



## **Eighteenth Session of the Madrid Working Group**

*Geneva, 12-16 October 2020*

**MARQUES** is the European Association representing brand owners' interests. **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).

In preparation of the forthcoming Madrid Working Group meeting, **MARQUES** would like to make the following statements as per the original agenda, though we took note that due to a reduction adopted in the timetable, the assessment of documents MM/LD/WG/18/6 "Provisional Refusal", MM/LD/WG/18/7 "Dependency" and MM/LD/WG/17/9 "Proposal by the Delegation of Switzerland" will be postponed for discussion at the Nineteenth Session of the Working Group in 2021.

### **1. [MM/LD/WG/18/2 REV.](#) - Proposed Amendments to the Regulations Under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks**

**MARQUES** supports the proposals in document [MM/LD/WG/18/2 REV.](#) to improve the speed and ease of appointing representatives, communicate electronically with holders, and to ensure holders are protected against failure to meet deadlines in situations like the current global pandemic. In addition, **MARQUES** is in support of ensuring all communications between the holder, International Bureau and national Offices be in electronic format, to improve the speed and reliability of such communications. In particular, **MARQUES** notes that some Contracting Parties may be reluctant to incur the expense of sending hard copies of bulky documents such as evidence to the International Bureau, and some Contracting Parties still operate paper-based systems which may result in communication delays. **MARQUES** supports the harmonisation and efficiency of communications throughout the system.

### **2. [MM/LD/WG/18/3](#) - New Means of Representation**

**MARQUES** welcomes the review of the Madrid system to allow non-traditional marks, and the proposed amendments are an integral part of this. 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 through the Madrid system.

**MARQUES** supports the proposals to remove the requirement for graphic representation and to allow the electronic transmission and flexible representation of non-traditional marks as important first steps towards the improvement of the system in this regard. **MARQUES** agrees that we need to amend 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).

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. The proposal to allow different representations of marks to overcome problems of differing formats of representation is an insufficient response to this issue. **MARQUES** urges further harmonisation on means of representation of non-traditional marks, and clear guidance to users as to where and in what form non-traditional marks are accepted. Without this, brand owners' confidence in the system will be lowered and could mean that applicants are reluctant to use the Madrid system for non-traditional marks at all.

### 3. [MM/LD/WG/18/4](#) - Partial Replacement

**MARQUES** supports the proposals put forward in document [MM/LD/WG/18/4](#)

It is clear that the purpose of replacement is to allow users to streamline the management of their trade mark portfolios, and is therefore of value to brand owners. Clarifying that partial and total replacement is possible will encourage greater use of replacement by brand owners.

However, in line with our previous statements in relation to this topic, **MARQUES** believes 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.

### 4. [MM/LD/WG/18/5](#) - Study of the Cost Implications and Technical Feasibility of the Gradual Introduction of the Arabic, Chinese and Russian Languages into the Madrid System

**MARQUES** is 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 do not consider that the time to do so is now. The reasons for this are:

- the cost of implementation will be excessive. During the current global economic uncertainty, a prudent approach should be adopted.

- 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 the Spanish translations as understood between the different Spanish speakers such as the Spanish from Spain or Spanish from Mexico. Arabic translations and transliterations also cause issues. There is a large program of work to undertake to standardise and harmonise specification practice before this can be properly implemented. Direct translation, would, therefore, be the preferred approach to minimise the risk of errors; and

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

In light of the fact that translation technology will improve over the next few years the project should be reviewed again in 5 years to examine updates in translation technology.

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 anyhow 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 16<sup>th</sup> session of the Working Group [MM/LD/WG/16/MARQUES/1](#)).

## 5. [MM/LD/WG/18/6](#) - Provisional refusal

**MARQUES** refers to the Joint Statement submitted on this topic by **MARQUES** and other sister organisations, that include – as we write – **AIM, APRAM, CITMA** and **ECTA** as co-signatories.

## 6. [MM/LD/WG/18/7](#) - Dependency

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

We have previously provided our input as to other ways to improve the Madrid system, including the reductions of the dependency period, cf. our paper of 3<sup>rd</sup> June 2016 **MM/LD/WG/14/MARQUES** and 19<sup>th</sup> July 2019 **MM/LD/WG/17/MARQUES**.

We agree that the dependency principle, in its current form, creates a strong imbalance which favours the interests of third parties over the rights holders.

We have studied possible ways forward set forth in document [MM/LD/WG/18/7](#). In view of the discussion at previous meetings and the difficulty in reaching a solution, we would like to offer the following input to the proposed options for moving forward:

1. We are in favour of a combination of the reduction of the dependency period and a limitation of the grounds for cancellation.
2. We support the reduction of the dependency period from five to three years.

We commend the highlighting of the issues with trade marks in a script different than the one used in the home territory and refer to our paper addressing this issue, **MM/LD/WG/16/MARQUES/1**.

3. We support the reduction of the grounds for cancellation, so that the use of central attack is not an "over reach" of the cancellation applicant's rights. As stated in paper [MM/LD/WG/18/7](#), while a third party may have the right to cancel a basic mark, they may not have a right to cancel in each of the designation countries. Hence, any dependency on the basic mark has the possibility to grant to the applicant for cancellation an unwarranted advantage over the International registration right holder. Reduction of the grounds for cancellation will serve to increase the legal certainty for rights holders, at the same time bringing a balance between the rights of the International registration right holder and the rights of the applicant for cancellation.

As we noted that the analysis of Dependency has been postponed for discussion at the 19<sup>th</sup> Session of the Madrid WG in 2021, we reserve to submit our further proposals on the topic of limitation of the cancellation grounds for reducing the effect of dependency on the basic mark, ahead of next year's meeting.

## 7. [MM/LD/WG/17/9](#) - Proposal by the Delegation of Switzerland

On May 1, 2020, the Delegation from Switzerland proposed an amendment to the Common Rules with respect to limitations to an international application or registration ("IR").

**Proposal from MARQUES**

**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 to properly review and decide who should be responsible for the examination of the limitation. While understanding that the below may already reflect the responsibilities today, **MARQUES** proposes the following roles:

Nature of Limitation Examined	WIPO	Office of Origin	Designated Office
Limitation at the filing of the IR	√		
Limitation of list in a specific designation at the filing of the IR			√
Limitation of list in connection with the examination of the designation			√
Limitation of list for the entire IR at renewal	√		If there are designations with lists different from the IR list, WIPO sends to designated offices for examination
Limitation of list for a specific designation at renewal			√
Limitation of list for the entire IR as a result of e.g. an agreement	√		If there are designations with lists different from the IR list, WIPO sends to designated offices for examination
Limitation of list for a specific designation as a result of e.g. an agreement			√
Limitation of list for a specific designation in connection with a subsequent designation			√
Limitation of the list for the entire IR as a result of partial cancellation	√		If there are designations with lists different from the IR list, WIPO sends to designated office for examination
Limitation of list for a specific designation as a result of partial cancellation			√

Limitation of list as a result of renunciation	√		If there are designations with lists different from the IR list, WIPO sends to designated office for examination
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We take this opportunity to point out the obvious. If all Contracting Parties that have ratified the Nice Treaty implemented a practice harmonising the application of the Nice Classification to the letter, the work involved for all parties would be much reduced. **MARQUES** strongly supports progress towards harmonisation of specification practice. In fact, WIPO could become responsible for examination of all lists of goods and services, and it would significantly reduce the difficulties that brand owners face when registering trade marks around the globe.

**Summary of Amendments proposed by the Swiss Delegation**

**MARQUES** understands that the proposal from the Delegation in Switzerland states that whether a limitation falls within the scope of an International registration is incumbent on the Office of Origin to address during the certification process.

WIPO must also review any limitation within the International application or registration to ensure it falls within the specification set out in the International application or registration. This is to cover off any errors conducted by the Office of Origin in the certification process.

If an error is found, WIPO must issue a notice of irregularity to the Office of Origin and the owner of the International application/registration asking for a correction or deleting the term(s) within a three-month time frame. Where no response is provided to the irregularity, WIPO would delete the term. Where a response is provided but not acceptable to WIPO and the Office of Origin has specified the class of goods/services, WIPO shall include a note specifying that in its opinion the limitation remains broader than the specification of goods/services than in the International application/registration.

The proposal envisions any designated Office would not have the power to issue a provisional refusal for this issue.

**MARQUES Comments**

**MARQUES** strongly supports the aim of improving certainty in the examination of limitations, as well as ensuring the prompt and accurate prosecution of rights. In that respect, **MARQUES** appreciates the proposal from the Delegation of Switzerland to bring clarity to this situation. However, **MARQUES** would like to discuss the specifics of the proposal.

1. The aim of the proposal is to provide certainty around the examination of limitations; however, the use of the term “where applicable” in the proposed amendments to Rules 9 and 13 suggest that this process of examination is not applicable at all times but only during certain unspecified scenarios and may lead to some confusion among the various parties involved in the process.
2. **MARQUES** is of the view that there should not be any duplication of effort across the examining entities in the registration process, so as not to lead to inconsistencies or delays, or to place the certification process conducted by the Office of Origin in doubt.
3. The placement of notes to indicate that the limitation may be broader than the specification of goods and services in the International registration may confuse the designated Contracting Party rather

than aid them and does not provide a firm resolution on the issue. **MARQUES** is of the view that the term should be deleted if no response is filed or if the response filed does not provide an acceptable resolution to the issue in WIPO's view.

4. As the designated Office will be engaging in some level of examination, it may be more efficient for the designated Office to be involved in reviewing this type of issue as well.

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

9 October 2020

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



## About **MARQUES**

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

**MARQUES** unites European and international brand owners across all industry sectors to address issues associated with the use, protection and value of IP rights, as these are essential elements of commerce, vital to innovation, growth and job creation, which ultimately enhance internal markets. Its current membership includes intellectual property rights owners and legal practitioners representing their intellectual property rights and interests, in more than 80 countries.

**MARQUES** is an accredited organisation before the European Union Intellectual Property Office (EUIPO), appointed observer at the EUIPO's Management Board and Budget Committee, an official non-governmental observer at the World Intellectual Property Organisation and a registered interest representative organisation (ID 97131823590-44) in the Transparency Register set up by the European Parliament and the European Commission.

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