The Trusted Voice of Brand Owners

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Twenty-Fourth Session of the Working Group on the Legal development of the Madrid System for the International registration of Marks (MM/LD/WG/24)

Introduction

MARQUES is the European Association representing brand owners' interests in Europe and worldwide. It was established in 1986 and is incorporated in the UK as a not-for-profit company limited by guarantee. **MARQUES** is an official nongovernmental 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).

Further information about **MARQUES**, its mission, membership and initiatives can be found at www.marques.org.

MARQUES comments

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

MM/LD/WG/24/3 Proposed Amendments to the Regulations under the Protocol Relating to the Madrid agreement Introducing Requirements to Issue a National or Regional Certificate and to Indicate certain Relevant Dates in Statements Granting Protection

General Position

The document under consideration concerns proposed amendments introducing requirements to issue a national or regional certificate and to indicate certain relevant dates in statements granting protection.

MARQUES supports the proposed amendments requiring the issuance of a national or regional certificate upon the grant of protection of an international registration and the indication of relevant dates in statements granting protection. **MARQUES** considers these measures to be important steps towards enhancing legal certainty, improving transparency and facilitating the effective enforcement of trademark rights obtained through the Madrid System.

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While the Madrid System provides an efficient mechanism for obtaining trademark protection across multiple jurisdictions, practical difficulties continue to arise when rights holders seek to prove and enforce their rights at the national level. The proposed amendments address these challenges in a practical manner and would strengthen the value of the Madrid System for users.

National and Regional Certificates

MARQUES strongly supports the introduction of a requirement for designated Contracting Parties to issue a national or regional certificate following the grant of protection.

As acknowledged during previous discussions within the Working Group, the proposal is intended to enhance legal certainty and facilitate the enforcement of trademark rights.

In practice, trademark owners are frequently required to provide evidence of their rights before national courts, customs authorities and other administrative bodies. The absence of a national or regional certificate can therefore create unnecessary obstacles, delays and costs when rights holders seek to enforce their rights. Although a Statement of Grant of Protection and WIPO documentation provide evidence of protection, such documentation is not always recognised or accepted as readily as a certificate issued by the relevant national or regional office. Many users encounter practical difficulties because local authorities often more readily recognise locally issued documents in enforcement actions, customs procedures, business transactions and administrative processes. It is also easier for users to understand the status of their rights when a registration certificate is issued.

MARQUES believes that rights holders should be able to demonstrate the existence and scope of their rights easily and efficiently in every designated jurisdiction. The availability of a nationally or regionally issued certificate would significantly contribute to this objective and therefore, **MARQUES** supports the proposal requiring the issuance of national or regional certificates upon the grant of protection.

Renewal Certificates

MARQUES also supports extending a certification requirement to renewals of international registrations.

The need to provide proof of rights does not end once protection has been granted. In many cases, enforcement actions, customs measures, licensing negotiations, due diligence exercises, audits and commercial transactions can continue to occur many years after the initial grant of protection. In such circumstances, users must often demonstrate not only that protection was originally granted, but that it has remained valid and in force.

The considerations supporting the issuance of certificates following the grant of protection apply equally to renewed registrations. The availability of a national or regional renewal certificate would provide clear and readily recognizable means of demonstrating the continued validity of rights before local authorities and third parties.

MARQUES therefore supports the inclusion of renewal certificates within the proposed framework review, and for the sake of users' interests, provided that their issuance can be implemented in an efficient and largely automated manner.

Indication of the Relevant Use Requirement Date

MARQUES strongly supports to introduce a requirement for the IP Offices to clearly state both:

- the date of issuance of the Statement of Grant of Protection; and concurrently,
- the date from which the applicable use requirement period runs.

MARQUES considers it essential, that the relevant dates can be expressly indicated by the IP Office concerned and not left to trademark owners, practitioners, courts or third parties to determine and interpret for themselves.

Madrid System members apply use requirements under different legal frameworks, with significant variations regarding the commencement of the use period, applicable grace periods and the legal consequences of non-use. The Survey itself recognises the diversity of national practices and seeks to address concerns relating to the indication of relevant dates.

Because these issues are governed by national or regional laws per applicable in each of the Member State jurisdictions, each of the designated IP Offices is best placed to determine the relevant dates applicable in its jurisdiction.

MARQUES does not support an approach under which users are expected to calculate the relevant date themselves. Requiring users to perform such calculations would create uncertainty, increase the risk of errors and potentially lead to inconsistent interpretations. This would undermine the objective of enhancing legal certainty.

The objective should not be to provide users with the information necessary to calculate the dates; rather, the objective should be to explicitly provide the dates, already at the stage of issuing the statement of grant of protection. This information could also go with the registration certificate, depending on the viability for the IP Offices of the Contracting Parties to implement this improvement into the typically issued national registration certificates.

By expressly indicating the relevant dates, the IP Offices would provide trademark owners and third parties with clear and authoritative information. This would improve predictability for rights holders managing international portfolios and facilitate

assessment by practitioners, courts, customs authorities and other enforcement bodies.

Conclusion

MARQUES strongly supports the proposed amendments requiring to the IP Offices of the designated Contracting Parties to:

1. Issue a national or regional certificate upon the grant of protection;
2. issue a national or regional certificate also upon renewal of an international registration, provided that the designation has been subject to renewal;
3. State a clear issuance date of the Statement of Grant of Protection; and
4. State – at that stage - the date from which the applicable use requirement period runs.

These measures would enhance legal certainty, facilitate the enforcement of trademark rights, improve the practical operation of the Madrid System and assist rights holders in proving both the existence and the continued validity of their rights across designated jurisdictions. They would also ensure that users receive clear and authoritative information from the Offices best placed to determine the relevant dates under their national or regional laws.

MM/LD/WG/24/4 Further Elaboration of the Proposal made by the Delegation of the United Kingdom

MARQUES comments on Replacement

MARQUES welcomes the discussion regarding the modernisation of the replacement procedure under the Madrid System and supports the approach reflected in paragraphs 48 and 51 of the Proposal by the Delegation of the United Kingdom (MM/LD/WG/24/4).

MARQUES is in favour of implementing a centralized filing mechanism for requests of replacement through WIPO.

The current procedure requires trademark owners to file a replacement request with each designated national or regional IP Office. That IP Office must then examine the request and communicate the outcome to WIPO for recording. While this mechanism is legally available, it does not happen to be frequently used in practice, reasonably due to complexity. As a result, IP Offices may have accrued limited experience with replacement requests, at the same time that they have to assign anyhow administrative resources to processing these procedures, that arise in practice only occasionally.

From the users' perspective, the current system creates unnecessary complexity and costs. In many jurisdictions, trademark owners may need to appoint local representatives solely to request replacements, even where no substantive dispute or examination issue exists. This increases the cost of maintaining trademark portfolios and may discourage use of the replacement mechanism altogether.

A centralised procedure administered through WIPO would provide significant advantages:

- greater consistency in the handling of replacement requests;
- reduced administrative burden for national and regional IP Offices;
- lower costs for trademark owners;
- increased awareness and use of the replacement mechanism within the Madrid System; and
- greater legal certainty through a single, transparent process.

MARQUES considers that national and regional IP Offices should continue to play an appropriate verification role to the necessary extent. However, filing, coordination and communication may be centrally managed more efficiently through WIPO wherever possible. This would align with the fundamental objective underpinning the Madrid System, namely, to simplify international trademark portfolio management through a single procedural interface.

Accordingly, **MARQUES** supports further exploration of the viability of a WIPO-administered replacement procedure and encourages Member States to pursue solutions that allow replacement requests to be initiated and managed centrally through WIPO.

Respectfully submitted

On behalf of **MARQUES**, the European Association of Trade Mark Owners

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