

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

**Eighth Session
Geneva, July 5 to 9, 2010**

SUMMARY BY THE CHAIR

adopted 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 July 5 to 9, 2010.
2. The following Contracting Parties of the Madrid Union were represented at the session: Algeria, Australia, Austria, Belgium, Bhutan, China, Cuba, Cyprus, Czech Republic, Denmark, Egypt, European Union, Finland, France, Germany, Ghana, Greece, Hungary, Iran (Islamic Republic of), Israel, Japan, Kazakhstan, Kenya, Latvia, Madagascar, Mongolia, Morocco, Netherlands, Norway, Poland, Portugal, Republic of Korea, Romania, Russian Federation, Serbia, Singapore, Slovenia, Spain, Sudan, Sweden, Switzerland, Tajikistan, Turkey, Ukraine, United States of America and Viet Nam (46).
3. The following State was represented by an observer: Iraq (1).
4. Representatives of the following international intergovernmental organizations (IGOs) took part in the session in an observer capacity: Benelux Organisation for Intellectual Property (BOIP) and the League of Arab States (LAS) (2).
5. Representatives of the following international non-governmental organizations (NGOs) took part in the session in an observer capacity: American Intellectual Property Law Association (AIPLA), European Communities Trade Mark Association (ECTA), International Trademark Association (INTA), Japan Patent Attorneys Association (JPAA) and Japan Trademark Association (JTA) (5).
6. The list of participants is contained in Annex II to this Summary.

Agenda Item 1: Opening of the session

7. The session was opened by Mr. Francis Gurry, Director General.

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

8. Mrs. Vesela Venisnik (Slovenia) was unanimously elected as Chair of the Working Group, and Ms. Nancy Omelko (United States of America) and Mr. Mustafa Dalkiran (Turkey) were elected as Vice-Chairs.
9. Ms. Debbie Rønning, Director of the Legal and Promotion Division of the International Registries of Madrid and Lisbon (WIPO) acted as Secretary to the Working Group.

Agenda Item 3: Adoption of the Agenda

10. The draft agenda (document MM/LD/WG/8/1 Prov.) was introduced by the Chair. The Working Group adopted the draft agenda (document MM/LD/WG/8/1), with the inclusion of an additional item entitled "Other Matters". The adopted agenda is attached as Annex I to this Summary.

Agenda Item 4: Adoption of the Draft Report of the Seventh Session of the Working Group on the Legal Development of the Madrid System for the International Registration of Marks

11. The Working Group adopted the draft report of the seventh session of the Working Group, as contained in document MM/LD/WG/7/5 Prov., without comment.

Agenda Item 5: Analysis of Procedures and of Central Attack in the Absence of a Basic Mark

In the absence of the requirement of a basic mark, analysis of the tasks that would be required to be performed with respect to the filing of an international application, and by whom.

12. Discussions were based on documents MM/LD/WG/8/2 and MM/LD/WG/8/3..
13. Upon completion of the discussions, the Chair concluded as follows:
 - (a) A substantial number of delegations expressed the need for caution and prudence, and voiced concerns with regard to the possible consequences of such a fundamental change, felt to be premature, in the procedures under the Madrid system, in particular, in terms of the efficiency of the system and the effects which such a change might have for the users of the system; and with regard to the important role of Offices, as Offices of origin, the services provided by those Offices and the need to maintain those services.
 - (b) On the other hand, a number of delegations expressed an interest in continuing further analysis and study of the issue of the possible suppression of the requirement of a basic mark. Those delegations suggested that a further document might be prepared by the Secretariat, in the form of an options paper. That document would address the implications of the abolition of the requirement of a basic mark and the potential advantages and disadvantages of such a step.

(c) Having given due consideration to the matter under discussion, the Working Group agreed as follows:

- (i) The Working Group underlined the need for, and the importance of having, a system that is, as far as possible, simple, efficient, reliable, flexible, user friendly and time- and cost-effective.
- (ii) The Working Group will defer the discussion of the issue in order to enable Offices to consult with their stakeholders, in particular, the users of the Madrid system. Such further consultations will serve as a valuable basis for any future discussion by the Working Group concerning the issue of the requirement of a basic mark.
- (iii) The Working Group also approved the proposal of the Secretariat that the next meeting will be devoted to discussion of matters aimed at simplification of internal processes at the International Bureau, in order to make the Madrid system more efficient for all parties – applicants, mark holders, Offices and the International Bureau itself. This exercise may entail amendments to the Common Regulations to be discussed at the ninth session of the Working Group. The Working Group will also discuss the proposal made by the Delegation of Switzerland regarding the issue of division of international registrations, on the basis of the results of a questionnaire sent out to Contracting Parties.
- (iv) The agenda for the next, and following, sessions of the Working Group shall include an Agenda item entitled “Legal Development of the Madrid System”. Under this Agenda item, the Working Group may revisit the issue of the requirement of a basic mark.
- (v) Any proposal by delegations for items to be included for discussion under this Agenda item should be submitted to the International Bureau in accordance with the general rules of procedure and in good time.

How could a mechanism for central attack be envisaged in the absence of a basic mark?

14. Discussions were based on document MM/LD/WG/8/4.
15. The Chair concluded that more precise statistics need to be established in order to carry out further analysis and study as to the real incidence of central attack.
16. The Working Group agreed that the Offices would furnish, where possible, to the International Bureau, additional relevant information concerning the underlying grounds, when notifying to the International Bureau ceasings of effect in accordance with the provisions of Rule 22 of the Common Regulations. In addition, statistics concerning the incidence of transformation would be furnished, where possible.
17. It was understood that the furnishing of such additional information by Offices would not be mandatory.
18. The period during which Offices would be expected to furnish such additional information would be the period from July to December 2010.
19. Based upon the data obtained by the International Bureau during this period, the Secretariat would prepare a document for the next session of the Working Group. That document would merely present the data, for the consideration of the Working Group. The document would not seek to analyze or otherwise comment on the data.
20. In order to facilitate this exercise, the International Bureau would prepare an information document which will be circulated to the Offices of all Contracting Parties as soon as possible.

21. The Secretariat would also take steps to establish an electronic forum concerning the issues of the requirement of a basic mark and of central attack. Delegates would be able to post in the forum comments or suggestions regarding the future development of the Madrid system. The details, timing and functionality of the electronic forum would be drawn up by the Secretariat after the conclusion of the current session of the Working Group.

Agenda Item 6: Update on ongoing projects under the Madrid system

22. A presentation on the Madrid System Goods and Services Database was made by Mr. Ernesto Rubio, Senior Director-Advisor and Mrs. Isabelle Vicedo, Officer-in-Charge, Goods and Services Database Project.
23. A further presentation was made by Mr. Neil Wilson, Director, Functional Support Division, entitled "Improving Communication in the Madrid System".
24. Both of these presentations were warmly received and welcomed by the delegations, who expressed their appreciation for the advances being made and the efforts being undertaken by the International Bureau, in the context of the wider development of the system, to the benefit of all concerned.

Agenda Item 7: Other Matters

25. A proposal was made by the Delegation of the United States of America, supported by the Delegations of the European Union, Japan, Kenya, Morocco, Norway, the Republic of Korea, Romania, Singapore, Turkey and also by the Representative of the INTA, for the electronic adoption of the draft report of future sessions of the Working Group. The Delegation of the United States of America outlined the procedures that might be put in place for electronic adoption of the report.
26. The proposal by the Delegation of the United States of America was adopted by the Working Group.

Agenda Item 8: Summary by the Chair

27. The Working Group approved the Summary by the Chair, as contained in the present document, as amended to take account of the interventions of a number of delegations.

Agenda Item 9: Closing of the Session

28. The session was closed on July 8, 2010.

[Annexes follow]



Working Group on the Legal Development of the Madrid System for the International Registration of Marks

Eighth Session
Geneva, July 5 to 9, 2010

Agenda

adopted by the Working Group

1. Opening of the session
2. Election of a Chair and two Vice-Chairs
3. Adoption of the Agenda
See the present document.
4. Adoption of the Draft Report of the Seventh Session of the Working Group on the Legal Development of the Madrid System for the International Registration of Marks
See document MM/LD/WG/7/5 Prov.
5. Analysis of procedures and of central attack in the absence of a basic mark
See documents MM/LD/WG/8/2, MM/LD/WG/8/3 and MM/LD/WG/8/4.
6. Update on ongoing projects under the Madrid system
7. Other matters
Electronic adoption of the Working Group reports
8. Summary by the Chair
9. Closing of the session

[Annex II follows]

I. MEMBRES/MEMBERS

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

ALGÉRIE/ALGERIA

Hakim TAOUSAR, directeur général de l'Institut algérien de la propriété industrielle (INAPI), Alger

ALLEMAGNE/GERMANY

Li-Feng SCHROCK, Senior Ministerial Counsellor, Federal Ministry of Justice, Berlin

Carolyn HÜBENETT (Ms.), Head, International Registration Team, Trademarks, Utility Models and Industrial Designs, Munich

AUSTRALIE/AUSTRALIA

Robyn FOSTER (Ms.), General Manager, Trade Marks and Designs, IP Australia, Woden ACT

Julie BAXTER (Ms.), Assistant Director, Trade Marks and Designs, IP Australia, Philip ACT

AUTRICHE/AUSTRIA

Tanja WALCHER (Mrs.), Legal Department, Austrian Patent Office, Vienna

BELGIQUE/BELGIUM

Leen DE CORT (Mlle), attaché, Office de la propriété intellectuelle, Direction générale de la régulation et de l'organisation du marché, Bruxelles

Monique PETIT (Mme), attaché au Service d'affaires juridiques et internationales, Office de la propriété intellectuelle, Direction générale de la régulation et de l'organisation du marché, Bruxelles

BHOUTAN/BHUTAN

Yeshi LHAMO (Miss), Intellectual Property Officer, Intellectual Property Division, Ministry of Economic Affairs, Thimphu

CHINE/CHINA

DUAN Chuane (Mrs.), Deputy Director of Division, State Administration for Industry and Commerce (SAIC), Beijing

CHYPRE/CYPRUS

Christina TSENTA (Ms.), Attaché, Permanent Mission, Geneva

CUBA

Clara Amparo MIRANDA VILA (Sra.), Jefa del Departamento de Marcas y Otros Signos Distintivos, Oficina Cubana de la Propiedad Industrial (OCPI), La Habana

DANEMARK/DENMARK

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Mikael Francke RAVN, Senior Legal Advisor, Danish Patent and Trademark Office, Ministry of Economic and Business Affairs, Taastrup

Anja M. BECH HORNECKER (Ms.), Special Legal Advisor, International Affairs, Danish Patent and Trademark Office, Ministry of Economic and Business Affairs, Taastrup

ÉGYPTE/EGYPT

Amr HEGAZY, Head, Egyptian Trademarks and Industrial Designs Office, Internal Trade Development Authority (ITDA), Cairo

ESPAGNE/SPAIN

José María DEL CORRAL PERALES, Subdirector General Adjunto, Departamento de Signos Distintivos, Oficina Española de Patentes y Marcas (OEPM), Madrid

ÉTATS-UNIS D'AMÉRIQUE/UNITED STATES OF AMERICA

Jennifer CHICOSKI (Ms.), Staff Attorney, Office of the Commissioner for Trademarks, United States Patent and Trademark Office (USPTO), Department of Commerce, Alexandria

Nancy OMELKO (Ms.), Attorney–Advisor, Office of External Affairs, United States Patent and Trademark Office (USPTO), Department of Commerce, Alexandria

FÉDÉRATION DE RUSSIE/RUSSIAN FEDERATION

Vladimir G. OPLACHKO, Head, International Cooperation Department, Federal Service for Intellectual Property, Patents and Trademarks (ROSPATENT), Moscow

Maria KARABANOVA (Mrs.), Deputy Head of Trademark Examination Division, Federal Institute of Industrial Property (FIPS), Federal Service for Intellectual Property, Patents and Trademarks (ROSPATENT), Moscow

FINLANDE/FINLAND

Päivi RAATIKAINEN (Ms.), Deputy Director, Trademarks and Designs Line, National Board of Patents and Registration, Helsinki

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Thanaa Abdul SALAM MUHAMAD, Head Manager, Trademark Section, Ministry of Industry and Minerals, Baghdad

Uday Adnan IBRAHIM, Third Secretary, Permanent Mission, Geneva

III. ORGANISATIONS INTERNATIONALES INTERGOUVERNEMENTALES/ INTERNATIONAL INTERGOVERNMENTAL ORGANIZATIONS

Ligue des États arabes (LEA)/League of Arab States (LAS)

Maha BAKHIET ZAKI (Mrs.), Head, Intellectual Property Unit, Cabinet of the Secretary General, Cairo

Organisation Benelux de la propriété intellectuelle (OBPI)/Benelux Organization for Intellectual Property (BOIP)

Camille JANSSEN, juriste au Département des affaires juridiques, La Haye

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

Association américaine du droit de la propriété intellectuelle (AIPLA)/American Intellectual Property Law Association (AIPLA)

Michael BALLARD, Vice-Chair, Trademark Treaties and International Law Committee, Arlington

Association communautaire du droit des marques (ECTA)/European Communities Trade Mark Association (ECTA)

Florent GEVERS, Member, Law Committee and Chair, Geographical Indications Committee, Brussels

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Association internationale pour les marques/International Trademark Association (INTA)

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Chiaki KAWAI (Ms.), Patent-Trademark Attorney, Seijo

V. BUREAU/OFFICERS

Président/Chair:	Vesela VENISNIK (Mme/Mrs.) (Slovénie/Slovenia)
Vice-présidents/Vice-chairs:	Nancy OMELKO (Mme/Mrs.) (États-Unis d'Amérique/United States of America)
	Mustafa DALKIRAN (Turquie/Turkey)
Secrétaire/Secretary:	Debbie RØNNING (Mme/Mrs.) (OMPI/WIPO)

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

Binying WANG (Mme/Mrs.), vice-directrice générale/Deputy Director General

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Isabelle VICEDO (Mme/Mrs.), administratrice chargée du projet, Projet de base de données sur les produits et les services, Secteur des marques et des dessins et modèles/Officer-in-charge, Goods and Services Database Project, Brands and Designs Sector

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Kazutaka SAWASATO, consultant à la Section juridique, Division des questions juridiques et de la promotion, Services d'enregistrement international de Madrid et de Lisbonne, Secteur des marques et des dessins et modèles/Consultant, Legal Section, Legal and Promotion Division, International Registries of Madrid and Lisbon, Brands and Designs Sector