ECTA COMMENTS ON LEGAL DEVELOPMENT OF THE MADRID SYSTEM FOR THE INTERNATIONAL REGISTRATION OF MARKS

I. INTRODUCTION

During the 23rd session of the Madrid Working Group, several issues were discussed that are expected to be further considered at the forthcoming 24th session.

These include, in particular, the possible introduction of a requirement for Offices of designated Contracting Parties to issue national or regional certificates of protection and renewal, the indication in Rule 18ter statements of the date of grant of protection and of the date from which any applicable use requirement starts, and the United Kingdom's proposal concerning partial renewals.

Regarding certificates, the Working Group agreed to continue the discussion and requested the International Bureau to further refine the proposal and conduct a survey among Offices and users of the Madrid System to assess the need for and practical advantages of such certificates in specific jurisdictions. As regards the indication of the date of grant of protection and of the start date of use requirements, no consensus was reached, with concerns raised by several delegations. The proposal on partial renewals, on the other hand, was generally well received, although further analysis is needed in relation to legal, operational, and IT implications.

II. EXECUTIVE SUMMARY

This document contains ECTA comments and suggestions on the following topics:

- possible introduction of a requirement for Offices of designated Contracting Parties to issue national or regional certificates of protection and renewal;
- indication of the date of grant of protection and of the starting date of use requirements;
- proposals by the United Kingdom concerning partial renewals.

ECTA wishes to contribute to these discussions from the perspective of users of the Madrid System, with a view to supporting solutions that enhance legal certainty, procedural efficiency, accessibility, and the practical value of the Madrid System for trademark holders and their representatives.

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III. COMMENTS

The proposed amendments concerning the issuance of certificates aim to strengthen the enforceability and practical usability of trademark rights obtained through the Madrid System by requiring the Offices of designated Contracting Parties to issue national or regional certificates when protection is granted and upon renewal of an

international registration (MM/LD/WG/23/2 - Proposed Amendments to the Regulations Under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks Introducing a Requirement to Issue a National or Regional Certificate). The proposal also includes a transitional period to give members sufficient time to adapt their national or regional legislation and administrative procedures.

ECTA supports the proposed amendment, considering that, in certain countries, certificates are essential for litigation, customs enforcement, and commercial transactions, while grants of protection are not considered valid means of proof of the existence of the corresponding right.

Noting that, during the discussion, delegates highlighted some practical limits of mandatory certificates (including, for example, the fact that mandatory issuance could be problematic in jurisdictions where certificates must be issued exclusively in local languages) ECTA would like to suggest, as a possible alternative, the introduction of a centralized request mechanism under which the holder or the recorded representative could ask, through the International Bureau, that the Office of a designated Contracting Party issues one of the following documents:

- a national or regional certificate of protection;
- a renewal certificate; or
- an official electronic extract with equivalent evidentiary value.

In ECTA's view, this mechanism would be a proportionate alternative to a fully automatic issuance requirement. It would meet practical needs in enforcement, customs recordals, licensing, due diligence, and commercial transactions, while reducing the administrative and IT burden for Offices that may not be ready to issue certificates automatically for all international registrations.

In order to be fully efficient and cost-effective for users, the request should be filed through WIPO, without requiring the appointment of a local representative before the designated Office. ECTA recognizes that a centralized request mechanism would generate some administrative and IT costs for the International Bureau, however, those costs could possibly remain lower than under a fully automatic issuance system, because certificates or equivalent official extracts would be generated only where there is an actual user need.

A request-based mechanism would therefore offer a balanced and proportionate solution: it would respond to the practical needs of holders and representatives while limiting the burden on both the International Bureau and the Offices of designated

Contracting Parties where the grant of protection is sufficient to prove the holder's rights.

ECTA would support further consideration of a cost-recovery model, provided that any fee is transparent and reasonable.

ECTA also supports the proposal to require statements of grant of protection under Rule 18ter to indicate both the date on which protection was granted and the date from which the use requirement begins (MM/LD/WG/23/3 - Other Proposed Amendments to the Regulations Under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks).

ECTA considers these two dates to be legally distinct. The date of grant of protection does not necessarily coincide in all countries with the date from which the period for use requirements, declarations of use, or vulnerability to non-use cancellation as calculated under national or regional law. Accordingly, Offices of designated Contracting Parties should provide both the date of grant of protection and the relevant start date for any applicable use requirement.

ECTA would also support a **standardized "use requirement information field"** in Madrid Monitor showing, for each designation, the relevant information. To avoid placing an excessive burden on the International Bureau, responsibility for determining the relevant date should remain with the designated Office. The International Bureau's role should be limited to receiving, recording, publishing, and making that information available to the holder and the recorded representative through Madrid Monitor and other Madrid System tools.

ECTA considers that the indication of both dates should also address cases in which protection is granted only for certain classes, or in which different classes obtain protection at different stages. In those situations, a single date for the designation may be misleading. Offices should therefore indicate the relevant grant date and the relevant use requirement start date for each class. ECTA considers that providing this information on a class-by-class basis would materially improve legal certainty for holders and representatives, particularly in relation to non-use cancellation, declarations of use, and portfolio management. It would also reduce the risk that users rely on a general grant date that does not accurately reflect the legal position of all goods and services covered by the designation.

With respect to partial renewals (MM/LD/WG/23/4 - Proposal by the Delegation of the United Kingdom), ECTA supports the approval of this proposal, as it would give

International Registrations holders a practical and cost-effective means of maintaining protection only where it is needed.

ECTA considers that the proposed reform should, as an initial step, permit partial renewals by Contracting Party and by whole class or classes. Conversely, the renewal of only part of a class, or of specific goods and services within a class, should remain governed by the rules on limitation, given that such requests may require further examination by the designated Offices.

In ECTA's view, a carefully designed partial renewal mechanism would improve the efficiency and attractiveness of the Madrid System, avoid unnecessary renewals, reduce costs for users, and align the system more closely with the practical management of trademark portfolios.

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ECTA, which was formed in 1980, is an organisation concerned primarily with intellectual property matters. ECTA has over 1,300 members, coming from all the Member States of the EU, with associate Members from more than 50 other countries throughout the world.

ECTA brings together those practicing in the field of IP, in particular, trade marks, designs, geographical indications, patents, copyright and related matters. These professionals are lawyers, trade mark and patent attorneys, in-house lawyers concerned with IP matters, and other specialists in these fields.

The extensive work carried out by the Association, following the above guidelines, combined with the high degree of professionalism and recognised technical capabilities of its members, has established ECTA at the highest level and has allowed the Association to achieve the status of a recognised expert spokesman on all questions related to the protection and use of trade marks, designs and domain names in and throughout the European Union, and for example, in the following areas:

- Harmonization of the national laws of the EU member countries;
- European Union Trade Mark Regulation and Directive;
- European Union Design Regulation and Directive;
- Organisation and practice of the EUIPO.

In addition to having close links with the European Commission and the European Union Intellectual Property Office (EUIPO), ECTA is recognised by WIPO as a Non Government Organisation (NGO).

ECTA does also take into consideration all questions arising from the new framework affecting trade marks, including the globalization of markets, the explosion of the Internet and the changes in the world economy.