

WIPO



MM/A/42/4

ORIGINAL: English

DATE: October 1, 2009

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

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

ASSEMBLY

**Forty-Second (18th Ordinary) Session
Geneva, September 22 to October 1, 2009**

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/47/1): 1, 2, 3, 4, 5, 10, 12, 13, 14, 15, 16, 17, 18, 19, 31, 39 and 40.
2. The report on the said items, with the exception of item 31, is contained in the General Report (A/47/16).
3. The report on item 31 is contained in the present document.
4. Mr. Adil El Maliki (Morocco), was elected Chair of the Assembly;
Ms. Zhang Huan (China) and Mr. Matti Pääts (Estonia) were elected Vice-Chairs.

E

ITEM 31 OF THE CONSOLIDATED AGENDA:

MADRID SYSTEM

5. Discussions were made on the basis of documents MM/A/42/1, 2 and 3.

Study on the Introduction of Additional Filing Languages in the Madrid System

6. In introducing document MM/A/42/1, the Secretariat recalled that the Working Group on the Legal Development of the Madrid System (hereinafter referred to as “the Working Group”) had held its seventh session, in July 2009, under the chairmanship of Mr. António Campinos (Portugal) and had examined a preliminary version of the study on the introduction of additional filing languages in the Madrid system. The study had been prepared by the International Bureau following the mandate received from the Assembly at its meeting in 2008.

7. The Secretariat further stated that document MM/A/42/1 contained an updated version of the study, which was being submitted for consideration by the Assembly. The Assembly was being invited to take note of the study and to instruct the International Bureau to undertake a pilot project in cooperation with interested offices. The pilot project would assist in verifying the feasibility of implementing the procedures proposed for the introduction of new filing languages. In due course, the International Bureau would report the results of the pilot project to the Working Group and to the Assembly.

8. Mr. António Campinos, Head of the Delegation of Portugal, in his capacity as Chair of the Working Group, thanked the delegations represented at the Working Group session of July 2009 for the cordiality, professionalism and expediency with which the work of the Working Group had been conducted. He also expressed his thanks to the Secretariat for their work in assisting the Working Group.

9. Referring to the study contained in document MM/A/42/1, Mr. Campinos recalled the mandate of the Assembly of the Madrid Union regarding the possible introduction of new filing languages in the Madrid system. He said that the introduction of new filing languages would lead to the creation of linguistic diversity, expansion of opportunities, and would bring about greater economic viability and encompass new members in the Madrid system. Mr. Campinos then outlined the principal elements of the results of the study and reiterated the pre-requisites for the acceptance of filings in a non-working language, as well as the procedure that was being proposed in the study.

10. Referring to the pilot project, Mr. Campinos recalled that it had been understood by the Working Group that the project would commence in 2010, and that any one of the proposed languages meeting the requirements as set out in the study could participate. He noted that, as a first stage, it would be necessary to complete the translation of the database of acceptable indications of goods and services into the filing language concerned and the establishment of the necessary interface for the transmission of international applications, all of which had been set out in the results of the study. At a later stage, there would be an assessment of the results of the pilot project.

11. The Delegation of Croatia expressed its support for any initiative aimed at encouraging increased participation by users of the Madrid system and intellectual property systems in general. However, it wished to express its concerns regarding the reasoning and conclusions of the study. First, when analyzing the implications of the introduction of additional languages on the volume of required additional translations and consequently increased operational costs of the International Bureau, the Delegation noted that the study took into account only the current, and in some cases very low, numbers of international applications. For this reason, the Delegation said that it considered the presented calculation to be of questionable validity. Moreover, in view of the distinct advantages, in terms of rationalization and efficiency, that would result once the proposed database of acceptable indications of goods and services had become fully operational, the Delegation questioned why the possibility of introducing additional filing languages should be limited to those mentioned in the study. After all, the conclusion in the study that users of the Madrid system, and in particular, small- and medium-sized enterprises, would welcome the possibility of being able to file an international application under the Madrid system through the medium of their own language and in the same language of the basic application or registration was valid universally, regardless of any particular language or Contracting Party. For this reason, the Delegation expressed its support for the proposed pilot project and indicated that, should the pilot project confirm that the introduction of additional filing languages had been efficient and economically viable, the possible additional filing languages should not be limited to those languages indicated in the study. It should be open to all interested Contracting Parties. Should this lead to difficulties in the context of the resources of the International Bureau, then the Delegation of Croatia was of the view that, in terms of selection of additional filing languages, priority should be set by reference to the actual number of the speakers of any given language among the Contracting Parties of the Madrid system.

12. The Delegation of Denmark noted that, at the time of the meeting of the Working Group in July 2009, the Delegation had not held a mandate concerning the proposed introduction of new filing languages, nor had it had the opportunity to consult its users on the issue. It said that it had, however, expressed its concerns regarding the economic impact of the introduction of additional filing languages in the Madrid system. The Delegation confirmed that it had now consulted its users and a substantial number of users had expressed doubt that the introduction of additional filing languages would offer any added value for users, and concern that it might involve an additional work burden for both users and national offices. In particular, the need for additional translation was envisaged as likely to be time-consuming and expensive, as well as the building and maintenance of the databases. The Delegation expressed the view that the strength of the Madrid system was that it operated in a few languages. The Delegation emphasized the importance for its users and for its office, that the costs of additional translation would not have an impact on either the amount of fees or the processing time for applications. Nevertheless, the Delegation stated that it looked forward to the establishment of the pilot project, which would be thoroughly evaluated, in terms of outcome and impact.

13. The Delegation of China expressed its support for the introduction of new filing languages and the undertaking of the pilot project. The Delegation noted that in terms of the number of filings, its country was currently one of the most significant countries in the world, but ranked only eighth in the context of filings under the Madrid system. The Delegation believed that one of the main reasons for that was the language barrier. For this reason, the

Delegation believed that if Chinese were to be introduced as a filing language under the Madrid system, the volume of filings originating from China would increase. It therefore expressed the hope that at a later stage Chinese, and other languages, would be introduced as additional filing languages of the Madrid system.

14. The Delegation of Switzerland noted that, as had been recalled in the study on the introduction of additional filing languages, around 76% of Swiss filing requests were submitted in German or Italian and in fact, this was also the case for international filings originating from Switzerland. For this reason, the Delegation believed that the proposal put forward in document MM/A/42/1 could be an interesting proposal for its applicants and the Delegation therefore supported taking forward the work in this area.

15. The Delegation of Italy also expressed its support for the pilot project and noted its interest in seeing Italian as one of the filing languages. The Delegation said that it would give further consideration to the issues as soon as the pilot project had been completed and evaluated.

16. The Delegation of the former Yugoslav Republic of Macedonia said that it wished to align its position with the statement that had been made by Croatia.

17. The Delegation of Norway expressed its support for the proposal, which, it said, might lead to increased use of the system, while safeguarding efficient procedures. Regarding the pilot project, the Delegation said that it was essential that there be a sound evaluation of costs and possible effects on processing time. The Delegation stated that it was particularly interested in underlining the important link to be established between the possible introduction of further filing languages and the construction of a fully operable database of acceptable indications of goods and services.

18. The Delegation of the United States of America said that it appreciated the creative and forward-thinking nature of the proposal, which provided for flexibility in filing languages, while keeping costs down by not increasing the working languages of the system. Moreover, the proposal relied heavily on information technology solutions to gain efficiencies in the system. The Delegation referred also to the use by national offices of "pick lists", which would provide great efficiencies, both for offices and applicants. The Delegation said that the proposal under discussion would encourage that use and it supported it.

19. The Delegation of the Russian Federation recalled that, at the Madrid Union Assembly session of September 2008, virtually all of the delegates had expressed support for the undertaking of a study on the possible introduction of new filing languages in the Madrid system. However, the Delegation wished it to be known that, to some extent, it was not in full agreement with the conclusions arrived at in the study. For instance, the procedure as outlined in the study appeared to be extremely complicated and, for this reason, the Delegation suggested that in the course of the next session of the Working Group the matter be considered again. However, the Delegation noted that its country had already indicated its preliminary agreement to participate in the pilot project. As far as it was possible to take the proposal forward, the Delegation confirmed its willingness to participate in the pilot project and to promote the development of the Madrid system. Having said that, the Delegation expressed the need to subsequently have a more detailed discussion on the manner in which international applications were submitted.

20. The Delegation of Sudan expressed its support and welcomed the proposal, especially with regard to the possible introduction of the Arabic language among the other languages being proposed. The Delegation spoke of the benefits that would accrue to small- and medium-sized enterprises if linguistic barriers were to be eliminated and said that the introduction of additional filing languages would ensure that maximum benefit could be drawn from the Madrid system.

21. Expressing its support for the proposal and the establishment of a pilot project, the Delegation of Australia said that the proposal being put forward was a holistic and creative approach to an important issue which could, if costs were contained as anticipated and service levels maintained, prove very beneficial to the operation of the Madrid system. The Delegation said that it therefore welcomed the addition of filing languages to the system on the dynamic and responsive basis proposed, as it believed that it would make the system more accessible to current users and potentially attract new members. The advantages to users of the Madrid system would increase as the membership and geographical coverage also increased.

22. In an observer capacity, the Delegation of Brazil expressed its pleasure at the proposed inclusion of Portuguese as an additional filing language, among the other languages being proposed, and spoke of the large number of persons who could benefit from the introduction of new filing languages, as well as the efficiencies that might result for the Madrid system.

23. The Assembly took note of the document and of the study on the possible introduction of additional filing languages in the Madrid system, contained in Annex I of document MM/A/42/1. The Assembly mandated the International Bureau to undertake the pilot project recommended by the Working Group and to report its results to the Working Group and to the Assembly in due course.

Information Technology Modernization Program (Madrid and Hague International Registration Systems): Status Report and Proposed Next Steps

24. The Assembly:

(i) took note of the status of implementation of Phase I of the IT modernization program, as described in paragraphs 5 to 22 and Annex II of document MM/A/42/2;

(ii) approved the implementation of the remainder of Phase I and of Phases II and III of the IT modernization program within the 2010/11 biennium, as proposed in paragraphs 23, 30 and 34 to 43 of document MM/A/42/2; and

(iii) approved the financing of the remainder of Phase I and Phases II and III of the IT modernization program, as proposed in paragraph 49 of document MM/A/42/2.

Madrid System Database of Acceptable Indications of Goods and Services

25. The Delegation of Norway expressed its strong support for the project described in document MM/A/42/3, with the objective of accelerating the work on the establishment of the database of acceptable indications of goods and services and bringing online the Madrid Filing Assistant. The Delegation recalled that the Madrid Filing Assistant had been demonstrated to delegates during the course of the last session of the Working Group and that it had been met with enthusiasm, in particular with respect to its user-friendliness. In addition, the Delegation underlined the close linkage between the database and the filing-language projects.

26. The Delegation of Switzerland said that it welcomed any initiative that would improve the rapidity and the predictability of decisions taken in the course of the examination of lists of goods and services. The database that was being proposed by the International Bureau went in this direction, in particular when one considered the proposal by the International Bureau that, ultimately, the database would enable users to also establish the acceptability of certain goods and services in particular Contracting Parties. The Delegation said that it would be happy to cooperate with the International Bureau in this regard, and said that the exchange of data should be simple, rapid and free of charge in order to allow for the coordinated and speedy development of the database. The Delegation spoke also of the welcome that had generally been expressed for the Madrid Filing Assistant when it had been presented at the last session of the Working Group. The Delegation said that it would wish to have the necessary interface placed on the Madrid website as quickly as possible and wondered whether a firm date could not be given in that regard.

27. In response to the Delegation of Switzerland, the Secretariat said that it was planned to make the interface available as soon as possible during the course of 2010.

28. The Assembly considered the project proposed in document MM/A/42/3 and approved the allocation of an amount of 1.2 million Swiss francs from the Madrid Union Reserve Fund for the implementation of the project. The Assembly invited the International Bureau to report to the Assembly in 2010 on the status of the implementation of the project.

[End of document]