

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

Seventeenth Session
Geneva, July 22 to 26, 2019

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 July 22 to 26, 2019.
2. The following Contracting Parties of the Madrid Union were represented at the session: African Intellectual Property Organization (OAPI), Albania, Algeria, Australia, Austria, Bahrain, Belarus, Brazil, Bulgaria, Canada, China, Colombia, Cuba, Czech Republic, Denmark, Egypt, Estonia, European Union (EU), Finland, France, Georgia, Germany, Greece, Hungary, India, Indonesia, Iran (Islamic Republic of), Israel, Italy, Japan, Kenya, Lao People’s Democratic Republic, Latvia, Lithuania, Madagascar, Mexico, Morocco, New Zealand, Norway, Oman, Poland, Portugal, Republic of Korea, Republic of Moldova, Romania, Russian Federation, Singapore, Spain, Sudan, Sweden, Switzerland, Tajikistan, Turkey, Ukraine, United Kingdom, United States of America, Viet Nam (57).
3. The following States were represented as observers: Bangladesh, Pakistan, Saudi Arabia, Sri Lanka, Trinidad and Tobago, United Arab Emirates (6).
4. Representatives of the following international intergovernmental organizations took part in the session in an observer capacity: Benelux Organization for Intellectual Property (BOIP), General Secretariat of the Andean Community, World Trade Organization (WTO) (3).

5. Representatives of the following international non-governmental organizations took part in the session in an observer capacity: China Council for the Promotion of International Trade (CCPIT), European Brands Association (AIM), European Communities Trade Mark Association (ECTA), 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, The Chartered Institute of Trade Mark Attorneys (CITMA) (9).

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

AGENDA ITEM 1: OPENING OF THE SESSION

7. Ms. Wang Binying, Deputy Director General, opened the session and, on behalf of Mr. Francis Gurry, Director General of the World Intellectual Property Organization (WIPO), welcomed the participants.

8. The Deputy Director General informed that, since the previous session of the Working Group, Brazil, Canada, Malawi and Samoa had joined the Madrid System for the International Registration of Marks (hereinafter referred to as “the Madrid System”). Further expansion of the Madrid System was expected over the following months and years, enabling it to become a truly global system. It was noted that a number of countries were well advanced in their preparation for accession to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as “the Madrid Protocol” and the “Madrid Agreement”), namely, Malaysia, Malta, Pakistan and Trinidad and Tobago. Countries in Latin America and the Middle East would be a focus for further work in the following years. In terms of the use of the Madrid System, 61,200 international applications were filed in 2018, an increase of 6.4 per cent compared to the preceding year. A growth rate of 9 per cent was expected in 2019. For the fifth consecutive year, applicants from the United States of America filed the highest number of applications, followed by applicants from Germany, China, France and Switzerland. The highest growth rate took place in the Republic of Korea, where applications had risen by 26.2 per cent, in Japan, by 22.8 per cent, in the United States of America, by 11.9 per cent, and in Turkey, by 10.2 per cent. The Deputy Director General also indicated that the European Union was the most designated Contracting Party, followed by China and the United States of America. Novartis AG was the most active filer of international applications in 2018, followed by L’Oréal, Daimler AG, Apple Inc. and Henkel AG & Co. Regarding developments in the Madrid System and the International Bureau over the last year, the Deputy Director General noted that pendency for international applications decreased by 42 per cent, from 60 to 35 days, that a new version of the Madrid e-Renewal service had been launched, and that preparatory work for the new Madrid System Information Technology (IT) platform project was well underway. The Deputy Director General stated that the Madrid Working Group Roundtable would provide the International Bureau with an opportunity to seek the advice of its 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

9. Mr. Steffen Gazley (New Zealand) was elected as Chair of the Working Group, Ms. Mathilde Manitra Soa Raharinony (Madagascar) and Ms. Constance Lee (Singapore) were elected as Vice Chairs.

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

AGENDA ITEM 3: ADOPTION OF THE AGENDA

11. The Chair thanked the participants for his election and the Deputy Director General for her opening remarks.
12. The Working Group adopted the draft agenda (document MM/LD/WG/17/1 Prov. 4).
13. The Working Group took note of the electronic adoption of the report of the sixteenth session of the Working Group.
14. The Chair opened the floor for general opening statements by delegations.
15. The Delegation of Brazil informed that, on July 2, 2019, the Government of Brazil had deposited with the Director General of WIPO its instrument of accession to the Madrid Protocol, which would enter into force, with respect to Brazil, on October 2, 2019. Acceding to the Madrid Protocol was part of Brazil's commitment to economic prosperity and innovation in a market economy environment and to the multilateral intellectual property systems. The National Institute of Industrial Property of Brazil (INPI) had recently eliminated its backlog and reduced the pendency of trademark examination to nine months from the filing date. INPI was currently working with the International Bureau on the translation of the International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement into Portuguese. The Delegation said it looked forward to contributing to the discussions on the development of the Madrid System.
16. The Delegation of Canada informed that, on March 17, 2019, the Government of Canada had deposited with the Director General of WIPO its instrument of accession to the Madrid Protocol, along with a number of declarations and notifications, which entered into force, with respect to Canada, on June 17, 2019. The Delegation further informed that acceding to the Madrid Protocol and taking the opportunity to modernize its legislative framework supported Canada's priorities on innovation and intellectual property. The Delegation emphasized that, in 2017, Canada had launched the innovation and skills plan that outlined an agenda to make Canada a world-leading center for innovation and intellectual property, including trademarks, which were a foundational element of that plan. In 2018, Canada also had unveiled a new intellectual property strategy to help Canadian businesses, creators, entrepreneurs and innovators understand, protect and access intellectual property. The Delegation indicated that the Canadian Intellectual Property Office's framework strategic plan outlined a vision for the way forward based on the five following pillars: (i) advancing innovation; (ii) delivering quality and timely intellectual property rights; (iii) building awareness and educating Canadians about intellectual property; (iv) offering a modern service experience; and, (v) fostering an agile and high performing organization. The Delegation added that Canada also had joined the Singapore Treaty on the Law of Trademarks and the Nice Agreement Concerning the International Classification of Goods and Services, as well as the Hague Agreement Concerning the International Registration of Industrial Designs. The Delegation stated that Canada was in the process of joining the Patent Law Treaty, which would come into force in October of that year. The Delegation informed that Canada had submitted the following declarations, to extend the refusal period from 12 to 18 months; to send a possible notification of refusal based on opposition after the 18 month time limit; to have an individual fee; and, that the recording of licenses in the International Register had no effect as provided for under domestic law. The Delegation said that Canada looked forward to working with all members of the Madrid Union as well as with the Secretariat.
17. The Delegation of Tajikistan noted that it was ready to discuss the issues set forth in the Agenda, in particular, the possibility of new languages in the Madrid System. The Delegation stated that multilingualism was deeply important in WIPO and hoped that such development in the Madrid System would allow the International Bureau to achieve some of the goals set for the Organization, particularly in the area of expanding IP services across the world.

18. The Delegation of China indicated that, since its foundation in 1891, the Madrid System had made significant progress and noted the comments made by the Deputy Director General concerning the number of countries that had acceded to the system and those that were preparing to do so. The Delegation indicated that the Working Group had played a great role and achieved notable results in the development of the system and said that China assigned great importance to this development and had interest in continuing with it. The Delegation stated that it actively sought to take part in the discussion of the Agenda items and that it expected to achieve more progress, in particular, on additional languages of the system, to make it more attractive and to promote its better development.

19. The Delegation of Ukraine said that it wished to draw the Working Group's attention to the fact that international trademark applications, which later resulted in international registrations, indicated the addresses of applicants living in territories occupied by other countries. For example, in applications filed by applicants from the territory of the Autonomous Republic of Crimea, the name of the country indicated in the address of the applicant was the Russian Federation, even though this territory was the territory of Ukraine. The Delegation recalled that the International Bureau had introduced a warning to this effect on the Madrid Monitor online platform, but stated that it did not believe such measure was an adequate solution. The Delegation stated that WIPO, as an agency of the United Nations (UN) system, had to share its views and adhere to the principles of that global international organization. The Delegation said that the recording of such international registrations by the International Bureau was contrary to the UN position on the territorial integrity of Ukraine set forth in the UN General Assembly Resolution 68/262, adopted on March 27, 2014. The Delegation emphasized that indicating in international registrations the address of applicants and holders living in territories occupied by other countries was a problem, and considered it necessary to raise this issue for the consideration of the Working Group. The Delegation called on other delegations and on representatives of international and intergovernmental organizations to apply all legal mechanisms available in their countries to refuse protection to such international registrations. The Delegation added that a similar statement had been made at the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications.

20. The Delegation of the United States of America referred to its proposal entitled "Contributing to the Financial Well-being of the Organization" that had been discussed during the previous session of the Working Group (document MM/LD/WG/16/10). The Delegation reiterated that the Madrid Union was not paying for its fair share of the common expenses, and requested that the Madrid Union budget and fees be reassessed and, possibly, adjusted. The Delegation recalled that the Working Group had decided that its proposal should be considered when the Schedule of Fees of the Madrid System was reviewed, and that it had decided that such review should be included in the Working Group mid-term Road Map. The Delegation said it understood the review would be addressed at the next session of the Working Group. The Delegation urged the Working Group to take up the issue sooner rather than later, particularly in light of the proposals to add languages to the Madrid System, and emphasized that incomes did not cover both direct and indirect costs. Therefore, there was little point in discussing adding cost to the system without fully understanding the fees schedule revision that would be necessary to bring the Madrid System into compliance with the terms of its own treaty Articles, which was to generate income that covered the cost of administering the system and to contribute to the Organization as a whole.

21. The Delegation of the Russian Federation, in response to the intervention made by the Delegation of Ukraine, noted that it highly valued the roles and significance of the Madrid System as a global system for the International Registration of Marks. The Delegation emphasized that the Working Group, which had now met 17 times, was an excellent platform for constructive discussions between experts and specialists working in the area of IP and a platform to discuss a large number of relevant issues included in the Agenda with regard to its development. The Delegation called on participants in the meeting to focus their efforts on the issues falling within the sphere of competency of the participants of that meeting, and to keep to the Agenda that had been proposed by the organizers of that meeting.

AGENDA ITEM 4: REPLACEMENT

22. Discussions were based on document MM/LD/WG/17/2.

23. The Secretariat introduced document MM/LD/WG/17/2 and noted that the Working Group had discussed replacement since its twelfth session. The Secretariat indicated that, at its previous session, the Working Group had requested that the International Bureau present a proposal to amend Rule 21 to reflect, in the rule itself, the key principles governing replacement, which the Working Group had discussed and tentatively agreed to in previous sessions. The Secretariat said that those principles would give useful guidance to both trademark holders and Offices on how to manage replacement. The proposed amendments to Rule 21 would state that: (i) the holder may present a request to take note of replacement, directly with the Offices of the designated Contracting Parties concerned, as from the date of the notification of the international registration or of the subsequent designation, as the case may be; (ii) the replaced national or regional registration may not be invoked to refuse protection to the mark in an international registration; (iii) the replaced national or regional registration may coexist with the International Registration that has replaced it; (iv) the Office of a designated Contracting Party must examine requests to take note of replacement; (v) the list of goods and services in the replaced national registration does not need to be identical to the list of the international registration, but it must be totally or partially covered by the list in the international registration that has replaced it; and, (vi) replacement occurs as of the date the national registration takes effect in the designated Contracting Party. The Secretariat proposed the amendments enter into force on February 1, 2020, the date on which the new Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as “the Regulations” would enter into force.

24. The Chair recalled that the issues for discussion were: (i) the time at which a request under Article 4*bis*(2) of the Madrid Protocol may be filed, covered by paragraphs 5 and 6 of the document; (ii) the principles concerning the previous national or regional registration, covered by paragraphs 7 to 12 of the document; (iii) the examination of a request under Article 4*bis*(2) of the Madrid Protocol, covered by paragraphs 13 to 18 of the document; (iv) the list of goods and services of the previous national or regional registration, covered by paragraphs 19 to 26 of the document; (v) the effective date of replacement, covered by paragraphs 27 to 31 of the document; and, (vi) the proposed date of entry into force of the proposed amendments to Rule 21 of the Regulations, covered by paragraph 32 of the document.

25. The Delegation of the European Union reiterated its view that replacement would benefit from a harmonization exercise and its support for discussions to find a consensual solution and to harmonize the practices, as far as the scope of replacement was concerned. The Delegation welcomed the proposal presented by the Secretariat, as reflected in the document and its Annex, with concrete suggestions for the amendment of Rule 21 and acknowledged with appreciation that the document focused on clarifying the key principles governing replacement, most of which reflected its own understanding. The Delegation endorsed suggestions about the time at which a request under Article 4*bis*(2) of the Madrid Protocol may be filed, the principles concerning the previous national or regional registration and the examination of request under

Article 4*bis*(2) of the Madrid Protocol. The Delegation also found that respective parts in the proposed amendments contained in the Annex had been drafted appropriately and in accordance with those suggestions. Nevertheless, the Delegation stressed that it could not support all proposals concerning the list of goods and services of the previous national and regional registration. The Delegation said that, while it agreed with suggestions in paragraphs 20 and 21 of document MM/LD/WG/17/2, it was not ready to endorse that the national or regional registration be partially replaced by an international registration. In light of such concerns, the Delegation said it fully supported the proposal by the Secretariat that the Working Group held further discussions on replacement, focused on the way in which replacement operated in the Offices of the Contracting Parties with the objective of making it more accessible and aligned with the needs of the users of the Madrid System. The Delegation welcomed the idea that such discussions take place at a future roundtable, noting that they stood ready to engage actively in continued discussions on that issue.

26. The Delegation of Japan stated that a consistent interpretation of the rules under the Madrid System would be most beneficial for users and supported all aspects of the proposed amendments to the Regulations. The Delegation expressed support for the Working Group recommending the adoption of the proposed amendments at the following session of the Assembly of the Madrid Union, which would be held later that year. The Delegation indicated that additional information on replacement, such as, for example, information on the replacement procedures on the Madrid Member Profiles database would further enhance the user-friendliness of the System.

27. The Delegation of Madagascar highlighted that its Office had only received five requests for replacement since Madagascar had acceded to the Madrid Protocol in 2008. The Delegation said that its Office always strived to deliver quality services to its users. Therefore, it supported the improvement of the legal framework relating to replacement and the clarification made in Rule 21 to ensure a uniform application of that Rule by Offices and to overcome any difficulties that holders of international registrations may encounter in different Offices. The Delegation stated that filing a request for replacement with the Office enabled better communication with holders of international registrations and, therefore, a better processing of their requests. The Delegation said it also favored the proposal to share experiences among Offices of Contracting Parties on the implementation of replacement during the roundtable.

28. The Delegation of China noted that principles concerning replacement were missing from the Regulations and that the proposed amendments would clarify some of those principles such as, for example, the effective date of replacement or when a request could be filed. The Delegation indicated that the proposed amendments would be helpful and agreed that the Working Group should recommend their adoption to the Assembly, for entry into force on February 1, 2020. The Delegation also said that, to understand the replacement procedure, more exchanges on the practices concerning that area were necessary.

29. The Delegation of Colombia stated that the national registration and the international registration that has replaced it could not co-exist in Colombia and that the Office would need time to implement the proposed amendments. Therefore, the Delegation said that the proposed date of entry into force was too early.

30. The Delegation of Australia supported the proposed amendments to Rule 21 because they would make the Madrid System more user-friendly and would streamline the replacement process for users and Offices. The Delegation said that it would support further discussions on replacement in the roundtable and supported the suggestion made by the Delegation of Japan that Contracting Parties update their Madrid Member Profiles on replacement. The Delegation added that it would support recommending the changes to the Madrid Union Assembly.

31. The Delegation of Israel informed that its Office had only received 20 requests for replacement over nine years. However, the Delegation stated that progress on the issue of replacement was needed to have a clearer and more harmonized practice among all Contracting Parties. The Delegation supported most of the proposed amendments. However, as it had stated in the previous session of the Working Group, it favored a literal interpretation of Article 4*bis*(1)(ii) of the Madrid Protocol, which would prevent the partial replacement of the national registration. The Delegation said that its Office would not be able to facilitate partial replacement until the legislation of Israel was changed, which would require considerable time. The Delegation agreed with the Delegation of Colombia and indicated that the proposed date of entry into force was too early.

32. The Delegation of the Russian Federation agreed with the Delegation of Colombia and stated that new paragraph (3)(a) of Rule 21 was problematic because its national legislation did not allow for the so-called “double registration” of an identical mark with an identical list of goods or services in the name of the same holder. The Delegation asked the Secretariat whether, under new paragraph (3)(a), the Office would have to accept such double registration, or whether the Office could refuse it.

33. The Delegation of Belarus supported most of the proposals concerning the principles of replacement, including, unlike other delegations, the possibility of a partial replacement, but found paragraphs 5 and 6 of the document under consideration problematic. According to the proposal, a request for replacement could be filed as of the date of notification of the international registration or subsequent designation to the Office of the designated Contracting Party. That would result in the Office having to prioritize the examination of replaced marks over other marks. The Delegation said that its Office would rather examine the replaced marks together with other marks filed on the same date. However, under its national legislation, a request for replacement had to be decided upon within 15 days. The Delegation said it would favor allowing a request for replacement to be filed only after protection was granted to the mark that was the subject of an international registration in Belarus, that is, after the recording of a statement of grant of protection in the International Register. Understanding that there might be other points of view, the Delegation agreed with other delegations and would welcome further discussions on replacement.

34. The Delegation of Brazil referred to paragraph 22 of the document and said it understood that the goods and services did not have to be identical and that there could be partial replacement. The Delegation underscored that examining partial replacement would be more complex, would raise cost and time and could increase the possibility of errors. However, the Delegation said it did not oppose the principle and agreed with the proposed date of entry into force, but reserved its right to comment on the other principles in the document, following further consideration.

35. The Chair referred to the comments made by the Delegation of Belarus and said that, in terms of the timing of the examination of the request, the holder could file the request for replacement at any time. Therefore, a possible solution would be for the Office of Belarus to delay the examination of such request until it had granted protection. Belarus could include such information on its Madrid Member Profiles page.

36. The Delegation of Georgia supported the proposed amendment to Rule 21 dealing with the scope of replacement, in particular, the possibility of presenting a request directly to the Offices concerned as from the date of the notification of the international registration or of the subsequent designation. The Delegation noted that it was working on the draft amendments of its national trademark law and on introducing the principle of co-existence with the national registration, preserving the holder’s right to renew this registration.

37. The Delegation of Algeria wondered whether, where a change in name or address of the holder recorded in the International Register was not recorded in the national or regional Register, the Office should take into account that change or whether it should request the holder to submit a request for the same recording to the Office. In such a case, the previous national registration would preclude the registration of the mark that was the subject of the international registration. The Delegation stated that Offices would require time to take note of the international registration in the national Register. The Delegation considered six months to be a reasonable time for Offices to examine the request, take note and notify the International Bureau.

38. The Delegation of the Republic of Korea supported the proposals, for a number of reasons, and recalled that replacement was introduced to alleviate the burden of renewing previous national registrations in one or more Contracting Parties, and that it should not be interpreted as a reason to invalidate or cancel the replaced national registration. Furthermore, the holder should continue to have the right to renew the replaced national registration or allow it to lapse. The Delegation said that it was important for the holder to decide whether to retain the replaced national registration or not and added that replacement did not require absolute identity or the equivalence of the list of goods and services. Replacement could take place where some of the goods and services listed in the national registration were subject of the international registration. Allowing holders to decide whether to let the national registration lapse after replacement gave holders a higher level of autonomy in exercising their rights and provided legal certainty over those rights. The Delegation reiterated its support for the proposed amendments to Rule 21 and said it was also in favor of further in depth-discussions on replacement at a later stage.

39. The Delegation of Switzerland recalled that a presentation on inclusive language had been given at the previous session of the Working Group and wondered why inclusive language had not been used in the proposed modifications to the Rules. The Delegation further asked whether the International Bureau planned to review the Regulations at a subsequent session, or whether it intended to modify the Regulations one at a time. On replacement, the Delegation supported the proposals, which corresponded to the Swiss practice and covered some important issues, particularly, partial replacement. The Delegation supported the principle that requests could be filed from the date of the notification of the international registration or subsequent designation that had not been examined by the designated Office. The Delegation wondered what would happen if the designated Office finely refused the international registration or subsequent designation due to, for example, a change in practice, and whether there should there be a provision for the taking of the note to have effect only if the Office granted protection to the international registration. The Delegation acknowledged that it was rather a general question but sought more clarification on that issue. The Delegation also questioned the date on which replacement would take effect but understood that this would be discussed at a later stage.

40. The Chair noted that some delegations had raised questions and invited the Secretariat to take the floor and reply to those questions.

41. The Secretariat responded to the question raised by the Delegation of the Russian Federation on whether co-existence had to be accepted by Offices or whether it was optional. The Secretariat informed that paragraph 9 of the document explained the principle of co-existence. The paragraph referred to the Diplomatic Conference in 1897, when replacement was introduced. When discussing Article 4*bis* of the Madrid Agreement at that time, the International Bureau warned that the administrative bodies or the courts of certain countries of the Union could be tempted to refuse an international registration where there existed a previous national one and that such refusal would neutralize all of the benefits of the international registration system. The document stated that it was convenient to declare that the previous national registration was not an obstacle to the validity of the international registration, which replaced any such previous national registrations. Accordingly, historical

documents supported that co-existence as a principle and not as an optional feature. Responding to the comments made by the Delegation of Belarus on when to receive requests to take note, the Secretariat explained that the examination of the request could be postponed, as suggested by the Chair. However, the Secretariat understood that such could be difficult and would depend on national practice. The Secretariat said that an Office would not be required to automatically start examining the international registration upon receipt of the request but that it would be useful to be aware of what the holder intended to replace when the examination of the international registration took place. If the request to take note was not available, the Office could be tempted to issue a refusal and the holder would have to find a local attorney to contest that refusal. The Secretariat said that, taking into account the difficulties to change its national practices indicated by the Delegation of Belarus, the Working Group could also consider clarifying in paragraph 1 of Rule 21 that the time to receive notification would be from the date of notification at the earliest. Responding to the first question raised by the Delegation of Switzerland concerning inclusive language, the Secretariat referred to the exercise of previous year and recalled that the English version was already fully inclusive. The Secretariat also recalled that it was agreed that discussions concerning whether the French and Spanish versions could also be made inclusive would take place in the future, bearing in mind that some delegations and representatives had raised some concerns. Once that exercise was underway, the International Bureau would ensure that the Spanish and French speaking delegations be consulted. Responding to the second question raised by the Delegation of Switzerland concerning refusals, the Secretariat said that if an Office had issued a refusal, the Office would not be required to take note that replacement had taken place.

42. The Representative of INTA agreed with the proposed amendments to Rule 21(1) of the Regulations regarding the date from which the request to take note of the International Registration may be presented. However, the Representative observed that under that paragraph (1), the holder could present a request for taking note of the international registration from the date of the notification of the international registration or the subsequent designation. The Representative noted that under Rule 24 of the Regulations, the holder was informed of the notification of a subsequent designation at the same time as the International Bureau issued that notification but no such information was sent to the holder under Rule 14 when the designation was made in the international application. Instead, the International Bureau sent a registration certificate to the holder. If it were the case that the certificate would be issued at the same time as the notification to the designated Contracting Parties, the certificate could be accompanied by information to the holder regarding the date of issue of the notification of the designation. If not, Rule 14 could be amended along the lines of Rule 24. The Representative welcomed the proposed additional subparagraphs (3)(a) and (b) which recognized the need for co-existence and noted that this was particularly important during the dependency period. The Representative of INTA also welcomed the additional subparagraph (3)(d) on partial replacement, and agreed with subparagraph (3)(e) regarding the effective date of the replacement. The Representative said that it had mixed feelings on the proposed additional paragraph (3)(c) that provides for an obligation for designated Contracting Parties to examine the request for taking note of the international registration in their Register in order to determine whether the conditions of Article 4*bis* had been met.

43. The Representative of JPAA supported the proposed amendments to Rule 21, as indicated in the Annex to the document, which clarified the key principles of replacement and harmonized the interpretation of replacement in designated Contracting Parties. The Representative of JPAA hoped that discussions would continue to establish a concrete procedure and fees.

44. The Representative of MARQUES supported the proposals put forward in the document. However, in line with its previous statements in relation to that topic, it believed that there should be an option of filing requests for replacement with the International Bureau, including the ability for users to pay any replacement fees via a central mechanism. The Representative considered it vital to improve the conditions for the user in the context of replacement and, if centralized filing was made available, the problem of a lack of a harmonized national procedure in the Contracting Parties would in essence disappear, as users would find the centralized filing option more attractive and accessible. Without it, replacement would remain under used. The Representative referred to MARQUES' position paper in relation to that topic and other topics.

45. The Representative of JTA said that users were not familiar with the replacement procedure, including its requirement and its effect; therefore, users hesitate to replace the older national registration with the newer international registration, so it was necessary to resolve the legal uncertainty of replacement. In that regard, the Representative believed that adding the new paragraph (3) to Rule 21 of the Regulations gave more clarity or guidance on the principles of replacement, which would encourage potential Madrid users to centralize their trademark portfolio under the Madrid Protocol. The Representative agreed with the proposed amendment that reflected those principles and hoped that it would make the Madrid System more user-friendly.

46. The Representative of JIPA supported the proposal to clarify replacement, as users of the Madrid System would be able to make use of the replacement procedure when managing their trademark portfolios in the future.

47. Responding to a question raised by the Representative of INTA, the Chair stated that both the registration certificate and the notification of subsequent designation included the date of notification to the Offices of designated Contracting Parties.

48. The Chair, noting there were no further comments relating to paragraphs 5 and 6 of the document, opened the floor for comments on paragraphs 7 to 12 regarding the principles concerning the previous national or regional registration. Noting that there were no comments relating to paragraphs 7 to 12, the Chair opened the floor for comments on the rest of the document.

49. The Delegation of Austria supported the statement made by the Delegation of the European Union and added that the Office of Austria applied a literal interpretation of Article 4*bis* of the Madrid Protocol. The Delegation further noted that the Office of Austria required that the list of goods and services concerned by replacement be identical or narrower in scope to those covered by the international registration.

50. The Delegation of the Russian Delegation requested clarification on paragraph (3)(a), in particular, whether it applied only where a request to take note of the international registration had been presented to the Office concerned, or in all cases, meaning also where the Office had not received any request for taking note of replacement. That question was important because the Office of the Russian Federation did not allow double registration. If no request had been presented to the Office, the Delegation wondered whether the Office could not follow the provisions of paragraph (3)(a).

51. Responding to the question raised by the Delegation of the Russian Federation, the Secretariat referred to previous discussions and reiterated that replacement took place automatically, without the holder having to do anything, as long as the conditions were met. That emphasized the importance of co-existence. If the holder wanted the Office to take note, it could request so. Once the Office confirmed that it had taken note, the holder may then eventually decide to let the national right lapse. If the Office, while examining an international registration, noted that there was no request to take note of replacement, it may seek

information from the holder on whether the national right, the earlier right, belonged to the holder. Some Offices may seek such information in the form of a provisional refusal. If holders confirmed to the Office that the national rights did belong to them, the Office would have to accept co-existence. The Secretariat also highlighted the importance of allowing holders to present requests as early as possible so Offices could have all information available when examining international registrations.

52. The Delegation of New Zealand agreed in principle with the proposed updates to Rule 21 that reflected the underlying principles of replacement. The Delegation informed that, while New Zealand was largely following those underlying principles, it welcomed the clarification provided on partial replacement. The Delegation explained that the approach taken in New Zealand was a literal interpretation of Article 4*bis*(1)(ii) and the proposed clarification that partial replacement for some goods and services was possible would allow the practice of New Zealand to change to allow for partial replacement. As to paragraph 4 of the document, the Delegation confirmed that it would be open to further discussions on replacement in the future, particularly the centralized system for requesting the taking note of replacement, which was discussed in previous sessions of the Working Group, as it saw further benefits in that system to users and Offices.

53. The Delegation of Hungary stated that the legislation of Hungary also required the list of goods and services to be identical, as mentioned by the Delegation of Austria.

54. The Delegation of Germany, noting that the principles of replacement had been discussed in the Working Group since 2010, said that it was concerned about the repetition of the topic. In the past, Germany had not allowed the co-existence of the national and the international registration, because Germany had previously believed that the national registration could no longer exist. However, it appeared from that session that some Offices still did not allow co-existence and had cancelled the national mark on replacement. The Delegation explained that the Office had changed its practice and that such change had not been a big task for its IT Department to implement and that the Office now accepted co-existence. The Delegation said that the Office did not accept partial replacement. The Delegation referred to the *Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol* (the Guide), published by WIPO, and said it believed that the Guide stated, as a condition for replacement, that all the goods and services listed in the national or regional registrations had to be also listed in the international registration. The Guide clearly stated that the international registration did not need to have an identical list of goods and services, but, while such list could be broader in scope, it could not be narrower. The Delegation explained that, to accept a partial replacement with a narrower list in the international registration, the Office would require changing its system, which would take longer than February 2020 to implement. The Delegation noted again the past discussions on that topic and considered whether a central filing system would improve the situation, as mentioned by MARQUES, given that the national or regional registration may still be canceled. However, after many years of discussion, the Delegation stated that at least the general principles should be agreed upon.

55. The Secretariat referred to the question raised by the Delegation of Algeria and said that, where an Office of a Contracting Party had taken note of replacement and was notified that a change in ownership had been recorded for the international registration concerned, the Office could declare that such change had no effect in that Contracting Party, unless the holder also changed the ownership of the national registration.

56. The Chair invited the Secretariat to take the floor for comments concerning the literal interpretation of Article 4*bis* of the Madrid Protocol and partial replacement.

57. The Secretariat said that, as some delegations had pointed out, the topic of partial replacement had been discussed in the Working Group for a number of years. Some of the discussions had concerned the wording in Article 4*bis*, with some Offices having a literal reading of that provision while other Offices having a more flexible reading. The Secretariat recalled that footnote 14 of the document referred to a document of the sixth session of the Working Group on the Application of the Madrid Protocol of 1989, held in Geneva from May 2 to 6, 1994, namely document GT/PM/VI/3. Paragraphs 98 to 100 of document GT/PM/VI/3 clearly reflected that the previous national or regional registration could be partially replaced and that replacement did not require the absolute identity or equivalence of the list of goods and services. The Secretariat referred to the text in paragraph 99 of document GT/PM/VI/3 and stated that it should be understood that nothing in the Agreement or in the Protocol prevented a Contracting Party from checking that all the goods and services listed in the national or regional registration were also listed in the international registration. Furthermore, the Secretariat said that the word “listed” should be understood as also including the word “covered”. For example, if a mark that was the subject of an international registration covered alcoholic beverages and designated a Contracting Party where the same mark was registered for wines, replacement should be limited to wines and the holder would benefit from prior rights resulting from the national or regional registration, whether this registration was renewed or not. On the other hand, if a mark that was subject of an international registration covered wines and designated a Contracting Party where the same mark was registered for alcoholic beverages or for wines and spirits, replacement would be for the wines only. If the holder wished to maintain the national registration in respect of the goods and services not covered by replacement, the holder would have to renew this registration for those goods and services. In view of document GT/PM/VI/3, the Secretariat reiterated that partial replacement was possible and it was not just limited to full replacement.

58. The Delegation of Austria asked the Secretariat to further clarify some of the references in the historical documents.

59. The Secretariat repeated the references to the historical documents, and added that paragraph 26 of document MM/LD/WG/17/2 and footnote 15 of that document encompassed the essence of replacement. The footnote referred to the Diplomatic Conference held in London in 1934 where the International Bureau of the Union stated that, when taking note in its Register, an Office should mention any difference between the list of goods and services in the national registration and that in the international registration.

60. The Delegation of the United States of America understood the desire for further guidance on replacement to provide clarity for users and national Offices. The United States Patent and Trademark Office (USPTO) had a national procedure in place that worked quite well and received between 15 to 20 requests per year to take note of a replacement. To put that in context, the USPTO received 21,812 designations in 2017 and 22,827 designations in 2018. The Delegation believed that further guidance would assist users when they received a provisional refusal from the Office of a designated Contracting Party based on an existing national registration, sometimes referred to as double protection refusal. The Delegation said that a request to take note of replacement was a tool for the users to argue against the provisional refusal, particularly when a designated Contracting Party did not have a clearly defined procedure for taking note of a replacement. The Delegation further stated that, as to the proposed principles governing replacement, it could only join consensus to support the effect of replacement on the national registration and support the literal reading of the goods and services for purposes of determining scope. The Delegation informed that it could not join consensus to support the proposals that the time for filing a request for replacement and the effective date of replacement were as of the date of the notification of the international registration or subsequent designation. The effective date of replacement was as of the date on which the extension of protection to the United States of America was actually registered. Neither the international registration nor the request for extension had any legal significance until the extension was actually issued as a registration in the United States of America. Only at

that point could it stand in the place of a prior national registration. At that time, if a request to take note of replacement was filed before the extension of protection was registered, the USPTO considered the request untimely or premature and did not process it and refunded the fee. To be flexible and for the convenience of holders, the USPTO was exploring the possibility of retaining and docking the request until the extension of protection was registered. At that time the Office would examine the request and determine its outcome. No refund of the fee would be issued under that scenario. The Delegation said that if draft Rule 21 moved forward, the United States of America would docket the request to take note of replacement until the extension of protection to the United States of America was granted or registered. Once the extension of protection was granted, the USPTO would examine the request and would take note of replacement. However, the USPTO would need time to implement IT changes to allow for that. Therefore, the Delegation of the United States of America requested that a transition period be incorporated in the rule. The Delegation said it could join consensus for the proposal on the effect of replacement on the national registration, in that the national registration and a subsequently registered extension of protection may coexist. The Delegation believed that only the owner or holder should have the right to decide whether to abandon or maintain the national registration. The designated Contracting Party should not *ex officio* cancel the national registration. The USPTO did not issue a refusal based on double protection when a request for extension of protection coincided with an existing national registration. The USPTO accepted the request for extension of protection as it was a different type of application under the legislation of the United States of America. Therefore, both could co-exist in the United States of America. The Delegation stated that it could also join consensus on the proposal for the designated Contracting Party to examine the request to take note of replacement before actually taking note of that replacement. The USPTO followed that practice and examined the request for compliance with conditions of Article 4*bis*(1). However, the Delegation was of the opinion that such examination and taking note took place only after the extension of protection was registered. Finally, as to the scope of the goods and services, the Delegation said that the United States of America could join consensus on the proposal advocating for the literal reading of goods and services. That was, that the goods and services in the national registration be the same or equivalent to those covered in the international registration. The Delegation believed the equivalent standard allowed accommodation for any translation issues, and was more favorable and beneficial to the applicant. The USPTO practice did not currently offer partial replacement. The USPTO required the holder to delete or narrow the goods and services in the national registration that were not encompassed in the registered extension of protection. The Delegation recognized that this was not beneficial to the holder for two reasons. One, the holder was forced to lose trademark rights in the goods and services deleted from or narrowed in the national registration. Two, there was no less of an incentive or reason for the holder to maintain the national registration other than, perhaps, for possible future court action since both the national registration and the registered extension of protection had the same goods and services. Therefore, the Delegation said that it would consider whether to allow taking note of partial replacement so that the holder could retain trademark protection for the goods and services remaining in the national registration. However, if the USPTO incorporated a partial replacement practice, it would need a five- to ten-year implementation period to devise and implement IT changes to reflect, in the USPTO's trademark database and on the certificate of registration, which goods and services had been replaced and which had not.

61. The Chair noted that there was some agreement on most of the principles of replacement and acknowledged that the main issue of disagreement was around partial replacement and on the literal interpretation of Article 4*bis* which was due, in particular, to the extra time needed to amend national laws and update IT systems. The Chair invited the Secretariat to take the floor to introduce the possibility of a transitional provision.

62. The Secretariat referred to the previous proposal made by the Delegation of the United States of America regarding the possibility of a transitional provision and recalled that a transitional provision had been introduced in 2009 in Rule 40(5), following the mandatory requirement to issue grants of protection introduced in Rule 18ter(1). Rule 40(5) related only to statements of grant of protection and stated that no Office shall be obliged to send statements of grant of protection under Rule 18ter(1) before January 1, 2011. That paragraph had now been deleted. Given some of the concerns raised by delegations, the Secretariat envisaged that a similar approach could be taken concerning the principle of partial replacement. If the Working Group agreed with the revised proposal concerning Rule 21, it could be possible to also introduce a new paragraph (7) in Rule 40 with the heading “[*Transitional Provision Relating to Replacement*]” and with the following text: “no Office shall be obliged to apply Rule 21(3)(d) before February 1, 2025.” The Secretariat said that the provision would give Offices sufficient time to amend their legislation and their IT structures.

63. The Chair opened the floor for discussions on the Secretariat’s proposal and noted no further comments.

64. The Representative of INTA reminded the Chair of his earlier intervention concerning his mixed feelings on the proposed additional paragraph (3)(c) of Rule 21 and questioned whether it would be possible to revisit such discussions when considering the draft wording of the transitional provision in Rule 40, as proposed by the Secretariat.

65. The Chair recalled that the floor had been opened for comments on the entire document, and that no comments were raised concerning the proposed additional paragraph (3)(c). Therefore, discussions would proceed in relation to the new text in respect of the proposed transitional period only.

66. The Chair referred to a minor amendment made by the Secretariat to the proposed wording for Rule 40(7), noting that a comma was included in the second sentence.

67. The Delegation of the European Union reiterated its intention to continue the debate with caution, as long as there were still some points that should be considered. Specifically, the Delegation was concerned about the possible misalignment of the proposed draft of Rule 21(3)(d), second sentence, with Article 4bis(1)(ii) of the Madrid Protocol. The introduction of that new paragraph would certainly change the procedures of the Madrid System. Even with the provisional exemption until 2025, the consequences were important enough to take that issue into further consideration. For that reason, the Delegation suggested that the draft provided by the Secretariat be taken as a first step and the decision on that issue be postponed to the next session of the Working Group. Nevertheless, the Delegation was open to further discussion on that important issue.

68. The Chair sought clarification from the Delegation of the European and asked whether the Delegation’s request for postponement made in respect of the principle in proposed draft of Rule 21(3)(d), second sentence, concerned only that aspect or all principles, noting that the other principles had tentatively been agreed upon by the Working Group.

69. The Delegation of the European Union clarified that it wished to wait only on the aforementioned aspect.

70. The Chair proposed deleting the second sentence of Rule 21(3)(d), which related to Rule 40 and partial replacement. The Chair said that this would allow the rest of the proposed wording to enter into force on February 1, 2020, and suggested that the second sentence be revisited at the next session of the Working Group. The Chair added that it would be helpful if there could be some thought given as to when that second sentence might enter in force. The Chair opened the floor for comments on that proposal.

71. The Delegation of Germany said it was not aware that there had been any agreement, especially given that some Contracting Parties had problems with coexistence and not only, as mentioned by the Delegation of the European Union, with the partial replacement in the second sentence of Rule 21(3)(d). The Delegation requested clarification on the Chair's proposal that the second sentence be deleted and did not believe that it was a question of when it should enter into force, because some delegations did not agree with it in principle, but rather whether it should enter into force at all.

72. The Chair, in reply to the Delegation of Germany, recalled that there had been discussions regarding concerns about co-existence. However, it appeared that such concerns were related to the time frame required to amend legislation rather than to the principles. A 2021 date of implementation was discussed to ensure that members had an opportunity to align their legislation. The Chair recalled that a number of members were already allowing partial replacement and that the Secretariat had explained the history of partial replacement. Accordingly, the principles were no longer being discussed, but rather the time frame for their entry into force and the intention was to remove the second sentence so that the rest of the proposal could be moved forward. The Chair further clarified the position by summarizing that there was agreement on the text of draft Rule 21, with the removal of the second sentence, which states that replacement may concern some only goods and services listed in the national or regional registration, with an entry into force of February 1, 2021. The Chair said that the proposed date gave a time to ensure any alignment in national legislation could be done and that, at the following session of the Working Group, discussions around that second sentence should be revisited in a narrower context. The Chair opened the floor for any objections to that proposed way forward.

73. The Delegation of Spain said that it had no objection to the proposed way forward, but after speaking to other delegations, wanted to comment on the interpretation of the text of the Article, as referred to by the Secretariat. The Delegation was concerned about the divergence in opinion on how the Article should be interpreted and, given those differences in interpretation, believed that the Article could be made clearer. The Delegation proposed the next session of the Working Group consider the Article with a view to revising the wording for clarification.

74. The Chair, in response to the Delegation of Spain, noted that the issue of partial replacement was going to be looked at the next session of the Working Group and that the document that would be prepared by the International Bureau would provide further information on the background and on the revised Rule.

75. The Working Group:

- (i) agreed to recommend to the Madrid Union Assembly the adoption of the amendments to Rule 21 of the Regulations, as set out in Annex I to the present document, with February 1, 2021, as the date for their entry into force;
- (ii) requested the International Bureau to prepare a document, for discussion at its next session, proposing a possible further amendment to Rule 21 of the Regulations concerning the partial replacement of a national or regional registration by an international registration.

AGENDA ITEM 5: OTHER PROPOSED AMENDMENTS TO THE REGULATIONS UNDER THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

76. Discussions were based on document MM/LD/WG/17/3.

77. The Secretariat introduced document MM/LD/WG/17/3 and explained that the proposed amendments to the Regulations under the Madrid Protocol had been identified by the International Bureau and supported its ongoing process of simplifying the Regulations to make the Madrid System more user-friendly. The document concerned specifically amendments to Rules 25, 27*bis*, 30, and 40 of the Regulations under the Protocol. The Secretariat noted that the four proposed amendments sought to: (i) clarify, in Rule 25(4), that for a recording of a change in ownership concerning several transferees the entitlement must be established for each of them; (ii) clarify, in Rule 27*bis*(3), that irregularities which concerned the payment of fees to the International Bureau for the recording of division of an international registration must be remedied by the holder and not by the Office; (iii) simplify the current renewal process and the process of calculating fees in Rule 30 by no longer requiring a statement in case of renewal for Contracting Parties where partial protection had been granted; and, (iv) deal with incompatibility with the law of intergovernmental organizations concerning division and merger, set out in Rule 40(6). The Secretariat proposed that those amendments enter in to force on February 1, 2020, which was also the date on which the new Regulations under the Protocol would enter in to force.

78. The Chair suggested that the document be discussed in four parts and first opened the floor for comments on paragraphs 3 and 4 concerning the request for recording of a change in ownership, Rule 25(4), where there are several transferees.

79. The Representative of INTA strongly agreed with the proposed change to Rule 25.

80. The Delegation of Switzerland in principle had no comments on the proposed change to Rule 25 and believed that it simplified the process. However, the Delegation remarked that the text in Rule 25 provided that each new owner should meet the requirements indicated in Article 2 of the Protocol and, since those were non-cumulative requirements, the Delegation wondered whether the text should say, instead, "one of the requirements indicated in Article 2 of the Protocol". The Delegation further mentioned that it was just a question of wording, at least in the French language, and requested that other French speaking delegations share their views on that. The Delegation was unclear as to whether the wording had any impact on substance.

81. The Chair invited French speaking delegations to take the floor and share their thoughts on the issue raised by the Delegation of Switzerland. The Chair added that the wording was included in the original version of the Rule and therefore, considered that there should not be an issue.

82. The Delegation of Switzerland noted that there was also the same problem concerning the English text. Article 2 of the Protocol mentioned conditions that were non-cumulative. Therefore, the Delegation wondered whether an amendment to that wording should also be discussed when considering the change to Rule 25. However, the Delegation deferred to the Secretariat, given its experience in drafting legal texts.

83. The Chair referred to the wording that had been questioned by the Delegation of Switzerland and suggested leaving the text as it was to avoid opening up new problems, particularly, as it had not posed any problems in the past.

84. The Chair noted an agreement to the proposed change to Rule 25(4) and opened the floor for comments on paragraphs 5 to 8 which concerned irregularities in requests for the division of an international registration, Rule 27*bis*(3).

85. The Delegation of Belarus noted that the revised Rule 27*bis*(3) referred to an irregularity that was not remedied within three months from the date of the communication under subparagraph (a) or (b) and suggested that the word “or” in the wording be changed to “and/or” because a request for division might be defective for both fees and otherwise.
86. The Chair referred to the suggestion made by the Delegation of Belarus and indicated that the preference would be to leave the wording, as it was in line with the standard drafting practice. Further, the use of the word “or” did not prevent either or both irregularities being raised. Accordingly, the proposed drafting should be sufficient to address the concerns that were raised.
87. The Chair noted that there were no further comments on Rule 27*bis*(3), and that there appeared to be an agreement to the proposed changes. The Chair then opened the floor for comments on paragraphs 9 to 19 of the document concerning Rule 30.
88. The Delegation of Japan supported the proposed amendments to the Common Regulations and believed that they further enhanced user-friendliness. However, the Delegation was hesitant to confirm its agreement to the proposed amendment to Rule 30 without further clarification. Since paragraph (2)(d) of Rule 30 was to be deleted, the procedure to renew an international registration for all the goods and services for certain designated Contracting Parties, when those goods and services were partially refused, was not clear.
89. The Delegation of Switzerland had some minor concerns regarding the wording of Rule 30 and noted that new paragraph (1)(c) allowed the individual fee to be determined by taking into account only the products and services indicated. However, as the individual fees were established by reference to the number of classes provided for, and not the goods and services, the Delegation suggested that the paragraph be amended to reflect that the individual fee took into account the number of classes of goods and services concerned.
90. The Delegation of Austria stated that it was in favor of any amendment of Rule 30 that simplified form MM11. In the past, users from Austria had problems understanding items three and four of form MM11. Users were confused about the existence of two alphabetical lists of Contracting Parties. The Delegation asked what would be the practical consequences of the proposed amendment of Rule 30, particularly, whether item 4 in form MM1 would be made redundant and only one alphabetical list would remain.
91. The Delegation of Brazil requested clarification of the proposed amendment of Rule 30. The Delegation understood that that holder had two options : (i) if the holder did not make the declaration, the class granted protection would be renewed and; (ii) if the holder made the declaration, all classes would be renewed and there would be no option to choose the goods and services that are to be renewed. The Delegation said that it agreed with the amendment if its understanding was correct.
92. The Chair noted the suggestion made by the Delegation of Switzerland regarding the reference to the number of classes, rather than to the goods or services, but was hesitant to introduce such a reference given that other rules in the Regulations referred to goods and services rather than classes. Therefore, the Chair suggested that it might be better to leave the proposed wording for consistency with other rules. The Chair invited the Secretariat to take the floor to answer some of the questions raised by other delegations.
93. The Secretariat explained that, where the holder had received a statement in accordance with Rule 18*ter*(2) or Rule 18*ter*(4) concerning partial protection in a designated Contracting Party, the holder could opt to pay for only the classes covered by the scope of protection. In such a case, if the holder wanted to renew all classes covered by the international registration, including those that had been partially refused, the holder would be obliged to make a statement and pay the fees for all the classes concerned. This way, holders preserved

their position in the event they overcame the partial refusal on appeal. The feedback from users indicated that the procedure was cumbersome. Further, some designated Contracting Parties stated that they could not accept payment for classes that were not covered by the given scope of protection. The proposal put forward simplified the renewal process and made it easier for holders to renew the international registration. The holder would no longer be required to make a statement, nor would the holder be required to pay fees for classes that were not covered by the scope of protection. In the event that the holder had ongoing appeal proceedings and those appeal proceedings were successful, the holder would then pay the fees for all the classes covered by the extended scope at the next renewal date. The Secretariat further clarified that the proposed amendment to Rule 30 would make it easier for holders to renew because there was a delinking of the request to renew from the payment for the classes. The change would entail changes to form MM11. Addressing the question raised by the Delegation of Austria, the Secretariat stated that the form would be much simpler and that there would be one list for Contracting Parties. The e-renewal tool would also be simplified. The Secretariat added that the proposed change applied to cases where partial protection had been granted by a Contracting Party. Where the holder wanted to renew for a Contracting Party that had issued a total refusal, the holder would still need to pay for all the classes covered by the international registration.

94. The Chair noted that no further delegations had requested the floor and that there was agreement with the proposed changes to Rule 30. The Chair opened the floor for comments on paragraph 20 of the document concerning the notification under Rule 46.

95. The Delegation of China expressed support for the proposed amendments to Rule 25, noting that all transferees needed to conform with the requirements of the Protocol concerning entitlement; Rule 27*bis*, on irregularities concerning the payment for the division of an international registration and its remedies; Rule 30, streamlining the renewal of international registration; and Rule 40, on notification. However, with regard to Rules 27*bis* and 27*ter*, concerning the division and merger of an international registration, the Delegation reiterated that China had made a declaration confirming that those Rules did not currently apply to China.

96. The Delegation of Brazil had some questions concerning the proposed amendments to Rule 30 and needed further time to consider their implications following the explanation given by the Secretariat.

97. The Chair opened the floor for comments on paragraph 21 of the document concerning the proposed date of entry into force, which was February 1, 2020.

98. The Delegation of Colombia highlighted that it was crucial for Colombia to extend the entry in to force of the proposed amendments to allow for the introduction of a new system to deal with those requirements.

99. In response to the Delegation of Colombia, the Chair explained that, given the nature of the proposed changes, there should not be any significant impact on the procedures on or requirements for the Offices and indicated that the proposed date should be acceptable.

100. The Delegation of Colombia acknowledged the comments made by the Chair.

101. The Delegation of Madagascar noted that, given the nature of the proposed amendments, it supported the entry in to force of the proposed amendments on February 1, 2020.

102. The Chair noted that there was agreement on recommending to the Madrid Union Assembly that the proposed amendments enter into force on February 1, 2020, and opened the floor for any final comments.

103. The Delegation of Brazil confirmed that it had no further comments on Rule 30.

104. The Working Group agreed to recommend to the Madrid Union Assembly the adoption of the amendments to Rules 25, 27*bis*, 30 and 40 of the Regulations, as set out in Annex II to the present document, with February 1, 2020, as the date for their entry into force.

AGENDA ITEM 6: FINDINGS OF THE SURVEY ON ACCEPTABLE TYPES OF MARKS AND MEANS OF REPRESENTATION

105. Discussions were based on document MM/LD/WG/17/4.

106. The Chair indicated that discussions on Agenda item 6, regarding the survey on acceptable marks, would be combined with discussions concerning Agenda item 10, regarding possible amendment to Rule 9 of the Common Regulations under the Madrid Agreement concerning International Registration of Marks and the Protocol relating to that Agreement.

107. The Secretariat recalled that, at its previous session held in 2018, the Working Group requested the International Bureau to conduct a survey among Offices of the Contracting Parties of the Madrid System on acceptable types of marks and means of representation, and to present a document on the findings of that survey at the current session. The Secretariat explained that the survey, in the form of an online questionnaire, had been conducted between January 14 and February 15 earlier that year with the participation of 82 Offices. The questionnaire and the replies were all available on the webpage of the current session of the Working Group, under other related documents. The Annex of the document provided a summary of the findings, without an analysis. The findings covered the views of the Offices in areas such as definition of a trademark, which specific signs were excluded from registration, what were acceptable types of marks and means of representation, the format and means to file an application with the Office, and formats used by the Office to store, manage and publish electronic representations of marks.

108. The Chair suggested breaking the discussions on the results of the survey into several parts and opened the floor for comments on Part (I) of the document, "Definition of Trademark" and Part (II) of the document, "Signs Excluded from Registration".

109. The Chair noted that there were no comments on Part (I) or Part (II) of the document and opened the floor for comments on Part (III) of the document, "Acceptable Types of Marks and Means of Representation".

110. The Delegation of Belarus said that it had a remark on Question 1.a. of the questionnaire, concerning visually perceptible signs. The Delegation indicated that answers to some of the questions might not always be informative because, for example, the Office of Belarus had to answer "no" to Question 1.a. because its law did not have a provision concerning the visual perceptibility of signs. However, that did not mean it would not accept visually perceptible signs for registration, its law just followed a different logic and stated that a trademark was any sign capable of distinguishing goods and services of one enterprise from goods and services of another. One might interpret such a provision in Belarus very liberal in terms of accepting any type of mark. However, another provision in the law rendered it very restrictive because it stated that only verbal marks, figurative marks and combination marks might be registered. The Delegation reiterated therefore, that the answers to the questions might be not always be informative.

111. The Chair noted that no other delegations had requested the floor, but acknowledged that Part (III) of the document was large and therefore, believed that it might be helpful to break the discussions down further into groups of questions. The Chair suggested starting with Question 3. of Part (III) of the document, where the applicant was required to specify in the application the type of mark for which registration was requested. The answers indicated that most Offices required the applicant to specify the type of mark. The Chair then suggested

moving on to Question 4. of Part (III) of the document, that indicated that for 22 per cent of Offices a description of the mark was mandatory, and that in 77 per cent of Offices a description was optional. One Office advised that it was not possible to provide a description. Lastly, the Chair suggested that the Working Group look at Question 5. of the document, concerning the situation where an indication of the type of mark was neither specified nor included in the description and whether the Office would accept and process the application in that case. The Chair noted that 60 per cent of Offices would process the application, 40 per cent said they would not and 19 Offices indicated that they provided the applicant with an opportunity to specify.

112. The Chair opened the floor for comments on Questions 3. to 5. of Part (III) of the document.

113. The Delegation of India stated that description of the trademark should be mandatory because the applicant would then properly describe the mark, as intended, and said that, if it were optional, it may pose problems for Offices that would have to describe the mark concerned when indexed on-line. The Delegation stated that the applicant should properly describe the mark.

114. The Delegation of Germany mentioned that the German Office had answered “b.” to Question 4., so it was within the 77 per cent who said that a description of a mark was optional. However, that answer was wrong and was only selected because sometimes a description was not permitted in Germany and the Office was not able not select more than one answer. However, sometimes a description could be mandatory, such as, for example, if the mark was otherwise not clear, the Office would need a description. The most appropriate answer would have been that a description was either mandatory or not allowed.

115. The Delegation of Spain said that its Office, like the Office of Germany, had answered Question 4. of Part (III) in a way that did not reflect its practice. The options that were available had led the Spanish Office to indicate that a description of a mark was optional. However, there were some cases in which, given the complexity or other circumstances surrounding a mark, a description was needed for the mark to be understood better by the Office.

116. The Chair thanked the delegations for their comments and moved on to Question 6. of Part (III) of the document, concerning the types of marks accepted by the Office and, where applicable, the way in which they must be represented. The Chair noted that there were a number of different types of mark. Every Office accepted word marks. Nearly half of those Offices required the use of standard characters for the representation of word marks. Most Offices required that the words be translated. Furthermore, a high number of Offices confirmed that a transliteration was required.

117. The Chair opened the floor for comments on Question 6.a. of Part (III) of the document, concerning word marks.

118. The Chair noted that there were no comments from delegations concerning Question 6.a. of Part (III) of the document and moved on to Question 6.b. of Part (III) of the document, concerning figurative marks. Almost all Offices indicated that they accepted figurative marks and most of those indicated that the mark had to be graphically represented and be clear, such as, for example, with an image. Some Offices had also indicated other requirements such as, for example, the size of the image, the quality of the representation or that the applicant provide a clear indication of color, if that was applicable. The most common file types or formats that were allowable were JPEG, GIF and PNG.

119. The Chair opened the floor for comments on Question 6.b. of Part (III) of the document, concerning figurative marks.

120. The Chair noted that there were no comments from delegations on Question 6.b. of Part (III) of the document and moved on to Question 6.c. of Part (III) of the document, concerning non-traditional trademarks. The Chair noted that 50 Offices, 61 per cent, accepted hologram marks. In terms of representation, most Offices indicated that they require a number of images, drawings or pictures that identify the effect of the hologram. Many Offices also indicated that they accept digital or video files. The file format of that type included MP4 and JPEG.

121. The Chair opened the floor for comments on Question 6.c. of Part (III) of the document, concerning hologram marks and, in particular, their representation.

122. The Chair noted that there were no comments on Question 6.c. of Part (III) of the document and moved on to Question 6.d. of Part (III) of the document, concerning three-dimensional marks or, as they were sometimes known, shape marks. The Chair noted that most Offices, 96 per cent, accepted three-dimensional marks, both in terms of product packaging and product shapes. In terms of representation of three-dimensional marks, most Offices required a photographic reproduction or a graphic representation of the mark. One Office also required a physical sample, if necessary. There were a number of different file types indicated including, JPEG, OBJ, STL and X3D.

123. The Chair opened the floor for comments on Question 6.d. of Part (III) of the document concerning three-dimensional marks.

124. The Chair noted that there were no comments from delegations on Question 6.d. of Part (III) of the document and moved on to Question 6.e. of Part (III) of the document concerning color marks. Ninety three per cent of Offices indicated that color marks were acceptable. Many Offices, 82 per cent, allowed single color marks, whereas 18 per cent said that a single color was not acceptable. In terms of a combination of colors, all Offices said that those were acceptable. In terms of representation requirements, most Offices required a clear reproduction of the mark in color. If the mark comprised a combination of colors, a reproduction showing the systematic arrangement of the color combination was often required. Most Offices required a clear description or indication of the color, and some also required a recognized color standard to narrow it down to a particular shade of color, using often the pantone system. The most commonly indicated file format was JPEG.

125. The Chair opened the floor for comments on Question 6.e. of Part (III) of the document, concerning color marks.

126. The Chair noted that no comments were raised by delegations on Question 6.e. of Part (III) of the document, concerning color marks or their representation, and moved on to Question 6.f. of Part (III) of the document, concerning sound marks. The Chair noted that 73 per cent of Offices indicated that sound marks were acceptable. However, 27 per cent of Offices indicated that sound marks were not allowed. The national and regional practices concerning the reproduction of sound marks varied significantly. Many Offices required either a sound file or a graphical representation of the musical notation, with or without a description of the sound. Some Offices also required both the sound file and a graphical representation of the sound, or accepted other reproductions of the sound such as, for example, a sonogram or phonogram. Some Offices were flexible and offered the applicant a choice of reproduction.

127. The Chair opened the floor for comments on Question 6.f. of Part (III) of the document, concerning sound marks.

128. The Representative of INTA was pleased to note that 73 per cent of the Offices that had replied to the survey allowed for sound marks. However, the Representative also noted that Question 1. indicated that 43 per cent of those Offices required that the mark be visually perceptible and, given that inconsistency, wondered whether question one had been correctly understood.

129. The Chair noted that no further comments were raised by delegations on Question 6.f. of Part (III) of the document and moved on to Question 6.g., concerning motion marks. The Chair recalled that 54 per cent of Offices accepted motion marks, while 46 per cent indicated that they did not. Twenty one of those Offices indicated that they accepted motion marks represented in video or graphical form. Five Offices required a video and graphical representation. Sixteen Offices required a graphical reproduction and a series of sequential images. Not all Offices specified how the marks should be represented, but some acceptable formats included JPEG and MP4. Given some of the similarities, the Chair grouped Question 6.f. with Question 6.h., concerning multimedia marks, and commented that 44 per cent Offices indicated that multimedia marks were acceptable. Fifteen Offices indicated that they accepted or required audiovisual files and many required MP4 format. The Chair noted that quite a few Offices still required a graphical reproduction of the mark.

130. The Chair opened the floor for comments on Questions 6.g. and 6.h. of Part (III) of the document, concerning motion and multimedia marks.

131. The Chair noted that no comments were raised by delegations concerning Questions 6.g. or 6.h. of Part (III) of the document and moved on to Question 6.i. of Part (III) of the document, concerning a variety of different types of marks. The marks referred to in Question 6.i. were considered less common and were gesture marks, smell marks, pattern marks, position marks, taste marks, texture marks and trade dress. The Chair noted that not all Offices accepted all of those marks but 60 per cent indicated that one or more of those types of marks were acceptable. The Chair then referred to the breakdown included in the document and stated that 21 Offices accepted pattern marks, 23 Offices accepted position marks, nine Offices accepted trade dress, eight Offices accepted olfactory marks, six Offices accepted tactile marks, seven Offices accepted taste marks and six Offices accepted gesture marks. Finally, the Chair noted that ten Offices indicated that they accepted any mark capable of being represented graphically.

132. The Chair opened the floor for comments on the other types of marks referred to in question 6.i.

133. The Chair noted that no comments were raised by delegations concerning Question 6.i. of Part (III) of the document and moved on to Parts (IV) and (V) of the document, concerning the format and the means to file an application with the Office and the standards used by the Office to store and manage and publish electronic representations of marks.

134. The Chair opened the floor for comments on Question 7 of Part (IV) of the document, concerning acceptable formats to file an application with the Office, noting that 91 per cent of Offices still allowed a paper form to be filed, whereas seven Offices, 9 per cent, said paper forms were no longer allowed. Half of the Offices accepted an image of the form such as, for example, a PDF or JPEG file. The Chair also recalled that structured data, e-filing, was used in 68 per cent of cases.

135. The Chair noted that no delegations had requested the floor and suggested reviewing Questions 8 and 9 of Part (IV) of the document together, which concerned the submission of the application and noted that 24 per cent of Offices no longer used facsimile and that most Offices, 74 per cent, allowed for the electronic representation of the mark.

136. The Chair opened the floor for comments on Questions 8 and 9 of Part (IV) of the document regarding submission of the application.

137. The Representative of INTA pointed out that, from the results of the survey, three out of four of the Offices participating in the survey required or allowed an electronic representation of the mark and, among those Offices, one out of two accepted a digital sound recording. Four out of 10 Offices accepted digital recording of moving images with or without sound. The Representative of INTA believed that such information would be extremely useful in the discussion of document MM/LD/WG/17/8, concerning possible amendments to Rule 9.

138. The Chair opened the floor for comments on the remaining questions of Part (IV) of the document namely, Questions 10, 11, 12 and 13.

139. The Chair noted that there were no further comments concerning the remaining questions of Part (IV) of the document and opened the floor for comments on the last section of the document, Part (V) and Questions 14 to 16.

140. The Chair noted no comments were raised on Questions 14 through to 16 of Part (V) of the document and that discussions would continue in relation to item 10 of the Agenda.

141. The Working Group took note of the findings of the survey on acceptable types of marks and means of representation presented in the document.

AGENDA ITEM 7: NOTIFICATION OF PROVISIONAL REFUSAL – TIME LIMIT TO REPLY AND WAYS IN WHICH TO CALCULATE THAT TIME LIMIT

142. Discussions were based on document MM/LD/WG/17/5.

143. The Secretariat said that the International Bureau regularly received complaints from users of the Madrid System concerning provisional refusals and time limits. In view of those complaints, and to learn more about those time limits, the International Bureau conducted a survey among Contracting Parties on provisional refusals and presented the findings of that survey in the Roundtable in 2014*. The Secretariat recalled that the topic was listed for discussion in the mid-term priorities of the Working Group Road Map. Therefore, the International Bureau prepared document MM/LD/WG/17/5 for discussion at the current session of the Working Group. The Secretariat noted that the document presented specific challenges that users of the Madrid System faced when they received provisional refusals focusing, in particular, on the different time limits Offices of Contracting Parties had to notify provisional refusals, different time limits set by Offices for holders to respond to those refusals and the different ways Offices calculated those time limits. To address users' concerns, the Secretariat added that the Working Group could consider amending the Common Regulations to specify a harmonized or a minimum time limit for holders to respond to the Offices concerned, and a harmonized way to calculate the time limit. The Secretariat acknowledged that determining the time limit to notify a provisional refusal could pose a challenge for the Office of a Contracting Party, particularly in the case where the Contracting Party concerned is a member of the Agreement and it had made the declaration to extend the time limit to 18 months. In that situation, the Office would need to assess, on a case to case basis, whether the Office of the Contracting Party of the holder of a given international registration was also a member of the Agreement and, if that were the case, the time limit to issue a provisional refusal would be reduced to only one year. The Secretariat referred to the statistics mentioned in paragraph 10 of the document and noted that more than 90 per cent of all the provisional refusals received by the International Bureau in 2017 were received within 12 months from the start date of the refusal period. In view of that, the Secretariat invited the Working Group to consider whether a review of the operations of Article 5(2)(b) of the Madrid Protocol should be undertaken to

* Please see Document MM/LD/WG/12/RT/INFORMATION ON PROVISIONAL REFUSALS.

harmonize the time limit for Offices to notify an *ex officio* provisional refusal to 15 months or one year or to decide on another time limit. The Secretariat noted that the manner in which the notification of the provisional refusal was transmitted to the International Bureau and later on to the holder, may shorten the time limit that the holder had to respond to the provisional refusal. The Secretariat remarked that at that time only 30 Offices transmitted information to the International Bureau in a machine-readable format, namely extended markup language or XML format. The Secretariat said that the Working Group may wish to address that situation to ensure a speedier transmission of provisional refusals to holders. The Secretariat also suggested that holders and their representatives provide an e-mail address to the International Bureau so notifications could be received electronically to ensure that they had as much time as possible to respond to provisional refusals. The Secretariat underlined that 88 per cent of the notifications of provisional refusals were transmitted electronically to holders. Therefore, the Secretariat said that the Working Group may consider making electronic communication the default option for communications from the International Bureau to applicants and holders. The Secretariat indicated that the document summarized the issues for consideration and suggested some possible ways forward.

144. The Chair stated that the six issues for discussion were: (i) the time limit for Contracting Parties to notify a provisional refusal, covered by paragraphs 5 to 13 of document; (ii) the time limit to respond to a provisional refusal and the calculation of that time limit, covered by paragraphs 14 to 17 of the same document; (iii) the different time limits and ways in which to calculate them, covered by paragraphs 18 and 19 of the document; (iv) the transmission of the notification to the International Bureau, covered by paragraphs 20 to 24 of the document; (v) the transmission of the notification to the holder, covered by paragraphs 25 to 30 of the document; and, (vi) further issues for consideration, covered by paragraphs 31 to 38. The Chair first opened the floor for general statements on the document.

145. The Delegation of the European Union, said that it was open to exploring measures to harmonize, as much as possible, the ways in which to calculate time limits for the benefit of the users of the system. The Delegation supported the proposal to harmonize the calculation of the start date. However, the Delegation shared its concerns about the proposal to reduce the time limit for all Offices to notify *ex officio* provisional refusals to one year, as that measure might create difficulties for some Contracting Parties to meet the deadline due to legal constraints and jeopardize their right to declare that protection could not be granted in their respective territories. The Delegation, supported the proposals contained in paragraphs 34 to 37. The Delegation, referring to the proposals set out in items (i) and (ii) of paragraph 38 of the document, said that the European Union supported that the Working Group explore the potential for setting a minimum time limit or, alternatively, even for harmonizing the time limit to respond to a provisional refusal. However, the Delegation stated that it was not in favor of harmonizing the time limit Offices had to notify an *ex officio* provisional refusal to one year.

146. The Delegation of Madagascar observed that notifications of provisional refusals affected holders of international registrations in all cases and they should not be further penalized by the difficulties in defending their rights and interests. The Delegation said that the Madrid System should be concerned with assisting the interests of holders of international registrations, while avoiding establishing an unfair treatment between national filings and international registrations.

147. The Delegation of Georgia acknowledged the difficulty that applicants faced because of the different methodologies used by Contracting Parties to calculate the starting dates of time limits to respond to refusals and supported the standardization of the said date. The Delegation said that, based on its legislation, the calculation of the start date of the time limit for the applicant to respond was counted from the publication date of the refusal in the *WIPO Gazette of International Marks* (“the Gazette”). The time limit to respond to the refusal was a matter for each Contracting Party’s national legislation and, therefore, the Delegation believed that it would be more efficient to set the calculation of the start date rather than the time limit to respond.

148. The Delegation of the United Kingdom supported the comments made by the Delegation of the European Union, which were in line with long standing positions articulated by the United Kingdom on harmonization in that area, in particular, those set out in its position paper reference MM/LD/WG/15/4, submitted in the fifteenth session of the Working Group, in 2017.

149. The Representative of MARQUES strongly supported the resolution of issues concerning the response to notifications of provisional refusal and agreed with the position taken by the Delegation of the United Kingdom in its position paper submitted in the fifteenth session, as referred to by the Delegation. The Representative stressed that it was very important, for the ease of use of the system and for the confidence in its operation, that users got prompt notification of issues that affected their international registrations and a clear indication of the time limit to respond. The Representative added that anything less would compromise the fairness and accessibility of the system. The Representative strongly encouraged the Working Group to make such changes that were necessary to ensure that, as much as possible, there was harmonization of time limits to respond and that, ideally, that harmonization should be established by the Regulations rather than by the individual Contracting Parties. The Representative said that there should be speedy processing of provisional refusals, both by the Contracting Party and the International Bureau, which should be facilitated by electronic means of communication between all parties. The Representative highlighted that, in particular, a clear statement of the date by which a response was required should be included in all correspondence from the International Bureau because, without the exact date of the deadline stated on the correspondence, the possibility for error remained. A clearer statement of the date of notification or of the method of calculating the response date would not resolve the issue. The Representative recalled that it was common practice to include a date to respond and it was an obvious way to increase confidence in the system and noted that, while harmonization of the notification time limits was ideal, to avoid either very short or non-extendible deadlines, having a clear indication of the required response date would solve many problems in handling deadlines by applicants and their representatives.

150. The Delegation of Norway agreed that the document suggested that handling provisional refusals could be quite challenging for holders and supported the idea of harmonizing time limits to improve the situation. The Delegation said it hoped that more use of electronic machine-readable means of communication would help solve the problem and indicated that the Norwegian Office continuously strived to improve its electronic communication with WIPO and other users and believed it important to have a precise indication of the response date in the provisional refusal issued by the Offices, as stressed by the Representative of MARQUES.

151. The Delegation of Italy said it strongly supported the statement made by the Delegation of the European Union and noted that its Office notified WIPO a large part, if not all, of its provisional refusals within the time limit of one year. The Delegation noted, however, that it preferred to maintain the current time limit, though it was open to discuss the time limit to respond to a provisional refusal. The time limit to respond to a provisional refusal issued by the Office in Italy was three months from the date of the notification to the holder. However, the Delegation was open to a solution.

152. The Delegation of the Republic of Korea said it understood that Contracting Parties had different interpretations of what was considered to be a reasonable time to respond, which was why Contracting Parties had established different time limits to reply to a provisional refusal. In that regard, the Delegation considered it necessary to set a minimum time limit to respond to a provisional refusal to provide institutional safeguards to applicants responding to the notice and said it hoped that the Secretariat could suggest a harmonized way to calculate the time limit. Finally, the Delegation suggested that the International Bureau encourage Member States to transmit documents in machine-readable format to expedite the processing time and help resolve infrastructure issues providing technical assistance as needed.

153. The Delegation of Belarus acknowledged the need of holders to have a transparent and more harmonized system when dealing with provisional refusals. The Delegation said it understood that, to achieve that goal, delegations had to study the document. The Delegation supported some of the proposals contained in the document, such as, for example, setting a minimum time to respond to a provisional refusal and e-mail correspondence as the default means of communication. However, the Delegation did not support harmonizing or rather reducing the time to respond to a provisional refusal to twelve months, in accordance with the Madrid Agreement. While the Office was meeting that limit, there had been cases where it had to use its right to notify outside of that time limit. The Delegation further noted that it could not indicate a concrete date to respond in a provisional refusal due to its national law. The Delegation explained that, although there had been consultations on whether to change the provisions in the national law to allow for the calculation of the time-limit to commence from the date of communication, there was no agreement on that position and there would not be one in the near future.

154. The Delegation of Israel said that its Office sends provisional refusals through electronic communication and was at that time developing its system to automatically do so on a daily basis to shorten the process time. The Delegation explained, while the formal time allowed to respond to provisional refusal in Israel was three months from the date on which the refusal was issued, in practice an additional three months were allowed before a final decision was made. The Delegation noted that an optimal measure would be to determine one universal time frame, agreed upon all Contracting Parties, using a consistent calculation method. The Delegation said it realized that such was unrealistic because it would entail changing the national law in the Contracting Parties and, for that reason, stated that it was imperative to set a minimum reasonable time limit to respond, taking into account the transmission time and all the actions required by the holder to respond to the provisional refusal. Referring to the proposed reduction of the time period to issue a provisional refusal to one year, the Delegation informed that the Office issued provisional refusals within six months from the date of the international registration notification, and that it expected to shorten that time. However, the Delegation stated that Israel's declaration to extend the refusal period to 18 months enabled the Office, in exceptional cases, to change the provisional refusal following a second examination in complicated cases. Therefore, the Delegation stressed a preference to maintain the 18 months period, but said that it would not oppose a reduction to one year if there was an agreement to do such by most of the members and added that such reduction would require an amendment to its national legislation. The Delegation stated that the time limit to reply and the way in which it was calculated should be made clear to the applicant and noted that such information was explicitly indicated in the notification of provisional refusal sent by the Office. The Delegation stated that the International Bureau should require an e-mail address as the default option for communication.

155. The Delegation of Colombia said that it did not agree with the proposed reduction of the refusal period from to 12 months and proposed that the Working Group continue with the 18 month time period because it provided greater flexibility for countries that were joining the system and made the Madrid System more attractive. The Delegation stated that, while it was open to discuss a time limit of 12 months, it wanted to keep the time limit of 18 months to be used in exceptional cases.

156. The Delegation of China informed that its Office was already using electronic means to send the notifications of provisional refusals and that in China the holder had 15 days from the date of reception of the provisional refusal to respond. The Delegation noted that Contracting Parties had different rules and, therefore, harmonization would be hard for Contracting Parties to implement because, for example, some Contracting Parties could think three months was too long and, since China had 15 days, which would be unfair to national users. Therefore, the Delegation suggested that the time limit and their calculation be determined by the designated Contracting Parties.

157. The Delegation of Japan said it understood that harmonizing operations at the Offices of Contracting Parties would benefit users. Notwithstanding, with regard to the time limit for Contracting Parties to notify a provisional refusal, it was one of the key principles of the Madrid Protocol that a Contracting Party may declare the time limit of one year to be replaced by 18 months, which was particularly beneficial for Contracting Parties that conducted substantive examination. The Delegation stated that eliminating the option of 18 months might prevent potential members from joining the Madrid Protocol. The Delegation expressed support for the review of the provision in Article 9*sexies*, which seemed to complicate matters for users of the Madrid System, including the Offices concerned and third parties. The Delegation indicated that the harmonization of the time limit for holders to respond to provisional refusals should be discussed very carefully, given that time limits are governed by national laws.

158. The Delegation of Hungary said that, in light of the findings of the survey, it considered it necessary to take measures to address the difficulties that others faced relating to provisional refusals. The Delegation indicated a preference for minimum time limit instead of a harmonized time limit to respond to provisional refusals and said that reaching a mutually acceptable solution was more challenging in view of the differences between Member States. The Delegation informed that the Hungarian trademark law provided for a fixed time limit of three months from the date of notification for submitting comments, with an opportunity to extend that period by the holder and added that its Office used XML format for everyday work and would prefer to use XML format in the future.

159. The Delegation of Denmark stated that it was not necessary to undertake a review of the operations of the Article 5(2)(b) of the Protocol and disagreed with the proposal to harmonize the time limit to 12 months for Offices to notify the International Bureau of an *ex officio* refusal. The Delegation recalled that Denmark had acceded to the Protocol only and had taken advantage of the possibility in Article 5(2)(b), to replace a time limit of 12 months with 18 months, and informed that, in most cases, its Office was able to complete all procedures regarding the examination of designations of Denmark well in advance of 12 months. However, it was not uncommon for procedures to be prolonged due to the specifics of each designation and, consequently, there was the need to notify the International Bureau of provisional refusals after the 12 months period. Furthermore, a change of the time limit to notify provisional refusals from 18 to 12 months would result in the need to change the national legislation as well as make changes to the Office's IT systems. The Delegation recalled that, according to Rule 18*ter* of the Common Regulations, all Offices had an obligation to send a Statement of Grant of Protection as soon as possible and informed that the Danish Office was complying with that requirement, ensuring that holders of international registrations, in most cases, receive notifications on the protection of their trademarks in Denmark well before the expiry of the 18 months and 12 months period. The Delegation said it did not support a review of the operations to harmonize the time limit for Offices to notify a provisional refusal. The Delegation recognized that the Madrid System operated with two time limits, 18 months and 12 months respectively and, therefore, it remained open to discussions on the harmonization of that time limit to 18 months. With regards to other topics in the document, the Delegation added that, if the Working Group decided to consider a minimum time limit for the holder to respond to a notification of provisional refusal, it would need to keep in mind that most of the Contracting Parties were party to the Singapore Treaty of the Law of Trademarks and that Article 14(2)(i) of that treaty provided the holder with the possibility to request an extension of the time limit.

Furthermore, Rule 9(1)(ii) of the Regulations of the Singapore Treaty stated that such requests could be filed within a time limit that could not be less than two months from the date of expiry of the time limit concerned. The Delegation recalled that such particular feature of the Singapore Treaty came about because, at the time the Diplomatic Conference in Singapore, there was no consensus on a minimum time limit to respond to provisional refusals. The Delegation informed that Denmark was party to the Singapore Treaty and had implemented Article 14(2)(i) in its national legislation, which meant that the Danish Office, after the time limit to respond to provisional refusal, had to wait for an additional two months before issuing a final refusal, unless the applicant requested an extension of the time limit. Consequently, the Delegation said that a minimum time limit ought not to go beyond four months because, due to the Singapore Treaty, such time limit would mean that the Danish Office would have to wait at least six months, following a provisional refusal, before it could issue a final refusal. The Delegation stated that agreeing on a minimum time limit was commendable and should be prioritized by the Working Group and encouraged Offices to clearly indicate time limit for the holder to respond to provisional refusal by indicating the exact date of the time limit.

160. The Chair noted that there was no agreement on the reduction of the time limit from 18 to 12 months.

161. The Delegation of Singapore noted that it had received feedback from users indicating that the different ways of calculating the time limits to respond to provisional refusals were confusing to them. The Delegation said that, while harmonizing the time limits might be challenging at that point in time, it supported the proposal of setting a minimum time limit for a holder to respond to a provisional refusal to help users.

162. The Delegation of Sweden expressed support for the statement made by the Delegation of the European Union but added that the time limit to respond to provisional refusal could be harmonized to three months to be calculated from the time when the provisional refusal was issued, or when it was sent to the International Bureau. The Delegation said it supported the view that communication between the International Bureau and the holder should be electronic.

163. The Delegation of Brazil praised the efforts of harmonization and transparency among members of the Madrid System and raised four points for discussion: (i) with regard to official provisional refusals, found in paragraph 38(iii) of the document, the Delegation agreed with other delegations that the proposed one-year period was not sufficient considering Brazil's current internal procedures concerning opposition; (ii) regarding the starting point for the calculation, that was in paragraph 17 of the document, it believed that it should be counted from the date the national Office sent the notification to WIPO; and, (iii) the Delegation agreed that the time to respond should be fewer than 60 days and informed that, according to the Brazilian legislation, the reply to a provisional refusal should be made in fewer than 60 days from the date of publication of the notification in its Gazette and, accordingly, it could not support the proposal made by the Delegation of Sweden. The Delegation added that, as regards to translation of the lists of goods and services found in paragraph 19(ii) of the document, it supported maintaining Rule 17(2)(v) of the Common Regulations that allowed Offices to list the goods and services referred to in the notification in cases where there were possible prior rights in the language used by that Office.

164. The Delegation of Australia said that a sensible place to start, when addressing the challenges holders faced, was a consistent way time limits to reply to provisional refusals were to be calculated, which would simplify things for holders. The Delegation stressed its support for further discussion on a minimum time limit to respond to provisional refusals.

165. The Delegation of the Czech Republic stated that the harmonization of the deadlines was complicated because it was apparent that each Office had its own practices and questioned whether it would be useful if the International Bureau could develop an information tool or a database so better guidance on the calculation of deadlines could be obtained. The Delegation

added that with such tool it would be easier to understand the several systems for calculating time limits and for responding because, for example, if a user designated 40 Contracting Parties, it would be quite difficult to find all that information in the Madrid Members Profiles database because, sometimes, the information was a bit confusing.

166. The Delegation of Canada supported the harmonization of time limits to respond to provisional refusals and informed that the Canadian Office provided a period of six months, from the date on which the provisional refusal was issued, to provide a response. Where the holder did not provide a response, there was an additional period of two months to remedy the situation. In all cases, the exact deadline or end date was provided. Requests for additional six months was also possible if the holder required more time to provide a complete response. The Delegation added that, in an effort to inform the holder as soon as possible of any grounds for refusal and in addition to sending the provisional refusal electronically to the International Bureau, a courtesy copy of the provisional refusal was sent to the holder, notwithstanding that they might not have a Canadian address. Given that harmonization of the time limit to respond to provisional refusals may not be possible for some Offices in the short term, the Canadian Delegation said it would support setting a minimum time limit, as a first step.

167. The Delegation of France supported the statement made by the Delegation of the European Union and indicated, while the French Office issued notifications of provisional refusals within a year, it still desired to keep the 18-month time frame. The Delegation expressed support for the possibility to have a minimum time frame for the response of holders which, for the French Office, was one month from date of receipt of the notification.

168. The Delegation of Cuba said that it did not have a problem with the proposed time frame for consideration because Cuba had a time frame of one year. However, the Delegation indicated that there would have a problem with the proposal concerning the calculation of the time limit to reply. The Delegation noted, as it was the case with France, Cuban law provide for a one-month time limit to reply, as from the date of the notification to the applicant. The Delegation stated that the said one-month time limit should not cause any problems, provided the communication with the applicant was done by electronic means, in coordination with the International Bureau. The Delegation recalled that the International Bureau published on Madrid Monitor the date on which it had notified the applicant and applicants had one month to reply from that date. However, the Delegation acknowledged that the said time limit to reply would be a problem for holders notified by post and said that, based on the analysis presented by the International Bureau on how postal services worked, a presumed date of notification could be established in these cases. The Delegation informed that some years before the Cuban Office had had serious problems with the above-mentioned time limit but that, after establishing electronic communication with the International Bureau, those problems had been almost eradicated, except for those holders who still received communications by post and for which determining the date on which the holder received the notification remained a problem.

169. The Delegation of New Zealand said it had received feedback from its users which indicated that the different time limits to respond and the different ways of calculating those time limits could be confusing and, therefore, it was open to further discussions on possible ways forward. The Delegation, agreeing with the Delegation of Australia, stated that a good place to start would be to establish a consistent way in which to calculate the start date of the time limits.

170. The Delegation of Latvia informed on the practice of its Office, given that it was governed by both of the Agreement and the Protocol, and said that it had a time limit of one year to issue a notification of provisional refusal of an international registration and that holders had three months to respond, starting from the date of transmission of the notification by the International Bureau to the holder.

171. The Representative of INTA acknowledged that there was not much appetite for a revision of Article 5(2)(b) of the Protocol but said that the data contained in paragraph 10 of the document, which showed that 92 per cent of the notifications of provisional refusal were in effect issued within 12 months, was extremely encouraging and hoped it corresponded to a trend that might hopefully continue. Regarding the time limit to respond to provisional refusals, the Representative highlighted that several interventions had indicated that an attempt to reach some harmonization in that respect would raise many problems. On the other hand, the Representative of INTA indicated that every effort should be made to try and agree on a minimum reasonable time limit and, if possible, also on a harmonized way to calculate that time limit. The Representative stated that Member States should continue to be encouraged by the International Bureau to enrich the Member Profiles database with as much information as possible, not only on the time limit to file a request for review but also on the time limit to appoint a representative for such purpose, on the time limit to file the arguments, which was also important, and on the various possibilities of an extension of those time limits. The Representative of INTA noted with interest the interventions made by the Delegations of Canada and China in that respect. In addition the Representative considered that the International Bureau should not only continue to encourage Offices to use electronic means of communication, but also assist them to facilitate the timely communication of the notifications of provisional refusal.

172. The Representative of JPAA supported the comments made by some delegations regarding harmonization of the calculation of the time limit to respond to the provisional refusals and setting minimum deadlines. The Representative indicated that holders often faced problems with time limits to respond to provisional refusals and the way they were calculated and underscored that said problems arose when those time limits were short, and where those time limits were calculated in different ways, as indicated in the document. Regarding methods to calculate the time limits, the Representative of JPAA highlighted that, in many cases, the holders did not know how to calculate time limits to respond to provisional refusals or were not certain about the exact start and end date of those time limits. Accordingly, the Representative said that it would be clear and helpful for holders if an exact end date of the time limits was indicated in each provisional refusal. Concerning the minimum time limits to respond, the Representative of JPAA noted that the holders were also facing difficulties when they had to respond to provisional refusals in a short period and, for this reason, even if it were too difficult to harmonize the time limit, setting a minimum time limit such as, for example, 60 days or three months would be advantageous for many Madrid users.

173. The Representative of CITMA said the document prepared by the International Bureau really helped to put things into real context and it was clear that trademark users had difficulty replying to provisional refusals coming from many different Contracting Parties with different criteria. The Representative supported the papers submitted by the Delegation of the United Kingdom and MARQUES and noted, from the interventions from the floor, that there was a real issue as many users did not know how to deal with those deadlines. The Representative indicated that CITMA fully supported the harmonization of time frames but was aware that it was extremely complicated given national legislation and that it would like to have clear deadlines in communications and not just harmonized deadlines. The Representative of CITMA strongly encouraged electronic communications.

174. The Representative of JIPA indicated that from a user's standpoint, JIPA would like to have a reasonable minimum time limit to respond to the provisional refusal in each of the designated Contracting Parties under the Madrid System, and hoped for the harmonization of reasonable minimum time limits and reasonable ways to calculate those time limits in the future, which would make the Madrid System more user-friendly.

175. The Delegation of JTA said that, in general, agreed that a harmonization of the time limit would benefit the Madrid System and its users. Even though it did not consider that there were any serious problems with meeting the 12-month time limit to issue provisional refusals, it had some concerns that setting the time limit to 12 months may make potential new members hesitant to join the Madrid Protocol. With regard to the time limit to respond to the provisional refusal and the calculation of that time limit, the Representative stated that it would be difficult to harmonize the time limit and the calculation of that time limit because the national law in each country was different. In that regard, since the International Bureau had results of a survey that was that conducted five years ago and had a list of the time limits and how to calculate them in each country, it called on the International Bureau to update that list and share it every year, if possible. The Representative added that, when the International Bureau send a notification of refusal to the holders, such notification could be accompanied by the English version of that updated list, which would help Madrid users understand the time limit and how to calculate it in each country more easily and would make the Madrid System more user-friendly. The Representative of JTA agreed with other delegations that a minimum time limit should be indicated in the legal framework of the Madrid System and proposed a minimum of two months from the date on which the International Bureau transmitted the notification to the holder by e-mail. In that regard, the Representative also agreed with the proposal to make electronic communication the default option for communication with the International Bureau.

176. The Representative of CCIPT indicated that time limits should be adjusted to take into account the different legislation requirements of different Contracting Parties and that, while a uniform time limit was not realistic, a minimum time limit was still possible. The Representative noted that the practices concerning the calculation of the time limit were quite different among Contracting Parties and said it understood that there were two practices, the first was from the date on which the notification was sent, and the second was from the date on which that notification was received, adding that either of those practices would be acceptable if there was a minimum time limit that could be calculated.

177. The Delegation of the United States of America said it recognized the value in the International Bureau's recommendation to establish a minimum time limit to avoid holders being disadvantaged by a lack of harmonization in time limits, particularly, where some Offices had extremely short response periods while others had extremely long periods. The Delegation added that short response periods were impractical, since they did not allow sufficient time for the holder to properly evaluate the problem or their response options or to obtain and consult with legal counsel to devise a response and prosecution strategy; whereas, long response periods often needlessly allowed applications to sit on the register, even when they might not ultimately be granted protection. The Delegation underscored that there was a question of whether either long or short response periods could be considered reasonable under the circumstances, which was the standard enumerated in Rule 17(2)(vii) and noted that neither the Common Regulations nor the Administrative Instructions informed what was reasonable under the circumstances meant, which left Contracting Parties to come up with their own differing interpretations. The Delegation was open to considering establishing a minimum time limit to respond and informed that there was a six-month response period in the United States of America, but that some stakeholders had expressed that six months was too long and allowed applications to remain on the register that the owners had no intention of using or prosecuting to registration. The Delegation said that, nonetheless, as a preliminary matter, it sought input from the Secretariat or the Working Group as to what types of Office communications qualified as a provisional refusal and, thus, subject to the minimum time period. The Delegation wondered whether a provisional refusal was a refusal based on substantive grounds or whether it did encompass a refusal based on a deficiency in formalities. As for the International Bureau's recommendation for harmonizing the calculation of the time limit to respond, the Delegation supported that issue and acknowledged the benefit of legal certainty to the users of having a uniform consistent method of calculating the deadlines for responding to provisional refusals. The Delegation suggested that, since all provisional refusals had to be notified to the International Bureau, who in turn forwarded them to holders, the time limit could be set to start

from the date the International Bureau received the provisional refusal from the Office, which was the USPTO's current practice, which referred to the date on which the provisional refusal was sent or notified to the International Bureau as the mailing date of the refusal. The Delegation recalled that, when the International Bureau forwarded the provisional refusal to the holder, that mailing date appeared in the cover letter accompanying the refusal, and noted that such date was also indicated in the USPTO's online database for checking the status of an application and for reviewing all relevant documents. The Delegation suggested that the Working Group consider whether and how other systems, such as, for example, the Hague, and PCT systems, had or were approaching the issue of establishing minimum time limits and harmonizing the calculation of those time limits as, perhaps, there were solutions there that were applicable to the Madrid System.

178. The Chair noted that there were no further general statements and opened the floor for comments on the rest of the document.

179. The Delegation of Germany agreed with the Representative of INTA in that it would be very difficult to have a certain time limit, but that a minimum time limit could be found as there seemed to be some consensus on that matter. The Delegation noted that many users' groups had asked to have a precise date, but said that such might be quite difficult because, as described in paragraphs 16(i), 16(ii) and 16(iii) of the document, with all the different start points for the calculation of the deadlines it was not possible to give an exact date. Germany calculated the date as indicated in paragraph 16(ii) and, like the United States of America, the start date was calculated from date the International Bureau transmitted the notification to the holder, which was clearly indicated in the communication from the International Bureau and explained that there was a precise description of the time limit and how it was to be calculated in the provisional refusal. The Delegation informed that the holder had a time limit of four months to respond to the provisional refusal and that, if the holder missed that deadline, could have an additional time limit of one month, subject to a fee. The Delegation stated that a minimum time limit, as mentioned by other delegations, of two or three months would be a good idea and suggested that the International Bureau create a form so users could easily find the time limit. The Delegation clarified that it was not suggesting that the International Bureau set the time limit but merely create a form, with a set format and specific headings to be used by all Contracting Parties, so users could at least know where to look.

180. The Delegation of Austria supported the statement made by the Delegation of the European Union concerning the calculation of the start date and added that it was in favor of a harmonization that resulted in a clear start date and, consequently, a clear end date. The Delegation said that it found the start date, as described in paragraph 16(iii) of the document, problematic since the date the holder received the notification from the International Bureau was not recorded in the International Register and, therefore, was not transparent.

181. The Delegation of Switzerland stated that it was in favor of everything that made things easier for the applicant and added that it would be in favor of a harmonization of the deadline, a harmonization of the calculation starting point and setting a minimum time limit. The Delegation suggested that it could be a good thing to start little by little, by setting on a minimum deadline, and said that it remained open to further proposals on the subject.

182. The Chair acknowledged that there was no agreement on the reduction in the time frame from 12 months to 18 months, and noted that, although there was some interest in the possibility of a harmonized time frame, it was apparent that, from comments made by some delegations, that might be difficult. The Chair recalled that there was some agreement around some of the proposals made in the document and suggested that the Working Group consider asking the International Bureau to prepare a document with some possible amendments to the Common Regulations concerning a minimum time limit to respond to provisional refusal and a harmonized way to calculate it. The Chair recalled that some delegations mentioned that it might be difficult to set a minimum time limit and, therefore, suggested that such a proposal

include delayed implementation provisions and some stricter requirements around an obligation to indicate, in a provisional refusal, the end date, if that was possible. The Chair added that, where the Office could not give a date, the Regulations could require a clear indication on how to calculate the end date in the provisional refusal to make it easier for users. The Chair also recalled that there was some agreement around mandatory e-mail requirements, particularly from the International Bureau to the holder, and said that this could be covered by an amendment to Rule 9. The Chair opened the floor for comments on the aforementioned proposals.

183. The Representative of INTA understood that the proposal concerning e-mail communication with the holders or representatives was to be the default position and that such would not exclude paper communication where electronic communication means were not available, and, if that were the case, the Representative of INTA would have no objection.

184. The Chair concluded the discussions.

185. The Working Group requested the International Bureau to prepare a document, for discussion at its next session, on possible amendments to the Regulations providing for:

- (i) a minimum time limit to respond to a provisional refusal;
- (ii) a harmonized way in which to calculate the above-mentioned time limit;
- (iii) the possibility to delay the implementation of those new provisions for Contracting Parties requiring time to change their legal framework, practices or infrastructure;
- (iv) a stricter requirement to clearly indicate, in the notification of provisional refusal, either the end-date of the above-mentioned time limit or, if that is not possible, the way in which it should be calculated; and
- (v) electronic communication as the default mode for transmitting communications by the International Bureau to applicants, holders and representatives.

AGENDA ITEM 8: POSSIBLE REDUCTION OF THE DEPENDENCY PERIOD

186. Discussions were based on document MM/LD/WG/17/6.

187. The Secretariat presented the document and recalled that the topic had been added to the Road Map in 2016 to be discussed in the medium-term. The Working Group had previously discussed dependency, either by itself or as part of discussions on the possible elimination of the basic mark requirement. In those discussions, delegations had expressed different views, from abolishing dependency, completely or freezing its operations, to preserving it fully, as it was or with some modifications, such as, for example, reducing the number of years in the dependency period or reducing the grounds invoking dependency. The document outlined the history of dependency in the Madrid System and the context in which the Working Group had previously discussed it. It also summarized the positions expressed by delegations and set out options for possible further discussions by the Working Group.

188. The Chair noted that the document was divided into three parts, namely, paragraphs 3 to 7, which provided an overview of dependency, paragraphs 8 to 19, concerning previous discussion on dependency by the Working Group, and paragraphs 20 to 33, on possible ways forward. The Chair first opened the floor for general comments on the document.

189. The Delegation of Norway recalled that the goal of the Working Group was to develop the Madrid System by improving it and making it more efficient and easier to access and stated that the total abolishment or freezing the dependency principle would be beneficial for the Madrid System and its users. The Delegation was also in favor of considering a reduction of the dependency period, from five to three years, or other possible changes mentioned in the document which could strike a fairer balance and increased legal certainty for users of the system. The Delegation mentioned that the Paris Convention set out the principle of independence of patents and trademark rights, in particular, Article 6(3) of the Paris Convention that stated that a mark duly registered in a country of the Union should be regarded as independent on marks registered in the other Members of the Union, including the country of origin. The Delegation recalled that under the Madrid System the Offices of the designated Contracting Parties were to determine the actual protection of the mark in an international registration. In light of those principles, the Delegation stated that trademark applications should not be dependent on the assessment in other Contracting Parties and said that, as central attack did not seem to be a widely used mechanism, dependency was not really needed and added that central attack could not be used as an argument to support the need for dependency. The Delegation said it looked forward to continuing discussions on that topic.

190. The Delegation of the European Union supported the endeavor to make steps towards the simplification of the Madrid System on that important and complex issue. Nonetheless, the Delegation reiterated its preference for abstaining from any fundamental and radical changes carried out at once or in the near or distant future, including the suspension of the operation of dependency. As regards to the possible way forward, the Delegation expressed that the route that may lead to a consensual solution could be oriented towards the reduction of the dependency period, as proposed in paragraphs 22 to 25 of the document, to, for example, three instead of five years or the reduction of the grounds, as discussed in paragraphs 26 and 27 of the document. The Delegation said that latter option was a new suggestion that could be further explored with caution and added that it was more in favor of focusing on the reduction of the dependency period to three years to try to reach a compromise. The Delegation stated that the European Union and its member states remained open to the opinions of other participants to the Working Group and looked forward to further discussions on this issue.

191. The Delegation of the Russian Federation spoke in favor of the possibility to suspend dependency and noted that the majority of the Russian users of the Madrid System that had responded to a survey sent out in 2014 had supported the proposed amendments concerning the suspension of the five-year dependency principle. The users also had indicated that the proposed amendments on the temporary suspension of that principle would help increase the number of international applications filed, in particular, by small and medium-sized businesses. The users commented that, in the existing legal field, the uncertainty on the fate of international registrations before a final decision on the basic application had been made, together with cost-effectiveness considerations, was largely a constraint for filing an international application. In the Delegation's view, the suspension or freeze of the principle of dependency of international registrations would have a positive psychological effect not only for current, but also for future users of the Madrid System. A suspension of dependency would provide a solution to holders that are not in a position to use the basic mark in the country of origin, because it contains words whose semantics are not understood by an average consumer in that country. For example, a basic mark containing Latin letters applied for or registered in a country of origin that uses Cyrillic. Given the aforementioned, the Delegation said that it wished to reiterate its support for the possible suspension of the principle of dependency, noting that the Assembly could take a decision on a freeze of paragraphs (2), (3) and (4) of Article 6 of the Protocol, subject to periodic analysis of the consequences of such a decision. The freeze, in the Delegation's opinion, could be introduced for five years during which a periodic analysis would be carried out. The decision could be overturned by the Assembly at any time, taking into account the rights of those holders who benefited from the temporary measures. In addition, the Delegation noted that a diplomatic conference would not be needed to adopt the suspension of dependency; a decision of the Assembly would be enough.

192. The Delegation of Belarus stated that, while it understood that dependency was an obstacle preventing users from using the Madrid System and creating problems for the existing users, and agreed on the need to discuss possible ways of improving the system, did not support the complete elimination of dependency, because that measure appeared too drastic, nor the freezing of the dependency principle because it would create legal uncertainty within the Madrid System and unequal rights for holders. The Delegation said it would support the reduction of the dependency in time and grounds on which the international registration must be dependent from the basic mark.

193. The Delegation of Algeria said that it was not in favor of the abolition, modification or suspension of the dependency principle and explained that there was a correlation between the principle of dependency and the possible lapse of a mark in the Algerian legislation, which provided that a cancellation action could be undertaken against the basic mark once the mark had been registered, and for a period of five years from that date, unless the mark was requested in bad faith. The Delegation stated that dependency remained necessary to preserve the interests of enterprises that might start a procedure leading to cancellation of an international registration within the five years dependency period and added that central attack remained exceptional. The Delegation invited the Secretariat to explore other options, such as, for example, to limit the inconveniences of the automatic effect of dependency without questioning the dependency principle, including the five-year period.

194. The Delegation of Israel acknowledged the disadvantages of dependency when seeking protection through the Madrid System and stated that in Israel Hebrew characters were used while abroad Latin characters were generally used, leaving the basic mark vulnerable to cancellation due to non-use. The Delegation recalled that the goal was to balance the needs of the applicant with the interest of third parties and said that, to increase the use of the Madrid System and to make it more flexible with a higher degree of legal certainty, Israel was in favor of reducing or freezing the dependency period. Since the reduction of the dependency period required a diplomatic conference, which made that process complicated and difficult to facilitate, the Delegation believed that the fitting solution was to freeze the dependency period as that was easier to achieve, its impact would be measurable and was reversible. However, the Delegation said that it would require amendments to the national law in Israel.

195. The Delegation of Hungary said that it held a deep aversion towards abolishing dependency and that it was of the opinion that eliminating dependency could be a first step towards eliminating the basic mark requirement which was a fundamental principle of the Madrid System. The Delegation fully supported the statement made by the Delegation of the European Union regarding the abstention from making any fundamental and radical changes. The Delegation stated that eliminating the automatic effect of dependency or the suspension of the operational effect of dependency would lead to the elimination of dependency in the long term and that it supported neither of those suggestions. The Delegation said that it was of the view that the best way forward was to preserve dependency as it was but it was open to further explore the option to reduce the dependency period.

196. The Delegation of Georgia supported maintaining the existing five-year dependency period and said that it was a well-balanced legal tool for the right holders and the institutions, which had been functioning efficiently so far. The Delegation indicated that the introduction of the possible transformation of the international registration and the difficulties faced by applicants regarding non-use procedures had strengthened its position but did not exclude the possibility of discussing the reduction of the dependency period from five to three years and the possibility of the introduction of non-use cancellation requests at WIPO.

197. The Delegation of Finland supported the statement made by the Delegation of the European Union and, referring to paragraphs 26 and 27 of the document, indicated that such proposal could entail problems should the central attack rule only work for a third party, as it did not take account the situation when relative grounds were examined *ex officio*. The Delegation

stated that third parties could face uneven situations where relative grounds were examined. The Delegation explained that, for example, where the Finnish Office had already denied a registration of a mark due to prior rights, there would be no need for a third party to react and, therefore, if the Delegation had understood the proposal correctly, central attack would not be possible. In contrast, in Contracting Parties where there was no *ex officio* examination on relative grounds, a third party could file an opposition and use central attack. The Delegation suggested that the proposal should not be limited to actions taken by a third party.

198. The Delegation of China, on the issue of whether to reduce the dependency period, explained that, according to its practice, there was no advantage of dependency. On the contrary, the Delegation stated that dependency had limited the Madrid System and introduced uncertainty and that, although there was a procedure for transformation, the cost for the holders was high. Therefore, the Delegation suggested freezing the implementation of dependency and regularly reviewing the impact of that freezing. The Delegation also suggested asking the Assembly to make a decision.

199. The Delegation of the Republic of Korea recalled that it had continuously suggested abolishing dependency and said that it was glad to discuss the likelihood of abolishing dependency or reducing the dependency period. The Delegation stated that dependency should be abolished for a number of reasons and highlighted that the dependency period and the fear of a central attack added significant barriers to the use of the Madrid System among Korean users. The Delegation informed that Korean users strongly believed that dependency was a disadvantage and should be abolished or reduced and that, without dependency, users in the Republic of Korea would be more inclined to use the Madrid System. The Delegation recalled that statistics showed that the Republic of Korea was the fifteenth major filer of applications for international registration but that, compared to the number of PCT and Hague applications from the Republic of Korea, the number of Madrid applications was below expectations. The Delegation underscored that there were no enterprises from the Republic of Korea among the top 10 filers. The Delegation indicated that the fate of the international registration varied accordingly to the result of the examination of the basic mark and recalled that dependency had been a weak point in the Madrid System due to its inconsistency with Article 6(3) of the Paris Convention. Moreover, it created irrationality in the system because central attack would cease the effects of marks in all designated Contracting Parties that had different substantive criteria for registration of marks. The Delegation stated that, to improve legal stability of international registration and to encourage new accession to the Madrid System, dependency should be abolished.

200. The Delegation of Australia said it was pleased to discuss dependency again in the Working Group, as changes to dependency were a big step in the modernization of the Madrid System, reiterated its support for the freezing of the operation of dependency and encouraged all Member States to consider its potential positive effects as a user-friendly simplification of the Madrid System. The Delegation further indicated that the accelerated geographic expansion of the Madrid System in recent years and increasing globalization of markets should create better flexibility for businesses in targeting markets with respect to particular goods and services. However, many of the export markets of choice for expanding businesses operated in languages that were not in Latin characters. Users sought to protect their brands in those territories in specific scripts to do business and to protect those rights in those markets. Dependency on a basic mark in a home country meant that users must file a mark in the country of origin in the foreign script of the market concerned. That mark was unlikely to be used in the home country because it would not communicate the desired message to national consumers; therefore, it was vulnerable to non-use actions. It was also a duplicative and expensive exercise for trademark owners. A business should not have to maintain two trademarks in the country of origin, one in the language desired for the home country, and the other in a language intended for an export market. The Delegation stated that such was an issue for all members and that, while Australia would prefer dependency to be frozen, the Delegation saw great value in continuing to discuss ways that the principle of dependency could evolve to support the

needs of users of the Madrid System. The Delegation supported a reduction of the dependency period from five years to three years and for holding discussions on reducing the grounds. The Delegation said it remained concerned about the significant costs involved in monitoring and reporting on the basic mark for five years, particularly, where there was little evidence to suggest that the activity served the purpose for the bulk of the international registrations. In addition to the monitoring and reporting for the Office of origin, there was a burden on the International Bureau, which had to notify all designated Contracting Parties, and a burden on the designated Contracting parties in respect of the actions to affect limitations or ceasing of effect. The Delegation added that it looked forward to further discussion on that matter.

201. The Delegation of Germany said it fully supported the statement made by the Delegation of the European Union and stressed that it could not support the freezing of dependency. The Delegation recalled that dependency had been discussed in the twelfth session of the Working Group, in October 2014, and that, while there was no consensus on the freezing of the dependency period, the same arguments were being put forward again in the current session from the same delegations. The Delegation recalled that freezing the dependency period was not included in the Road Map, as amended in 2016, which only included the topic of the reduction of the dependency period. The Delegation expressed its disappointment at the International Bureau for raising the topic of freezing the dependency in the document and said that, while it was open to discuss the reduction of the dependency period from five to three years, it did not want to discuss further the options already discussed in 2014.

202. The Delegation of Colombia stated that it would not be efficient to eliminate the dependency period since it was linked to a national jurisdiction and to a national right and added that, if there was no dependency period there would be no reason for the existence of a basic mark. However, the Delegation supported the reduction of the dependency period to three years to facilitate international registration and trade.

203. The Delegation of Sweden referred to the statement made by the Delegation of Finland and wished to share some facts regarding dependency in Sweden. The Delegation informed that the Office received about 120 oppositions and 10 to 15 administrative cancellations per year and that it examined on relative grounds. From summer 2016 to summer 2019, the Office had, on average, 170 applications for international registration filed through its Office. In approximately 5.5 per cent of those applications, the Office notified a ceasing of effect of the basic mark. The Delegation regretted that the notification did not reveal whether the ceasing of effect was a consequence of an *ex officio* examination on relative grounds, an opposition or an administrative cancellation and that the Office had no information under what grounds the basic mark had been rejected or revoked.

204. The Delegation of Japan believed that, since dependency was a fundamental principle of the Madrid System, it should be discussed in a careful manner and supported alleviating the principle of dependency to give more flexibility for language diversity and to reduce legal uncertainty.

205. The Delegation of New Zealand recalled that it had previously supported the introduction of a freeze of the operations of dependency and that it continued to support it. The findings of the 2015 survey discussed at the thirteenth session showed that a majority of users did not view dependency as a strength of the Madrid System and that 62 per cent of users were in favor of abolishing, suspending or restricting dependency. The Delegation welcomed further discussions on the options proposed.

206. The Delegation of Austria supported the statement made by the Delegation of the European Union and said it shared the concerns expressed by the Delegations of Belarus, Germany and Hungary. The Delegation explained that, according to its experience, central attack was used in Austria and it considered the dependency principal to be of value. The Delegation emphasized that dependency was a fair compromise between the interests of

the holder of the international registration and third parties, as both benefitted from a centralized procedure. It provided the holder with an easy access to a trademark and, at the same time, it provided third parties with an effective and a cheap defense mechanism. Consequently, the Delegation stated it supported neither the abolition of the dependency principle nor the suspension of the operations of dependency and that, in particular, it considered that the suspension of the operations of dependency would create legal uncertainty. However, the Delegation expressed its preference for the reduction of the dependency period to three years and remained open to further discussions.

207. The Delegation of Cuba said it shared the views of the Delegation of Germany as regard to discussing the principle of dependency again in the Working Group. The Delegation was pleased to hear the interventions made by the Delegation of the European Union and by a number of delegations of its member states regarding the concerns about central attack. The Delegation also referred to the comments regarding dependency and central attack preventing the accession of new Contracting Parties and recalled that dependency was one of the pillars of the Madrid System, which was more than 100 years old. During those years, the number of countries joining the system and the number of applications for international registration had increased. The Delegation also recalled that dependency was a fair compromise between the rights of the holder and third parties which had not prevented the progress of the Madrid System. The Delegation reinforced the importance of discussing the modernization of the Madrid System while maintaining the features valuable for its users, such as, for instance, central attack, which allowed essential savings for Cuban users in defending their rights as they had limited resources to keep themselves in the market. Therefore, the Delegation said that it did not agree with abolishing or freezing the dependency principle. However, the Delegation stated that it was open to study a possible reduction of the dependency period but keeping in mind the interest of small and medium companies from less developed countries.

208. The Delegation of Spain supported the statement made by the Delegation of the European Union and shared the concerns expressed by the Delegations of Algeria, Austria, Colombia, Cuba, Germany and Hungary. The Delegation said that while some users may disagree on the simplicity of dependency or on its advantages or disadvantages, it was an essential feature of the Madrid System and one of its fundamental principles. The Delegation highlighted that abolishing, freezing or reducing the dependency period would imply a modification of the essential features and basic principles of the Madrid System. Referring to the intervention made by the Delegation of Colombia, the Delegation stated that the main concern of eliminating dependency was that the existence of a basic mark and the work undertaken by the Office of origin would be questioned. Therefore, the Delegation said that one should think about the consequences that a change in the dependency principle beyond the dependency itself might have in the Madrid System. Finally, the Delegation reiterated the statement made by Delegation of the European Union against introducing any radical change to the Madrid System in the short or medium term.

209. The Delegation of Switzerland said it agreed with the statement made by the Delegation of Spain and added that dependency was one of the pillars of the Madrid System directly linked to the existence of the basic mark. The Delegation stated that the proposal to freeze one of the fundamental pillars of the Madrid System was not acceptable.

210. The Delegation of Italy supported the statement made by the Delegation of the European Union and further indicated that, while it could accept a reduction of the dependency period, it was deeply against the suspension because of its possible legal uncertainty. The Delegation stated that it preferred to maintain the current dependency period and that any change would be too radical.

211. The Representative of INTA recalled, as indicated by the Secretariat in the document, that the question of dependency had been before the Working Group for some 11 years, in various forms. In terms of the previous discussions on the pros and cons of the proposals concerning the removal of the dependency, the Representative of INTA recalled that the views of users were just as split as the views of the members of the Madrid Union. The Representative indicated that it could not support the temporary suspension of dependency by the Assembly of the Madrid Union, which would not offer the required legal certainty to holders of international registrations as underlined by a number of delegations. The Representative explained that, in March 2017, after a thorough review of the dependency system by INTA, which included a survey of a sample of INTA members, the Board of Directors of INTA adopted a resolution supporting a reduction of the dependency period from five to three years. That resolution and the reasoning behind it, was available on paper outside the room, on the INTA website and on the Working Group's website. The Representative said that a reduction of the dependency period to three years would offer greater certainty in the status of international registrations, which could increase the utilization of the system by trademark owners, and a greater consistency and harmonization among jurisdictions with different non-use cancellation timeframes. In that regard, the Representative noted that the inability to initiate a central attack against an international registration between the third and fifth year after the date of the international registration, would not appear to affect the current central attack facility significantly. The Representative explained that, given the existing legislations around the world, third parties could oppose new applications or registrations, in both pre and post opposition systems, well within a three-year period in the vast majority of cases. In jurisdictions where the non-use period was of three years, the reduction of the dependency period to three years would mitigate the risk of non-use cancellation actions in situations where the basic mark was not intended to be used in the Contracting Party of origin, such as, for example, for export marks in Latin script, originating from Contracting Parties using non-Latin script and *vice versa*. The Representative recalled that many jurisdictions were at that moment instituting simplified non-use revocation proceedings, which would make it easier and more efficient to cancel registrations based on non-use and indicated that this would help address the issue of absent central attack. On balance therefore, the Representative stated that the benefits of reducing the dependency period seem to outweigh significantly the inability to initiate the central attack for a very small subset of international registrations.

212. The Representative of MARQUES reminded that it was the European Brand Owners Association in Europe, acknowledged that discussions on dependency had been going on for some time and stated that such was a reflection of the fact that central attack and the basic mark really posed difficulties for brand owners. The Representative assured the Working Group that it had carefully reviewed its position, which represented both large and small brand owners, including third parties and that it had carefully discussed the pros and cons. The Representative highlighted that MARQUES' paper listed the options in order of preference, which were, firstly abolishing the basic mark and the dependency period, secondly, freezing the dependency and then, in the event that none of that happened, a reduction of the dependency period as mentioned by the Representative of INTA. The Representative of MARQUES emphasized that Contracting Parties with a non-use cancellation period shorter than five years posed a real problem.

213. The Representative of JIPA explained that many Japanese users refrained from using the Madrid System because of the risk of central attack and indicated that in Japan the threat of cancellation due to non-use of the basic mark materialized three years from the date of registration. If the dependency period were reduced to less than three years, the risk of central attack would be partially reduced. Therefore, abolishing, suspending dependency or reducing the dependency period to less than three years would encourage more Japanese users to use the Madrid System.

214. The Representative of CCIPT supported freezing dependency, as that would encourage more people to use the Madrid System. The Representative said that this option would allow the Working Group to assess this measure by providing for a period of observation before the final abolition of the principle.

215. The Chair concluded the Working Group discussion on Agenda item 8, and noted that there was no consensus in relation to freezing the dependency principle. However, the Chair highlighted that there was some agreement on further studying and discussing three points, namely, the reduction in the dependency period from five to three years, the reduction in the grounds, and the elimination of the automatic effect of the dependency. The Chair opened the floor for comments or, preferably, on any objections to the proposed way forward.

216. The Delegation of Germany said that it would be very useful to discuss the reduction of the dependency period but that it did not recall any support for the elimination of the automatic effect of dependency.

217. The Delegation of Denmark asked the Chair to repeat the options.

218. The Chair reiterated that the options were, firstly, the reduction of the dependency period, as indicated in paragraphs 22 to 25 of the document, then the reduction of the grounds, as mentioned in paragraphs 26 and 27 of the document, and, lastly, the elimination of the automatic effect of dependency, as mentioned in paragraphs 28 and 29 of the document.

219. The Secretariat, in response to the Delegation of Germany, clarified that the order in which the Chair listed the points corresponded to the degree of support in the room. The Secretariat said that there was no real objection to the last point, and reiterated that this option would be just part of a study which could be clearly ruled out by delegations at the next session.

220. The Working Group requested the International Bureau to prepare a document, for discussion at its next session, further exploring the possible reduction of the dependency period, from five to three years, and of the grounds for the ceasing of effect of the basic mark resulting in the cancellation of the international registration, as well as the possible elimination of the automatic effect of dependency.

AGENDA ITEMS 9 AND 12: POSSIBLE OPTIONS FOR THE INTRODUCTION OF NEW LANGUAGES INTO THE MADRID SYSTEM AND PROPOSAL BY THE DELEGATIONS OF ALGERIA, BAHRAIN, EGYPT, MOROCCO, OMAN, SUDAN, THE SYRIAN ARAB REPUBLIC AND TUNISIA

221. Agenda items 9 and 12 were discussed together.

222. Discussions on Agenda items 9 and 12 were based on documents MM/LD/WG/17/7 Rev., and MM/LD/WG/17/10.

223. The Chair invited the Secretariat to introduce document MM/LD/WG/17/7 Rev.

224. The Secretariat recalled that, at the previous session of the Working Group, the Delegations of China and of the Russian Federation presented proposals for the introduction of Chinese and Russian as working languages of the Madrid System. The Working Group requested the International Bureau to prepare an in-depth study analyzing the implications of introducing new languages and to identify possible implementation models for that purpose. The document introduced by the Secretariat contained an in depth analysis on the implications for the Madrid System of the introduction of Chinese and Russian, as the proposal for the Arabic language had not been received at the time of publication of MM/LD/WG/17/7 Rev. The document proposed five possible options for the introduction of new languages, which were, by order of complexity, filing language, processing language, transmission language,

communication language and working language, the criteria for such introduction and their advantages and disadvantages, without effecting the current trilingual regime. The document also included estimated translation and operational costs and the potential implications for the information and communication technology systems of the International Bureau. The document also envisaged the possibility of undertaking a complete review of the linguistic regime to accommodate introduction of further languages.

225. The Chair invited the Delegation of Bahrain to introduce its proposal in document MM/LD/WG/17/10 of Agenda item 12.

226. The Delegation of Bahrain supported the proposal made by the Delegations of China and the Russian Federation in the previous session of the Working Group. The Delegation stated that Bahrain in coordination with Algeria, Egypt, Morocco, Oman, Tunisia, Sudan and the Syrian Arab Republic proposed to adopt Arabic as a working language of the Madrid System for the International Registration of Marks. Bahrain informed that Arabic was one of the six official languages of the UN. There were more than 380 million Arabic speakers in the world, of which 246 million belonged to Contracting Parties of the Madrid System. Arabic was one of the top five most spoken languages in the world in terms of the number of speakers. The use of the Madrid System among Arabic Contracting Parties had increased over the past few years but it was still far from its full potential. The Delegation noted that the language barrier was one of the top problems preventing wider use of the Madrid System in the Arabic Contracting Parties and it was also a challenge for those Contracting Parties, especially for those considering accession. Consequently, the Delegation said that the adoption of Arabic as an official language of the Madrid System would further incentivize accessions and contribute to the growth in use of the Madrid System among Arabic Contracting Parties. In view of the above, the Delegation requested the Working Group to consider and support the proposal.

227. The Chair opened the floor for comments on both documents.

228. The Delegation of Tunisia supported the proposal made by the Delegation of Bahrain and welcomed further discussions. The Delegation also supported the proposals made by the Delegations of China and the Russian Federation. The Delegation underscored the importance of introducing new languages to the Madrid System, which would facilitate the registration of marks and eliminate the barriers and obstacles faced by some Contracting Parties. The Delegation requested more information from the Secretariat about the options proposed in the document.

229. The Delegation of Tajikistan, speaking on behalf of the Regional Group for Caucasian, Central Asian and Eastern European countries, supported the proposal made by the Delegation of the Russian Federation to introduce Russian as a working language of the Madrid System at the request of applicants and institutions of State members of the regional group. The Delegation referred to the interest expressed by the Offices of Armenia, Azerbaijan, Belarus, Kazakhstan, Kyrgyzstan, Tajikistan, Turkmenistan and Uzbekistan and to statistical information provided by the above-mentioned Offices confirming the significant growth in the number of applications for international registration between 2015 and 2017, where the average growth was 22 per cent, and the number of designations received. That positive tendency showed that introducing Russian as a working language of the Madrid System could facilitate a significant increase in the number of international applications from those Contracting Parties. It could also increase the efficiency and reduce the timeframe for consideration of applications by national Offices, given that office procedures were conducted in Russian in a number of countries of the regional group, where Russian was widely spoken. The Delegation informed that, on average, 92 per cent of the experts working in the respective national Offices were proficient in Russian and that the Russian language was in high demand and already, in the short term, justified the operational costs of its integration. The Delegation indicated that the process could be streamlined with support from the Offices of interested States and that, in particular, the Contracting Parties of the region expressed their readiness to render all possible

assistance in adapting IT tools for the use of non-Latin scripts and provide candidates of Russian speaking experts to work at WIPO. Given the variety of legislations and operational difficulties in WIPO's cooperation with national Offices, introduction of the Russian language, as one of the most required within the Madrid System, would significantly improve the quality of registration services and help reduce the number of technical and translation errors.

The Delegation stressed the importance of continuing work on a thorough study of the current language regime of the Madrid System in order to consider the possibility of its expansion, based on the needs of applicants. The Delegation supported the conclusion about the need to build a balanced and effective translation regime and proposed to carry out further studies on the volume of translations required by applicants and to consider possible ways of developing the linguistic diversity of the Madrid System. The Delegation also supported the views and additional arguments of the Delegation of China and of the Delegations of Arabic-speaking Contracting Parties regarding the expansion of the list of languages used within the Madrid System, and the approaches of those Delegations to the prospects of strengthening the system and making it accessible to users in different regions of the world.

230. The Delegation of China stated that the Madrid System was a user-friendly system that had to be further developed, recalled that the introduction of new languages had been discussed as early as 2009 and said that such discussion could not be avoided.

The Delegation stated that the introduction of new languages would benefit the system by making it more diverse and would increase the number of applications. There would be new benefits following the introduction of new languages, and revenue would increase if the number of new applications increased. The Delegation noted that there had been outstanding use of the system in China in the previous few years, which was a well-known fact, and said it hoped that discussions on the introduction of Chinese, as well as other new languages, would make some positive progress.

231. The Delegation of Canada explained that Canada was a multicultural and bilingual country with both French and English as official languages since 1979. The Delegation supported the introduction of additional languages to the Madrid System if that would make the system more accessible to users. The Delegation also reiterated its support to implement multilingualism in the UN system, particularly from the viewpoint of cost effectiveness. The Delegation stated that Canada was convinced that the Working Group and the International Bureau would ensure a smooth implementation of multilingualism, while improving or maintaining the processing delays. The Delegation noted that discussions towards a linguistic harmonization in WIPO would be appropriate and said that it was in favor of undertaking a complete review of the language regime in the Madrid System.

232. The Delegation of Algeria welcomed all efforts aimed at transforming the Madrid System into a multilingual system open to speakers of other languages and regions around the world in the coming years. The Delegation supported the previous interventions for adopting Arabic as a working language of the Madrid System and referred to the proposals put forward by the Delegations of China and the Russian Federation. The Delegation asked the Secretariat to provide further clarification on the possible solutions that could be provided for automatic translation and on further cost efficiencies in adopting new languages in the Madrid System.

233. The Delegation of Egypt fully supported the statement made by the Delegation of Bahrain regarding the addition of the Arabic language in the Madrid System. The Delegation recalled that Arabic was one of the official languages of the UN and had millions of speakers all over the world. The Delegation stated that the addition of Arabic would undoubtedly contribute to increase the number of applications from Arabic-speaking Contracting Parties and encourage the accession of further Arab countries to the Madrid System. The Delegation also supported the proposals made by the Delegations of China and of the Russian Federation regarding the other languages to be introduced to the Madrid System.

234. The Delegation of the Russian Federation said that it fully supported the intervention by the Delegation of Tajikistan, made on behalf of the Regional Group for Caucasian, Central Asian and Eastern European countries. The Delegation considered the document was a basis for continuing to work on the issue of including new languages and, in particular, on strengthening the capabilities of Russian-speaking users of WIPO global services. The Delegation informed that, according to various assessments, the number of Russian speakers in the world was around 300 million. Russian was the second most widely used language on the Internet; more than 18 million people worldwide studied the Russian language, and that number increased each year. There was a regular growth in the number of foreign students studying in Russia, as well as students studying the Russian language in the countries where they lived. Promoting Russian as a working language of international registration systems was supported by regional associations in which the Russian Federation was a member. The Delegation noted that the Russian language was a working language of the Eurasian Economic Union and that it was used within the framework of the regional system for the legal protection of intellectual property created in that Union. In particular, it was planned to introduce paperwork management in Russian for procedures provided for under the Agreement on Trademarks, Service Marks and Appellations of Origin. The Delegation recalled that the professional community supported the idea of introducing Russian as a working language and that the largest associations of patent attorneys, which considered that such introduction would be highly sought by applicants and affirmed that it would lead to an increase in the number of users of the system from Russia and other Contracting Parties. The Delegation stated that it was possible to take into account the proposed criteria for new languages, including the filing activity for national and international applications and the number of designations in international applications. In that context, the Delegation emphasized that, in the case of the Russian language, it was not only about the Russian Federation, but also about a number of other States active in filing applications. The Delegation thanked the Secretariat for including the provision on the UN official languages and information on the implementation by WIPO of the language policy of 2010, which was an important milestone in the expansion of the language coverage and in strengthening the position of WIPO as a specialized agency of the UN adhering to the principles of multilingualism and parity of the official languages of the Organization. The Delegation assured of its readiness to provide all possible assistance in training experts, populating translation databases and adapting ICT systems, including the work needed to include non-Latin fonts, for the effective operation of the system. The Delegation recalled WIPO's online tool – Madrid Goods and Services Manager (MGS), currently had an interface in Russian. As of May 2017, data representation in Russian was 76 per cent. According to WIPO's data, users from the Russian Federation headed the list of MGS users. The Nice Classification was being translated into Russian. The Delegation stated that with that level of representation of terms in the Russian language populating the terminology database for translation purposes would require minimum resources. In addition, the Delegation emphasized that Russian applicants used mainly electronic means for filing their applications and that for national procedures that number exceeded 70 per cent. Considering that, when applying electronically, an applicant was advised to choose terms from the International Classification of Goods and Services, it would be possible to predict a decrease in financial and time resources required for translation and quality control. The Delegation believed that WIPO's automated translation tools would provide an opportunity for increasing productivity and reducing the time spent on translating texts. The Delegation said that it would prefer an indirect translation practice, with English as the relay language. The Delegation supported the conclusions of the study which stated that the development of the Madrid System by adding new languages was inevitable due to the geographical expansion of the system but that it was also desirable from the point of view of ensuring the system's accessibility for users. The Delegation said that it shared the position that the translation regime should be determined in a way as to ensure the sustainability of the system and to avoid a financial and administrative burden for the Union. However, the Delegation stressed that, from its point of view, the data set forth in the study revealed the lack of balance in the use of existing working languages. It believed that the Working Group could continue to improve the language regime in terms of

identifying the types of translation required by applicants and users of the system, optimize translation costs, including by means of use of the automated translation tools, and expand the number of working languages of the system. The Delegation stated that the task of strengthening the language regime of the Madrid System was of a complex nature.

The Delegation said that it would be interesting to assess the number of applications, should Russian, Chinese and Arabic become working languages of the system and, in this regard, supported the considerations and additional arguments presented by the Delegations of China, Algeria, Bahrain, Egypt and Tunisia with respect to strengthening the language regime of the Madrid System and increasing its accessibility for users in different regions of the world

235. The Delegation of the European Union stated that, given the fundamental importance of the language regime, it remained challenging to take a definite position at that stage. The Delegation reiterated its concern that the addition of new languages could go against the key objective of that Working Group, which was simplifying and improving the efficiency of the Madrid System. The Delegation indicated that, in the light of the document, it was still not possible to assess the real financial and administrative burdens implied by the introduction of new languages and added that it was not certain that the introduction of a new translation regime would appropriately address the said complexities. The Delegation stated that, nevertheless, the European Union and its member states remained open to further discussions.

236. The Delegation of Oman supported the proposals made by the Delegations of Bahrain, China and the Russian Federation, and thanked the Delegation of Bahrain for coordinating the group of Arab countries regarding the addition of the Arabic language as an official language of the Madrid System for the International Registration of Marks. The Delegation pointed out that the addition of the Arabic language should increase the use of the Madrid System.

237. The Delegation of China added, for clarification, that it supported the introduction of Chinese, Arabic and Russian languages into the Madrid System and that it hoped that discussions on that objective would achieve positive results.

238. The Delegation of Sudan supported the proposal put forward by the Delegation of Bahrain and reaffirmed the positive impact of multilingualism on the Madrid System, in particular, to facilitate worldwide access to intellectual property and to increase its use and encourage new accessions. The Delegation indicated that the introduction of new languages would help improve and develop the Madrid System and benefit its users and recalled that the language barrier was one of the reasons for not using the system. The Delegation referred to the provisions of Article 6(2)(vii) of the Convention Establishing the World Intellectual Property Organization, where the working languages of the Secretariat were set out taking into consideration the languages of the UN system. The Delegation requested more information regarding the necessary steps required to add Arabic to the Madrid System.

239. The Delegation of Morocco stressed that Morocco had systematically supported multilingualism throughout various WIPO activities, noted the benefits of introducing new languages put forward by other delegations and supported the proposals made by the Delegations of Bahrain, China and the Russian Federation. The Delegation stated that new languages would improve the functioning of the Madrid System and encourage the accession of more Contracting Parties.

240. The Delegation of Brazil expressed that Brazil was favorable to the principle of multilingualism and believed it was an important subject for discussion which merited a holistic approach that would consider current languages of the Madrid System, as well as the possibility to contemplate other languages in the future. The Delegation welcomed more information on the sustainability and inclusiveness of the Madrid System, including cost implications in the long run and reminded the possibilities that artificial intelligence translation tools could offer.

241. The Delegation of Belarus said it fully supported the interventions made by the Delegations of the members of the Regional Group for Caucasian, Central Asian and Eastern European countries, the Russian Federation, China and the Arab countries. The Delegation stated that the proposals for each of the three languages should not be considered separately but rather as a single proposal and stated that the end goal should be to include Arabic, Chinese and Russian as fully fledged working languages of the Madrid System. The Delegation said it understood that it would require a great deal of preparatory work and that preparations for that work would need to be done in stages. The Delegation acknowledged the technical issues and noted that it seemed that direct translation might not be used and that it might be that translation through the English language could speed up the process of the inclusion of new languages in the Madrid System.

242. The Delegation of Colombia recognized the positive effects of multilingualism in the Madrid System. However, the Delegation expressed concerns regarding the translation strategy that was going to be used because sometimes, in the translation process, the sense of what was sought to express in the original language was lost, which meant that an additional burden would be placed on the Office to understand the information provided by the International Bureau. Therefore, the Office noted, before including a new language the International Bureau needed to have the required infrastructure to ensure adequate translation.

243. The Delegation of Madagascar stated that the increase in the number of users of the Madrid System was one of the main objectives of its continued review and that the extension of the language regime needed to be one of the ways in which to achieve that objective. The Delegation added that, nonetheless, it was important to keep the Madrid System simple, low-cost and to reduce the examination time-frame, because those were important advantages of using the Madrid System. The Delegation suggested a progressive introduction of new languages, following the appropriate analysis and study of the situation, including the impact of costs and examination time-frames.

244. The Delegation of Denmark supported the statement made by the Delegation of the European Union. The Delegation recalled the discussions held in the previous session of the Working Group regarding the introduction of new languages into the Madrid System and the substantial costs that such would imply and how those costs would be transferred to the users of the Madrid System in the end. The Delegation remarked that all of the options put forward in the document confirmed its concerns and, for that reason, the Delegation was not in a position to support any of those options now because the Madrid System would be more expensive to use and the overall benefits of introducing new languages would not match the costs.

245. The Delegation of Japan stressed the importance of continuously working on improving the Madrid System to enhance its user-friendliness. The Delegation added that the issue of which language should be a working language was an important one and one of the fundamental bases of the system. The Delegation warned that additional working languages might increase the International Bureau's human and financial costs in terms of additional translations and more operating procedures. The Delegation shared its concerns that users could suffer unexpected disadvantages depending on the quality of translations of the goods and services, as those were connected to the scope of their rights. The Delegation expressed that, besides the language issues, users faced other difficulties, such as, for example, being unfamiliar with filing procedures. The Delegation stated that adding new languages might make the Madrid System more complicated. The Delegation suggested, instead, working on other incentives to reduce the overall difficulties for users in Contracting Parties using non-working languages to improve the user-friendliness of the system. For example, providing support for filing by enhancing the customer service counter for users, making the system easier to use.

246. The Delegation of Saudi Arabia welcomed the proposals to add other languages in the Madrid System. The Delegation explained that Saudi Arabia was studying the possibility of acceding to the Madrid Protocol and was, therefore, interested in proposals that would encourage owners of local marks, as well as local authorities, to support the accession to the Madrid System.

247. The Delegation of the Republic of Korea said that introducing the proposed three new languages into the Madrid System appeared to be difficult in many aspects. The Delegation stated that that, prior to making a decision, the Madrid Working Group needed more time to conduct a review of the enormous financial and administrative issues this would imply.

248. The Representative of CCIPT strongly supported the proposal made by the Delegation of China regarding the introduction of new languages. The Representative said that the proposal reflected the demands of the Chinese industry and noted that, in 2018, the number of international applications from China reached more than 6,000, while, in the meantime, applications filed abroad by Chinese citizens represented only 36 per cent, which meant that there was a lot of potential for increasing the use of the Madrid System in China. The Representative of CCIPT added that if Chinese was an official language of the Madrid System, that number would obviously increase. The Representative informed that the China Trademark Association had recently conducted a survey among representatives of enterprises and lawyers and that 98 per cent of the participants in the survey thought that the addition of Chinese would make it easier for the applicants, while 95 per cent said that they would consider using the Madrid System more if Chinese was a working language. The Representative stated that introducing Chinese into the Madrid System was reasonable given that the survey indicated that Chinese applicants would give more consideration to using it.

249. The Delegation of Georgia confirmed its position, stated in previous sessions of the Working Group, that the introduction of Russian into the Madrid System would unreasonably increase its administration costs and would unnecessarily complicate the examination processes in the International Bureau. The Delegation said that, considering the number of the applications for international registration filed in Russian, the applications filed abroad where the said language was spoken and the percentage of the Madrid market share, the arguments of the Russian Federation to include Russian among official languages of Madrid System were not well grounded.

250. The Representative of MARQUES supported in principle the proposals to introduce new languages, as this could improve the accessibility of the system for users but shared doubts as to whether it was the right time and agreed with the Delegation of Madagascar in that all elements needed to be considered. The Delegation stated that it was not just about increasing the use of the Madrid System, but also about maintaining and improving its quality and reducing examination time. The Representative, agreeing with the Delegation of Denmark, said that it did not want costs to increase and said it shared the opinion of the Delegation of Japan in that the focus should instead be on improving the system. The Delegation indicated that the quality of translation would be a real concern because, if more languages were included, there could be an increase in errors, delayed examination and lack of quality of translations and recalled that there were problems with the introduction of Spanish. The Representative referred to its position concerning the protection of marks in non-Latin script and added that it would actually be better to discuss and focus on dealing with languages in connection with trademarks themselves before looking at working languages.

251. The Delegation of Australia supported making the Madrid System more user-friendly and said that the introduction of new languages would make the Madrid System more attractive to current and potential users. The Delegation indicated that additional languages would provide benefits to all users of the system by reducing language barriers, improving the quality of applications, which would decrease the number of irregularities, which would increase the overall use of the system. The Delegation said that, to ensure the introduction of any new

languages was done correctly, it was mindful of the need for caution to ensure that the implications in respect of timeliness and quality for the users of the system as a whole were fully understood. The Delegation indicated its support for a comprehensive review of the current language regime proposed by the Delegation of Canada, which would look at the current practices to consider whether changes could be made to introduce new languages in the Madrid System gradually, without placing a heavy financial and administrative burden on either the Member States or the International Bureau. The Delegation added that tools utilizing artificial intelligence and machine learning would likely assist in making translation easier and more cost effective but added that those tools needed time and rigorous testing to be developed and modified to meet the International Bureau's needs and quality standards. The Delegation stated that the introduction of new languages would benefit the Madrid System but it should be done with caution and care to make sure the tools and resources were available to support their introduction and to ensure that the quality, timeliness and the cost of the services were not negatively affected.

252. The Representative of JPAA indicated that strict accuracy would be required when translating the list of goods and services because it directly related to the interpretation of the scope of the right, adding that, given that the proposed new languages were so linguistically different from the existing working languages of the Madrid System, the Representative of JPAA was concerned as to whether the goods and services could be translated accurately and reflecting the applicants intention. Therefore, the Representative stated that JPAA believed that further discussions were necessary to add new working languages to maintain the good quality of standards of the translations while considering the costs of such translations.

253. The Delegation of the United States of America shared its concerns about the heavy administrative and financial investment and the time needed for adding new languages into the Madrid System and said that the idea of expanding the language regime, until there was a better understanding of the current quality of the translation capabilities, both human and machine, did not make sense. The Delegation indicated that, in addition to exploring the current deficiencies in translation capabilities and the costs for addressing those deficiencies, to the extent they exist, it suggested the International Bureau explore how the language issues could be addressed by the existing WIPO electronic tools and interfaces and, if not, what enhancements or additional tools could make the filing of an international application a more user-friendly experience. The Delegation noted that the WIPO Website appeared to be offered in the six UN languages and that the MGS was offered in approximately 15 or 16 languages. The Delegation added that other Madrid electronic tools, such as, the Global Brands database, Madrid Monitor, the Fee Calculator and the Madrid Member Profiles database appeared to be available in the three Madrid languages. The Delegation said it believed that it was critical the International Bureau conduct a comprehensive review of the current language regime of the Madrid System, including a review of the existing electronic tools available to national Offices and possible enhancements to those tools. The Delegation recalled that the International Bureau had an enormous backlog and had proposed making translations of certain documents available only upon request. The Delegation also recalled that it had supported that but that the Working Group ultimately did not agree with the Delegation or with the International Bureau. The Delegation explained that it supported the said proposal to ensure that the International Bureau was spending appropriate resources on examining and processing, and less resources on translations that might not be needed except by a few interested parties. The Delegation said it understood the concerns of those working in other languages and wanted to ensure that their users had the information they needed in a usable form. However, the Delegation noted that, just a few years on, it was hearing calls for a massive expansion in language capabilities of the Madrid System. The Delegation believed that the Working Group needed to study such expansion very carefully and consider its implications, in particular, the magnitude of the financial investment at stake for introducing the new languages. The Delegation referred to its proposal tabled at the previous session of the Madrid Working Group entitled "Contribution to the Financial Well-being of the Organization" and recalled that the Madrid System was not currently contributing its full financial share to the common expenses of WIPO or even the

indirect expenses of the Madrid Union. The Delegation stated that the Madrid Union was benefiting from the method of allocating income and expenses to the Madrid Union, such that it did not pay a fair share of the common expenses and, instead, was subsidized by the PCT Union which was leading to deficits in the contribution-financed Unions and, if that continued, it would be unhealthy for WIPO. The Delegation recognized that the Working Group had the Madrid Union fee revision issue marked for the medium term in the Road Map, and that was expected to be addressed next year. The Delegation asked the Working Group to prioritize that discussion, as it was necessary to discuss the need for the Madrid System to have the appropriate fee income to pay for both direct and indirect expenses. The Delegation said that adding languages to the system would directly impact the fees that would need to be charged to users to cover those expenses. The Delegation stressed that those conversations must move forward in parallel.

254. The Delegation of New Zealand lent its support to the introduction of new languages in the Madrid System to better reflect the global nature of the system and potentially make it more attractive to users. The introduction of new languages may increase the accessibility of the Madrid System and may encourage more countries to join. The Delegation said that it would, however, want to ensure that any costs that may be involved with the introduction of the languages were manageable for users and the International Bureau. The Delegation agreed with the suggestion made by the Delegation of Canada and supported by the Delegation of Australia for the International Bureau to conduct a comprehensive review into the introduction of new languages.

255. The Delegation of China noted, from the discussions that had taken place, that the majority of the delegations wanted to stick to what had been agreed upon, meaning, that it was necessary to introduce new languages in to the Madrid System. The Delegation recalled that the addition of English and Spanish to the Madrid system had attracted new Contracting Parties and noted that most applications in the Madrid System were filed in English. The Delegation said that most delegations had indicated that additional languages should be decided upon as soon as possible and indicated that the Secretariat had already conducted an in-depth study and analysis which was sufficient to warrant a decision. The Delegation acknowledged that some delegations had expressed concerns about adding new languages into the system, such as, for example, on the quality of translation. The Delegation said it did not believe there was a direct relationship between the introduction of new languages and the quality of the translations and added that the introduction of English and Spanish into the Protocol did not affect the quality of the translations but, rather, promoted the development of the Madrid System. The Delegation also acknowledged concerns expressed by other delegations on the cost implications and said it understood that the operational cost would be increased if new languages were added, in particular, translation costs. However, the Delegation underscored that the development of new technology and translation tools in the near future had to be taken into account, and that such would reduce the costs of translation. The Delegation expressed confidence in such advance translation tools. The Delegation further recognized the concerns raised by other delegations and noted that it was willing to introduce the Chinese language gradually. Today's world is diverse. Therefore, the Madrid System should be multilingual and diversified. The Delegation referred to the positive multilingualism of the European Union and said that was a very important element. The Delegation reiterated that the Madrid System should be developed as soon as possible to allow for the introduction of new languages. Finally, the Delegation referred to interventions made by delegations concerning the possibility of a comprehensive review of the language regime of the Madrid System and, if a consensus could be reached and built on, said it would be in favor of such review.

256. The Delegation of the Czech Republic expressed support for the statement made by the Delegation of the European Union. The Delegation explained that marks were used on certain goods and services in order to sell those goods, or offer those services, in the international market. That meant users would need to undertake a certain amount of work on the ground, in different languages, in order to trade. It was not enough to just have the trademark in Arabic,

Chinese or Russian. There were users that would be confused by such languages and find it quite difficult. Sometimes translation was not done well and there were errors. More languages would increase the possibility of there being an error. Therefore, the Delegation stated the existing languages were sufficient and indicated that it had concerns about the financial aspect, as indicated in the document.

257. The Chair summarized the general comments made by delegations and noted that a while number of delegations were in favor of the introduction of new languages, other delegations were undecided and some had reservations. However, there appeared to be some overall consensus that discussions on the topic should at least continue and, with that in mind, the Chair opened the floor for comments on paragraphs 5 to 17 concerning the possible criteria for the introduction of new languages.

258. The Delegation of China acknowledged that the document addressed a number of possible criteria for introducing new languages, such as, for example, the current filing activity, introducing new languages one at a time, and the methods that could be adopted to translate those languages. The Delegation declared that the Madrid System was a user-friendly system, dedicated to addressing the needs of the users to improve the development of the system. New applications were the main source of income of the Madrid System. The development of the system depended on the number of new applications. Only by improving the Madrid System continuously, taking full advantage of its benefits, attracting more trademark holders to use the Madrid System to increase the number of new applications could make it possible to maintain the prosperous and sustainable development of the system while better protecting the interests of all the users and Contracting Parties. Accordingly, the Delegation indicated that the number of applications in a given Contracting Party was the criterion for introducing new languages that best met the requirements and interests of all the Contracting Parties of the Madrid System. The Delegation recalled that in recent years the Madrid System had made remarkable progress in China. The number of new applications filed under the Madrid System in China was increasing on a yearly basis. From 2016 to 2018, the numbers of new applications filed in China were 3,053, 4,810 and 6,900, respectively, accounting for 5.8 per cent, 8.5 per cent and 11.3 per cent of all the new applications under the Madrid System each year. In 2017 and 2018, the number of new applications filed under the Madrid System in China ranked number three in the Madrid System for those two consecutive years. The Delegation also reminded that from 2006, for 12 consecutive years, China was the most designated Contracting Party in the Madrid System. From 2016 to 2018, the annual numbers of designations of China by foreign applicants under the Madrid System were 22,444, 26,148 and 24,289, respectively. The Delegation said that those numbers reflected the actual and potential needs of foreign users in the Chinese market. In March 2019, the China Trademark Association, which was a specialized organization on trademarks at the national level in China, conducted an Internet based survey on the introduction of Chinese language as a new working language of the Madrid System, which included its benefits and whether it would affect the willingness of users to choose the Madrid System. The participants of the survey included trademark specialists in companies, trademark agents and other professionals in related fields. Ninety eight per cent of the participants believed that introducing the Chinese language would facilitate their use of the Madrid System. Ninety five per cent of them believed that if the Chinese language was introduced as a working language of the Madrid System, they would be more willing to use the Madrid System when filing trademark applications abroad. According to the statistics of the International Bureau, in 2017, the share of the Madrid System only accounted for 36 per cent of the total number of foreign trademark applications in China, which was a relatively small portion. According to the survey conducted by the China Trademark Association, if the Chinese language was introduced to the Madrid System, the use of the Madrid System by the Chinese users to file trademark applications abroad could potentially increase by 61 per cent, which would significantly benefit the development of the Madrid System. The Delegation informed that, to facilitate the use of the Madrid System by Chinese users, the Office of China had been working on the development of the online filing service for international applications under the Madrid System since 2017. The Office had solved difficult problems such as, for example, the

transmission of data between Chinese language and English language, the compatibility of the Madrid online application system and its internal examination system; it had fully taken into account the needs of Madrid users and had developed the online filing service for international applications under the Madrid System. The service was developed under technical assistance from WIPO. The online filing service was officially launched in June 2018. Information concerning the service was also published in the WIPO Gazette of October 29, 2018. The Delegation explained that the online filing service covered the entire procedure for filing international applications under the Madrid System and provided great help to users with an interest in China. In the first month following the launch of the service, the number of applications reached 418, accounting for 55.58 per cent of all the international applications under the Madrid System in China. In the first half of 2019, online applications had already reached 83.12 per cent of all international applications under the Madrid System in China. Given the smooth running of its online filing service, an online service for subsequent designation procedures had been put to test and would be launched very soon. Once the online service for subsequent designation procedures was launched, the entire process of filing international applications under the Madrid System in China would be fully digitalized. In the meantime, for international registrations designating China, the Delegation noted that it had been able to receive notifications of designations from the International Bureau by electronic means since 2011 and, by May 2019, all communications with the International Bureau was electronic. The Delegation stated that electronic communication was more convenient, efficient and facilitated foreign users seeking trademark protection in China through the Madrid System. The Delegation of China emphasized its belief that current filing activity in a Contracting Party should be the criterion for introducing new languages, rather than introducing languages one at a time. The methods to introduce new languages should be decided based on the long-term development of the Madrid System and on users' needs. Due to the geographical expansion of the Madrid System, it was inevitable and reasonable to develop the Madrid System by introducing new languages. The Delegation reiterated that the Madrid Union Assembly in 2009 had already discussed whether new languages should be introduced. Introducing new languages was to ensure diversity of the Madrid System, to increase its flexibility, to attract more users and to improve comprehensive development of the Madrid System. The Delegation acknowledged that the introduction of new languages would bring cost issues. However, it would also bring more benefits and profits. Certain measures could be adopted to reduce the cost, such as, for example, as the International Bureau had already mentioned, different translation practices could be considered. According to the estimate of the International Bureau, adopting indirect translation compared to direct translation would significantly lower the cost of translation. In order to reduce the cost of translation, the Delegation supported the method of indirect translation.

259. The Delegation of Brazil believed that the criteria established in the document based on, for instance, the number of designations and Madrid market share was not beneficial to new members that had not yet had the opportunity to use the system. Therefore, the Delegation proposed that the potential of use should be taken into account as criteria. The Delegation reminded other delegations that 250 million people spoke Portuguese, which was the sixth most spoken language in the world.

260. The Delegation of Switzerland said that, regarding the criteria for introducing new languages, it believed the emphasis should be on the convenience for the applicant, the Office of origin and the Madrid System, in general. The Delegation added that, among the criteria that could be taken into account could be the language of the basic application or registration and, eventually, the languages that were used the most.

261. The Delegation of the United Arab Emirates informed that it was working on its accession to the Madrid System and was working closely with the Secretariat in that regard. The Delegation sought clarification from the Secretariat regarding paragraph 5 of document MM/LD/WG/17/7 Rev., and the reference to document PCT/A/38/6 adopted by the Assembly in 2008. The Delegation questioned whether the criteria mentioned in Annex III of

document PCT/A/38/6 were applicable to the Madrid System and whether those criteria applied to the working languages of the PCT or to further additional languages. The Delegation also sought clarification on document MM/A/42/1 from 2009, also referenced in the document. That document concerned a study conducted by the International Bureau on the admission of additional filing languages namely, Arabic, Chinese, Portuguese and Russian, the four WIPO working languages and Dutch, German, Italian and Japanese, which met the eligibility criteria at that time. The document concluded that there was an agreement that a pilot project be established. The Delegation requested the Secretariat to provide further information on that project and on its effectiveness.

262. The Secretariat, in reply to the Delegation of the United Arab Emirates, explained that the reference to the documents that appeared in the Working Group document under discussion were merely references to the fact that, when the issue of languages had been discussed previously by different bodies, those bodies developed a criteria for the introduction of new languages. The criteria that was in those documents did not apply to the Working Group. In answer to the second question, in respect to the introduction of filing language, that proposal was discussed and resulted in the development of the MGS, a tool that was now used by most Offices. The Secretariat further clarified that the idea of introducing new filing languages was put on hold and, instead, the instructions were that the International Bureau develop a tool that would allow applicants to search indications for goods and services in different languages, properly classified according to the Nice Classification, and that the tool was at that time available in 19 languages.

263. The Representative of MARQUES referred to indirect translation and direct translation and highlighted that it was in favor of direct translation. The Representative said that anything else would bring the quality of translation in too much risk. The Representative of MARQUES stated that such could only be achieved with a proper machine translation and that only then direct translation would not be a problem.

264. The Chair noted that no other delegations had requested the floor and to prompt some further conversation suggested that delegations indicate whether they were generally in favor of the criteria listed in the document or whether there were any other criteria that could be a possibility.

265. The Delegation of Germany, sharing some thoughts on the first two criteria listed in the document, said that, regarding the number of international applications, the Delegation believed that the heaviest burden was for the applicant who could not file an application in its own language, as it was the case in Germany. The Delegation acknowledged, however, that instead of adopting new filing languages, the International Bureau had developed the MGS database, available in 19 languages, which was a real help for applicants. With regard to the second criteria concerning designations, the Delegation stated that it not consider the number of designations as a good criterion because designations were always selected by applicants in other Contracting Parties. For example, if a German applicant designated China, it would not benefit from an introduction of Chinese as a working language because German applicants did not speak Chinese.

266. The Chair noted that there was some agreement concerning the filing activity as a possible criterion for the introduction of new languages, and referred to the next part of the document which mentioned the official languages of the UN. Given that all three of the proposed additional languages were UN languages, the Chair opened the floor for comments on paragraphs 19 to 24 of the document concerning the introduction of one language at a time.

267. The Chair noted that no delegations had requested the floor which the Chair understood as agreement on the introduction of one language at a time, as being a good criterion.

268. The Delegation of Brazil referred to its previous statements and reiterated that there should be a holistic approach taken to the adoption of new languages and not necessarily one language at a time. The Delegation believed that it would be helpful if the Secretariat could provide more information on how it would introduce each one of the new languages, and asked whether, for example, there would be a list of languages with the sequence in which they would be introduced.

269. The Delegation of the Russian Federation reiterated that it was in favor of a simultaneous introduction of all three languages and noted that other delegations had supported that proposal and that criterion for the introduction of new languages.

270. The Delegation of Belarus was not in favor of the introduction into the system of three languages at different times. The Delegation suggested that the organizational and other efforts for the introduction of the languages needed to be done together. That way, solutions proposed would be standardized for all three languages and could give rise to a kind of economy of scale because those three languages would simultaneously overcome difficulties linked to their introduction. The Delegation said it understood that trying to work out which language would go first could lead to heated and possibly non-constructive discussions, and that some parties might even feel discriminated. Therefore, the Delegation suggested the simultaneous introduction of those languages into the system as the right approach.

271. The Delegation of Brazil, clarifying its earlier point, said that the current filing activity and the official languages of the UN had not been taken in to account when determining the criteria on whether the languages should be introduced one at a time or simultaneously. Therefore, the Delegation welcomed proposals from the Secretariat for determining the languages that should be included in the system and, in particular, whether the criteria were cumulative or whether they were to be considered in another manner.

272. The Chair, in response to the Delegation of Brazil, said that the criteria were for the consideration of the Working Group, which had to decide which were the most appropriate.

273. The Chair noting that there were no further delegations requesting floor, opened the floor for comments on paragraphs 25 to 42 of the document concerning translation.

274. The Delegation of Bahrain sought clarification on the cost implications section of the document and said that it would have liked to see a more detailed breakdown of the costs mentioned and, more specifically, the difference between the cost of indirect and direct translation.

275. The Secretariat explained that to better understand how the estimations in the document were calculated, it would be useful for the Working Group to understand how the system worked. The current system operated under a trilingual regime. As allowed by the Office of origin, the applicant could file an application in English, in French or in Spanish. The application was received and processed by the International Bureau in that language, which meant that there were examiners who were proficient in each of those languages to process the application and verify the proper classification of the list of goods and services. The Office of origin and the applicant may choose a communication language, which could be also English, French or Spanish. The International Bureau would communicate with them in the chosen language, therefore, the application was processed then sent for translation. The Secretariat informed that the International Bureau had developed an internal translation database which contained about 1.5 million terms and translated about 75 per cent of the words. The difference was then sent to machine translation using artificial intelligence. As recognized by some of the delegations, artificial intelligence was still not at the desired quality level. Therefore, machine translation was then sent for revision to an outsourcing company to ensure that the translation was correct. When the translation came back, it was subject to further quality control by the internal translators, and then, the result was published in English, French and Spanish. Designated

Contracting Parties could then receive notifications also in the chosen language of English, French or Spanish. The Secretariat referred to the first implementation option in the Annex of the document and noted that it would allow the applicant to file in a new language. Then, the application would be translated into one of the working languages for further processing. The advantages were for the applicant and the Office of origin because the applicant would be able to file the application in the original language of the basic mark, or the language used at home, and the Office of origin would be able to certify that application in that language. Then, the application would be processed and any further communications would be in a working language. When it came to the cost estimations, the Secretariat noted that it had only estimated for the cost of outsourcing the revision of the translation, assuming that the International Bureau would develop an internal translation database, with a yield of approximately 20 per cent to 25 per cent in an initial stage, increasing at a rate of about 2 or 2.5 per cent each year. In a direct translation scenario, the application would be translated directly from the source language, such as, for example, Chinese or Russian, directly into English, French or Spanish. That process had cost implications because the International Bureau would need to outsource the revision of that translation. The document also estimated the amount of hours that would be required for quality control and noted that translators proficient in each of the new languages and in each language combination would be needed to be able to conduct control in that direct translation scenario. The Secretariat explained that, in an indirect translation scenario, the costs were significantly reduced because the translation was not done directly from the source language to each of the other languages. Such translation would be done through what was called a relay language. For various reasons, mainly to do with cost and availability of resources, the Secretariat indicated that it would seem logical to choose English as the relay language, in which case the application would be translated from the source language, be it Chinese or Russian, into English. Once the English translation had been established, it would be possible to leverage the existing translation capacity the International Bureau had to translate that text into French and Spanish. The Secretariat explained that the second option in the Annex of the document, concerning the filing and processing language, was a slight variation of the first option, which was the filing language option. In the filing and processing option, the applicant would be able to file the application in the new language and the Office of origin would be able to certify such application in the new language. The International Bureau would process the application in the new language, which meant that any further communication concerning that international application, mainly irregularities, would be dealt with in that new language. That also benefited the applicant and the Office of origin because the latter could receive and certify the application and communicate with the International Bureau in the new language whether it be in Chinese, Russian or Arabic. The International Bureau would then record the mark and translate it to English, French and Spanish and, from that point forward, would continue to operate under the trilingual regime. The Secretariat informed that the third option, concerning the language of transmission, would not just allow the filing and processing of applications in the new language but would also give Offices the option to receive notifications also in the filing language when they were designated. That could be beneficial for Offices in Contracting Parties speaking a language which was spoken in other Contracting Parties. For example, an application filed in one Russian speaking Contracting Party that designated another Russian speaking Contracting Party could be notified to the designated Office in Russian. That benefited not just the applicant and the Office of origin, but it also had the potential to benefit designated Offices in circumstances when the application was filed in the new language. Offices could receive the notification in the new language, process it in the new language and send their decision in that language. However, for all other international registrations the trilingual regime would remain applicable. The Secretariat clarified that the next option in the Annex of the document was probably the most comprehensive option, short of becoming a full working language. The communication language option allowed applicants, holders and Offices to decide in which language they wanted to communicate with the International Bureau, that is, in which language to send and to receive communications to and from the International Bureau. The difference between this option and a working language was that, in this option, the International Bureau

would only translate as needed. The Secretariat explained that under the full-blown working language regime everything that had to be inscribed and communicated had to be translated into English, French or Spanish, depending on which language the document was filed, whether such translation was needed for the purposes of communication with the applicant or the designated Offices, or not. In the communication language option, applicants, holders, Offices acting as Office of origin and designated Offices would benefit from operating in their preferred language but the International Bureau would only translate when required for the purposes of communicating with the applicant, holder or the Offices concerned. The Secretariat finished by explaining that each of the options was incrementally more complex and offered incrementally more features. However, as noted from the Annex of the document, each of the options resulted in higher cost implications for the International Bureau and that those cost implications needed to be considered, not just the choice of options.

276. The Chair opened the floor for comments on the Secretariat's explanation.

277. The Representative of CCPIT supported the option of indirect translation out the two options due to the cost implications and noted that under the Madrid System most of the translations were simple and easy translations of indications of the goods and services.

278. The Chair opened the floor for comments on paragraphs 45 to 71 of the document concerning the possible implementation of the options for the introduction of the new languages.

279. The Delegation of the Russian Federation said that it had looked through the figures very carefully and indicated that it had been pleasantly surprised by the projections made on the use of the Russian language in the Madrid System, taking into account the fact that eight Contracting Parties would use that language. The Delegation noted that, however, there was a problem on the expenditure for processing Russian language filings. Therefore, the Delegation suggested having further studies on those financial statistics to be in a better position to consider the proposal, because at that moment, if those figures were multiplied by eight, it would result in a huge number. The Delegation added that, historically, Chinese applications contained a short list, unlike applications that came from the Russian Federation. Nevertheless, the Delegation said the complexity of such applications should also be taken into account. The Delegation indicated that it had heard that international applications from its Office of the Russian Federation were always a gift to the experts because they were well checked out concerning the use of the required terminology, and that the terms of goods and services used in those international application were always acceptable.

280. The Delegation of Switzerland informed that its first statement, concerning criteria for adding languages, should be understood in light of the option chosen at that stage. In other words, the addition of the filing language that seemed the simplest and the least costly option for the system whilst also being the most useful.

281. The Delegation of Belarus reiterated that the introduction of Arabic, Chinese and Russian into the Madrid System as fully-fledged languages should be the end goal. Therefore, the various options, such as, for example, the filing language, processing language or the language of communication were not mutually exclusive. The Delegation asserted that those represented the development of the implementation of introducing the new languages over time, firstly, as a filing language, followed by the processing language, then by the language of communication and, finally, as a working language. The Delegation stated that such would be the most logical and feasible means of introducing new languages.

282. The Delegation of Brazil said that it considered the option of the communication language as the most suitable option.

283. The Representative of MARQUES reminded delegations that the reason for adding Spanish to the Madrid System was to attract Spanish-speaking countries into the system, which, however, had not been the result. The Representative noted that there was, of course, still hope that it would happen.

284. The Delegation of Bahrain, on behalf of the Delegations of Algeria, Bahrain, Belarus, China, Egypt, Morocco, Oman, the Russian Federation, Saudi Arabia, Sudan, Syrian Arab Republic, Tajikistan, Tunisia and the United Arab Emirates, announced that those Delegations had made an additional contribution to the discussion in a paper entitled “Non-paper from Algeria, Bahrain, Belarus, China, Egypt, Morocco, Oman, Russian Federation, Saudi Arabia, Sudan, Syria, Tajikistan, Tunisia, United Arab Emirates”. The Delegation noted that multilingualism was a core value of the UN and of WIPO that helped in the effectiveness of the multilateral system. Multilingualism was an essential component of culture diversity and a key to broadening the geographical scope of WIPO’s activities. The Delegation recalled that Arabic, Chinese, English, French, Russian and Spanish were the official languages of the UN and of WIPO. Those languages were among the most common languages in the world, with official status in more than 100 countries, and widely used for communication all over the world. Numerous Arabic, Chinese, Russian, French and Spanish speakers contributed greatly to the development of science, technology and intellectual property, in general. Considering the development of artificial intelligence and machine learning translation tools explored by WIPO, significant savings that could facilitate the implementation of the foreseen language policy in a cost effective manner could be expected. The implementation of the initiative would expand the use and access of Madrid System worldwide. The Delegation said that, taking into consideration the complexity of its administrative enforcement, it proposed that such introduction be conducted in a gradual and pragmatic approach. Therefore, the Delegation proposed that the Working Group request the Secretariat to prepare: (i) a comprehensive study of cost application and technical feasibility of the gradual introduction of Arabic, Chinese and Russian languages into Madrid System; and, (ii) a review of the current language regime to be discussed at the next session of the Working Group. The Delegation informed that the proposal was available for consideration in document entitled “Non-paper from Algeria, Bahrain, Belarus, China, Egypt, Morocco, Oman, Russian Federation, Saudi Arabia, Sudan, Syria, Tajikistan, Tunisia, United Arab Emirates”.

285. The Chair announced that copies of the above-mentioned non-paper were available outside the conference hall and offered delegations time to review it. The Chair opened the floor for comments on that document.

286. The Delegation the European Union, speaking also on behalf of its member states, reiterated its position about the complex nature of the issue and its various implications. The Delegation stated that more information was needed to properly develop an informed opinion on the topics that were being discussed. Therefore, the Delegation favored conducting a more comprehensive study, which should encompass all the various factors at stake without excluding any possible option. The study was to shed light on the aspects, which, at that moment, remained unclear, such as, for example, the whole range of costs or the potential impact on the financing system. Accordingly, the Delegation considered that it was premature to take any decision other than to undertake a comprehensive study of the impacts of adding the languages proposed to the Madrid System and not to undertake wider review of language policy at that time.

287. The Delegation of Brazil reiterated that it favored multilingualism and believed that the Madrid System should strive towards the inclusiveness of languages of different Member States. The Delegation commended the proposal, but encouraged the inclusion of not only Arabic, Chinese and Russian, all UN official languages, but also other languages of Member States. The proposal should request the Secretariat to prepare a comprehensive study of cost implication and technical feasibility of the gradual introduction of Arabic, Chinese and Russian, as well as other languages into the Madrid System. The openness to other languages would be in line with the model adopted by the PCT Union, which, thanks to artificial intelligence tools, was able to broaden successfully its scope to include different languages.

288. The Delegation of Norway supported the statement made by the Delegation of the European Union.

289. The Chair noted consensus in relation to requesting that the International Bureau conduct a comprehensive study of the cost implications and technical feasibility of the gradual introduction of the Arabic, Chinese and Russian languages into the Madrid System, option (a). The Chair also noted that there was no consensus or agreement in relation to undertaking a review of the current language regime at the next session of the Working Group, option (b). The Chair opened the floor in relation to any further comments on the latter option.

290. The Delegation of Germany supported the statement made by the Delegation of the European Union and reiterated that the European Union member states were not prepared to undertake a wider review of the language policy, option (b), as referred to by the Chair.

291. The Delegation of the United States of America reiterated its earlier intervention and its interest in a comprehensive review of the current language regime so the full costs and implications of the existing three languages were understood before undertaking the cost and implementations of adding new languages. As part of that review, the Delegation said it wanted a review of the current tools that were available, such as, for example, the Fee Calculator, E-renewal, the Global Brand Database and the MGS to assess their viability, quality, predictability and reliability and to see whether those could be expanded to other languages, rather than considering adding new languages into the Madrid System at that time. The Delegation of the United States of America supported options (a) and (b), as referred to by the Chair.

292. The Chair proposed that the Working Group request the International Bureau to prepare, for discussion at its next session, a comprehensive study of the cost implications and technical feasibility, including the assessment of the currently available WIPO tools, of the gradual introduction of the Arabic, Chinese and Russian languages into the Madrid System. The Chair opened the floor for comments.

293. The Delegation of Brazil recalled that there had not been any opposition from the floor regarding its proposal to include other languages into the Madrid System.

294. The Chair explained that a number of delegations did not agree on the review of the current language regime or the language regime in general, hence, there was no agreement to add further languages to the study.

295. The Delegation of Brazil said it understood the option (b), as referred to by the Chair, was a review of the current language regime, and that option (a) was simply a comprehensive study of cost implications and technical feasibility of the gradual introduction of languages in the system, which may include languages other than those being proposed.

296. The Chair invited delegations to comment on the suggestion made by the Delegation of Brazil.

297. The Delegation of Germany agreed with the proposed paragraph specifying the gradual introduction of the Arabic, Chinese and Russian languages into the Madrid System and including the assessment of the current available WIPO tools. The Delegation said it did not recall anything relating to languages only.

298. The Chair noted that there was no support for including further languages within the study and concluded that the study would include only the Arabic, Chinese, and Russian languages.

299. The Representative of MARQUES agreed with the suggested proposal to take a step-by-step approach and reminded the Working Group that things took time and that the Working Group might come back to other languages eventually.

300. The Delegation of China agreed that a step-by-step approach to introduce more languages should be taken and that the Working Group should consider, at that time, the introduction of the Arabic, Chinese and Russian languages only into the system. The Delegation suggested that discussing other languages once an in-depth analysis of the position had been undertaken by the Secretariat.

301. The Working Group requested the International Bureau to prepare, for discussion at its next session, a comprehensive study of the cost implications and technical feasibility (including assessment of the currently available WIPO tools) of the gradual introduction of the Arabic, Chinese and Russian languages into the Madrid System.

ITEM 10: POSSIBLE AMENDMENTS TO RULE 9 OF THE COMMON REGULATIONS UNDER THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS AND THE PROTOCOL RELATING TO THAT AGREEMENT

302. Discussions were based on document MM/LD/WG/17/8.

303. The Chair noted that discussions on Agenda item 6, regarding the survey on acceptable marks, would be taken into account during the related discussions of Agenda item 10 regarding possible amendments to Rule 9 of the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement.

304. The Secretariat recalled that, in its previous session, the Working Group requested the International Bureau to prepare a document describing possible changes to Rule 9 of the Common Regulations to accommodate new means of representation. The survey discussed during Agenda item 6 of the current session of the Working Group had shown that many Contracting Parties still required a graphical reproduction of the mark. However, the Secretariat invited the Working Group to discuss how to prepare for future development by making the legal framework more neutral and allow some flexibility. The document did not propose an amended text to be discussed but it identified and described three possible changes to Rule 9 namely, (i) to remove the requirement that the mark fit in the box provided in the international application form MM2 and, instead, require that the international application contain or be accompanied by a clear and precise representation of the mark; (ii) to delete the requirement of a second representation of the mark and the need for box 7(b) in the application form MM2, which was only used where the mark contained a color claim but had been published in black and white by the Office of origin; and (iii) to harmonize the wording in Rule 9(5)(d)(iv) with Article 3(1) of the Protocol so the Office of origin would be required to certify that the particulars of the mark in the international application corresponded to the particulars of the mark in the basic application or basic registration. The Secretariat suggested that the details on how marks could be represented in the international application be specified in the Administrative Instructions, which could then contain indications of acceptable formats and requirements for representation. The Secretariat clarified that the Administrative Instructions would deal with the mere technical details of the formats and requirements, such as, for example, a reproduction no bigger than an A4 size for a mark represented on paper or which formats to use for electronic

representation, such as, for example, JPEG, MP3 or MP4. It was expected that all Contracting Parties in the future would accept various means of representation exchanged electronically and in digital format. The Secretariat said that the Madrid System had to be ready to serve its users by updating its legal framework and by adjusting processes, practices and organizational infrastructures. Specific practical and technical considerations that the Working Group would need to discuss further were identified in the document. The Secretariat further noted that the possible amendments to Rule 9 would not force Offices of Contracting Parties to protect signs that, according to their applicable laws, did not constitute a mark. Furthermore, the possible amendments would not remove the inconvenience of having different representation requirements in the Contracting Parties of the Madrid System. However, the amendments did require Offices of all Contracting Parties to exchange electronic representations by electronic means and also required changes to the ICT systems of the International Bureau.

305. The Chair suggested that the document be discussed in parts and opened the floor for comments on paragraphs 3 to 6 of the document concerning the possible amendments to Rule 9.

306. The Delegation of the European Union informed that its new harmonized legislation repealed the requirement of graphical representability and had replaced it with a general condition that a trademark must be capable of being represented on the register in a manner that enabled the competent authorities and the public to determine the clear and precise subject matter of protection. Following that change, the European Union and its member states considered it of the utmost importance that trademark holders in the European Union had the opportunity to seek extended protection for their non-traditional marks by using the Madrid route under the same modernized conditions that were available for them under the new European legislation. The Delegation fully understood and acknowledged the difficulties highlighted by the Secretariat and that some Contracting Parties may have to face if new means of representation were introduced in the Madrid System. The Delegation also noted concerns expressed as to whether the possibility to file an international application with any representation of the mark, graphic or non-graphic, would remove the inconvenience holders would still face of having to comply with different representation requirements in designated Contracting Parties for a given type of mark, provided it could constitute a mark in those territories. The Delegation fully recognized the complexity of the problem to solve, however it reiterated its view that embracing the use of latest technologies in actual application practices would also facilitate the modernization, digitalization and enhanced the user-friendliness of the Madrid System. Against that background, the Delegation stressed that document MM/LD/WG/17/8 had been very much appreciated and read with great interest. The Delegation lent its full support to the Secretariat in its efforts to address that complex issue in a comprehensive and solutions oriented manner and thanked the Secretariat for preparing document MM/LD/WG/17/4 on the findings of the survey on acceptable types of marks and means of representation. The information compiled in that document was a good basis for further discussions and added valuable practical context to the continued work on the issue. Regarding guidance on a possible way forward, the Delegation said that, given the practical realities and legal difficulties, the Working Group might wish to take a step-by-step approach and build up a systemic solution that was as flexible as possible. The Delegation said it fully believed that taking into consideration the wide range of different situations in Madrid Member States was crucial and it remained open to hearing the opinion of other participants in the Working Group. The European Union and its member states looked forward to further discussions on that issue and stood ready to work with the Secretariat and members of the Madrid Union to find technical and legal solutions for adequate protection for non-traditional trademarks via the Madrid System.

307. The Delegation of Japan supported the amendments to Rule 9(4)(a)(v) and (vii) and the proposal for harmonizing Rule 9(5)(d)(iv) with the wording in Article 3(1) of the Protocol. The Delegation stated that the introduction of electronic data would bring great benefits to both applicants and Offices but stressed that the Working Group had to discuss the amendments very carefully because for some Offices, including the Japanese Patent Office, revising their domestic laws and developing their IT systems to handle the transfer of electronic data would take time.

308. The Delegation of Denmark supported further working on possible amendments to Rule 9(4)(a)(v) and Rule 9(5)(d)(vi) of the Common Regulations and on establishing some guidance in the Administrative Instructions as to how marks could be represented in international applications, including the indication of acceptable formats and technical requirements for each type of electronic representation to accommodate new means of representation. The Delegation referred to Rule 9(4)(a)(x) that states that the international application must contain or indicate whether the basic application or the basic registration relates to a collective, certification or guarantee mark. The Delegation informed that, according to national legislation in Denmark, it was necessary to know exactly whether it was a collective, certification or guarantee mark. Therefore, each time an indication according to Rule 9(4)(a)(x) was made in an international registration designating Denmark, the Danish Office had to issue a total provisional refusal. Consequently, the Delegation suggested that the indication be split into two so that the international application clearly indicated one or the other. In addition, the national legislation of Denmark required regulations governing use of collective marks, guarantee and certification marks. Therefore, the Delegation suggested that it ought to be possible to provide those regulations when filing the international application. The Delegation stated that the option to clearly indicate whether the mark was a collective, certification or guarantee mark and to be able to provide the regulations governing the use of the mark would also benefit users, as they would not receive a total provisional refusal solely on that basis.

309. The Delegation of Israel said that the Madrid System should provide the opportunity for international applications to be presented for non-graphic trademarks since there were some members whose national law allowed for non-graphic representation. The Madrid System should be advanced and accommodate that new development. Therefore, the Delegation suggested that the Madrid Regulations be amended to meet the needs of users and Offices. The option of furnishing additional representations of non-traditional marks within the international application might help holders avoid provisional refusals in Contracting Parties where graphic representation was compulsory. Regarding paragraph 5 of the document, the Delegation favored introducing flexibility into the certification process of international applications and amending the Madrid Regulations in a manner in which the Office of origin would certify that the mark in the international application corresponds to the basic mark or basic registration. Regarding the Administrative Instructions, the Delegation recognized the importance of establishing standards for representing marks in international applications, which would depend on the way in which the application was transmitted to the International Bureau. The Administrative Instructions should expressly indicate the acceptable formats and technical requirements for all kinds of electronic representation, such as, for example, sound marks, multimedia marks and holograms. The Delegation firmly believed that the International Bureau should begin to develop the electronic data exchange in the Madrid System with a view to providing for transmission of the digital files including non-graphic representation of marks. Given the rapid pace of technological advancement in digitalization, members would be able to join gradually over time and take advantage of that mode of communication.

310. The Delegation of New Zealand informed that New Zealand had a graphical representation requirement. In the 2018 financial year, only 0.3 per cent of the total designations of New Zealand were for non-traditional trademarks. In the previous three years, zero out of 1,200 international applications were for non-traditional trademarks. The Delegation indicated that it had not received feedback from users indicating that graphical representation requirement was the reason for that low number. More likely, it was because the registrability

requirements for non-traditional trademarks were often more difficult and regularly required evidence of use. Given the developments of technology and electronic transmission, it seemed inevitable to allow more flexibility for mark representation. The proposal in Rule 9 to not require that the designated Contracting Party accept non-graphic representations was desirable because it meant that members could assess the demand for non-traditional marks and make any domestic changes in response to that. The Delegation said it had noted the possible concerns that users would have to be mindful when filing trademarks that were not graphically represented given the high number of Contracting Parties that still require graphical representation. That would be somewhat mitigated as applicants who typically filed non-traditional trademarks tended to be more sophisticated users and therefore, should be aware of different representation requirements. The Delegation suggested that information could be included on the Madrid Member Profiles database.

311. The Delegation of Republic of Korea stated that, despite the increasing number of applications for non-traditional marks worldwide, a procedure for filing a non-traditional mark was not provided for in the Madrid System for the international registration of marks. That made offering protection difficult through the system. The Delegation agreed with the proposals made by WIPO to improve the system by changing the form and allowing a second representation of the mark to be accompanied to secure rights for their marks. However, as there remained several members of the Madrid System who had not yet introduced non-traditional marks, the Delegation suggested that WIPO make every necessary effort to increase the number of Contracting Parties that accept non-traditional marks by lessening the burden that would result from this amendment.

312. The Delegation of Madagascar informed that, while its current legislation only recognized visible signs that could be registered, a new law that was waiting to enter in to force by decree recognized all signs that were sufficiently distinctive for the use for which they were intended. Therefore, the Delegation supported the introduction of new means of representation in the Madrid System for the benefit of applicants, but in a flexible manner, that was, by providing for supplementary means of representation of marks and by taking into account the specific features of the legislation in the Contracting Parties, as revealed in the findings of the survey. The Delegation said that it would require a graphic representation for all filed marks but that it would accept digital representations as a supplement. However, the Delegation requested clarification of paragraph 5 and on the notion and scope of correspondence.

313. The Delegation of Colombia informed that Colombia accepted different kinds of marks, including those considered as non-traditional and that the Office had received application for exotic types of marks, such as, for example, olfactory marks. However, Colombia still required graphic representation because other means of representation were accepted on a subsidiary basis only. The national regulations, which were in accordance with the Andean Community law, allowed applicants to file for non-traditional marks and prescribed the minimum requirements to undertake examination and determine whether they were distinctive. The Delegation said that during that step the Office had encountered obstacles that prevented granting protection to the mark. Nevertheless, Andean Decision number 486, which was supranational law, governed industrial property in Colombia as a Member State of the Andean Community. Therefore, amending this supranational law to either broaden or eliminate the graphic representation requirement, had to be put into the consideration of the other Andean Community Member States, which were not members of the Madrid System, so they could take a decision at the regional level.

314. The Delegation of Australia supported the simplification of Rule 9 for both users and Offices. However, as the Delegation of Japan, urged caution because any amendment should take into account the different circumstances in each Contracting Party. The Delegation noted that, as the results of the survey had demonstrated, not all Offices were in the same position. The Delegation stated that moving forward it would welcome a proposal to amend Rule 9 at the following session of the Working Group, along the lines suggested in the document.

315. The Delegation of China noted from the survey results that Contracting Parties had very different trademark laws. Given the types of trademarks and the representations were very different in each country, the Delegation suggested that the Madrid System adopt a relatively flexible and open framework so that users could still request protection in different Contracting Parties for different types of marks.

316. The Delegation of Belarus said it understood that the overall trend was to include newer types of marks in the laws of more and more Contracting Parties. There was also a need to progress from graphic to non-graphic representation of marks. As such, the Delegation accepted the amendments to Rule 9 proposed in paragraphs 3 to 6 of the document. The Delegation understood that the new rule would be interpreted according to the national law in Belarus and according to its technical abilities. The Delegation expressed concern at those Offices that did not allow for protection of non-traditional marks, as their Offices would be snowed under with international registrations designating them. Those registrations, due to their nature, were not protectable in Belarus either because they were for a type of mark that could not be protected in Belarus or because they were represented in some non-graphical way. The Delegation referred to the comments made by the Delegation of Israel regarding the use of the Madrid Member Profiles database to inform users of the acceptable types of marks. However, not all users were sophisticated and, therefore, maybe, the international application form could be developed to further address the issue. For example, there were currently footnotes for some designated Contracting Parties, explaining their specific requirements, such as for declaration of use. The Delegation wondered whether the international application form could be developed to refer directly to the Madrid Member Profiles database or, maybe, if it was not too cumbersome, to include more information about the acceptability of such marks. For example, there could be a footnote containing the list of Contracting Parties that did not protect sound marks. Other types of marks could also be dealt with in the same way. If the list of footnotes was too long, there could be a reference to the Madrid Member Profiles database.

317. The Delegation of Switzerland said it understood the need to update Rule 9 on the representation of the mark, given that technical developments had provided new opportunities that did not exist when the rule was drafted. The modernization of that rule was welcomed and, in principle, the Delegation supported the proposed ideas in paragraphs 3 to 6 of the document. However, the Delegation found the wording in paragraph 4 concerning the inclusion of color claimed as a distinctive feature problematic. Whether an element was considered a distinctive element or not was different in each Office due to national law. Color itself may not be distinctive, but the combination of colors or the combination of a color with other elements may be distinctive. So, for that reason, when it came to drafting a future paragraph for Rule 9, the Delegation believed that a formulation such as, for example, when the color was claimed or when the color was part of the constituent elements of the sign could be used. The Delegation clarified that its remark was made in relation to the work that would be done the following year and said that it was important for the Delegation and it would later come back with a comment in that regard. The Delegation questioned the interpretation of Rule 9(4)(a)(vii) of the Common Regulations and informed that its Office sometimes had reproductions of marks in color that did not contain a color claim. Therefore, no color was indicated under INID code 591 in Madrid Monitor. To that date, the Swiss Office had considered those as marks without color, in other words, marks in black and white that may be protected in all colors. Indeed, the Delegation understood Rule 9(4)(a)(vii) as meaning that, if the mark was to be protected in color, those colors had to be indicated in words in the application. The Delegation recalled that Rule 9(4)(a)(vii) read “an indication that color is claimed and an indication by words of the color or combination of colors claimed”. The Delegation questioned whether its current interpretation should be modified or, where a mark was to be protected in color, the colors needed to be mentioned in words.

318. The Delegation of Brazil supported the proposal put forward by the Delegation of Belarus to include footnotes in the form with information concerning non-acceptable formats for the different Member States, or a reference to the Madrid Member Profiles database.

The Delegation said that would be helpful for both the users and the trademark Offices in terms of costs, time and work.

319. The Representative of INTA welcomed the proposed removal of the 8 centimeters by 8 centimeters square box from the international application form. The Representative recalled that such requirement had been deleted in the Singapore Treaty. The Representative highlighted that it was extremely difficult for applicants when applying for 3D marks to include more than one representation of the mark in a space of eight centimeters by eight centimeters. An A4 format could be accepted as an annex to the international application.

The Representative of INTA referred to paragraph 7 of the document and noted, with extreme pleasure, the statement made by the International Bureau indicating that the Madrid System had to get ready to serve its users in an evolving landscape. The Representative stated that all efforts should be made to allow international applicants to use the Madrid System for all sorts of requirements by the designated Contracting Parties. The Representative referred to paragraphs 14 and 15 of the document and noted that there would be a problem when an international applicant sought protection in a Contracting Party that required a digital recording of the sound. The Representative indicated that the suggestion made in paragraph 15 for an additional representation of the mark, which could be graphical or words describing the sound, should be entertained subject, of course, to the confirmation by the Office of origin that the graphic representation or the representation in words corresponded to the digital representation of the sound.

320. The Chair invited the Secretariat to answer a number of questions raised by delegations.

321. The Secretariat first responded to the question raised by the Delegation of Denmark concerning the grouping together of collective, certification and guarantee marks in the international application. The Secretariat noted that the Office of Denmark only accepted one type of mark of this nature, and if it received no clear indication as to the type of mark, it would issue a total refusal. The Secretariat acknowledged that the lack of harmonization in defining the type of marks of that nature and the complexity of the matter. Grouping the three types of marks together allowed the most flexibility for users when designating a Contracting Party that might interpret the type of mark differently from the interpretation by the Office of origin. Users could designate Contracting Parties and use the voluntary description to specify the type of mark, if necessary. The Secretariat agreed that it would be easier if the International Bureau received and forwarded the Regulations to the Offices and recognized that such could be an option once all Offices had electronic communication. The Secretariat stated that, once electronic communication was in place, the Madrid System could become more user-friendly because the International Bureau could receive more documentation. The secretariat, addressing the question raised by the Delegation of Madagascar concerning the correspondence of marks, recalled that the sameness requirement between the basic and the international mark, in Rule 9(5)(d)(iv) of the Regulations, and the correspondence requirement, under Article 3(1) of the Protocol, which referred to the correspondence between the particulars in the international application and those of the basic mark had been discussed in some detail. Some Offices had questioned whether Rule 9 was stricter than Article 3(1) of the Protocol. The findings of a survey presented at the Roundtable indicated that some Offices required complete identity, while others allowed more flexibility. For example, where there were small differences between the basic mark and the international mark, some Offices would consider the marks to be the same for certification purposes. The Secretariat believed that the issue of correspondence could be very important when considering the different requirements for representation and questioned whether an Office would consider a basic mark and an international mark represented in different formats as meeting the requirement for correspondence, and noted that it was presently up to the Office to decide. The Secretariat, addressing the comments made by the Delegation of Belarus on the possibility of a footnote in

the application form, said that a footnote might provide some technical complications because not all Offices would accept the same types of marks. The Secretariat added that it would be possible to add to the form a reference to the Madrid Member Profiles database and advise applicants to refer to this database to see whether the designated Contracting Parties accepted certain types of marks. The Secretariat added that all Offices would be responsible for ensuring that the information in the Madrid Member Profiles database was kept up-to-date. In response to the Delegation of Switzerland concerning the color claim, the Secretariat explained that not all marks represented in color had a color claim because that depended on the practice of the Office of origin. If the basic mark had a color claim, the international application would also have to have a color claim. If the Office of origin had no practice or there was no color claim in the basic mark, the applicant could still file a trademark in color and add the claim voluntarily because certain designated Contracting Parties might require such claim. The Secretariat added that it was up to the Swiss Office to interpret whether it required a color claim or a description of the mark in color and noted that Offices took different approaches. Some Offices looked at the mark as it was and just accept the colors indicated in the mark, while not necessarily grant protection to all potential colors of the mark. The Secretariat said that it would study the suggestion made by the Delegation concerning a change in wording in Rule 9 and would revert to the Delegation at a later date.

322. The Chair summed up the discussions on paragraphs 1 to 6 of the document and acknowledged that there was general agreement that the Madrid System needed to evolve to allow for non-graphical representation. On that basis, the Chair suggested that the International Bureau prepared a document with proposed amendments to Rule 9 for the following session, which could also consider clarifying the role of the Office of origin and the possibility of having more than one representation in international applications.

323. The Chair opened the floor for comments on paragraphs 7 to 11 of the document.

324. The Delegation of Cuba stated that, on the possible amendment of Rule 9 of the Common Regulations, it seemed wise to appraise introducing new means of representation for non-traditional marks to mold the Madrid System to the needs of Contracting Parties where means of representation, other than those currently envisaged in the system, were accepted. The Delegation added that the above would also leave open this possibility for Contracting Parties that, in the future, include in their corresponding legal frameworks these elements. The Delegation highlighted that, nevertheless and as indicated by other delegations, this introduction would be a complex process involving, beyond good intentions, diverse development stages and diverse legal frameworks among Contracting Parties which would require flexibilities according to their corresponding capacity. The Delegation suggested that new Rule 9 expressly indicate that the amendments would not restrict the right of designated Contracting Parties to refuse protection to distinctive signs that cannot constitute a mark under their corresponding legal frameworks and practices, as indicated in paragraph 9 of the document. The Delegation of Cuba underscored that, further to adequately regulating the Madrid System procedures, attention should be given to amending the official forms, the publication and notification forms, and the search features in the online databases concerning possible new means of representation. Concerning whether to include in the Administrative Instructions the manner and format in which the international application must include the representation of the mark, the Delegation stated that, while this would develop and clarify those matters from a procedural point of view, such would not be sufficient. The Delegation indicated that, for example, it would be difficult to include sound and multimedia files in the box provided in the current official form, as required under Rule 9(4)(a)(v) of the Common Regulations. The Delegation recalled the difficulties faced by applicants when using the current official form to request the international registration of tree-dimensional marks, as previously explained by the Representative of INTA. The Delegation stressed the impact new means of representation would have on the current online databases, in particular, on Madrid Monitor and the need to update its search engine, which provided for phonetic and image-based searches but did not provide for sound and multimedia-based searches, which the Delegation believed

were under development. The Delegation said that a decision was required on how to include marks represented by new means in the international application, in communications concerning administrative decisions and in the Gazette, which under Rule 32 of the Common Regulations, must publish marks as they appear in the international application. The Delegation informed that Legislative Decree number 203, in force in Cuba, required a clear reproduction of the mark, which, as further specified in Article 2(d) of its Regulations, would require a graphical representation or an understandable description for signs that are not visually perceptible. Accordingly, under this flexibility afforded by the Cuban legislators, applicants could combine several of those means to meet the representation requirement, which excluded other means of representation such as, for example, analog or digital sound, video or multimedia recordings. The Delegation further informed that the Cuban legislation had a *numerus clausus* provision that limited the number of signs that could constitute a mark, which included three-dimensional shapes, color delimited in a given way, color combinations, sounds and sound combinations. However, under a final provision, the legislation excluded the protection of smells and sounds as marks until there existed the necessary conditions for their registration. The Delegation explained that, to overcome this legal constraint, Cuba's trademark legislation would need to be amended or new rules enacted for accepting these signs and prescribing their means of representation whenever the material necessary conditions for their registration had been created. The Delegation, referring to those material necessary conditions, recalled that the Industrial Property Automation System (IPAS), the WIPO-developed IP administration system used by the Cuban Office, provided for image and description as means of representing marks only, and not for new means of representation. The Delegation said that, to accept and process these new means of representation, it was necessary to introduce new functionalities in IPAS or link this system to an external database. Moreover, as a further need, IPAS did not provide for prior right searches for these new means of representation, as it only provided for phonetic and Vienna classification-based searches. Therefore, it was also required to develop new IT functionalities to search for prior rights of marks represented by sound or video recordings. The Delegation informed that the legal framework prescribed the publication of all trademark applications in the official gazette of the Cuban Office, which, under the Cuba Trademarks Law Regulations, must include the mark, without specifying further details. For that reason, such publication could include a link to the representation of the mark, when this consisted of a sound or multimedia recording. Notwithstanding, the Delegation stated that such publication of the mark in the official gazette, which consisted of a file in PDF format, would be ambiguous. The Delegation indicated that, in view of the aforementioned legal and practical considerations, Cuba could not accept new means of representation until its legal framework evolve and the material necessary conditions for their admission be met.

325. The Delegation of Madagascar referred to paragraphs 7 to 11, in particular, to signs that could not constitute a mark and noted that the Office of Madagascar was one of the 35 Offices that defined marks as visible signs, according to its national legislation currently in force. Consequently, the Office refused marks that did not fit in that category at that time. The Delegation agreed that the law of the Contracting Parties that were in the same situation should not be limited, and suggested the Working Group monitor its developments at the Roundtable. The Delegation stated that, as previously mentioned, the new legislation of Madagascar was waiting to enter into force.

326. The Delegation of OAPI informed that OAPI was going through a transitional period and that its new regulations, currently in preparation, would take into account the suggested new amendments to Rule 9. The Delegation also stated that a number of Offices, including the Office of OAPI, encountered some problems when it downloaded verbal marks processed through IPAS. The Delegation remarked that such process would be more complex with new types of marks, such as, for example, sound or moving marks. The Delegation said that OAPI would need the assistance of the International Bureau to implement the amended Rule 9.

327. The Representative of JPAA recalled that, at the previous session of the Working Group, it had suggested adding check boxes to the MM2 form so the applicant could specify the type of mark. The Delegation remarked that such would prevent situations where the mark was registered in a designated Contracting party as a certain type of mark, when the applicant wished to obtain protection for different type of mark. The Representative referred to the summary of the replies to Question 5 of the Questionnaire on Acceptable Types of Marks and Means of Representation, in the Annex to document MM/LD/WG/17/4. The Representative remarked that, according to those replies, 10 Offices (20 per cent) accepted and processed an application without an indication of the type of mark, whereas 20 Offices (41 per cent) accepted and processed an application with an *ex officio* indication of the type of mark. Echoing its previous comment, the Representative emphasized that applicants would prefer to specify the type of mark in the MM2 form or, as 19 Offices (39 per cent) so allowed, when responding to an Office action or inquiry in a designated Contracting Party. Accordingly, the Representative of JPAA requested that the Working Group consider whether adding check boxes to specify the types of marks in the application form would be a solution to the problem that some users have faced.

328. Responding to the comments made by the Representative of JPAA, the Chair said that at present an applicant could indicate the type of mark in the voluntary description, in item 9(e)(ii) of the MM2 form. The Chair remarked that this offered some benefits because applicants were not necessarily limited to the type of marks or the way which the Office of origin may have defined or limited the type of mark.

329. The Chair opened the floor for comments on paragraphs 12 to 18 of the document on whether the Working Group should establish minimum representation requirements for each type of mark and on how the Working Group could accomplish that objective.

330. The Delegation of Switzerland favored introducing some flexibilities in the Office certification practice, as suggested in paragraph 15 of the document, or having minimum requirements. The Delegation also stated that it could not support the proposal that provided for the possibility for Offices of designated Contracting Parties to request additional reproductions after issuing a provisional refusal.

331. The Chair opened the floor for comments on paragraphs 19 to 25 of the document and encouraged delegations to inform on the amount of ICT work that may be required to implement changes to Rule 9 and on how long that might take.

332. The Delegation of OAPI stated that some Offices, including its Office, did not have an electronic filing system nor IPAS. The Delegation asked whether the International Bureau could assist Offices of the Contracting Parties so that they could receive that type of application.

333. The Chair invited the Secretariat to respond to the question raised by the Delegation of OAPI.

334. The Secretariat explained that WIPO colleagues dealing with IPAS could assist Offices on the matter raised by the Delegation of OAPI. The Secretariat stated that WIPO made available to Offices the Madrid E-Filing interface and noted that a presentation on that tool would be made during the Roundtable and that Offices already using the said interface would provide their feedback.

335. The Delegation of Australia highlighted that more and more Contracting Parties transmitted communications electronically to the International Bureau. Therefore, the Delegation suggested that the Working Group request the International Bureau to assess the changes it would need to make to its processes and IT systems to allow it to receive, examine and publish electronic or digital representations. The Delegation added that the International Bureau could report to the Working Group on that assessment at its following session and could provide guidance on the timing of the introduction of any amendments to Rule 9.

336. The Chair noted that no further delegations had requested the floor and suggested that the International Bureau prepared a document with proposed amendments to Rule 9 for the following session. That document could include the necessary flexibilities and take into account the different positions expressed by some of the delegations. The Chair added that the document could help clarify the role of the Office of origin and cover the practical IT infrastructure requirements not only for Offices but also for the International Bureau. The Chair opened the floor for comments on that proposal.

337. The Delegation of Germany supported the proposal made by the Delegation of Australia. The Delegation asked the Secretariat for an estimation of the timeframe of the International Bureau for receiving, examining and publishing those new means of representation.

338. The Delegation of Madagascar agreed with the proposal made by the Chair. The Delegation noted that the infrastructure needed, principally for Offices, would need to be defined. The Delegation further noted that the document could possibly propose new simplified IT solutions, depending on the level of the Office concerned.

339. The Representative of MARQUES welcomed the review of the Madrid System to allow non-traditional marks. The Representative highlighted that it was very important for MARQUES that the changing landscape of those marks and how the consumer perceived and interacted with those marks was reflected in the Madrid System. The Representative noted that it was in the interest of mark holders to have the ability to protect non-traditional marks in a harmonized manner through the Madrid System. The Representative stated that the results of the survey showed that the legal and technical positions in each Contracting Party was very variable. The Representative said that it would welcome a review of the international application form to ensure that it is clear that other types of marks were available, even though such marks may not be accepted in all Contracting Parties. The Representative also agreed that, ultimately, the graphical representation requirements should be removed. The Representative stated that the system and its IT solutions should be allowed to evolve to represent non-traditional marks, which would give maximum flexibility and protection for brand owners. The Representative noted that those were important first steps, but it emphasized, as some delegations had mentioned, that it had to be clear to applicants in which Contracting Parties non-traditional marks would be accepted. If the application form allowed for non-traditional marks to be filed and any Contracting Party to be designated, without a clear indication of whether the format for representing the mark or the mark was itself acceptable in the Contracting Party, applicants would designate Contracting Parties where their mark had no possibility of acceptance. The Representative said that such would be a waste of time and fees for applicants, and that it would also delay decisions by brand owners on how best to protect non-traditional marks when filing an international application designating multiple Contracting Parties. The Representative believed that this would undermine confidence in the Madrid System and mean that applicants would be reluctant to use the Madrid System for non-traditional marks.

340. The Chair invited the Secretariat to respond to the comments made by the Delegation of Germany.

341. The Secretariat said that a concrete timeline on when the International Bureau would be able to accept new means of representation could not be given at that time. The Secretariat mentioned that the matter needed further assessment and more information would be in the document to be discussed by the Working Group at its following session. However, the Secretariat did not foresee the matter to be overcomplicated for the International Bureau. The Secretariat reminded delegations of the existence of WIPO standards on various formats that were acceptable, which had been developed in the framework of the Committee on WIPO Standards (CWS). The Secretariat noted that it was not necessary to wait for the new document and more concrete information on when the International Bureau could change its infrastructure to accept different formats. Offices could begin making preparations to pave the way for more electronic exchanges and the acceptance of digital formats. There were WIPO standards already in place, including WIPO Standard ST.68 for sound marks, and WIPO Standard ST.67 for figurative elements of marks, that is, as digital still images. The Secretariat informed that the CWS was currently working on a standard for multimedia marks. The Secretariat encouraged delegations and their IT colleagues to look at those standards. The Secretariat said that, as suggested by some delegations and users' organizations, Offices should update their Madrid Member Profiles page to reflect the types of marks and means of representation that they currently accepted.

342. The Representative of CITMA supported the comments made by the Representative of MARQUES and noted its concern about how difficult it would be in practice for owners to have to go through the country profiles of the Madrid Member Profiles database to check whether graphical representation was required and what type of marks were acceptable. The Representative said that such a datamining exercise would be complex and that there was a risk that, in trying to make the system more flexible, the backlash could result in undermining the confidence in the Madrid System, which was quite the opposite of what the Working Group was trying to do. The Representative suggested, instead of adding footnotes to the MM2 form or updating the Madrid Member Profiles database, having a more streamline tool on the Madrid System website, like the Madrid Fee Calculator, to quickly check what was actually acceptable per Contracting Party.

343. The Working Group requested the International Bureau to prepare a document, for discussion at its next session:

- (i) proposing changes to Rule 9 of the Regulations providing for new means of representing marks and introducing the necessary flexibilities that would allow applicants to meet different representation requirements in the designated Contracting Parties;
- (ii) discussing the role of the Office of origin in the certification of the representation of the mark in the international application; and
- (iii) addressing the practical implications of the above-mentioned changes on the information and communication technology infrastructure of the Offices and of the International Bureau, as well as enhancing access to information regarding acceptable types of marks and representation requirements.

AGENDA ITEM 11: PROPOSAL BY SWITZERLAND

344. Discussions were based on document MM/LD/WG/17/9.

345. The Delegation of Switzerland presented the document and brought attention to a typo in page 14 that referred to changes to Rule 26. The Working Group was requested to ignore the suggested paragraph 4 of the said Rule.

346. The Delegation of Switzerland informed that its various proposals would be illustrated with additional drawings to provide some visual context. In terms of limitations it was implicit that the limitation of that scope had to be made in accordance with Rules 12 and 13 of the Common Regulations. The Delegation recalled that limitations had been discussed in previous sessions of the Working Group and that the only point that the Working Group seemed to agree on was that there was no solution to the important problems associated to the examination of limitation. Hence, the Delegation said that it wished to continue those discussions and had proposed possible solutions for the consideration of the Working Group. The aim of the proposal was to try to define the roles of the holder, the International Bureau, the Office of the Contracting Party of the holder and the Offices of the designated Contracting Parties to find a solution that responded to the needs of all, but above all, to the needs of the users while keeping a high quality International Register. The Delegation proposed to discuss the document in three parts rather than open the floor for general comments as that would allow more focus on the solutions. The Delegation pointed out that certain proposals went quite far but that the goal was to continue the discussions and find a pragmatic solution. The Delegation invited the Working Group to discuss the document and welcomed any comments, criticisms, proposals and support.

347. The Chair invited delegations to deliver general statements on the proposal.

348. The Delegation of Israel expressed concerns towards the fact that there were limitations recorded in the International Register that had never been examined by an Office or the International Bureau. The Delegation was of the opinion that, to maintain a reliable Madrid System with a high degree of legal certainty, the Working Group had to make progress on the discussions and reach an agreement that could be reflected in the Common Regulations.

349. The Delegation the European Union recognized and supported the ultimate aim of the proposal, which was to bring more clarity and transparency to the issue and improve the situation, which merited further reflection. The delegation appreciated the consensual spirit of the proposal, reflected in the endeavor to take into account various interests at stake in order to achieve a solution satisfactory to all parties. The Delegation agreed that the possible way forward could imply some adjustment of the legal framework and proposed that the Working Group continued working on the problem of limitations to find a solution that was acceptable to all. The Delegation said that the European Union and its member states remained open to discussions.

350. The Delegation of New Zealand shared its view that it should be solely the responsibility of the Office of the designated Contracting Party to examine all limitations. The Delegation said that it was concerned about the possible duplication of work across the Office of origin, the Office of the Contracting Party of the holder, the International Bureau and the Office of the designated Contracting Party and about the fact that it would require the International Bureau to carry out substantive examination, which may add complexity, delays and costs into the Madrid System. The Delegation suggested that, given that delegations were unable to reach a consensus during the Working Group, discussions could continue in a future session of the Roundtable.

351. The Delegation of Austria said that it would be constructive if each party involved, meaning the Office of the Contracting Party of the holder, the Office of the designated Contracting Party and the International Bureau, took on part of the task. The Delegation suggested that the International Bureau be involved in the examination process of limitations as much as possible, given its experience in notifying irregularities according to Rule 13.

352. The Delegation of China said that the Swiss proposal was pragmatic and would help clarify the subject. The examination of limitations to ensure that the limited goods and services fell within the scope of the initial list of goods and services would improve the Madrid System. However, the Delegation said it was concerned that some of the suggestions, particularly the

suggestion that the limitation be submitted through the designated Office, could make the system complicated. For example, if the applicant submitted an application through a designated Office, it would need the involvement of a local agent. Further, the Delegation wondered which Office should the applicant use if the limitation applied to several Contracting Parties. The Delegation said that in China, a request for limitation should reduce the list of goods and services. To avoid any misunderstanding about the goods and the services to be covered, the limitation should not alter the description of the original good and services. The limitation should only reduce the goods and services listed. The Delegation said that the Office that transferred that request did not have the obligation to examine the limitation.

353. The Delegation of Denmark fully supported the statement made by the Delegation of the European Union and recognized the issues raised in the Swiss proposal. The Delegation encouraged further work and discussions on the proposal and suggested it remain on the agenda of the following session of the Working Group, together with a discussion on cancellations where scope is not precise or unclear, or where the cancellation broadens the scope of protection of the international registration.

354. The Delegation of Australia shared similar concerns to those raised by the Delegation of New Zealand. The Delegation said it was of the view that the Office of the designating Contracting Party should examine all limitations. The Delegation had concerns with the International Bureau conducting substantive examination, as that would be a resource intensive proposal that would require the recruitment, training and possible modifications to the IT systems of the International Bureau. The Delegation mentioned that limitations were usually made to address or avoid issues in a relevant designated Contracting Party and could sometimes be time sensitive and, therefore, would avoid any change that would seek to add complexity or delays to the process. The Delegation also supported the proposal made by the Delegation of New Zealand for further discussions to take place in a future session of the Roundtable.

355. The Delegation of Austria supported the statement made by the Delegation of the European Union and favored discussing limitations in a future session of the Madrid Working Group and not in the Roundtable.

356. The Delegation of Japan recalled that, according to the survey results presented by the International Bureau at the previous session of the Working Group, most of the Offices of origin examined limitations in international applications and, therefore, it supported the proposal to amend Rule 9 to clarify the role of the Office of origin. On the other hand, the Delegation believed that allowing the submission of subsequent designations and limitations under Rule 25 through the Office of a designated Contracting Party might be complicated and confusing, since it could have a significant impact on the operations, national laws, and IT systems of each designated Office. Therefore, the Delegation said it was of the opinion that the proposal should be discussed very carefully, as to whether it was necessary or reasonable.

357. The Delegation of the Czech Republic supported the Swiss proposal and said it wished to continue discussions in the Working Group.

358. The Delegation of France supported the statement made by the Delegation of the European Union. It was clear from previous Working Group sessions that Offices needed to continue discussions on their roles in the examination of limitations. The Delegation recalled that there were three types of limitations and that it could be interesting to discuss one type at the time, beginning with limitations in international registrations, as there was already a similar practice in a number of Offices.

359. The Representative of INTA recalled that, in March 2018, INTA had submitted responses to the questionnaire prepared by the International Bureau on the issue of limitations for the previous session of the Working Group. The Representative recalled that, regretfully, no consensus could be achieved at that time but, as underlined by the Swiss proposal, problems remained and had to be addressed. Therefore, the Representative of INTA welcomed the initiative of the Delegation of Switzerland in identifying the problems and providing suggestions for their solution. In particular, regarding the role of the Office of Origin in the examination of the scope of a limitation of the goods and services contained in the application for international registration and regarding the central role of the International Bureau in controlling the proper classification of any list of goods and services.

360. The Delegation of the Republic of Korea said it was not in a position to support the proposal made by the Delegation of Switzerland because it was not efficient and pragmatic. The Delegation was of the view that the Office of origin should examine whether the limited list was covered by the main list. However, the Delegation did not agree that the Office of the designated Contracting Party should receive the limitation directly from applicants.

361. The Representative of MARQUES referred to its paper concerning all situations where a limitation might happen and who should be interested in examining that limitation. The Representative believed that limitations should be discussed in their specific context and looked forward to continuing the discussions.

362. The Delegation of the United States of America recalled that the Working Group had been discussing limitations for many years and that the International Bureau had issued a questionnaire in 2018 to discern the practices of national Offices on limitations. Despite all of those efforts, there had been no clear decision on who examined the scope of limitations. The Delegation believed that it should be the end of the debate. The proposal reiterated much of the prior proposals, which the Working Group could not agree on, and went further, as it appeared to propose that all three Offices examine limitations to some extent, which meant that workflows and processing times would be adversely impacted. It also proposed that limitations might be filed with the Offices of the designated Contracting Parties whereas, at that time, limitations were filed either with the Office of origin or with the International Bureau. The Delegation said it felt that the time and resources of the Working Group would be better spent on discussing other issues.

363. The Representative of the JPAA noted that the Swiss proposal included the possibility that the Office of origin, the International Bureau and the Office of the designated Contracting Parties duplicate examination of the limitation embodied in international applications, those included in subsequent designations and those requested as a change. Therefore, the Representative indicated that JPAA believed that further careful discussions were necessary, considering a possible prolongation of the procedures and leveling of efficiency. The Representative said it was also concerned about the possible increase in work and the economic burden of the International Bureau, since in all of the proposed options it was prescribed that the International Bureau should examine limitations.

364. The Delegation of Sweden supported the statement made by the Delegation of the European Union and reiterated its view that the Office of the designated Contracting Party should examine limitations in international registrations and, therefore, supported the statements made by the Delegations of Australia and New Zealand.

365. The Delegation of Germany supported the statement made by the Delegation of the European Union and shared its opinion that the subject had to be discussed further, especially, as many limitations in the International Register had never been examined and that situation could not remain. The Delegation recalled that many Offices of origin were already examining limitations in applications for international registration. However, it would be more important to clarify who should examine limitations in subsequent designations and limitations under

Rule 25, as there were not a lot of Offices of designated Contracting Parties examining them, which was a concern, as 78 per cent of subsequent designations and 97 per cent of limitations under Rule 25 were filed directly with the International Bureau. The Delegation reiterated that unexamined limitations could not be in the International Register.

366. The Delegation of Italy supported the statement made by the Delegation of the European Union and requested additional time to reflect on the contents of the proposal.

367. The Chair invited the Delegation of Switzerland to present the first part of the document.

368. The Delegation of Switzerland introduced the first part of the document on limitations in international applications under Rule 9. The Delegation explained that the majority of Offices of origin believed it was their duty, as part of the certification done under Rule 9(5)(d)(vi), to verify that the limited list was covered by the basic mark and by the main list of the international application. If that principle was widely accepted, the Delegation proposed that the Rule be amended to clearly reflect that principle. The International Bureau currently examined limitations in applications in accordance with Rule 12, for the classification of goods and services, and with Rule 13, for accuracy, although the latter was not envisaged under the Common Regulations. Therefore, the Delegation suggested amending the Common Regulations to include the obligation for the International Bureau to examine limitations according to Rule 13. The Delegation stated that the work of the International Bureau should go further and consider whether the scope of limitation was acceptable or covered by the main list of the international application. The objective of that examination should be to avoid the recording of gross errors, as that might happen even if the Office of origin had certified the application. That examination might also aim at promoting the harmonization of interpretations and practices. In any event, the irregularity notices issued by the International Bureau based on Rule 13 would have to be consulted with the Office of origin. Regarding the Office of the designated Contracting Party, the Delegation said it was of the view that there was no need for a specific provision requiring such examination, as this should be the role of the Office of origin. By way of example, the Delegation displayed an illustration and described an application that had shoes in the main list and socks in the limited list. The Office of origin would in that case receive the application and refuse the limitation for socks. Then, the application would be transferred to the International Bureau, which would also examine the limited list to check whether there were gross errors not spotted by the Office of Origin.

369. The Delegation of Belarus supported further discussions on limitations. The Delegation fully supported the proposal made by the Delegation of Switzerland concerning the role of the Office of origin. The Office of origin should determine whether the limitation was a limitation or an expansion of the main list. The Delegation stated that the majority of Offices believed that it was the role of the Office of origin to examine limitations. Therefore, the Delegation proposed amending Rule 9(5)(d)(vi) of the Common Regulations to read as follows: "where applicable, the goods and services indicated in any limitations are covered by the list of goods and services indicated in the main list of the international application". The Delegation said that such amendment would make the provision clearer and in line with the proposed amendments to Rule 13. Regarding the examination of limitations in international applications by the International Bureau, the Delegation said it understood the fears of the Delegation of Switzerland regarding gross errors, but it was hesitant about making that the duty of the International Bureau as that would make the process of registering an international application longer. Regarding the role of the Office of the designated Contracting Party, the Delegation of Belarus fully supported the Swiss proposal.

370. The Chair invited the Delegation of Switzerland to present the second part of the document.

371. The Delegation of Switzerland introduced the next part of the document regarding limitations in subsequent designations. The Delegation pointed out that a subsequent designation that contained a limitation could be presented to the Office of the Contracting Party of the holder and that some of those Offices examined it while others did not. Then, the request was sent to the International Bureau, which did not look at the scope of the limitation. Once recorded in the International Register, the subsequent designation was notified to the Office of the designated Contracting Party, which might have the legal basis to refuse a limitation or not. A subsequent designation, that contained a limitation, could also be presented directly to the International Bureau, which did not examine it and the subsequent designation was notified to the Office of the designated Contracting Party, which again, might have the legal basis to examine a possibly broader subsequent designation or not. The Delegation clarified that the aforementioned procedures were based on its understanding of the current situation and after seeing that there were a number of subsequent designations containing broad limitations recorded in the International Register. To respond such problems, the Delegation further explained its proposed solutions as follows: (i) a subsequent designation which includes a limitation could be presented through the Office of the Contracting Party of the holder, if that Office accepted to receive such requests; the Office must then examine the limitation before sending it to the International Bureau. The International Bureau would have to examine such designation and would have the last say. Once recorded in the International Register, the subsequent designation would be notified to the Offices of the designated Contracting Parties, which might have the legal basis to examine the scope of the limitation or not; (ii) a subsequent designation which includes a limitation could be also be presented to the International Bureau directly. In those cases, the International Bureau would have to examine the scope of the limitation. Then, the subsequent designation would be notified to the Office of the designated Contracting Party, which might have the legal basis to refuse a limitation considered too broad or not. The last proposal (iii) concerned situations where the holder presented a limited subsequent designation because there was a problem in a specific designated Contracting Party. The Delegation considered that proposal a bit different as, in those cases, the subsequent designation of only one Contracting Party that included a limitation could be presented directly before the Office of that Contracting Party, which would verify the formalities, including the scope. If the conditions were met, particularly regarding the scope, the Office would send it to the International Bureau. The International Bureau would undertake a small examination to avoid any gross errors, and then it would be sent back to the Office of the designated Contracting Party for examination. At that stage the Office would then examine it as usual, for relative or absolute grounds, but the scope would have already been examined at the time it was received. The Delegation clarified that the last option would only concern subsequent designations that designated a single Contracting Party. Where the subsequent designation was for more than one Contracting Party, it should be presented directly to the International Bureau.

372. The Chair invited the Delegation of Switzerland to present the third part of the document.

373. The Delegation of Switzerland introduced the third part of the document regarding limitations under Rule 25 of the Common Regulations. The Delegation noted that a limitation under Rule 25 could be submitted to the Office of the Contracting Party of the holder. Some of those Offices examined the scope of the limitation while others did not. Then, the limitation was sent to International Bureau, which did not examine the scope of the limitation. The limitation was then notified to the Offices of the designated Contracting Party, who might have the legal basis to refuse the limitation or not. Some Offices would consider the scope of the limitation and could declare that the limitation had no effect under Rule 27; some did not. However, in the previous year a number of delegations mentioned their Offices did not make use of Rule 27. Similarly, the limitation might be presented directly to the International Bureau, which did not examine the scope of the limitation and notified the Office of the designated Contracting Party that might make use of Rule 27, or not. The Delegation proposed that a limitation presented to the Office of the Contracting Party of the holder be examined by that Office to determine whether it fell within the main list of the international registration before it was sent to the

International Bureau. The International Bureau should again look at it to verify that it was acceptable. Then, the Office of the designated Contracting Party would be notified and might examine the limitation and apply Rule 27 or not. The Delegation acknowledged that its proposal would involve a duplication of work but reminded delegations that, under the current situation, the Office of origin reviewed and certified the international application, then the International Bureau checked the application under Rules 12 and 13, and then, sometimes, it was examined by the designated Office; so, redundancy already existed in another context within the Madrid System. The Delegation said another possibility would be to present the limitation under Rule 25 directly to the International Bureau, which would then be obliged to carry out an examination of the scope of the limitation before sending it to the Office of the designated Contracting Party. The Office of the designated Contracting Party could then carry out examination under Rule 27. However, the Delegation explained that applying Rule 27 was a complicated process that was not always applicable and, therefore, its Office avoided using Rule 27 whenever possible. The Delegation noted that a third possibility would be to present the limitation that applied to the designation of a particular Contracting Party directly to the Office of that particular Contracting Party. That Office would then examine the scope of the limitation. The goal would be to respond to the need expressed by many delegations on previous several occasions that, ultimately, a limitation according to Rule 25 was aimed at solving a problem in a given Contracting Party. It would be better for the Office concerned to look at the limitation and, in those cases, the examination would be done beforehand and only when acceptable would then the request for limitation be sent to the International Bureau. Then, the International Bureau would examine again to avoid any gross errors. The International Bureau would notify the Office of the designated Contracting Party, which would examine it again under its usual practice. However, if the limitation applied to many designated Contracting Parties there would be no reason to use one particular Contracting Party directly and, therefore, it should be presented to the International Bureau in such cases. The Delegation concluded by reminding delegations that there were many limitations recorded in the International Register that had never been examined. It had proposed a number of solutions and explained that it had tried to ensure that not too many Offices examine the scope of a limitation and that the process be streamlined. The current situation allowed for a certain number of holders to present a request for the same limitation for 10 or more Contracting Parties and each of those Offices carried out examination that could result in 10 different conclusions as regards to the scope. The objective was to clarify and find solutions for the examination of limitations. Accordingly, the Delegation suggested that the Working Group request the International Bureau to include the examination of limitations in the agenda of the following session of the Working Group, starting with the limitation in international applications, then with limitations in subsequent designations and limitations under Rule 25, as suggested by the Delegation of France.

374. The Chair opened the floor for further comments.

375. The Delegation of Germany supported the statement made by the Delegation of France to start with the scope of limitations in an international application because there seemed to be consensus on that aspect. The Delegation reminded that the other two situations were even more important as the limitations were not examined at all.

376. The Chair noted the support to continue the discussions on the proposal made by the Delegation of Switzerland at the following session of the Working Group in relation to limitations in international applications. The Chair opened the floor for further comments on that proposal.

377. The Delegation of Switzerland requested flexibility, depending on the agenda for the following session, to not confine the discussion to limitations in international applications but to also discuss other kinds of limitations.

378. The Chair explained that the Swiss proposal, in general, would remain on the agenda for the following session and that the Summary by the Chair would note that the first discussions would be on of limitations in applications for international registrations.

379. The Delegation of Belarus proposed the Secretariat to invite delegations to propose or comment on all kinds of limitations, particularly, on limitations in subsequent designations and limitations under Rule 25 because it was also important to make progress in those two areas.

380. The Working Group agreed to continue discussions on document MM/LD/WG/17/9, at its next session, focused on, but not limited to, the examination of limitations made in international applications.

AGENDA ITEM 12: PROPOSAL BY THE DELEGATIONS OF ALGERIA, BAHRAIN, EGYPT, MOROCCO, OMAN, SUDAN, THE SYRIAN ARAB REPUBLIC AND TUNISIA

381. Agenda items 9 and 12 were discussed together (see paragraphs 221 to 301, above).

382. Discussions on Agenda item 12 were based on document MM/LD/WG/17/10.

383. The Working Group took note of the proposal contained in the document and referred to its decision under Agenda item 9 in this regard.

AGENDA ITEM 13: SUMMARY BY THE CHAIR

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

AGENDA ITEM 14: CLOSING OF THE SESSION

385. The Chair closed the session on July 26, 2019.

[Annexes follow]

AMENDMENT TO RULE 21 OF THE REGULATIONS UNDER THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

**Regulations Under the Protocol Relating to the Madrid Agreement
Concerning the International Registration of Marks**

(as in force on February 1, 2021)

[...]

Rule 21

*Replacement of a National or Regional Registration
by an International Registration*

(1) [Request and Notification] From the date of the notification of the international registration or of the subsequent designation, as the case may be, the holder may present directly to the Office of a designated Contracting Party a request for that Office to take note of the international registration in its Register, in accordance with Article 4bis(2) of the Protocol. ~~Where, in accordance with Article 4bis(2) of the Protocol following the said request, 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 or registrations, as the case may be, has ~~have~~ been replaced by an ~~the~~ 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 or registrations which ~~has~~ have 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 or registrations, ~~in a form agreed between the International Bureau and the Office concerned.~~

(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.

(3) [Further Details Concerning Replacement] (a) Protection to the mark that is the subject of an international registration may not be refused, even partially, based on a national or regional registration which is deemed replaced by that international registration.

(b) A national or regional registration and the international registration that has replaced it shall be able to coexist. The holder may not be required to renounce or request the cancellation of a national or regional registration which is deemed replaced by an international registration and should be allowed to renew that registration, if the holder so wishes, in accordance with the applicable national or regional law.

(c) Before taking note in its Register, the Office of a designated Contracting Party shall examine the request referred to in paragraph (1) to determine whether the conditions specified in Article 4*bis*(1) of the Protocol have been met.

(d) The goods and services concerned with replacement, listed in the national or regional registration, shall be covered by those listed in the international registration.

(e) A national or regional registration is deemed replaced by an international registration as from the date on which that international registration takes effect in the designated Contracting Party concerned, in accordance with Article 4(1)(a) of the Protocol.

[Annex II follows]

**AMENDMENTS TO THE REGULATIONS UNDER THE PROTOCOL RELATING TO THE
MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS**

**Regulations Under
the Protocol Relating to the Madrid Agreement
Concerning the International Registration of Marks**

(as in force on February 1, 2020)

[...]

**Chapter 5
Subsequent Designations; Changes**

[...]

*Rule 25
Request for Recording*

[...]

(4) *[Several Transferees]* Where the request for the recording of a change in the ownership of the international registration mentions several transferees, each of them must~~that change may not be recorded in respect of a given designated Contracting Party if any of the transferees does not~~ fulfill the conditions under Article 2 of the Madrid Protocol to be holder of the international registration~~in respect of that Contracting Party~~.

[...]

*Rule 27bis
Division of an International Registration*

[...]

(3) *[Irregular Request]* (a) If the request does not comply with the applicable requirements specified in paragraph (1), 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~~amount of the fees received is less than the amount of the fees referred to in paragraph (2), the International Bureau shall notify accordingly the ~~Office that presented the request~~holder, ~~it shall inform and~~ at the same time inform the ~~holder and refund any fee paid under paragraph (2), after the deduction of an amount corresponding to one-half of that fee~~Office that presented the request.

(c) If the irregularity is not remedied within three months from the date of the communication under subparagraph (a) or (b), 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.

[...]

[...]

Chapter 6 Renewals

[...]

Rule 30 Details Concerning Renewal

(1) *[Fees]* (a) [...]

[...]

(c) Without prejudice to paragraph (2), where a statement under Rule 18ter(2) or (4) has been recorded in the International Register for a Contracting Party in respect of which payment of individual fee is due under subparagraph (a)(iii), the amount of that individual fee shall be established taking into account the goods and services included in the said statement only.

(2) *[Further Details]* (a) [...]

(b) Where the holder wishes to renew the international registration in respect of a designated Contracting Party notwithstanding the fact that a statement of refusal under Rule 18ter is recorded in the International Register for that Contracting Party in respect of all the goods and services concerned, payment of the required fees, including the complementary fee or individual fee, as the case may be, for that Contracting Party, shall be accompanied by a statement by the holder that the renewal of the international registration is to be recorded in the International Register in respect of that Contracting Party for all the goods and services concerned.

(c) The international registration shall not be renewed in respect of any designated Contracting Party in respect of which an invalidation has been recorded for all goods and services under Rule 19(2) or in respect of which a renunciation has been recorded under Rule 27(1)(a). The international registration shall not be renewed in respect of any designated Contracting Party for those goods and services in respect of which an invalidation of the effects of the international registration in that Contracting Party has been recorded under Rule 19(2) or in respect of which a limitation has been recorded under Rule 27(1)(a).

~~(d) [Deleted] Where a statement under Rule 18ter(2)(ii) or (4) is recorded in the International Register, the international registration shall not be renewed in respect of the designated Contracting Party concerned for the goods and services that are not included in that statement, unless payment of the required fees is accompanied by a statement by the holder that the international registration is to be renewed also for those goods and services.~~

~~(e) The fact that the international registration is not renewed under subparagraph (d) in respect of all the goods and services concerned, shall not be considered to constitute a change for the purposes of Article 7(2) of the Protocol.~~ The fact that the international registration is not renewed in respect of all of the designated Contracting Parties shall not be considered to constitute a change for the purposes of Article 7(2) of the Protocol.

[...]

Chapter 9
Miscellaneous

[...]

Rule 40
Entry into Force; Transitional Provisions

[...]

(6) *[Incompatibility with National or Regional Laws]* If, on the date this Rule comes into force or the date on which a Contracting Party becomes bound by the Protocol, paragraph (1) of Rule 27*bis* or paragraph (2)(a) of Rule 27*ter* are not compatible with the national or regional 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 Protocol. This notification may be withdrawn at any time.

[...]

[Annex III follows]



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

Dix-septième session
Genève, 22 – 26 juillet 2019

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

Seventeenth Session
Geneva, July 22 to 26, 2019

LISTE DES PARTICIPANTS
LIST OF PARTICIPANTS

établie par le Secrétariat
prepared by the Secretariat

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* Le 2 juillet 2019, le Gouvernement du Brésil a déposé son instrument d'adhésion au Protocole relatif à l'Arrangement de Madrid concernant l'enregistrement international des marques. Le Protocole de Madrid entrera en vigueur à l'égard du Brésil, le 2 octobre 2019.

* On July 2, 2019, the Government of Brazil deposited its instrument of accession to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks. The Madrid Protocol will enter into force with respect to Brazil on October 2, 2019.

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