

Special Union for the International Registration of Marks (Madrid Union)

Assembly

Fifty-Fifth (24th Ordinary) Session
Geneva, October 4 to 8, 2021

DRAFT REPORT

prepared by the Secretariat

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/62/1): 1, 2, 3, 4, 5, 6, 10(ii), 11, 12, 22, 32 and 33.
2. The reports on the said items, with the exception of item 22, are contained in the draft General Report (document A/62/13 Prov.).
3. The report on item 22 is contained in the present document.
4. Mr. Philippe Cadre (France) was elected Chair of the Assembly;
Mr. Willie Mushayi (Zimbabwe) was elected Vice-Chair.

ITEM 22 OF THE CONSOLIDATED AGENDA

MADRID SYSTEM

5. The Chair welcomed two new Contracting Parties where the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as “the Madrid Protocol”) had entered into force since the Madrid Union Assembly had held its previous session in October 2020, namely, Trinidad and Tobago and Pakistan.

Proposed Amendments to the Regulations Under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks

6. Discussions were based on document MM/A/55/1.

7. The Secretariat indicated that document MM/A/55/1 proposed a number of amendments to the Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as “the Regulations”). The Working Group on the Legal Development of the Madrid System for the International Registration of Marks (hereinafter referred to as, respectively, “the Working Group” and “the Madrid System”) had recommended the adoption of the proposed amendments at its eighteenth session. The Secretariat stated that these amendments were quite technical in nature and could be grouped into four categories. Under the first category, the proposed amendments provided for new means of representing marks, which would be a significant modernization of the Madrid System because, at that time, marks could only be represented by graphical means. In the second category, the proposed amendments would provide for greater flexibilities and relief to users who had missed certain time limits under the Madrid System, including due to *force majeure* reasons. The third category of proposed amendments concerned the manner in which a representative before the International Bureau could be appointed and regulated certain aspects of the cancellation of such appointment. The final category of proposed amendments concerned housekeeping matters. The Secretariat said that the Working Group had recommended that the proposed amendments enter into force on November 1, 2021, except those concerning new means of representing marks, which were recommended for entry into force on February 1, 2023.

8. The Delegation of Belarus, speaking on behalf of the Group of Central Asian, Caucasus and Eastern European Countries (CACEEC), expressed its support for the proposed amendments to the Regulations. The Delegation emphasized the need for continued work to develop the Madrid System further and, in particular, to break the language barrier giving users greater access to this system and enhancing the quality of the international application procedure. The Delegation stated that parity should be given to the United Nations (UN) official languages, including to the Russian language, and that its regional group looked forward to discussing a document on the possible introduction of the Arabic, Chinese and Russian languages into the Madrid System at the upcoming session of the Working Group. The Delegation said that it hoped other delegations would support this approach, in principle, and help the Working Group make progress on the matter of languages, which was a very important subject for several delegations.

9. The Delegation of China expressed its support for the proposed amendments to the Regulations and its appreciation for the cooperative approach of the members of the Madrid Union and of the Secretariat. The Delegation indicated that the Madrid System, as well as all the other global IP services administered by WIPO, should constantly modernize to adapt to a changing environment and to meet the needs of its users. The Delegation encouraged the members of the Madrid Union to continue with a pragmatic approach and, in alignment with the language policy of the Organization, accelerate the introduction of the Arabic, Chinese and

Russian languages, which were UN official languages, into the Madrid System to modernize it and better serve the needs of global users.

10. The Delegation of the Russian Federation said that it joined in the statement delivered by the Delegation of Belarus, on behalf of CACEEC, and that it supported the adoption of the proposed amendments to the Regulations because it would facilitate the work in the Madrid System under the prevailing conditions. The Delegation stated that priority should be given to complying with the rights and legitimate interests of right holders, regardless of the place in which they resided. The Delegation indicated that the registration of intellectual property rights (IPRs) in the Russian Federation was guided by the provisions in the international treaties to which it was a party, such as the Madrid Protocol, in strict compliance with WIPO standards and in accordance with the applicable legislation of the Russian Federation. The Delegation stated that all activities concerning the registration of IPRs should be legally oriented. The Delegation recalled that the Program and Budget of the Organization for the upcoming biennium allocated significant resources to finance the Fellowship Program in the Brands and Designs Sector and expressed its hope for the continued success of this program, as it gave national experts the possibility to improve their skills and increase their knowledge, in particular, in the examination of applications. The Delegation expressed its gratitude for the cooperation displayed in the discussion of the possible introduction of the Arabic, Chinese and Russian languages into the Madrid System, advocated for continued work to expand its language coverage and emphasized the need to devise a practical approach that could meet the needs of users worldwide. The Delegation stated that a diversification of the language regime would increase the quality of the Madrid System and said that it looked forward to continuing discussions on the subject at the upcoming session of the Working Group with a view to finding a possible way forward that could allow it to make progress on the subject.

11. The Delegation of Azerbaijan expressed its support for the statement delivered by the Delegation of Belarus, on behalf of CACEEC, on the important issue of languages. The Delegation recalled that the Russian language was widely used in its region and said that its introduction into the Madrid System would help sustain the positive trend in international applications filed in the region, increase the quality of the services delivered by the Madrid System and shorten the time required to process applications. The Delegation encouraged continued discussions on the implications of the introduction of the Arabic, Chinese and Russian languages into the Madrid System at the upcoming session of the Working Group. The Delegation stated that enhancing the linguistic diversity would be a logical step in developing the Madrid System because it would remove linguistic barriers and give greater access to this system to a larger number of users. This work would help the Organization to achieve its objectives in the area of linguistic diversity, while observing the principle of equality among official UN languages, including Arabic and Chinese.

12. The Delegation of Pakistan thanked the Secretariat and, in particular, the Division for Asia and the Pacific, for their unwavering support during the accession of Pakistan to the Madrid Protocol, welcomed the proposed amendments to the Regulations and said that it looked forward to receiving the continued support of the Secretariat in the implementation of this treaty in Pakistan.

13. The Delegation of Spain indicated that it was aware that technical studies and work were essential for the Organization and that it actively participated in the Working Group and in other technical meetings of the Organization for this reason. The Delegation stated that the appropriate functioning and sustainability of the Madrid System were essential and that some of the proposed amendments the Working Group had recommended would facilitate the work of applicants and holders in the management of their rights. The Delegation added that, for that reason, it expressed its gratitude and satisfaction for the proposed amendments to Rules 3, 5, 5*bis*, 22, 24 and 39 of the Regulations. The Delegation highlighted that the proposed amendments to Rule 9 and the consequential amendments to Rules 15, 17 and 32 of the

Regulations and to item 2 of the Schedule of Fees were the culmination of a long process that had been underway to provide for new means of representing marks. These proposed amendments were aligned with the progress made by several members in that area in recent years. The Delegation said that the introduction of new means of representing marks would be a welcomed development to meet the needs of users in an increasingly modern and complex corporate environment and urged the Secretariat to devise a way to achieve this introduction without increasing the complexity of the Madrid System for users and Offices. The Delegation shared its concern with the proposed amendment to Rule 21(3)(d) of the Regulations that would provide for the possibility of partial replacement because it would necessarily involve significant changes at the administrative and technological level. The Delegation expressed doubt at the possibility that the use of this feature would compensate the introduction of those changes because, until then, the use of replacement had been minimal.

14. The Delegation of Morocco expressed its support for the proposed amendments to the Regulations because they were a positive development as they would simplify and increase the use of the Madrid System.

15. The Representative of the Intellectual Property Latin American School (ELAPI) brought attention to the qualitative and quantitative promotional activities that ELAPI had undertaken to promote legal instruments, technical support and other manifestations of the Stockholm spirit, which instituted the system for the protection of the expressions of the human intellect. The Representative indicated that such protection was one of the pillars of the international system that allowed for the comprehensive development of peoples based on the unrestricted respect for the individual in its various derivations. The Representative highlighted the substantive, core and central value of trademarks as a manifestation of identity, not just from the traditional, yet very important, aspects of commercial interaction, but also as a form of identification of a nation. The Representative indicated that States had ventured into the configuration of country brands to promote economic growth in their competitive areas, which was a very important aspect under the circumstances, and as a way to establish a cultural differential. The Representative indicated that ELAPI encouraged the creation of those expressions of national identity to improve international economic investment and to value the cultural elements of nations. The Representative added that ELAPI believed that, based on the principle of equality among States with its broad normative manifestations both at the conventional level and as soft law instruments, it was of vital importance to establish legal mechanisms of extraterritorial effectiveness to ensure equality in the institution of those expressions with which nations seek to promote themselves. The Representative reiterated to the Assembly and to the Group of Latin American and Caribbean Countries (GRULAC) the willingness of ELAPI to collaborate in efforts on this matter.

16. The Madrid Union Assembly adopted the amendments to Rules 3, 5, 5*bis*, 9, 15, 17, 21, 22, 24, 32, 39 and 40 of the Regulations Under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, as well as the amendments to the Schedule of Fees, as set out in the Annexes to document MM/A/55/1.

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