

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

**Nineteenth Session**  
**Geneva, November 15 to 17, 2021**

### SUMMARY BY THE CHAIR

*approved 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 November 15 to 17, 2021.
2. The following Contracting Parties of the Madrid Union were represented at the session: Algeria, Antigua and Barbuda, Armenia, Australia, Austria, Azerbaijan, Bahrain, Belarus, Bhutan, Brazil, Cambodia, Canada, China, Colombia, Czech Republic, Democratic People’s Republic of Korea, Denmark, Egypt, Estonia, European Union (EU), Finland, France, Georgia, Germany, Ghana, Greece, Hungary, Iceland, India, Indonesia, Iran (Islamic Republic of), Israel, Italy, Japan, Kazakhstan, Kyrgyzstan, Latvia, Lesotho, Lithuania, Madagascar, Malawi, Malaysia, Mexico, Morocco, New Zealand, North Macedonia, Norway, Oman, Pakistan, Philippines, Poland, Portugal, Republic of Korea, Republic of Moldova, Romania, Russian Federation, Serbia, Singapore, Slovakia, Slovenia, Spain, Sudan, Sweden, Switzerland, Syrian Arab Republic, Tajikistan, Thailand, Trinidad and Tobago, Tunisia, Turkey, Turkmenistan, Ukraine, United Arab Emirates\*, United Kingdom, United States of America, Uzbekistan, Viet Nam (77).
3. The following States were represented as observers: Côte d’Ivoire, Djibouti, Ethiopia, Peru, Qatar, Saudi Arabia, South Africa, Yemen (8).

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\* On September 28, 2021, the Government of the United Arab Emirates deposited its instrument of accession to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks. The Madrid Protocol will enter into force with respect to the United Arab Emirates, on December 28, 2021.

4. Representatives of the following international intergovernmental organization took part in the session in an observer capacity: Benelux Organization for Intellectual Property (BOIP) (1).
5. Representatives of the following international non-governmental organizations took part in the session in an observer capacity: Asian Patent Attorneys Association (APAA), *Association romande de propriété intellectuelle* (AROPI), Benelux Association of Trademark and Design Agents (BMM), Brazilian Association of Intellectual Property (ABPI), Centre for International Intellectual Property Studies (CEIPI), China Council for the Promotion of International Trade (CCPIT), China Trademark Association (CTA), European Brands Association (AIM), European Communities Trade Mark Association (ECTA), German Association for the Protection of Industrial Property (GRUR), International Federation of Intellectual Property Attorneys (FICPI), International Trademark Association (INTA), Japan Intellectual Property Association (JIPA), Japan Patent Attorneys Association (JPAA), Japan Trademark Association (JTA), MARQUES - Association of European Trademark Owners, The Chartered Institute of Trade Mark Attorneys (CITMA) (17).
6. The list of participants is contained in document MM/LD/WG/19/INF/2.

#### **AGENDA ITEM 1: OPENING OF THE SESSION**

7. Ms. Wang Binying, Deputy Director General, Brands and Designs Sector, 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. Nicolas Lesieur (Canada) was elected as Chair of the Working Group, Mr. Juan Pablo Mateus Bernal (Colombia) and Ms. Tiyamike Banda (Malawi) were 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/19/1 Prov. 3).
11. The Working Group took note of the electronic adoption of the report of the eighteenth session of the Working Group.

#### **AGENDA ITEM 4: ACCREDITATION OF AN OBSERVER**

12. Discussions were based on document MM/LD/WG/19/2.
13. The Working Group approved the representation in sessions of the Working Group of the China Trademark Association (CTA).

#### **AGENDA ITEM 5: PROVISIONAL REFUSAL**

14. Discussions were based on documents MM/LD/WG/19/3 and MM/LD/WG/19/INF/1.
15. The Working Group requested the International Bureau to prepare a document, for discussion at its next session, proposing amendments to the Regulations providing for:
  - (i) a minimum time limit for the holder of an international registration to respond to a notification of provisional refusal;
  - (ii) an obligation to clearly indicate in that notification the start and expiry date of the said time limit; and,
  - (iii) the delayed implementation of the proposed amendments giving Contracting Parties time to make the necessary legislative and administrative changes.

**AGENDA ITEM 6: PROPOSED AMENDMENTS TO THE REGULATIONS UNDER THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS**

16. Discussions were based on document MM/LD/WG/19/4.

17. The Working Group recommended to the Madrid Union Assembly the adoption of the proposed amendments to the Regulations as amended by the Working Group and as set out in the Annex to the present document, with November 1, 2022, as the date of their entry into force.

**AGENDA ITEM 7: DEPENDENCY**

18. Discussions were based on document MM/LD/WG/19/5.

19. The Working Group:

(i) indicated that it favored a reduction of the dependency period from five to three years and requested the Secretariat to prepare a document on the possibility to convene a diplomatic conference to amend the Protocol for this purpose and on other possible options to implement this reduction, for discussion at its following session; and,

(ii) requested that the Secretariat prepare another document exploring further options concerning dependency, also for discussion at its following session.

**AGENDA ITEM 8: PROPOSAL BY THE DELEGATION OF SWITZERLAND**

20. Discussions were based on document MM/LD/WG/19/6.

21. The Working Group took note of the proposals contained in document MM/LD/WG/19/6 and agreed to continue discussing them at its following session.

**AGENDA ITEM 9: REVISED STUDY OF THE COST IMPLICATIONS AND TECHNICAL FEASIBILITY OF THE GRADUAL INTRODUCTION OF THE ARABIC, CHINESE AND RUSSIAN LANGUAGES INTO THE MADRID SYSTEM AND OTHER RELEVANT INFORMATION**

22. Discussions were based on document MM/LD/WG/19/7.

23. The Working Group:

(i) acknowledged the *Revised Study on the Cost Implications and Technical Feasibility of the Gradual Introduction of the Arabic, Chinese and Russian Languages into the Madrid System and other Relevant Information*, contained in document MM/LD/WG/19/7;

(ii) requested the International Bureau to continue to hold technical consultations with interested Contracting Parties of the Madrid Protocol and other WIPO Member States as well as with users' organizations, in particular regarding the elements mentioned in paragraph 38 of document MM/LD/WG/19/7 and report back to the Working Group, at its following session, on those consultations; and,

(iii) requested the International Bureau to prepare a document proposing a way forward in particular regarding the elements mentioned in paragraphs 39 to 60 of document MM/LD/WG/19/7, taking into account the above-mentioned consultations, to be discussed at the following session of the Working Group.

**AGENDA ITEM 10: PRESENTATION BY THE INTERNATIONAL BUREAU ON THE LATEST DEVELOPMENTS IN THE MADRID REGISTRY**

24. The Working Group took note of the latest developments in the Madrid Registry.

**AGENDA ITEM 11: SUMMARY BY THE CHAIR**

25. The Working Group approved the Summary by the Chair, as contained in the present document.

**AGENDA ITEM 12: CLOSING OF THE SESSION**

26. The Chair closed the session on November 17, 2021.

[Annex follows]

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

as in force on ~~November 1, 2021~~ November 1, 2022

[...]

### Chapter 1 General Provisions

[...]

#### Rule 3 Representation Before the International Bureau

[...]

##### (2) *[Appointment of the Representative]*

[...]

(b) The appointment of a representative may also be made in a separate communication, provided it is made on the relevant official form, which and it may relate to one or more specified international applications or international registrations of the same applicant or holder. The said ~~communication~~ form shall be presented to the International Bureau

- (i) by the applicant, the holder or the appointed representative, or
- (ii) by the Office of the Contracting Party of the holder.

The ~~communication~~ form shall be signed by the applicant or the holder, or by the Office ~~through which it was presented~~ presenting the request.

[...]

#### Rule 5 Excuse in Delay in Meeting Time Limits

[...]

(5) *[International Application and Subsequent Designation]* Where the International Bureau receives an international application or a subsequent designation beyond the two-month period referred to in Article 3(4) of the Protocol and in Rule 24(6)(b), and the Office concerned indicates that the late receipt resulted from circumstances referred to in paragraph (1), ~~(2) or (3)~~, paragraph (1), ~~(2) or (3)~~ and ~~paragraph~~ (4) shall apply.

[...]

**Chapter 6**  
**Renewals**

**Rule 30**  
**Details Concerning Renewal**

(1) *[Fees]*

[...]

(b) If any payment made for the purposes of renewal is received by the International Bureau earlier than ~~three~~six months before the date on which the renewal of the international registration is due, it shall be considered as having been received ~~three~~six months before the date on which renewal is due.

[...]

[End of Annex and of document]