

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

**Fifteenth Session  
Geneva, June 19 to 22, 2017**

POSITION PAPER SUBMITTED BY THE DELEGATION OF THE UNITED KINGDOM

*Document prepared by the International Bureau*

1. In a communication dated May 19, 2017, the International Bureau received a position paper from the Delegation of the United Kingdom for consideration by the Working Group on the Legal Development of the Madrid System for the International Registration of Marks (hereinafter referred to as “the Working Group”), at its fifteenth session to be held in Geneva, from June 19 to 22, 2017. The Delegation of the United Kingdom has requested that the document be brought to the attention of the Working Group.
2. The said position paper is annexed to this document.

[Annex follows]

## Madrid System- UK Position Paper

### Background

1. Since its introduction, the Madrid System has been a huge success for both applicants and national offices. For applicants, the Madrid system offers a time efficient, simple way of obtaining trade mark registrations in their key markets. As a business grows or evolves, the System can be used to expand protection into new markets and the owner's portfolio of trade marks can be managed efficiently through one central system. For contracting offices the system represents the largest international regime for sharing work. The UK Intellectual Property Office and UK stakeholders value the Madrid System and believe that it plays an important role in supporting and encouraging innovation, and economic growth, in the contracting parties.
2. The Madrid System works well because of its flexibility and scale. It currently offers potential for protection in 114 territories through its 98 members. During the 2016 calendar year, the system saw the highest filing numbers to date, with a 7% increase over the previous year's filings.

### Summary

3. At the 14<sup>th</sup> session of the Madrid Working Group the Secretariat put forward the paper "The Future Development of the Madrid System for the International Registration of Marks"<sup>1</sup> (hereafter referred to as "the Future Paper"). The UK welcomes this paper, we believe that it is very useful and outlines many proposals that we can support. Consultation with our user groups also shows that UK users of the system support many of the proposals.
4. The Madrid system performs well, but we agree with the suggestion in the paper that we should look at ways in which the system can be further improved. The UK believes that increased harmonisation will lead to a simpler system that users have even more confidence in. Removing inconsistencies may also lead to an increased membership of the system.

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<sup>1</sup> Document MM/LD/WG/14/4 available at:  
[http://www.wipo.int/edocs/mdocs/madrid/en/mm\\_ld\\_wg\\_14/mm\\_ld\\_wg\\_14\\_4.pdf](http://www.wipo.int/edocs/mdocs/madrid/en/mm_ld_wg_14/mm_ld_wg_14_4.pdf)

5. The Future Paper represents a good way of ensuring that options for system improvement are presented, discussed and agreed amongst the contracting parties. This UK position paper follows on from the Future Paper. It puts forward our priorities and our views on the improvements that we believe could be made reasonably quickly and which would benefit users of the system, the International Bureau and national offices. We would be happy to discuss these proposals in further detail in advance of, or during, the next Madrid Working Group.

## **Proposals**

### ***Provision of clear deadlines of response in relation to WIPO notifications, with these listed on the front page of communication.***

6. As identified in the Future Paper, the time limits to respond to provisional refusals vary greatly between Contracting Parties: from 15 days to 15 months. We have received feedback from UK users of the system stating that it is also difficult to ascertain if dates are set by WIPO or by national offices. Both of these factors make it very difficult for them to work out their response dates. The ambiguity may result in them missing the chance to respond and may lead to marks being cancelled unnecessarily. Moreover, the confusion over deadlines of response can in turn, lead to additional work for the International Bureau and national offices if this results in applications requiring reinstatement.
7. We commend the International Bureau for its work in collating and clearly making available information regarding the procedures of different contracting parties for applications and registrations, including time limits for responding to provisional refusals<sup>2</sup>. We also acknowledge both the International Bureau and members' efforts in placing harmonisation of these time limits as a medium term priority for the Working Group, as addressed in the Future Paper and corresponding Road Map<sup>3</sup>. UK users have asked if the International Bureau could calculate the response periods and provide a clear date of reply on the front page of all communications.
8. Looking longer term, we believe that the proposals set out in the Future Paper are helpful. We would welcome discussions at the Working Group on the topic of harmonising deadlines across members of the Madrid System, with a view to providing increased certainty to users, offices and the International Bureau.

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<sup>2</sup> [http://www.wipo.int/madrid/en/members/ipoffices\\_info.html](http://www.wipo.int/madrid/en/members/ipoffices_info.html)

<sup>3</sup> Annex IV of document MM/LD/WG/14/6, "Summary by the Chair" available at: [http://www.wipo.int/edocs/mdocs/madrid/en/mm\\_ld\\_wg\\_14/mm\\_ld\\_wg\\_14\\_6.pdf](http://www.wipo.int/edocs/mdocs/madrid/en/mm_ld_wg_14/mm_ld_wg_14_6.pdf)

***Automatic deduction of second part fees when designating countries with this requirement.***

9. The Future Paper states that it has been more than 20 years since the last review of the Schedule of Fees took place. The Paper suggests that it is time for a new review, and that this should focus on a new payment option, particularly in relation to automated services. We fully support these proposals and the inclusion of fee revision and payment options in the agreed Road Map. We believe that a review of the fee schedule will ensure that payment processing within the Madrid System remains up-to-date and continues to support the best interests of users, national offices and the International Bureau itself.
  
10. An additional area of discussion between the UKIPO and UK stakeholders has been in relation to the payment of second part fees. We are aware that payment of the second fee can be easily overlooked and some users are not aware of the requirement. To help mitigate against this, we would like to suggest that an additional box could be added to the MM2 which would permit WIPO to automatically charge the applicant's account for the second fees. We would also like to propose that consideration is given to adding the pay reference to Romarin or its successor, Madrid Monitor, so that the user does not have to wait to receive the request on paper. We believe that this will also help reduce the burden for the International Bureau and for national offices as the payment information will be readily accessible, hence stopping the need for additional correspondence to the applicant.
  
11. As a longer term request, we would like to propose that discussions on the requirement of second part fees, and the role they play in the application process, should be included in any broader fee review. We would appreciate the opportunity to explore this topic further and would welcome views from other contracting parties and the WIPO Secretariat on this issue.

***Divergent practices around goods and services specification- potential for increased collaboration between WIPO and designated offices***

12. The Future Paper clearly notes the challenges around achieving harmonisation on specification due to the global divergence in practices. We acknowledge the valuable work the International Bureau has carried out regarding the Madrid Goods and Services Manager database. Additionally, in sharing their "Examination Guidelines Concerning the Classification of Goods and Services in International Applications"<sup>4</sup> to advise users and contracting parties of the principles applied by WIPO's trade mark examiners.

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<sup>4</sup> Available at  
[http://www.wipo.int/edocs/mdocs/madrid/en/mm\\_ld\\_wg\\_15\\_rt/mm\\_ld\\_wg\\_15\\_rt\\_classification\\_guidelines\\_ib.pdf](http://www.wipo.int/edocs/mdocs/madrid/en/mm_ld_wg_15_rt/mm_ld_wg_15_rt_classification_guidelines_ib.pdf)

As a complimentary strand to this work, we wish to highlight the potential for increased collaboration between WIPO and designated offices when assessing specifications. For example, we would be interested to hear if it would be possible for a mechanism to be introduced allowing the International Bureau to engage with designated offices and applicants, before determining that any additional fees are necessary for additional classes of goods/services.

13. We believe enhanced collaboration of this kind would allow users to get their funds in place before making any payment. Moreover, it could lead to efficiency savings for designated office's finance departments, alongside the International Bureau, as payments would be managed more effectively, thus leading to a reduction in avoidable contact.

***Universal provision of full statements of grant of protection from all contracting parties.***

14. We welcome the Future Paper's proposals regarding the possibility of providing users, upon request, with international registration certificates to reflect the status of a mark in each Contracting Party. We also wish to highlight that statements of grant of protection can be very helpful for users when attempting to enforce their rights in overseas markets. Where countries do not issue statements of grant of protection, users have to rely on information taken from the Romarin or Madrid Monitor databases, however we are aware that in some instances, this may not be considered as sufficient evidence. The Future Paper outlines that there are issues with the recognition and enforcement of Madrid marks in certain Contracting Parties and we have received feedback from UK users supporting this stating that they have faced difficulties when trading in certain markets.
15. Therefore, we suggest that member states should discuss whether members could commit to providing a full statement of grant of protection that is particular to the individual trade mark in question – these could replace the list of registration numbers issued by some members. .. A full statement of grant of protection could include all key information including the applicant/holder's details, the mark applied for, specification and dates of protection. We consider that it would be helpful for the statement to be made available in the three main languages (English, French and Spanish) and in the local language, for use with third parties, or before the courts, Customs and other authorities in any local disputes.

16. We believe that the universal provision of statements of grant of protection will strengthen the Madrid System and assist users to get the best value from their rights. As a consequence we believe that use of the system will increase further as applicants become more confident in the strength of their international rights.

***Option for requesting a search upon designation of the EU.***

17. We would like to propose that an option is introduced to request a search on designation of the EU. For example this could be provided for by the inclusion of a tick box upon the MM2 and MM4, where users could signal if they wanted a search to be completed (specifying the territories).

18. The addition of the box could enable the search fee, to be calculated with the application fees. We believe that this could streamline the current process, saving time for the International Bureau and national offices and helping prevent the applicant/representative from being faced with a request for any additional fees at the point of examination.

**Conclusions**

Once again the UK would like to thank the secretariat for preparing such a thoughtful paper. The Madrid System has been and is a huge success. The UK looks forward to discussing with the IB, other member states and users of the system, how the international trade system can be further improved. This paper outlines some options and our preliminary thoughts on them but the UK is of course open to discussing other options and priorities.

Paper submitted May 2017

[End of Annex and of document]