

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

Assembly

Fifty-Fourth (31st Extraordinary) Session Geneva, September 21 to 25, 2020

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/61/1): 1, 2, 4, 5, 6, 8, 10(ii), 11, 13, 21 and 22.
2. The reports on the said items, with the exception of item 13, are contained in the General Report (document A/61/10).
3. The report on item 13 is contained in the present document.
4. In the absence of the Chair of the Assembly, Mr. Philippe Cadre (France), Vice-Chair of the Assembly, presided over the meeting.

ITEM 13 OF THE CONSOLIDATED AGENDA

MADRID SYSTEM

5. Discussions were based on document MM/A/54/1.

6. The Secretariat indicated that document MM/A/54/1 proposed amendments to Rules 3, 9, 25 and 36 of the Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as “the Regulations” and the “Protocol”) that would require users to indicate an e-mail address. The Secretariat explained that, after the WIPO premises were evacuated in March 2020, it quickly became clear that, while normal examination outputs could be maintained in the home working environment, the International Bureau was faced with a huge challenge to ensure that users who had not provided e-mail addresses could continue receiving key legal notifications despite the disruptions in the traditional paper-based postal delivery services throughout the world. Through a host of measures, the International Bureau succeeded in mitigating this risk, but a significant number of international registrations still lacked an e-mail address. With COVID-19 remaining a major concern and ongoing disruptions of postal services in many countries, failure to provide an e-mail address placed the interests of users unduly at risk. For this reason, the Secretariat proposed making the indication of an e-mail address a mandatory requirement, which was reflected in the proposed amendments to the Regulations that would enter into force on February 1, 2021, as detailed in the document under consideration. The Secretariat also explained that, under the proposed amendments, where the e-mail address was missing, but there were otherwise indications in the international application sufficient to contact the applicant, the International Bureau would issue an irregularity notice, which the applicant could remedy within the given time limit. Such irregularity would not have an impact on the possible date of the international registration. Finally, the Secretariat indicated that the implementation of the proposed amendments would normally not require any significant technical development by the Offices of the Contracting Parties.

7. The Delegation of China recalled that the COVID-19 pandemic had severely disrupted global postal and delivery services, and that, to avoid any negative impact on users when receiving notifications from the International Bureau, the document under consideration proposed amendments to the Regulations to collect e-mail addresses from users. The Delegation expressed its support for the adoption of the proposed amendments, as they would help to address the challenges brought by the current pandemic, as well as other possible emergencies, and would protect effectively the interests of the users.

8. The Delegation of the United Kingdom, speaking on behalf of Group B, indicated that it was undeniably useful to adapt working practices to take full advantage of technology, as this could support intellectual property (IP) offices to manage their workload and provide users of the IP system with clarity in the challenging circumstance presented by emergencies, such as the COVID-19 pandemic. The Delegation stated that the new requirement would help the International Bureau to communicate with users in a timely, resilient and efficient manner, allow IP offices to communicate effectively and provide for service continuity during difficult times, while enabling a more efficient communication outside times of crisis. The Delegation highlighted the fact that privacy concerns had been taken into consideration in the preparation of the proposed amendments. The Delegation said that Group B supported the adoption of the proposed amendments and welcomed further discussions on how to deal with emergencies during the upcoming session of the Working Group on the Legal Development of the Madrid System for the International Registration of Marks (hereinafter referred to as, respectively, “the Working Group” and “the Madrid System”).

9. The Delegation of Zimbabwe, speaking on behalf of the African Group, expressed its support for the adoption of the proposed amendments, as they would expedite the international registration process. The Delegation wondered whether it would have been appropriate also to extend the obligation to indicate an e-mail address to all requests, such as, for example, renewal or requests for the recording of change in the name or address of the holder.
10. The Delegation of the Russian Federation, speaking on behalf of the Group of Central Asian, Caucasus and Eastern European Countries (CACEEC), expressed its support for the adoption of the proposed amendments. The Delegation said that, in view of the disruptions in postal and delivery services during the pandemic, the requirement to indicate an e-mail address had become quite important. Electronic, as the default means of communication, would ensure fast delivery, without resulting in delays to respond to important communications, such as notifications of provisional refusal or of irregularities sent by the International Bureau, for which the time-limit to respond was calculated from the date on which they were sent. The Delegation underscored that the proposed amendments were in accordance with the present practice and preference of users, as evidenced by the fact that most users had already indicated an e-mail address. The Delegation added that the CACEEC Group anticipated the resumption of discussions by the Working Group in the near future and looked forward to continuing its work on the development of the language regime. The Delegation said that it expected that a comprehensive study would help the Working Group consider the issue of the gradual introduction of new languages into the Madrid System.
11. The Delegation of Colombia acknowledged the efforts made by the International Bureau to ensure users benefited from receiving electronic communications, which were of the utmost importance under the existing circumstances. The Delegation expressed its support for the adoption of the proposed amendments because electronic was a secure and efficient mean to transmit, in particular, time-sensitive communications. The Delegation added that the proposed amendments would deliver important benefits for users of the Madrid System, strengthen electronic services and simplify access and management of the system. The Delegation stated that the proposed amendments were a decisive step towards consolidating the Madrid System.
12. The Delegation of the Russian Federation aligned itself with the statement made on behalf of the CACEEC Group and expressed its support for the adoption of the proposed amendments, as they would simplify the work of the International Bureau and ensure effective communication with users, even during disruptions in postal services. The Delegation recalled that, in the spring of 2020, its Office had assisted the International Bureau to identify missing e-mail addresses for Madrid System users from the Russian Federation. The Delegation highlighted the need to reduce the risk of a recurrence of similar situations in the future and said that it shared the view that it would be preferable to send communications electronically to promptly inform users. The Delegation expressed its hope for the resumption, in the near future, of discussions by the Working Group, which had been postponed due to the COVID-19 pandemic. The Delegation said that it looked forward to the results of the additional study on the introduction of new languages and relied on continued work by the Working Group on this important subject.
13. The Delegation of the Republic of Korea supported the adoption of the proposed amendments in light of the difficulties the International Bureau had encountered to mail physical communications to the users of the global IP services during the COVID-19 pandemic and because similar emergencies may occur in the future. The Delegation added that the proposed amendments would improve the efficiency in the delivery of services and facilitate the sending of communications from the International Bureau to applicants, holders and their representatives.

14. The Delegation of the European Union, speaking on behalf of the European Union and its member states, expressed its support for the adoption of the proposed amendments because they constituted a positive step forward in the modernization of the Madrid System.

15. The Delegation of France aligned itself with the statements made by the Delegations of the United Kingdom, on behalf of Group B, and of the European Union and expressed its support for the adoption of the proposed amendments. The Delegation stated that ensuring the continued proper functioning of the Madrid System was of the utmost importance to provide the best service for its users, and added that preserving the exchange of communications between users and Offices, especially in times of crisis, was part of that service. The Delegation underscored that the issue at hand was a question of simplifying and modernizing the exchange of communications and the IP system, and said that it was pleased that the question of e-mail privacy, to which France attached the highest importance, had been duly taken into account.

16. The Delegation of Japan aligned itself with the statement delivered by the Delegation of the United Kingdom, on behalf of Group B, and stated that it basically supported the proposed amendments policy. The Delegation added that, in light of the recent experience with the COVID-19 pandemic, the proposed amendments would benefit communication between users and the International Bureau in case of suspension of international mail services. The Delegation noted that many users still preferred to receive communications for international registrations by postal services and stated that, to avoid excessive inferences, lack of indication of e-mail addresses should not fall within the scope of the irregularities affecting the date of the international registration, under Rule 15(1) of the Regulations. The Delegation said it looked forward to coordinating with the International Bureau, at the administrative level, on specific operations to take into account during the implementation of the proposed amendments.

17. The Delegation of Afghanistan recalled that, on March 6, 2018, the Government of the Islamic Republic of Afghanistan had deposited the instrument of accession to the Protocol making Afghanistan the 101st member of the Madrid System. The Protocol had entered into force in respect of Afghanistan on June 26, 2018. As from that date, local brand owners in Afghanistan could use the Madrid System to protect their marks in the territories of the other 100 members, by filing a single international application and paying a single set of fees. With the straightforward designation process provided for by the Madrid System, foreign companies from across the globe, including from important origins, such as, the United States of America, Kazakhstan and India, could also easily seek protection for their trademarks when selling their products and services in Afghanistan. The membership of Afghanistan highlighted the ongoing expansion of the Madrid System across the region and solidified it as a key component for protecting marks internationally. The Delegation added that, to implement the Madrid System well, a number of issues needed serious attention: becoming a member of the Protocol but not fully joining the Madrid System; in addition, a user had not yet filed a trademark application for international registration in Afghanistan; finally, full training and financial support for the IP office was required. The Delegation reiterated the commitment of Afghanistan to the principles of IP and expressed its hope for the continued support of WIPO.

18. The Delegation of Canada aligned itself with the statement delivered by the Delegation of the United Kingdom, on behalf of Group B, and expressed its support for the adoption of the proposed amendments, which were certainly of the essence and made clearly necessary in light on the experience of the previous winter. The Delegation added that the proposed amendments were a positive step forward in the further modernization of the Madrid System.

19. The Madrid Union Assembly adopted the amendments to Rules 3, 9, 25 and 36 of the Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, as set out in the Annex to document MM/A/54/1.

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