

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

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

### **REPORT**

*adopted by the Working Group*

### **INTRODUCTION**

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”) held its eighth session, 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 Office for Intellectual Property (BOIP) and the League of Arab States (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 the Annex to this Report.

#### Agenda Item 1: Opening of the Session

7. Mr. Francis Gurry, Director General of the World Intellectual Property Organization (WIPO), opened the session and welcomed the participants.

8. Mr. Gurry stated that before the discussions of the Working Group commenced, he wished to recall some of the latest developments concerning the Madrid system that had taken place since the Working Group last met in July 2009.

9. With regard to the membership of the Madrid Union, Mr. Gurry noted that, in the second half of 2009, WIPO had received the instruments of accession to the Madrid Protocol of Liberia and Sudan, thus bringing the number of Contracting Parties of the Madrid Protocol to 82. Mr. Gurry said that just three members of the Madrid Union remained bound by the Agreement only - Algeria, Kazakhstan and Tajikistan. He noted that there had been some important developments with regard to the possible accession to the Protocol by Kazakhstan.

10. Mr. Gurry also welcomed the recent accession to the Madrid Protocol by Israel, effective as from September 1, 2010. He spoke, additionally, of the considerable interest in the Madrid system on the part of a number of States in the Latin-American region and mentioned that, in particular, Colombia was probably the country that had progressed furthest, in this regard. Finally, he spoke of the interest that is being expressed by a number of countries in the Asian region, most notably, India, Malaysia, the Philippines and Thailand.

11. With regard to filing activity, Mr. Gurry stated that last year the Madrid system had felt the full impact of the economic crisis. Filings had fallen over the course of 2009 by 16 percent. In terms of international applications, the overall number had fallen from some 42,000 to 35,000, when compared with the previous year. However, he noted that in the first six months of the current year, there had been an increase in filings of 10 percent.

12. In terms of the International Register, Mr. Gurry stated that at the end of 2009, over half a million active international registrations stood recorded, containing some 5.6 million active designations. This was an overall increase of 2.4 percent, when compared with the end of 2008.

13. Concerning the provision of information to users of the Madrid system, Mr. Gurry spoke of the notification of statements of grant of protection, and in particular, the digitization of such notifications, and the making available of digitized copies of the notifications on the ROMARIN database. He said that this initiative had been a very positive response to a perceived need in the system, which had been achieved through the efforts of the Working Group.

14. Mr. Gurry spoke of the increased use of electronic communications in the Madrid system, noting that 37 percent of international applications are now filed electronically. He said that, increasingly, the data flows between Offices and the International Bureau were being conducted electronically.

15. Finally, Mr. Gurry stated that the International Bureau was very conscious that further improvements needed to be made, particularly in terms of customer-service orientation. In this regard, he spoke of the establishment of a dedicated customer assistance team, which had been created under WIPO's new strategic framework for the building of a responsive communications interface with WIPO's customers.

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

16. 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.

17. 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

18. The Delegation of the United States of America proposed the inclusion of a new item number 7 entitled "Other Matters". Under that Agenda item, the Delegation said that it would be intending to propose the future electronic adoption of reports of the Working Group.

19. In response to a query from the Delegation of the Russian Federation, supported by the Delegation of the Republic of Korea, concerning the project for the possible introduction of additional filing languages, the Secretariat recalled that this matter had been the subject of discussions at the last session of the Working Group. The Secretariat noted that this issue was also closely related to the project regarding the WIPO database of acceptable indications of goods and services, and that a presentation of that project was due to take place later during the course of the present session of the Working Group, under the Agenda item "Update on ongoing projects under the Madrid system". The Secretariat also confirmed its willingness to discuss the matter directly with the Delegation of the Russian Federation, for the purpose of clarifying matters that might require clarification.

20. The Working Group adopted the draft agenda (document MM/LD/WG/8/1 Prov.), as amended to take account of the proposal from the Delegation of the United States of America, concerning electronic adoption of reports of the Working Group under Agenda item 7, "Other Matters". What had been Agenda items 7 and 8 in the draft Agenda, namely, "Summary by the Chair" and "Closing of the session", then became Agenda items 8 and 9, respectively, in the Agenda, as adopted.

#### 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 (document MM/LD/WG/7/5/ Prov.)

21. 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 (document MM/LD/7/5/ Prov.) was adopted without amendment.

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

22. Discussions were based on documents MM/LD/WG/8/2, MM/LD/WG/8/3. and MM/LD/WG/8/4.

*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, and statistical information related to the operations of the International Bureau.*

23. This part of the discussions of the Working Group was based on documents MM/LD/WG/8/2 and MM/LD/WG/8/3., respectively, which were introduced by the Secretariat.

24. The Delegation of the European Union stated that the European Union and its twenty-seven member States wished to reaffirm their commitment to the work of the Working Group and wished also to thank the Secretariat for its work and, in particular, for its analysis of the tasks that would be required to be performed with respect to the filing of an international application, and by whom, in the absence of a basic mark requirement.

25. The Delegation said that it wished to emphasize the general support of the European Union for the development of the Madrid system, with the aim of making the system more efficient and attractive for users. The Delegation noted, however, that it had been found that the present system was working well and that the adoption of fundamental changes to the system, such as the proposal for the removal of the basic mark requirement, should be considered with great caution and not without having a clear and complete picture of the impact of such a step, and, in particular, its impact on users.

26. The Delegation stated that document MM/LD/WG/8/2 raised concerns that the abolition of the requirement of a basic mark could have negative implications on the level of support and services being provided to users and that it might, ultimately, have negative consequences in the context of the overall perception of the Madrid system, in terms of its efficiency, effectiveness and user-friendliness. The Delegation of the European Union said that two important aspects had not yet been addressed by the Working Group, as had been made clear in document MM/LD/WG/8/2, namely, the filing structure that might exist in the event of the suppression of the basic mark requirement, and whether a new regime would allow for self-designation.

27. The Delegation of the European Union went on to point to the ongoing evaluation of the overall functioning of the trademark system in the European Union, the results of which would be available in November 2010. The Delegation suggested that the outcome of that internal study be awaited, before any firm decision is taken with respect to the issue of the requirement of a basic mark in the Madrid system.

28. The Delegation of Morocco spoke of the importance and usefulness of the information contained in document MM/LD/WG/8/2, allowing for discussion of the relevance of a basic mark in the Madrid system, and underlined the need to ensure that the Madrid system maintained its simplicity and efficiency, both for users and for Offices.

29. The Delegation of Japan stated that the proposal concerning the possible deletion of the requirement of a basic mark might be one of the ways to resolve the problem of linguistic diversity under the Madrid system, as it currently stands. For this reason, the Delegation said that it supported the discussion of the issue. However, the Delegation of Japan noted that it was necessary to proceed with care, and in particular, to bear in mind certain facts.

30. Firstly, the Delegation noted, was the need to have a fair and precise analysis of the role of the Office, as Office of origin, in the international application and registration procedure. Secondly, consideration should be given to the future workload of the International Bureau, in the event that the requirement of a basic mark were to be suppressed. Finally, the Delegation made reference to paragraphs 90 to 92 of document MM/LD/WG/8/2, concerning ongoing projects, and expressed its interest in establishing how effectively those projects might contribute to the future framework of the Madrid system, in the absence of a basic mark requirement. In any event, any new framework should ensure that the Madrid system would maintain its merits, in terms of simplicity, cost-effectiveness and user-friendliness.

31. The Delegation of Madagascar advised caution, given the fundamental nature of the changes being proposed, so that the advantages offered by the Madrid system may be preserved, namely, its cost-effectiveness and efficiency. In this context, the Delegation expressed its wish that solutions be sought, not only in applicants' and third parties' interests, but also taking into account the implications for the International Bureau and for the Industrial Property Offices of the Contracting Parties, as important actors in the system.

32. The Delegation of the Republic of Korea said that it supported what had been stated by the Delegation of Japan and recalled the customer-oriented focus of the Madrid system, which had been referred to by the Director General in his introductory remarks. The Delegation said that it believed that the current framework of the Madrid system lacked certain aspects of user-friendliness, and spoke of the situation as it pertains in the intellectual property office of that Delegation. In particular, the Delegation raised the issue of central attack, which affected 10 percent of international registrations originating from that Office. This was resulting in anxiety on the part of potential users of the Madrid system in the Republic of Korea. For this reason, the Delegation stated that it believed that the discussions concerning the requirement of a basic mark and the issue of central attack were very important.

33. The Delegation of Australia said that it supported the modernization of the Madrid system, taking the system into the twenty-first century. It noted the importance of continuing to simplify the system and reduce bureaucracy. The Delegation stated that the current requirement of a basic mark and the system of central attack were designed in a commercial environment that has now changed.

34. The Delegation, supporting what had been said by the Delegations of Japan and the Republic of Korea, said that having in place a system that restricts exporters from trading effectively offshore simply did not make sense, from an economic or policy perspective. For this reason, it supported further analysis and discussion of the issues, by the Working Group, and said that, in the *interim*, it would encourage Contracting Parties to consult with their users. The Delegation confirmed that the Australian Office had conducted such consultations, but did not believe that many other Offices had committed to doing so.

35. The Delegation of China said that it believed that the proposal by Norway was very constructive, in terms of simplification of the international procedure under the Madrid system. However, drawing from its own experience of the Madrid system, the Delegation confirmed that China would favor maintaining the existing framework.

36. The Representative of the International Trademark Association (INTA) said that the discussion documents went a long way towards casting light on the implications of the proposal by Norway, and on the concerns that had been expressed by delegations and representatives of users in the previous session of the Working Group which had been dedicated to the examination of the proposal by Norway. The Representative stated that the discussion documents also went a long way towards considering ways in which those concerns might be addressed.

37. The Representative stated also that the historical background which had been provided in document MM/LD/WG/8/4 demonstrated that the limits of the flexibility of the Madrid system had not yet been reached. In particular, that document showed that the current *continuum* between Office of origin, basic mark, dependence and central attack could be, so to speak, unpackaged. In fact, one could well conceive of central attack without total dependence on the basic mark, and even without a basic mark at all. Similarly, one could conceive of an Office of origin, without a basic mark, and this opened interesting perspectives.

38. The Representative of INTA went on to state that users did appreciate the role played by Offices of origin and realized that the removal of the basic mark requirement, coupled with the removal of national Offices as Offices of origin, could have significant practical impacts that would need to be carefully considered.

39. Finally, the Representative of INTA said that the message conveyed in paragraph 85 of document MM/LD/WG/8/4 had been received loud and clear. That is to say, the proposal by Norway did indeed offer an opportunity to address perceived weaknesses in the Madrid system, but this must not be at the expense of the simplicity and cost-effectiveness of the international registration procedure. In particular, in considering possible alternatives to a system of central attack, the Representative said that it would be necessary to weigh very carefully the expected benefits of such mechanisms and the complexity that they might inevitably introduce into the Madrid system.

40. The Representative of the European Communities Trade Mark Association (ECTA) made reference to a discussion document, prepared by ECTA, which had been made available to the delegations at this session of the Working Group.

41. The Representative of ECTA underlined the need to proceed with the utmost caution. Referring to document MM/LD/WG/8/2, the Representative said that it showed the virtue of deleting the requirement of a basic mark, but what was lacking was an analysis of the virtues of the existing system, in order to compare the virtues of one against the other, in terms of the benefits for users.

42. The Representative of ECTA spoke also of the possibility of ameliorating perceived problems in the Madrid system and referred, as an example, to the proposal by the Delegation of Norway that, after five years, the mark that is the subject of the basic registration could be amalgamated into the international registration.

43. The Representative of ECTA stated that the main arguments that had emerged in favor of the suppression of the basic mark requirement had come from the Trademark Registration Treaty (TRT) and noted that the TRT had not been a significant success. The Representative therefore questioned the strength of those arguments and also noted that, when the Madrid Protocol was being discussed, the issue of the requirement of a basic mark did not appear to be a matter of great concern. Thus, said the Representative, it was somewhat of a surprise that that issue now appeared to be of great interest.

44. The Delegation of Switzerland stated that it regretted that the discussion documents had been made available to the delegations only at a late date, which had made consultation among interested circles impossible – particularly, given the great importance of consultation in the context of the present discussions. For that reason, the Delegation requested that the International Bureau complement the documents under discussion, with further concrete information regarding the legal and practical advantages and disadvantages, for all parties concerned – that is to say, the International Bureau, Offices and applicants – of, on the one hand, a system which would envisage the requirement of a basic mark, and, on the other hand, a system in which there would not be such requirement.

45. This additional documentation would comprise a detailed analysis of the future role of Offices as Offices of origin and of the different possibilities in the event of the suppression of the requirement of a basic mark. The analysis would also examine possible amendments to the Common Regulations, so as to illustrate, in practice, what changes might be envisaged.

46. The Delegation of Switzerland confirmed its readiness to provide information regarding the incidence, in its Office, of notifications of ceasing of effect and transformation, as suggested by the International Bureau. The Delegation said that it would wish that any such new document would be made available to delegations as early as possible, and at least two months before the next session of the Working Group, in order to enable delegations to consult with stakeholders and to examine the issues in detail. The Delegation said that it was in favor of all changes that would lead to simplicity and efficiency in the Madrid system. However, it would be only when such additional documentation were made finally available that delegations would be able to assess the full nature, and the merit, of the changes being proposed.

47. The Delegation of Kazakhstan made an announcement concerning progress, at the national level, regarding its accession to the Madrid Protocol.

48. The Delegation of Norway, echoing what had been expressed by many previous delegations, communicated to the Secretariat its appreciation for the discussion documents that had been prepared by the International Bureau, along with the contributions that had been received from different Offices, and the willingness to address the current legal framework under the Madrid system. The Delegation said that the documents show the complex history of the Madrid system and also make reference to some fundamental principles, including Article 6(3) of the Paris Convention.

49. The Delegation stated that more thorough discussion of the issues was required and expressed the need also for more input from trademark owners. It stated its belief in the continuing merit of its proposal and said that the Working Group should continue to study the proposal, and any additional proposals.

50. Finally, the Delegation of Norway expressed its interest in reading the results of the internal European Union study, in November 2010.

51. The Delegation of Kenya spoke of the importance of the basic mark requirement as a central focal point in the international filing system and said that it wished to introduce a note of caution in that regard. The Delegation said that further time was needed in order to conduct consultations.

52. The Delegation of France spoke of the difficulty of conducting consultations with their users in advance of the session of the Working Group, due to the late delivery of the discussion documents, in particular, given the nature of the important issues that were under discussion. The Delegation spoke of the important role played by Offices in the context of the Madrid system, and the assistance that those Offices provide to international applicants.

53. The Delegation of France expressed its concern for the ability of the International Bureau to provide such assistance, in the event of the withdrawal of the filtering role played by national Offices. The Delegation stated its concern also that the suppression of the requirement of a basic mark should not have undue impact, in particular, in terms of efficiency and of the time period for the registration procedure, as well as in terms of ease of use of the system and of costs for users.

54. The Delegation of France noted that document MM/WG/LD/8/2 contained little information regarding the impact of the suppression of the requirement of a basic mark, in particular regarding the future work of the International Bureau. The Delegation spoke of the possible extension of the time period for the registration procedures, the role of the International Bureau as regards examination in the event of direct filing, as well as the general costs for WIPO, and the impact on the amount of fees, for users. Expressing its support for what had been stated by the Delegation of Switzerland, the Delegation said that it was fundamental that further studies be carried out, and, in particular, that there be identified the advantages and the disadvantages of the continuation, or the suppression, of the requirement of a basic mark, along with the comparative roles of national Offices and of the International Bureau in either of these situations.

55. The Delegation of Turkey spoke of the fundamental nature of the issues under discussion and the need to take account of all the possible advantages or disadvantages that such a change in the system might bring about. The Delegation spoke also of the need to examine the current system as it stands and said that the current system itself also had certain disadvantages. The Delegation mentioned the quite substantial number of notifications of ceasing of effect emanating from the Office of Turkey and the fact that most of the international applications originating from that Office are based upon national applications, rather than upon national registrations.

56. The Delegation of Turkey spoke also of the principle of territoriality in trademark law and the impact which the mechanism of central attack had with respect to that principle. In effect, the central attack mechanism was conferring extra-territorial rights upon third parties, as a result of the cancellation of international registrations, following the notification of a ceasing of effect as a result of central attack.

57. The Delegation of Turkey said that it needed to consult with its stakeholders, including the private sector, and to have extensive discussion of the issues at the national level. Nevertheless, it was important, according to the Delegation of Turkey, that the proposal of Norway continue to be discussed by the delegations.

58. The Delegation of the Russian Federation noted, from the data provided in discussion document MM/LD/WG/8/2, that a substantial number of Offices had indicated that they would not provide the same level of assistance to applicants in the event of the suppression of the requirement of a basic mark. The Delegation said that due importance should be given to this, before any decision is taken by the Working Group.

59. The Delegation of the Russian Federation noted also that document MM/LD/WG/8/2 did not specify which Offices would, in fact, continue to be willing to provide assistance to applicants.



60. The Delegation of the Russian Federation spoke of the importance of taking account of the increase of work for the International Bureau, were there to be no longer the requirement of a basic mark, including the likely increase in the number of notifications of provisional refusal. This may have a detrimental effect, in terms of the efficiency of the Madrid system, and its user-friendliness.

61. The Delegation of the Russian Federation said that it supported the continuation of the discussions, but stated that further clarification of the issues was required, in order to ensure that the balance of interests of all parties would be assured.

62. Referring to paragraph I.A of document MM/LD/WG/8/2, concerning non-mandated services provided by Offices, acting as Office of origin, at the international filing stage, the Delegation of Japan spoke of the merit of those services. The Delegation noted that those services were provided in the national language, face to face, and there is not any time interval between the request for those services and their provision by an Office. For this reason, amongst others, the Delegation said that it felt that there was a need to maintain the role of Offices as Office of origin, in the event of the suppression of the requirement of a basic mark.

63. The Delegation of the United States of America stated that currently the United States Patent and Trademark Office (USPTO) provides electronic forms for the submission of international applications, subsequent designations and responses to irregularities, for transmission to the International Bureau. The USPTO also provides conversion of international application filing fees from US dollars to Swiss francs, through multiple means of payment, including credit cards, debit of funds from USPTO deposit accounts and electronic fund transfer.

64. Additionally, the USPTO provides information and procedural guidance to applicants filing international applications under the Madrid Protocol.

65. For those international applications based on a single United States of America application or registration, the Delegation said that the international application form can be pre-populated from information in the basic application or basic registration. This is then used to certify to the International Bureau that the information in the international application is the same as that in the basic application or basic registration.

66. The Delegation of the United States of America stated that those tasks performed by the USPTO help applicants to navigate the international system more efficiently and reduce the risk of irregularities due, primarily, to typographical errors.

67. Referring to what had been stated by the Delegation of Japan, the Delegation of the Republic of Korea spoke of the importance to users of the services currently offered by Offices in their role as Offices of origin. The Delegation expressed its view that those services should continue, even in the absence of a requirement of a basic mark. The Delegation spoke of the difficulties that may be encountered by certain Offices, due, for example, to lack of human resources or information technology infrastructure. In this regard, the Delegation suggested that the International Bureau may be in a position to offer some support, in order to enhance the level of services that Offices may wish to provide to their users, in the event that the basic mark requirement were to be suppressed.

68. The Delegation of Madagascar expressed its support for what had been said by earlier delegations with regard to the importance of the services provided by Offices as Offices of origin. The Delegation noted, that notwithstanding the limited number of international applications emanating from the Office of Madagascar, international applicants receive a significant level of support, free of charge, from the Office, and those services would continue to be provided, even in the absence of a basic mark requirement.

69. The Representative of ECTA spoke of the questionnaire and its extreme interest and of the lessons that could be derived from it. As had been noted by a number of delegations, the Representative drew attention to the importance of advice being offered, in one's own country, and in one's own language. However, if there were not any longer the requirement of a basic mark, international applications would be filed directly with WIPO, and then there would be the possibility of extending the international registration to one's own country. In such case, the trademark would be examined in one's own country at a later stage than it is currently. The Representative spoke of the importance of this, in the context of the overall anxiety of most trademark holders to obtain protection for their marks in their own country. In many cases, if trademark protection is not secured in the home country, frequently the trademark owner will no longer have the interest in filing for protection elsewhere.

70. The Delegation of the Republic of Korea spoke of the problems arising from linguistic diversity and the protection of export marks under the Madrid system. The Delegation suggested that this was, to an extent, a failure of the Madrid system, in particular given the geographical scope of the system as it now stands, and said that it was crucial that this issue be considered, if the system were to become truly global.

71. The Delegation of Morocco said that it wished to echo what had earlier been said by other delegations regarding the importance of the assistance and support being provided by Offices in their role as Offices of origin. Such assistance helped to reduce the risk of irregularities and it was extremely important that it was available to international applicants from the outset of the international filing procedure.

72. The Delegation of Greece said that it wished to express its support for what had been stated by the Delegations of Japan, Madagascar, the Republic of Korea and the United States of America. The Delegation noted that a great deal of support is provided free of charge, by the Office of Greece, to its users, and wished to underline the important role of Offices as Office of origin, in particular, in the reduction of the scope of irregularities in international filings.

73. The Representative of INTA spoke of the importance of the role of Offices as Offices of origin, and expressed the view that, regardless of the outcome of the discussions on the proposal by Norway, INTA would wish to see that facility maintained. The Representative stated also that it would be useful if a more precise breakdown of irregularities, than that contained in document MM/LD/WG/8/3., could be provided. Such additional information would assist in establishing how electronic filing developments might help in reducing the level of irregularities. Given the reasonably simple formal filing requirements, the Representative of INTA expressed the view that the level of irregularities appeared to be considerably high.

74. Responding to a query by the Representative of INTA regarding apparent discrepancy between the figures provided in document MM/LD/WG/8/2 and in the tables in document MM/LD/WG/8/3., the Secretariat clarified the matter by noting that the figures set out in the former document were based upon responses to questions in

the questionnaire, which had been focused on estimations only, and furthermore that the questionnaire had been responded to by 58 Contracting Parties only. On the other hand, the statistics provided in the latter document were exact data extracted from the database of filing statistics maintained by the International Bureau, covering all the filing activities in the periods in question.

75. The Delegation of Algeria, noting what had been expressed by many earlier delegations, including the Delegations of France, Morocco and Switzerland, said that it shared the view that there was a need for caution and a need to give time to Contracting Parties to assess the impact of the suppression of the basic mark requirement, in particular, with respect to users of the system. The Delegation said that it was in favor of any improvements that might be introduced into the Madrid system. In addition, the Delegation said that it considered that the role of Offices as Office of origin should be maintained and reinforced, in the event of any modification of the current system. Meanwhile, the Delegation advised the Working Group of the intention of Algeria to initiate, in autumn, the process leading to its accession to the Madrid Protocol.

76. The Delegation of Romania spoke of its entire agreement to the modernization of the Madrid system. But, as had been noted by many delegations, including the Delegations of France and Switzerland, the Delegation expressed the need for prudence and noted that it had not had the opportunity to study the documents in depth.

77. The Delegation of Romania spoke of the important job that is carried out by Offices as Office of origin and the sensitive role that is played by these Offices, in terms of prevention. Many applicants, when they see that their trademark application has been rejected for different reasons, make use of the international system, to the exclusion of the national route. This gives rise to litigation in countries where there are conflicting national marks which were at the origin of the refusal of these marks. The Delegation said that the Office of Romania has had a number of experiences of this type, where the applicant whose application was rejected nationally, then turned to the Community Trademark system, or the Madrid system.

78. The Delegation of Turkey stated that the responses to the questions in Part A.1 of the questionnaire (non-mandated services provided by Offices) demonstrated the critical importance of the role of Offices, both for users of the Madrid system and for the International Bureau. The Delegation said that if there were an interruption in the provision of such services, it was inevitable that problems would result for the International Bureau, including in terms of the workload of the International Bureau, and an increase in the number of notifications of irregularity. Thus, the Delegation said that, regardless of the outcome of the discussions concerning the requirement of a basic mark, the provision of those services should be maintained.

79. The Delegation of Kenya requested clarification regarding Table II in document MM/LD/WG/8/3., concerning representation. The Delegation wished it to be noted that, in Kenya, representatives are also clients of the Office and comprise a large proportion of the persons served by the Office.

80. The Delegation of Singapore expressed its support for the efforts towards review of the Madrid system, so as to make it more efficient and user-friendly. With regard to the non-mandatory services provided by Offices, the Delegation stated that the services, although optional, added much value to the overall level of services provided for the benefit of users of the system.

81. The Delegation of Singapore said that if the course of the discussions led to the eventual suppression of the requirement of a basic mark and a diminution of the role of Offices in the international registration system, it was uncertain whether Offices could effectively continue to offer those value-added optional services to users.

82. The Delegation of Singapore stated that, at this early stage of the discussions, perhaps it would suffice to say that, whatever the fate of the basic mark requirement, special attention needed to be paid to ensure that those non-mandatory services continued to be made available to users of the Madrid system.

83. No comments were offered by delegations regarding Part I. B of document MM/LD/WG/8/2 concerning tasks carried out by Offices, acting as Office of origin, that are mandated by the Madrid Agreement and Protocol and by the Common Regulations (the certification procedure).

84. Regarding Part II of document MM/LD/WG/8/2, concerning tasks and services provided by Offices during the course of the filing/registration of a basic mark, and which may, in turn, benefit the filing of an international application, the Delegation of Madagascar said that although it had a small Office, it offered a full range of services to its users, including an availability search. Before filing of applications, applicants were advised as to registrability of a mark and the procedures that would be involved if it were intended to extend protection of the mark through the Madrid system.

85. The Delegation of the Czech Republic said that its situation was similar to that of Madagascar. If a mark encountered difficulties at the national filing stage, the Office would advise the applicant to await registration, before proceeding with an international application. The Delegation underlined the importance of the national filing stage in the elimination of marks that would subsequently encounter difficulties, for example, for lack of distinctiveness.

86. The Representative of INTA stated that this part of the document under discussion (Part II) was particularly interesting and contained a wealth of useful information, but noted that more close examination of some of that information was necessary, if possible.

87. With regard to the statistical information relating to the issue of representation, the Delegation of Denmark said that this was not necessarily an important issue for applicants filing through the Office of Denmark, as such applicants, even if represented, would usually not apply for registration of a mark until the Office had had an initial look at the application. The Office would usually submit its first response within six weeks. Where difficulties do arise, those difficulties frequently concern the list of goods and services, and thus, in many respects, it does not make a great deal of difference whether the applicant is represented, or not.

88. With regard to international registrations, the Delegation of Denmark spoke of the difficulty it sometimes encountered in establishing whether the representative recorded with respect to a given international registration is in fact a lawyer or a person with trademark experience. Often the recorded representative would not be a person of that nature, and may, for example, be the legal department of a commercial enterprise or some other section of a company, without direct knowledge of trademark law, or trademark experience. The Delegation therefore questioned the importance of the information concerning the issue of representation, as made available in the document under discussion.

89. The Delegation of Morocco confirmed that advice is given to users by the Office of Morocco before trademark applications are filed. Furthermore, a free availability search is offered by the Office for marks that are intended to be protected nationally and for international applicants intending to designate Morocco. In addition, guidance is offered by the Office with regard to matters such as descriptiveness and the classification of goods and services. Apart from that, the Office carries out general awareness-raising activities regarding the extension of protection through the Madrid system, and, in particular, this is focused upon small and medium-sized enterprises (SMEs), which may be exporting their products or services.

90. The Delegation of Austria also confirmed that if it is known by the Austrian Office that an applicant is intending to extend protection of a mark through the Madrid system, the Office attempts to give advice to the applicant, in order to reduce the risk of irregularities and additional costs during the international stage. Such advice might consist in information regarding the classification of goods and services, or perhaps the procedures in Contracting Parties to which it is intended to extend protection.

91. The Delegation of Turkey noted that the Office of Turkey is often not aware as to whether, at the national filing stage, an applicant intends to extend protection of a mark through the Madrid system. However, if an applicant requests assistance, that assistance, and information, will be made available, including information regarding the risk of basing an international application on a national application, and the issues of ceasing of effect and central attack. The Office will also offer an availability search, both in Turkey and in other countries.

92. The Delegation of Cuba recommended prudence when dealing with the issues at stake; the Delegation outlined the relevance of the intervention of the Delegation of Denmark, as it pointed out that Offices intervene in a varied spectrum of issues, aiming at ensuring that national applicants are well prepared to deal with international applications. The Delegation stated that Offices are the filter for those interested in using the system, and in the case of SMEs, this role is even more relevant. The Delegation outlined the relationship between the filing with Offices of Origin and national filing; in this respect, for instance, the determination of the applicant is one of the elements included in the certification function: This element generates further issues, since, when verifying, Offices are aware of the changes undergone by the files, whereas for the representatives of enterprises, which in turn have changed representatives, those changes are not obvious, and only when they interact with the national Office those representatives sometimes realize that the file is not sufficiently updated, or that the data filed with the application do not correspond to those in the file of the Office. This is a frequent occurrence, especially as far as representation is concerned. In many cases of changes of representative, the status of the files they take over is not clear enough for those representatives. The Delegation stated the fact that an applicant may be interested in a given application, whereas, regrettably, the representative is not aware enough of the changes in the system as such; Offices are aware of those changes in the system. Additionally, young representatives of both the private sector and the companies are not aware enough of all the necessary actions concerning the legislation in force in the country, thus the angle through which a representative considers an application may not include the practice of Offices when they assess applications; this may be a source of problems that justify the advisory role of the Office; whereas the Office may not become both a judge and a party, through its advisory role it tries to help the applicant to solve the problems posed by filing and the register-related aspects of an application, thus assuming functions of high importance for users of the system. The Delegation indicated that this issue is also related to an aspect highlighted by another delegation the day before, namely the fact that the advisory role and other functions of the national Offices are developed in their own language, on the basis of the legislation and experiences of the Office staff; this has a huge value, and when discussing the eventual replacement of this role and functions, prudence is of the essence, as already noted by other delegations.

93. The Delegation of Romania confirmed that, as does the Office of the Czech Republic, the Office of Romania provides unofficial assistance to applicants, but the Office also recommends that applicants be represented. Furthermore, the Office makes available to applicants a search service and provides consultations, which are not free, regarding national and international marks.

94. Regarding Part III of the document under discussion (tasks and services that may be provided by an Office subsequent to the international registration of a mark), and in response to comments by the Chair, the Delegation of the Czech Republic spoke of the sensitive nature of the provision of advice and explanations to applicants. The Delegation referred to the current availability of, for example, digitized copies of refusal notifications on the ROMARIN database and stated that its Office makes reference to the content of such notifications, when asked to give advice in that regard. The Delegation stated its view that the local representative is the person best served to give advice in such a situation.

95. Referring to comments made by the Chair, the Delegation of Greece said that the experience of the Office of Greece was very similar to the Office of Slovenia, as outlined by the Chair. That is to say, the vast majority of holders of international registrations prefer to go through the Office of origin when requesting modifications, despite the option of being able to file such requests directly with the International Bureau. The Delegation also noted that most applicants are represented by professionals, but nevertheless, the Delegation stated its belief that the role of the Office was very important, including, for example, the provision of advice offered by the Office in the event of the notification of a provisional refusal.

96. Concerning Part IV of the document under discussion (assessment of the tasks that, in the absence of the requirement of a basic mark, would be required to be performed with respect to the filing of an international application, and by whom), the Delegation of the Czech Republic noted that the Office of the Czech Republic assisted international applicants in responding to irregularity notifications, and that this often represented quite an amount of work for the Office. However, the Delegation considered that this assistance could be maintained in the event of the suppression of the requirement of a basic mark.

97. The Delegation of Denmark, in the context of Part V of the document under discussion (what would ensure that users would continue to receive from Offices at least the level of support and services that they currently receive, and the readiness of Offices to continue to provide such support and services, in the absence of the requirement of a basic mark) stated that if the requirement of a basic mark were to be suppressed and, furthermore, if there were to be no longer a role for Offices as Office of origin, it would, in all likelihood, be very difficult for Offices to be able to maintain the necessary expertise in order to continue to offer support and services in relation to the international system. The Delegation said that there would also be issues as to the financing of the provision of such support and services, in such event.

98. The Delegation of Germany said that it supported the views of the Delegations of France, Switzerland and other delegations, as expressed earlier, concerning the late delivery of the discussion documents, and the consequent difficulty in conducting consultations. The Delegation stated that it would wish to have the documentation at least two months in advance of the meetings of the Working Group.

99. The Delegation of Germany, endorsing what had been stated by the Delegation of Denmark, noted that it was the biggest user group in the Madrid system at the present time and that its Office had around twenty persons examining international applications and translating lists of goods and services, and so on. The Delegation expressed the view that if the requirement of a basic mark were to be suppressed, it would be for WIPO to provide services and support to users of the Madrid system. In any event, the Office of Germany could not, in such case, offer services to users free of charge.

100. The Delegation of the Czech Republic stated that its Office charges an administration fee for the handling of international applications and that this fee could be maintained as a charge for the provision of assistance and support, in the event of the suppression of the requirement of a basic mark. The Delegation noted that, in most cases, holders or representatives file requests for modifications, through the Office, even if they are required to pay a fee. However, requests for renewal are mostly filed directly with the International Bureau.

101. The Delegation of Norway stated that it would like it to be noted that the document under discussion had been prepared upon the basis of the proposed suppression of the requirement of a basic mark. However, the Delegation said that it had not been the idea to abolish the possibility for an applicant to file an international application based on a national application or registration. The idea had been also to have a possibility for applicants to file an international application directly. On that basis, it would be a new possibility for applicants and the Delegation said that it was not sure that the document, as presented for discussion, reflected all those possibilities.

102. Furthermore, the Delegation of Norway said that it should be borne in mind that trademarks are renewed, and the holders of those marks are paying a lot of money to each designated Contracting Party. In the view of the Delegation of Norway, those monies should be utilized for supporting the Madrid system. The Delegation said that, from all perspectives, it was difficult to see how it could not be possible to maintain services for users of the Madrid system.

103. In any event, the Delegation of Norway noted that the present discussion was theoretical, and that without additional material being made available, it was difficult to discuss what different Offices may be able to provide, in terms of services to the users of the Madrid system.

104. The Delegation of Ghana said that it wished to identify with the comments expressed by the Delegations of Cuba and Kenya. Abolition of the requirement of a basic mark would add to the volatile problems which the Office of Kenya already had and therefore the Delegation was of the view that the requirement should be maintained. The Delegation spoke of the difficulties that had been encountered at the national level when Ghana joined the Madrid system and said that the *status quo* should be continued.

105. The Delegation of Australia, supporting what had been said by the Delegation of Germany concerning the late delivery of the discussion documents, spoke of the difficulty of having in-depth and fruitful discussions when the delegates are not afforded sufficient time to consider the documents and conduct consultations in advance of the meeting of the Working Group.

106. With regard to the issue of support and advice, the Delegation of Australia said that its Office does not provide advice, as such, to users. It provides information, through a number of sources, in relation to filing either at national, or international level. The Delegation said that it would not see that changing in the event of the suppression of the requirement of a basic mark. What would change would be the underlying structures, and the Delegation of Australia spoke of the difficulty of having a discussion of that, without having some concrete options on the table. Thus, the Delegation said that one of the concrete things that it would like to see emerging is that options would be presented, whether drawn up by the Secretariat, or otherwise, and that there could be a discussion of the advantages and disadvantages of the various options, leading to a more fruitful discussion of the issues.

107. Regarding Part VI of the document under discussion (consideration of the regulatory framework that might be put in place, in the event of the abolition of the requirement of a basic mark, and the implications for users, in terms of offices continuing, or not, to offer support and services), the Delegation of Cuba stated that it was favorable to the progress and advancement of the system, and that it tried to see the issue with a long-term perspective, but it was very difficult for the Delegation to consider the issue not only from the approach of the Australian delegate but also from that of the Ghana delegate; the Delegation stated that countries have national legal frameworks that were the bases for accession to international treaties and its country has established systems from all points of view on the basis of the pros and cons of such treaties *vis-à-vis* the national law; the Delegation repeated the need for prudence and expressed its worry about changes aimed at the very legal foundation of the system; in the case of Cuba, the country assessed the convenience of accession with the proviso that it should not entail an economic burden for the country, and should favor the interests of Cuban nationals; for that reason, it was very difficult for the Delegation to envisage a legal framework very different from the current one; an extremely cautious approach is of the essence, since the proposed changes would have effects on all countries and would imply a change of philosophy for which they are not prepared.

108. The Delegation of Japan, in reference to Part VII of the document (abolition of the basic mark requirement – conclusions), spoke of the difficulty and complexity of the issues under discussion and the need for much time to study the implications fully.

109. The Delegation of Japan stated that the possibility of self-designation, in the absence of a basic mark requirement, may have merit. In that context, the Delegation spoke also of the issue of languages in the Madrid system and the particular situation that might be faced by applicants from certain Contracting Parties. For example, a Japanese applicant might file an international application, in English, designating several Contracting Parties, and also self-designating Japan. Following registration by the International Bureau, each designated Contracting Party, including Japan, is notified of the registration. The international registration will then be examined by the Office of Japan, and if it occurs that the Office intends to notify a provisional refusal, that will be done in English. The Delegation thus spoke of the incongruity of a Japanese applicant being notified, by the Japanese Office, of a provisional refusal, in the English language.



110. The Delegation of the Republic of Korea noted that, during the discussions of the previous day, three important principles had been spoken of, in terms of the Madrid system, namely, simplicity, cost-effectiveness and user-friendliness. Additionally, the Delegation noted that there appeared to be a consensus from the current discussions that there should be a continuation of the provision of services to users of the system. In this regard, the Delegation spoke of paragraph (1) of Article 8 of the Madrid Protocol, which entitles Offices to collect, for their own benefit, fees from applicants, in connection with the filing of an international application, and suggested that this provision could be utilized by Offices in the context of a revised regulatory framework in the system.

111. With regard to the possible abolition of the requirement of a basic mark, the Delegation of the Republic of Korea said that it had been shown by the discussion documents that users of the Madrid system did not stand to lose, and that such a step would give freedom and flexibility to users of the system.

112. The Delegation of the Republic of Korea noted also that there appeared to be a consensus that Offices should continue to provide services to users. The Delegation stated that the Office of the Republic of Korea did not intend to charge a fee for the continued provision of such services, but other Offices may, and could do so. Offices could carry out a quality check procedure, as in the PCT system.

113. The Delegation of the Republic of Korea stated that it wished to further discuss issues concerning the future legal framework of the Madrid system, and in this regard, it expressed its support for what had been said by the Delegation of Australia. The Delegation referred also to the possible leverage, in the future, of information technology developments and the issue of electronic filing in the Madrid system, all of which would result in further simplification of the system.

114. The Delegation of Romania said that it shared the views of Japan regarding the issue of self-designation and that it would be necessary to have a self-designation, an *ex officio* designation or an automatic designation of the country of the applicant, in the absence of a basic mark requirement.

115. The Delegation of the Russian Federation, making reference to paragraph 88 of part VII of the document under discussion (implications for users), spoke of the possible increase in the number of irregularity notifications and of notifications of provisional refusal. The Delegation said that the efficiency, effectiveness and user-friendliness of the Madrid system would be affected, and said that this is not in line with what had been given as the original rationale of the proposal for the abolition of the requirement of a basic mark.

116. The Delegation of the Russian Federation spoke also of the statistics contained in document MM/LD/WG/8/3., concerning the average processing time for international applications, and queried the impact which the abolition of the requirement of a basic mark would have on those statistics. The Delegation expressed its concern that issues such as those should be taken into account in the discussions, and that all of the issues required careful consideration.

117. The Delegation of Turkey, referring to paragraphs 62 and 64 of document MM/LD/WG/8/2, under discussion, spoke of the role of the Office in the event of the abolition of the requirement of a basic mark, and the different possibilities that had been outlined in those paragraphs of the document. The Delegation said that if direct filing were to be chosen as the preferred option, it would be difficult to have national Offices also carrying out a formalities examination. The Delegation said that it was necessary to give careful consideration to what would be the best option, in the overall framework of the Madrid system, in particular, taking into account the relative advantages and disadvantages of each option.

118. In particular, the Delegation of Turkey said that it wished to make specific reference to the first sentence of paragraph 64 of the document, which states as follows: "If there were to be no longer a formal role attributed to an Office as Office of origin, the International Bureau would, in effect, be required to deal with *not* a relatively small number of Offices on a regular basis, but instead with tens of thousands of individual private parties." The Delegation queried the impact which that would have upon the operations of the International Bureau.

119. Responding to a query that had been raised by the Delegation of Romania concerning the possibility of an increase of the fees payable to the International Bureau, in the event of an increase in the scope of the tasks that the International Bureau might be required to undertake, the Secretariat stated that, as all of the elements of an alternative framework had not yet been arrived at by the Working Group, this issue had not been addressed in the document. In any event, the Secretariat noted, the fees under the Madrid system are established not by the International Bureau, but by the Madrid Union Assembly.

120. Referring to the interventions by the Delegations of Romania and Turkey, the Representative of INTA noted that two aspects needed to be distinguished. Firstly, with regard to the changes in the tasks and the magnitude of the tasks to be undertaken by the International Bureau, in the event of the suppression of the requirement of a basic mark, the Representative said that the document shows clearly that there would not be any fundamental change in the formality examination to be carried out by the International Bureau, although there was the possibility that the number of irregularities would increase. But, the Representative said, all options needed to be elaborated further and it was conceivable that the basic mark requirement would be suppressed and at the same time the role of an Office of origin could be maintained.

121. On the other hand, as far as the international application is concerned, the Representative of INTA said that the International Bureau would be required to deal not with a limited number of Offices, but instead with a large number of individual applicants. However, making reference to filing procedures in the PCT and the Hague system, and the fact that, even in the Madrid system, the International Bureau does deal with large numbers of single individuals in the context of requests for the recording of changes, renewals, subsequent designations and so on, the Representative of INTA said that this, in itself, would not therefore be totally new, as far as the International Bureau is concerned.

122. The Representative of INTA said that this pointed to how critical it would be, in that situation, that the International Bureau pursues its program of development of electronic facilities, both in terms of its communications with the private parties in question and also in order to provide for the inclusion of various automated checks that could be performed by electronic means.

123. The Delegation of Greece, supported by the Delegation of the Czech Republic, stated that it shared the concerns that had been expressed by other delegations, and in particular the Delegation of Turkey, regarding the suppression of the basic mark requirement and the ability of the International Bureau to deal with large numbers of persons on an individual basis. The Delegation said that its own experience had shown that, in situations where the International Bureau is unable to make contact with the applicant, it will contact the Office of origin. The International Bureau would also contact the Office of origin if there were irregularities which could be remedied only by the Office of origin, and this important matter needed to be borne in mind.

124. The Delegation of Cuba supported the ideas put forward by other delegations, on the studies that should be presented to the Working Group, and proposed that a study be undertaken on all aspects concerning the deletion of a basic mark, so as to shed light on this issue, since in its view many delegates currently share misgivings in that regard; the Delegation acknowledged that the discussion had considered the fact that the basic mark requirement is related to the risks holders intending to protect abroad incur, including those resulting from the different characteristics of marks. The Delegation referred to the intervention of the Japanese Delegation concerning the fate of marks refused in national jurisdictions, and recalled that marketing-related problems would not necessarily be solved by the legal solutions discussed by the Working Group. Therefore the Delegation insisted in the importance of a deep analysis of the real need to suppress the requirement of a basic mark; the Delegation acknowledged the need to evolve, simplify and become more efficient, but to attain that goal it was indispensable to be convinced about the necessary approach. The Delegation stated that IT-based solutions are not easily affordable to many countries that would thus have a hard time to solve problems through such technologies. The Delegation praised the documents prepared by the International Bureau, stating that they contained new reflections; although the Delegation expressed its conviction that the International Bureau wished to work together with all users of the system to improve results, it outlined its worry for the workload of the International Bureau and the fact that there are certain inconsistencies in the decisions of Offices that must be dealt with in coordination with the International Bureau; the Delegation cited publications as an example; the workload would not diminish, since the applications received in the International Bureau are national applications that would return to the International Bureau for further processing. The Delegation indicated that future studies should consider the advantages and disadvantages of both the current system and of any proposed system, including the consideration of the real need to suppress the basic mark.

125. Responding to the comments from the Delegation of Cuba, the Secretariat referred to the study of the likely impact of the abolition of the requirement of a basic mark undertaken by the International Bureau and contained in paragraph III of document MM/LD/WG/6/5, entitled "Implications of the Deletion of the Requirement of a Basic Mark", which document is attached as an Annex to document MM/LD/WG/8/2.

126. The Delegation of Morocco said it wished to echo what had been expressed by a number of other delegations, all of which had acknowledged the value of the services provided by Offices, as Office of origin, so as to facilitate the use of the Madrid system by its users. However, with a view to the modernization of the Madrid system so that it is more attractive for users and that it is simpler to work with it, both for the International Bureau and for national Offices, the Delegation proposed that, as had been noted by the Delegation of the Republic of Korea, the Working Group should continue its reflection on improving the quality of verification and assistance at the national level and the increased use of information technology. In this regard, the Delegation of Morocco said that, as had been proposed by the Delegation of Australia, specific options should be developed, which would permit the Working Group to pursue its discussions at future sessions.

127. At the conclusion of this part of the discussions of the Working Group, Ms. Wang Binying, Deputy Director General, spoke of the fundamental nature of the issues under discussion. Ms. Wang stated that the concerns that had been expressed by the delegations were fully understood, and spoke of the uniqueness of the Madrid system. Thus, Ms. Wang said, it was extremely important that the delegations work together, in order to find a way to move ahead, so as to improve the system and the services offered to users of the system, as well as to make the system more user-friendly, simple and efficient. She said that, whatever way we move forward, we must ensure that the Madrid system continues to be developed in the best interests of its users and Contracting Parties.

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

128. The Working Group then commenced discussion of document MM/LD/WG/8/4, which was introduced by the Secretariat.

129. The Delegation of Japan expressed its appreciation for the content of the document and, in particular, the outline of the history of the discussions concerning the possible alternatives to central attack during the lead up to the adoption of the Trademark Registration Treaty (TRT). The Delegation said that it supported the continued discussion by the Working Group of this important issue.

130. However, the Delegation of Japan expressed also the need to take time so that the discussions would proceed with care, given the complexity of the issues under consideration. In that regard, the Delegation requested clarification as to the rationale of the requirement of a basic mark, in the context of the Madrid system, and whether that rationale continued to the present time.

131. In response to the query raised by the Delegation of Japan, the Representative of INTA referred to the publication, issued by WIPO, on the celebration of the 100<sup>th</sup> anniversary of the Madrid Agreement in 1991. The Representative spoke of how the law makers had initially imagined a system of extension of conferred rights, by a member of the Madrid Union, of a mark filed, but not necessarily registered, to all of the other member States of the Madrid Union, which, at that time, numbered six. The right to refuse protection on the basis of grounds complying with the Paris Convention was enshrined in the initial treaty of 1890, which was adopted in 1891. The Representative spoke also of the development of the concept of dependency and the introduction of the compromise period of five years, at the time of the Diplomatic Conference of Nice, in 1957. Further amelioration of the concept of dependency was introduced into the system at the time of the adoption of the Madrid Protocol in 1989, by the provision allowing for transformation, in the event of a ceasing of effect of the basic mark during the five-year dependency period. The Representative concluded that, at the present time, it may be legitimate to question whether the mechanism of central attack and the concept of dependency are still required, within the framework of the Madrid system.

132. The Delegation of Madagascar stated that it was in possession of the publication referred to by the Representative of INTA and quoted a short extract from that publication, for the information of the Delegation of Japan.

133. The Delegation of Japan expressed its thanks to the Delegation of Madagascar and the Representative of INTA for the information which they had made available to the Working Group. The Delegation noted that at the sixth session of the Working Group, which took place in November 2008, that Delegation had explained that there were very few cases of central attack by third parties in Japan. On the other hand, some Japanese users thought that central attack was a useful feature of the Madrid system. Therefore, with regard to the abolition of the requirement of a basic mark, the Delegation of Japan said that it was thus not necessary to consider the balance of interests between applicants for international registration and third parties who sought to cancel international registrations by central attack, if the requirement of a basic mark were abolished.

134. The Delegation of Japan, supported by the Delegation of Norway, stated that the suggestion by the International Bureau, as contained in the discussion document, to assemble further statistics, would reveal the actual use of central attack and contribute to further discussion. The Delegation, therefore, supported that proposal and confirmed that its Office was willing to provide such statistics.

135. The Delegation of Norway also confirmed its willingness to provide statistics.

136. The Delegation of the United States of America also expressed its support for the proposal by the Delegation of Japan. The Delegation noted that the mechanism of central attack is used very infrequently in the United States of America, although some users have voiced interest in maintaining it. The statistics assembled thus far by the USPTO show that only 2.5 percent of notifications of ceasing of effect communicated to the International Bureau by the USPTO involve action from its Trademark Trial and Appeal Board. With regard to the rate of transformation requests following the cancellation of an international registration due to ceasing of effect of the basic mark, only 59 incidents have occurred in the time that the United States of America has been a member of the Madrid system. Of those, 48 have been total and 11 have been partial. Thus, of all of the cases of cancellations affecting designations of the United States of America, just 2.23 percent resulted in requests for transformation. The Delegation confirmed its willingness to provide those, and further, statistics to the International Bureau, if and when required.

137. The Delegation of Australia said that its experience in this regard was similar to that that had been expressed by the Delegation of the United States of America. The Delegation said that it would be happy that additional statistics be collected, if that were to prove useful, and it could then form part of an options paper, which had already been proposed by the Delegation of Australia.

138. The Delegation of the Republic of Korea spoke of the divergence of law and regulation in the field of trademarks, from country to country, and the implications of such divergence in the context of the procedure of central attack. The Delegation also echoed what had been said by the Delegation of Japan, referring to the balance between holders of international registrations and third parties. The Delegation noted that it considered very feasible the proposal to assemble further statistics.

139. With regard to the period of time which might be allocated for the assembly of the further statistics, the Delegation of Australia said that a period of six months, as had been suggested by the Chair, would appear to be quite adequate. However, the International Bureau would be required to indicate with more clarity precisely what information it would require. The Delegation said that if Offices could provide the information by the end of December 2010, this would facilitate the International Bureau in the preparation of an options paper for consideration at the next session of the Working Group.

140. The Delegation of Cuba supported the Australian delegation, in that documents should be made available earlier, not only in English, but in French and Spanish as well, since there usually is an interval between the publication of documents in English and that of documents in French and Spanish, with the correlated reduced time available for delegates using the latter languages to study documents.

141. Referring to the earlier query from the Delegation of Japan concerning the rationale for the original requirement of a basic mark in the Madrid system, the Secretariat offered to the Working Group additional information, taken from the publication earlier referred to, issued to celebrate the 100<sup>th</sup> anniversary of the Madrid Agreement\*. The Secretariat quoted from the following text on pages 37 and 38 of the publication:

“Existence of a Basic Right, that is, a National Registration in the Country of Origin

“From the time of the first project for a system of international registration of marks, presented by the Delegation of Switzerland at the Rome Conference of 1886, the idea of a unitary system – namely, a system under which one and the same title of protection of a mark would have the same effect and be governed by the same law through the whole of the territory of all of the contracting countries – has been eschewed. The explanatory memorandum to the proposals of the Swiss Administration presented at the Rome Conference of 1886 opposed the adoption of a unitary system, this opposition being repeated at the Madrid Conference of 1890 in the following terms:

“Absolute unification of the system of trademarks, assuring protection throughout the whole territory of the Union to all marks regularly filed in one State of the Union, will perhaps be achieved one day; but the differences that presently exist between internal laws lead one to believe that that moment is still far off. Furthermore, the Swiss Administration does not see the need for such a complete unification of law on this matter: it even fears that marks used solely in the internal commerce of one country should be protected throughout the whole Union, since that would oblige persons seeking to choose a new trademark to consult beforehand the enormous collection of marks used in all the contracting States, in order not to become infringers without knowing it.”

“By rejecting the idea of a unitary system, the framers of the Madrid Agreement were required to develop a system which would preserve the separate national effects of the protection of a mark in each of the contracting countries, while at the same time creating the possibility for those separate national effects to be made available to any mark that originated on one of the contracting countries. Such a result required the starting point for the system on international registration to be a national registration which, through a subsequent international registration, could be given the effect of national registrations in the other contracting countries.

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The publication in question is entitled *Madrid Agreement Centenary (International Registration of Marks 1891 – 1991)*: WIPO Publication No 880; ISBN 92-805-0324-3

“The proposal originally presented by the Swiss Administration at the Rome Conference of 1886 (which preceded by five years the Madrid Conference) envisaged the possibility of a direct filing with the International Bureau by the owner of the national registration. As stated in Part I above, however, the proposal was amended on the initiative of the Delegation of Italy so as to provide for the international application to be made through the intermediary of the Office of the country of origin, the purpose of interposing the Administration of the country of origin being to compensate “contracting States for the loss of fees on foreign marks by the right to impose a fee on marks filed for international registration by the nationals.”

142. The Delegation of the European Union said that, on behalf of the European Union and its twenty-seven member States, it wished to make reference to its position, as already set out in relation to working document MM/LD/WG/8/2. In view of the well-functioning of the current Madrid system, which is understood to be due to its present simplicity, the Delegation said that the proposed abolition of the basic mark requirement should be envisaged only if there were very strong reasons for doing so, and only if it were obvious that the overall benefits, particularly for users, would clearly outweigh the negative impacts.

143. The Delegation stated that the European Union and its member States understood that such assessment could not be made on the basis of the information available to date, and were open to review of any of the various issues addressed in working document MM/LD/WG/8/4. However, for the reasons stated, the Delegation of the European Union and its member States did not consider this matter to be one of priority.

144. The Delegation of Japan said that it wished to express its thanks to the Chair and to the Secretariat for the additional information concerning the philosophical basis for the requirement of a basic mark.

145. The Delegation of the Republic of Korea confirmed that it would be willing to make available the necessary statistics regarding notifications of ceasing of effect and the incidence of central attack. The Delegation spoke also of the late delivery of the discussion documents and, given the time constraints, the difficulty in reviewing those documents in-depth, and commenting upon them. The Delegation requested clarification of certain aspects of the statistics in the Annex to the document under discussion, and this was provided by the Secretariat.

146. The Delegation of Australia said that it saw as a priority the examination of the basic mark requirement and the issue of central attack. The Delegation stated that the proposal by Norway had been on the table since 2005. The Delegation said that it understood that fellow delegates wished to take their time and to consider the issues carefully, and to consult further, such being entirely appropriate and reasonable.

147. The Delegation of Australia said that all delegations supported a desire for modernization, simplicity, cost-effectiveness and user-friendliness in the Madrid system. It said that users of the Madrid system deserve that their interests are looked after by the Working Group and, additionally, the delegations' respective jurisdictions were looking to the Working Group to ensure that sustainable economic outcomes were achieved. The Delegation of Australia stated that the Working Group played a key role in achieving this, as it related to the international trademark registration system.

148. For the reasons already indicated, the Delegation of Australia stated its belief in the value of the proposal which it had put forward on the previous day, as this would be useful and would lay a foundation for the Working Group to discuss possible future models or options. The Delegation said that, as it perceived it, effective discussion would be impossible without that information. The Delegation said that it therefore looked forward to progressing the discussion of the issue in future sessions of the Working Group.

149. The Delegation of Norway stated that it wished to express its wholehearted support for what had been said by the Delegation of Australia.

150. The Delegation of the Republic of Korea spoke of the difficulties for enterprises which file international applications and pay fees to the International Bureau and to the Offices of designated Contracting Parties for global protection, extending over a 10 year period, which may then find that, because of the ceasing of effect of the basic mark, the international registration is cancelled and that protection is thus lost. The Delegation stated that this was not a cost-effective proposition for those enterprises and that they are complaining. For that reason, the Delegation said that it wished that the discussion of this issue be continued, as a priority.

151. The Delegation of Ghana expressed its support for the proposal made by the Delegation of Australia and spoke of the difficulty of being able to give the issues due consideration due to the late delivery of the documents. For that reason, the Delegation said that further time should be taken, to enable the delegations to study the documents, and all the issues, and to facilitate the conducting of consultations.

152. The Delegation of the United States of America stated its belief that the discussions had been a good start to the work on finding the best way forward to address the issues in question. Before decisions can be made on whether to suppress the requirement of a basic mark, the Delegation said that it would like to look at other options that may provide a solution. The Delegation said that feedback from its holders would indicate that not all holders believe that the mechanism of central attack should be eliminated – at least, not without fully understanding other options that could maintain that feature. One option that may be possible would be the loosening of the requirements currently in place for the choice of the Office of origin. However, the Delegation of the United States of America noted that it looked forward to engaging in informed discussions, so that a balanced solution could be found.

153. Expressing its support for the proposal by the Delegation of Australia, the Delegation of Turkey said that the discussions that were taking place would have beneficial effects for the Madrid system in the future, even though it is still an early stage to be taking important, clear decisions.

154. The Chair then reviewed the history and evolution of the proposal by Norway, within the context of the Working Group, and spoke of the length of time that is required to process the discussion of issues of such importance to the Madrid system. The Chair spoke also of the subjective aspect of the issues now under discussion. Referring to the discussions that had taken place on the previous day, the Chair noted that many delegations had underlined the need for time and caution. The Chair wondered whether there was need, at this time, for further documentation, or for more time to consider the content of the three discussion documents that were before the delegations at the current session of the Working Group. Those documents had been applauded by many delegations, for the wealth of their detail and the quality of their content.



155. The Chair went on to note that if further time were taken for consideration of the issues, clearer decisions could be taken, in particular, with respect to the issue of the basic mark requirement, but also with regard to the possible alternatives to the procedure of central attack. Not least, such further time would enable delegations to conduct important consultations with their stakeholders, in order to ascertain users' opinions on the issues under discussion, and it should be reiterated that any change that is introduced into the system must ultimately be for the benefit of users. In this regard, the Chair noted again that many delegations had called for caution and prudence.

156. The Delegation of the Republic of Korea, referring to what had been proposed by the Delegation of Australia, stated that, although the working documents had covered the issues well, a further document would be useful. The Delegation said that it would like to see how the Madrid system would develop into the future and to prepare for that. The Delegation spoke also of the importance of considering the business environment, and not just the legal framework of the Madrid system, and referred to the need to focus on the growth of the system.

157. The Delegation of Australia expressed its support for what had been said by the Delegation of the Republic of Korea. The Delegation said that it would be useful if the Secretariat could compile an executive summary, with an overview of the information contained in all of the documents concerning these issues, containing options and explaining how those options would work. This would assist the delegations in having a useful discussion as to whether, and how, some of those conceptual options would work, or not.

158. The Delegation of Kenya, echoing what had been said by the Delegation of Australia, said that, while a lot of time had been spent on discussion of the issues, it was time that had been well spent.

159. The Delegation of Japan expressed support for what had been expressed by the Delegations of Australia and the Republic of Korea.

160. The Chair, at this point, expressed the view that it appeared that a number of delegations had considered the proposal by Norway to be somewhat premature at this time. That was not to say that the proposal should then be removed from discussion by the Working Group, but merely that it should be placed to the side, for the time being, and deferred for later discussion by the Working Group. That is to say, the topic under discussion would remain as part of the work of the Working Group.

161. It seemed, in the view of the Chair, that there had been almost a consensus on the need to simplify the Madrid system, without touching the treaties governing the system. The Chair noted that some delegations had underlined that their recent accessions to the system had been based on the Madrid system in its current state. For those Contracting Parties, and for potential future accessions, it would appear that radical changes of a substantive nature would perhaps not be useful.

162. The Chair said that if discussion of the issues in question were to be put to one side, for the present time, there nonetheless remained much work for the next session of the Working Group. That session could be concerned with issues relating to the further simplification of internal processes carried out by the International Bureau, as well as the proposal by the Delegation of Switzerland regarding division of international registrations, and a review of pending issues.

163. The Secretariat noted that the words “caution”, “prudence” and “premature” had been repeated by several delegations during the discussions of this session of the Working Group. This suggested the need for caution when embarking upon discussion of issues of this magnitude, as well as prudence when considering introducing significant changes into the Madrid system. The Secretariat recalled that the issue of the basic mark requirement had been on the Agenda of the Working Group over the previous five years. Nevertheless, it may still be somewhat premature to progress those discussions further at this particular time.

164. The Secretariat emphasized that the services offered to users by Offices, in their capacity as Office of origin, were of crucial importance, and that without the provision of those services, the Madrid system would not be the success that it is today. The Secretariat underlined the common goal shared by all, namely, a system that is simple, efficient, reliable, flexible, user-friendly and time- and cost-effective. In that regard, having paid great attention to the interventions by many delegations, it would appear that there was full agreement on the need to continue focusing on the simplification of the Madrid system, but, for the time being, without touching upon the core pillars of the system, such as the requirement of a basic mark.

165. The Secretariat noted that the next session of the Working Group would take place, tentatively, in late May, or early June 2011, and suggested setting to one side, for the time being, the issue of the basic mark requirement, while retaining that issue on the list of topics for future discussion by the Working Group. It was suggested also that a permanent item would, in future, be placed on the Agenda of the Working Group, which would be entitled “Legal Development of the Madrid System”.

166. Under that Agenda item, the proposal by Norway could then be reintroduced, when the Working Group was disposed to continue the discussion of the issue of the basic mark requirement. Meanwhile, delegations would then have the necessary time and space to enter into consultations with their users, based upon all of the documentation now available on this matter.

167. The Secretariat made reference to the presentations that were due to be made later in the day to the Working Group, regarding new electronic tools that will be of great importance for international applicants, trademark holders, Offices and the International Bureau.

168. The Secretariat then spoke of the items for discussion at the next session of the Working Group and, in the interest of progressing the simplification of the system, it was proposed that the items would include discussion of the possible simplification of the internal procedures of the International Bureau, as had been mentioned earlier by the Chair. Also included on the Agenda would be the proposal by the Delegation of Switzerland concerning division of international registrations, in preparation for which, a questionnaire would be circulated to Offices after the conclusion of the present session.

169. Making reference to the fact that only three Contracting Parties are now bound solely by the Madrid Agreement and the expected eventual accession by those Contracting Parties to the Madrid Protocol, the Secretariat said that it would become necessary to begin to give consideration to the status of the Madrid Agreement, within the framework of the system, and to look at the relationship between Contracting Parties bound by both treaties. This would also involve a review of Article 9*sexies* of the Protocol.

170. The Secretariat noted that there appeared to have been consensus on the need to assemble further information concerning notifications of ceasing of effect, and transformation, and many delegations had agreed that their respective Offices would cooperate in that regard. During the course of the discussions, it appeared that an acceptable time period for this exercise would be six months. The Secretariat suggested, therefore, that the period would run from July of this year to December 2010, and that the information could be submitted to the International Bureau early in 2011. It was suggested by the Secretariat that if Offices could provide information regarding the period prior to July of this year, that also would be useful.

171. Following the receipt of the information from Offices, the Secretariat said that the International Bureau would compile the information in a document which would be made available to the delegations in advance of the next session of the Working Group. That document would not analyze or comment upon the information and would permit delegations to draw their own conclusions from the information made available. That information would be useful for future discussion of the issue of central attack.

172. Making reference to the proposal by the Delegation of Australia and the comments by the Delegations of Japan and the Republic of Korea, the Secretariat stated that a first step in moving forward could be, with the approval of the delegations, the establishment of an electronic forum. This forum would allow for the posting of comments, questions and suggestions, or other contributions. If this were acceptable to the Working Group, the International Bureau would make available, after the conclusion of the present session, more precise information on the modalities of such electronic forum.

173. Responding to a query from the Delegation of the Republic of Korea, the Secretariat stated that the details of the electronic forum would be finalized shortly and comprehensive information would then be made available to the delegations, if it were agreed that such a forum should be established.

174. The Delegations of Germany and the European Union expressed support for the proposal for the establishment of an electronic forum. Responding to a query from the Delegation of Greece, the Secretariat replied that the information concerning the electronic forum might be communicated to Offices by way of a circular, to be prepared by the International Bureau after the conclusion of the present session.

175. The Chair underlined that Offices would not be mandated to furnish to the International Bureau the information under discussion.

176. The Representative of INTA recalled that it had been said that there appeared to be general agreement upon the need to have simplification of the procedures in the Madrid system, without touching the substance of the governing treaties. The Representative said that this was understood to mean that there were ways of introducing simplification without touching the treaties, but noted that this was not to rule out such changes at some time in the future, as, to do so, would rule out also the proposal by Norway.

177. Regarding the earlier reference to Article 9*sexies*, the Representative of INTA wondered if this would be an item for discussion by the Working Group at its next session in 2011, or at a later stage. The Representative made reference also to a further item that is pending, namely, Article 4*bis*, concerning replacement. The Representative mentioned that an electronic forum had been established also in that regard, and questioned the success of that forum.

178. Referring to the proposal to have an options paper, the Representative of INTA stated that, while there would have been merit in such a paper, postponement of the discussion in that regard would allow for the ascertainment of the views of users, and others, through the electronic forum, which would allow for the continued existence of the proposal by Norway.

179. Responding to what had been stated by the Representative of INTA regarding Article 9*sexies*, the Secretariat said that it was not possible, at this point, to give further information, as the issue depends also on the eventual accession to the Madrid Protocol of the three remaining Agreement-only Contracting Parties.

180. Speaking of the simplification of the Madrid system, the Delegation of the Republic of Korea spoke of the importance of that issue and stated that if that could be achieved without touching the substance of the governing treaties, then that would be all the better. However, if the only way to achieve simplification was to change the treaties, then that should be on the table for discussion.

181. The Delegation of Norway indicated its agreement to the suggestion by the Secretariat regarding the establishment of a permanent Agenda item relating to the legal development of the Madrid system. The Delegation expressed its puzzlement concerning the apparent hesitancy on the part of the International Bureau regarding the preparation of a document, as proposed by the Delegation of Australia. The Delegation said that it was seeking from the Secretariat clarification on the reasons for that.

182. In response to the Delegation of Norway, the Secretariat outlined the history and evolution of the proposal by Norway, and said that there was already a substantial body of documentation available for delegates to draw upon, for the purpose of further consultation with their users and other stakeholders. The Secretariat stated that the preparation of such a document in the future was not being definitively ruled out, and this was confirmed also by the Chair. Meanwhile, the Secretariat recalled the important program of work that is contemplated for the following sessions of the Working Group and said that that program of work would be likely to have a more immediate successful impact for the present time. The Secretariat spoke also of the benefits that would accrue from the establishment of the electronic forum, in the context of the proposal by Norway. Additionally, the Secretariat spoke of the assembly of the additional information concerning the incidence of central attack, and the importance of that information, which will be compiled in a document for the consideration of delegations at the next session of the Working Group. That would facilitate the work of the Working Group in its attempts to establish a way forward.

183. The Chair asked whether there were any further submissions from delegations regarding the issue of the proposal by Norway and said that if there were not, it would be concluded that there was agreement to proceed in the manner that had been outlined.

184. There were no further submissions.

#### Agenda Item 6: Update on Ongoing Projects under the Madrid System

##### *The Madrid System Goods and Services Database*

185. Mr. Ernesto Rubio, Senior Director-Advisor reported on the current status of development of the Madrid System Goods and Services Database (see document MM/LD/WG/8/REF/DATABASE). Mr. Rubio's presentation was followed by a demonstration of the Madrid Filing Assistant (MFA) by Mrs. Isabelle Vicedo, Officer-in-Charge, Goods and Services Database Project.

186. Mr. Rubio stated that WIPO was planning to make the database available to the public by October 2010 in the three working languages of the Madrid system (English, French and Spanish), as well as in certain other languages in respect of which agreement had been reached with interested Contracting Parties. A progress report would be submitted to the Madrid Union Assembly in September 2010 (document MM/A/43/2).

187. Mr. Rubio and Mrs. Vicedo then responded to a number of queries from the delegations.

188. In response to a question from the Delegation of Algeria as to whether there were links between the WIPO database and the ROMARIN database, Mr. Rubio noted that those databases were different in nature, the latter dealing with trademarks that had been registered under the Madrid system, and the former concerning not the trademarks themselves, but rather goods and services which can be protected under a given trademark.

189. The Representative of INTA raised a question as to the type of separators used between the individual indications of goods and services in a list and asked if the Madrid Filing Assistant had a standard separator, or would different separators be entertained, depending upon the wishes of an applicant, if the applicant composed the list himself.

190. In response to the Representative of INTA, Mrs. Vicedo stated that the separator used by the Madrid Filing Assistant was a semi-colon. If a list is copied and pasted, from an individual list, onto the Filing Assistant, and if that list contains a variety of separators other than semi-colons, the system will not, at present, automatically correct that punctuation so as to insert semi-colons throughout. The risk of so doing would be, at present, that the meaning of a list might be changed.

191. The Representative of INTA asked Mr. Rubio whether the International Bureau had been testing the Madrid Filing Assistant with users, or intended to do so. In the latter case, the Representative confirmed that INTA would volunteer to participate in such testing.

192. Mr. Rubio stated, in response to the Representative of INTA, that the database had not yet been submitted for testing by users but would be so in the near future. He expressed welcome for the offer of INTA to participate in such testing.

193. Responding to a question by the Delegation of Norway about the relationship between the WIPO database and the Nice Classification, Mr. Rubio noted that the Nice Classification contained some 8,800 indications, which had been approved by the Committee of Experts of the Nice Agreement. The WIPO database contained all those 8,800 indications plus many more terms that would also be accepted in the context of the Madrid system procedures. It may be of interest to the Committee of Experts of the Nice Agreement to examine the indications in the Madrid System Database with a view to increasing the number of indications in the Nice Classification. Mr. Rubio also spoke of the possibility of the International Bureau issuing recommendations, as is done from time to time, in between new editions of the Nice Classification, about how to classify goods and services.

194. The Delegation of the Republic of Korea spoke of the benefits which would be derived from the WIPO database, for all parties concerned in the application process. The Delegation spoke also of the utility to be found in the creation, by Offices, of own-language lists of goods and services, in conjunction with the WIPO database. The Delegation asked whether the International Bureau had plans to offer support to those Offices who may wish to take such a course of action.

195. In response to the Delegation of the Republic of Korea, Mr. Rubio confirmed the readiness of the International Bureau to cooperate with the Offices of Contracting Parties in various ways, including the provision, to those Offices, of the contents of the WIPO database. Mr. Rubio expressed the belief that the creation of databases of this type would be an extremely useful tool, both for applicants and Offices – even for the filing of domestic applications.

196. The Delegation of the Republic of Korea confirmed its readiness to work, in this regard, in cooperation with the International Bureau and spoke also of the importance of quality control in the creation and maintenance of a database of this nature.

197. The Delegation of Japan requested information regarding the source of the indications in the database and the standards applied. Mr. Rubio said that the database contained some terms that had been extracted from the Trilateral and USPTO lists. Mr. Rubio said that, as of June 2010, the situation was that out of 27,000 terms accepted in English, 2,779 were terms that were also known to have been accepted by the Trilateral Offices. A further 4,426 were other terms that have been accepted by the USPTO. Work will continue on the review and incorporation of terms from the Trilateral list. Mr. Rubio referred also to the identification by WIPO examiners of terms that are frequently used in Madrid applications, that have been well formulated and expressed, and which are considered to be sufficiently clear and valid, for incorporation in the database.

198. The Delegation of the Russian Federation noted that applicants will be in a position to avail of the Madrid Filing Assistant not just for international filings, but also for the filing of national applications, once the database becomes available online. Speaking of the importance of the project, the Delegation said that some additional potential uses of the Madrid Filing Assistant may be identified in the future. Responding to a query by the Delegation of the Russian Federation, Mr. Rubio stated that the building of the database concerned only phase I of the pilot project on additional filing languages.

199. The Delegation of Singapore expressed its happiness with the rapid progress of the database project, which it believed would be very useful for users and Offices. The Delegation asked whether, in the event that clarification were required, either regarding the identification or classification of a product or someone would like to propose that a term be added to the database, there was in place a procedural mechanism for that purpose.

200. In response to the Delegation of Singapore, Mr. Rubio confirmed that such a mechanism would be in place when the system became operational.

201. The Delegation of the Republic of Korea spoke of the impressive opinion which it had formed, in terms of the work that had gone into the establishment of the database. The Delegation said that the creation of the database was one important means by which the effectiveness of the Madrid system can be improved, for the benefit of all parties concerned.

202. The Representative of the Japan Patent Attorneys Association (JPAA) expressed its hope that more and more Offices would cooperate in the acceptance of terms.

203. The Delegation of Turkey spoke of the importance of the database project, not only for users, but also for national Offices. The Delegation stated that the project would probably be useful in the harmonization of classification procedures among Offices of Contracting Parties of the Madrid system, and among other Offices. The Delegation confirmed its readiness to participate in the project.

*Improving Communication in the Madrid System*

204. A presentation entitled "Improving Communication in the Madrid System" was given by Mr. Neil Wilson, Director, Functional Support Division.

205. Mr. Wilson then took questions from delegations.

206. Responding to a query from the Delegation of the Republic of Korea regarding the nature of the security aspects of the projects that had been discussed, Mr. Wilson said that he wished to congratulate the Office of the Republic of Korea for being a pioneer in the utilization of bi-directional XML exchanges with the International Bureau. Regarding the issue of information security, Mr. Wilson said that all new information technology systems at WIPO are submitted to very stringent security controls.

207. The Delegation of the United States of America posed a question regarding communications from an Office to the International Bureau in pdf format. Mr. Wilson said that for the time being, there was an option of transmitting document images to the International Bureau by email. Mr. Wilson said that his preference would be to utilize the ftp service that is currently used to exchange XML transactions with the USPTO.

208. The Delegation of the Republic of Korea spoke of the interface with users, which had been mentioned in Mr. Wilson's presentation, in the context of the development of information technology systems, and the future plans and intentions of the International Bureau in that regard. The Delegation spoke of the considerable experience that its Office had in that respect, and that such experience may be usefully put at the disposal of the International Bureau.

209. Mr. Wilson responded to the Delegation of the Republic of Korea that it was essential that the International Bureau did not build web services in isolation from what are real client requirements and spoke of what had been done by the International Bureau in this context up to now, in particular the engagement of user organizations for the purposes of beta testing the new services.

210. The Representative of INTA stated that it looked forward to the ongoing development of the projects that had been presented and discussed, especially those that concern communication with users. The Representative said that it would be useful to have a time line of the expectations of the International Bureau on the progress of those projects and confirmed that the offer of cooperation from INTA regarding the testing of the Madrid Filing Assistant extended also to the testing of the projects that had been presented by Mr. Wilson.

211. The Chair offered congratulations to Mr. Rubio, Mr. Wilson and Mrs. Vicedo for the excellence of their presentations and noted the enthusiastic and appreciative reception there had been of the presentations, on the part of the participants in the Working Group.

Agenda Item 7: Other Matters

*Electronic Adoption of Working Group Reports*

212. Before proceeding with discussion of Agenda Item 7, the Secretariat stated, for clarification, that if it were wished that the International Bureau would produce, for the next session of the Working Group, a list of topics under the new Agenda item of Legal Development of the Madrid System, delegations would need to submit to the International Bureau, in writing, the proposals that delegates would like to have included in that list, in accordance with the general rules of procedure.

213. With regard to the issue of the electronic adoption of Working Group reports, the Delegation of the United States of America noted that the report that had been adopted earlier, in the course of the present meeting, had been the report of a meeting that had taken place one year previously. The draft had been posted online for comments in February, and then formally adopted in July, one year after the meeting had taken place.

214. In order to finalize the report while the information was still fresh in the minds of delegations, the Delegation proposed that electronic adoption of the draft be put in place. The Delegation outlined the proposed procedure as follows:

- (a) The International Bureau could post a draft of the report on the WIPO website, as usual, indicating a deadline of, say, one month, for comments by the participants at the Working Group.
- (b) The participants would be invited by the International Bureau to check the web page for publication of the draft through the channel of the monthly newsletter.
- (c) After the expiry of the deadline, the International Bureau would post:
  - (i) All comments received, in the original languages in which they had been made. Translations of the comments into the other languages would also be posted;
  - (ii) A track-changed new version of the draft report, including the comments;
  - (iii) A clean new version of the report, which would be deemed adopted at the date of publication, and would include the date of adoption (date of posting).

215. The proposal by the Delegation of the United States of America was supported by the Delegations of the European Union, Japan, Kenya, Morocco, Norway, the Republic of Korea, Singapore, Turkey and the Representative of INTA.

216. The Representative of INTA suggested that some form of email alert be issued to the participants at the time of the posting of the draft report, in order to ensure that all parties would have the opportunity to react.

217. In response to the Representative of INTA, the Secretariat confirmed that this would be done, along with information reiterating the procedure to be followed in the electronic adoption of the report.

218. The proposal of the United States of America was adopted by the Working Group.

#### Agenda Item 8: Summary by the Chair

219. The Working Group approved the Summary by the Chair, as contained in document MM/LD/WG/8/5.

#### Agenda Item 9: Closing of the Session

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



## 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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