

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

Fifteenth Session
Geneva, June 19 to 22, 2017

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 June 19 to 22, 2017.
2. The following Contracting Parties of the Madrid Union were represented at the session: African Intellectual Property Organization (OAPI), Albania, Algeria, Australia, Austria, Belarus, Brunei Darussalam, Cambodia, China, Colombia, Cuba, Cyprus, Czech Republic, Denmark, Estonia, European Union (EU), Finland, France, Georgia, Germany, Greece, Hungary, Iceland, India, Israel, Italy, Japan, Kazakhstan, Latvia, Lithuania, Madagascar, Mexico, Montenegro, Morocco, Mozambique, New Zealand, Norway, Oman, Philippines, Poland, Portugal, Republic of Korea, Republic of Moldova, Romania, Russian Federation, Singapore, Slovakia, Spain, Sweden, Switzerland, Tajikistan, Tunisia, Turkey, United Kingdom, United States of America (55).
3. The following States were represented as observers: Afghanistan, Benin, Brazil, Canada, Iraq, Kuwait, Malaysia, Malta, Pakistan, Sri Lanka, Thailand (11).
4. Representatives of the following international intergovernmental organizations took part in the session in an observer capacity: Benelux Office for Intellectual Property (BOIP), Eurasian Economic Commission (EEC), World Trade Organization (WTO) (3).

5. Representatives of the following international non-governmental organizations took part in the session in an observer capacity: Association of Trade Mark and Design Law Practitioners (APRAM), *Association romande de propriété intellectuelle* (AROPI), Centre for International Intellectual Property Studies (CEIPI), European Communities Trade Mark Association (ECTA), International Trademark Association (INTA), Japan Intellectual Property Association (JIPA), Japan Patent Attorneys Association (JPAA), Japan Trademark Association (JTA), MARQUES – Association of European Trade Mark Owners (9).

6. The list of participants is contained in document MM/LD/WG/15/INF/1 Prov. 2*.

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.

AGENDA ITEM 2: ELECTION OF THE CHAIR AND TWO VICE-CHAIRS

8. Mr. Mikael Francke Ravn (Denmark) was unanimously elected as Chair of the Working Group, Ms. Mathilde Manitra Soa Raharinony (Madagascar) and Ms. Isabelle Tan (Singapore) were unanimously elected as Vice-Chairs.

9. Ms. Debbie Roenning acted as Secretary to the Working Group.

AGENDA ITEM 3: ADOPTION OF THE AGENDA

10. The Working Group adopted the draft agenda (document MM/LD/WG/15/1 Prov. 2), without modification.

11. The Working Group took note of the electronic adoption of the report of the fourteenth session of the Working Group.

AGENDA ITEM 4: REPLACEMENT

12. Discussions were based on document MM/LD/WG/15/2.

13. The Working Group tentatively agreed:

(i) with the proposed amendments to Rule 21 and with new item 7.8 of the Schedule of Fees, as amended by the Working Group and as set out in Annex I to the present document; and,

(ii) to request the International Bureau to prepare a document proposing the amount of the fee to be specified in new item 7.8 of the Schedule of Fees and suggesting a date for the entry into force of amended Rule 21, to be discussed at its next session.

* The final list of participants will be made available as an Annex to the report of the session.

AGENDA ITEM 5: ANALYSIS OF LIMITATIONS IN THE MADRID SYSTEM FOR THE INTERNATIONAL REGISTRATION OF MARKS

14. Discussions were based on document MM/LD/WG/15/3.

15. The Working Group agreed to request the International Bureau to:

(i) submit to the Offices of the Contracting Parties of the Madrid System and to users' organizations a draft questionnaire on the role of those Offices and of the International Bureau on limitations;

(ii) conduct a survey among Offices of the Contracting Parties of the Madrid System and users' organizations on the role of those Offices and of the International Bureau on limitations; and

(iii) prepare a document on the findings of that survey to be discussed by the Working Group at its next session.

AGENDA ITEM 6: OTHER MATTERS

16. Discussions were based on document MM/LD/WG/15/4.

17. The Working Group agreed to amend the road map including a list of subjects to be discussed by the Working Group or its Roundtable, as set out in Annex II to the present document.

AGENDA ITEM 7: SUMMARY BY THE CHAIR

18. The Working Group approved the Summary by the Chair, as amended to take account the interventions of a number of delegations.

AGENDA ITEM 8: CLOSING OF THE SESSION

19. The Chair closed the session on June 22, 2017.

[Annexes follow]

PROPOSED AMENDMENTS TO THE COMMON REGULATIONS UNDER THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS AND THE PROTOCOL RELATING TO THAT AGREEMENT

See document MM/LD/WG/14/6, paragraph 13(iii) and Annex II. The text of Rule 21, as tentatively agreed by the Working Group at its fourteenth session, is reproduced below in a clean version. The proposed amendments under discussion are indicated in track-changes.

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

(as in force on [to be determined])

[...]

Rule 21

Replacement under Article 4bis of the Agreement or the Protocol

(1) *[Presentation of the Request]* The holder may, from the date of the notification of the designation, present a request for the Office of a designated Contracting Party to take note of the international registration in its Register. The request may be presented directly to that Office or through the International Bureau. Where presented through the International Bureau, the request shall be effected on the relevant official form.

(2) *[Contents of a Request Presented Through the International Bureau and Transmission]* (a) The request referred to in paragraph (1), where presented through the International Bureau, shall indicate:

- (i) the number of the international registration concerned,
- (ii) the name of the holder,
- (iii) the Contracting Party concerned,
- (iv) where replacement concerns only one or some of the goods and services in the international registration, those goods and services,
- (v) the filing date and number, the registration date and number, and, if any, the priority date of the national or regional registration or registrations which are deemed to be replaced by the international registration; and,
- (vi) ~~where paragraph (7) applies,~~ the amount of the fees being paid, the method of payment, or instructions to debit the required amount of fees to an account opened with the International Bureau and the identification of the party effecting the payment or giving the instructions.

(b) The International Bureau shall transmit the request referred to in subparagraph (a) to the Office of the designated Contracting Party concerned and inform the holder accordingly.

(3) *[Examination and Notification by the Office of a Contracting Party]* (a) The Office of a designated Contracting Party may examine the request referred to in paragraph (1) for compliance with the conditions under Article 4bis(1) of the Agreement or of the Protocol.

(b) An Office that has taken note in its Register of an international registration shall so notify the International Bureau. Such notification shall contain the indications specified in paragraph (2)(a)(i) to (v). The notification may also contain information relating to any other rights acquired by virtue of the national or regional registration or registrations concerned.

(c) ~~An~~ Where the request has been presented through the International Bureau and the Office ~~that has~~ of the designated Contracting Party concerned has decided not ~~take~~ to take note, ~~it~~ may so notify the International Bureau, which shall inform the holder accordingly.

~~(4) [Recording and Notification] The International Bureau shall record in the International Register any notification received under paragraph (3)(b) and shall inform the holder accordingly.~~

~~{(54) [Scope of Goods and Services Concerned by Replacement] The names of the goods and services listed in (a) The international registration is deemed to have replaced the national or regional registration or registrations ~~shall be equivalent, but not necessarily identical, to those listed in only~~ in respect of the goods and services covered by both the international registration ~~that has replaced them~~ and the national or regional registration or registrations.~~

~~(b) The names of the goods and services in the national or regional registration or registrations concerned by replacement shall be the same or equivalent to those covered by the international registration.}~~

(65) [Effects of Replacement on the National or Regional Registration] A national or regional registration or registrations shall not be cancelled or otherwise affected by the fact that they are deemed to be replaced by an international registration or that the Office has taken note in its Register of the latter.

(6) [Recording and Notification] (a) The International Bureau shall record in the International Register, as of the date of receipt by the International Bureau, any notification under paragraph (3)(b) complying with the applicable requirements.

(b) The International Bureau shall inform the holder of any notification recorded under subparagraph (a).

~~{(7) [Fees] (a) Where a Contracting Party requires a fee for the presentation of a request under paragraph (1), the request is presented through the International Bureau, and the Contracting Party wishes the International Bureau to collect that fee, it shall so notify the International Bureau Director General, indicating the amount of the fee in Swiss currency ~~or in the currency used by the Office~~. A Contracting Party can notify changes in the required fee twice in a given calendar year. Rule 35(2)(b) shall apply mutatis mutandis.~~

~~(b) Fees or changes thereto will be applicable three months from the date of receipt by the Director General of any notification under subparagraph (a).~~

~~(c) Fees collected by the International Bureau on behalf of a Contracting Party under subparagraph (a) shall be credited to the account of that Contracting Party according to the procedure applicable to the fees payable for the designation of such Contracting Party.~~

~~(d) A request under paragraph (2) shall be subject to the payment of the fee specified in item 7.8 of the Schedule of Fees.}~~

PROPOSED AMENDMENTS TO THE SCHEDULE OF FEES

SCHEDULE OF FEES

(in force on [\[to be determined\]](#))

Swiss francs

7. *Miscellaneous recordings*

[...]

[7.8 Request presented through the International Bureau that the Office of one or more designated Contracting Parties take note of an international registration \(replacement\)](#) [\[to be determined\]](#)

[Annex II follows]

PROPOSED REVISED ROAD MAP – JUNE 2017

SHORT TERM

WORKING GROUP	ROUNDTABLE
Replacement	Classification principles ¹
Transformation	Correction
New types of marks	Correspondence of marks for certification purposes
Limitations	Marks in different scripts Fulfillment of requirements Examination practices of the International Bureau (publication of)

MEDIUM TERM

WORKING GROUP	ROUNDTABLE
Harmonized time limit to reply to a provisional refusal ²	Examination practices of the International Bureau (publication of)
Possible reduction of the dependency period	Reducing inconsistencies of classification practices ¹
Fee revision and payment options ³	Updated International Registration Certificates
Correction	Universal provision of full statements of grant of protection from all Contracting Parties ⁴ Option for requesting a search upon designation of the European Union ⁵

LONG TERM

Entitlement to file
Issues listed in IV of document MM/LD/WG/14/4 "Options Concerning Offices"
Review procedure
Scope of the list of goods and services (possible de-linking)

REPORTING TO ROUNDTABLE

Geographical coverage of the Madrid System
Performance framework
Time to process regular transactions (maximum processing time)
E-Madrid

[End of Annex II and of document]

¹ Including "Divergent practices around goods and services specification – potential for increased collaboration between WIPO and designated Offices" (MM/LD/WG/15/4, paragraphs 12 and 13).
² Including "Provision of clear deadlines of response in relation to WIPO notifications, with these listed on the front page of communication" (MM/LD/WG/15/4, paragraphs 6 to 8).
³ Including "Automatic deduction of second part fees when designating countries with this requirement" (MM/LD/WG/15/4, paragraphs 9 to 11).
⁴ New topic (MM/LD/WG/15/4, paragraphs 14 to 16).
⁵ New topic (MM/LD/WG/15/4, paragraphs 17 and 18).