

Special Union for the International Registration of Marks (Madrid Union)

Assembly

**Forty-Eight (28th Extraordinary) Session
Geneva, September 22 to 30, 2014**

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/54/1): 1, 3, 4, 5, 6, 10, 12, 19, 26 and 27.
2. The report on the said items, with the exception of item 19, is contained in the General Report (document A/54/13).
3. The report on item 19 is contained in the present document.
4. Mrs. Grace Issahaque (Ghana), Chair of the Assembly, presided over the meeting.

ITEM 19 OF THE CONSOLIDATED AGENDA

MADRID SYSTEM

5. Discussions were based on documents MM/A/48/1, MM/A/48/2 and MM/A/48/3.
6. The Chair opened the session and invited the Secretariat to present the documents.

Information Technology Modernization Program (Madrid International Registration System): Progress Report

7. Discussions were based on document MM/A/48/1.
8. The document outlines the progress made in the Information Technology (IT) Modernization Program since the last session of the Madrid Union Assembly.
9. The Secretariat stated that the focus had been on the delivery of Phase II of the IT Modernization Program, that a delivery for this component had been received from the external implementation partner and that it was being subject to system testing by internal technical staff.
10. The Secretariat also stated that an implementation review had been initiated to take into account the new challenges currently faced by the Madrid Registry and to ensure the undertaking of all the necessary preparations for system deployment. The Secretariat further indicated that this independent validation and verification exercise had commenced in August, that it would be completed in October 2014 and that, upon its completion, the Secretariat would be able to determine the deployment date of Phase II of the IT Modernization Program.
11. The Assembly took note of the content of the Progress Report on the Information Technology Modernization Program (Madrid International Registration System).

Madrid System Goods and Services Database: Progress Report

12. Discussions were based on document MM/A/48/2.
13. The document outlines the progress made in the operational status of the Madrid Goods and Services Database (MGS) since the last session of the Madrid Union Assembly.
14. The Secretariat stated that the focus had been on the operational support of MGS and that the database was available in 16 languages, enabling users to verify the acceptance of terminology by the Offices of the Contracting Parties of the Madrid System for the International Registration of Marks (hereinafter referred to as “the Madrid System”). The Secretariat remarked that MGS was being used by Offices and applicants all over the world.
15. The Secretariat proposed that the remaining funds from the development project continued to be used for facilitating translation activities regarding MGS.
16. The Delegation of India recalled that the Offices of several Member States were developing detailed classification systems of indications of goods and services and requested that those systems be taken into account and further studied.

17. The Assembly:

- (i) took note of the content of the Progress Report of the Madrid System Goods and Services Database, including its paragraph 26 related to the remaining project funds; and
- (ii) requested that the International Bureau submit to the Madrid Union Assembly in 2015 a new progress report of the Madrid System Goods and Services Database, including the use of remaining project funds.

Proposed Amendments to the Common Regulations Under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement

18. Discussions were based on document MM/A/48/3.

19. Upon invitation by the Chair, the Secretariat introduced the document which contains three proposals for amendments to 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”), as recommended by the Working Group on the Legal Development of the Madrid System for the International Registration of Marks, for their adoption by the Madrid Union Assembly.

20. The Secretariat indicated that the first proposal concerned a new Rule *5bis* which would introduce continued processing, as a relief measure, where an applicant or holder had failed to meet a time limit for an action in a procedure before the International Bureau.

21. The Secretariat said that the request for continued processing would have to be presented directly to the International Bureau within two months, counted from the date of the expiry of the time limit concerned, accompanied by a proposed fee of 200 Swiss francs, and that the applicant or holder would have to comply with all the requirements for the procedure in respect of which continued processing was being sought. The Secretariat indicated that, where all the previous conditions were met, the International Bureau would continue processing the relevant application or request for the recording of a change and that, otherwise, the application or request would remain abandoned.

22. The Secretariat stated that the proposed amendments to Rules *20bis* and 27 clarify the date of recording of a license or a change of the international registration, where continued processing had been granted. The Secretariat also clarified that the reference at the end of proposed new paragraph (3)(c) of Rule *20bis*, concerning the time limit specified, should read “(2)(b)”.

23. The Secretariat indicated that the second proposal dealt with amendments to Rule 30 and that it would introduce the principle of partial renewal, which would allow the holder to renew his international registration only for the goods and services protected in a designated Contracting Party, without having to previously request the recording of a limitation in respect of that Contracting Party.

24. The Secretariat said that the last proposal would introduce amendments to Rule 31(4) to provide for the notification to the holder and his representative, if any, when an international registration had not been renewed.

25. The Delegation of India noted that, under its national trademark system, there was a provision and a specific form to request the deletion of certain classes, where an applicant did not wish to continue with all the classes, further indicating that, following the deletion of certain classes, he could renew the remaining classes.

26. The Assembly adopted new Rule 5*bis* and the amendments to Rules 20*bis*, 27, 30 and 31 of the Common Regulations, as well as the amendments of the Schedule of Fees, with a date of entry into force of January 1, 2015, as set out in the Annexes to document MM/A/48/3 and according to the clarification made by the Secretariat.

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