

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

Ninth Session
Geneva, July 4 to 8, 2011

REPORT

adopted by the Working Group

INTRODUCTION

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”) held its ninth session, 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, Panama, Philippines, Qatar, Saudi Arabia, Senegal, Tunisia (14).
4. Representatives of the following international intergovernmental organizations 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 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* (AROPI), 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 Annex II to this draft report.

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.

8. Mr. Gurry recalled that in the current year, the Madrid System for the International Registration of Marks (hereinafter referred to as “the Madrid system”) was celebrating two anniversaries, namely, the 120th year since the conclusion of the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as “the Madrid Agreement”) in 1891 and, secondly, the 15th year since the entry into operation of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as “the Madrid Protocol”), in 1996.

9. Concerning developments in the Madrid system, Mr. Gurry noted that two of the three States that had been party only to the Madrid Agreement, namely Kazakhstan and Tajikistan, had deposited their instrument of accession to the Madrid Protocol, leaving just one State that remained party only to the Madrid Agreement. Mr. Gurry expressed his optimism that, in the future, that State would also accede to the Madrid Protocol. That meant that, currently, of the 85 members of the Madrid Union, 84 were now party to the Madrid Protocol and the prospect of a one-treaty system was looming very realistically.

10. With regard to membership of the Madrid system, Mr. Gurry referred to a number of developments that were taking place around the world and stated that active discussions were under way with quite a lot of countries, with a view to their joining the Madrid system. In this regard, in particular, Mr. Gurry made reference, in the Latin American region, to Colombia and the Dominican Republic, where proceedings for joining the Madrid system were well advanced. Mr. Gurry also referred to the understanding among the Association of Southeast Asian Nations (ASEAN) countries that those countries would join the Madrid system by the year 2015, and noted that a number of the countries in question had taken steps to join the system even before 2015. In particular, this concerned Indonesia, Malaysia, Philippines and Thailand. Mr. Gurry also referred to India having passed legislation in the previous year with a view to the ratification of the Madrid Protocol.

11. In terms of the use of the Madrid system, Mr. Gurry expressed pleasure in noting that 2010 had seen a recovery from the decline that had occurred in 2009. In particular, he noted that international applications had increased by some 12.8 per cent in 2010, amounting to 39,687 filings in the period in question. Mr. Gurry referred to a number of countries where there had been notable increases in filing activity, mentioning, in particular, China (42 per cent), the Republic of Korea (42 per cent), Italy (39 per cent), the United States of America (30 per cent), the European Union (27 per cent) and Japan (20 per cent). Mr. Gurry stated that there had been a continuation of that trend in the first five months of 2011, during which time international applications had increased by some 11.5 per cent over the equivalent period in 2010. Mr. Gurry said that the International Bureau was, at this time, on track to receive over 42,000 international applications over the course of 2011. This would result in a new record, surpassing the previous high recorded in 2008.

12. Mr. Gurry noted that there were now some 526,000 active international registrations in the International Register, representing some 5.5 million designations and 175,000 holders around the world. He said that 80 per cent of those holders were small- or medium-sized enterprises (SMEs).

13. Regarding the provision of services, Mr. Gurry referred to the establishment of a Customer Service Team in 2009, which was subsequently enhanced in 2010. He referred also to the creation of three new tools, namely, the Goods & Services Manager, which is available to assist international applicants in compiling their lists of goods and services, the Madrid Portfolio Manager, which will give access to applicants and holders to their international registrations, for status review and for interaction with the file, in terms of submission of documents. Thirdly, he referred to the Madrid Electronic Alert, which is a service to be made available to third parties who wish to follow the status of given international registrations.

14. Concerning IT strategy for Madrid, Mr. Gurry said that this had progressed well overall. In terms of electronic communications, some 41.5 per cent of international applications had been transmitted to the International Bureau electronically, and also refusals, statements of grant of protection and modifications. Up to May 2011, for example, Mr. Gurry said that 120,000 documents had been transmitted electronically to the International Bureau by Offices, representing about 55 per cent of the total number of documents transmitted. He said that there also had been an increase in the number of Offices using electronic communications, from 53 to 55.

15. Mr. Gurry recalled that the sending of statements of grant of protection had become mandatory as from January 2011, as a consequence of the introduction of new Rule 18*ter*. Up to the end of April, 2011, the International Bureau had received 40,000 such statements, which could be seen as an overwhelming endorsement of this new procedure that increased legal certainty for holders. In this regard, Mr. Gurry referred also to the successful work of the Working Group in the repeal of the safeguard clause. In this context, he emphasized the importance of looking to the future of the Madrid system, and noted that the Working Group was the vehicle for the evolution of the system. Mr. Gurry said that the current session would focus on the simplification of the system, the scope of central attack, and the possibility of division of international registrations.

16. Mr. Gurry then thanked the delegations for their constructive engagement in the development and evolution of the Madrid system and said that he looked forward to a very positive week of discussions.

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

17. 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.

18. Ms. Debbie Roenning (WIPO) acted as Secretary to the Working Group.

AGENDA ITEM 3: ADOPTION OF THE AGENDA

19. The Working Group adopted the draft agenda (document MM/LD/WG/9/1 Prov.3) without modification.
20. The Chair reminded the delegations that the report of the eighth session of the Working Group had been adopted electronically, and that the report for the present session would be similarly adopted.
21. Following a remark by the Delegation of Spain concerning the late delivery of the Working Group documentation in the Spanish language, Ms. Wang Binying, Deputy Director General, Brands and Designs Sector, offered the apologies of the International Bureau in this regard and explained that the delay had been due to the heavy workload of the Language Service of the International Bureau. She assured the delegations that every effort would be made in the future in order to avoid such delay.

AGENDA ITEM 4: INFORMATION CONCERNING CEASING OF EFFECT AND TRANSFORMATION

22. Discussions were based on document MM/LD/WG/9/3.
23. The document was introduced by the Secretariat. The Secretariat stated that, in order to place the discussion document in the appropriate context, reference should be made back to the eighth session of the Working Group. During that session, there had been discussion of the deletion of the requirement of a basic mark. Related to the requirement of a basic mark was the issue of the dependence of an international registration on the continued existence of the basic mark for the period of five years from the date of an international registration. This, in turn, was connected to the matter of so-called "central attack", whereby an action initiated by a third party against a basic mark may ultimately result in the cancellation, in whole or in part, of the international registration.
24. The Secretariat recalled that in the course of the discussions at the eighth session of the Working Group, it had become quite clear that, even though the International Bureau possessed data with regard to all requests for cancellation of international registrations following upon notifications of ceasing of effect, there was not any information, or any statistical data, with regard to how many of those had been the result of an attack, as such, upon the basic mark.
25. Thus, the delegations had agreed that further statistics were necessary with a view to establishing the actual incidence of central attack, as such. The Working Group concluded its eighth session with a request that the Secretariat prepare a document compiling information with regard to ceasing of effect and transformation. The Working Group had decided that the exercise of collecting this information would run for a period of six months, from July to December 2010, and that the furnishing of the information by Offices would be on a voluntary basis.
26. The Secretariat further recalled that the Working Group had determined that the document in question would not seek to analyze or comment upon its content and that it would be for the delegations to therefore draw their own conclusions from the information made available in the document.
27. Following the issuing of a Circular by the International Bureau, the Secretariat noted that the Offices of 24 Contracting Parties had confirmed their willingness to participate in the information-gathering exercise. Those Offices were Offices of origin in 65 per cent of the

total number of international applications received by the International Bureau in 2010. They were also the subject of 45 per cent of all designations recorded in 2010. Finally, those Offices constituted 90 per cent of all of the notifications of ceasing of effect recorded by the International Bureau in the same year.

28. The Secretariat recalled that the purpose of the exercise was the establishment, as far as possible, of the underlying cause of the notification, by an Office, of a ceasing of effect and, where such ceasing of effect had been the result of an attack, as such, that that should be explicitly noted.

29. During the period of the exercise, a total of 1,240 notifications of ceasing of effect were sent to the International Bureau by the Offices participating in the exercise. Of this number, the Offices reported that 215 notifications of ceasing of effect appeared to have resulted from central attack. Of those, 60 per cent were partial only. In the same time period, those Offices had been Offices of origin for more than 14,000 international applications. In the same time period, the Offices reported 96 incidents of transformation. The Secretariat recalled that the relevant information was annexed as a supplement to the discussion document.

30. The Representative of MARQUES referred to the position paper that it had provided for circulation. The Representative referred also to the Norwegian proposal, which had been the subject of discussion during the eighth session of the Working Group and said that MARQUES had carefully studied and fully supported the propositions set out in the Norwegian proposal.

31. The Representative of MARQUES stated that the advantages and disadvantages of the deletion of the basic mark requirement had been carefully weighed and the advantages outweighed the disadvantages. While the Madrid system continued to work well with the current basic mark requirement, if that requirement were to be deleted, the effect of international applicants first resorting to their national Offices would not be impaired, because of the facility of availing of the Paris Convention for the Protection of Industrial Property (hereinafter referred to as "the Paris Convention") priority of their national filings. Thus, the Representative said, MARQUES would favor the further discussion of the Norwegian proposal. The Representative said that the abolition of the basic mark requirement would highly benefit international applicants and users of the system and that none of the suggested disadvantages had been demonstrable, or provable, as such. Furthermore, MARQUES would not see the need to find a replacement for the central attack procedure by any measure with similar effect.

32. The Delegation of the Republic of Korea said that it supported the abolition of the basic mark requirement. A trademark needed to be protected more independently in each country than a patent or a design. In order to reflect this, the Paris Convention adopted the principle that a trademark should be protected independently in each country. However, the Delegation said that the current Madrid system did not fully reflect this principle. The Delegation noted that most cases of central attack occurred in countries where substantial examination was carried out by Offices, such as Australia, Japan, the Republic of Korea, and the United States of America. According to the data provided to the International Bureau, only 215 cases of ceasing of effect appeared to have resulted from central attack, as such, in the second half of 2010.

33. The Delegation of the Republic of Korea went on to say that if the Madrid system no longer required a basic mark, more applicants would have easier access to the system. The Delegation, making reference to interviews conducted by the Korean Intellectual Property Office (KIPO), said that the concerns of most Korean users regarding uncertainty stemmed from the basic mark requirement. Referring to the Korean company Samsung, the Delegation said that this company had filed 600 applications using the Paris Convention route in 2010, and had filed only two international filings using the Madrid system. According to the information obtained by the Office, one of the main reasons for this imbalance was the possibility of central attack.

34. The Delegation of the Republic of Korea therefore expressed its belief in the desirability of the removal of the basic mark requirement and the redesign of the Madrid system.

35. The Delegation of Norway stated that it was pleased to see that so many Contracting Parties had participated in the information-gathering exercise and thanked the Secretariat for compiling the responses. The Delegation said that the information obtained would be of substantial use for the future deliberations on the issues in question.

36. The Delegation of Norway, referring to the results of the exercise, stated, by way of clarification, that its data had been from April 1, 2010, and not from June 1, 2010. In this period, there had been 21 cases of ceasing of effect, 11 of which had been total and 10 partial. The number of filings from its Office, as Office of origin, was around 300 per year. In Norway, *ex officio* examination on relative grounds was conducted.

37. The Delegation of Norway said that it had studied each of the cases of ceasing of effect in detail. Regarding the cases of total ceasing of effect, in six the applicant failed to respond to an Office action, in two there was no power of attorney and in four the holder cancelled the mark after registration. Of the four cancelled by the holder, in only one was an opposition filed (post-registration opposition). Regarding the cases of partial ceasing of effect, half were due to incorrect classification and two were due to a restriction of the indication of goods and services in accordance with a letter of consent obtained in response to an Office action issued during *ex officio* examination.

38. Thus, the Delegation said that, in its opinion, it could draw the conclusion that with respect to its Office experience, cases of ceasing of effect resulting from central attack were very rare and that, in fact, central attack was hardly used. Furthermore, the Delegation noted that there were a lot of issues regarding formalities and the basic mark which, because of the dependency requirement, could result in huge costs for the holder of the international registration, resulting in the need to request transformation in several countries and perhaps the need to appoint local agents in those countries.

39. With regard to what had been said by the Representative of MARQUES, the Delegation of Norway said that it might wish to revert to the issue when it had studied the paper that had been circulated.

40. The Delegation of Australia said that it wished to thank the Offices of those Contracting Parties which had agreed to participate in the survey, and to thank the Secretariat for compiling the data. The Delegation expressed its regret that it was not in a position to offer to the Working Group such in-depth and interesting information as had been proffered by the Delegation of Norway. The Delegation of Australia said that the information that had been compiled was extremely interesting. The Delegation expressed its concern regarding the data contained in the document since some of the figures furnished by some Offices may not have been entirely precise, in terms of the issue of central attack, as such.

41. The Delegation of Australia noted that 17 per cent of the notifications of ceasing of effect during the period of the exercise appeared to have resulted from central attack. The Delegation said that this figure might be somewhat misleading as there was significant variation between reported results, which warranted further investigation.

42. From its preliminary perusal of the data, the Delegation of Australia said once the outliers had been removed from the sample, the percentage of central attack was reduced to 16 per cent. The Delegation made reference to the figures for the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) and the Office of Germany, with a percentage of occurrences of central attack of 70 and 26 per cent, respectively, when compared with other large users of the Madrid system, such as the United States of America, at three per cent. The Delegation stated that it could be of interest to explore why there had been a high incidence of central attack in the Office of certain Contracting Parties and that the thoughts of others on that issue would be welcomed.

43. The Delegation of Australia noted that removing OHIM and Germany from the sample selection would reduce the percentage of central attack to just four per cent. The Delegation said that the further analysis that it had carried out indicated that the incidence of ceasing of effect as a result of central attack was minimal. However, care needed to be taken, given the limited sample selection.

44. The Delegation made reference also to the issue of requests for transformation. It noted that the Office of Germany had not reported any incidence of such a request being recorded in the context of 220 notifications of ceasing of effect and OHIM had recorded just 11 incidences of transformation out of 165 notifications of ceasing of effect. Japan, on the other hand, had recorded 15 transformations from 18 notifications and Australia had recorded nine from 25 notifications, being a 36 per cent transformation rate.

45. The Delegation of Australia said that it would be interesting to explore the reasons why transformation was not being more widely availed of as a strategy for overcoming central attack in the two jurisdictions with the highest recorded rates.

46. The Delegation of Japan noted that the Working Group document had indicated that most of the notifications of ceasing of effect had not been the result of a third-party intervention and that the number of requests for transformation had been slight. On the other hand, the Delegation said, the mechanism of central attack had been in use. The Delegation also underlined the concerns of some Japanese users regarding their rights in designated Contracting Parties and the risk of loss of rights as a result of central attack.

47. On the other hand, the Delegation recalled the merit of a single procedure whereby the rights in all of the designated Contracting Parties might be cancelled, particularly in a case where an international registration should not have been recorded in the first place. For that reason, the Delegation expressed the need to progress the discussion with care, including taking account of a possible alternative to the present procedure of central attack.

48. At the request of the Representative of INTA, the Secretariat provided clarification of the figures in Table 1 of the discussion document. The Secretariat stated that the number of international applications did not have any correlation to the number of notifications of ceasing of effect. That number was indicated merely for the purpose of illustrating the context in which the relevant Offices of origin operated. In the time period concerned, the Offices in question had notified a given number of ceasing of effect and in the same time those Offices had been Office of origin for a given number of international applications. In order to have a more complete picture of the correlation between international registrations and the number of ceasing of effect, the Secretariat suggested that reference be made to the Annex of the document and in particular to have regard to Table 2 and the tables following.

49. The Secretariat also noted that the number of requests for transformation had no correlation with the notifications of ceasing of effect indicated in the data. It was merely an indication of the number of requests for transformation as communicated by the Offices to the International Bureau in respect of the same time period. It would have been necessary to revert to the year 2005, in order to obtain more comprehensive information relating to numbers of international registrations, numbers of notifications of ceasing of effect and numbers of requests for transformation.

50. The Delegation of China noted that the advantages of the Madrid mechanisms could be misused by users in bad faith. The examining Offices would not then be in a position automatically to refuse such requests for registration. In addition, the Office might forward the application directly to the International Bureau without the Office being aware that such had been the case. This could lead to a system that was unfair *vis a vis* applicants who filed in good faith. If third parties wished to contest rights thus acquired, they would have to go through legal services and lawyers and that would mean cost implications for those holders who had acted in good faith. The Delegation stated that the mechanism of central attack could be very difficult to apply in the case of technical marks, because the International Bureau cannot, itself, initiate a central attack.

51. The Chair suggested at that point that the discussions thus far appeared to be reverting in nature to the discussions that had already taken place during the course of the eighth session of the Working Group, including, in particular, the issue of the possible abolition of the requirement of a basic mark. The Chair noted that the current discussion document was not particularly concerned with the requirement of a basic mark, but rather with the issues of ceasing of effect and transformation and, of course, the mechanism of central attack. Noting the evident relation between the requirement of a basic mark and the issues of ceasing of effect, transformation and central attack, the Chair suggested nevertheless that the discussions might focus more on those latter issues, while not entirely ruling out the possibility that there may also be discussion of the basic mark requirement.

52. The Delegation of the Russian Federation stated that it wished to underline that the Madrid system continued to work very well and that this was an important plus-factor for the users of the system. In that context, any possible changes to the system should be viewed from that perspective. With regard to the discussion document, the Delegation said that the mechanism of central attack was a procedure that was very rarely used and that the users of the system did not appear to have much interest in the mechanism. At the same time, it also demonstrated that the risks for the holders of international registrations were not as high as it might have been suggested. Given this, the Delegation said that there was a balance of interests between the users of the system. However, discussions could nevertheless proceed, and in particular, the Delegation said that it could be of interest to consider the time limitations provided for in the system and, in particular, the time period in the context of dependency.

53. The Delegation of Norway said that in light of the discussions on the Norwegian proposal in previous sessions of the Working Group, where dependency had been one of the key issues, it wished to share with the Delegations one of the initiatives that its Office had taken since the previous meeting of the Working Group.

54. In light of the comments of a majority of the delegations, in particular in the context of the Norwegian proposal relating to the abolition of the requirement of a basic mark, the Delegation said that it might be preferable at this stage to focus upon and explore further the issue of dependency – independently of the issue of the basic mark requirement. Thus, the Norwegian Office had decided to seek feedback from stakeholders and industry with respect to the issue of dependency. The Delegation noted that the Office had also posted the letter in question on the Madrid Electronic Forum (the Madrid Legal Forum), earlier in the year, and that that letter was available on the Forum in English.

55. The Delegation of Norway stated that, in this initiative, the Office had focused on the main purpose of finding ways of reducing rights holders' risks of loss of rights and consequential costs in the countries covered by the international registration. One of the major arguments for taking a renewed look at the dependency issue was, in the opinion of the Delegation, the introduction in 1934 of Article 6(3) in the Paris Convention. That article provides that a trademark duly registered in one country of the Paris Union shall be regarded as independent of marks registered in the other countries of the Union, including the country of origin.

56. The Delegation of Norway noted that the Office had received very limited response to the letter posted on the Electronic Forum. On the other hand, the Delegation stated that central attack did not appear to be a tool that was very actively used in Norway, as evidenced from the statistics that the Office had compiled. At the same time, the results from the exercise by the participating Offices (document MM/LD/WG/9/3), showed, in the view of the Delegation of Norway, a very representative picture of the factual situation and shed some interesting light on the discussion.

57. The Delegation referred to a point made earlier by the Secretariat, namely, that the participating Offices in the exercise had sent 90 per cent of the notifications of ceasing of effect recorded by the International Bureau in 2010. Of the 1,240 notifications of ceasing of effect, only 215 seemed to have resulted from central attack. There had been 96 requests for transformation.

58. The Delegation of Norway stated that this illustrated that neither central attack nor transformation seemed to be mechanisms that were greatly utilized in the Madrid system. In the spirit of trying to streamline the system and to make the system more attractive to users, the Delegation said that it wished to suggest that, at a future session, the Working Group could consider freezing the provisions in the Madrid legal framework that deal with dependency. The Delegation said that such an option of freezing did have precedent in other WIPO-administered treaties, such as in the Hague System for the International Registration of Industrial Designs and, in the context of the Madrid system, the cessation of application of Article 9*bis*(1) of the Madrid Agreement.

59. The Delegation of Norway stated that the option of freezing of dependency could reduce the vulnerability of the basic mark and, at the same time, the requirement of a basic mark would remain in full force. The Delegation said that it wished to propose that the Secretariat prepare a document which would analyze more in detail how dependency could be frozen. In its view, the Delegation said that this could be a way forward in making the system evolve towards a truly global system, serving the needs of users and trade.

60. The Delegation of Cuba stated its concern that the Working Group documents had been made available initially only in English, which had made it difficult to make a detailed analysis of the documents. The Delegation said that it wished to stress that the documents should also be made available in Spanish so as to give to the Office sufficient time to read them thoroughly. It said that it therefore reserved the right to come back to the documents at future sessions of the Working Group and that the discussions should remain open for future comments to be added.

61. Regarding the document under discussion, the Delegation of Cuba said that it also believed that the Madrid system was in very robust health and that it has been possible to strengthen it by means of a number of decisions which would ensure that users were comfortable in using the system. Looking at the document under discussion, and the analysis and statistics contained in it, the Delegation said that it could be concluded that there was not a very common resort to the procedure of transformation, so the risk of a loss of protection for the holders through a ceasing of effect of the basic application or the basic registration would

not appear to be very high. For that reason, the Delegation said that it believed that the freezing of the dependency provision should be thought about very carefully and additional analysis should be conducted until there was a real conviction that the core pillars of the system, which had been developed and defended for so long, would not be weakened.

62. The Delegation of Austria, commenting upon the results of the survey, said that over the six-month period in question, its Office had had 43 notifications of ceasing of effect. Four of those not only appeared to have resulted from central attack, but were definitely followed by central attack procedures. Furthermore, the Delegation stated that it strongly believed that some more cases of central attack had taken place beyond the remaining 39 cases of ceasing of effect, at a preliminary stage, which had not been considered by the Austrian Office.

63. Regarding the body of statistics in general, the Delegation of Austria said that it wished to underline two points, namely, that 215 cases of central attack amounted to 17 per cent of all cases of ceasing of effect. This could not be seen as a negligible percentage. Secondly, in referring to "only 215 cases", it should be kept in mind that it was the result from the period of just six months and that furthermore, not all Contracting Parties had participated. The Delegation said that it assumed that what was being discussed was about 500 cases per year and that this led to the conclusion that applicants were using the mechanism of central attack.

64. The Delegation of Germany spoke of its concern to have the Working Group documents well in advance of the meetings, and noted that it had already requested that the documents be made available two months in advance.

65. On the issue under discussion, the Delegation of Germany referred to the questions that had been raised by the Delegation of Australia and said that, while it was not in a position to give entirely complete answers, it was apparent from their meetings with users that there was support for the mechanism of central attack. It was used by at least 26 per cent of its users, and perhaps even more, as had been pointed out by the Delegation of Austria, in the context of possible hidden central attacks, where it was not possible in some cases to know for certain the precise source of a ceasing of effect.

66. The Delegation of Germany, stating that it fully supported what had been said by the Delegation of Austria, went on to say that it did not know precisely why its percentage was so high and that it might be because the Office had a post-registration opposition system. With regard to transformation, the Delegation said that its Office had, on average, three requests per year, which was not a very high number. The Delegation also referred to the possible impact of the recent modification of Article 9*sexies* in terms of the transformation numbers.

67. The Delegation of Australia expressed its thanks to the Delegation of Germany and said that the discussion document contained some very interesting information. Regarding the interventions of the Delegations of Cuba and Norway with respect to the suggested freezing of the dependency provision, the Delegation of Australia said that it wished to thank the Delegation of Norway for its interesting proposal, and Cuba for its subsequent comments. The Delegation said that a document prepared by the Secretariat on the impact and consequences of the freezing of the dependency provision would provide a lot of interesting and useful information for the Working Group and it would therefore be supportive of such initiative and of hearing others' views on the issue.

68. The Delegation of the Republic of Korea said that, from its enquiries, it was clear that the non-use of the Madrid system by its users was connected with a concern on the part of its users with the issue of ceasing of effect and central attack. Even if the statistical data indicated that the number of ceasing of effect resulting from central attack was negligible, there could be a large number of potential central attack cases. The Delegation stated that it wished to endorse what had been proposed by the Delegation of Norway.

69. The Delegation of the United States of America said that, in the context of the original discussion arising from the proposal by the Delegation of Norway regarding the abolition of the basic mark requirement, its Office had reached out to its stakeholders and asked whether the benefits of eliminating the basic mark requirement would be enough to outweigh the loss of the central attack feature of the Madrid system. The answers had been mixed. The Delegation said that it did not therefore wish to extrapolate from those results and say categorically that central attack was not useful or necessary. But certainly, data compiled by the Secretariat would suggest that central attack might not be used as much as one might have thought.

70. In the context of the United States of America's national use of the system, the Delegation said that in 2010 only about 3,800 international applications had been filed through the United States Patent and Trademark Office (USPTO) as Office of origin. From that, the Office was looking to see how it could increase use of the system and, talking to its stakeholders, it emerged that one of the main reasons cited for low use of the system was the USPTO's specific goods and services identification practice, along with dependency. From that perspective, many United States nationals filed directly into other Offices, so as to get the broadest specification of goods and services possible. Within that context, the Delegation said that it was very interested in the idea of exploring whether dependency could be frozen, while not being ready to move to a wholesale elimination of the basic mark requirement, because their user-response had been mixed in this regard. The proposal appeared to be perhaps an acceptable compromise between maintaining the *status quo* and eliminating the basic mark requirement.

71. The Delegation of the United States of America said that it wondered also whether this idea might help other delegations address constraints of the Madrid system specific to their own situations. The Delegation said that it had the potential to seriously diminish the work of national Offices in dealing with notifications of ceasing of effect or limitations issued by the Office of origin to the International Bureau. If there were no dependency, changes to the basic mark would not require the issuing of a notification of ceasing of effect. With that in mind, the Delegation said that it wished to request the International Bureau to conduct further research, as had been proposed by the Delegation of Norway.

72. The Delegation of the Czech Republic expressed its support for the proposal by the Delegation of Norway, as endorsed by other delegations.

73. The Delegation of Zambia said that it agreed with what had been stated by the Delegation of the United States of America and that its Office had had experience of a large multinational company, filing directly through its Office, in order to avoid the implications of the issue of central attack and possibly the limitation of the specification of goods and services. Thus, there was need to give consideration to the proposal regarding the freezing of the dependency provision, keeping in mind that as we tried to simplify the system, we did not at the same time introduce other complications.

74. The Delegation of the Russian Federation stated that it wished it to be noted that it had not seen the letter referred to by the Delegation of Norway on the Electronic Forum, but having heard of the contrast between the dependency period of five years and what was at the same time provided for in the Paris Convention, the Delegation said that it would like to have clarification as to why this would be considered to be a contradictory situation, and questioned where such distinction lay. It seemed that Article 6(3) of the Paris Convention related to the independence of the registration in countries party to the Paris Union, including the country of origin. The Madrid system, on the other hand, involved a single registration, in which the designated Contracting Parties may grant protection to the use of the mark. Instead, Article 6(3) concerned marks registered through national procedures, in a number of countries. The Delegation suggested that a copy of the letter referred to by the Delegation of Norway be distributed to all the delegations.

75. The Chair confirmed that the letter referred to would be made available to the delegations.

76. The Delegation of Norway expressed its thanks to those delegations which had supported its proposal regarding the freezing of the dependency provision. Referring to the intervention which had been made by the Delegation of the Russian Federation, the Delegation sought to clarify its earlier intervention to the effect that it had mentioned a letter that its Office had sent to its stakeholders in Norway concerning the issue of ceasing of effect. In that letter, reference had been made to the Paris Convention. A copy of that letter would be made available to the delegations.

77. The Delegation of Turkey explained the procedure in its Office regarding ceasing of effect. Most of the international applications from Turkish users were based on a national application. Ceasing of effect in Turkey did not primarily result from central attack, as the national applications in question were refused *ex officio*. The Delegation said that the Norwegian proposal merited further exploration.

78. The Delegation of Spain said that it wished to be associated with what had been said by the Delegations of Austria and Germany. It believed that the dependency provision was a very important legal institution.

79. The Delegation of China said that the proposal of the Delegation of Norway was a very constructive proposal and that it should be considered in some depth.

80. The Delegation of Ukraine said that it wished to support the proposal of Norway.

81. The Representative of AROPI said that, on behalf of users, it wished to support what had been said by the Delegation of Spain, to the effect that the possibility of central attack was one of the major advantages of the Madrid system, and to draw to the attention of the delegations the importance of that provision and what it made possible for users. The Representative said that he would have some problems with regard to the freezing proposal.

82. The Delegation of Morocco said that its Office had not had any cases of central attack. The results of the survey showed that the use of central attack was very small, which supported its view as expressed at the last session of the Working Group, to the effect that it was in favor of the retention of the basic mark requirement.

83. The Delegation of Denmark said that it wished to add its voice to what had been stated by the Delegations of Austria, Germany and Spain and also by the Representative of AROPI. The mechanism of central attack was an important mechanism. The Delegation said that it had not conducted any formal consultations in this regard, but it was their understanding that its users found this mechanism to be very useful and thus the importance of its retention. The Delegation said that the proposal to freeze the dependency provision should therefore be considered with great care and being mindful of the good which the mechanism of central attack served for users of the system.

84. The Delegation of France said that it wished to express its support for what had been stated by the Delegations of Austria, Denmark, Germany and Spain, and the Representative of AROPI. The Delegation said that it had not had the opportunity to consult with its users, but that the mechanism of central attack was important for its users and it would like to have more time before a definitive decision was taken on this issue.

85. The Delegation of India, as an observer State, informed the Working Group that the necessary legislation had been passed in India for the purpose of acceding to the Madrid Protocol. The Delegation said that it believed that the requirement of a basic mark was an essential element of the Madrid system. The Delegation asked whether the abolition of such a requirement would not be going beyond the fundamental concepts of the system.

86. The Delegation of Italy stated that most of the international applications in its country were submitted by representatives. For its users, the mechanism of central attack was considered to be very important. Therefore, the Delegation supported the positions of the Delegations of Austria, Denmark, Germany and Spain, and the Representative of AROPI.

87. The Chair noted that there had been support expressed thus far for the proposal of Norway regarding the freezing of the dependency provision, including the Delegations of Australia, China, Czech Republic, Morocco, Republic of Korea, Turkey, Ukraine, United States of America and Zambia. Counter-arguments had been submitted by the Delegations of Austria, Denmark, France, Germany, Italy and Spain, and by the Representative of AROPI.

88. The Secretariat recalled that the information-gathering exercise had lasted only for six months and involved only 24 Offices. Those Offices represented 90 per cent of all ceasing of effect notified to the International Bureau in 2010. While the period of the exercise had been limited, the Secretariat suggested that the statistics illustrated a clear trend. Of the 1,240 ceasing of effect, 215 appeared to have resulted from central attack. Of those, 64 had been total ceasing of effect and the remainder had been partial.

89. As some delegations had pointed out, the Secretariat stated that 17 per cent of all ceasing of effect appeared to be connected to central attack. It also implied that, conversely, 83 per cent did not appear to have any connection with central attack.

90. The Secretariat, referred to the fact that the large numbers of ceasing of effect were coming from the Offices that were the greatest filers of international applications, which would suggest that the users in those countries were not afraid of the central attack mechanism. On the other hand, there was evidence from other countries that if it were not for the central attack mechanism, its stakeholders would use the system more. The Secretariat made reference to countries in the Asian region which were constrained by the difficulties encountered because of the need to file marks in Latin characters and the risks for their users caused by the need to file the basic mark in the same script, despite the subsequent non-use of that mark in the home country and the possibility of cancellation or revocation for non-use.

91. The Secretariat enquired as to whether the delegations might be disposed to furnish to the International Bureau additional information on ceasing of effect, reverting to all ceasing of effect and seeking to establish what had been the underlying cause of those ceasing of effect, within a new time period. The provision of such additional information would assist the Working Group in its future discussions. At the same time, the International Bureau could undertake a study on the possible impact and consequences of a freezing of the dependency provision, without pre-empting the further discussions on central attack.

92. The Delegation of Australia said that it was of the view that the conducting of such a study would provide the Working Group with some very useful information. The Delegation said that the fundamental issue was that most of the central attack advantages, as expressed by users certainly in Australia, related to the *possibility* of central attack, rather than the actuality of it. It was concerned that, while it did not, in principle, disagree with the collection of further information, any such further information would not ultimately serve to throw any light on what it had just indicated as the fundamental issue. The Delegation of Australia said that it believed that the study that had been proposed by the Delegation of Norway would be of more value to the delegations in considering the issue of dependency.

93. The Delegation of Cuba referred to the summary just made by the Chair and said that some delegations had made reference to ambiguous data in the discussion document, whereas others had suggested that the figures did not quite add up, and those comments should also be taken into consideration. The Delegation said that there was therefore a need to look for additional information, rather than trying to draw conclusions on the basis of the information

now available. With regard to the concerns that had been expressed regarding the freezing of the dependency provision, the Delegation said that it believed that it had been one of the first to take the floor to raise such concern after the Norwegian proposal had been aired.

94. The Delegation referred to paragraph 17 of the discussion document, where reference was made to the Working Group being asked to consider all of the information that had been made available, and stated that what was being sought was guidance from the Secretariat about what type of steps should be taken in the future. While there was quite a lot of data and information available, the Delegation suggested that the data was not yet sufficiently clear and that the Working Group needed to go further in that regard.

95. The Delegation of Cuba therefore concluded that there did not appear to be enough information available at this time so as to enable the Working Group to take a decision, and suggested that discussion of agenda item 4 might be postponed so as to facilitate the collection of more thorough data.

96. The Chair noted that it appeared that there was a need for further research and exploration of the issue under discussion.

97. The Secretariat noted that for the recent information-gathering exercise, the data had been provided by Offices on a voluntary basis. At the same time, it was clear that the International Bureau would not draw any conclusions when preparing the discussion document, nor provide any analysis, as the Working Group wished to draw its own conclusions. That was what the present discussion was therefore concerned with.

98. The Secretariat recalled that a number of delegations had expressed the wish to have additional information on the numbers of cases of central attack. This would continue to be voluntary, on the part of Offices. However, it was suggested by the Secretariat that amendments might be made to the existing model form for the notification of ceasing of effect, for example, by providing a box that Offices might tick, if the ceasing of effect in question involved any aspect of central attack. This would simplify for Offices the reporting of the information to the International Bureau. The Secretariat noted that the information thus obtained could then be made available to the Working Group at its next session. The information obtained could also be attached to a study document, if the Working Group decided to follow that route. The Working Group would, once again, need to decide whether the information was to be merely compiled, or to be compiled and analyzed.

99. The Delegation of Germany requested clarification with regard to the question of a study and said that it thought it was premature to conduct such a study regarding the freezing issue, pending the gathering of further information on central attack, and noted that this also had been the view expressed by several other delegations, as well as the Representative of AROPI. The Delegation also noted that not all Offices were using the model form referred to by the Secretariat and that a certain period should be established in which the information should be provided by Offices. The Delegation referred, in particular, to the possibility that the statistics presented to the Working Group may not have disclosed cases of hidden or undisclosed central attack.

100. The Representative of AROPI, adding to what he had said earlier and following on what had been stated by the Delegations of Australia and Germany, said that the mechanism of central attack was of great interest to users, not just in terms of the particular mechanism itself, but in the fact that users were *able* to have recourse to it. The Representative said that he wished to draw attention to the fact that a study on central attack should also take into account this aspect. That is to say, the existence of the mechanism, *per se*, being just as important for users as implementation of the actual mechanism itself.

101. The Delegation of the Russian Federation said that it had certain sympathy for the proposals made by the Delegation of Germany. The Delegation said that what had been said by the Delegation of Germany was a wise suggestion at this time. It was vital to collect data before conducting a study on freezing. The Delegation also spoke of the necessity for additional clarity on what did, or did not, constitute central attack, and gave an example in illustration of this. The Delegation expressed the importance of proceeding with caution.

102. The Delegation of China said that, according to its experience, for some users central attack may be seen as a highly desirable feature of the Madrid system, and for others it may be seen as a highly undesirable one. If it was proposed to make a change to the procedure of central attack, there should be enough data to support any such change and progress should be made patiently. Other options might exist.

103. The Delegation of Norway said that it believed that the proposal made by the Secretariat was a useful proposal and, like China, it agreed that there was always the issue of the usefulness of the mechanism of central attack, as opposed to the tool as a hindrance. If it were decided to proceed with the collection of further data, there should also be given consideration to focusing on how the mechanism of central attack might be stopping users from using the Madrid system.

104. The Delegation of Norway said that it wished to clarify its earlier proposal relating to the freezing of the dependency provision. It was not intended to be a proposal to be decided upon at the current session of the Working Group, but rather to be an issue for discussion at some future session of the Working Group. Nevertheless, the Delegation suggested that the Secretariat may be in a position, meanwhile, to examine what might be the possible implications of such a freezing and said that this would be a constructive way forward in that it would enlighten the discussions of the Working Group in the future.

105. The Chair noted that there appeared to be almost a consensus among the delegations that there was a need to collect further information and data so as to provide clarity for further discussions.

106. The Delegation of Tajikistan, supported by the Delegation of the Republic of Korea, stated that it wished to support the proposal regarding the need for additional studies.

107. The Representative of MARQUES, referring to its earlier intervention, stated that there had been expressed by the delegations the need for caution and said that he would appreciate the proposed intermediate step in looking more carefully at the possible freezing of the dependency provision.

108. The Representative ECTA spoke of the importance of the central attack mechanism in the Madrid system. Nevertheless, there was merit in looking at the mechanism in greater depth and obtaining improved statistics. The Representative referred to the importance of the phrasing of questions when it came to central attack, if questionnaires were to be sent by Offices to their users. Meanwhile, at present, the system was well balanced and met the interests of both sides of the debate. The Representative made reference to the possibility of the dependency period being cut to three years, which might be of particular interest to Asian users, who currently encountered problems with having to file marks in Latin characters and may subsequently have difficulty arising from non-use of those marks in the country of origin.

109. The Delegation of Denmark, referring to what had been mentioned earlier by the Delegation of Germany concerning the hidden use of central attack and the difficulty for Offices to furnish information or data in that regard, asked how that type of use could be taken into account in the compilation of additional information.

110. The Delegation of Italy stated that it wished to underline that, for its Delegation, it was not a question of numbers of central attack, but rather the ease and utility of the mechanism, as had been noted by the Representative of ECTA.

111. The Chair stated that there had been many useful comments and that there appeared to be a consensus that more information was required regarding central attack and transformation if the discussions and the proposal of Norway concerning freezing of the dependency provision were to progress. Noting that 24 Offices had participated in the earlier exercise, the Chair invited as many Offices as possible to engage in the provision of additional information. It was concluded that some further study of the issue of central attack would be conducted by the International Bureau, and for the following session of the Working Group further data would be made available. Regarding the time period, the Chair said that he felt that a further period of six months would be sufficient, commencing from July 1, 2011.

112. The Delegation of Germany said that a time period commencing in the past would not be appropriate, and suggested, perhaps, August 1, 2011.

113. The Deputy Director General, Ms. Wang, noted the concern of the Delegation of Germany and said that it was clear that there was a consensus that the issue of central attack needed to be carefully studied and reviewed, as the matter was important in the context of the Madrid system and in light of the desire to introduce simplification and user-friendliness. Ms. Wang also noted that, in any event, the International Bureau would need to communicate in advance with Offices, and in that communication an indication could be made of the commencement date for the exercise. Ms. Wang suggested that a date towards the beginning of the fall period might be appropriate and acceptable to Offices.

114. The Delegation of Cuba said that it agreed with what had been stated by the Deputy Director General and recalled that it had earlier spoken of the need for further analysis so as to ensure that the correct information could be obtained, referring to the apparent incompleteness of the information obtained earlier. The Delegation said that if the circular to be sent out to Offices could indicate the type of information that was required in the new period, the new information would be quantitatively and qualitatively more reliable. Otherwise, the new data would not be any clearer than the data already obtained.

115. The Delegation of China questioned the utility of collecting further information and opinions from the users of the system.

116. Responding to a query raised by the Delegation of Portugal as to whether it would be advisable also to further analyze the implications of the requests for transformation under Article 9*quinquies*, the Chair confirmed that this would also form part of the study.

117. The Chair concluded the discussion of agenda item 4 by stating that there had been no consensus on the immediate need to undertake a study on the freezing of dependence, as proposed by the Delegation of Norway. On the other hand, there was agreement on the need to compile additional, more accurate information on ceasing of effect, and specifically on central attack and transformation. Finally, the Chair noted that the Working Group had agreed that Offices would furnish to the International Bureau additional, more accurate information on ceasing of effect and, specifically, on central attack and transformation. The International Bureau was requested to notify to Offices 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

118. Discussions were based on document MM/LD/WG/9/5 Rev.

119. The document was introduced by the Secretariat. The Secretariat outlined the historical development of Article 9sexies, which had been commonly referred to as “the safeguard clause”. The Secretariat referred then to new paragraph (2) of amended Article 9sexies, which provided that the Madrid Union Assembly should, after the expiry of three years from September 1, 2008, review the application of new paragraph (1)(b) of that Article and that the Assembly might, at any time thereafter, either repeal it or restrict its scope, by a three-fourths majority of those States which were party to both treaties.

120. The Secretariat stated that the discussion document contained information regarding the application of paragraph (1)(b) of Article 9sexies and, in particular, information with respect to the non-operation of declarations extending the time limit to notify a provisional refusal and declarations of individual fees.

121. The Secretariat noted that there were 55 States bound by both treaties. Of those, 14 had made a declaration extending the time limit for the notification of provisional refusal to 18 months, and seven of those had made the declaration extending the time limit beyond 18 months, in the case of the notification of provisional refusal based upon opposition.

122. Of the 55 States in question, 16 had made the declaration requiring payment of individual fees.

123. The Secretariat stated that the document contained, *inter alia*, tables indicating data relating to the number of cases in which those declarations had been rendered inoperative by the application of paragraph (1)(b) of Article 9sexies.

124. The Delegation of France stated that it wished to recall that the two exceptions introduced in paragraph (1)(b) had been discussed at length during the meetings concerned with the review of the safeguard clause and that those exceptions were very important for its users. The Delegation said that it wished to be noted that the system, as it stood, was working very well and it was important to ensure that the system remained attractive for users and, in particular, SMEs.

125. The Delegation said that if most Offices could examine applications and inform applicants of the results in a period of less than 12 months, as the document suggested, the principle of tacit acceptance still remained the rule. In the absence of paragraph (1)(b) of Article 9sexies, holders would have to wait until the period of 18 months had expired. In the view of the Delegation, abrogating the period to 12 months would be damaging for the users of the Madrid system and for the legal certainty of third parties. If the statement of grant of protection had been introduced in order to overcome the problems linked to the principle of tacit acceptance, it is only mandatory since January 1, 2011, and does not have any legal consequences. The Delegation said that it believed that there had not yet been enough time and experience to put an end to the exception of the extension of the refusal period.

126. The Delegation of France said that it was in favor of maintaining paragraph (1)(b) as it stood. Removing the exception regarding individual fees would be damaging for users as it would increase the fees quite substantially. French users were among the main users of the Madrid system and the Delegation said that those users were very much against the review of the provision on the issue of fees. In addition, the removal of that exception could give rise to

other consequences, in that States that have not made the individual fees declaration thus far could be tempted to do so. Abandoning the exception with respect to fees would be going against the commitment of WIPO to make the Madrid system more attractive to users and, in particular, for SMEs.

127. The Delegation of Italy stated that as it was one of the States that had made the declaration extending the refusal period, it wished to underline that, despite the making of that declaration, it was now in a position to operate within the period of 12 months. The Delegation said that its Office had never used the extended period of 18 months.

128. Regarding the fee regime, the Delegation of Italy noted that the change from the standard fee regime to individual fees would have quite a significant impact for users, as had been seen from the document. Therefore, there should be thorough consultations with users and their representatives before making a decision in this regard.

129. The Delegation of Switzerland said that it supported the comments made by the Delegations of France and Italy and, in particular, the remark made by the Delegation of Italy concerning the need to hold consultations and to conduct a more in-depth review of the issues. For these reasons, the Delegation believed that these issues should again be included in the agenda of the following session of the Working Group.

130. The Delegation of China stated that up to now everything had been working extremely well in the Madrid system, and the period for examination of trademarks had been one of the significant advantages of the system. Thus, the Delegation said that it did not think that anything needed to be changed and it therefore supported maintaining the provision as it stood.

131. The Delegation of the European Union, supported by the Delegation of Germany, stated that it, and its member States, were of the opinion that the current system was working fairly well and that this had been confirmed by the review of paragraph 1(b) of Article 9*sexies*, carried out by the International Bureau. The amendments last introduced into this Article had stood the test of time and the Delegation said that it was therefore of the view that there was not any need to take further action at this time.

132. The Delegation of the United States of America said that when the review of the safeguard clause had been initiated, it had been looking forward to seeing how the system could be simplified, leaving the old and moving to the new. The Delegation said that it sensed a holding on to the old. There had been a suggestion that this document be maintained for further discussion in the future. Another suggestion might be to have a new review period. The Delegation said that it was reluctant to have a situation arise where it might be seen that the discussion on the review of the paragraph in question had come to a conclusion. The Delegation said that it supported the suggestion of looking at the provision again at the next session of the Working Group, or at least set a new formal review period, so as to try to keep moving forward.

133. The Delegation of Spain said that Spain had always supported the total repeal of the safeguard clause and that that was the position it continued to hold.

134. On a point of information, Ms. Wang, noted that during the forthcoming Assemblies, all of the committees of the Unions would have a reporting session. For this reason, the Secretariat was required to prepare a report to the General Assembly based upon the outcome of the Working Group meeting and any recommendation it might make. In addition, Ms. Wang recalled that one State was still not a party to the Madrid Protocol. However, it was hoped that this State would soon accede to the Protocol. That would then provide a useful opportunity to fully discuss all the issues raised in the present context.

135. 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 9*sexies*. The Working Group therefore agreed to recommend that the Madrid Union Assembly neither repeal nor restrict the scope of paragraph (1)(b) of Article 9*sexies* at this time. The Working Group also decided that the review of the application of paragraph (1)(b) of Article 9*sexies* should again be included in the agenda of the following session of the Working Group.

AGENDA ITEM 7: LEGAL DEVELOPMENT OF THE MADRID SYSTEM. DIVISION OF THE INTERNATIONAL REGISTRATION

136. Discussions were based on document MM/LD/WG/9/2.

137. The document was introduced by the Secretariat. The Secretariat noted that this issue had first been raised during the fifth session of the Working Group, when the Representative of AROPI made reference to an informal paper which had been made available to the delegations. At the seventh session, the Delegation of Switzerland proposed in a paper that the suggestion by AROPI be included in the agenda of that session.

138. The Working Group then agreed that a study be conducted by the International Bureau in order to ascertain the impact and consequences of the possible introduction of a procedure that would permit the division of international registrations. The study should also examine the practices of Contracting Parties in that regard.

139. In September 2010, a questionnaire was sent to the Offices of all members of the Madrid Union. The findings derived from the responses to the questionnaire were presented and analyzed in the discussion document. The International Bureau had also presented in the document other possible options that might serve the needs of the users of the Madrid system, apart from the introduction of a formal structure for the division of international registrations.

140. The Delegation of Switzerland said that when it had proposed the discussion of this issue by the Working Group, it had been concerned by problems raised by users of the system, through AROPI, at the fifth session of the Working Group, and the views of several delegations and representatives who had expressed interest in pursuing the discussions. Having considered the document prepared by the Secretariat, the Delegation said that it noted that the alternative solutions proposed by the International Bureau, including an intermediary statement of partial grant of protection, would not enable the resolution of all of the problems referred to by users.

141. The Delegation said that in the present session of the Working Group it would like to have taken into account the point that there should not be created an additional burden for the Secretariat. Such burden would not be justified, in particular, by the needs of users and, in any case, it should remain within reasonable limits compared to those needs. Having studied the document and discussed the issues with other delegations and users, the Delegation of Switzerland said that the proposal intended to introduce a provision for division of international registrations remained in that framework.

142. The Delegation said that it wished to point out that the type of division referred to at the current session and mentioned in its submission to the seventh session of the Working Group concerned the division of the designation, and not the basic mark. In its view, that limited the scope and the effects of the division to the designated Contracting Party concerned. The Delegation also underlined that the number of cases of division remained limited. However, some problems remained in the absence of division of the designation, in particular, the fact that, under the legal framework of the Madrid system, it is not possible to obtain a statement confirming the protection of the trademark for the non-controversial goods and services.

143. Additionally, the Delegation of Switzerland stated that, given the information provided by the International Bureau, in particular, the issue relating to the examination of the lists of goods and services, an option would be to allow the filing of the request for division before the Office of the designated Contracting Party in which such division would take effect. This Office would be more sensitive to the reason prompting the filing of the request for division. Said Office would examine the request and, in particular, the list of goods and services, and transmit the request to the International Bureau for its inscription. The Delegation, echoing the opinion of some of the Swiss users, remained open and interested in pursuing the discussions to find new ideas regarding this issue which could be presented and discussed during the following session of the Working Group.

144. The Representative of AROPI said that it wished to thank all those Offices that had participated in the consultations leading to the preparation of the document. The Representative also expressed its thanks to the Delegation of Switzerland for having specified the very particular nature of the entire issue of division.

145. The Representative said that it regretted that since the number of divisions was very limited, as had been shown by the responses to the questionnaire, there appeared to be a conclusion that this reflected a lack of interest in the issue, in general. The Representative said that this might not be an appropriate conclusion and that the existence of a limited number of division requests did not have any bearing upon the importance of the mechanism of division itself, for users.

146. The Representative of AROPI said that it was aware of the possibility that the introduction of a procedure for division could lead to extra work for the International Bureau, as had been mentioned in the discussion document. However, the details of this additional work are not very well explained in the document. The Representative emphasized that any of the alternatives suggested would not allow to really solve the problem. In particular, if Offices had to record divisions concerning their designation, this option would not be possible in Contracting Parties which did not maintain, for instance, a distinct register for international marks. For this reason, the Representative believed that the intervention of the International Bureau would always be required, since the International Bureau is responsible for the International Register. However, the Representative indicated that it may be possible to find alternatives or other options which would guarantee a comparable result. The Representative added that AROPI, as Switzerland, remained open to consider other options. In addition, the Representative said that AROPI would welcome any proposal in this sense from the International Bureau.

147. The Representative of INTA expressed to the Delegation of Switzerland her thanks for having taken on board the suggestion of AROPI. The Representative also expressed her thanks to the member States that had taken part in the survey.

148. The Representative of INTA said that the results of the survey made it clear that a large majority of the members of the Madrid Union did provide, or as parties to the Trademark Law Treaty (TLT) or the Singapore Treaty on the Law of Trademarks, were expected to provide, for the possibility of division of applications for trademark registration filed directly with the Office, and in certain cases, also for registrations. The results of the survey made it equally clear that, except for a few jurisdictions, such possibility was made little use of.

149. The Representative went on to say that however small such use may be, it remained that division corresponded to a clearly identified need of brand owners. The need for such procedure had been sanctioned by the TLT back in 1994 and confirmed by the Singapore Treaty just five years past. Both made it mandatory to provide for the possibility of division of

trademark applications and, in certain circumstances, of registrations. The Representative noted that, as had been pointed out during the seventh session of the Working Group, it seemed peculiar that the Madrid system would not make room for an international standard, set by international treaties concluded under the auspices of WIPO and administered by WIPO.

150. The Representative of INTA said that it was of the very essence of the Madrid system that applicants had chosen the international route for the protection of their marks abroad and they should be treated no less favorably than those having chosen the national or regional route. It followed from this that the international registration should afford holders the possibility of dividing it, with respect to jurisdictions that allowed for division of applications filed directly with their Offices, or registrations effected by their Offices.

151. The Representative further observed that, as pointed out in the discussion document, there existed already *de facto* division of international registrations as the result of the recording of a change of ownership, as well as provision for subsequent merger. A procedure for division of international registrations, as alluded to in the document, other than as a result of a partial change of ownership, could well be developed, based on that existing procedure. A procedure for the refusal of the effects of division could also be included, inspired by the existing provisions for the refusal of a change of ownership.

152. The Representative of INTA said that it was therefore believed that a procedure for the recording in the International Register of the division of international registrations along the same lines of such *de facto* division should be given serious consideration and should be further elaborated upon, in order to give to the Working Group the opportunity to fully assess the possible impacts on all relevant parties. Of course, such assessment would consider fully the concerns that had been expressed by the International Bureau and referred to in the discussion document.

153. Referring to the alternatives envisaged in the document, the Representative of INTA said that, while there was willingness to consider such alternatives, those alternatives would need to meet the needs of brand owners and other users, and offer equal legal security to the holders of international registrations and third parties.

154. The Delegation of Italy stated that it wished to thank the Offices of all those Contracting Parties that had collaborated with the International Bureau in the provision of information for the preparation of the document. The study had shown that 78 per cent of national Offices had received between zero and five requests for division in 2009. The Italian Office had not received any such request in the same period. The Delegation said that it appeared that the introduction of a procedure for the division of international registrations would considerably increase the workflow of the representatives of users. Nevertheless, the Delegation of Italy said that at this moment, it did not see any real benefit for users and expressed concern regarding the introduction of a new procedure that would have a large impact on the existing legal framework of the Madrid system and that would probably introduce complexity into the system.

155. The Delegation of the United States of America said that when it had first reviewed the proposal under discussion, it was somewhat puzzled and questioned why there should be a need to introduce a procedure for division at the international level, given that it already existed at the national level and was required by the treaties that had been referred to earlier. It then became apparent to the Delegation that, in fact, not all Offices had a divisional practice in place at the national level for Madrid filings, even though they may likely have it for their national filings.

156. The Delegation said that this brought it back to what it had often previously referred to, namely, the treatment of Madrid filings differently to national filings, the provision of different levels of service to users and discrimination of Madrid users *vis a vis* domestic users. The Delegation of the United States of America noted that its Office did provide a procedure for the division of applications and that there was not any separate system for national *versus* international filings. The Delegation spoke of the particular circumstances that might give rise in the USPTO to a request for division and explained how the procedure worked in practice in its Office.

157. The Delegation of Switzerland, responding to what had been noted by the Delegation of the United States of America in its concluding comments, said that the idea was to look at the question of division of an international registration in a given designated Contracting Party and not the division of the basic application or registration, as such. The procedures that one was trying to develop related to the designated Contracting Parties, and would not therefore represent an extra burden for the Madrid system.

158. The Delegation of Australia thanked the Delegation of the United States of America for its useful comments and, referring to what had been said by the Delegation of Switzerland, it noted that eight Contracting Parties allowed for division of a Madrid designation, in principle, and this demonstrated that there was not any constraint against such a practice, as far as the Madrid system was concerned. Thus, the Delegation said that it wondered, from the point of view of users, what particular issue remained to be addressed through the Madrid system, in order to meet the needs of users, rather than through processes that may already be possible at the national level.

159. The Representative of INTA, responding to the Delegations of Australia and the United States of America, said that it was obvious that division of the international registration should be country-specific and what it had in mind was that the procedure for division of international registrations should allow for the division of the international registration in respect of the designated Contracting Parties in which an objection had been raised and where the need for division arose.

160. The Representative said that a parallel could be made with the limitation of the international registration. Country-specific division should, in the same way as a limitation, for example, or a partial change in ownership, be reflected in the International Register and the procedure should be at the level of the International Register. Referring to the eight countries that had been mentioned by the Delegation of Australia, the Representative of INTA said that there was evidence of only one country where there was actually legislation and a procedure in place in order to provide for the division of international registrations at the designation level.

161. The Representative said that, of course, users would have no difficulty if all members of the Madrid Union whose legislation provided for division at the national level would also provide for the division of a designation, but wondered whether it was something that the countries would wish to consider, from a legislative point of view.

162. The Delegation of Denmark said that it had been surprised when reading the document to find that the USPTO had been providing for the division of international registrations at the designation level, which its own Office had thought to be not possible under the Madrid system. But in fact, as the Delegation noted, a number of other Offices also allowed, in principle, for the same facility. The Delegation said that it could be useful to have the view of the International Bureau on this issue and that its Office would be very happy to give to its users the possibility of dividing an international registration at the level of a designation of Denmark, if it were permitted to do so.

163. Referring to what had been said by the Representative of INTA, the Delegation of Denmark spoke of the importance of paying attention to making sure that the International Register reflected the actual status, if designations were divided at the national level.

164. The Delegation of Israel said that its implementation of the Madrid system appeared to be a success and it hoped that this trend would continue. With regard to the issue of division, the Delegation said that it was of the view that the possibility of division should be available to those users who chose the international route. However, it believed that such division should take place at the national level and not involving the International Bureau.

165. The Delegation of the European Union said that it believed that the possibility of dividing an international registration was of great importance to users and that it was not appropriate to conclude otherwise, merely because of the limited use that might be made of division in certain national jurisdictions. Referring to the treaties already alluded to, the Delegation noted that a significant number of those Offices that responded to the questionnaire provided for the possibility of division, the Community trademark systems being one of such systems, which followed a very liberal approach on the issue. For this reason, and despite the concerns referred to in the document, the Delegation stated that it was necessary and appropriate to undertake further efforts with the aim of finding a proper solution for introducing the possibility of division of an international registration and thereby achieving coherence with international trademark standards.

166. The Delegation of the Russian Federation stated that provisions relating to the division of applications and registrations existed in the law of the Russian Federation and users had been using it quite successfully. The Delegation referred to its response to Question 11 of the questionnaire, where it had indicated that a request for division had been satisfied in 190 cases. The Delegation said that in recent years, the procedure of division had been used more and more by users, where there had been a partial refusal of the application. The Delegate made reference to the time limit for overcoming objections in its Office, and in particular the difficulty for foreign applicants in some cases. If there were to be a possibility of division within the framework of the Madrid system, there would be need for the recording of division in the International Register also.

167. The Delegation of China said that it was apparent that the need for division was quite limited and the introduction of such a procedure in the Madrid system would make the system more complicated, including the addition of alphabetically sequenced letters to registration numbers. As had been suggested by other delegations, the Delegation of China said that if division could be carried out at the national level to the satisfaction of everyone, it would not be necessary to have division at the level of the International Bureau. The Delegation noted also that even if a procedure for division were to be provided for at the international level, there would still be difficulties for some users, because not all Contracting Parties provided for division at the national level. Since division was already operating satisfactorily at the national level, the Delegation queried the need for such a procedure at the international level.

168. The Delegation of France stated that it wished to point out that it believed that solutions that were designed to decentralize the procedure of division to national Offices, such as proposed in the document, would not be beneficial for users, as it would complicate matters from a practical point of view at the national level.

169. The Representative of INTA said that INTA's introductory statement had sought to clarify that its position was based on the principle that whatever was accessible through the direct route should also be accessible through the international route. In answer to the Delegation of China, the Representative said that he wished it to be clear that INTA was not calling for the introduction of division in countries whose law did not provide for division at the national level.

170. The Delegation of Austria said that its Office did not provide for division and in view of its limited use where it was provided, there should be caution about the introduction of a complex procedure or obligation into the Madrid system. If the delegations supported the introduction of a division procedure, it would be appropriate not to establish new obligations at the national level.

171. The Representative of INTA said that regarding the real impact on the International Bureau of such a procedure as the one contemplated, it was notable, from the second part of the document (the results of the survey), that the country where the largest number of divisions was requested at the national level was the United States of America. If one considered that, in that country, the number of divisions at the level of the designation amounted to just about 100 since the United States of America acceded to the system, then one should expect that introducing a procedure for division into the international registration system should not create such an important amount of work as the International Bureau seemed to anticipate.

172. The Representative of INTA also said that it seemed that the main concern was that a procedure for division would result in difficulty in classification and examination of the lists of goods and services in the divisional registration, translation of the divided lists, and so on. This assumed that the division could be expressed in indications different from those used in the international registration. The Representative of INTA wondered whether this was really the case. If there were such a difficulty, one could consider whether it would equally serve the needs of the users if goods and services to be included in the divisional registration had to be spelt out using only indications that were contained in the parent registration. The Representative of INTA suggested, in that regard, that the International Bureau could possibly clarify what happened in the case of partial changes in ownership, in terms of indications of goods and services.

173. In response to the Representative of INTA, the Delegation of the United States of America said that if there had not, for example, been sufficient specificity in the indication of goods and services, then there could not be the same indications in the parent and child registrations.

174. The Secretariat, in response to the query from the Representative of INTA, said that in the case of the recording of a partial change in ownership, these requests were becoming more and more complex, increasingly involving more than one international registration. The Secretariat did not have any data available relating to how many requests involved changes in the classification. However, there was often considerable difficulty in establishing the scope of protection to be provided for, as between the part to be transferred and the part to be retained.

175. The Delegation of Morocco said its legislation did not provide for division. However, its new legislation to be enacted would allow for division, in accordance with the Singapore Treaty. It said that it would like to think about the issues somewhat further, but, in principle, it did not have any opposition to it.

176. The Delegation of Switzerland said that it wished to refer to its proposal and how it would like to continue work on the issue under discussion. The goal of this procedure was to increase the transparency and legal certainty of the system, so that information could be obtained on international registrations, managed by WIPO, in each designated Contracting Party, where there were differences in goods and services, arising from division. It did not want to make the system more complex. Neither did it wish to introduce new national procedures for countries which did not provide for division at the national level.

177. The Delegation of Switzerland thought that a solution could be found that would avoid that change, so it proposed continuing the discussions and, in particular, to look at the situation in countries that did provide for division, and to find a mechanism that would enable those countries to notify to the International Bureau information relating to divisions, for recording in the International Register. The Delegation said that a continuation of the discussion would allow for further ideas to emerge, for discussion at the following session of the Working Group.

178. Referring to what had been said by the Delegation of Switzerland in the context of transparency and certainty, the Delegation of Cuba said that the gathering of relevant information was very important for all members of the Madrid system. The provision by Offices of additional services on market information would always be useful, in terms of the making of such information available officially through its electronic database. The Delegation noted that its legislation had a provision for division. The Delegation said that it would not have any objection to establishing division as a possibility in the Madrid system, provided that the formalities on fee payment were met at the national and international levels. It did not believe that the introduction of such a procedure would necessarily give rise to a large demand for the application of such a procedure.

179. The Representative of OAPI said that it was following very closely the discussions of the Working Group and, with regard to the issue of division, the Representative said that OAPI had been giving very careful consideration to the issue, and in particular also in the context of change in ownership.

180. The Delegation of Germany shared with the delegations its experience of division at the national level and noted that its Office had had only 12 requests for division of applications, compared with 70,000 applications filed, which meant that the number of divisions was considerably less than one per cent. The Delegation said that if division were to be introduced at the international level, then examination would have to take place at the national level because the underlying problems, such as partial refusal, always arose at the national level.

181. The Delegation of Germany said that, nevertheless, it would need to be reflected in the International Register because, for example, Germany did not have a register of international registrations and therefore could not assign a new number to a divided international registration. The Delegation said that such a framework was already in place in the international context, with regard to partial changes in ownership, which were also examined at the national level, but recorded in the International Register. The Delegation said that its Office would have to revise its electronic system and would also need time for advance preparation. Given the rarity of the application of the division procedure, the Delegation of Germany queried whether it was really necessary to introduce such a feature into the international framework, which would certainly add complexity to the system.

182. The Representative of JPAA said that there had been a lot of experience of filing of divisional applications in Japan, and noted that there had been over 1,000 such applications in the year 2009. From the users' point of view, the Representative said that he did not think that there was any reason not to introduce a division procedure into the Madrid system. Referring to what had been said by the Delegation of the United States of America, the Representative said that in Japan there now existed discrimination between national users and international holders.

183. The Representative of JPAA said that, as had been mentioned by the Delegations of Cuba and Switzerland, it also believed that, from the point of view of third parties, there was a need for transparency and clarity of databases, if a procedure of division were to be introduced. This would involve the International Bureau, in terms of the International Register.

184. The Delegation of Australia stated that it agreed with the comments of many delegations that the introduction of a formal structure for the division of international registrations would entail a great deal of complexity. However, this did not mean that it should not be done, if sufficient benefit could be identified, but the Delegation did signal that caution needed to be exercised.

185. In the case of Australia, where there was a large number of divisional applications, the Delegation said that the division of an application was well used, and the Delegation said that it would be interested in having the views of Australian users regarding the possible division of an international registration designating Australia. The Delegation referred to the possible notification of the official acceptance of goods and services that had not been covered by a partial refusal (mentioned in the discussion document), prior to the completion of all procedures before the Office, and said that it had some reservations about this and that it would be interested to hear the views of other delegations in this regard.

186. The Delegation of Australia said that its reservations were based upon the fact that such a statement would only be interim and that potential partial protection might anyway easily be deduced from a notification of partial refusal. The potential confusion for users and third parties alike could be another problem and the Delegation said that it was not convinced that an official statement of partial protection would be useful.

187. The Delegation of Japan said that its Office provided at present for the division of applications and registrations at the national level. The number of requests for such division in its Office was quite large. The Delegation said that it believed that it was important to have discussions regarding the possible division of international registrations. It wished to note that, as had already been indicated, the International Register should reflect reality if there were to be a division of an international registration at the level of a designation. Secondly, Japan had made the declaration for receipt of the individual fee in two parts. If there were to be a provision for the division of international registrations, there may therefore be a necessity to have an additional procedure in order to provide for the protection of a part of the divided registration. The Delegation said that it was of the view that there was a need that the issue be considered in depth.

188. The Delegation of Sweden said that it attached great importance to the views of users. It was not yet aware of the opinions of users in Sweden regarding the issue of possible division of international registrations and therefore wished to make a reservation regarding the further discussions of the issue.

189. The Delegation of Norway stated that it wished to thank the Delegation of Switzerland for that Delegation's very constructive proposal. It said that it attached great importance to the goal of increasing transparency and legal certainty, while keeping the system simple.

190. At the same time, the Delegation of Norway said that it wished to support going forward along the lines that had been suggested by the Delegation of Switzerland, while being cautious not to make the International Register overly complex.

191. The Chair concluded that there appeared to be 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 more depth, in order to present a proposal for the following session of the Working Group. The Working Group agreed to pursue the approach proposed by the Chair.

AGENDA ITEM 8: OTHER MATTERS

192. The Secretariat said that this agenda item presented the opportunity to speak about the Madrid System Legal Forum, the establishment of which had been requested by the delegations at the previous session of the Working Group. The Forum was intended to provide a platform for continued discussion of the legal development of the Madrid system, outside the sessions of the Working Group.

193. The Forum had been established and information had been disseminated concerning the modality for gaining access to it. Thus far, the Secretariat said that access had been granted to 47 parties and there had been one document submitted to the Forum, namely the document referred to earlier by the Delegation of Norway, regarding the issue of central attack.

194. The Secretariat said that the Forum was a place where ideas and proposals could be aired and explored and that the momentum of the Working Group could be continued. The Secretariat therefore urged those who had not yet subscribed to the Forum to do so, by providing user names and obtaining passwords. The Secretariat explained how to gain access on the Internet to information concerning the Forum.

195. The Representative of INTA said that he wished to commend the International Bureau for the establishment of the Madrid System Legal Forum and expressed his hope that it would be availed of. The Representative said that he wished to recall also that some years past, a Forum on the issue of replacement had been established. INTA had posted some comments on that issue two months previously and suggested that the Forum on replacement be closed and that the contributions on that Forum be transferred to the new Madrid System Legal Forum.

196. In response to the Representative of INTA, Ms. Wang, said that she would wish to have input from the delegations as to how the Madrid system might be simplified. She said that according to the current draft Program and Budget for the following biennium, the Madrid Working Group had been budgeted for one session per year. She noted that there had been some comments from delegations and user-groups to the effect that a single session per year was not sufficient. The Deputy Director General said that it would be difficult to request an increase in the budget so as to facilitate the holding of two sessions per year. She said that another option was to have a single session, broken into two terms, which would be more cost-effective. However, much depended upon the requirements of the development of the work of the Working Group. The Deputy Director General assured the delegations that she was entirely at their disposal and welcomed having from the delegations any ideas as to how matters could be progressed.

197. The Delegation of China, in response to what had been stated by the Deputy Director General, said that its feeling was that the sessions were important and necessary for the development of the Madrid system and that one session per year was perhaps not sufficient. More frequent meetings would increase the efficiency of the work of the Working Group, shortening the time taken by each meeting and allowing for a wider exchange of ideas and discussions.

198. The Delegation of Australia said that it had earlier been concerned when it became apparent that the Working Group would not be meeting for a further year, because the opportunities for Contracting Parties to work on the simplification of the system were thereby being made more difficult. The Delegation said it agreed with what had been said by the Delegation of China, but noted that, for Australia, and probably for other delegations, to meet for a shorter period twice a year might not be useful. It said that it welcomed the possibility to discuss other options, if the holding of meetings twice per year were not possible.

199. The Delegation of France said that its Delegation had a preference for having the discussion documents as early as possible so that its Office could consult with its users.

200. The Delegation of Italy, supported by the Delegation of Germany, said that its Office would have some difficulties in participating in twice-yearly Working Group sessions, as it had also other commitments of this nature. The Delegation of Germany said that it wished also to strongly support what had been stated by the Delegation of France concerning the timely making available of the discussion documents, and their translations, and proposed that this issue be included on this occasion in the Summary by the Chair.

201. The Delegation of Switzerland said that it could see the point of having more frequent meetings, in order to stimulate the work of the Working Group. Nevertheless, it said that, like other delegations, it could be a problem when it came to receiving the discussion documents early enough. Thus, it wondered, in possibly increasing the frequency of the Working Group sessions, how possible would it be to have discussion documents prepared in advance. Regarding the length of the sessions, it said that it had noted and understood the concerns of the Delegation of Australia, but queried whether five days per session was really needed, if the frequency of the meetings was increased.

202. The Chair said that if the Madrid System Legal Forum could be used more effectively for the sharing of comments, that may in turn bring about a consensus on items for further discussion during the Working Group, even if the Working Group were to be restricted to one session per year. However, this would mean a more engaged participation in the Forum by all of the member States.

203. The Deputy Director General, Ms. Wang, referred to the Round Table meeting, which was due to take place on the Thursday of the week of the current session of the Working Group. She said that the Secretariat would be looking forward to feedback from the participants as to how this could be better organized in the future. The Deputy Director General noted that with the accession, probably next year, to the Madrid Protocol, of the single remaining Contracting Party bound by the Agreement only, there would likely be much more work for the Working Group and that a single session per year might not be sufficient. It might become necessary to consider the holding of *ad hoc* meetings, from time to time.

204. In concluding the discussion of this item of the agenda, the Deputy Director General also addressed the issue of the timely delivery of the discussion documents and the postponement of the date of the current session. She spoke of the sometimes logistical difficulties in the arrangement of meetings at WIPO and expressed her regret that on this occasion, it had become necessary to have a postponement. Regarding the documentation, she said that she was in agreement with it being mentioned in the Summary by the Chair that the documents would be delivered in a timely fashion for the next session. However, she said that she was also requesting the indulgence of the participants in understanding that there were certain aspects of the publication of documentation that were beyond the control of the Secretariat, and in particular, aspects of translation, because of the large demand in WIPO for the translation of documentation in general and the limitations on the staff available to carry out such work. She said that every effort would be made to ensure that there would be no avoidable delays in the future.

AGENDA ITEM 6: PROPOSALS FOR THE SIMPLIFICATION OF THE MADRID SYSTEM

205. Discussions of this agenda item were based on document MM/LD/WG/9/4.

206. Before the discussions commenced, 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.

GENERAL COMMENTS AND RESPONSES BY THE SECRETARIAT

207. The Delegation of Cuba confirmed that its Office had already used some of the functions that had been referred to in the presentation and had begun recently to send to the International Bureau electronic communications. The Delegation asked whether there was any coordination between the work that had been described in the presentation and the Industrial Property Automation System (IPAS) which was the system that its Office had been working on, but some of which did not permit integration with international registrations. The Delegation said that other countries that had been using the same system would also be interested to know if there was any link between it and the Madrid system.

208. Mr. Wilson said that IPAS was a system that had been developed by WIPO and that it was essentially an industrial property administration system in a box, delivered fully functional, covering patent, trademark and industrial design procedures. With regard to the question as to whether there was a link between that system and the new functionalities that had been presented, the answer was in the affirmative. The IPAS toolbox included, for the time being, a function called the Madrid module. This, when installed, would enable an Office to benefit from full electronic communication of notifications in XML format, for upload and prosecution within the IPAS system. Mr. Wilson noted also that there were discussions as to how the system could be further improved by a web-service-enabling IPAS.

209. The Delegation of Australia said that a lot of the tools being developed by WIPO and a lot of the challenges that were faced in the processing of trademark procedures were also faced by Offices, so the area in general was of widespread interest. The Delegation asked what kind of outreach WIPO was giving to users of the system to alert them to the provision of the new useful tools for the management of users' rights.

210. Mr. Wilson responded to the Delegation of Australia saying that the marketing of products, as such, was not an area in which WIPO had had a long experience. It was accepted that before the new client-based communication tools were launched, there would need to be a full suite of support services, including interactive demonstration videos on the website.

211. The Representative of AROPI said that it commended the International Bureau for the efforts that it had been making for the purpose of improving the quality of the system and the quality of communications within the system. The Representative sought confirmation on the fact that access to the Madrid Portfolio Manager would be restricted to holders of international registrations and their representatives. The Representative, making reference to the system that operates at OHIM asked if there was also going to be general access, through a portal, allowing, for instance, third parties to become aware of changes in the International Register.

212. Furthermore, the Representative suggested that, where an electronic communication is received by the International Bureau, an automatic acknowledgement of receipt should be systematically sent. The Representative believed that implementing such a mechanism would not represent an insurmountable difficulty and underlined that this mechanism would be very useful for users of the Madrid system.

213. In addition, the Representative said that, although the e-renewal system was remarkable and easy to use, this facility could not be used to renew an international registration which had been the subject of a partial refusal of protection. Thus, the Representative suggested that this facility should be extended to all the international registrations.

214. The Representative of AROPI further expressed the thought that a new box should be added, in the form to request the renewal of an international registration (i.e., form MM11) and in the e-renewal service, requesting the International Bureau to renew the international registration in all the designated Contracting Parties in which the said registration had effect. The Representative stated that the system, as it stood, obliged users to indicate each Contracting Party and some mistakes or omissions could occur.

215. Mr. Wilson responded to what had been said by the Representative of AROPI by noting that there were three elements to the intervention. Firstly, there had been the issue of understanding more about accessing online the real-time status of either a portfolio or a particular request. Secondly, there was the issue of a more automated procedure for the acknowledgement of receipt of communications, and in particular, email communications. Thirdly, there was the issue of improvements to the e-renewal procedure.

216. Mr. Wilson said that the reason that there were three new client tools was because, on the one hand, the International Bureau believed that holders and representatives in fact managed portfolios of international registrations. It was believed that it would be useful for those parties to be able to see the status of their portfolio online and, behind that, to have the possibility to make requests or upload requests for recording for processing by the International Bureau for one or many, or all, of the international registrations in the portfolio.

217. Additionally, reference was made by Mr. Wilson to the watch service. The Madrid Portfolio Manager looked at one's own portfolio, but one may also wish to look at the portfolio of a third party, for example, a competitor. The service would offer an email alert system each time there was a movement on any international registration in the watch list. The email alert would contain a hyperlink to WIPO's ROMARIN environment, where it would be possible to see precisely what had taken place with regard to the third party's registration.

218. Referring to a person who in fact did not have a portfolio established at the International Bureau, but had, for example, submitted a request for the recording of a subsequent designation, and who wished to know precisely what was the workflow status of such request, Mr. Wilson said that, within the Madrid real-time status solution, it would be possible for that person to input various criteria, such as an international registration number, or a reference number, and the system would find that particular request in the pending requests before the International Bureau and would indicate where it stood in the prosecution process.

219. Regarding e-renewal, Mr. Wilson said that his understanding was that the e-renewal interface did permit the renewal of registrations which had been the subject of a provisional refusal, but this point might be further clarified later in the discussions. As far as the possibility of the indication in the renewal form, either on paper or online, of the wish of the holder to have renewal effected automatically for all of the designated Contracting Parties, avoiding the need to indicate individually all such Parties, and the consequent risk of accidentally omitting a given Contracting Party, Mr. Wilson said that the proposal of the Representative of AROPI was in fact an excellent proposal for simplification and would be considered for inclusion on the form and on the Internet.

220. With regard to the automated acknowledgement of the reception of emails, Mrs. Valdimarsdóttir said that the goal was to respond to emails within 48 hours.

221. The Delegation of Morocco expressed its welcome for the new tools that were in development. Referring to the portal that had been mentioned by Mr. Wilson in his presentation, the Delegation asked whether it would be possible to use the email addresses that had been referred to, to send notifications and letters to the Groups within Operations at the International Bureau (Groups 1, 2 and 3), in the meantime, before the portal became operational. Secondly, with regard to the new client services, the Delegation of Morocco asked whether there would be practical workshops to train persons, perhaps within the WIPO Academy, so that the services could be used more effectively.

222. Responding to the Delegation of Morocco, Mr. Wilson said that the concept of the portal was a recent innovation, so it was still in its infancy. Technologically, he said, it would not be a challenge to put it in place but its development had not yet commenced. Users would be kept informed as to its progress. Regarding the use of the email addresses at the team level, for the delivery of requests for recording, while the development of the portal proceeded, Mr. Wilson said that this would be challenging to process in an efficient way. This was because of the unstructured way in which email presented itself. The process could not be automated such that documentation would arrive at the examination process.

223. With respect to the new services, Mr. Wilson confirmed that there was a need to build a package of publicity and e-tutorials, explaining the working of the new client tools. That would have to be dealt with comprehensively prior to going live on the Internet with those new tools.

224. The Deputy Director General, Ms. Wang, said that with regard to all the IT products that had been mentioned and demonstrated, there would, in due course, be a circular issued to all Offices, in order to set out the steps that were being embarked upon. Secondly, Ms. Wang said that, technically speaking, it appeared that everything was possible. However, it may still take some time to develop a package so as to ensure that the new technological tools were made fully available to everyone. Finally, Ms. Wang said that the training request mentioned by the Delegation of Morocco was a very important issue and a packaged program would be elaborated for this purpose, to ensure that all the electronic tools that had been developed were exploited fully and most efficiently.

PROPOSALS FOR THE SIMPLIFICATION OF PROCEDURES

225. The Secretariat made a general introduction to the discussion document, referring to the conclusion which had been drawn at the eighth session of the Working Group to the effect that there had been a consensus on the fact that the following session would deal with issues relating to the further simplification of the internal processes carried out by the International Bureau, in order to make the Madrid system simpler, more efficient, reliable, flexible, user-friendly and time- and cost-effective.

226. In line with the above, the Secretariat stated that the International Bureau had begun a review of its processes and practices with a view to their streamlining and said that the discussions in this regard would need to continue into the future. The Secretariat noted that information had been received that there were also taking place, at the level of Offices, parallel discussions on ways in which the Madrid system might be simplified, and this was something that was to be encouraged, as part of a joint effort in the process of simplification.

227. The Secretariat said that the discussion document dealt with possible amendments to the Common Regulations and, more specifically, contained four proposals. These related to, firstly, the issue of translation, upon request, of statements of grant of protection, following a notification of provisional refusal, secondly, translation of the list of goods and services affected

by a limitation in an international application, a subsequent designation or in a request for the recording of a limitation, thirdly, communications concerning the status of the protection of a mark sent by Offices to the International Bureau in a positive wording, and finally, 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 18^{TER}(2)(II) (PARAGRAPHS 5 TO 24 OF DOCUMENT MM/LD/WG/9/4)

228. The Delegation of the European Union said that it could unconditionally support the proposed amendments to the Common Regulations regarding the efficient publication of the Gazette. This amendment would contribute to making the system technologically up to date, and more simple and reliable. The Delegation said that it had taken note of the other proposed amendments and said that the implications of such proposals should be further studied.

229. The Delegation of Spain stated that it supported what had been said by the Delegation of the European Union. Additionally, with regard to the issue of translation, the Delegation said that if simplification led to reduction in efficiency, then it would be counter-productive. Simplification which would lead to the introduction of translation upon request would, in the view of the Delegation of Spain, undermine the drive to extend the Madrid system, as it would make the system less attractive to Spanish-speaking States. Introduction of the proposed amendments would also lead to the undermining of the extension of the languages policy of WIPO, as stated in the document on the languages policy at the recent meeting in that context.

230. With regard to Article 9^{sexies}, the Delegation of Spain said that what it wished to state during the discussion of this issue was that Spain was in favor of total repeal of the safeguard clause, but, as had been also noted by the Delegation of the European Union, for the time being, it was not possible to move towards that total repeal, but such would be possible if and when circumstances allowed it.

231. The Delegation of Panama, speaking on behalf of the Group of Latin American and Caribbean Countries (GRULAC), said that it wished to underscore the preservation of WIPO language policy and it thought that some of the simplification proposals might work to the detriment of that policy. The Delegation said that there should be retained a languages policy that was consistent for all of the forums within WIPO, without restricting the use of any of the languages used in each of the treaties. Therefore, the issue should be considered very carefully.

232. The Delegation of Monaco stated that it was aware as to why the International Bureau had proposed to adopt such a pragmatic solution of translating, upon request, statements of grant of protection. The Delegation said that it hoped that, in due course, the necessary conditions, including funding, would be in place, so as to enable the International Bureau to carry out systematic translations. It did not think that it would be appropriate to make the practice of translation upon request a formal rule. The Delegation said that it did not wish to see the current temporary practice become an official practice.

233. The Delegation of France said that it supported what had been stated by the Delegations of the European Union and Monaco. It did not support making official a policy that had been adopted as a temporary measure. The trilingual regime of the Madrid system was one of the cornerstones of the system and to adopt the proposed amendment would undermine that cornerstone.

234. The Delegation of Italy said that it too agreed with and supported what had been said by the Delegation of the European Union. It said that it considered of the highest importance the principle of linguistic unity of international registrations.

235. The Delegation of Switzerland said that it felt that the proposed changes would support the objects of simplicity, efficiency, cost-effectiveness and so on. The proposals appeared to strike the right balance between the need to have translations, when necessary, and the importance of not giving priority to one language over others. The Delegation therefore supported the proposals and said that it was necessary to consider the longer-term benefits that such proposals could lead to, in terms of widening membership of the system and the work that this would lead to for the International Bureau.

236. The Delegation of Algeria commended the International Bureau for the efforts that it had been making for improving the Madrid system and making it more reliable. The Delegation said that its Office hoped that the notifications of registrations would become more detailed, in terms of the legal changes.

237. The Delegation of Israel said that it supported all of the proposed amendments and said that it understood that the changes were necessary in order to simplify procedures.

238. The Delegation of the Russian Federation said that, on the whole, it supported the proposed amendments. The Delegation said that it appeared that users of the system would not have any additional difficulties as a result of the proposed amendments.

239. The Delegation of China stated that it also was of the view that the direction in which the Working Group was proceeding was correct. It understood the concerns that had been expressed by the Delegation of the European Union and other delegations on the issue of languages, which was a very important aspect of the Madrid system. The Delegation said that its users, being the highest filers in the system, would probably encounter more problems than users in other member States, in terms of language, given that Chinese was not a member of the family of Latin languages. The Delegation said that it believed that a proper languages policy was the cornerstone for attracting more members, so it was necessary to work hard to eliminate linguistic barriers in the system and, in particular, in attracting users from countries that did not use the Latin system. It said, however, that it was aware of the funding constraints.

240. The Secretariat reviewed Rule 18ter(2)(ii), also called “final decision”, and the translation requirements of that provision. The Secretariat referred to the background to the proposal, which was set out in the document, and the situation of pending translations and the size of the backlog of such translations, and what it would require to address the backlog at this time. It was underlined that it was intended that the trilingual regime would remain intact, as it stood. The proposed amendment was with a view to formalizing a situation that had been in existence for some time.

241. The Secretariat said that it was important to note that the proposal did not touch upon the rights of holders of the international registrations concerned, or the concerned Offices. It was proposing a flexibility of translation upon request, where the history had shown that translations were not greatly sought. The Secretariat presented a detailed analysis of the breakdown of the backlog and referred to the cost which would be incurred if the translation of the backlog were to be addressed. The cost of translation would be 3.31 million Swiss francs, of which 1.7 million Swiss francs would be incurred for translation into Spanish, 1.35 million Swiss francs for translation into French and 260,000 Swiss francs for translation into English.

242. From the data and information which was set out in the discussion document, the Secretariat said that it appeared that translation of the final decision under the rule in question would only be of interest to a small number of users. It was also necessary to underline that the proposed amendment would affect only third parties in countries other than the country of the holder, or the countries of the designated Contracting Parties, and it related to all three working languages.

243. The Secretariat gave an example of how the proposed amendment would operate and said that, if adopted, the change would allow for a more rational allocation of existing resources and place the International Bureau in a better position to be able to absorb future growth, while still satisfying the needs of the users of the system.

244. The Delegation of Australia said that it welcomed the opportunity to work through the issues on simplification of the system and said that it was a very important exercise for the work of the Working Group. The Delegation said that on the particular item under discussion, it had listened carefully to the statements that had been made by other delegations and it was open to considering the particular modification in question. The Delegation said that it did have some concerns about the proposed changes, but those related particularly to the provision of information to users about the scope of protection in different countries and how accurate and accessible information could be decreased as a result. However, given that the full translations had not been readily available since 2009 and that the number of requests for translation had been so low, and that the continued availability of translation on request was envisaged, it felt that it might not, in fact, be such an issue of particular concern for users.

245. The Delegation of Zambia said that it believed that the potential problems that might be envisaged as arising, in the event of the adoption of the amendment, had been addressed. The parties directly concerned would have available to them the relevant information, in a language that they could understand. The Delegation therefore expressed its support for the proposal.

246. The Delegation of France, supported by the Delegations of Cuba, the European Union and Spain, said that it wished to reiterate the position of its Delegation to the effect that it did not wish to see the legalization of what was a temporary practice. The Delegation said that it did not have a difficulty with the International Bureau continuing the practice, given the budgetary constraints. The Delegation said that it could not support the proposed amendment. The proposal merited further study because of its implications.

247. The Delegation of Zambia said that each time a simplification was introduced, it was followed by the introduction of a complication. Because of regular deferral of items for discussion, the Delegation said that it could be necessary to hold two sessions of the Working Group each year.

248. The Deputy Director General, Ms. Wang, said that the key issue seemed to be how to address the issue of the backlog. She said that it would not be in compliance with the Common Regulations to continue as theretofore. However, if there were not some type of formalization of the current temporary practice, this would not be correct for users and for the International Bureau. If there were to be a final resolution of the problem, there would be need for additional financial resources. Meanwhile, efficiencies could be maximized in order to reduce the costs of translation. One way or another, there was a need for a solution, whether it be the bringing to the Assembly of a recommendation to endorse the continuation of the temporary practice, without amending the Common Regulations, pending further discussion and budgetary approval, or the issue be kept open for further discussion. But one way or another, the issue needed to be resolved, as the backlog would continue to grow.

249. The Delegation of Japan spoke of the importance of simplification of the Madrid system and expressed its support for the proposed amendment.

250. The Delegation of the Republic of Korea, supported by the Delegation of Norway, also expressed its support for the proposed amendment and said that a balance needed to be struck between the trilingual regime and the user-friendliness of the system. It stated that, in its view, the proposed amendment struck that balance. The Delegation said that its Office had consulted with its users and this had shown that one of the biggest complaints had been the long pendency period in the Madrid system. The proposed amendment went in the direction of alleviating this.

251. The Delegation of Viet Nam said that, with the aim of simplification and budgetary efficiency, it supported the proposed amendment.

252. The Delegation of France, supported by the Delegation of Monaco, said that it aligned itself with what had been stated by the Delegation of the European Union, but wished to reiterate that it did understand the budgetary constraints, forcing the International Bureau to take temporary measures on an exceptional basis. Nevertheless, the current practice should remain an exception. The trilingual regime represented a cornerstone of the Madrid system and should not be compromised. When it had been agreed to introduce simplification, it had also been agreed that the cornerstones of the system would not be touched. The Delegation said that it was concerned that making the practice official in the Common Regulations could lead to a precedent for other systems that were managed by WIPO. The Delegation referred also to what had been said by the Delegation of Spain regarding the current review of the languages policy at WIPO and said that to accept the proposed amendment would be contradictory to that policy.

253. The Delegation of Monaco said that the door should be left open for the possibility of reverting to the original practice of systematic translation in the future.

254. The Representative of JPAA said that, from the users' point of view, if the burden of translation was causing delays in other procedures, he would support the proposed amendment.

255. The Chair concluded that the current practice of the International Bureau was a logical solution to the ever-increasing workload and of the expansion of the system. There had not been a general consensus regarding the proposed amendment and the Working Group had 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)

256. The Secretariat outlined the proposal, making reference to the relevant paragraphs of the discussion document.

257. The Secretariat noted that a request for the recording of a limitation was often the consequence of a notification of provisional refusal. It was noted that, despite the best efforts on the part of the International Bureau to decrease the pendency time for translations, there remained an increased probability that a request for the recording of a limitation could be notified to the Office of a refusing Contracting Party, beyond the time limit for responding to such notification of provisional refusal, thereby rendering futile the efforts by the holder to resolve the provisional refusal.

258. The Secretariat stated that the proposed amendment was aimed at introducing a more pragmatic approach to the issue of translation of indications of goods and services affected by a limitation and gave examples of how the proposal would operate, in practice, if adopted. The expected results would allow for the expedited recording, publication and notification of recordings of limitations and assist in ensuring that holders could preserve their rights, by complying with a time limit for responding to a notification of provisional refusal.

259. There was not an option for translation upon request, as far as the proposed amendment was concerned. However, the Secretariat stated that such could be provided for, if the Working Group saw fit to do so.

260. The Delegation of France, supported by the Delegation of Monaco, said that it held exactly the same position regarding the proposed amendment as it held with regard to the earlier proposed amendment and would thus not be in favor of amending the Common Regulations as proposed.

261. The Representative of JPAA said that it supported the proposed amendment. He said that he had noted what had been said by other delegations with regard to the proposed amendments in general, but he expressed the hope that, as far as this proposed amendment was concerned, the Working Group would endorse the current practice of the International Bureau so as to ensure that the rights of users would not be prejudiced, because of heavy translation loads.

262. The Delegation of Australia said it had some reservations, as with the previous proposal, for the same reason as earlier expressed, regarding the information being made available to users with respect to the scope of protection in given designated Contracting Parties. However, it was aware that the proposed changes would be of benefit to users and said that it would be unfortunate if the particular problem concerning the time limit for holders to respond to provisional refusals could not be resolved by the Working Group.

263. The Representative of INTA sought clarification from the Secretariat regarding partial subsequent designations, in the context of the figures for the number of words to be translated as appearing in Table 3 of the discussion document. Referring to the relevant rule of the Common Regulations, the Representative said that it was his understanding that where a subsequent designation was not for all the goods and services of the international registration, the relevant goods and services should be indicated, but only in the same terms as the original indications. Thus, the Representative expressed his surprise at the need for translation in the case of a subsequent designation.

264. Furthermore, the Representative of INTA asked for confirmation that the data referred to in the document did not take into account the automatic translation that had been referred to earlier.

265. The Delegation of Japan proposed the introduction of a practice similar to the one followed for translations of statements of grant of protection, that is to say, to allow for the possibility also of translation upon request, in order to avoid disadvantaging users.

266. The Secretariat said that it wished to underline that the current practice was to provide for translations into the three languages and that it was not operating a system of translation upon request, as such.

267. The Delegation of China said that the essence of the two proposals was similar and that support and opposition, for the proposals, among the delegations, would be likely to not alter greatly. The Delegation said that the suggestion that had been made by the Delegation of Japan was very persuasive.

268. The Secretariat referred to the difficulties that had already been outlined with regard to final decisions and the backlog dating to 2009. There were about 20 requests for translation of final decision each month. There was not the same difficulty with regard to limitations. The proposal under discussion was merely aimed at decreasing the pendency time. It was not a budgetary issue and not because of a backlog. The Secretariat said there was not included in the proposal the possibility of translation upon request. It was upon the proposal of the Delegation of Japan that that possibility was added to the proposal.

269. The Delegation of Switzerland said that it wished to recall the position that it had tended to adopt and to indicate its support for this particular proposal, formalizing the suggested practice. The Delegation said that it recognized the problems that systematic translations gave rise to and said that it would be a good idea to make official the practice suggested in the proposal. The Delegation said that it did not think that to adopt the proposal would undermine the trilingual character of the system. It was not necessary to always have a translation into the three languages, if the country in question was not concerned with a given language.

270. The Delegation said that the proposal would facilitate the future development of the Madrid system and that serious consideration should be given to the consequences if it were decided to continue with the current practice. With regard to the issue of the languages policy of WIPO, the Delegation of Switzerland said that there was a difference between the provision of documentation for committees and individual requests in specific cases. The Delegation pointed out that it had already been indicated by users that translation into all three languages was not always necessary and led to quite considerable delays.

271. The Delegation of the Russian Federation noted that the subject under discussion was closely linked with the previous proposal. It spoke of the trilingual regime having been referred to as a cornerstone of the Madrid system and the issues regarding the languages policy of WIPO, already referred to. The Delegation queried the idea that the trilingual regime was quite a cornerstone. It merely reflected the situation as it had evolved up to this time, starting with French, followed by the addition of English, and then the introduction of Spanish.

272. Referring to the languages policy issue, the Delegation said that that was a very important matter, but the policy had to be flexible. The Working Group had as its objective the development of the Madrid system and that included improving the flexibility of the system. The more there was flexibility, the better it was for countries and the International Bureau. Flexibility meant dynamism.

273. The Delegation of the Russian Federation said that it supported both the first and the second proposal. They corresponded to reality. It was necessary to try to arrive at a consensus, perhaps not at the present session of the Working Group, but in future discussions. If the rules of the Common Regulations could not be adhered to, then it was necessary to examine ways in which the rules could be changed. Flexibility was one of the main attractive characteristics of the Madrid system, which was appreciated by its users.

274. The Delegation of Norway said that it wished to support what had been stated by the Delegation of Switzerland. In its view, the proposal was a practical step that did not change the principles of WIPO's languages policy. It also said that it supported the proposal of the Delegation of Japan regarding the inclusion of the possibility of a translation upon request.

275. The Delegation of Zambia, supported by the Delegation of the Republic of Korea, said that simplification of the system implied, in this case, expediency. The Delegation therefore supported the proposal.

276. The Delegation of Monaco asked whether translation and publication in the three languages was an absolute condition for a request having legal effect.

277. In response to the Delegation of Monaco, the Secretariat stated that the question raised did not touch upon the core issue at hand. The proposal under discussion, with the amendment proposed by the Delegation of Japan, was being made in order to streamline procedures in the best interests of users.

278. The Delegation of Spain said that it wished to present the same comments it had made earlier. It agreed with the Delegation of the European Union to the effect that there was a need to continue to study the issues and it wished to stress the need for all three languages to be treated as on an equal footing.

279. The Chair concluded that the Working Group was recommending 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)

280. The Secretariat outlined the proposal, making reference to the relevant paragraphs of the discussion document.

281. The Secretariat referred to the option currently available to Offices to communicate the scope of protection of a mark in either a positive or a negative manner. The information received by the International Bureau was inscribed, notified to the holder and published exactly as it was received. If the information was communicated in a negative manner, there would be an indication of the goods and services for which protection had been partially refused, rather than the goods and services for which protection had been granted.

282. In certain case, the Secretariat said, it may not be easy for a holder to readily ascertain, in given Contracting Parties, the goods and services for which a mark had in fact been protected. It would indeed be even more difficult for third parties or tribunals, in such cases, to establish the scope of protection of the mark in question.

283. The Secretariat noted that, in recent times, it had been provided in the Common Regulations that certain communication were required to be sent in a positive manner and, in particular, statements of grant of protection and also such statements following the sending of a notification of provisional refusal.

284. The Secretariat considered that all communications dealing with the scope of protection of a mark might be sent in a positive manner and indicated the particular rules that were proposed to be affected by the proposed amendment under discussion.

285. The Delegation of Germany said that for its Office, it may not be very practical in a case where there had been a partial provisional refusal, in the context of a very long list of goods and services, where only a small number of indications were affected by the partial refusal. Its Office was still paper based and, in such case, a detailed comparison would have to be conducted in order to produce, in positive format, the eventual list of protected goods and services. The Delegation said that the current situation, allowing for communication in either positive or negative manner, allowed the Office to adopt the manner that was most practical in any given case. It also reduced the risk of mistakes being made. It therefore did not agree with the proposed amendment.

286. The Delegation of Estonia said that the sending of communications concerning the scope of actual protection might be more transparent for users but said that it did not agree that a provisional refusal which did not indicate the goods and services that were affected by the grounds of refusal would be easier to understand, especially if the original list of goods and services was very long and complex. The holder of an international registration had to react to a notification of provisional refusal and such holder had to be in a position to understand very clearly what he was going to lose if he did not react, in terms of the goods and services actually affected by the refusal. It would, in the Delegation's view, be much clearer to the holder if the provisional refusal was presented in a negative manner.

287. The Representative of INTA said that he welcomed any proposals aimed at making the register more readable, but wished to follow up upon the earlier interventions of the Delegations of Estonia and Germany. The Representative said that he tended to agree that it might not always be practical for users to see the provisional refusals expressed only in a positive manner. He said that perhaps consideration should be given to expressing refusals both in a positive and negative manner.

288. The Delegation of Austria, referring to how the proposed amendment might affect the wording of licenses, stated that it supported the positions of the Delegations of Estonia and Germany.

289. The Delegation of Madagascar said that its Office had always issued notifications in a negative manner, to enable holders to appeal decisions, or at any rate, to enable them to clearly understand the status of protection of their marks. It therefore supported what had been said by the earlier delegations in this regard.

290. The Delegation of China said that it had consulted a number of stakeholders and had found that a minority would benefit from the proposal under discussion. For users who intended to file an appeal, it was essential to be able to identify clearly the goods and services that had been the subject of refusal. Additionally, the adoption of the proposed amendment might create difficulties for examiners, as had been stated by the Delegation of Germany. From a legal and practical point of view, the Delegation of China said that its Office usually issued the list in a negative manner. From the point of view of tribunals, the only concern was the goods and services that had been denied protection. The Delegation said that it did not therefore support the proposed amendment.

291. The Chair concluded that the Working Group had decided not to adopt the proposal. The Chair stated that the International Bureau would further study this issue, with a view to its possible inclusion in the agenda of 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)**

292. The Secretariat outlined the proposal, making reference to the relevant paragraphs of the discussion document.

293. The Secretariat said that the introduction of the Gazette in electronic format had made redundant Rule 32(3) of the Common Regulations. The proposal was simply to amend the paragraph in question so as to indicate that the Gazette was published on the WIPO website. The proposal, if adopted, would align the mode of publication with the standing practice of the International Bureau with regard to other WIPO-administered treaties.

294. No delegation expressed opposition to the proposal and the Chair concluded that the Working Group had decided to recommend to the Madrid Union Assembly the amendment to Rule 32(3), as proposed.

AGENDA ITEM 9: SUMMARY BY THE CHAIR

295. The Working Group approved the Summary by the Chair, as contained in document MM/LD/WG/9/6.

AGENDA ITEM 10: CLOSING OF THE SESSION

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

[Annexes follow]



MM/LD/WG/9/6
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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

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 9*sexies*(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 9*sexies* 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 9*sexies*.
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 9*sexies*.
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 9*sexies* at this time. The Working Group also decided that the review of the application of paragraph (1)(b) of Article 9*sexies* 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.



MM/LD/WG/9/1
ORIGINAL: ENGLISH
DATE: JULY 4, 2011

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

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.~~

[Annex II follows]



MM/LD/WG/9/INF/1
ORIGINAL: FRANÇAIS/ENGLISH
DATE: 8 JUILLET 2011 / JULY 8, 2011

Groupe de travail sur le développement juridique du système de Madrid concernant l'enregistrement international des marques

Genève, 4 – 8 juillet 2011

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

Geneva, July 4 to 8, 2011

Liste des participants

List of Participants

établie par le Secrétariat

prepared by the Secretariat

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[End of Annex II and of document]