

WIPO



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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

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

Sixth Session
Geneva, November 24 to 26, 2008

SUMMARY BY THE CHAIR

approved by the Working Group

1. 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 November 24 to 26, 2008.
2. The following Contracting Parties of the Madrid Union were represented at the session: Algeria, Antigua and Barbuda, Australia, Austria, Belgium, Bosnia and Herzegovina, China, Cuba, Czech Republic, Denmark, Estonia, European Community, Finland, France, Germany, Ghana, Hungary, Iran (Islamic Republic of), Italy, Japan, Latvia, Lithuania, Montenegro, Netherlands, Norway, Portugal, Republic of Korea, Republic of Moldova, Romania, Russian Federation, Serbia, Sierra Leone, Singapore, Slovenia, Spain, Sudan, Sweden, Switzerland, Tajikistan, The former Yugoslav Republic of Macedonia, Turkey, Ukraine, United Kingdom, United States of America (44).
3. The following States were represented by observers: Argentina, Brazil, Canada, Ecuador, Jamaica, Jordan, Mexico, Qatar, Thailand (9).
4. A representative of the following international intergovernmental organization (IGO) took part in the session in an observer capacity: Benelux Organisation for Intellectual Property (BOIP) (1).

5. Representatives of the following international non-governmental organizations (NGOs) took part in the session in an observer capacity: 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 Chamber of Commerce (ICC), International Federation of Industrial Property Attorneys (FICPI), International Trademark Association (INTA), Japan Patent Attorney Association (JPAA), Japan Trademark Association (JTA), MARQUES (Association of European Trademark Owners) (11).
6. The list of participants is contained in document MM/LD/WG/6/INF/1.

Agenda Item 1: Opening of the session

7. Mr. Francis Gurry, Director General of WIPO, opened the session and welcomed the participants.
8. Mr. Ernesto Rubio, Assistant Director General, introduced the Draft Agenda.

Agenda Item 2: Election of a Chair and two Vice-Chairs

9. Mr. António Campinos (Portugal) was unanimously elected as Chair of the Working Group, and Mr. Chan Ken Yu Louis (Singapore) and Mr. Vladimir Oplachko (Russian Federation) were elected as Vice-Chairs.
10. Mr. Grégoire Bisson (WIPO) acted as Secretary to the Working Group.

Agenda Item 3: Adoption of the Agenda

11. The Working Group adopted the Draft Agenda (document MM/LD/WG/6/1 Prov. 2) without modification.

Agenda Item 4: Contribution by Japan and Revised Proposal by Norway

12. The Working Group took note of the proposal by the Delegation of Norway and of the contribution by the Delegation of Japan for the future legal development of the Madrid system, contained in documents MM/LD/WG/6/2 and MM/LD/WG/6/3 respectively, and thanked those Delegations for their contributions. Discussions were based on those two documents and on document MM/LD/WG/6/5, prepared by the Secretariat, and entitled “Considerations Relating to the Proposal by Norway”.

13. At the conclusion of the discussions, the Working Group requested the Secretariat to prepare two documents for the Working Group session in the second half of 2009, as follows:

– a first document exploring how, in the absence of the requirement of a basic mark, a mechanism of “central attack” of the international registration could be envisaged, so as to ensure a fair balance between the interests of holders of international registrations on the one hand and third parties on the other. The document would contain also, where possible, relevant statistical data on the system of central attack;

– a second document assessing, in the absence of the requirement of a basic mark, what tasks would be required to be performed with respect to the filing of an international application, and by whom. To that end, the Secretariat would circulate a questionnaire among the Offices of the Contracting Parties to the Madrid system in the early part of 2009, in order to gather information on the range and level of services and tasks that they currently provide and carry out as Offices of origin, in the context of both the international registration procedure, and national/regional registration procedures to the extent that the latter benefit an international application. The questionnaire should also enquire as to what might ensure that users continue to receive at least the level of support and services they currently receive from national/regional Offices, and as to the readiness of such Offices to continue to provide such support and services, in the absence of the requirement of a basic mark. The questionnaire would distinguish between those tasks and services that are mandated by the Madrid treaties and those that are not. Furthermore, in order to establish a context for discussions, the document would contain, where available, statistical data relating to operational aspects of the work carried out by the International Bureau.

14. On the basis of the Contribution by Japan, the Working Group had a useful exchange of views on the questions concerning the risk of cancellation of an international registration on grounds of non-use of the basic mark. Several delegations commented upon their experience in seeking solutions to the problem at their domestic level, through a flexible definition of the use requirement. Other delegations noted that if use is required only within five years from the registration of the basic mark, it is likely that the international registration will not be at risk. The Working Group agreed to continue to keep in mind the question of linguistic diversity in its future work.

Agenda Item 5: Model Forms

15. Discussions were based on document MM/LD/WG/6/4 “Information Relating to the Fate of Designations; Revised Model Forms for Offices of Contracting Parties”. The Working Group indicated its approval of the revised model forms, for use by Offices of Contracting Parties, with slight amendments to Model Form 8, as reproduced in the Annex hereto.

Agenda Item 6: Other Matters, Including Discussion on Future Work

16. The International Bureau provided an update on recent IT developments concerning the international registration procedure under the Madrid system.

17. The Chair recalled that the Working Group would hold two sessions in 2009, the first one from June 2 to 5, and the second one either late November or early December.

18. The Working Group agreed that the June session would focus on the study on the introduction of additional filing languages in the Madrid system, with a view to making recommendations to the Assembly of the Madrid Union in that respect.

19. The Working Group agreed to continue discussions on the topic of the future development of the Madrid Protocol at its eighth session in the second half of 2009 on the basis of, *inter alia*, the two papers requested from the Secretariat, as referred to in paragraph 13, above.

20. Following an invitation by the Chair, some delegations and representatives suggested other items for possible future work, as follows: the possibility for Contracting Parties to issue communications concerning the acquired distinctiveness of the mark; the communication to Offices of the date of notification of provisional refusals; the review envisaged under Article 9*sexies*(2) of the Madrid Protocol and the future of the Madrid Agreement; and finally, the issue of replacement. With regard to the latter, the Chair invited representatives of users to make their views known.

Agenda Item 7: Summary by the Chair

21. The Working Group approved the Summary by the Chair as contained in the present document.

Agenda Item 8: Closing of the Session

22. The Chair closed the Session on November 26, 2008.

[Annex follows]

ANNEX

Model Form 8

MADRID AGREEMENT AND PROTOCOL

COMPLETION OF *EX OFFICIO* EXAMINATION

– INTERIM STATUS OF A MARK –

Rule 18bis(1)(a) and (b)

This form is to be used in the following situation: the Office confirms that ex officio examination has been completed, but protection of the mark is still subject to possible opposition or observations by third parties.

NOTE: *This statement may optionally be sent by an Office following ex officio examination, including in situations where the Office had notified a provisional refusal, but ex officio procedure has been completed favorably for the holder.*

If, following the present statement, opposition is filed, or observations leading to a refusal are filed, a Provisional Refusal of Protection (Model Form 3) should be sent in due course.

If no opposition is filed or no observations leading to a refusal are filed, the present statement should be followed by a Statement of Grant of Protection (Model Form 4 or, where the mark had first been the subject of an ex officio provisional refusal, but the ex officio procedure has been completed favorably for the holder, Model Form 5).

I.	Office sending the statement:
II.	Number of the international registration:
III.	Name of the holder (or other information enabling the identity of the international registration to be confirmed):
IV.	A notification of provisional refusal: <input type="checkbox"/> has not been communicated by the Office (Rule 18bis(1)(a)) <input type="checkbox"/> has been communicated by the Office (Rule 18bis(1)(b))
V.	Date by which opposition or observations may be filed:
VI.	Signature or official seal of the Office sending the statement:
VII.	Date: