



## Seventeenth Session of the Madrid Working Group

*Geneva, July 22 to 26, 2019*

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

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

More information about **MARQUES** and its initiatives is available at [www.marques.org](http://www.marques.org).

In preparation of the Madrid Working Group meeting, **MARQUES** would like to make the following statements as per the agenda.

### **MM/LD/WG/17/2. Replacement**

**MARQUES** supports the proposals put forward in document MM/LD/WG/17/2.

However, in line with our previous statements in relation to this topic, we believe that there should be an option of filing requests for recordal of replacement with the International Bureau of WIPO, including the ability for users to pay any replacement fees via a central mechanism at the International Bureau.

This is a vital element to improve the conditions for the user in the context of replacement. We believe that if a centralised filing option were made available, issues with filing replacement applications national office by national office and the lack of harmonised national procedures in the Contracting Parties would in essence disappear as users would find the centralised filing option more attractive and accessible.

We would like to take the opportunity to insist on this centralised filing option. Without it replacement will remain underused.

### **MM/LD/WG/17/5. Notification of Provisional Refusal – Time Limit to Reply and Ways in Which to Calculate that Time Limit**

**MARQUES** strongly supports resolving the issues faced by users of the system in responding to notifications of provisional refusal. In this respect, we agree with the position stated by the

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Delegation of the United Kingdom in a paper submitted for the Fifteenth Session of the Working Group (document MM/LD/WG/15/4).

It is very important for ease of use of the International Registration system and for confidence in the operation of the system that users get prompt notification of issues affecting their applied-for rights and a clear indication of the time available for these issues to be dealt with. Anything less compromises the fairness and accessibility of the system.

As a result, **MARQUES** strongly encourages the Working Group to make such changes as are necessary to ensure that:

1. as much as possible, there is harmonisation of time limits to respond to provisional refusals, and ideally this should be controlled by Regulation rather than left to the individual Contracting Party;
2. there should be speedy processing of provisional refusals both by the Contracting Parties and the International Bureau, and in particular this should be facilitated by electronic means of communication between all parties;
3. a clear statement of the date by which a response is required is included on all correspondence from the International Bureau. Without the exact date of the deadline being stated on the face of the correspondence, the possibility for error remains. This issue would not be resolved by a clearer statement of the date of notification and / or the method of calculating the response date. This is common practice amongst most Trade Mark Registries around the world and is an obvious way to improve confidence in the system.

We note that while harmonisation of the notification time limits is ideal, to avoid either the very short and / or non-extendable deadlines that exist now, having a clear indication of the required response date will solve many problems in handling the deadlines by applicants and their representatives.

#### **MM/LD/WG/17/6 Possible Reduction of the Dependency Period**

**MARQUES** remains in favour of the abolishment of the requirement for a basic mark.

We have previously given our input to the other ways to improve the Madrid system, including the reductions of the dependency period, cf. our paper of 3rd June 2016 MM/LD/WG/14/MARQUES.

We have studied the possible ways forward in document MM/LD/WG/17/6, and we are supportive of all these proposals being given due consideration. As the options are not all to be implemented simultaneously, we would like to give the following priorities to these:

1. We prefer seeing a total abolition of the principle of dependency. It does not relieve the applicant from having the obligation to file a basic mark nor does it give the applicant the

opportunity to designate his/her home market, but it does remove the threat of central attack, and it would be our preferred choice. In our view, central attack is often an overreaching and disproportionate response to an issue or conflict that in many instances is just pertaining in one territory.

2. Our second choice would be the freezing of the dependency period. The reasoning that we put forward at the 12th session of the Working Group remains the same, including the uncertainty for 5 years of central attack or of a rejection from the basic mark office.

3. As our third choice, if the above two options are not selected, we would support the reduction of the dependency period. We previously argued for a reduction to two years, but based on discussions at previous meetings and the fact that several countries have a 3-year use requirement, we would be in agreement if the dependency period was reduced to 3 years.

The remaining possible ways forward could very well be combined with a reduction of the dependency period. We believe that both options, Reduction of the Grounds as well as Elimination of the Automatic Effect of Dependency, could be introduced at the same time as a reduction of the 5 years to 2 years or 3 years.

In conclusion we prefer complete abolishment, freezing and then reduction together with the last two ways forward in that order. If abolishment is not agreed upon then we must insist upon a reduction in dependency.

#### **MM/LD/WG/17/7 Introduction of New Languages**

**MARQUES** is very supportive of the possibility of introducing new languages to the Madrid System. In general, we support the ability of all brand owners and users to access the system, and providing them the ability to do this in their "home" language is an important part of this.

However, we are concerned to implement this in an effective and appropriate way, and so we do not consider that the time to do so is now. The reasons for this are:

1. the cost of implementation will be excessive, especially in light of the fact that translation technology will likely improve dramatically over the next few years, reducing both the issue of translation errors and the cost of implementation;
2. the risk of error, particularly when using a "relay" language is significant. Errors in translation can affect the scope of protection of a right, and we have already anecdotally been aware of differences in this respect in relation to Spanish translations as understood between Castilian and Mexican Spanish. There is a large program of work to undertake to standardise and harmonise specification practice before this can be properly implemented; and
3. the Madrid System has a number of important projects and issues to address, before it takes on another significant project. In particular, **MARQUES** is concerned at pendency times, particularly in relation to corrections. A project of this magnitude – as introducing new

languages can be - is likely to increase, not reduce errors and pendency times at the International Bureau.

In addition, we already see that a number of countries where the "home" language is not one of the working languages of the Madrid system have a large number of applications, so the lack of a working language is not, in our view, posing an automatic bar to applicants from those countries using the system.

We do however strongly support the option for applicants whose mark is in a non-Latin script to be able to access and use the system appropriately, with equivalent transliterations of the mark being considered identical for the purposes of filing designations of the mark in another, locally appropriate, language (see our paper of June 2018 for the 16th session of the Working Group MM/LD/WG/16/MARQUES/1).

**MM/LD/WG/17/8 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**

**MARQUES** welcomes the review of the Madrid system to allow non-traditional marks, and the proposed amendments are an integral part of this review. It is important that the changing landscape of trade marks and how consumers perceive and interact with them is reflected in the Madrid system, and it is in the interests of brand owners to have the ability to protect non-traditional marks in a harmonised manner also through the Madrid system.

We understand from the results of the survey on non-traditional marks that the current legal and technical position in each Contracting Party is highly variable. **MARQUES** agrees that we need to review the current application form to ensure it is clear that other types of marks are available (although noting that currently such marks may not be accepted in all Contracting Parties). **MARQUES** also agrees that ultimately the graphical representation requirement should be removed to allow adaptation of the system to the evolution of IT-solutions for representing brands, including non-traditional marks and in this way maximum flexibility and protection for brand owners.

While these are important first steps, it must be clear to applicants in which Contracting Parties non-traditional marks will be accepted. If the application form allows for non-traditional marks to be filed, and any Contracting Party to be designated, without a clear indication of whether either the format for transmission of the mark is acceptable or the mark itself is acceptable in that Contracting Party, applicants will designate countries where their mark has no possibility of acceptance. This will both waste time and fees of applicants, as well as potentially delaying decisions around how best to protect non-traditional marks in multi-country filing programs. This could undermine confidence in the system and effectively mean that applicants are reluctant to use the Madrid system for non-traditional marks at all.

**MM/LD/WG/17/9. Proposal by the Delegation of Switzerland**

**MARQUES** would like to propose that we look at limitations in the precise context of when the limitation is requested. We believe that this approach will make it easier for the Madrid Working Group members to properly review and decide who should be responsible for the examination of the limitation, in view of the fact that there is unclarity about who will be responsible for the examination. While understanding that the below may already reflect the responsibilities today, we propose the following roles:

1. Limitation of the list for the entire IR at the filing time

Examination done by WIPO

2. Limitation of the list in a specific designation at the filing of the IR

Examination done by the Office in the designated contracting party

3. Limitation of the list in connection with the examination of the designation

Examination done by the Office in the designated contracting party

4. Limitation of the list for the entire IR at the renewal time

Examination done by WIPO

If there are designations with lists that were different from the IR list, WIPO will send the limitation upon renewal to these Offices who will examine that limitation

5. Limitation of the list for a specific designation at the renewal time

Examination done by the Office in the designated contracting party

6. Limitation of the list for the entire IR as a result of e.g. an agreement

Examination done by WIPO

If there are designations with lists that are different from the IR list, WIPO will send the limitation to these Offices who will examine the limitation

7. Limitation of the list for a specific designation as a result of e.g. an agreement

Examination done by the Office in the designated contracting party

8. Limitation of the list for a specific designation in connection with a subsequent designation

Examination done by the Office in the designated contracting party

9. Limitation of the list for the entire IR as a result of partial cancellation

Examination done by WIPO

If there are designations with lists that are different from the IR list, WIPO will send the limitation to these Offices who will examine the limitation

10. Limitation of the list for a specific designation as a result of partial cancellation

Examination done by the Office in the designated contracting party

11. Limitation of the list as a result of renunciation

Examination done by WIPO

If there are designations with lists that are different from the IR list, WIPO will send the limitation to these Offices who will examine the limitation

We would like to take the opportunity to point out a pre-condition to resolving many of these questions of limitation examination. If Contracting Parties which have ratified the Nice Treaty implemented a practice that harmonised the application of the Nice Classification to the letter, the work involved for all parties would be much reduced. In fact, it would enable the International Bureau to be responsible for all examination of lists of goods and services, and it would significantly reduce the difficulties that brand owners face when registering trade marks around the globe.

**MARQUES** looks forward to participating in the Madrid Working Group meeting. We gladly remain at disposal for any clarifications that may be requested on our proposals over the course of our participation.

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Submitted by **MARQUES** International Trade Mark Law and Practice Team on behalf of

**MARQUES** the European Association of Trade Mark Owners