

Eighteenth Session of the Madrid Working Group

Joint Statement

Regarding Paper MM/LD/WG/18/6 Provisional Refusal

In preparation of the Madrid Working Group meeting, the undersigned organisations, representing thousands of brand owners and companies across industry, as well as entrepreneurs and small and medium-sized enterprises (SMEs) and intellectual property practitioners in Europe and beyond, would like generally to state the following regarding the agenda item MM/LD/WG/18/6¹ PROVISIONAL REFUSAL.

1. INTRODUCTORY REMARKS

At the 14th session of the Madrid Working Group the Secretariat put forward the paper “The Future Development of the Madrid System for the International Registration of Marks”² (hereafter referred to as “the Future Paper”). As identified in the Future Paper, the time limits to respond to provisional refusals vary greatly between Contracting Parties: from 15 days to 15 months. As detailed in the position by the Delegation of the United Kingdom, supported by CITMA and MARQUES, in a paper submitted for the Fifteenth Session of the Working Group (document MM/LD/WG/15/4)³, users of the system find it difficult to ascertain if dates are set by WIPO or by national offices. Users of the system continue to find it difficult to ascertain or calculate the actual response date relating to the provisional refusal, and often the information provided in the guidance documents does not match advice from the local attorneys in most countries. This ambiguity may result in brand owners missing the chance to respond to provisional refusals and may lead to marks being cancelled unnecessarily. Moreover, the confusion over deadlines to respond can in turn, lead to additional work for the International Bureau and national offices if this results in applications requiring reinstatement.

2. REMARKS ON SUBSTANCE

It is the view of the undersigned organisations that it is very important for ease of use of the International Registration system and for confidence in the operation of the system that users get prompt notification of issues affecting their applied-for rights and a clear indication of the time available for these issues to be dealt with. Anything less compromises the fairness and accessibility of the system.

¹ Document MM/LD/WG/18/6 available at https://www.wipo.int/edocs/mdocs/madrid/en/mm_ld_wg_18/mm_ld_wg_18_6.docx

² Document MM/LD/WG/14/4 available at: http://www.wipo.int/edocs/mdocs/madrid/en/mm_ld_wg_14/mm_ld_wg_14_4.pdf

³ Document MM/LD/WG/15/4 available at https://www.wipo.int/edocs/mdocs/madrid/en/mm_ld_wg_15/mm_ld_wg_15_4.docx

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As a result, we strongly encourage the Working Group to make such changes as are necessary to ensure that as much as possible, there is harmonisation of time limits to respond to provisional refusals, and ideally this should be controlled by Regulation rather than left to the individual Contracting Party and there should be speedy processing of provisional refusals both by the Contracting Parties and the International Bureau, and in particular this should be facilitated by electronic means of communication between all parties.

The undersigned organisations support the proposal by the International Bureau to apply an interpretation that, for the purposes of calculating the time limit, the refusal could be deemed to have been issued or transmitted to the International Bureau on the date which the International Bureau transmits it to the holder.

Importantly, this would allow the International Bureau to include, on that transmission, a clear statement of the date by which a response is required. Without the exact date of the deadline being stated on the face of the correspondence, the possibility for error remains. This issue would not be resolved by a clearer statement of the date of notification and / or the method of calculating the response date. Having an exact date of the deadline for responses is common practice amongst Trade Mark Registries around the world for nationally filed trade marks, it is an obvious way to improve confidence in the system and so there should be no difference for International registrations. We strongly encourage the Working Group to adopt this proposal, including the requirement for the International Bureau to clearly state the actual date of the deadline for response on communications regarding provisional refusals.

We note that while harmonisation of the notification time limits is ideal to avoid either the very short or very long deadlines that exist now, we ask for implementation of an immediate *interim* solution (hopefully without delay), where the International Bureau would provide a clear indication of the required response date. This will solve almost all problems in handling the deadlines currently faced by applicants and their representatives.

As this is a general concern within the IP community, before concluding, we wish to note that other organisations might join in this statement, as we write.

We look forward to participating in the Madrid Working Group meeting. We gladly remain at disposal for any clarifications that may be requested over the course of our participation.

9 October 2020

The signatories

AIM, APRAM, CITMA, ECTA and MARQUES

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About the signatory organisations:

AIM®

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AIM is the European Brands Association representing brand manufacturers in Europe on key issues which affect their ability to design, distribute and market their brands. AIM's membership comprises 2500 businesses ranging from SMEs to multinationals, directly or indirectly through its corporate and national association members. For more information, please visit: <https://www.aim.be/>.

APRAM

APRAM – Association of Trademarks and Designs Rights Practitioners – is an international Association for specialists in industrial and intellectual property, in particular Trademarks and designs. The association, which now has more than 1150 members, was founded 42 years ago and is open to all francophone or francophile lawyers practicing, all over the world, in the field of Trademarks and designs. It gathers together in-house intellectual property specialists, Attorneys at law and Trade Mark Attorneys. The association plays an active role in, and is at the forefront of, further to consultation or on its own initiative, discussions concerning intellectual property and business law in France, Europe and the world. APRAM is member of the EUIPO's users group and the EUIPO's Observatory, and is observer at the World Intellectual Property Organization (WIPO). For more information, please visit: <http://www.apram.com>

CITMA

The Chartered
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CITMA - Founded in 1934, chartered in 2016, the Chartered Institute of Trade Mark Attorneys (CITMA) is a UK-based professional membership organisation representing the interests of over 1,600 trade mark and design legal professionals. Our community of members includes Chartered Trade Mark Attorneys, those in training and support roles, and barristers and solicitors with a trade mark or design interest working around the world. For more information, please visit: www.citma.org.uk.

ECTA

ECTA, founded in 1980, brings together IPR professionals who practice in the field of trade marks, designs, geographical indications, copyrights, and related matters. ECTA members come from all EU Member States and associate members from more than 50 countries globally outside of the EU. These professionals are lawyers, trade mark and patent attorneys, in-house counsels focusing on IPR matters, and also other specialists in these fields. The extensive work carried out by the Association, following the above guidelines, combined with the high degree of professionalism and recognised technical capabilities of its members, has established ECTA at the highest level and has allowed the Association to achieve the status of a broadly recognised expert body on all questions related to the protection and use of trade marks, designs, geographical indications, copyrights and domain names in and throughout the European Union. For more information, please visit: www.ecta.eu.

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MARQUES is the European association representing brand owners' interests. MARQUES' mission is to be the trusted voice for brand owners.

MARQUES unites European and international brand owners across all industry sectors to address issues associated with the use, protection and value of IP rights, as these are essential elements of commerce, vital to innovation, growth and job creation, which ultimately enhance internal markets. Its current membership includes intellectual property rights owners and legal practitioners representing their intellectual property rights and interests, in more than 80 countries.

MARQUES is an accredited organisation before the European Union Intellectual Property Office (EUIPO), appointed observer at the EUIPO's Management Board and Budget Committee, an official non-governmental observer at the World Intellectual Property Organisation and a registered interest representative organisation (ID 97131823590-44) in the Transparency Register set up by the European Parliament and the European Commission. More information about MARQUES and its initiatives is available at www.marques.org.