made on the WIPO website.

REDRAFTED PROPOSED RULES 3 AND 25

226. The Chair opened the discussion on redrafted proposed Rules 3 and 25.

227. The Secretariat recalled that a small modification had been added to Rule 3(4), providing that the International Bureau should notify the recording referred to in subparagraph (a) to both the applicant or holder, and in the latter case, the Offices of the designated Contracting Parties, as well as the representative. The Secretariat indicated that new paragraph 6(f) stipulated that the cancellation of the recording of the representative should also be notified to the Offices of the designated Contracting Parties. The Secretariat then elaborated on the fact that any change in the recording concerning the representative had always been interpreted as falling within Rule 25, and, in fact, form MM10, also referred to Rule 25; it was thus now proposed to explicitly mention in Rule 25 the change in a name or address of the representative.

228. The Delegation of OAPI stated that the wording of subparagraph (6)(f) of Rule 3, was not correct, in the French version.

229. The Delegation of Switzerland observed that the translation of item (iv) in Rule 32(1) was wrong in terms of language.

230. The Secretariat then presented a further amendment to Rule 32(1)(xiii), to introduce the publication of recordings of the appointment of the holder’s representative communicated under Rule 3(2)(b) and cancellations at the request of the holder or the holder’s representative under Rule 3(6)(a).

231. The Delegation of Switzerland pointed out a minor problem concerning item (xiii) in Rule 32(1), since there were some inconsistencies in the French version.

232. The Representative of INTA pointed out that the recording of representatives was effected after the International Bureau was satisfied that the appointment was not irregular, thus the Representative of INTA suggested to refer the recordings of the appointment of representative, in item (xiii), to Rule 3(4), instead of Rule 3(2).

233. The Secretariat explained that the reference to Rule 3(2) or, rather, to Rule 3(2)(b) was justified by the fact that the publication alluded to the appointment of representative received in a separate communication.

234. The Secretariat then presented revised draft Rule 18*ter*(4), which should read "Where a notification of provisional refusal has not been sent within the applicable time limit under Article 5(2) of the Agreement or of the Protocol, or, where following the sending of a statement in accordance with either paragraph (1), (2) or (3), a further decision, taken by the Office or other authority, affects the protection of the mark, the Office shall, to the extent that it is aware of that decision, without prejudice to Rule 19, send to the International Bureau a further statement indicating the status of the mark and, where applicable, the goods and services for which the mark is protected in the Contracting Party concerned".

235. The Delegation of China expressed opposition to the amendment, as it would increase the workload of the holder as well as increase uncertainty.

236. The Secretariat explained that the purpose of the proposed amendment was to allow Offices more flexibility and make it easier for them to notify to the International Bureau a decision made in accordance with the national legislation, without having to refer to the history of the case. The Secretariat clarified that where a court decision had been made against which no appeal would be possible under the national law, notifications under Rule 19 continued to be applicable.

237. The Chair explained that the proposed amendment merely introduced an option for Offices in specific situations.

238. The Delegation of China stated that in view that the proposed amendment introduced an option, it could support it.

239. The Working Group agreed:

(i) to recommend to the Madrid Union Assembly the adoption of the amendments to Rules 3, 18*ter*, 22, 25, 27 and 32 and the introduction of new Rule 23*bis* of the Common Regulations, as amended by the Working Group and as set out in Annex I to the present document, with November 1, 2017, as the date for their entry into force;

(ii) with the proposed amended Section 16 of the Administrative Instructions with the same date of entry into force, as contained in Annex I to the present document; and

(iii) with the proposed amendment to Rule 21, paragraphs (1) to (4) and (6), as amended by the Working Group and as set out in Annex II to the present document, and requested the International Bureau to prepare a document on paragraphs (5) and (7) of the proposed amended rule, suggesting a date of entry into force to be discussed at the next session of the Working Group.

AGENDA ITEM 5: PROPOSAL FOR THE INTRODUCTION OF THE RECORDING OF DIVISION AND MERGER CONCERNING AN INTERNATIONAL REGISTRATION

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

241. The Secretariat introduced the proposal and explained that in its last session the Working Group agreed that the new proposal should provide for four additional elements; one was the option for the Office sending the request to verify that such request fulfilled the requirements established in its applicable law; the second was the option for the same Office to transmit statements regarding the status of protection of the mark along with the request for division; the third option should be an opt out provision and, in addition, a transitional delayed implementation provision for division; finally, the similar opt out and delayed implementation provisions for the merger of international registrations resulting from division. The Secretariat recalled that as a part of the preparations for the meeting, the Working Group invited delegations and observers to send to the International Bureau further contributions for the development of the proposal; valuable contributions had been received from the Office of Switzerland as well as from INTA, and had been taken into account in the drafting of the document. The Secretariat further explained that the new proposal would entail amendments to Rules 22, 27, 32 and 40 as well as to Sections 16 and 17 of the Administrative Instructions, and the introduction of new Rules 27*bis* and 27*ter* and new item 7.7 in the Schedule of Fees.

NEW PROPOSED RULE 27BIS

242. The Secretariat presented new proposed Rule 27*bis*. The new provision dealt with division of an international registration; the request for division would need to be submitted through the Office of the concerned designated Contracting Party; a fee would be payable to WIPO for the request for recording of division; the Secretariat informed that designated Contracting Parties might also request the payment of a fee. The Secretariat indicated that after the Office had determined that the request met the requirements of the national law, it should send the request to the International Bureau; the International Bureau would then verify that the request complied with the formal requirements for the recording of division of the parent international registration; this would be done by creating a divisional registration. The Secretariat informed that the same principles and processes currently observed for the recording of a partial change in ownership would be followed, which meant the use of the same international registration number and the addition of a letter. The Secretariat further explained that the request presented by the Office would need to indicate the date on which the Office received the request from the holder and, where applicable, the date on which division would have effect on the Contracting Party concerned; the date of effect of a divisional registration would be the date of effect of its parent registration. The Secretariat elaborated on the fact that a divisional registration would continue to have the same effects as the parent registration and contain the same relevant information contained in that registration; any decision concerning the scope of protection made by the Office in respect of the parent registration would also continue to have effect in the new international divisional registration; the divisional registration would have as the only designated Contracting Party that of the Office which sent the request, and only the goods and services listed in the request would be in the main list of the divisional registration. The Secretariat observed that recordings relevant to the Contracting Party concerned such as cancellations, limitations, decisions, *etcetera*, would be recorded also under the divisional registration; as regarded the possibility for the Office to provide a statement on the status of protection of the mark, it might send it either simultaneously but in a separate document or included in the request as part of the official form. The Secretariat then elaborated on the possibility, provided for in Rule 27*bis*(6), to opt out; this possibility would be limited to those Contracting Parties whose legislation did not provide for division. The Secretariat recalled that in the last session of the Working Group certain Contracting Parties observed that their national laws allowed for division, but they would need to make amendments to implement the division of international registrations; those Contracting Parties would have the possibility of notifying the International Bureau accordingly, under new paragraph (6) of Rule 40, to the effect of suspending the application of new Rule 27*bis*(1). The Secretariat announced a proposed

consequential amendment to Rule 32 foreseeing the publication of any received notification on delayed implementation. The Secretariat then informed of a proposal to amend Rule 22, to explicitly mention that the divisional registration would be canceled following the receipt by the International Bureau of a notification requesting the cancellation of the parent registration due to the ceasing of effect of the basic mark.

RULE 27TER

243. The Secretariat then elaborated on the second part of the proposal, concerning merger; the current proposal included the deletion of Rule 27(3), to be replaced by a new Rule 27ter, comprehensively dealing with the merger of international registrations; new Rule 27ter(1) would deal with the merger of international registrations resulting from the recording of a partial change in ownership while new Rule 27ter(2) would contemplate the merger of divisional registrations with the parent registration only. The Secretariat explained that the request for merger would have to be presented by the holder through the designated Office that presented the request for division and only where that Office would have verified that the request complied with the requirements of its applicable law, including any payment of fees; only then would the Office be able to send the request to the International Bureau. The Secretariat stated that, similarly as for division, the proposal included opt out declarations for those Contracting Parties not having provisions for merger in their national legislations, as well as the possibility of notifying a delayed implementation due to the need of making necessary amendments to national laws.

244. The Secretariat finally indicated that amendments to Rule 27 and Sections 16 and 17 of the Administrative Instructions were proposed, in order to address a perceived legal incongruence, following which only the numbering of international registrations would be dealt with in the Administrative Instructions.

245. The Delegation of Madagascar stated that its legislation did not provide for division and Madagascar would thus make the corresponding declaration. The Delegation said it agreed with the proposed date of entry into force of April 1, 2018.

246. The Delegation of Korea considered that the procedures for division should be simple and workable in order to limit the increase in workload of the International Bureau and Offices.

247. The Delegation of Switzerland supported the proposal, and suggested the consideration of a different date of entry into force, since hopefully Contracting Parties would not need too long to make the necessary adaptations. The Delegation observed that a declaration of reservation was foreseen for Contracting Parties whose national laws did not envisage merger but might have division in their national laws. However, since merger existed as an international recording in cases of partial change in ownership, the Delegation considered that the provision on merger should be binding for such Contracting Parties, without the opt out option; the Delegation esteemed that the mechanism could be the outcome of a partial change in ownership and the same rule, in fact, could cover both types of merger. The Delegation further reflected on the fact that concerned Contracting Parties could offer more detailed explanations as to why, despite the fact that mergers already existed in the Madrid System for recordings following a change in ownership, it would not be possible to follow the same rationale for recordings of divisions. The Delegation declared itself open on the point of the inclusion of statements of protection, and considered January 1, 2018, as a reasonable date of entry into force. The Delegation announced that Switzerland would not make a declaration of reservation, given that division was a well-known principle that existed in its national legislation.

248. The Delegation of China considered that the proposal added burden to the workload of Contracting Parties and might occasion problems to their functioning. The Delegation added that the proposal might negatively impinge on the use of the system and considered that the introduction of division in the Madrid System was premature.

249. The Representative of JIPA informed that JIPA was a private organization established in 1938, which consisted of some 900 Japanese companies. The Representative of JIPA supported the proposal to introduce division and merger, as it would be very useful for most users. The Representative explained that division was an interesting option where provisional refusals were sent; additionally, it contributed to make the Madrid System simple and user-friendly; merger would be of special interest to Japanese companies, not very familiar with that mechanism.

250. The Representative of INTA expressed general satisfaction with the proposal, with the same reserves as voiced by the Delegation of Switzerland; these reserves had to do with, in the first place, the transitional provision. The Representative said that INTA, like the Delegation of Switzerland, would like to see that provision nuanced by some kind of time limit. The Representative of INTA elaborated on the relevance of merger, which derived from one of the core purposes and main advantages of the international registration system, namely, to enable trademark owners to maintain the protection of their titles at the international level in one single international registration. Hence, where, for example, part of an international registration had been transferred to another party and was later transferred back to the original owner, the international registration resulting from the partial transfer was merged back with the parent registration irrespective of whether or not the law of the Contracting Party or Parties concerned provided for merger at the national level; the mechanism was totally independent of the national legislation, as it was a feature of the Madrid System itself. The Representative of INTA further observed that where a trademark owner extended only part of the goods and services covered by his registration to a Contracting Party, he might later, in a subsequent designation, extend to that same Contracting Party other goods and services contained in his basic mark; and, in effect, the subsequent designation was *de facto* merged into the original international registration even though at the national level the owner of the trademark would have needed to file a new application and obtain a new registration. The Representative of INTA acknowledged that certain delegations had expressed some issues with merger, and had requested the International Bureau to investigate those difficulties with a view to determining whether they could be solved by a transitional provision as proposed in Rule 40, but not by an opt out provision. The Representative said he could not find in the document indications regarding the outcome of any such investigations by the International Bureau and therefore, like the Delegation of Switzerland, would respectfully urge those Contracting Parties having difficulties to consider whether the proposed transitional provision would solve their issues with merger.

251. The Delegation of the European Union highlighted the value for users of the possibility to divide an international registration thereby achieving coherence with the international standard provided for both under the Trademark Law Treaty (TLT) and the Singapore Treaty on the Law of Trademarks (STLT). The Delegation said that, at the same time, it was necessary to maintain the philosophy of the Madrid System, namely keeping the international system as simple as possible. The Delegation noted that the division of an international registration should result in a new international registration; therefore the Delegation endorsed the proposed adoption of new Rules 27*bis* and 27*ter*, including the necessary consequential amendments to the Common Regulations, Administrative Instructions and Schedule of Fees. The Delegation also supported the opt out provision in paragraph (6) of proposed new Rule 27*bis* for those Contracting Parties whose legislations did not provide for division, as well as the delayed implementation for Contracting Parties whose national laws did. On the issue of merger, the Delegation supported the proposal of an opt out declaration limited to Contracting Parties whose national laws did not provide for the merger of divisional registrations. Finally, the Delegation proposed that the date of entry into force of the amendments be fixed for February 1, 2019, and requested that the Director General of WIPO invite Offices to send information regarding possible opt out or delayed implementations before the date of entry into force.

252. The Delegation of Colombia considered that including division in the International Register might lead to very complex situations; it could make the system more expensive for users, and imply structural changes in the International Bureau. Consequently, the Delegation esteemed

that it was necessary to further discuss certain aspects of division as well as analyze mechanisms for recording division in national registers whenever the legislation established the possibility of a division of an international registration.

253. The Delegation of Mexico recalled that Mexico did not have division in its national system. The Delegation asked the Secretariat whether when a country not having division received a request for division it should consequently send it to the International Bureau.

254. The Secretariat replied to the question of the Delegation of Mexico stating that if the national legislation did not provide for division, there existed the possibility to opt out, thus if an Office received a request for division and was not in a position to forward it to the International Bureau, that Bureau would not receive the request, since it had to be sent through the Office.

255. The Delegation of Australia recalled that the Government of Australia had announced an election to be held on July 2, 2016; as a result, the Office was under a caretaker government arrangement, which meant that it could not enter into any agreements or make any decisions that might bind an incoming government. The Delegation noted that Australian law did not provide for either division of international registrations or for the merger of divisionals; because legislative and regulatory amendments might take some time to develop and pass through domestic processes, the Delegation appreciated the new proposals for opt out and delayed implementation. The Delegation declared that it still considered that entry into force in April 1, 2018, was quite unrealistic in the Australian context. The Delegation asked whether a Contracting Party having sent information about an anticipated date by which its law would be compatible with the proposed changes and later realizing that the law would not be compatible by that date might amend the initial notification.

256. The Delegation of the Republic of Moldova supported the proposal and informed that, though the Republic of Moldova had division at the national level, it would need to introduce changes in its domestic law. Nevertheless the Delegation considered the proposal was in the interest of users.

257. The Chair recalled the question by the Delegation of Australia, concerning dates included in notifications to the Director General; the Chair wondered whether a date was required and observed that proposed Rule 40 simply referred to a notification and stated that the notification should be withdrawn as soon as the provisions concerned became compatible with the national law.

258. The Delegation of France concurred with the statement by the Delegation of the European Union and its member states; the Delegation had some questions concerning the implementation of the proposal, since its national law envisaged the division of an application of a national mark, but did not include the possibility of division after registration had taken place, nor the division of an international mark. Therefore, the Delegation wondered whether the implementation of the proposal might be postponed until the domestic law had been adapted. The Delegation further informed that its national law did not envisage merger and would thus make a declaration in that respect.

259. The Secretariat answered the question of the Delegation of France and stated that since the domestic law on division did not seem to be compatible, delayed implementation might be used; as far as merger was concerned, since it did not exist in the national law, opt out would be applicable.

260. The Delegation of the United States of America raised some issues based on its domestic practice. The Delegation informed that its national law provided for division; division was commonly used where a substantive refusal had been issued for only part of the goods or services; the application was thus divided and could proceed to registration for the goods and services that had not been refused. The Delegation noted the cost that users in the United States of America would incur with the implementation of the proposal. The Delegation

informed that under its national practice, where extension was requested and division occurred, the same process applied as for national applications; fees were charged and division resulted in a parent and a child application. However, the Delegation observed that holders of international registrations had the advantage over national applicants of paying only one set of renewal and other maintenance fees. The Delegation remarked that the proposal implied the creation of two international registrations for which two sets of fees would now be payable, which meant a raise in costs. The Delegation concurred with the Delegations of Australia and the European Union on the concern regarding the date of entry into force. The Delegation explained that the proposal implied significant domestic changes to accommodate the additional international registration number. Consequently, the Delegation supported the European Union's proposal of February 1, 2019, as the date of entry into force. Concerning merger, the Delegation recalled that division at the national level occurred in cases of substantive refusal based on lack of distinctiveness or likelihood of confusion; in cases of likelihood of confusion, usually a co-existence agreement was reached and thus the refusal was overcome; but in cases of lack of distinctiveness, users typically amended the application, for instance by adding a disclaimer or proving acquired distinctiveness to overcome the refusal; the result was a parent and a child registrations actually having different scopes of protection. The Delegation wondered how such a situation could be accommodated at the national level if merger was effected, and how the relevant information might be tracked in a way that would be transparent for both Offices and users. The Delegation referred to the periodic affidavits of use required by its national law; the deadlines for filing them referred to the registration date, which was the date on which protection had been granted; the issue was that the parent and child registrations would typically have different registration dates under the domestic law, thus where affidavits of use needed to be filed the relevant dates would be different; in cases of merger of those registrations, it was not possible to change the dates; the applicant would have to file two or more different affidavits of use, tied to different dates and that would create confusion. Finally, the Delegation informed that a very profound change in its systems would be needed to accommodate the proposal.

261. The Representative of APRAM stated that he was aware that the process of introduction of division would be gradual and adequate timing was of the essence; yet, the Representative esteemed that division was an additional, advantageous tool for users.

262. The Representative of INTA thanked the Delegation of the United States of America for its explanations on the system of the United States of America. The Representative of INTA noted that the United States of America was, except for perhaps Colombia, the only member of the Madrid Union where the international registration could be divided, giving birth to divisional registrations in its register, which might enjoy different dates of effect; yet those national registrations resulting from the international registration remained merged, in effect. The Representative of INTA wondered why having two international registrations corresponding to two national registrations in the United States of America merged into one single international registration would make any difference.

263. The Chair summarized that the proposal had been made as flexible as could be; both opt out and delayed implementation were available. The Chair expressed hope that those delegations having voiced reserves would be able to let the majority continue with the adoption of the proposal. Concerning the question raised by the Delegation of Switzerland in relation to merger, the Chair considered that the discussion showed that there should be an opt out possibility. The Chair then proposed the examination of the draft rules.

264. The Delegation of Colombia said it was ready to be flexible, notwithstanding the fact that opt out possibilities might delay the process; yet the Delegation supported the notion of division.

265. The Delegation of Cuba considered that division would not occasion major problems for the Office. The Delegation thought that the main issue could be the availability of an automated system, though the Delegation of Cuba was confident that the issue could be overcome with the

eventual assistance of WIPO. The Delegation stated that merger rather than division might be a concern for its Office, since Cuba did not have a provision for merger of international registrations. The Delegation further noted that maybe Cuba would need to use the opt out mechanism in that respect.

RULE 27BIS (CONTINUED)

266. The Chair opened the discussion on Rule 27*bis*.

267. The Delegation of Germany wondered what goods and services should be indicated in the request; the Delegation thought there was no decision in that respect.

268. The Secretariat clarified that it would be up to the holder to decide which part of the list to set out in the new divisional registration.

269. The Delegation of Germany stated it did not need paragraph (1)(b)(vi), but would like to include in the provision the date of effect of the divisional registration.

270. The Delegation of Japan stated that it did not object to the introduction of division or merger as long as opt out provisions were included. The Delegation further stated that in its view, no conclusion had yet been reached on the issue of where the request for division needed to be filed, namely with the Office of the concerned Contracting Party or with the International Bureau; yet the document only considered the Office of the designated Contracting Party. The Delegation esteemed that both possibilities should be discussed.

271. The Secretariat elaborated on the issue raised by the Delegation of Japan, and explained that the proposal discussed in the previous session already indicated that the request had to be presented to the Office of the designated Contracting Party; there seemed to be a clear agreement in that respect, since delegations had stated that they needed to verify that requests would meet the requirements in their domestic laws as well as fee payment, where applicable.

272. The Chair elaborated on the issue raised by the Delegation of Germany, concerning the effective date of the division in the designated Contracting Party concerned; as there seemed to be no use for that date, the Chair suggested that it should be deleted from paragraph (1)(b)(vi). The Chair noted that where the reference to an effective date of the divisional registration was concerned, a conclusion had been reached that would have to be the date of the international registration.

273. The Delegation of Germany noted that, should the effective date of the divisional registration be retained, for clarification purposes, it might be included in paragraph 5.

274. The Representative of INTA said he did not object to the deletion, since what the Office of the Contracting Party concerned would send to the International Bureau was the request for division when it considered that the request met its applicable requirements, but the international registration would be divided at the level of the International Bureau, which in turn would notify the Contracting Party concerned of a new registration arising from the divided one.

275. The Chair opened the discussions of paragraphs (2)(c) and (d), noting that paragraph (d) contained a choice to accompany the request, or include in it, a statement under Rules 18*bis* or 18*ter*.

276. The Delegation of Germany favored that separate statements be provided, thus preferring the formula "to be accompanied by"; the reason was that the domestic IT system required two processes.

277. The Delegation of Australia said it did not have a strong preference, given the fact that new legislation would be needed, although in order to prevent errors it might be beneficial to have the statement included in the same form.

278. The Chair, for the sake of flexibility, proposed the formula "may include or be accompanied by", which was accepted.

279. The Chair opened the discussion on paragraphs (2) and (3).

280. The Delegation of Germany asked whether the refund of any paid fee referred to in paragraph (3)(b) alluded to the fee for the International Bureau or to national fees; should it be the latter fee, a re-formulation would be needed, for clarity purposes; the Delegation informed that its Office did not refund fees if the request did not comply with certain requirements and was rejected.

281. The Chair clarified that the fee at stake was that of the International Bureau.

282. The Delegation of Germany requested that the concerned fee should be specified in the text of the provision.

283. The Chair said the specification would be included in the provision, and proposed the formula "[...] refund any fee paid under paragraph (2), after the deduction of an amount corresponding to one-half of that fee". The Chair then opened the discussion on paragraphs (4) and (5).

284. The Delegation of Germany stated that the date of effect of the divisional registration should be expressly indicated in the rule, possibly in paragraph (5); in any event, wording specifying that the date of effect of a divisional registration would be the date of effect of its parent registration and that any priority claim made in the parent registration would be preserved should be expressly added in Rule 27*bis*.

285. The Secretariat explained that in the proposed provision the creation of a divisional registration was mirrored on the similar provision on partial change of ownership and the creation of a new international registration as well; where partial change in ownership was concerned, the date was not specified, although it was the same date as the date of the parent international registration. Consequently, the specification in the draft rule had not been deemed necessary; the same date and number would be shared by both registrations, with the addition of a letter to the new one.

286. The Chair stated that the relevant date was that of the international registration or, eventually, that of the subsequent designation; if a clarification was included in the draft rule, probably also amendments in relation to partial change in ownership would be needed. The chair considered that the simpler way would be not to change the wording.

287. The Delegation of Germany said that, although it considered that such an important element should be indicated expressly, the Delegation would be flexible.

288. The Representative of INTA noted the word “and” in paragraph (6): “A Contracting Party, the law of which does not provide for division of applications for the registration of a mark and registrations of a mark [...]”. The Representative remarked that that op out clause was open only to Contracting Parties not providing for both division of the application and division of the registration; as a matter of fact, some countries did provide for both, but an important number of countries would provide for one or the other, depending on whether they had a pre-registration opposition procedure or a post-registration opposition procedure. The Representative of INTA recalled that the STLT made division of the registration compulsory only where there was no division of the application before opposition. The Representative of INTA concluded that the word “and” might lead to misunderstandings and could be replaced by “or”.

289. The Chair noted that the draft rule should be re-worded, as the proposed formula provided more flexibility and opened the discussion on Rule 27*ter*.

290. The Delegation of Germany asked whether the reference to paragraph (1) in paragraph (2)(a) of draft Rule 27*ter* alluded to draft Rule 27*bis*.

291. The Chair confirmed that reference was made to draft Rule 27*bis*.

292. The Delegation of Germany asked whether the notification to the Director General in paragraph (2)(b) could be effected at any time, or should rather follow the formulation in draft Rule 27*bis*(6), namely, “[...] before the date this Rule comes into force or the date on which the said Contracting Party becomes bound by the Agreement or the Protocol [...]”.

293. The Chair confirmed that both formulations should coincide, and thus the wording in Rule 27*bis*(6) would be mirrored.

294. The Delegation of Mexico indicated that the Spanish version of the draft rule should indicate that the notification might be withdrawn at any time.

295. The Delegation of Japan asked for clarifications concerning the changes to Section 16 of the Administrative Instructions, specifically on the numbering of international registrations. The Delegation wondered how to identify the international registration after the request for recording of a division, but before the new numbering resulting from the division had been assigned; the Delegation asked whether the Office of the designated Contracting Party should assign a provisional number.

296. The Secretariat explained that, once the Office had confirmed compliance with its applicable requirements, it should notify the International Bureau, which would record and assign a number, the same as the parent registration, and the first available letter so as to fully identify the new divisional registration.

297. The Delegation of Cuba asked about the numbering of international registrations in cases of merger.

298. The Secretariat clarified that in cases of merger of divisional registrations a possibility would be to merge under the original number only; or where children registrations would be merged the same number with a different letter might be assigned as well; existing procedures for cases of partial change in ownership would be followed for merger.

299. The Delegation of Israel asked whether a Contracting Party would need to wait for the number from the International Bureau to be assigned before implementing the division, and asked that the processing by the International Bureau be fast.

300. The Secretariat answered that the International Bureau would process requests for division as speedily as possible.

301. The Chair opened the discussion on the date of entry into force, and recalled that a number of delegations had supported the date of February 1, 2019.

302. The Delegation of the United States of America recalled that it supported the date of February 1, 2019.

303. The Chair concluded that there was agreement on the date of February 1, 2019.

304. The Working Group agreed:

(i) to recommend to the Madrid Union Assembly the adoption of the proposed amendments to Rules 22, 27, 32 and 40, as well as the introduction of new Rules 27*bis* and 27*ter* of the Common Regulations, as amended by the Working Group, and the introduction of item 7.7 in the Schedule of Fees, as set out in Annex III to the present document, with February 1, 2019, as the date for their entry into force; and

(ii) with the proposed amended Sections 16 and 17 of the Administrative Instructions, with the same date of entry into force, as contained in Annex III to the present document.

AGENDA ITEM 6: THE FUTURE DEVELOPMENT OF THE MADRID SYSTEM FOR THE INTERNATIONAL REGISTRATION OF MARKS

305. The Chair asked the Secretariat to present document MM/LD/WG/14/4.

306. The Secretariat explained that the document amounted to a “macro” view of the system. The Secretariat presented two slides; the first slide showed the evolution of the use of the system in terms of filings, which were increasing: the previous year had seen a 2 per cent increase and an even bigger one was expected for the current year. The second slide dealt with the Madrid market share, namely the proportion of non-resident trademark filings that go through the Madrid System *versus* direct filing; that second slide showed that while in 2014 the market share was quite high, 60 per cent, it had nevertheless decreased compared to 2008/2009; that fact should trigger reflection about how the system was performing and how it should evolve. The Secretariat reflected that the Madrid System might either in its design or in its practical functioning not sufficiently meet the demands of users. The Secretariat noted that the purpose of the document was to present the issue and ask whether the Working Group would have interest in analyzing the evolution of the Madrid System at such “macro” level. The Secretariat remarked that the document offered no solutions; that would be too ambitious at the moment. The document was an inventory of issues that the International Bureau thought worth considering in view of the future well-being of the system. The Secretariat informed that the document had two parts; the first part dealt with the design of the system, namely the legal framework; the second part related to the practical operation of the system. Both aspects were equally important, and it would be the experience of holders and users which would determine whether they would continue to use the system or choose the direct route. The Secretariat noted that the Working Group tended to focus on design issues whereas the Roundtable targeted more practical issues. In an overall consideration, the output of the Working Group could be perceived as changes to the legal framework and that of the Roundtable as best practices or recommendations. The Secretariat stated that the document might function as a roadmap for the Working Group and the Roundtable as well as the International Bureau in the years to come. The Secretariat asked for feedback from delegations on the questions of how to create a framework of issues to work on in the years ahead, and whether some issues should be added to the document or deleted from it. Finally the Secretariat asked the Working Group for guidance as to which issues it would prefer to treat in depth in the short term.

307. The Delegation of Madagascar stated that even before adhering to the Madrid Protocol, Madagascar considered the Madrid System very attractive and beneficial for the economic operators in the country; eight years later, the system was effective even if the cares and expectations of holders and applicants had not totally been met. The Delegation expressed hope that the analysis of the issues in the document would contribute to making the system more effective while remaining realistic.

308. The Delegation of the United States of America declared interest in performance metrics and wondered whether the performance framework section in the document encompassed a quality control mechanism. The Delegation informed that its Office had a specific quality control process to review the work of its examining attorneys and ensure that it complied with the policy of the United States of America. Therefore, the Delegation could support a quality control mechanism. The Delegation noted that the document related to customer inquiries and formal complaints; it would be of interest to inform on the resolution time of those complaints; although doing so might elicit adverse reactions from users, it also provided with a target for improvement.

309. The Delegation of Hungary elaborated on the findings on the issue of dependency in the document and the proposal of MARQUES in that respect. The Delegation considered that dependency served the interest of small and medium enterprises, since they could undertake proceedings leading to the cancellation of the international registration within the five-year period and they could do it in their own language and in a cost efficient manner. Consequently, the Delegation could not support the proposal to reduce the dependency period from five years to two years. The Delegation esteemed that the proposal moved in the direction of abolishing the basic mark requirement. The Delegation considered that the system as was met the needs of Hungarian users, who tended to see central attack as an effective defense mechanism and not as a disadvantage of the Madrid System.

310. The Delegation of Switzerland declared that in its view the target to be achieved by the Working Group should be the evolution of the system in the interest of users and Offices without questioning its fundamental principles. For the Delegation, the paramount issue was to achieve the best possible quality of registrations. The Delegation expressed appreciation for the items and options in the document concerning Offices, namely item IV, the International Bureau in item V, and Offices and the International Bureau in item VI. For the Delegation the achievement of the stated objectives and the maintenance or improvement of the current level of material quality of registrations and services, should be undertaken without impinging upon the fundamental principles of the Madrid System, particularly the reduction of the five-year dependency period to two years nor the basic mark requirement or the entitlement to file requirements.

311. The Delegation of Germany supported the statements made by the Delegations of Hungary and Switzerland; discussing the reduction of the dependency period was not a priority. The Delegation considered that the real issues were in national laws rather than dependency. The Delegation recalled the elaboration on dependency in the document: trademark holders filing an application with the Office of origin, with the sole purpose of using it as the basic mark to file an international application, faced the threat of cancellation due to non-use of the basic mark; in a number of Contracting Parties that threat might materialize in three years from the date of the basic registration, the minimum provided in Article 19 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (the TRIPS Agreement). The Delegation of Germany wondered whether there actually existed a country whose national law established a period shorter than five years for non-use cancellation.

312. The Delegation of Italy supported the positions of the Delegations of Hungary, Switzerland and Germany. The Delegation was ready to discuss improvements in the system, but its basic principles, such as the five-year dependency period, should remain, even if the Delegation was willing to discuss a small reduction. Likewise, the Delegation was against the deletion of the basic mark requirement or the possibility to file directly through the International Bureau.

313. The Delegation of Japan stated that it favored focusing on certain options concerning the design of the Madrid System, namely marks, scope of the lists of goods and services, dependency and the harmonized time limits to reply to provisional refusals. The Delegation expected that proactive discussions on those items among Contracting Parties would improve the Madrid System in terms of meeting the needs of users and changing market environment. The Delegation of Japan was of the view that the basic mark principle should be adopted as a subject of further discussion in the Working Group; the analysis of the issues concerning the list of goods and services was another relevant matter. The Delegation informed that the feedback from industry provided to the Japan Patent Office revealed that companies wished that the dependency period be revised so as to ensure legal certainty; thus the issue of dependency should be included for further discussion in the Working Group.

314. The Delegation of Colombia stated that it considered of paramount importance to undertake a holistic approach and have a roadmap for the following meetings; the Delegation outlined the interest of non-Member countries of Latin America in seeing how the Madrid System worked for countries of the region having recently acceded to it. The Delegation made an appeal to reflect upon the fine tuning of the administration of the system, with a view to showing its neighbors which were natural markets that the Madrid System was easy to use. The Delegation saw no merit in the modification of the dependency period, a fundamental principle of the system, nor the entitlement to file requirements; the Delegation informed that users of certain neighboring countries had attempted to use the Madrid System through Colombian channels without fulfilling entitlement requirements, which had created problems for the Office. For the Delegation, the correct approach was to work together to stimulate accessions to the system by its neighboring countries. The Delegation of Colombia did not favor discussion of the harmonization of time limits concerning provisional refusals, as national law would not allow different time limits for national and foreign users. The Delegation informed that it agreed with a number of relevant items affecting the operations of Offices, including new types of marks.

315. The Delegation of Israel believed that the Madrid System should be more user-friendly and thought that the proposed working matrix was useful. The Delegation recalled that it was in favor of freezing the dependency period or at least reducing it and thus would like to have that issue included in further discussions of the Working Group. As a country using non-Latin characters, the Delegation saw a great advantage in allowing holders to file international applications for marks that in the opinion of the Office of origin would intrinsically correspond to the basic mark, and recommended the preparation of a document on the issue for the next session of the Working Group. The Delegation of Israel believed that a review of the fee system should be made, including a review of payment options.

316. The Delegation of Norway noted that the document contained topics that the Working Group had already begun to consider and thought that those issues deserved continued attention; one such case was minimizing the disadvantages of dependency. The Delegation considered that while the system of basic mark requirement and dependency does in fact still exist, the Working Group should also study how to accommodate differences in respect of languages and alphabets; such was the way to make the Madrid System modern and global; at the same time, realistic goals should be set; the future demanded electronic solutions to meet users' expectations and to secure cost-effective handling of transactions. The Delegation thought predictability for users was relevant, as well as transparency and updated information to holders, optimal processing time, and harmonization of time limits.

317. The Delegation of the Republic of Korea expressed its wish that the Madrid system should be simpler, user-friendly and appealing for new applicants. The Delegation noted that dependency had been maintained as a mechanism to balance the interests of right holders and third parties and had contributed to preventing bad faith registrations. However, dependency also was one of the factors dissuading applicants to use the Madrid System due to legal uncertainty. The Delegation was of the view that the number of users of the Madrid System in the Republic of Korea would increase if legal uncertainties caused by dependency would be

addressed and solved. The Delegation stated that many trademark owners criticized the dependency principle, especially users in non-Latin script countries such as the Republic of Korea and Japan. Korean users needed to register marks in Latin characters, facing the risk of cancellation for lack of use in the country of origin and consequently losing international registrations. Therefore the Delegation esteemed that the dependency principle should be reconsidered.

318. The Delegation of Belarus stated the need to set priorities, and thought that the Working Group should pursue the analysis of topics it had already begun to discuss, in particular in the current session. Concerning the issues of the basic mark, dependency and transformation, the Delegation noted that they were interconnected and ripe for debate, especially the basic mark which embodied very strict requirements; the Working Group need to discuss how to alleviate them, including the identity of marks. The Delegation considered that other matters, such as new types of marks or harmonization of time limits were not so pressing, as they would probably require long discussions.

319. The Delegation of France stated its interest in a system improved for users. Yet the Delegation did not question the fundamental principles of the system; the Delegation did not wish to work on making the basic mark requirement more flexible. However, the Delegation could accept working on reducing the dependency period. The Delegation informed that it could also accept to discuss harmonization of time limits to reply to provisional refusals. The Delegation wished to leave aside Office-related issues for the time being and saw merit in working on the items in parts V and VI of the document.

320. The Delegation of Austria supported the Delegations of Germany, Hungary, and Italy and considered that the limitation of dependency would make it more difficult to administer the system. Therefore the Delegation esteemed that analyzing options to the dependency principle should not be a priority in the next sessions of the Madrid Working Group. Where the basic mark requirement was concerned, the Delegation thought that a de-linking of the list of goods and services in the basic mark from those of the international application would anticipate the abolishment of the basic mark requirement. Consequently, the scope of the list of goods and services should not be a priority for the next sessions of the Madrid Working Group. The Delegation favored the analysis of a new decision-review mechanism.

321. The Delegation of the Republic of Moldova noted the importance of increasing transparency. The Delegation was in favor of discussing the duration of the dependency period. The Delegation acknowledged the difficulty in establishing identical time limits for replying to provisional refusals, but considered that an effort to harmonize them might be made. The Delegation underlined the usefulness for both users and Offices of the publication of a guide of International Bureau practices and added that it was in favor of the discussion on new types of marks. Finally, the Delegation endorsed the publication of information on the performance of the International Bureau.

322. The Delegation of the European Union, given the broad range of options in the document, supported the suggestion to prioritize their analysis by the Working Group and/or its Roundtable. Regarding the options concerning the design of the Madrid System, the Delegation proposed that priority should be initially given to the discussion on whether and how to relax or eliminate the entitlement requirement and the harmonization of the time limits to reply to a provisional refusal, as well as its method of calculation. Regarding the options concerning Offices, the Delegation, while recognizing the utility of such proposals, suggested that they be addressed at a later stage. Regarding the options concerning the International Bureau, the Delegation proposed that priority should initially be given to the publication and consultation of the International Bureau's examination practices for all Madrid System related transactions, regular publication of information on the International Bureau's performance, establishment of guarantees for maximum processing time for regular transactions by the International Bureau, clarification of issues concerning corrections, assessment of the possibility of producing, upon request, updated international registration certificates reflecting the current status of the mark in

each of the designated Contracting Parties, review of the schedule of fees and payment options and development of E-Madrid. Regarding the options concerning both Offices and the International Bureau, the Delegation proposed that all options falling under the heading should be given priority.

323. The Delegation of Morocco supported the Delegations of Germany, Hungary, Italy and Switzerland and other delegations on the issue of dependency and considered that the reduction of the dependency period was not a priority. The Delegation deemed that it was necessary to work on the matter of the time limits to reply to provisional refusals, especially the calculation method.

324. The Delegation of Spain fully supported the proposals from the Delegation of the European Union and the position of delegations opposed to the reduction of the dependency period.

325. The Delegation of the Russian Federation thought that the geographic scope of the Madrid System needed to be expanded as a priority for developing the Madrid System; Russian users were awaiting the accession to the Madrid System of a number of countries with impatience. Concerning the design of the Madrid System, the Delegation considered that it was necessary to preserve its fundamental principles. The Delegation did not support the proposal relating to the basic mark, although it was in favor of reflecting on the entitlement requirements. Concerning the dependency principle, the Delegation was in favor of studying the consequences of central attack, especially the fact that grounds for revocation that were valid in a given Contracting Party were not in others, nevertheless bringing about the cancellation of the international registration altogether; proposals by users in that regard needed to be considered as well. The Delegation of the Russian Federation considered that new types of marks should be discussed, as well as the harmonization of time limits to reply to provisional refusals. The harmonization of the database of goods and services was also worth considering. Where Offices were concerned, the Delegation supported high priority for the Madrid Commitment Charter. The Delegation supported the setting of time limits for procedures and the availability of information thereon. The regular publication of information and E-Madrid were endorsed by the Delegation. As far as matters relating to Offices and the International Bureau were concerned, classification needed to be harmonized.

326. The Delegation of Sweden wished to prioritize the discussion regarding new types of marks, in line with the new European Union directive on trademarks. The Delegation considered that transformation needed discussion, given its relevance for users. Dependency should be given priority as well, yet on a more general level. Finally, the Delegation endorsed the discussion on harmonized time limits in respect of provisional refusals. Regarding topics the Delegation thought could be deleted or discussed in another forum, the Delegation singled out issues concerning national Offices only. The Delegation acknowledged the relevance of the issues concerning the International Bureau, although it did not believe that a discussion regarding a review procedure should deserve priority, as it would not be beneficial to the Madrid system; a review procedure would rather make the system less user-friendly and add unnecessary workload.

327. The Delegation of the United Kingdom supported the harmonization of the time limit to reply to provisional refusals, since feedback from users had revealed difficulties in calculating the response date.

328. The Representative of MARQUES voiced the priority of making the system simple in the sense of being practical and easy to work with. Enlarging the geographical scope was another priority. The Representative noted the interconnection of topics; such was the case of the dependency period and the script issue, on the discussion of which the Delegation was keen. The Representative fully endorsed the Madrid commitment charter and quality assurance; users faced great problems when new Contracting Parties joined the system without implementing it into their laws. The Representative also fully supported harmonization of

classification practices. Updated international registration certificates would need to be discussed as well, as it was a source of confusion for users, holders and third parties alike. The Delegation supported the introduction of clarity on certain issues; the ongoing discussion on replacement was an example; another was transformation, which needed to be simplified; users were demanding more clarity on the notion of real and effective establishment; in that respect, the creation of a database on national legal frameworks and practices would be welcome. On the issue of harmonization of time limits to reply to provisional refusals, the Representative of MARQUES suggested to start simplifying things by including the end date of the time limit in every irregularity notice. Online filing would be most welcome by users.

329. The Representative of JIPA wished for a modern, user-friendlier system. JIPA gave priority to the issues of dependency and flexibility in the certification procedure concerning identity of marks. As to dependency, JIPA's prior research of the 50 major Japanese companies showed that central attack made companies hesitate to use the system; in Japan the cancellation for non-use of the mark was submitted to a three-year deadline from the date of registration; consequently, abolishing or suspending dependency, or reducing the dependency period to less than three years would encourage Japanese companies to use the Madrid System. Regarding identity, JIPA wished that the strict level of identity required between the basic and the international marks be lowered down; if the system allowed correspondence between marks, more users would be attracted to it, from both Latin and non-Latin script countries; flexibility regarding the correspondence of the list of goods and services of the basic mark with that of international application would be welcome as well.

330. The Representative of APRAM stated that in his opinion the system was very well balanced and thus it should both retain its fundamental principles and develop towards increased legal certainty. The Representative noted that APRAM was in favor of a number of proposals, namely the inclusion of new types of marks, the harmonization of time limits for responses to provisional refusals, any proposals dealing with transparency and electronic communication; replacement and division should be introduced progressively. The Representative of APRAM remarked that, concerning certain proposals, he had doubts about their usefulness for the evolution of the system; these included the relaxation of the criteria for obtaining an international registration through an Office of origin; for the Representative the system was already sufficiently flexible and offered users enough alternatives and choice; further relaxing the system here would lead to legal uncertainty. The Representative applied the same rationale to the relationship between the basic and the international mark; the principle of identity between these two marks should be retained instead of the correspondence approach, liable to create confusion. Likewise the Representative did not endorse the relaxation of criteria regarding the links between the goods and services in the basic mark and the list of goods and services in the international mark. Where the principle of dependency was concerned, APRAM was open to discussion, but rather focusing on the possible reduction of the dependency period to three years.

331. The Representative of the AIPPI declared that he did not favor the deletion of the basic mark requirement, nor the principle of dependency. However, the Representative supported the reduction of the dependency period from five to three years, as this would provide a greater balance amongst the interests of right holders and those of third parties, as well as reduce the negative effect of dependency, particularly the uncertainty for right holders.

332. The Delegation of Mexico supported greater flexibility to allow for right holders and applicants to comply with the legislations of designated Contracting Parties.

333. The Delegation of Italy supported the proposals aimed at increasing the user-friendliness of the system. The Delegation noted the importance of the double session approach, one with the proper Working Group discussing on the legal framework of the Madrid system, but also the Roundtable, to deal with the harmonization of procedural and operational aspects. The Delegation outlined the importance of accurate, updated, accessible and easy to consult databases, both for users and national Offices. The Delegation of Italy further remarked the

relevance of harmonization of classification practices, which would provide increased legal certainty and reduce examination time as well as irregularities. The Delegation saw no reason to set different fees for black and white and color trademarks, with publication being effected online. The Delegation further noted that possibly in the future the time needed to examine mark applications should be considered when setting fees.

334. The Delegation of Australia stated that it was open to discuss the design elements of the system; those should be a medium to high priority. In particular, the Delegation expressed interest in discussing the reduction of the dependency period. Australia focused on user-centered design and behavioral economics, with a view to understanding users' needs; in that regard, the Delegation saw merit in some of the elaborations by MARQUES. As regarded the options concerning the International Bureau, the Delegation assigned a high priority to the principle of transparency of practices and processes; the Delegation esteemed that such options did not require extended discussion in the Working Group, as the International Bureau should be free to pursue them. The Delegation endorsed the discussion of item VI as well. The Delegation of Australia assigned medium priority to options concerning fast tracking, the commitment charter and quality assurance, and noted the interest of corrections and certainty about their time frames. The Delegation supported the introduction of a review procedure, as well as updated registration certificates, with a medium priority; the Delegation shared the views of MARQUES on transparency and the issue of deadlines for provisional refusal. The Delegation supported the E-Madrid initiative as a way to reduce the duplications and improve results.

335. The Representative of the JPAA showed appreciation for the International Bureau's approach on the issue of the basic mark requirement, especially where script and dependency were concerned. Regarding dependency, the Representative of JPAA stated that JPAA would like the Working Group to discuss options of reduction of the dependency period or that the cancellation of international registrations could be limited to certain grounds.

336. The Delegation of Cuba stated that it did not consider relevant to promote analysis which would question the very basis of the system; this would in particular include basic mark-related issues, even if the Delegation was open to discuss flexible approaches. The Delegation considered that discussions should focus on items V and VI. The Delegation also favored analysis on the review of examination by the International Bureau, including corrections. The Delegation supported as well the harmonization of classification practices. For the Delegation, the list of goods and services in the international application should not be more extensive than the list of the basic mark. Harmonization regarding the time limit to reply to a provisional refusal should be dealt with in a conservative manner, bearing in mind that the need to appoint a local representative might impinge on the time available to reply; the Delegation expressed reservations on an eventual extension of the time limit, as it would not comply with domestic legislation.

337. The Delegation of the United States of America esteemed that it would be helpful to discuss new types of marks. The Delegation was aware that the notion of de-linking goods and services was controversial, but considered that a discussion could be undertaken that would not undermine dependency completely. The reduction of the dependency period was worth considering. The Delegation declared that it would encourage and appreciate discussion on the issue of fulfillment of requirements starting on page 7 of the document, allowing flexibility in the form of providing additional information, such as in cases where certification marks were applied for, would be of substantial assistance. The Delegation also supported the discussion of the options concerning the International Bureau, starting at page 9.

338. The Delegation of New Zealand noted the relevance of discussing a reduction in the dependency period; a review and simplification of the Schedule of Fees, which should at least remain neutral, and of payment options to make it easier, needed to be undertaken as well. Further work in the development of electronic communications, such as E-Madrid, would be welcome. Reduction of data errors should also be discussed, as it would ease the burden of corrections.

339. The Chair summarized the discussions, noting that regarding the options concerning the design of the Madrid System, delegations were divided into two groups: certain delegations would not like to see the basic principles of the system being questioned while others would like to undertake a discussion on some of the fundamental elements, such as the basic mark, including dependency, scripts, etc. The Chair esteemed that discussion on at least some of those topics needed to be envisaged. The Chair observed that among the delegations having expressed a preference for not dealing with some of the basic principles, there seemed to be a number of them willing to at least discuss dependency, as well as considering whether there could be other ways of addressing the problems that some Contracting Parties encountered in relation to those principles. There did not seem to be much support to include options concerning Offices, whereas the options concerning the International Bureau were endorsed by a sizable number of delegations. The same applied in respect of options concerning both Offices and the International Bureau. The Chair noted that some topics might be more suitable for Roundtable discussions whereas other issues clearly should correspond to the Working Group. The Chair informed that the Secretariat would prepare a roadmap including matters to be considered in the short, medium and long term, and also including information on what should be discussed in the Working Group or in the Roundtable.

340. The Secretariat presented the roadmap, divided into short, medium and long-term perspectives; the short-term perspective would include the next two sessions of the Working Group; the midterm perspective would cover issues scheduled after those two sessions. The long-term perspective would relate to issues without a defined schedule, yet to possibly be discussed in the Working Group or Roundtable. In the short term, for the next meeting of the Working Group, or the meeting after, replacement would be discussed. The Secretariat recalled that transformation had been raised by a number of delegations as a relevant topic to further look into, as well as new types of marks. The following two meetings of the Roundtable would see a discussion on classification principles, in fact starting the following day. Corrections would also be included in the short-term perspective. Furthermore, the Roundtable would continue the discussion on the issue of correspondence or marks for certification purposes; different scripts were included as well, and fulfillment of requirements. The examination practices of the International Bureau were to be analyzed too. In the midterm perspective, the Working Group would study the harmonized time limit to reply to provisional refusals. The outcome of the discussions on corrections in the Roundtable might need to be considered by the Working Group. The Secretariat noted that fee review and payment options had been raised by certain delegations during the session, as well as an eventual reduction of the dependency period. The Secretariat indicated that in the medium term Roundtable would deal with examination practices by the International Bureau. Harmonization of classification practices would be in the list of the Roundtable, and the scope of the list of goods and services, including de-linking as a way to mitigate the disadvantages of dependency. Finally the Roundtable would include updated international registration certificates. The Secretariat then elaborated on long-term perspectives. Those would encompass entitlement to file, options for Offices, and the review procedure; in parallel, there would be a reporting mechanism from the International Bureau to the Roundtable. The roadmap would also cover the geographical scope of the Madrid System, the performance framework, with the maximum processing time, and E-Madrid as well.

341. The Delegation of Germany stated that it had qualms on the issues of new types of marks, and correspondence of marks for certification purposes, as they could mean a first step to abolish the basic mark requirement, thus the Delegation could not accept the topics.

342. The Secretariat explained that where new types of marks were concerned, the aim was to reflect on the fact that the Common Regulations were quite limited on that issue; the goal would be to look into types of marks already recognized by the STLT in case any addition was feasible; there existed no relation whatsoever with the abolishment of the basic mark requirement. Regarding correspondence of marks for certification purposes, it would already be discussed at the Roundtable during the current session, even if the discussion would probably continue in future Roundtable meetings.

343. The Representative of INTA noted that most of the proposals deserved consideration; the real question was how to tackle the different issues in a short, medium or long-term perspective.

344. The Delegation of Hungary considered that dependency should be discussed in the long term.

345. The Delegation of Switzerland wondered whether the inclusion of transformation in the short-term perspective was justified, given the few occurrences Offices had to process. The Delegation expressed doubts on the need of a centralization in the International Bureau, since the issue was of a national nature and, moreover, the intervention of the International Bureau might make the procedure lengthier. Nevertheless, the Delegation of Switzerland could understand that for certain Offices it might be useful that the International Bureau dealt with the examination or the reception of requests of transformation. Regarding medium term matters, the Delegation esteemed that the issue of the scope of the list of goods and services seemed to seriously question legal certainty, since should an extension of the list be possible internationally, the holder would be able to further benefit from the priority of the basic mark; the Delegation considered that such a situation was to be avoided. Where long-term issues were concerned, the Delegation did not favor a re-consideration of the entitlement to file, as it would entail serious risk of forum shopping. Concerning the harmonization of the deadline to respond to provisional refusals, the Delegation of Switzerland explained that under its national law, not only deadlines were set, but the limit date to receive responses to refusals was also specified.

346. The Delegation of Germany supported the views of the Delegation of Switzerland. For the Delegation of Germany, the most relevant issue was the scope of the list of goods and services, namely, a possible de-linking of the lists of the basic mark and the international registration. The Delegation did not want the issue to be included in the roadmap, as it considered it was a big first step to abolish the basic mark requirement. Regarding transformation, the Delegation shared the views of the Delegation of Switzerland as well because it esteemed that it should be dealt with by the national Office, since it was a subject relating to a national mark; besides, national processing would be faster. As to dependency, the Delegation of Germany was willing to discuss an eventual reduction of the dependency period.

347. The Delegation of France supported the positions of the Delegations of Germany and Switzerland regarding transformation. For the Delegation, the issue was not urgent and it had no difficulties with transformation. Where dependency was concerned, the Delegation of France supported the position of the Delegation of Germany, and favored the discussion of an eventual reduction of the dependency period.

348. The Delegation of Colombia stated that transformation was not a priority for its Office, as it did not receive a considerable number of applications for transformation. The Delegation considered that limitations should be included within the short-term perspective, instead of transformation.

349. The Delegation of Cuba esteemed that the review procedure should have an earlier place in the roadmap. The Delegation agreed with the previous interventions on the fact that transformation was not an urgent issue. As to harmonization of time limits to reply to refusals, the Delegation considered that the discussion would be time consuming, as would be an eventual implementation, and thus it should not be included in the midterm perspective.

Concerning dependency, a reduction of the period could be considered in the medium term. The Delegation of Cuba supported the view of the Delegation of Colombia that limitations should be given priority.

350. The Delegation of Austria thought that the issue of the list of goods and services should be discussed in the long term.

351. The Delegation of Japan stated that, according to the opinions of industry provided to the Japan Patent Office, the revision of the dependency period should be given priority.

352. The Delegation of the Russian Federation declared that it agreed with the proposed roadmap, although it wondered why division and merger had not been included.

353. The Chair clarified that since the Working Group had reached an agreement on division and merger during the session, the issue did not need to be included.

354. The Delegation of Norway esteemed that dependency should remain in the medium term.

355. The Delegation of the Czech Republic shared the views of the Delegations of France, Germany and Switzerland on transformation and dependency. As to the harmonization of time limits to reply to provisional refusals, the Delegation considered that it could be discussed in the short term, as users had problems with the diversity of time limits.

356. The Delegation of Australia expressed interest in discussing an eventual reduction of the dependency period within the context of the Working Group, and shared the view that it should be a medium term priority. The Delegation understood the misgivings voiced with respect to the scope of the list of goods and services. However, it supported continued discussion in the Working Group in the medium term as well. Regarding the harmonization of time limits to reply to provisional refusals, the Delegation supported its placement in the medium term, acknowledging users had a keen interest in addressing the issue.

357. For the Delegation of the Republic of Moldova, dependency and its duration was the most relevant issue. The Delegation also gave priority to the harmonization of time limits to reply to provisional refusals; additional priorities were the publication of WIPO practices and the harmonization of classification practices.

358. The Representative of MARQUES stated that dependency should be discussed in the short term, as agreement on an eventual reduction would take a long time to be reached; transformation should be kept on the list given that users needed clarity on that issue. The Representative of MARQUES stressed that there existed a third topic on which clarity was needed, namely the notion of real and effective establishment. The Representative agreed with the priority assigned to classification practices and harmonization.

359. The Representative of INTA considered that the discussion on examination practices of the International Bureau should start in the short term; the roadmap should evolve and needed to be reviewed periodically. On the possible reduction of the dependency period, the Representative informed that he did not have a mandate from INTA; his personal view was that it would require an amendment to the Madrid Protocol and thus an early start of the discussion was recommendable.

360. The Delegation of Montenegro favored discussion on the possible reduction of the dependency period in the medium term.

361. The Secretariat proposed the concept of non-exclusion as a guiding principle, given the fact that the document solely proposed to undertake discussions on the different topics; the Secretariat suggested that if one or more delegations would like to discuss a given issue, it should be included at least in the medium term. The Secretariat recalled that discussions could be initiated in the Roundtable, and eventually be forwarded to the Working Group.

362. The Representative of JIPA proposed the discussion of the possible reduction of the dependency period in the short term, given its importance for users.

363. The Chair proposed to include limitations in the short term; clarification was needed to the effect that, where classification practices harmonization was concerned, the goal was to reduce inconsistencies. The Chair asked for feedback on transformation, given that a number of delegations did not feel it was an urgent issue, whereas the survey on dependency had revealed that transformation was a subject users wanted to be considered and improved. The Chair also raised the issue of the de-linking of the list of goods and services; again a number of delegations had stated it was not a topic they wished to discuss, yet at least one delegate supported its inclusion in the Roundtable, which seemed a reasonable solution.

364. The Delegation of Switzerland clarified that it was not against the discussion of transformation, and did not object to its analysis in the short term.

365. The Delegation of Germany recalled that in the previous session the Working Group had decided fundamental principles would not be questioned. The Delegation considered that the scope of the list of goods and services impinged on one such principle, namely the basic mark requirement. Consequently, the Delegation of Germany opposed to the discussion of that matter even in the Roundtable.

366. The delegation of the European Union acknowledged the merit of the principle that all limitations should be examined by the Office of the designated Contracting Party concerned and supported the need for additional considerations on a legal basis to examine limitations in subsequent designations; once that issue would have been satisfactorily clarified, the Delegation would support an analysis of the option of a provisional refusal in the context of the principle of examination of all limitations by the Office of the designated Contracting Party. The Delegation stated that the European Union and its member states also remained open to discussion of the alternative options proposed.

367. The Delegation of Italy noted that since a discussion on transformation had already been undertaken in the previous sessions, it was worthwhile to continue the debate and reach an agreement. As regarded limitations, the Delegation favored inclusion in the short term. The Delegation of Italy supported discussion of classification principles and harmonization in the Roundtable and in the short term.

368. The Secretariat, in respect of classification practices, clarified that the International Bureau intended to first publish its own examination principles, which might lead to reduced inconsistencies in the medium term.

369. The Delegation of the United States of America elaborated on the issue of the de-linking of goods and services. The Delegation considered that the subject could be viewed as the ways in which the scope of protection differed under each Contracting Party's different approach on confusion standards. The Delegation elaborated on the scope of protection given by its Office, which considered not only the classes requested, but also marketplace realities, the strength of the mark and other factors. While understanding the feelings of other delegations on the issue of dependency, the Delegation of the United States of America esteemed that discussion would be worthwhile and valuable, with a view to making the system more flexible and appealing for potential new members.

370. The Chair recalled that the Working Group had a mandate from the Assembly to consider issues relating to the legal development of the Madrid System, which encompassed matters relating to its fundamental principles. The Chair esteemed that the issue could be included for analysis in the long term. The Chair also recalled the proposal from the Delegation of the United States of America, relating the topic to the scope of protection, rather than the scope of the list of goods and services, and asked whether it could be discussed in the medium term. The Chair concluded that the matter would be discussed in the long term.

371. The Delegation of Germany reiterated that it did not wish to discuss the issue, even in the long term.

372. The Chair reminded that the question of whether a topic should be discussed was not subject to consensus; it was necessary to take into account the wishes of all delegations. The Chair recalled that he had also raised the subject of transformation: in view of the reactions from delegations, the Chair concluded that it should be kept for discussion in the short term. The Chair summarized that the roadmap would be kept as presented in the document, with the changes that limitations would be discussed in the short term, de-linking in the long term and that the topic of harmonization of classification practices would be re-phrased to reduction of inconsistencies in classification practices.

373. The Working Group agreed on a road map including a list of subjects to be discussed by the Working Group or its Roundtable in the short, medium and long term, as well as a list of matters on which the International Bureau should periodically report to the Roundtable, as contained in Annex IV to the present document.

AGENDA ITEM 7: ANALYSIS OF LIMITATIONS UNDER THE MADRID SYSTEM FOR THE INTERNATIONAL REGISTRATION OF MARKS

374. Discussions were based on document MM/LD/WG/14/5.

375. The Secretariat introduced the document and recalled previous discussions on the competence for verifying the scope of limitations in international applications, in subsequent designations, and in requests for recording of a limitation in an international registration. The Secretariat further recalled that the Working Group had requested the International Bureau to prepare a document analyzing the issue and in particular look at the roles and responsibilities of the Office of origin, the International Bureau, and the Offices of the designated Contracting Parties in the examination of limitations; the document included a proposal to ensure that all limitations would undergo the same treatment so as to increase legal certainty for users and Offices. The Secretariat recalled that in previous discussions some Contracting Parties had informed that they would not be in a position to refuse protection on the grounds that a limitation was deemed to go beyond the main list of the international registration, since they did not have any legal basis in their domestic legislations to do so; in the interest of those Contracting Parties, the legal framework would need to be modified, by either amending the domestic legislation, or the Common Regulations. The document outlined a possible way forward, either by amending Rule 17, to provide sufficient legal basis for refusal, or introducing a general declaration following the model of Rule 27.

376. The Delegation of Israel considered that limitations must be examined to ensure they fell within the main list of goods or services; consequently, limitations in international applications should be examined by the Office of origin. Regarding subsequent designations, since most were filed directly with the International Bureau, the Delegation was of the view that the International Bureau should examine them; limitations requested as changes to the international registration should be examined by the designated Contracting Party concerned.

377. The Delegation of Belarus esteemed that where limitations as changes to an international registration were concerned, Rule 25 provided a legal basis to assign examination to the Office of the designated Contracting Party. Limitations in international applications should be examined by the Office of origin, as prescribed by Rule 9(5)(d)(vi). The Delegation considered that Rule 17 did not provide a legal basis for a designated Office to refuse protection based on the fact that a limitation was an extension. The Delegation suggested an amendment to Rule 9, making the responsibility of the Office of origin more explicit. Regarding subsequent designations, the Delegation esteemed that the Office of the designated Contracting Party should determine whether or not the limitation was in fact an extension.

378. The Delegation of Australia agreed in principle that limitations should be examined by the Office of the designated Contracting Party concerned, since limitations were generally intended to fulfill requirements in that Contracting Party. The Delegation requested that the International Bureau further elaborate on all the options described in the document, and present its findings in a document to be discussed at the next session of the Working Group; the Delegation expressed interest in the third option.

379. The Delegation of Germany asked whether the limitation had to be checked only against the main list of the international registration, and not against the list of the basic mark; if it was checked against the main list of the international registration, the designated Office was concerned by the limitation. The Delegation recalled that such was the solution in Rule 25. For the Delegation the best solution would be that designated Offices examine limitations.

380. The Delegation of Switzerland considered that limitations in international applications should be examined by Offices of origin; for those in subsequent designations, there could be two possibilities, the Office of the Contracting Party of the holder or the International Bureau. For limitations not contained in international applications or subsequent designations, the designated Office should examine. The Delegation thought that, should limitations contained in international applications and subsequent designations be examined by designated Offices, the legal means to do so should be offered to those Offices. The Delegation of Switzerland noted that such approach might lead to a substantial increase in the number of refusals or declarations where the limitation would be without effect, since the grounds for refusal could be as diverse as the number of designated Contracting Parties, thus negatively affecting the simplification of the system.

381. The Delegation of New Zealand agreed with the conclusion that the designated Contracting Party should examine the limitation; this would mean that the country where the limitation is to have effect would be assessing it. The Delegation favored further elaboration on option C.

382. The Delegation of France thought that limitations in international applications should be examined by the Office of origin as a part of its certification work. Regarding limitations on subsequent designations, the Delegation informed that its Office did not have the legislative possibilities to examine them as a designated Office, as it would entail an in depth examination.

383. The Delegation of the Czech Republic considered that the Office of origin should examine the limitation, on the basis of the basic mark. Regarding subsequent designations, the Delegation proposed examination by the Office of origin, or possibly by the International Bureau.

384. The Delegation of China considered that examination by Offices of designated Contracting Parties would increase their workloads, and proposed that examination should be undertaken by the International Bureau.

385. The Delegation of the United States of America thought that the Office of the designated Contracting Party should examine limitations in subsequent designations, as well as those in requests for recording of a change. The Delegation declared itself open to the idea that the Office of origin should do the examination of limitations in international applications.

386. The Delegation of Sweden noted that limitations had the effect of limiting the scope of protection in designated Contracting Parties. Regarding limitations in international applications, the Delegation supported the view that the Office of the designated Contracting Party should examine the limitation. For subsequent designations, the Delegation held the same view. Limitations made as a separate request would affect some or all of the designated Contracting Parties and thus should be examined by the Office of the designated Contracting Party concerned.

387. The Delegation of Colombia considered that the Office of origin should examine limitations in international applications under the certification function. Where subsequent designations were concerned, the Delegation was of the view that the International Bureau should examine limitations in them.

388. The Delegation of Japan stated that, should examination of limitations in international applications be undertaken by Offices of origin, the impact on the operations of those Offices needed to be assessed; amendments to concerned provisions should be analyzed as well. The Delegation of Japan esteemed that the issue still needed further careful discussions in the coming sessions of the Working Group.

389. The Delegation of Mexico referred to the complexity involved in the examination of limitations in international applications and noted that it was far from obvious that Offices of origin should examine such limitations, especially given the eventual disparity of criteria with the Office of the concerned designated Contracting Party. Consequently, the Delegation of Mexico supported the view that Offices of designated Contracting Parties should examine limitations.

390. The Delegation of Italy upheld the view that examination of limitations in international applications should be undertaken by the International Bureau. Where the limitation was effected in a subsequent designation, the examination corresponded to the Office of the designated Contracting Party concerned. The Delegation noted that often limitations were made in order to comply with the legal framework of the designated Contracting Party; it was thus that designated Contracting Party the only one in a position to effectively undertake the examination of that kind of limitation. The Delegation of Italy stressed the relevance of setting a common general framework on the issue at stake.

391. The Representative of INTA aligned himself with delegations supporting that the examination of limitations in international applications was the responsibility of the Office of origin. The Representative of INTA stated that his reading of Rule 9(5)(d)(vi) of the Common Regulations had always been that the Office of origin should certify that all 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; not just the goods and services of the main list, but obviously also those of the limited list or lists that might be included in the international application to meet specific requirements of some designated Contracting Parties, or commercial requirements, since the applicant might have different business interests in different countries. The Representative of INTA noted that paragraphs 21 and 22 of the document pointed out that the Regulations under the Madrid Agreement which preceded the Common Regulations did not contemplate the inclusion of limitations in the international application, and deduced from that fact that the certification function of the Office of origin could not be considered to have originally included the examination of limitations. The Representative recalled that, before the entry into force of the Common Regulations, limitations as well as all other changes and subsequent designations were presented to the International Bureau by the Office of origin, which was expected to control that the limitation was indeed a limitation, and that the list of goods and services contained in a subsequent designation was in effect covered

by the basic mark; the International Bureau did exercise a control on the limitations and could come back to the Office of origin if need be. Therefore, the designated Contracting Parties could and did rely on the Office of the country of origin to certify that any limitation was actually a limitation. The Representative of INTA observed that the situation had changed with the entry into force of the Protocol, since not all subsequent designations went through the Office of origin, and changes, including the limitations, could also be filed directly with the International Bureau. The Representative of INTA observed that for that very reason, a different treatment for those limitations had been introduced under Rule 27, with the possibility for the Office of a designated Contracting Party to refuse the effects of a limitation. And a similar provision had been introduced in Rule 24, allowing Offices of designated Contracting Parties to refuse the effect of a designation if they considered that the list of goods and services did not fall within the basic list. The Representative of INTA acknowledged the need for a practical solution, although that should not imply that only one and the same authority should examine limitations. The Representative stressed the need to preserve the control of the international application by the Office of origin.

392. The Representative of JTA deemed it preferable that limitations presented in international applications be examined by the Office of origin, since the interpretation of the scope of goods and services could differ depending on each designated Contracting Party.

393. The Representative of JPA considered that limitations in international applications should be examined by the Office of origin; firstly because examination by the Office of origin was understandable for users; secondly because the Office of origin examined basic requirements under the certification process, thus examination of limitations presented in international applications seemed to be an extension of the certification process; finally, because users assume that the scope of the list of goods and services in the main list corresponds to the trademark practices of the Office of origin at the time of filing the international application.

394. The Representative of APRAM favored examination of limitations in the international application by the Office of origin. First, on the basis of a textual interpretation of the applicable provisions in the Common Regulations regarding certification. The Representative of APRAM then elaborated on the example provided by the International Bureau in the document, reversing it: should an Office of origin have restrictive practices regarding interpretation of class headings, and the Office of a designated Contracting Party an extensive practice regarding the same, if the limitation were to be examined by the Office of the designated Contracting Party, the end result would be an extensive limitation compared to the interpretation by the Office of origin of the relationship between the scope of the basic application or registration and that of the international registration. That did not seem to be the aim of the Madrid System.

395. The Chair recalled that on previous discussions, the Working Group had analyzed the role of the International Bureau in relation to limitations and had concluded that it did not correspond to the International Bureau to consider whether a limitation fell within the scope of the basic mark or the international registration; it should be up to the designated Contracting Parties to consider whether they saw it within that scope. In that context, the analysis should focus on whether the task corresponded to the Office of origin, or to those of the designated Contracting Parties; the Chair noted that the discussion had revealed that a vast majority favored that it should be the function of the Office of origin. The Chair asked the Secretariat to clarify this fact further in the Common Regulations, for the next session of the Working Group. Where other situations were concerned, there seemed to be a majority favoring that Offices of the designated Contracting Parties should assess whether a limitation is within the scope of the international registration, because the limitation affected those Contracting Parties. The Chair asked the Secretariat to make a proposal in that direction, thus providing Offices with the appropriate legal framework.

396. The Working Group requested the International Bureau to prepare a document, to be discussed at its next session, analyzing the role of the Office of origin in the examination of limitations in international applications and the possible implications therefrom. The document would also analyze the role of the Offices of designated Contracting Parties in respect of limitations in international registrations or subsequent designations affecting them, and the possible implications therefrom, including proposals in respect of both roles.

AGENDA ITEM 8: OTHER MATTERS

397. The Representative of MARQUES recalled that certain Offices were not able to communicate directly with holders, since a local representative was needed to that effect. The Representative of MARQUES suggested the sending of a standard note to holders, informing them accordingly, that might be added to statements of grant of protection, for example.

AGENDA ITEM 9: SUMMARY BY THE CHAIR

398. The Working Group approved the Summary by the Chair, as contained in document MM/LD/WG/14/6.

AGENDA ITEM 10: CLOSING OF THE SESSION

399. The Chair closed the session on June 17, 2016.

[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

MM/LD/WG/14/2 REV. ANNEX (AMENDED BY THE WORKING GROUP)

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

(as in force on [November 1, 2017](#))

[...]

**Chapter 1
General Provisions**

[...]

Rule 3

Representation Before the International Bureau

[...]

(4) *[Recording and Notification of Appointment of a Representative; Effective Date of Appointment]*

[...]

(b) The International Bureau shall notify the recording referred to in subparagraph (a) to both the applicant or holder and, in the ~~representative~~ [letter case, the Offices of the designated Contracting Parties, as well as the representative](#). Where the appointment was made in a separate communication presented through an Office, the International Bureau shall also notify the recording to that Office.

[...]

(6) *[Cancellation of Recording; Effective Date of Cancellation]*

[...]

(f) Cancellations at the request of the holder or the holder's representative shall also be notified to the Offices of the designated Contracting Parties.

Chapter 4
Facts in Contracting Parties
Affecting International Registrations

[...]

Rule 18ter

Final Disposition on Status of a Mark in a Designated Contracting Party

[...]

(4) *[Further Decision]* Where, a notification of provisional refusal has not been sent within the applicable time limit under Article 5(2) of the Agreement or of the Protocol, or, where following the sending of a statement ~~in accordance with either under~~ paragraph (1), (2) or (3), a further decision, taken by the Office or other authority, affects the protection of the mark, the Office shall, to the extent that it is aware of that decision, without prejudice to Rule 19, send to the International Bureau a further statement indicating the status of the mark and, where applicable, the goods and services for which the mark is protected in the Contracting Party concerned⁴.

[...]

Rule 22

*Ceasing of Effect of the Basic Application,
of the Registration Resulting Therefrom,
or of the Basic Registration*

(1) *[Notification Relating to Ceasing of Effect of the Basic Application, of the Registration Resulting Therefrom, or of the Basic Registration]*

[...]

(c) Once the judicial action or proceeding referred to in subparagraph (b) has resulted in the final decision referred to in Article 6(4) of the Agreement, in the final decision referred to in the second sentence of Article 6(3) of the Protocol or in the withdrawal or renunciation referred to in the third sentence of Article 6(3) of the Protocol, the Office of origin shall, where it is aware thereof, promptly notify the International Bureau accordingly and shall give the indications referred to in subparagraph (a)(i) to (iv). Where the judicial action or proceedings referred to in subparagraph (b) has been completed and has not resulted in any of the aforesaid final decisions, withdrawal or renunciation, the Office of origin shall, where it is aware thereof or at the request of the holder, promptly notify the International Bureau accordingly.

(2) *[Recording and Transmittal of the Notification; Cancellation of the International Registration]*

[...]

(b) Where any notification referred to in paragraph (1)(a) or (c) requests cancellation of the international registration and complies with the requirements of that paragraph, the International Bureau shall cancel, to the extent applicable, the international

⁴

Interpretative statement endorsed by the Assembly of the Madrid Union:

“The reference in Rule 18ter(4) to a further decision that affects the protection of the mark includes also the case where that further decision is taken by the Office, for example in the case of *restitutio in integrum*, notwithstanding the fact that the Office has already stated that the procedures before the Office have been completed.”

registration in the International Register. The International Bureau shall also cancel, to the extent applicable, international registrations resulting from partial change in ownership recorded under the international registration that has been cancelled, following the above-mentioned notification, and those resulting from their merger.

[...]

Chapter 5 Subsequent Designations; Changes

[...]

Rule 23bis Communications from the Offices of the Designated Contracting Parties sent through the International Bureau

(1) [Communications from the Offices of the designated Contracting Parties not covered by these Regulations] Where the law of a designated Contracting Party does not allow the Office to transmit a communication concerning an international registration directly to the holder, that Office may request the International Bureau to transmit that communication to the holder on its behalf.

(2) [Format of the Communication] The International Bureau shall establish the format in which the communication referred to in paragraph (1) shall be sent by the Office concerned.

(3) [Transmission to the holder] The International Bureau shall transmit the communication referred to in paragraph (1) to the holder, in the format established by the International Bureau, without examining its contents or recording it in the International Register.

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:

[...]

(v) cancellation of the international registration in respect of all the designated Contracting Parties for all or some of the goods and services;

(vi) a change in the name or address of the representative.

[...]

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

[...]

(ii) the name of the holder or the name of the representative where, ~~unless~~ the change relates to the name or address of the representative,

[...]

Rule 27
Recording and Notification of a Change or of a Cancellation;
Merger of International Registrations; Declaration That a Change in Ownership or a Limitation
Has No Effect

[...]

(2) ~~[Deleted]~~[Recording of Partial Change in Ownership] (a) A change in ownership of the international registration in respect of only some of the goods and services or only some of the designated Contracting Parties shall be recorded in the International Register under the number of the international registration concerned by the partial change in ownership.

(b) The part of the international registration for which a change in ownership has been recorded shall be deleted from the international registration concerned and recorded as a separate international registration.

[...]

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

[...]

(xii) international registrations which have not been renewed;

(xiii) recordings of the appointment of the holder's representative communicated under Rule 3(2)(b) and cancellations at the request of the holder or the holder's representative under Rule 3(6)(a).

[...]

(3) The International Bureau~~Gazette~~ shall effect the publications under paragraphs (1) and (2) be published on the website of the World Intellectual Property Organization.

**PROPOSED AMENDMENTS TO THE ADMINISTRATIVE INSTRUCTIONS FOR THE
APPLICATION OF THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL
REGISTRATION OF MARKS AND THE PROTOCOL RELATING THERETO**

**Administrative Instructions for the Application of the
Madrid Agreement Concerning the International
Registration of Marks and the Protocol
Relating Thereto**

(as in force on [November 1, 2017](#))

[...]

**Part Six
Numbering of International Registrations**

*Section 16: Numbering Following Partial Change
in Ownership*

- (a) ~~Assignment or other transfer of the international registration in respect of only some of the goods and services or only some of the designated Contracting Parties shall be recorded in the International Register under the number of the international registration of which a part has been assigned or otherwise transferred. The separate international registration resulting from the recording of partial change in ownership shall bear the number of the registration of which a part has changed in ownership, followed by a capital letter.~~
- (b) ~~[Deleted] Any assigned or otherwise transferred part shall be cancelled under the number of the said international registration and recorded as a separate international registration. The separate international registration shall bear the number of the registration of which a part has been assigned or otherwise transferred, together with a capital letter.~~

[Annex II follows]

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

MM/LD/WG/14/2 REV. ANNEX (AMENDED BY THE WORKING GROUP)

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

(as in force on ...)

[...]

**Chapter 4
Facts in Contracting Parties
Affecting International Registrations**

[...]

Rule 21

*Replacement under Article 4bis of the Agreement or the Protocol ~~a National or Regional~~
~~Registration~~
~~by an International Registration~~*

~~(1) *[Notification]* Where, in accordance with Article 4bis(2) of the Agreement or Article 4bis(2) of the Protocol, the Office of a designated Contracting Party has taken note in its Register, following a request made direct by the holder with that Office, that a national or a regional registration has been replaced by an international registration, that Office shall notify the International Bureau accordingly. Such notification shall indicate~~

- ~~(i) the number of the international registration concerned,
(ii) where the replacement concerns only one or some of the goods and services listed in the international registration, those goods and services, and
(iii) the filing date and number, the registration date and number, and, if any, the priority date of the national or regional registration which has been replaced by the international registration.~~

~~The notification may also include information relating to any other rights acquired by virtue of that national or regional registration, in a form agreed between the International Bureau and the Office concerned.~~ *[Presentation of the Request]* The holder may, from the date of the notification of the designation, present a request for the Office of a designated Contracting Party to take note of the international registration in its Register. The request may be presented directly to that Office or through the International Bureau. Where presented through the International Bureau, the request shall be effected on the relevant official form.

~~(2) *[Recording]* (a) The International Bureau shall record the indications notified under paragraph (1) in the International Register and shall inform the holder accordingly.~~

~~(b) The indications notified under paragraph (1) shall be recorded as of the date of receipt by the International Bureau of a notification complying with the applicable requirements.~~ *[Contents of a Request Presented Through the International Bureau and Transmission]* (a) The request referred to in paragraph (1), where presented through the International Bureau, shall indicate:

- (i) the number of the international registration concerned,

- (ii) the name of the holder,
 - (iii) the Contracting Party concerned,
 - (iv) where replacement concerns only one or some of the goods and services in the international registration, those goods and services,
 - (v) the filing date and number, the registration date and number, and, if any, the priority date of the national or regional registration or registrations which are deemed to be replaced by the international registration; and,
 - (vi) where paragraph (7) applies, the amount of the fees being paid, the method of payment, or instructions to debit the required amount of fees to an account opened with the International Bureau and the identification of the party effecting the payment or giving the instructions.
- (b) The International Bureau shall transmit the request referred to in subparagraph (a) to the Office of the designated Contracting Party concerned and inform the holder accordingly.

(3) [Examination and Notification by the Office of a Contracting Party] (a) The Office of a designated Contracting Party may examine the request referred to in paragraph (1) for compliance with the conditions under Article 4bis(1) of the Agreement or of the Protocol.

(b) An Office that has taken note in its Register of an international registration shall so notify the International Bureau. Such notification shall contain the indications specified in paragraph (2)(a)(i) to (v). The notification may also contain information relating to any other rights acquired by virtue of the national or regional registration or registrations concerned.

(c) An Office that has not taken note may so notify the International Bureau, which shall inform the holder accordingly.

(4) [Recording and Notification] The International Bureau shall record in the International Register any notification received under paragraph (3)(b) and shall inform the holder accordingly.

[(5) [Scope of Replacement] The names of the goods and services listed in the national or regional registration or registrations shall be equivalent, but not necessarily identical, to those listed in the international registration that has replaced them.]

(6) [Effects of Replacement on the National or Regional Registration] A national or regional registration or registrations shall not be cancelled or otherwise affected by the fact that they are deemed to be replaced by an international registration or that the Office has taken note in its Register of the latter.

[(7) [Fees] Where a Contracting Party requires a fee for the presentation of a request under paragraph (1), the request is presented through the International Bureau, and the Contracting Party wishes the International Bureau to collect that fee, it shall so notify the International Bureau, indicating the amount of the fee in Swiss currency or in the currency used by the Office. Rule 35(2)(b) shall apply *mutatis mutandis*.]

[Annex III follows]

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

MM/LD/WG/14/3 REV. ANNEX (AMENDED BY THE WORKING GROUP)

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

(as in force on [February 1, 2019](#))

[...]

**Chapter 4
Facts in Contracting Parties
Affecting International Registrations**

[...]

*Rule 22
Ceasing of Effect of the Basic Application,
of the Registration Resulting Therefrom,
or of the Basic Registration*

[...]

(2) *[Recording and Transmittal of the Notification; Cancellation of the International Registration]*

[...]

(b) Where any notification referred to in paragraph (1)(a) or (c) requests cancellation of the international registration and complies with the requirements of that paragraph, the International Bureau shall cancel, to the extent applicable, the international registration in the International Register. The International Bureau shall also cancel, to the extent applicable, international registrations resulting from partial change in ownership or division recorded under the international registration that has been cancelled, following the above-mentioned notification, and those resulting from their merger.

Chapter 5 Subsequent Designations; Changes

[...]

Rule 27

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

[...]

(3) ~~[Deleted] [Recording of Merger of International Registrations] Where the same natural person or legal entity has been recorded as the holder of two or more international registrations resulting from a partial change in ownership, the registrations shall be merged at the request of the said person or entity, made either direct or through the Office of the Contracting Party of the holder. The International Bureau shall notify accordingly the Offices of the designated Contracting Parties affected by the change and shall inform at the same time the holder and, if the request was presented by an Office, that Office.~~

[...]

Rule 27bis

Division of an International Registration

(1) [Request for the Division of an International Registration] (a) A request by the holder for the division of an international registration for some only of the goods and services in respect of a designated Contracting Party shall be presented to the International Bureau on the relevant official form by the Office of that designated Contracting Party, once the latter is satisfied that the division whose recording is requested meets the requirements of its applicable law, including the requirements concerning fees.

(b) The request shall indicate

(i) the Contracting Party of the Office presenting the request,

(ii) the name of the Office presenting the request,

(iii) the number of the international registration,

(iv) the name of the holder,

(v) the names of the goods and services to be set apart, grouped in the appropriate classes of the International Classification of Goods and Services,

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

(c) The request shall be signed by the Office presenting the request and, where the Office so requires, also by the holder.

(d) Any request presented under this paragraph may include or be accompanied by a statement sent in accordance with either Rule 18bis or 18ter for the goods and services listed in the request.

(2) [Fee] The division of an international registration shall be subject to the payment of the fee specified in item 7.7 of the Schedule of Fees.

(3) [Irregular Request] (a) If the request does not comply with the applicable requirements, the International Bureau shall invite the Office that presented the request to remedy the irregularity and at the same time inform the holder.

(b) If the irregularity is not remedied by the Office within three months from the date of the invitation under subparagraph (a), the request shall be considered abandoned and the International Bureau shall notify accordingly the Office that presented the request, it shall inform at the same time the holder and refund any fee paid under paragraph (2), after the deduction of an amount corresponding to one-half of that fee.

(4) [Recording and Notification] (a) Where the request complies with the applicable requirements, the International Bureau shall record the division, create a divisional international registration in the International Register, notify accordingly the Office that presented the request and shall inform at the same time the holder.

(b) The division of an international registration shall be recorded with the date of receipt by the International Bureau of the request or, where applicable, the date where the irregularity referred to in paragraph (3) was remedied.

(5) [Request Not Considered as Such] A request for the division of an international registration in respect of a designated Contracting Party that is not or is no longer designated for the classes of the International Classification of Goods and Services mentioned in the request will not be considered as such.

(6) [Declaration That a Contracting Party Will Not Present Requests for Division] A Contracting Party, the law of which does not provide for division of applications for the registration of a mark or registrations of a mark, may notify the Director General, before the date this Rule comes into force or the date on which the said Contracting Party becomes bound by the Agreement or the Protocol, that it will not present to the International Bureau the request referred to in paragraph (1). This declaration may be withdrawn at any time.

Rule 27ter Merger of International Registrations

(1) [Merger of International Registrations Resulting from the Recording of a Partial Change in Ownership] Where the same natural person or legal entity has been recorded as the holder of two or more international registrations resulting from a partial change in ownership, the registrations shall be merged at the request of the said person or entity, made either direct or through the Office of the Contracting Party of the holder. The request shall be presented to the International Bureau on the relevant official form. The International Bureau shall record the merger, notify accordingly the Offices of the designated Contracting Party or Parties affected by the change and shall inform at the same time the holder and, if the request was presented by an Office, that Office.

(2) [Merger of International Registrations Resulting from the Recording of the Division of an International Registration] (a) An international registration resulting from division shall be merged into the international registration it was divided from at the request of the holder, presented through the Office that presented the request referred to in paragraph (1) of Rule 27bis, provided that the same natural person or legal entity is the recorded holder in both aforementioned international registrations and the Office concerned is satisfied that the request meets the requirements of its applicable law, including the requirements concerning fees. The request shall be presented to the International Bureau on the relevant official form. The International Bureau shall record the merger, notify accordingly the Office that presented the request and shall inform at the same time the holder.

(b) The Office of a Contracting Party, the law of which does not provide for the merger of registrations of a mark, may notify the Director General, before the date this Rule comes into force or the date on which the said Contracting Party becomes bound by the Agreement or the Protocol, that it will not present to the International Bureau the request referred to in subparagraph (a). This declaration may be withdrawn at any time.

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

[...]

(viii**bis**) division recorded under Rule 27**bis**(4) and merger recorded under Rule 27**ter**,

[...]

(xi) information recorded under Rules 20, 20**bis**, 21, 21**bis**, 22(2)(a), 23, 27~~(3)~~ and (4) and 40(3);

[...]

[...]

(2) *[Information Concerning Particular Requirements and Certain Declarations of Contracting Parties]* The International Bureau shall publish in the Gazette

(i) any notification made under Rules 7, ~~or Rule 20**bis**(6)~~, 27**bis**(6), 27**ter**(2)(b) or 40(6) and any declaration made under Rule 17(5)(d) or (e);

[...]

Chapter 9 Miscellaneous

[...]

Rule 40

Entry into Force; Transitional Provisions

[...]

(6) *[Incompatibility with National Laws]* If, on the date this Rule comes into force or the date on which a Contracting Party becomes bound by the Agreement or the Protocol, paragraph (1) of Rule 27**bis** or paragraph (2)(a) of Rule 27**ter** are not compatible with the national law of that Contracting Party, the paragraph or paragraphs concerned, as the case may be, shall not apply in respect of this Contracting Party, for as long as it or they continue not to be compatible with that law, provided that the said Contracting Party notifies the International Bureau accordingly before the date this Rule comes into force or the date on which the said Contracting Party becomes bound by the Agreement or the Protocol. This notification may be withdrawn at any time.

[...]

PROPOSED AMENDMENTS TO THE SCHEDULE OF FEES

SCHEDULE OF FEES

(in force on [February 1, 2019](#))

Swiss francs

[...]

7. *Miscellaneous recordings*

[...]

[7.7 Division of an international registration](#)

[177](#)

[...]

**PROPOSED AMENDMENTS TO THE ADMINISTRATIVE INSTRUCTIONS FOR THE
APPLICATION OF THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL
REGISTRATION OF MARKS AND THE PROTOCOL RELATING THERETO**

**Administrative Instructions for the Application of the
Madrid Agreement Concerning the International
Registration of Marks and the Protocol
Relating Thereto**

(as in force on [February 1, 2019](#))

[...]

**Part Six
Numbering of International Registrations**

*Section 16: Numbering Following [Division or](#) Partial Change
in Ownership*

(a) The separate international registration resulting from the recording of partial change in ownership [or division](#) shall bear the number of the international registration of which a part has changed in ownership [or been divided](#), followed by a capital letter.

[...]

*Section 17: Numbering Following Merger
of International Registrations*

The international registration resulting from the merger of international registrations in accordance with Rule 27 ~~ter(3)~~ shall bear the number of the international registration of which a part had [changed in ownership or](#) been [divided](#) ~~assigned or otherwise transferred together,~~ [followed](#), where applicable, ~~with~~[by](#) a capital letter.

[Annex IV follows]

PROPOSED ROAD MAP

SHORT TERM

| WORKING GROUP | ROUNDTABLE |
|--------------------|---|
| Replacement | Classification principles |
| Transformation | Correction |
| New types of marks | Correspondence of marks for certification purposes |
| Limitations | Marks in different scripts Fulfillment of requirements Examination practices of the IB (publication of) |

MEDIUM TERM

| WORKING GROUP | ROUNDTABLE |
|---|--|
| Harmonized time limit to reply to a provisional refusal | Examination practices of the IB (publication of) |
| Correction | Reducing inconsistencies of classification practices |
| Fee revision and payment options | Updated International Registration Certificates |
| Possible reduction of the dependency period | |

LONG TERM

| |
|--|
| Entitlement to file |
| Issues listed in IV of document MM/LD/WG/14/4 "Options Concerning Offices" |
| Review procedure |
| Scope of the list of goods and services (possible de-linking) |

REPORTING TO ROUNDTABLE

Geographical coverage of the Madrid System

Performance Framework

Time to process regular transactions (maximum processing time)

E-Madrid

[Annex V follows]



MM/LD/WG/14/INF/1
ORIGINAL : FRANCAIS / ENGLISH
DATE : 17 JUIN 2016 / JUNE 17, 2016

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

**Quatorzième session
Genève, 13 – 17 juin 2016**

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

**Fourteenth Session
Geneva, June 13 to 17, 2016**

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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