

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

**Ninth Session**  
**Geneva, July 4 to 8, 2011**

### **SUMMARY BY THE CHAIR**

*adopted by the Working Group*

1. The Working Group on the Legal Development of the Madrid System for the International Registration of Marks (hereinafter referred to as “the Working Group”) met in Geneva from July 4 to 8, 2011.
2. The following Contracting Parties of the Madrid Union were represented at the session: Algeria, Australia, Austria, Belgium, China, Cuba, Cyprus, Czech Republic, Democratic People’s Republic of Korea, Denmark, Estonia, European Union, Finland, France, Georgia, Germany, Ghana, Greece, Hungary, Israel, Italy, Japan, Kazakhstan, Latvia, Lesotho, Lithuania, Madagascar, Monaco, Morocco, Netherlands, Norway, Oman, Poland, Portugal, Republic of Korea, Romania, Russian Federation, Serbia, Singapore, Slovenia, Spain, Sweden, Switzerland, Tajikistan, Turkey, Ukraine, United Kingdom, United States of America, Viet Nam, Zambia (50).
3. The following States were represented by observers: Brazil, Colombia, Costa Rica, Côte d’Ivoire, Dominican Republic, India, Indonesia, Iraq, Philippines, Qatar, Saudi Arabia, Senegal, Tunisia (13).
4. Representatives of the following international intergovernmental organizations (IGOs) took part in the session in an observer capacity: African Intellectual Property Organization (OAPI), African Regional Intellectual Property Organization (ARIPO), Benelux Office for Intellectual Property (BOIP) (3).

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), Association of European Trademark Owners (MARQUES), *Association romande de propriété intellectuelle* (AROP), European Communities Trade Mark Association (ECTA), International Trademark Association (INTA), Japan Patent Attorneys Association (JPAA), Japan Trademark Association (JTA) (7).
6. The list of participants is contained in document MM/LD/WG/9/INF/1 Prov. 2.

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

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

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

8. Mr. Mustafa Dalkiran (Turkey) was unanimously elected as Chair of the Working Group, and Ms. Amy Cotton (United States of America) and Mr. Zhang Yu (China) were elected as Vice-Chairs.
9. Ms. Debbie Roenning, Director, Legal Division of the International Registries of Madrid and Lisbon (WIPO), acted as Secretary to the Working Group.

#### Agenda Item 3: Adoption of the Agenda

10. The draft agenda (document MM/LD/WG/9/1 Prov. 3) was introduced by the Chair. The Working Group adopted the draft agenda, without modification. The adopted agenda is contained in Annex I to the present document.
11. The Chair reminded delegates that the Report of the eighth session of the Working Group had been adopted electronically, and the report for this session would follow the same procedure.

#### Agenda Item 4: Information Concerning Ceasing of Effect and Transformation

12. Discussions were based on document MM/LD/WG/9/3.
13. A number of delegations expressed their view on the requirement of a basic mark in light of the document. Some questioned the usefulness of this requirement while others stated that it was a necessary feature of the Madrid system and recommended caution when considering this issue. The Chair reminded delegations that the issue at hand was the analysis of document MM/LD/WG/9/3 on information concerning ceasing of effect and transformation, and not the question concerning the requirement of the basic mark.
14. The Delegation of Norway proposed that the International Bureau undertake a study on the consequences of freezing the principle of dependence of the international registration.
15. The proposal of the Delegation of Norway was supported by the Delegations of Australia, China, Czech Republic, Republic of Korea, Tajikistan, Turkey, Ukraine, United States of America and Zambia.

16. The Representative of MARQUES made a statement supporting the proposal of the Delegation of Norway.
17. The following Delegations stated that their users considered dependence and central attack a necessary feature of the Madrid system and therefore, undertaking the study was premature: Austria, Cuba, Denmark, France, Germany, Italy, Russian Federation and Spain; these Delegations deemed it necessary that the International Bureau compile further, more accurate information on ceasing of effect, and focusing on central attack and transformation.
18. The Representative of ECTA concurred with the view of the aforementioned Delegations.
19. Upon completion of the discussions, the Chair concluded as follows:
  - (a) There was no consensus on the immediate need to undertake a study on the freezing of dependence, as proposed by the Delegation of Norway.
  - (b) There was agreement on the need to compile additional, more accurate information on ceasing of effect, and specially on central attack and transformation.
  - (c) The Working Group agreed that Offices would furnish to the International Bureau additional, more accurate information on ceasing of effect, and specially on central attack and transformation. The International Bureau was requested to notify the details concerning the implementation of this initiative.

Agenda Item 5: Information Relating to the Review of the Application of Article 9sexies(1)(b) of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks

20. Discussions were based on document MM/LD/WG/9/5 Rev.
21. The majority of delegations stated that the current wording of paragraph (1)(b) of Article 9sexies was satisfactory for users and, therefore, declared themselves in favor of keeping it, while other delegations were of the view that it was necessary to undertake a review of paragraph (1)(b) of Article 9sexies.
22. The Chair concluded that there was no consensus on the immediate need to either restrict or repeal the scope of paragraph (1)(b) of Article 9sexies.
23. The Working Group therefore agreed to recommend that the Madrid Union Assembly neither repeal nor restrict the scope of paragraph (1)(b) of Article 9sexies at this time. The Working Group also decided that the review of the application of paragraph (1)(b) of Article 9sexies should again be included in the agenda of the next session of the Working Group.

Agenda Item 7: Legal Development of the Madrid System. Division of the International Registration

24. Discussions were based on document MM/LD/WG/9/2.
25. The Delegation of Switzerland, in recalling the discussion on division during the seventh session of the Working Group, stated that “division” meant division of the international designation. While recalling the importance and usefulness of enhanced transparency, in relation to the status of divisions in designated countries, in the International Register managed by WIPO, the Delegation said that it was sensitive to the workload-related concerns of the International Bureau, that might result from the inclusion of the division of international registrations in the Madrid system. The Delegation further highlighted that options could be envisaged which would meet the needs of users, while retaining a reasonable impact on the workload of the International Bureau.
26. A number of delegations supported the concept of division, either as a division of the designation, at the designated Office, or as a division of the designation, at the International Register, through a procedure before the International Bureau. Moreover, representatives from INTA and AROPI supported the introduction of the division of the international registration.
27. On the other hand, other delegations did not see the need to include such division in the Madrid system. Among the reasons cited were the low incidence of division, the absence of some national laws to provide for division and the complexity that might result should division be introduced into the Madrid system.
28. The Delegation of Switzerland suggested that the Working Group study, for instance, the possibility of division at the level of the designated Contracting Party.
29. The Chair concluded that there was no consensus at this stage on the need to introduce division in the Madrid system, and proposed that the International Bureau, together with some interested Offices and organizations, study the matter in depth in order to present a proposal for the next session of the Working Group.
30. The Working Group agreed to pursue the approach proposed by the Chair.

Agenda Item 8: Other Matters

31. The Secretariat introduced the Madrid Legal Forum, the establishment of which was requested by the Working Group in its eighth session. The Secretariat indicated that 47 requests for access had been granted, and that 100 requests were pending provision of usernames by potential users of the forum. The Secretariat further stated that one submission had been made on behalf of Norway, and that the Madrid Legal Forum should be an arena for exchanging views between sessions of the Working Group.
32. The Representative of INTA stated that it had made a submission to the Forum on Replacement and suggested that this forum be integrated in the Madrid Legal Forum.
33. The Secretariat sought the view of the Working Group on the frequency of its sessions, and the possibility of holding two sessions per year in the future.
34. A majority of delegations stated that, for a variety of reasons, they would prefer to keep the current schedule of one meeting per year.

35. The Chair concluded that it would be worth exploring alternative ways to expedite the discussions, including, in particular, the effective use of the Madrid Legal Forum.
36. Responding to a statement made by the Delegation of Germany, supported by the delegations of Cuba, France and Spain, on the timely provision of documents, at least two months before the meeting, the Secretariat reassured the Working Group of its commitment to make the best efforts for an earlier publication of documents in the future.

#### Agenda Item 6: Proposals for the Simplification of the Madrid System

37. A presentation on operational and procedural simplification of the Madrid system was made by Mr. Neil Wilson, Director, Functional Support Division, and Mrs. Asta Valdimarsdóttir, Head, Operations Service, which was warmly received and welcomed by the delegations. Certain delegations made proposals for further improvements of existing procedures and tools, which were duly noted by the International Bureau and deemed worthy of consideration.
38. Discussions were based on document MM/LD/WG/9/4.

#### *General Statements*

39. Some delegations stated that they could not endorse proposals concerning the amendments to Rules 6 and 40 of the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement (hereinafter referred to as the “Common Regulations”), because they considered that the proposals were not in line with the trilingual language regime of the Madrid system, were contrary to a sound linguistic policy and would hinder the expansion of the Madrid system. Other delegations did not deem it appropriate to legalize the current practice of translations upon request. Some delegations concluded that the proposed amendments required further analysis.
40. Some delegations endorsed the proposal since, in their view, it served the need for increased efficiency in the Madrid system and embodied the necessary balance between the interests of all parties involved and the preservation of the language regime.
41. Some delegations expressed support for the proposals regarding the sending of communications concerning the status of protection of the mark in a positive manner and the efficient publication of the *WIPO Gazette of International Marks* (hereinafter referred to as “the Gazette”).

#### *Proposal Regarding Translation Upon Request of Statements of Grant of Protection, Following a Provisional Refusal, Made Under Rule 18ter(2)(ii) (Paragraphs 5 to 24 of Document MM/LD/WG/9/4)*

42. Certain delegations expressed support for the proposal. Other delegations opposed the legalization of the current practice of the International Bureau embodied by the proposal, even though they were ready to temporarily accept the continuation of the current practice. These delegations also stated that the simplification of the Madrid system should not affect the trilingual regime which was a cornerstone of the Madrid system, and which should not be permanently abolished; they underlined the danger that the proposed approach could be spread to other WIPO administered treaties.

43. The Secretariat indicated that continuation of the current practice would not be in compliance with the legal framework, that full compliance with the current legal framework would imply additional financial resources in view of the backlog so far accumulated, and that the proposed simplification did not prejudice language regime of the Madrid system.
44. The Chair concluded that the current practice of the International Bureau is a logical solution to the ever increasing workload and of the expansion of the system.
45. The Working Group agreed to recommend to the Madrid Union Assembly that it take note of the current practice of the International Bureau concerning translation, as described in paragraphs 5 to 16 of document MM/LD/WG/9/4.

*Proposal Concerning the Translation of the List of Goods and Services Affected by a Limitation in an International Application, Subsequent Designation or Request for Limitation (Paragraphs 25 to 44 of Document MM/LD/WG/9/4)*

46. The views of delegations were divided in essentially the same way as for the previous proposal.
47. The Delegation of Japan proposed the introduction of a practice similar to the one followed for translations of statements of grant of protection, following a provisional refusal, made under Rule 18ter(2)(ii). This proposal met with the approval of a number of delegations with no delegation objecting to it.
48. The Working Group recommended that the International Bureau implement a practice, concerning the translation of the list of goods and services affected by a limitation in an international application, subsequent designation or request for limitation, as described in paragraphs 25 to 44 of document MM/LD/WG/9/4, with the inclusion of the option of translation upon request, and agreed to recommend that the Madrid Union Assembly take note accordingly.

*Proposal Regarding Communications Concerning the Status of Protection of the Mark Sent by the Offices of the Contracting Parties to the International Bureau in a Positive Manner (Paragraphs 45 to 62 of Document MM/LD/WG/9/4)*

49. All the delegations which spoke expressed their disagreement to the proposal on the bases that it would introduce unnecessary complexity to the internal procedures of Offices, require special examination procedures and would negatively affect the necessary clarity as to the refused protection for the purposes of lodging requests for review or appeals.
50. The representative of INTA suggested that the communications concerning the status of protection should be made both in a positive and a negative manner.
51. The Chair concluded that the Working Group decided not to adopt the proposal. The Chair stated that the International Bureau would further study this issue, with a view to a possible inclusion in a future session of the Working Group.

*Proposal Regarding Efficient Publication of the Gazette (Paragraphs 63 to 70 of Document MM/LD/WG/9/4)*

52. No delegation expressed any objection to the proposal.
53. The Chair concluded that the Working Group decided to recommend to the Madrid Union Assembly the amendment to Rule 32(3), as proposed. The proposed new rule is reproduced in Annex II to this document.

Agenda Item 9: Summary by the Chair

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

Agenda Item 10: Closing of the Session

55. The Chair closed the session on July 8, 2011.

[Annexes follow]



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**MM/LD/WG/9/1**  
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## **Working Group on the Legal Development of the Madrid System for the International Registration of Marks**

**Ninth Session**  
**Geneva, July 4 to 8, 2011**

### **AGENDA**

*adopted by the Working Group*

1. Opening of the session
2. Election of a Chair and two Vice-Chairs
3. Adoption of the Agenda  
See the present document
4. Information Concerning Ceasing of Effect and Transformation  
See document MM/LD/WG/9/3.
5. Information Relating to the Review of the Application of Article 9*sexies*(1)(b) of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks  
See document MM/LD/WG/9/5 Rev.
6. Proposals for the Simplification of the Madrid System  
See document MM/LD/WG/9/4
7. Legal Development of the Madrid System  
Division of the International Registration  
See document MM/LD/WG/9/2.



8. Other matters
9. Summary by the Chair
10. Closing of the session

[Annex II follows]

**PROPOSALS FOR THE MODIFICATION OF THE LEGAL FRAMEWORK OF THE MADRID SYSTEM**

**Proposals Concerning the Common Regulations Under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement**

*Rule 32  
Gazette*

[...]

(3) [The Gazette shall be published on the website of the World Intellectual Property Organization.](#) ~~[Number of Copies for Offices of Contracting Parties] (a) The International Bureau shall send to the Office of each Contracting Party copies of the Gazette. Each Office shall be entitled, free of charge, to two copies and, where during a given calendar year the number of designations recorded with respect to the Contracting Party concerned has exceeded 2,000, in the following year one additional copy and further additional copies for every 1,000 designations in excess of 2,000. Each Contracting Party may purchase every year, at half of the subscription price, the same number of copies as that to which it is entitled free of charge.~~

~~(b) If the Gazette is available in more than one form, each Office may choose the form in which it wishes to receive any copy to which it is entitled.~~

[End of Annex II and of document]