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WORKING GROUP ON THE LEGAL DEVELOPMENT OF THE MADRID SYSTEM FOR THE INTERNATIONAL REGISTRATION OF MARKS

Fifth Session
Geneva, May 5 to 9, 2008

REPORT

adopted by the Working Group

I. INTRODUCTION

1. The fifth session of 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 May 5 to 9, 2008.

2. The following Contracting Parties of the Madrid Union were represented at the session: Australia, Austria, Bosnia and Herzegovina, China, Croatia, Cuba, Czech Republic, Denmark, Egypt, Estonia, European Community, Finland, France, Germany, Greece, Hungary, Italy, Japan, Latvia, Liberia, Lithuania, Madagascar, Mongolia, Netherlands, Norway, Oman, Portugal, Republic of Korea, Romania, Serbia, Singapore, Slovenia, Spain, Sweden, Switzerland, Syrian Arab Republic, The former Yugoslav Republic of Macedonia, Turkey, Ukraine, United Kingdom, United States of America (41).

3. The following States were represented by observers: Bangladesh, Canada, Ecuador, Iraq, South Africa (5).

4. A representative of the following international intergovernmental organization (IGO) took part in the session in an observer capacity: Benelux Organization for Intellectual Property (BOIP) (1).
5. Representatives of the following international non-governmental organizations (NGOs) took part in the session in an observer capacity: *Association romande de propriété intellectuelle* (AROPI), Centre for International Industrial Property Studies (CEIPI), European Brands Association (AIM), European Communities Trade Mark Association (ECTA), German Association for the Protection of Industrial Property and Copyright Law (GRUR), International Association for the Advancement of Teaching and Research in Intellectual Property (ATRIP), International Trademark Association (INTA), MARQUES (Association of European Trademark Owners), Union of European Practitioners in Intellectual Property (UNION) (9).
6. The list of participants is given in Annex II to this report.
7. Mr. Ernesto Rubio, Assistant Director General, opened the session and, on behalf of the Director General of the World Intellectual Property Organization (WIPO), welcomed the participants. He recalled that, since the past session of the Working Group, the number of Members of the Madrid Union had increased to 82, of which 75 were party to the Protocol. Registration activity under the Madrid system had continued to grow. In 2007, the International Bureau had received some 40,000 international applications (representing a 9.5% growth over 2006). Detailed information on the Madrid system operations could be found in the yearly report for 2007 and its statistical supplement, made available on the WIPO website.
8. Mr. Rubio then reported on a number of steps taken by the International Bureau to upgrade the level of services being offered to users of the Madrid system. In August 2007, a new service for the electronic notification of refusals and irregularity notices to interested holder had been introduced. Currently, the International Bureau was working on the development of an electronic interface to allow for the payment by credit card of any fees required in connection with the international procedure. This initiative followed the very successful experience the International Bureau had already had with the payment of renewal fees by credit card.
9. Mr. Rubio further informed the Working Group that the International Bureau was planning to replace the paper version of the *Gazette of International Marks* by an electronic version, as from January 2009. The new electronic version of the Gazette would be published on the WIPO website along with the current PDF version. The International Bureau had recently made available, in the PDF format, additional issues of the Gazette, back to 1997. The security that used to prevent partial downloading of images had been removed, so that any person could now extract a single page or a portion from any issue of the Gazette currently available on line in the PDF format.
10. Concerning the ROMARIN database, Mr. Rubio reported on additional measures that the International Bureau intended to implement with a view to making relevant information more easily accessible to users. One of these measures would consist of making digitalized copies of the notifications of provisional refusals available in ROMARIN before the end of

this year. A further measure would consist of adding in ROMARIN, where appropriate, an indication informing that, in respect of a given designation, the refusal period had lapsed with no notification of provisional refusal having been received by the International Bureau. This addition to ROMARIN was already being tested and would be implemented very soon.

11. Mr. Rubio then recalled that, in 2007, the Assembly had decided to give an ongoing mandate to the Working Group to analyze issues relating to the further legal development of the Madrid system. Two sessions of the Working Group had been planned for 2008. The second session would take place, tentatively, from November 24 to 28, 2008 and would be devoted to discussing the issues raised by the delegations of Norway, in 2006 (document MM/LD/WG/2/9), and Japan, in 2007 (documents MM/LD/WG/4/5 and MM/LD/WG/4/5 Corr.).

12. With regard to the present session of the Working Group, Mr. Rubio recalled that this would be mainly devoted to examining how to facilitate access to information on the fate of international registrations in designated Contracting Parties. As requested by the Working Group and based on contributions received from Australia, Japan and Switzerland, the International Bureau had prepared a paper (document MM/LD/WG/5/2.) addressing the main issues under consideration and proposing draft amendments to the Common Regulations. The proposed amendments would consist of a reorganization of the Rules currently dealing with provisional refusals, final decisions and statements of grant of protection and a rewording of some of those provisions, so as to provide a clearer and more consistent legal framework, capable of evolving in the future. A major substantive amendment would consist of including a mandatory requirement for Offices to issue statements of grant of protection. The proposed amendments would ensure speedier information with regard to the effect of the international registration in a Contracting Party and would allow that that information be recorded centrally in the International Register for the benefit of all interested parties.

13. In this respect, Mr. Rubio highlighted the readiness of the International Bureau to handle a situation in which all Offices of Madrid Union members would be issuing statements of grant of protection, if the members of the Union were to agree on establishing such a requirement. The International Bureau would ideally see this taking place as part of its electronic communication with Offices, something that the International Bureau was constantly fostering. He stated that the International Bureau would continue to provide full assistance to those Offices that indicated a willingness to go that route. In addition, the International Bureau could envisage processing paper lists issued by Offices which would not yet be in a position to communicate statements of grant of protection electronically and turn those lists into individual communications to the holders concerned.

14. Referring to the issue of replacement, Mr. Rubio recalled that, following the instruction of the Working Group, the International Bureau had launched in November 2007 an open forum on the Internet and had distributed a questionnaire to the Offices of Contracting Parties, inviting them to share their practice and experience in relation to replacement. While the participation in the forum had been disappointing, the reaction from Governments responding to the questionnaire had been very positive. The International Bureau had prepared a statistical compilation as well as a matrix of the replies received and these were available on the WIPO website, where also the individual answers of each Office could be found. As far as the electronic forum was concerned, and in spite of its limited success so far, Mr. Rubio confirmed that this would nonetheless remain open, until further notice.

15. Mr. António Campinos (Portugal) was unanimously elected as Chair of the Working Group, and Mr. Chan Ken Yu Louis (Singapore) and Mrs. Debbie Rønning (Norway) were elected as Vice-Chairs.

16. Mr. Grégoire Bisson (WIPO) acted as Secretary to the Working Group.

17. The Working Group adopted the draft agenda, as contained in document MM/LD/WG/5/1 Prov.

18. Under agenda item 4, the Working Group adopted the report of the fourth session of the Working Group on the Legal Development of the Madrid System for the International Registration of Marks, held in Geneva from May 30 to June 1, 2007.

II. INFORMATION ON THE FATE OF DESIGNATIONS

19. Discussions were based on document MM/LD/WG/5/2, prepared by the International Bureau and entitled “Information Relating to the Fate of Designations” (hereinafter referred to as “the document”).

20. The Chair opened the discussions by recalling the responsibility of making the Madrid system more user-friendly and capable of effectively responding to the challenges with which it was faced. Referring to the successful conclusion of the earlier sessions of the Working Group, he stated the work would now proceed on further aspects of the system, with a view to making the system more efficient and attractive, both for existing Contracting Parties and also for those that are not party to the system.

21. At the invitation of the Chair, document MM/LD/WG/5/2, was introduced by the Secretariat, who also made reference to document MM/LD/WG/5/2, Corr., prepared by the International Bureau. The Secretariat explained that the possible amendments contained in Annex I of the document went beyond what would be strictly necessary to introduce a requirement for Offices of Contracting Parties to issue statements of grant of protection. The approach that the International Bureau had taken in its document was to seize the opportunity to propose a clearer legal framework for communication of information relating to the status of marks in designated Contracting Parties. It was thus being proposed to the Working Group to consider the possibility of taking out of current Rule 17 all existing provisions that concerned final decisions and statements of grant of protection (so as to keep in that rule only the existing provisions that concerned the procedure of notification of provisional refusals) and to have those reflected in two new provisions 18*bis* (*Interim Status of a Mark in a Designated Contracting Party*) and 18*ter* (*Final Disposition on Status of a Mark in a Designated Contracting Party*). The Secretariat emphasized that new Rule 18*ter*(1)(a), which, as drafted, was making it compulsory for Offices to issue statements of grant of protection, would be the sole provision introducing a new requirement for Offices. As far as the other provisions were concerned, the sole effect of this restructuration was that what

Offices were currently required to notify as a withdrawal of refusal or confirmation of a partial refusal would, under possible Rule 18*ter*, take the form of a statement of grant of protection. Finally, the Secretariat recalled that Annex I also contained a draft amendment to Rule 16, that the Working Group could consider independently from the fundamental issue of requiring Offices to issue statements of grant of protection and from the broader restructuration exercise.

22. In response to a request by the Chair for comments of a general nature by delegations in advance of detailed discussion of the issues, the Delegation of Italy stated that it recognized the importance of providing better quality information to the users of the Madrid system and of reaching an interim standard level of data access for holders of international registrations and also for third parties. However, the Delegation noted that it wished to underline two points. Firstly, the Italian Office did not yet have sufficient experience with opposition procedures and was, therefore, unable, at this point, to express an opinion regarding intermediate information to be provided with regard to oppositions. Secondly, the Delegation stated that the Italian Office was currently undergoing a substantial reorganization and was experiencing a significant increase in trademark activity and, for this reason, the Office would be interested in obtaining notifications of designations electronically from the International Bureau. This would enable the Office to process the ongoing work in a more efficient manner and reduce the work of the Office. It would reduce the workload of the Office and remove the need to transcribe data unnecessarily.

23. The Delegation of Japan stated that it welcomed and strongly supported the proposal for the introduction of a requirement to issue a statement of grant of protection, as it was important that users knew whether or not a mark was protected. It said that, with the adoption of a provision as the proposed Rule 18*ter*(1), the Madrid system would become more user-friendly, transparent and attractive for users.

24. The Delegation of Spain stated that, in general, it fully supported the design and outline of the strategy envisaged in the proposals under discussion, that is to say, giving greater information to users with respect to the status of their marks. The Delegate outlined the procedure that currently applied in its Office with respect to marks that did not meet objection and concluded by noting that all communications from its Office took place in electronic form. In addition, information concerning registrations was available on the website of the Office.

25. The Delegation of China said that it was not in favor of the proposal for a mandatory obligation for Offices to issue statements of grant of protection, in view of the continuously increasing number of designations of China. Instead, the Delegation suggested that, if the information on ROMARIN could be improved, holders or third parties could be sufficiently informed without the need of issuing statements of grant of protection.

26. The Delegation of Germany said that, if statements of grant of protection became mandatory, Germany would likely have to change its national law, as, at present, German law was based on the principle of tacit acceptance. The Delegate pointed out that accessibility to information would be improved by having data in electronic form and that Germany was in the course of developing an electronic system. However, the system could probably not be operational in the German Office before mid-2010.

27. The Delegation of the Republic of Korea indicated that it wished to confirm its support for the proposals, which would improve the accessibility of information by the issuing of statements of grant of protection to the International Bureau. The Delegation noted that it currently made every possible effort to improve the accessibility of information regarding international registrations and that it notified statements of grant of protection and withdrawals of provisional refusals as soon as possible. It said that it believed that the proposals provided a good basis for constructive discussions and a fruitful outcome.

28. The Delegation of Madagascar said that it was pleased to participate for the first time in the meeting of the Working Group on the Legal Development of the Madrid System for the Legal Registration of Marks. The Delegation explained that the Protocol had entered into force the previous week in Madagascar. For that reason, the Delegation did not as yet have any major observations to make with regard to the provisions, other than that it was in favor of issuing a statement of grant of protection. The Delegation considered that it was right for the holder to be given the possibility of knowing the fate of its registration in the designated countries. The Delegation was also in favor of better access to information relating to international registrations.

29. The Delegation of Australia stated that it supported the proposals embodied in the paper. Referring to the earlier comments, the Delegation noted that the concerns which had been expressed related largely to issues about implementation, rather than the desirability, of the proposals. The Delegation said that it wished to acknowledge that the practical concerns were indeed real and expressed its commitment to working in cooperation with others in order to achieve the expressed goals. For this reason, it had proposed firstly an interim, and then a more long-term, approach. The Delegation also expressed its satisfaction with the comments of Mr. Rubio, to the effect that the International Bureau stood ready to move forward and to assist Offices wherever necessary.

30. The Delegation of Singapore noted its support for the proposal to introduce provisions making compulsory the issuing of statements of grant of protection and that such information would be published in the International Register. Such information was certainly essential knowledge for the holders of marks, and to some extent, also for third parties. The proposals were an important step in making the Madrid system more user-friendly and relevant. However, noting the need to be sensitive to the difficulties that some Contracting Parties might face, the Delegation expressed the hope that it would be possible to arrive at a compromise, in the light of the spirit of willingness exhibited by Delegations during the previous sessions of the Working Group.

31. The Delegation of the United States of America noted with satisfaction the increased level of services provided by the International Bureau and the plans and proposals for further improvements. However, measures to improve transparency should not impose too heavy a burden on Offices. It was therefore important to see how to use automation in order to reduce the impact, as far as possible, for those Offices with different levels of automation. However, one way or another, in order to have better information on ROMARIN, there would have to be an increased level of communication between Offices and the International Bureau. Furthermore, the Delegation stated that it wished to avoid redundancy where Offices already communicated directly with the holders of international registrations. In conclusion, the Delegation expressed its support for the proposals.

32. The Delegation of Croatia stated that it supported any proposal that might ultimately enable holders to have better information with regard to the status of international registrations. Croatia made the current status of international registrations available electronically. It would be useful if similar information could be made available to users at the international level, and from a central source. The Office of Croatia did not presently issue statements of grant of protection because their examination procedure takes them to the edge of the refusal period. However, the Delegation expressed that, in principle, it was in favor of the issuing of statements of grant of protection. However, if these were to become mandatory, its Office would need time to adapt its system.

33. The Chair then concluded that no Delegation had objected, in principle, to the objective of improving the access to information for users. Some Delegations had, however, expressed reservations, notably with regard to timing and logistics. It appeared, therefore, that the Working Group could proceed with the discussion of the proposals.

Proposed Amendment of Rule 16

34. Presenting the proposed amendments to Rule 16, the Secretariat referred to the issue that had been raised in a previous session of the Working Group by the Delegation of Australia that, in many cases, Offices that had issued an alert as provided for in Rule 16, would not communicate subsequently the dates of the opposition period. If no refusal was eventually notified, this effectively left the situation open-ended.

35. However, the Secretariat noted that the proposed amendment of subparagraph 2 of Rule 16 might cause a problem in Contracting Parties where the opposition period was extendible. Further consideration would therefore be given to the drafting of the amendment in question.

36. The Secretariat also mentioned that perhaps the Working Group might not need to pursue this amendment if it went ahead with the proposed new Rule 18^{ter}, insofar as application of new Rule 18^{ter} would, in any event, ensure that in no case would the procedure remain open-ended.

37. The Delegation of Australia stated that it broadly supported the proposed amendment to Rule 16, regardless of whether or not proposed Rule 18^{ter} were adopted, since a statement of grant of protection under that new provision would in any event be communicated at a later date than the information concerning the opposition period under Rule 16. The proposed amendment would therefore be of benefit both to holders and to third parties.

38. The Delegation also pointed out that the provision of the information concerning the opposition period could be utilized in the updating of the ROMARIN database and suggested that the International Bureau should consider noting the elapsing of the seven-month period, in the same way as it was proposing to note the passing of the regular refusal periods.

39. The Secretariat stated that it agreed with the views and comments expressed by the Delegation of Australia and confirmed that it should be in a position to indicate in ROMARIN the elapsing of the opposition period, as long as a starting date had been communicated to the International Bureau.

40. The Delegation of Sweden noted that, heretofore, it had communicated the information regarding the opposition period only in cases where an actual refusal based on an opposition was being notified to the International Bureau. Proposed revised Rule 16 would now impose upon it a more extensive obligation. For this reason, the Delegation, supported by the Delegation of Australia, asked the Secretariat whether it would be possible to send a list to the International Bureau, that mentioned the same opposition dates for several international registrations.

41. The Secretariat confirmed that this was the case.

42. The Delegation of the United States of America stated that when it sends to a holder a Notice of Publication, the end date of the opposition period is not indicated, because the period is extendible. The current text of the proposed amendment to Rule 16 did not accommodate the possibility of an extendible period and the Delegation therefore expressed its appreciation of the International Bureau's willingness to look again at the proposed text.

43. The Representative of INTA suggested that, for clarity, there should be added to the end of the proposed title of Rule 16 the words "under Article 5(2)(c) of the Protocol", whether retaining, or not, the reference to "possibility of".

44. The Secretariat circulated a revised version of Rule 16 based on the comments made by the Working Group.

45. The Working Group agreed on the text of Rule 16 as it appears in Annex I of the present document.

Proposed Revised Rule 17

46. On the invitation of the Chair, the Secretariat presented the proposed revised Rule 17.

47. The Working Group agreed on the text of Rule 17 as proposed. The text of proposed revised Rule 17 appears in Annex I of the present document.

Proposed New Rule 18bis

48. The Secretariat gave an introduction to Rule 18bis recalling that the procedure allowed under this provision, as proposed, would simply replace the procedure under current Rule 17(6)(ii). However, it further emphasized that the benefit of having a provision as to the interim status of a mark was that would enable the addition of new types of information on the status of the mark to be provided for in the future.

49. The Representative of INTA stated that Rule 18bis might evolve in the future to allow more information to be transmitted to the International Bureau. The Representative recalled that in the context of the amendment of the procedures for the notification of refusals in 2000, a clear distinction had been made between a statement and a notification (see footnote 14 of document MM/LD/WG/5/2.). The word "notification" was used in connection with a communication from which stemmed a legal consequence. The Representative suggested the wording of Rule 18bis be aligned accordingly.

50. The Delegation of Singapore, supported by the Delegation of Australia, referred to the disparity of the information regarding the status of a mark in the International Register in so far as, in the case of a notification of a provisional refusal which had been withdrawn, the holder of the registration was notified, but third parties would not have access to this information. Both Delegations emphasized the interests of third parties in knowing, as soon as possible, the status of the mark.

51. The Secretariat introduced a revised version of Rule 18*bis* that included a new paragraph (1)(b), intended to address the concerns of the Delegations of Singapore and Australia. The wording of Rule 18*bis*(2) was improved, taking into account the comments of the Representative of INTA.

52. Following further interventions by the Delegations of the European Community and Australia and by the Representative of GRUR, the wording of Rule 18*bis*(1)(b) was further revised.

53. The Working Group agreed on the text of Rule 18*bis* as it appears in Annex I of the present document.

Proposed New Rule 18*ter*

54. The Secretariat recalled that Rule 18*ter*(1)(a) established an obligation for an Office which did not intend to communicate a notification of provisional refusal to send, as soon as possible within the period applicable under Article 5(2) of the Agreement or Article (5)(2)(a), (b) or (c) of the Protocol, to the International Bureau, a statement to the effect that all procedures before the Office had been completed and the Office had decided to grant protection to the mark that was the subject of the international registration. It further emphasized that this was the sole new obligation that the proposed amendments introduced for Offices. As regards Rule 18*ter*(1)(b), (2), (3) and (4), those provisions reflected the current requirements.

55. The Secretariat stressed that the two issues to be decided by the Working Group were whether, in view of simplification and improvement of the transparency of the proceedings, the Working Group considered favorably the “relabeling” and “restructuring” of the provisions, and whether the communication of a statement of grant of protection should be compulsory for Offices.

56. The Delegation of Switzerland, supported by the Delegations of Germany and Australia, said that it endorsed the proposal for new wording made for the different rules, since such changes would make the texts easier to read.

57. In response to a question raised by the Delegation of Germany, the Secretariat explained that there was no intention to introduce any changes as to the substance of Rule 18*ter*(1)(b). The different wording was necessary in order to align the wording with the restructured provision. As regards Rule 18*ter*(2), the word “may” instead of “shall” was used, bearing in mind that if the procedures before an Office relating to the protection of the mark had been completed favorably for the holder, the Office would issue a statement of grant of protection under Article 18*ter*(1)(b).

58. The Delegation of Spain supported the new structure of the provisions, which allowed the introduction of new rules that would simplify the proceedings. The Delegation, however, raised concern about the compatibility of Rule 18*ter* with the administrative proceedings before its Office. The Delegation sought clarification of the wording “all the procedures before the Office have been completed” in Rule 18*ter*(1)(a). The Delegation explained that, in its national legislation, a possibility of an administrative appeal before the Office was provided for. After the Office had completed its examination, there was still a possibility of appeal to be filed before the Office. The Delegation further informed the Working Group that its Office would issue statements of grant of protection, which could be sent within six to seven months from the notification received from the International Bureau.

59. In response to a question from the Delegation of Spain, the Secretariat clarified that Rule 18*ter*(1)(a) applied when there had been no notification of a provisional refusal. In the case of an opposition by a third party, the Office would issue a notification of provisional refusal based on opposition. Consequently, Rule 18*ter*(1)(a) did not apply in such a case.

60. The Representative of INTA agreed with the reorganization of the Rules as proposed. The Representative felt that the proposed Rules were likely to meet the needs of users, holders and third parties to have information on the fate of international registrations in various countries. The Representative suggested, however, some clarifications as to the formulation of Rule 18*ter*(2).

61. The Representative of the Association for the Advancement of Teaching and Research in Intellectual Property (ATRIP) and the Center for International Industrial Property Studies (CEIPI) shared the views of INTA regarding the reorganization of the provisions, even though those two organizations did not represent users. It would, however, be clearer in Rule 18*ter* in general to say firstly what the decision was and then how it was notified or communicated to the public. Concerning the difficulty of achieving a consensus on the requirement to issue statements of grant of protection, one possibility would be to use the word “shall” but to allow, for a transitional period, the Contracting Parties that had legislative or practical difficulties not to apply the rule until they were in a position to do so.

62. The Representative of GRUR stressed the importance of the mandatory character of the issuing of statements of grant of protection. The Representative noted that flexibility concerning the coming into force of the proposed Rules was necessary in order to allow all the Members of the Madrid Union to accommodate them at the national level. The Representative referred to an intervention of the Delegation of Spain, explaining that in the case that a refusal was followed by an administrative review or appeal, or a judiciary review or appeal, a further decision, in accordance with Rule 18*ter*(3), had to be issued.

63. The Delegation of Slovenia mentioned that the rewording of the rules was a positive step and said that the Office of Slovenia was in the process of setting up a computer system to allow it to apply the content of subparagraph 1 of Rule 18*ter*.

64. The Delegation of the European Community said that the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) sent two statements: one statement was sent after the examination regarding the absolute grounds and another one was sent after final acceptance. The Delegation specified that it would wait for all the appeals within the Office to be completed, which could take several years if necessary, before sending the final result and the fate of the international registration.

65. The Delegation of China reiterated its position that the issuing of statements of grant of protection should not be compulsory.

66. The Representative of GRUR observed that the only new obligation in Rule 18*ter* was that if an Office had found no grounds for refusal prior to the expiry of the refusal period, the Office should send a statement to that effect to the International Bureau. In the case that the Office did not examine the mark within the above time limit, the mark was protected in accordance with Articles 4 of the Madrid Agreement and Protocol.

67. The Chair stated that the only new provision as to substance was Rule 18*ter*(1). The Chair further asked the Secretariat to clarify whether, in line with the proposed Rule, the communication to the International Bureau should be made electronically or on paper.

68. The Secretariat emphasized the flexibility of the International Bureau in terms of what would be required from Offices. At present, the International Bureau dealt with a vast volume of paper communications and would continue to accept paper communications also in the future. However, the International Bureau would endorse electronic communication with Offices. In addition to individual statements of grant of protection communicated through electronic means, the International Bureau would accept also lists of protected international registrations. For this purpose, the International Bureau needed only the international registration number and the name of the Office concerned. The International Bureau would transform such lists into individual communications to be forwarded to the holders of the respective international registrations. The International Bureau was also prepared to handle paper lists. To this end, a marked-up duplicate of the bordereau of notification might simply be returned to the International Bureau.

69. The Delegation of Australia sought from the Secretariat clarification as to whether an Office could prepare a copy of the list sent by the International Bureau, highlight the registration numbers concerned and return it to the International Bureau. In response, the Secretariat confirmed that the procedure as defined by the Delegation was sufficient as far as statements of grant of protection, under Rule 18*ter*(1)(a) only, were concerned. As regards other statements, more information would be needed.

70. The Delegation of China said that it was not in favor of sending lists of statements of grant of protection.

71. In response to an intervention of the Delegation of Cuba, the Secretariat noted that an exchange of paper lists might alleviate the concerns of the Delegation.

72. The Delegation of Italy, supported by the Delegation of Portugal, favored the proposal of sending lists to the International Bureau. The Delegation noted that the workload of the Office would not increase since the Office only had to highlight in the list the mark whose protection had been accepted.

73. The Delegation of the United States of America explained that, currently, it did not provide the information under Article 18*ter*(1) to the International Bureau. The Office sent a certificate of acceptance directly to the holder. The Office would revise its systems in that respect.

74. The Delegation of Germany raised a question as to whether the draft model forms, as annexed to document MM/LD/WG/5/2., were compatible with the idea of sending lists.
75. In reply, the Secretariat explained that the draft model forms were intended to take into account the fact that certain Offices might wish to continue sending individual statements of grant of protection on paper. In addition, most of those forms dealt with situations in which Offices had to communicate with the International Bureau through an individual statement. In that context, the International Bureau needed to accommodate those individual statements.
76. The Delegation of Germany agreed with the content of the proposed Rule, but pointed out that the coming into force of the provision should be flexible.
77. The Delegation of Austria wondered whether it was possible to transmit also lists of marks that were *not* protected. In response, the Chair underlined the flexible approach of the International Bureau.
78. In response to an inquiry from the Delegation of Cuba, the Secretariat further clarified that the expression mentioned by the Delegation of Cuba was to be understood “as soon as possible before the expiry of the maximum time limit in theory applicable”. However, the Secretariat noted that a second review of the provision was necessary.
79. The Secretariat circulated a revised version of Rule 18*ter* based on the comments made by the Working Group. The Secretariat emphasized that the revised formulation of that provision was still broad enough to cover also the case of Offices that did not carry out any examination. The Secretariat further drew the attention of the Working Group to footnote 3, which was added to take into account the two-part fee system.
80. The Secretariat explained that the revised Rule 18*ter*(2) was different from the provision initially proposed in document MM/LD/WG/5/2.. The revised wording of subparagraph (a) was more explicit. That subparagraph concerned situations where there had been a total withdrawal of a provisional refusal and protection was granted for all goods and services. The wording of subparagraph (b) had not been revised and it covered a series of different situations.
81. The Delegation of the European Community inquired about the concept of the expression “the provisional refusal is withdrawn” in subparagraph (2)(a). The Delegation explained that when a provisional refusal had been issued, the applicant often sent a request for limitation of the list of goods and services to OHIM. In this case, OHIM did not issue any decision and the file was considered closed.
82. In response, the Secretariat referred to the wording of the current Rule 17(5), the *chapeau* of which read “Confirmation or Withdrawal of Provisional Refusal”. Subparagraphs (ii) and (iii) of that Rule were migrated to the new Rule 18*ter*(2) and relabelled, but there were no changes as to the substance.
83. The Delegation of Australia considered that the formulation of Rule 18*ter*(2) was broad enough to cover the situation referred to by the Delegation of the European Community.

84. The Secretariat indicated that Rule 18^{ter}(3) had been revised to take into account the comments of the Working Group and further pointed out that Rule 18^{ter}(4), as revised, corresponded better to the current Rule 17(5)(b).

85. Finally, the Secretariat noted that the wording of Rule 18^{ter}(5) had been revised to reflect the comments of the Working Group.

86. The Working Group agreed on the text of Rule 18^{ter} as it appears in Annex I of the present document.

Entry into Force of the Amendments and New Transitional Provision

87. Noting that the Working Group was in agreement as to the text of all the proposed amendments, the Chair recalled that a decision still had to be made as to their entry into force.

88. The Delegation of Germany recalled that Rule 18^{ter}(1) introduced a new obligation on Offices. For this reason, the Delegation would prefer the middle of the year 2010 as the date of entry into force of proposed Rule 18^{ter}(1).

89. The Delegation of France specified that an excessively heavy workload should not be imposed on Offices. For that reason, the date of entry into force of Rule 18^{ter}(1) should be reasonable. The Delegation proposed January 1, 2011.

90. The Delegation of China indicated that, in light of the discussions at the present meeting, it would take the proposal back to its Office for consideration.

91. The Chair invited the Working Group to consider the possibility of a transitional provision so as to defer the mandatory effect of Rule 18^{ter}(1). Under this scenario, all of the amendments could enter into force on September 1, 2009, but Offices would not be obliged to start sending statements of grant of protection under Rule 18^{ter}(1) until January 1, 2011. The Chair proposed the following text, to be added to Rule 40 (*Entry into Force; Transitional Provisions*):

“(5) [*Transitional Provision Relating to Statements of Grant of Protection*] No Office shall be obliged to send statements of grant of protection under Rule 18^{ter}(1) before January 1, 2011.”

92. In reply to a question by the Delegation of Germany, the Chair confirmed that this transitional provision would also enter into force on September 1, 2009.

93. The Delegation of Australia expressed its thanks to the other delegations for the constructive way in which the discussions had been conducted. It said that it recognized the difficulties that some offices might encounter. In particular, with respect to the Office of China, it noted the difficulties to which the Delegation of China had made reference and underlined the willingness of the Australian Office to offer its support and assistance in any way.

94. The Working Group agreed on the text of Rule 40 as proposed by the Chair. The text of proposed revised Rule 40 appears also in Annex I of the present document.

Recommendation of the Working Group

95. The Chair concluded as follows:

- that the Working Group had requested the International Bureau to submit to the Assembly of the Madrid Union, at its session in September 2008, draft amendments to the Common Regulations as proposed in Annex I of this report, and
- that the Working Group had recommended that the Assembly adopt such amendments with a date of effect of September 1, 2009.

Model Forms

96. The Secretariat presented to the Working Group the proposed model forms that had been prepared by the International Bureau as an adjunct to the proposed amendment of the Common Regulations relating to the refusal procedure. It recalled that following the earlier work of the Working Group, the International Bureau had already made available on the Madrid website a series of model forms for the convenience of Offices.

97. Regarding Model Form 1, the Secretariat noted that the wording might require revision to take into account the earlier comments of the Delegations of Singapore and Australia regarding the communication of a statement of grant of protection following the completion of the *ex officio* examination.

98. Model Form 2 corresponded to current Model Form D for use when a refusal was withdrawn. However, under the proposed new Rule 18*ter*, this would be labelled as a statement of grant of protection, even if the refusal was withdrawn only for some goods or services, or when a partial refusal was confirmed. This form could be used in a wide variety of situations.

99. Model Form 3 concerned a confirmation of a total provisional refusal and would replace the current Model Form B.

100. Model Form 4 also had a corresponding model form currently available. It was intended to be used in cases where an appeal had been lodged outside the Office, such as to an external tribunal. However, this form was not intended for use in respect of invalidations.

101. Model Form 5 concerned the possibility of an opposition after the 18-month period.

102. In reply to a query from the Delegation of Germany, the Secretariat confirmed that the model forms were not intended to be compulsory.

103. Commenting on Model Form 2, the Delegation of Norway said that the issuing of a statement of grant of protection could be seen as the international version of a certificate of registration. The Delegation stated that its users had expressed the importance for holders and their representatives of having all necessary information pertaining to one international

registration in one single document. It would be very useful for holders if Model Form 2 were to contain also information about the date of international registration, the date of subsequent designation, if any, and, for the purpose of the use requirement of many countries, the date the Office had decided to grant protection in the designated country.

104. The Delegation proposed, therefore, that this additional information be included in Model Form 2. However, if the designated Office provided the International Bureau with a list, and not an individual statement, the Office concerned would only be required to provide the date of the decision to grant protection in the designated country concerned.

105. The Delegation of Italy stated that it could not at this time express an opinion on Model Form 5 because there was not yet an opposition procedure in Italy. However, regarding Model Forms 1 and 2, it wondered if it would be possible to send lists, in order to minimize the work of the Office.

106. In response to comments from the Representative of ATRIP and CEIPI, the Secretariat agreed that the use of the word “confirm” might indeed give the impression that it concerned a second communication and, that not being the case, this term would therefore be reconsidered.

107. Commenting on the Delegation of Norway’s mention of the communication of the starting date for the use requirement of a mark, the Representative of INTA wondered whether such data could be included in the International Register and published by the International Bureau. It stated that this data was of interest for third parties, as much as it was for holders, and that there was a need for further reflection upon this issue.

108. Supporting the intervention of the Representative of INTA, the Representative of GRUR suggested that all information becoming available to the International Bureau regarding international registrations be made available on ROMARIN. Furthermore, as there was no uniformity as to the starting date of protection among the different legislations, it would be most useful if these dates be made available, especially in the context of use requirements.

109. In response to a comment made by the Delegation of Norway, the Secretariat underlined that Offices were not prevented from adapting the model forms. The Common Regulations did not require that Offices indicate dates, but an Office that was willing to provide more information might do so. Furthermore, the Secretariat recalled that a digitalized copy of notifications of provisional refusal would be available in ROMARIN by the end of the year and that it could be envisaged to extend this facility to other types of statements sent by Offices. In that context, if an Office provided additional information as part of its statements, this information would be made available to third parties.

Document MM/LD/WG/5/4

110. On the invitation of the Chair, the Delegation of Switzerland introduced document MM/LD/WG/5/4.

111. The aim of the contribution by Switzerland was to improve access to information by means able to increase the quantity and enhance the quality of the information and services provided for system users. The first part of the contribution included, for information and by way of illustration, certain quality measures or standards introduced by the Swiss Office, which could be the subject of discussion by the Working Group.

112. The second part of the contribution contained two measures which national Offices could implement so as to allow the applicant or holder to be more familiar with and to understand the practice of an Office and the grounds for refusal of a mark.

113. In this regard, the publication of the guidelines would allow the applicant or holder to become familiar with the procedure and practice of the national Office at an earlier date, thereby enabling it to determine whether it was wise to request protection in the form of a mark in the Contracting Party. On the basis of experience, since the Swiss Office guidelines had been drafted and made available about ten years previously, the criticisms of users concerning the unpredictability and the lack of transparency in the practice of the Swiss Office had decreased appreciably.

114. As to the summary presentation of the grounds for refusal, that was a summary memorandum which should explain the grounds for refusal applied by the national (or regional) Office, thereby allowing the holder or applicant to make an initial analysis and to determine whether it was wise to adopt a position.

115. The Delegation welcomed the plan of the International Bureau to make available shortly, through ROMARIN, provisional notifications of refusal, which corresponded partially to the second proposal made by Switzerland. There appeared to be a real need to make available to users all the information provided by the national Offices, such as the start date of the grace period for non-use of the mark.

116. In reaction to paragraph 2.2 of the contribution from Switzerland, the Secretariat indicated that the proposals in question appeared to be based on the same principles that were guiding the International Bureau. Indeed, as outlined in the Program and Budget for the 2008/09 biennium, which had been adopted by the WIPO General Assembly on March 31, 2008, increased quality of service and enhanced electronic filing and communication under the international registration procedures are a major focus for the activities of the International Bureau in respect of, *inter alia*, the Madrid system. In addition, the Madrid Union Assembly had approved, at its Session in 2007, a four-year IT investment project for the modernization of the IT system for the support of the business activities of the International Bureau for the administration of procedures under the Madrid system. With the sophisticated IT platform that would result from this investment project, the International Bureau would have greater flexibility in tailoring certain of its services to the needs of individual national or regional Offices: e.g., the compilation and publication of mark information and the maintenance of databases used to search for pending and registered marks for purposes of clearance, examination, opposition, invalidation and enforcement. The Secretariat said that the improvements identified in paragraph 2.2 of the contribution from Switzerland were also the subject of ongoing or planned work towards the same goals, as outlined in the Program and Budget for the 2008/09 biennium and the IT modernization project adopted by the Madrid Union Assembly.

117. Continuing with regard to the details of the items addressed in paragraph 2.2 of the contribution from Switzerland, the Secretariat first took up the suggestion that the electronic exchanges between the International Bureau and national or regional Offices should be standardized and improved. He informed the Working Group that the International Bureau found this a useful suggestion and was planning to conclude memoranda of understanding with all Offices of members of the Madrid Union setting out the actual means of electronic communication established between the International Bureau and a given Office under Section 11 of the Administrative Instructions. With some Offices, such a memorandum of understanding had already been concluded. The two specific aspects mentioned in the Swiss contribution in this respect were among the items addressed in these memoranda of understanding. The Swiss Office, in particular, had direct access to the International Register electronically allowing it to prepare the entry of data into the International Register up to the point of validation by an examiner of the International Bureau. The Swiss Office was the only Office so far with which the International Bureau had established such an arrangement. The other aspect expressly mentioned in the contribution from Switzerland was addressed in all memoranda of understanding concluded to date, allowing the International Bureau to raise an irregularity with the Office concerned in case the quality of, for example, the image of the mark was not in line with the standard set out in the memorandum of understanding concerned.

118. He then referred back to the opening statement of Mr. Rubio, who had informed the Working Group, *inter alia*, of the intention of the International Bureau to make available in ROMARIN digitalized copies of the notifications of provisional refusals. This improvement was planned to be in place by the end of 2008. By the same time, the International Bureau was also contemplating the replacement of the paper version of the *WIPO Gazette of International Marks* by a truly electronic version. However, meanwhile, WIPO had already removed the security that used to prevent partial downloading of the online PDF version of the Gazette. As a result, anyone now had the opportunity to extract a single page, or a portion, from the Gazette online. This possibility was introduced only last week, when also copies of all issues of the Gazette since 1997 had been made available on the WIPO website. As regards the suggestion by Switzerland that refusal notifications should be translated into the other two languages of the Madrid system, he wished to recall that the International Bureau only translated data of which publication in the Gazette was required. Thus, provisional refusals were translated without an indication of the goods and services concerned and without the grounds for refusal, but just with an indication as to whether the provisional refusal related to all the goods and services or only some of them. However, once copies of the notifications of provisional refusal would be available in ROMARIN, an indication of the goods and services concerned and the grounds for refusal became available to anyone wishing to consult a provisional refusal on the WIPO website. The International Bureau would be hesitant to engage in translation of grounds of refusal because of possible interpretation issues. Finally, he said that the other items mentioned in the contribution from Switzerland would be addressed in detail at the informal liaison meeting scheduled for Thursday, May 8, 2008.

119. In response, the Delegation of Switzerland specified that the Swiss Office had access to the WIPO database only as the originating Office.

120. Following a question from the Chair as to what was intended by ‘direct access’, the Secretariat stated that it was possible for the Swiss Office to enter a change in the International Register through a direct line, without communication by email, or otherwise. However, examination in the normal way then followed. As to whether the same facility could be extended to an Office as Office of a designated Contracting Party, the Secretariat confirmed that this could be looked into.

121. The Delegation of Japan expressed its appreciation for the contribution by the Delegation of Switzerland. It said that it was supportive of the proposition regarding examination guidelines in the form of an English translation. On the other hand, with respect to the summary presentation of the refusal system, while it could be useful to have this made available in the three languages of the Madrid system, it might prove difficult for some Offices, particularly for Offices whose language was not one of the three Madrid languages.

122. The Delegation of Switzerland said that the proposed summary presentation should not be more than a standard form prepared once only and attached to act as a reminder, in summary form, of what the procedure was.

123. The Delegation of Japan also expressed some concern regarding the responsibility for the accuracy of such a translation and that if such a requirement became mandatory it might have a discouraging effect on potential Contracting Parties. The Delegation stated that it could not therefore agree with this proposition until the difficulties to which it had referred had been addressed.

124. Regarding the proposal to permit direct access by Offices of Contracting Parties to the International Register, the Delegation of Japan suggested that even a minor change to the Register might impact directly upon a holder’s trademark rights and therefore, in its view, the facility to insert changes to the Register should remain the sole prerogative of the International Bureau.

125. The Chair referred to the explanation given by the Secretariat of the system in place for the Swiss Office entering data into the International Register. As he understood it, the Swiss Office would enter the data in a “shadow” file, which would only be entered into the International Register if and when validated by an examiner of the International Bureau.

126. The Delegation of Australia also expressed its thanks to the Delegation of Switzerland for its submission and confirmed that it supported each of the proposals in question. However, the Delegation noted that it understood the concerns that had been expressed by the Delegation of Japan, but in this regard, the Australian Office had decided that the additional burden would be small because of the relatively low number of translations which would be required.

127. The Delegation of China stated that its Office was currently preparing amendments of its trademark law and that it was not, therefore, an opportune time for them to give further consideration to the proposals presented by the Delegation of Switzerland.

128. The Delegation of Spain suggested that the idea of a translation of the guidelines into English might be seen, in a sense, as discriminatory, *vis-à-vis* the other two languages of the Madrid system. The measure should therefore provide for translation into all three of the languages of the Madrid system.

129. The Delegation of Finland wondered whether the information under discussion might be made available as part of the country information sheets which featured already on the Madrid website.

130. Indicating its support for what had been proposed by the Delegation of Finland, the Delegation of Croatia said that it was not enthusiastic about the proposal for the attachment in three languages of the summary grounds of refusal.

131. The Delegation of Austria stated that, as Spanish was not a language accepted by the Austrian Office, it could not give the required information in Spanish.

132. The Delegation of Cuba expressed its interest in the proposal and noted that it already had on its own website information on the functioning of the system in Cuba. However, the Delegation said that it would give consideration to including its legislation in the other working languages.

133. The Delegation of Italy indicated that it would be agreeable to furnish guidelines in English regarding the examination of a mark, but noted that when there had been a refusal by its Office, the reasons and references to national legislation in French were already provided for. A translation into English would be possible, but the Office would be unwilling to translate also into Spanish.

134. The Delegation of the United States of America also expressed its thanks to the Delegations of Japan, Switzerland and Australia for providing input to the discussions. It said that it could agree with most of what had been proposed and that any resulting increase in transparency would be of benefit to users. It confirmed that it would be willing to summarize its refusal procedures and to translate the text into French and Spanish. However, it expressed some reservations regarding the examiners' manual, due to the likely expense that might be incurred in providing translations of this 1,600-page document.

135. The Delegation of the European Community, while also expressing its appreciation to Australia, Japan and Switzerland, stated that its examiners' guidelines were already available in the three languages and, with respect to the summary presentation suggested by Switzerland in respect of applicable refusal procedures, it supported the Delegation of Finland and other delegations who had suggested making this information available through the country information sheets on the WIPO website.

136. The Representative of MARQUES stated that it supported the idea of direct access by Offices to the International Register. This would be a practical way to make work easier and a means of transforming ROMARIN into a central repository for all users, subject to the maintenance of controls, as at present.

137. The Representative of AIM, supported by the Representative of ECTA, also expressed its support for the proposals by the Delegation of Switzerland and, in particular, made reference to the possibility that an active alert system might be built into ROMARIN, allowing holders and third parties to be advised when there was a change in the database, that was of concern to them.

138. The Chair concluded this part of the discussion stating that the Working Group had noted the contents of the contribution by the Delegation of Switzerland.

Document MM/LD/WG/5/3

139. The document was introduced by the Delegation of Japan. The Delegation indicated its concern for the improvement of information as to the fate of international registrations and improved accessibility to information more generally. The mandatory communication of certain information as to the status of marks might, however, deter potential members from acceding to the Madrid system.

140. The Delegation noted that with the introduction to the Common Regulations of the proposed amendments now under discussion, including the adoption of a mandatory statement of grant of protection, the problem of “tacit acceptance” would be resolved. In addition, it was of the view that if the Offices of Contracting Parties implement appropriately the new rules regarding the communication of notifications, most of the problems concerning information relating to the status of marks would be resolved.

141. The Representative of MARQUES expressed support for the contribution from Japan. She did, however, not agree with the suggestion that mandatory statements of grant of protection would be an obstacle to increased membership of the Madrid system, as there would only be an obligation to provide information about the status of the work in the designated Office with regard to international registrations designating them.

142. The Chair concluded by stating that the Working Group had noted the content of the contribution by the Delegation of Japan.

Documents MM/LD/WG/5/5 and MM/LD/WG/5/6

143. The documents were introduced by the Delegation of Australia, which recalled that the papers presented had their genesis in the discussions on the repeal of the safeguard clause and the trade-off between the repeal of the safeguard clause and the provision of improved services. Over the course of the previous meetings, the discussion had changed shape, and ultimately the link between the two items had lost its specific significance.

144. It noted that the Australian Office had been consulting vigorously with user groups and that this had been of assistance to both the Office and users alike. The two papers which the Delegation was now introducing had been submitted with a view primarily to facilitating further reflection.

145. The Delegation stated that, in substance, the proposals of both documents were the same, the first rather focusing on items for immediate action and the second aimed at the longer term. Document MM/LD/WG/5/5, which comprised much of the subject matter of the current discussion suggested an interim standard, and document MM/LD/WG/5/6 presented certain issues from a perspective of how they might look like in an ideal world. In view of the evolution of the Madrid system, it would be sensible to identify its direction and to stimulate discussion around certain issues.

146. As a result of its discussions with users, the Delegation said that it was clear that Australian users were keen that there should be greater consistency in the information provided by Offices, across the system – both in terms of *what* was provided and also the means by which that information was provided.

147. Finally, the Delegation expressed its gratitude to the Delegation of Japan for its helpful and thoughtful contribution to the discussions and the support which it had received from that delegation in helping to develop the issues under discussion.

148. The Representative of INTA expressed its gratitude to the Delegation of Australia for its contribution, and in particular, for initiating the discussions of the Working Group. It also expressed its gratitude to the Delegations of Japan and Switzerland and the Representative of MARQUES for their contributions.

149. The Delegation of the United States of America, referring to the content of document MM/LD/WG/5/6 submitted by the Delegation of Australia, welcomed the very forward looking nature of the paper.

150. The Delegation of Japan expressed its appreciation for the contribution by the Delegation of Australia. The Delegation stated that a flexible timetable should be formulated, instead of obliging all Contracting Parties to implement the proposals simultaneously. To satisfy the minimum standards, some Contracting Parties would have to amend their laws and practices and sufficient time should be allowed to those Contracting Parties.

151. With regard to the proposal in the second paper submitted by the Delegation of Australia that notifications to the holder should always go through the International Bureau, the Delegation of Japan stated that if such a practice were introduced without affecting unduly the workload of the International Bureau, it would lead to integrated administration of notifications and make the Madrid system more user-friendly. However, Japanese law required notifications to be communicated directly to the holder.

152. The Chair concluded this part of the discussion by recording that the Working Group had noted the contents of the contributions by the Delegation of Australia.

Concluding Remarks of the Chair

153. In concluding the discussions on the contributions from Australia, Japan and Switzerland, the Chair encouraged member States and the International Bureau to consider the possible implementation of the suggestions that had been put forward. He further noted that the Working Group might agree to have on the agenda of its future meetings a regular item relating to IT developments.

Proposed Modifications to the ROMARIN Database

154. The International Bureau gave a demonstration of the new information which it envisaged publishing in the ROMARIN online database. It specified that such information was aimed at cases where, while the deadline for the notification of a provisional refusal had expired, no such refusal had been recorded in the International Register. The International Bureau emphasized that the aim was to provide ROMARIN users with information which reflected that situation.

155. Responding to a question from the Delegation of Australia concerning the possibility of an erroneous entry of data in the context of this new facility in ROMARIN, the Secretariat recalled that the indication in question was not, in fact, a data recorded in the International Register, but merely a provision of information, and that in the event an error was discovered, the indication would be removed.

III. OTHER MATTERS

156. The Representative of INTA made reference to document MM/LD/WG/5/7 and thanked the International Bureau for the substantial work and effort which had gone into its preparation. He expressed also his appreciation to the Offices that had replied to the questionnaire on replacement and stated that the information contained in the document was of considerable importance and of interest to all. The document had disclosed a wide divergence of interpretation by Offices with regard to Article 4*bis* of the Agreement and Protocol.

157. The Representative made particular reference to the information concerning the responses received to questions 6 and 7 in Chapter III of the questionnaire, which showed that one quarter of respondents did not allow for full coexistence between the international registration and the replaced national registration. He noted that of the 12 respondents that did not allow coexistence, seven would cancel the national registration and three of those seven would not allow reinstatement in the event that the international registration were cancelled following a ceasing of effect within the dependency period. He said that the risk of having national rights put in danger when using the international route should be a matter of extreme concern to all users.

158. Underlining that this was only one of several issues, the Representative stated that this issue should retain the attention of the Working Group.

159. In an effort to achieve more harmonization in the operation of the replacement procedure, the Representative suggested that it might be of use to seek to complete the analysis which was the subject of the document under discussion. Thus, Contracting Parties that had not yet responded should be encouraged to do so and this could lead to a more informed discussion of the issues at a further session of the Working Group with a view to ultimately seeking to reach some convergence on the issues.

160. In response to a request for clarification by the Delegation of Germany as to whether question 6 of the questionnaire was intended to refer to situations where there had been a request for replacement, or merely a unilateral *ex officio* decision taken by an Office, the Secretariat confirmed that it was intended to refer to the latter. In light of this clarification, the Delegation of Germany indicated that it wished to revise their response to question 6, which should then read as "yes".

161. The Representative of GRUR indicated its support for the general thrust of the intervention by the Representative of INTA and noted that the examination of the replacement issue which the International Bureau had undertaken indicated an entire absence of harmonization. However, he said that this did not appear to be causing any particular concerns on the part of users, probably because of the limited use of the replacement procedure.

162. The Representative considered that it was troubling that there was this attitude towards Article 4*bis* and that it was not consistent with the reasons for which the Article had been put in place. He said that it was important to come to some common conclusions as to how its provisions should be interpreted.

163. The Delegation of Germany stated that it wished to echo the comments of the Representatives of INTA and GRUR and said that it could confirm that the Federal Government of Germany was prepared to pursue this issue, once further responses to the questionnaire had been obtained.

164. In response to a question from the Delegation of Australia, the Secretariat indicated that the total number of requests under Rule 21 communicated by Offices to the International Bureau amounted to about 850 cases in the last 12 years.

165. Referring to the future work of the Working Group, the Delegation of Australia said that, while recognizing the significant interest of the issues already on the table for discussion, he believed that the effectiveness of the Working Group would be enhanced by having a work plan. He said that the issue of whether or not to continue with the requirement of a basic mark was of fundamental importance for the system, and time would be needed to consider the implications and to allow for consultations with users.

166. The Representative of AROPI said that he welcomed the improvements that were being proposed for incorporation into the ROMARIN database and said that it should make it possible to achieve greater transparency for the benefit of users. The Representative also made reference to a paper that had been prepared by AROPI concerning the possibility of the division of international registrations. He encouraged delegates to hold discussions on this issue during future sessions of the Working Group.

167. Referring to document MM/LD/WG/4/5, the Delegation of Japan explained its proposal with respect to the future work of the Working Group. It recalled that, at the *ad hoc* Working Group sessions held in the past, Japan had spoken of certain aspects of the Madrid system which were considered a burden by Japanese users, in particular, issues that had to do with the existence of a variety of languages in the Asian region. The Delegation indicated that, in order to solve this linguistic issue, the possibility might be considered of the introduction of more flexibility in the requirement that the mark filed in an international application should be the same as the basic mark.

168. The Delegation accepted that its proposal faced two technical challenges – firstly, the possibility of relaxing the requirement of identity and, secondly, the manner in which an Office of origin should determine and certify identity. In particular, when the mark contained in the international application would be totally different from the basic mark in Japan, the issue could not be solved by merely relaxing the requirement of identity.

169. The Delegation noted that because of the importance of this issue for Asian nations, including those that had not yet joined the Madrid system, it would continue to study the matter and indicated that, at the next session of the Working Group, it would present the results of its studies.

170. Making reference to the proposal of the Delegation of Norway, which would be the subject of discussion at the next session of the Working Group, the Delegation of Japan suggested that the suppression of the requirement of a basic mark might be the best solution to the problem of linguistic diversity.

171. The Delegation of Slovenia thanked the International Bureau for the document on replacement. It said that the Office of Slovenia did not have much experience in that area and that it had therefore encountered a number of problems in responding to the questionnaire. The Delegation specified that it was in favor of continuing the work on replacement and asked the International Bureau to note a correction to the response given to question 6 in Chapter III of the questionnaire, in view of the explanations given previously by the International Bureau. It stated that, in that case, the response of the Office of Slovenia was positive (“yes”). Moreover, the Delegation said that the division of an international mark and the issues relating to division could also form part of the future work of the Working Group.

172. The Delegation of Romania said that, for the future work of the Working Group, it proposed an adjustment to Rule 27 of the Regulations. The Delegation specified that it considered the Rule to be ambiguous and that, in the context of a dispute in Romania, the Rule had caused great concern to the Romanian Office. The Delegation said that the Office had been unable to send its responses to the questionnaire on replacement owing to computer problems and apologized for that. It did, however, mention that it would submit a hard copy of its responses to the questionnaire to the International Bureau.

173. The Representative of MARQUES said that she wished to thank all of the delegates for being so responsive to the interests of users. She also referred to, and expressed her support for, the earlier proposal by the Chair that there should be a standard item in the agenda of the future sessions of the Working Group to deal specifically with the issue of IT developments. She said that, in general, she would like to see further discussions focusing on how to improve efficiency and harmonization between Offices and the International Bureau.

174. In conclusion, the Chair noted that the Working Group was encouraging Contracting Parties to submit their responses to the questionnaire, if they had not already done so. Those that had completed their responses but had not yet returned the questionnaire to the International Bureau were also encouraged to do so. The Chair noted that the Working Group had an interest in having the data in document MM/LD/WG/5/7 updated by the International Bureau as soon as additional responses became available. Finally, the Chair indicated that the Working Group had taken note of the existence of the paper mentioned by the Representative of AROPI and encouraged member States to study that document.

Future Work of the Working Group

175. Referring to the papers of the Delegations of Norway and Japan that would be the subject of discussion at the next session of the Working Group, the Chair encouraged delegates to undertake consultations in order to be fully prepared for those discussions.

176. The Chair also indicated that the Working Group had taken note of all suggestions and comments made by delegations, including the suggestion that there should be a standard agenda item as to how the Working Group should proceed, and in particular, the formulation of a work plan.

177. This report was unanimously adopted by the Working Group on May 9, 2008.

[Annexes follow]

ANNEX I

Rule 16

*Possibility of Notification of a Provisional Refusal Based on an Opposition
Under Article 5(2)(c) of the Protocol*

(1) *[Information Relating to Possible Oppositions and Time Limit for Notifying Provisional Refusal Based on an Opposition]* (a) Where a declaration has been made by a Contracting Party pursuant to Article 5(2)(b) and (c), first sentence, of the Protocol, the Office of that Contracting Party shall, where it has become apparent with regard to a given international registration designating that Contracting Party that the opposition period will expire too late for any provisional refusal based on an opposition to be notified to the International Bureau within the 18-month time limit referred to in Article 5(2)(b), inform the International Bureau of the number, and the name of the holder, of that international registration.

(b) Where, at the time of the communication of the information referred to in subparagraph (a), the dates on which the opposition period begins and ends are known, those dates shall be indicated in the communication. If such dates are not yet known at that time, they shall be communicated to the International Bureau as soon as they are known¹.

(c) Where subparagraph (a) applies and the Office referred to in the said subparagraph has, before the expiry of the 18-month time limit referred to in the same subparagraph, informed the International Bureau of the fact that the time limit for filing oppositions will expire within the 30 days preceding the expiry of the 18-month time limit and of the possibility that oppositions may be filed during those 30 days, a provisional refusal based on an opposition filed during the said 30 days may be notified to the International Bureau within one month from the date of filing of the opposition.

(2) *[Recording and Transmittal of the Information]* The International Bureau shall record in the International Register the information received under paragraph (1) and shall transmit that information to the holder.

Rule 17

Provisional Refusal

(1) *[Notification of Provisional Refusal]* (a) A notification of provisional refusal may comprise a declaration stating the grounds on which the Office making the notification considers that protection cannot be granted in the Contracting Party concerned (“*ex officio* provisional refusal”) or a declaration that protection cannot be granted in the Contracting Party concerned because an opposition has been filed (“provisional refusal based on an opposition”) or both.

¹ In adopting this provision, the Assembly of the Madrid Union understood that if the opposition period is extendable, the Office may communicate only the date the opposition period begins.

(b) A notification of provisional refusal shall relate to one international registration, shall be dated and shall be signed by the Office making it.

(2) [*Content of the Notification*] A notification of provisional refusal shall contain or indicate

- (i) the Office making the notification,
- (ii) the number of the international registration, preferably accompanied by other indications enabling the identity of the international registration to be confirmed, such as the verbal elements of the mark or the basic application or basic registration number,
- (iii) [Deleted]
- (iv) all the grounds on which the provisional refusal is based, together with a reference to the corresponding essential provisions of the law,
- (v) where the grounds on which the provisional refusal is based relate to a mark which has been the subject of an application or registration and with which the mark that is the subject of the international registration appears to be in conflict, the filing date and number, the priority date (if any), the registration date and number (if available), the name and address of the owner, and a reproduction, of the former mark, together with the list of all or the relevant goods and services in the application or registration of the former mark, it being understood that the said list may be in the language of the said application or registration,
- (vi) either that the grounds on which the provisional refusal is based affect all the goods and services or an indication of the goods and services which are affected, or are not affected, by the provisional refusal,
- (vii) the time limit, reasonable under the circumstances, for filing a request for review of, or appeal against, the *ex officio* provisional refusal or the provisional refusal based on an opposition and, as the case may be, for filing a response to the opposition, preferably with an indication of the date on which the said time limit expires, and the authority with which such request for review, appeal or response should be filed, with the indication, where applicable, that the request for review, the appeal or the response has to be filed through the intermediary of a representative whose address is within the territory of the Contracting Party whose Office has pronounced the refusal.

(3) [*Additional Requirements Concerning a Notification of Provisional Refusal Based on an Opposition*] Where the provisional refusal of protection is based on an opposition, or on an opposition and other grounds, the notification shall, in addition to complying with the requirements referred to in paragraph (2), contain an indication of that fact and the name and address of the opponent; however, notwithstanding paragraph (2)(v), the Office making the notification must, where the opposition is based on a mark which has been the subject of an application or registration, communicate the list of the goods and services on which the opposition is based and may, in addition, communicate the complete list of goods and services of that earlier application or registration, it being understood that the said lists may be in the language of the earlier application or registration.

(4) *[Recording; Transmittal of Copies of Notifications]* The International Bureau shall record the provisional refusal in the International Register together with the data contained in the notification, with an indication of the date on which the notification was sent or is regarded under Rule 18(1)(d) as having been sent to the International Bureau and shall transmit a copy thereof to the Office of origin, if that Office has informed the International Bureau that it wishes to receive such copies, and, at the same time, to the holder.

(5) *[Declarations Relating to the Possibility of Review]* (a) [Deleted]

(b) [Deleted]

(c) [Deleted]

(d) The Office of a Contracting Party may, in a declaration, notify the Director General that, in accordance with the law of the said Contracting Party,

(i) any provisional refusal that has been notified to the International Bureau is subject to review by the said Office, whether or not such review has been requested by the holder, and

(ii) the decision taken on the said review may be the subject of a further review or appeal before the Office.

Where this declaration applies and the Office is not in a position to communicate the said decision directly to the holder of the international registration concerned, the Office shall, notwithstanding the fact that all procedures before the said Office relating to the protection of the mark may not have been completed, send the statement referred to in Rule 18*ter*(2) or (3) to the International Bureau immediately following the said decision. Any further decision affecting the protection of the mark shall be sent to the International Bureau in accordance with Rule 18*ter*(4).

(e) The Office of a Contracting Party may, in a declaration, notify the Director General that, in accordance with the law of the said Contracting Party, any *ex officio* provisional refusal that has been notified to the International Bureau is not open to review before the said Office. Where this declaration applies, any *ex officio* notification of a provisional refusal by the said Office shall be deemed to constitute a statement in accordance with Rule 18*ter*(2)(ii) or (3).

[...]

Rule 18bis

Interim Status of a Mark in a Designated Contracting Party

(1) *[Ex Officio Examination Completed but Opposition or Observations by Third Parties Still Possible]* (a) An Office which has not communicated a notification of provisional refusal may, within the period applicable under Article 5(2) of the Agreement or Article 5(2)(a) or (b) of the Protocol, send to the International Bureau a statement to the effect that the *ex officio* examination has been completed and that the Office has found no grounds for refusal but that the protection of the mark is still subject to opposition or observations by third parties, with an indication of the date by which such oppositions or observations may be filed.

(b) An Office which has communicated a notification of provisional refusal may send to the International Bureau a statement to the effect that the *ex officio* examination has been completed but that the protection of the mark is still subject to opposition or observations by third parties, with an indication of the date by which such oppositions or observations may be filed.

(2) *[Recording, Information to the Holder and Transmittal of Copies]* The International Bureau shall record any statement received under this Rule in the International Register, inform the holder accordingly and, where the statement was communicated, or can be reproduced, in the form of a specific document, transmit a copy of that document to the holder.

Rule 18ter

Final Disposition on Status of a Mark in a Designated Contracting Party

(1) *[Statement of Grant of Protection Where No Notification of Provisional Refusal Has Been Communicated]*² When, before the expiry of the period applicable under Article 5(2) of the Agreement or Article 5(2)(a), (b) or (c) of the Protocol, all procedures before an Office have been completed and there is no ground for that Office to refuse protection, that Office shall, as soon as possible and before the expiry of that period, send to the International Bureau a statement to the effect that protection is granted to the mark that is the subject of the international registration in the Contracting Party concerned³.

(2) *[Statement of Grant of Protection Following a Provisional Refusal]* Except where it sends a statement under paragraph (3), an Office which has communicated a notification of provisional refusal shall, once all procedures before the said Office relating to the protection of the mark have been completed, send to the International Bureau either

(i) a statement to the effect that the provisional refusal is withdrawn and that protection of the mark is granted, in the Contracting Party concerned, for all goods and services for which protection has been requested, or

(ii) a statement indicating the goods and services for which protection of the mark is granted in the Contracting Party concerned.

(3) *[Confirmation of Total Provisional Refusal]* An Office which has sent to the International Bureau a notification of a total provisional refusal shall, once all procedures before the said Office relating to the protection of the mark have been completed and the Office has decided to confirm refusal of the protection of the mark in the Contracting Party concerned for all goods and services, send to the International Bureau a statement to that effect.

(4) *[Further Decision]* Where, following the sending of a statement in accordance with either paragraph (2) or (3), a further decision affects the protection of the mark, the Office shall, to the extent that it is aware of that decision, send to the International Bureau a further statement indicating the goods and services for which the mark is protected in the Contracting Party concerned⁴.

² In adopting this provision, the Assembly of the Madrid Union understood that a statement of grant of protection could concern several international registrations and take the form of a list, communicated electronically or on paper, that permits identification of these international registrations.

³ Where Rule 34(3) applies, the grant of protection will be subject to the payment of the second part of the fee. The same remark applies to paragraph (2).

⁴ It would be necessary to resubmit to the Assembly the Interpretative Statement that currently appears as footnote 2 (not reproduced here) to the equivalent of this provision, i.e. Rule 17(5)(b).

(5) *[Recording, Information to the Holder and Transmittal of Copies]* The International Bureau shall record any statement received under this Rule in the International Register, inform the holder accordingly and, where the statement was communicated, or can be reproduced, in the form of a specific document, transmit a copy of that document to the holder.

[...]

Rule 40
Entry into Force; Transitional Provisions

[...]

(5) *[Transitional Provision Relating to Statements of Grant of Protection]* No Office shall be obliged to send statements of grant of protection under Rule 18^{ter}(1) before January 1, 2011.

[Annex II follows]

ANNEX II

I. MEMBRES/MEMBERS

(dans l'ordre alphabétique des noms français des États)
(in the alphabetical order of the names in French of the States)

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CHINE/CHINA

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ÉQUATEUR/ECUADOR

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Luis VAYAS VALDIVIESO, First Secretary, Permanent Mission, Geneva

IRAQ

Ahmed AL-NAKASH, Third Secretary, Permanent Mission, Geneva

III. ORGANISATIONS INTERNATIONALES
INTERGOUVERNEMENTALES/
INTERNATIONAL INTERGOVERNMENTAL
ORGANIZATIONS

ORGANISATION BENELUX DE LA PROPRIÉTÉ INTELLECTUELLE
(OBPI)/BENELUX ORGANIZATION FOR INTELLECTUAL PROPERTY (BOIP)

Camille JANSSEN, juriste, La Haye

IV. ORGANISATIONS INTERNATIONALES NON GOUVERNEMENTALES/
INTERNATIONAL NON-GOVERNMENTAL ORGANIZATIONS

Association allemande pour la propriété industrielle et le droit d'auteur (GRUR)/German Association for the Protection of Industrial Property and Copyright Law (GRUR)
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Jan WREDE (Law Committee member, Antwerp)

Association des industries de marque (AIM)/European Brands Association (AIM)
Jean BANGERTER (Representative, Lausanne)

Association internationale pour les marques (INTA)/International Trademark Association (INTA)
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Union des praticiens européens en propriété industrielle (UNION)/Union of European Practitioners in Intellectual Property (UNION)
Laurent OVERATH (vice-président, Commission des marques)

V. BUREAU/OFFICERS

Président/Chair:	António CAMPINOS (Portugal)
Vice-présidents/Vice-Chairs:	CHAN Ken Yu Louis (Singapour/Singapore)
	Debbie RØNNING (Ms.) (Norvège/Norway)
Secrétaire/Secretary:	Grégoire BISSON (OMPI/WIPO)

VI. **SECRETARIAT DE L'ORGANISATION MONDIALE DE LA
PROPRIÉTÉ INTELLECTUELLE (OMPI)/
SECRETARIAT OF THE WORLD INTELLECTUAL
PROPERTY ORGANIZATION (WIPO)**

Ernesto RUBIO, sous-directeur général/Assistant Director General

Secteur des marques, des dessins et modèles industriels et des indications géographiques/
Sector of Trademarks, Industrial Designs and Geographical Indications:

Grégoire BISSON, chef du Service juridique des systèmes d'enregistrement international/
Head, International Registration Systems Legal Service

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[End of Annex II and of document]