

WIPO



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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

**SPECIAL UNION FOR THE INTERNATIONAL REGISTRATION OF MARKS
(MADRID UNION)**

ASSEMBLY

**Fortieth (23rd Extraordinary) Session
Geneva, September 22 to 30, 2008**

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/45/1): 1, 2, 3, 16, 22, 25 and 26.
2. The report on the said items, with the exception of item 16, is contained in the General Report (document A/45/5).
3. The report on item 16 is contained in the present document.
4. Mr. Li-Feng Schrock (Germany), Chair of the Assembly, presided over the meeting.

Amendment of the Common Regulations

5. The Assembly considered document MM/A/40/1.
6. The Chair invited the Chair of the Working Group on the Legal Development of the Madrid System for the International Registration of Marks (hereinafter referred to as “the Working Group”) to report to the Assembly on the work of the Working Group that had resulted in the proposals now being submitted for consideration by the Assembly in document MM/A/40/1.
7. The Chair of the Working Group, Mr. António Campinos from Portugal, reported that the Working Group had held its fifth session in May 2008. He addressed special thanks to the two Vice-Chairs of the Working Group and to all participating delegations for the very positive and constructive contributions. The discussions in the Working Group had been based on contributions by Australia, Japan and Switzerland, and a document prepared by the Secretariat. Some of these suggestions for improvement of the system would be further considered, but consensus was reached in the Working Group on the amendments to the Common Regulations now being proposed concerning the accessibility of information, particularly information relating to the fate of designations in the designated Contracting Parties. In particular, the proposals were introducing an obligation for all Contracting Parties to issue statements of grant of protection. In order to enable national offices to accommodate their practices to the new procedures under the Madrid system within a reasonable time, the proposal contained a transitional period until December 31, 2010.
8. The Chair recalled that some amendments to the Common Regulations had come into force on September 1, 2008, and that it was on the basis of the consolidated version of the Regulations that the amendments proposed in document MM/A/40/1 were now to be considered.
9. The Delegation of the United States of America welcomed and supported the proposed amendments to the Common Regulations. In the view of the Delegation, the amendments were a positive first step towards increasing the level of services provided by the International Bureau and the national offices. The Delegation thanked the other delegations participating in the Working Group, in particular the Delegation of Australia, for working so collaboratively to address these issues. The Delegation was looking forward to future discussions so as to move towards further improvements of the system.
10. The Delegation of China noted that for three successive years its country had been the most designated Contracting Party in the Madrid system. The Delegation further indicated that its office had concluded that the heavier workload that would result from the proposed amendments to the Common Regulations could be overcome. Therefore, the Delegation was in a position to support the proposed amendments.
11. The Delegation of Japan expressed its support for the proposed amendments to the Common Regulations and said that the introduction of provisions on statements of grant of protection would increase user-friendliness and transparency.
12. The Delegation of Norway expressed its support for the proposed amendments to the Common Regulations.

13. The Delegation of France expressed its support for the proposed amendments to the Common Regulations and emphasized the importance of the transitional period, which would allow national offices to adapt their systems to the new procedures under the Madrid system.

14. The Representative of INTA commended the work of the Working Group under the chairmanship of Mr. António Campinos and the outstanding support of WIPO Assistant Director General Ernesto Rubio. INTA was in favor of the proposed amendments to the Common Regulations, which would improve the flow of information on the fate of territorial extensions under the Madrid system and offer a framework for further improvements of the system.

15. The Assembly took the following decisions concerning the Common Regulations, with a date of entry into force of September 1, 2009:

(i) adopted new Rules 18*bis*, 18*ter* and 40(5), accompanied by the footnote to new Rule 18*ter*, as set out in Annex I of document MM/A/40/1;

(ii) modified its interpretative statement presently referring to current Rule 17(6)(a)(ii) and (iii) so that it refers to new Rule 18*bis*;

(iii) modified its interpretative statement presently referring to current Rule 17(5)(b) so that it refers to new Rule 18*ter*;

(iv) adopted the amendments to Rules 16, 17, 24, 28, 32 and 36, accompanied by the footnote to paragraph (1)(b) of amended Rule 16, as set out in Annex I of document MM/A/40/1.

Proposal for a Study on the Possible Introduction of “Filing Languages” in the Madrid System

16. The Assembly considered document MM/A/40/2.

17. The Delegation of Egypt expressed its support for the conducting of a study on the introduction of additional languages in the Madrid system. The Delegation stressed that the objective of the Arab-speaking countries was to introduce Arabic not only as a filing language in the Madrid system but, in the longer term, as a language on equal footing with respect to the other working languages of the system.

18. The Delegation of Brazil expressed its support for the conducting of the proposed study, which would facilitate the accession of Portuguese-speaking countries to the system and pointed out that the additional translation costs would be compensated by the increased use of the system.

19. The Delegation of Morocco associated itself with the statement of the Delegation of Egypt and expressed its support for the conducting of the proposed study.

20. The Delegation of the Russian Federation stated that it considered the possible introduction of additional filing languages in the Madrid system to be a crucial issue. The Delegation expressed its interest in discussing the extension of the working languages and introducing additional languages for publication purposes. The Delegation expressed its

support for the conducting of the proposed study, particularly, in relation to the Russian language.

21. The Delegation of Mozambique expressed its support for the conducting of the proposed study. The Delegation observed that having Portuguese as a filing language would enhance the use of the Madrid system in Portuguese-speaking countries.

22. The Delegation of China stated that the introduction of Chinese as a filing language would eliminate language barriers for applicants from China and increase the number of users of the Madrid system. The Delegation expressed its support for the conducting of the proposed study on the introduction of other working languages of WIPO in the Madrid system.

23. The Delegation of Oman, noting that improvement of communication was a key point in the Director General-Elect Francis Gurry's acceptance speech of September 22, 2008, stressed that languages were an important component of effective communication. The Delegation expressed its support for the statement of the Delegation of Egypt.

24. The Delegation of Portugal expressed its support for the conducting of the proposed study.

25. The Delegation of Japan indicated that it supported the idea of conducting a study but that, with a view to taking into account factors such as potential increase of operational costs, it could be useful if a comparative appraisal included languages other than just the four mentioned in document MM/A/40/2. Referring to the discussion in the PCT Union Assembly, the Delegation of Japan also suggested that the International Bureau consider other statistical figures, such as the number of international applications, estimated domestic filings and the number of native speakers.

26. The Delegation of Algeria concurred with the position of the Delegation of Egypt.

27. The Delegation of Spain shared the opinion of other delegations and supported the conducting of the proposed study.

28. The Delegation of the United States of America welcomed and supported the proposal for a study on the inclusion of additional languages in the Madrid system. The Delegation stressed, however, the need to remain cautious about the implications of adding languages to an already complex system. The Delegation expressed its interest in determining what types of costs would be incurred.

29. The Delegation of Sudan expressed its support for the statement of the Delegation of Egypt.

30. The Delegation of Italy stated that it was in favor of an enlargement of the linguistic regime of the Madrid system. Referring to the complexity of the Madrid system, the Delegation said that adding other languages to the system should not result in the use of any additional languages being imposed on an office.

31. The Delegation of France expressed its support for the conducting of the proposed study and stressed that a complete study on the implications of the proposed linguistic regime should be carried out.

32. The Representative of INTA welcomed any measure that would facilitate access to the international registration system by a larger number of potential users and would promote the accession to the Madrid Protocol by a larger number of jurisdictions while maintaining the cost effectiveness of the system. The Representative stated that INTA would stand ready to positively contribute its views to the proposed study.

33. The Assembly took note of document MM/A/40/2 and agreed that the Secretariat conduct a study on the introduction of additional filing languages in the Madrid system.

Information Technology Modernization Program: Status Report

34. The Assembly considered document MM/A/40/3.

35. The Assembly took note of the status report as contained in that document.

Madrid Union Building – Mortgage

36. The Assembly considered document MM/A/40/4.

37. The Assembly approved that the mortgage of the Madrid Union building be reimbursed and the corresponding amount drawn from the Union's Reserve Fund, as proposed in document MM/A/40/4.

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