

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

**Seventeenth Session  
Geneva, July 22 to 26, 2019**

### **SUMMARY BY THE CHAIR**

*adopted by the Working Group*

1. The Working Group on the Legal Development of the Madrid System for the International Registration of Marks (hereinafter referred to as “the Working Group”) met in Geneva from July 22 to 26, 2019.
2. The following Contracting Parties of the Madrid Union were represented at the session: African Intellectual Property Organization (OAPI), Albania, Algeria, Australia, Austria, Bahrain, Belarus, Brazil, Bulgaria, Canada, China, Colombia, Cuba, Czech Republic, Denmark, Egypt, Estonia, European Union (EU), Finland, France, Georgia, Germany, Greece, Hungary, India, Indonesia, Iran (Islamic Republic of), Israel, Italy, Japan, Kenya, Lao People's Democratic Republic, Latvia, Lithuania, Madagascar, Mexico, Morocco, New Zealand, Norway, Oman, Poland, Portugal, Republic of Korea, Republic of Moldova, Romania, Russian Federation, Singapore, Spain, Sudan, Sweden, Switzerland, Tadjikistan, Turkey, Ukraine, United Kingdom, United States of America, Viet Nam (57).
3. The following States were represented as observers: Bangladesh, Pakistan, Saudi Arabia, Sri Lanka, Trinidad and Tobago, United Arab Emirates (6).
4. Representatives of the following international intergovernmental organizations took part in the session in an observer capacity: Benelux Organization for Intellectual Property (BOIP), General Secretariat of the Andean Community, World Trade Organization (WTO) (3).

5. Representatives of the following international non-governmental organizations took part in the session in an observer capacity: China Council for the Promotion of International Trade (CCPIT), European Brands Association (AIM), European Communities Trade Mark Association (ECTA), International Trademark Association (INTA), Japan Intellectual Property Association (JIPA), Japan Patent Attorneys Association (JPAA), Japan Trademark Association (JTA), MARQUES – Association of European Trade Mark Owners, The Chartered Institute of Trade Mark Attorneys (CITMA) (9).

6. The list of participants is contained in document MM/LD/WG/17/INF/1 Prov. 2.

#### **AGENDA ITEM 1: OPENING OF THE SESSION**

7. Ms. Wang Binying, Deputy Director General, Brands and Designs Sector, World Intellectual Property Organization (WIPO) opened the session and welcomed the participants.

#### **AGENDA ITEM 2: ELECTION OF THE CHAIR AND TWO VICE-CHAIRS**

8. Mr. Steffen Gazley (New Zealand) was elected as Chair of the Working Group, Ms. Mathilde Manitra Soa Raharinony (Madagascar) and Ms. Constance Lee (Singapore) were elected as Vice Chairs.

9. Ms. Debbie Roenning acted as Secretary to the Working Group.

#### **AGENDA ITEM 3: ADOPTION OF THE AGENDA**

10. The Working Group adopted the draft agenda (document MM/LD/WG/17/1).

11. The Working Group took note of the electronic adoption of the report of the sixteenth session of the Working Group.

#### **AGENDA ITEM 4: REPLACEMENT**

12. Discussions were based on document MM/LD/WG/17/2.

13. The Working Group:

(i) agreed to recommend to the Madrid Union Assembly the adoption of the amendments to Rule 21 of the Regulations Under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to, respectively, as “the Regulations” and “the Protocol”), as set out in Annex I to the present document, with February 1, 2021, as the date for their entry into force;

(ii) requested the International Bureau to prepare a document, for discussion at its next session, proposing a possible further amendment to Rule 21 of the Regulations concerning the partial replacement of a national or regional registration by an international registration.

**AGENDA ITEM 5: OTHER PROPOSED AMENDMENTS TO THE REGULATIONS UNDER THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS**

14. Discussions were based on document MM/LD/WG/17/3.

15. The Working Group agreed to recommend to the Madrid Union Assembly the adoption of the amendments to Rules 25, 27*bis*, 30 and 40 of the Regulations, as set out in Annex II to the present document, with February 1, 2020, as the date for their entry into force.

**AGENDA ITEM 6: FINDINGS OF THE SURVEY ON ACCEPTABLE TYPES OF MARKS AND MEANS OF REPRESENTATION**

16. Discussions were based on document MM/LD/WG/17/4.

17. The Working Group took note of the findings of the survey on acceptable types of marks and means of representation presented in the document.

**AGENDA ITEM 7: NOTIFICATION OF PROVISIONAL REFUSAL – TIME LIMIT TO REPLY AND WAYS IN WHICH TO CALCULATE THAT TIME LIMIT**

18. Discussions were based on document MM/LD/WG/17/5.

19. The Working Group requested the International Bureau to prepare a document, for discussion at its next session, on possible amendments to the Regulations providing for:

- (i) a minimum time limit to respond to a provisional refusal;
- (ii) a harmonized way in which to calculate the above-mentioned time limit;
- (iii) the possibility to delay the implementation of those new provisions for Contracting Parties requiring time to change their legal framework, practices or infrastructure;
- (iv) a stricter requirement to clearly indicate, in the notification of provisional refusal, either the end-date of the above-mentioned time limit or, if that is not possible, the way in which it should be calculated; and
- (v) electronic communication as the default mode for transmitting communications by the International Bureau to applicants, holders and representatives.

**AGENDA ITEM 8: POSSIBLE REDUCTION OF THE DEPENDENCY PERIOD**

20. Discussions were based on document MM/LD/WG/17/6.

21. The Working Group requested the International Bureau to prepare a document, for discussion at its next session, further exploring the possible reduction of the dependency period, from five to three years, and of the grounds for the ceasing of effect of the basic mark resulting in the cancellation of the international registration, as well as the possible elimination of the automatic effect of dependency.

**AGENDA ITEM 9: POSSIBLE OPTIONS FOR THE INTRODUCTION OF NEW LANGUAGES INTO THE MADRID SYSTEM**

22. Discussions were based on document MM/LD/WG/17/7 Rev.

23. The Working Group requested the International Bureau to prepare, for discussion at its next session, a comprehensive study of the cost implications and technical feasibility (including an assessment of the currently available WIPO tools) of the gradual introduction of the Arabic, Chinese and Russian languages into the Madrid System.

**AGENDA ITEM 10: POSSIBLE AMENDMENTS TO RULE 9 OF THE COMMON REGULATIONS UNDER THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS AND THE PROTOCOL RELATING TO THAT AGREEMENT**

24. Discussions were based on document MM/LD/WG/17/8.

25. The Working Group requested the International Bureau to prepare a document, for discussion at its next session:

(i) proposing changes to Rule 9 of the Regulations providing for new means of representing marks and introducing the necessary flexibilities that would allow applicants to meet different representation requirements in the designated Contracting Parties;

(ii) discussing the role of the Office of origin in the certification of the representation of the mark in the international application; and

(iii) addressing the practical implications of the above-mentioned changes on the information and communication technology infrastructure of the Offices and of the International Bureau, as well as enhancing access to information regarding acceptable types of marks and representation requirements.

**AGENDA ITEM 11: PROPOSAL BY THE DELEGATION OF SWITZERLAND**

26. Discussions were based on document MM/LD/WG/17/9.

27. The Working Group agreed to continue discussions on document MM/LD/WG/17/9, at its next session, focused on, but not limited to, the examination of limitations made in international applications.

**AGENDA ITEM 12: PROPOSAL BY THE DELEGATIONS OF ALGERIA, BAHRAIN, EGYPT, MOROCCO, OMAN, SUDAN, THE SYRIAN ARAB REPUBLIC AND TUNISIA**

28. Discussions were based on document MM/LD/WG/17/10.

29. The Working Group took note of the proposal contained in the document and referred to its decision under agenda item 9 in this regard.

**AGENDA ITEM 13: SUMMARY BY THE CHAIR**

30. The Working Group approved the Summary by the Chair, as amended to take account the interventions of a number of delegations.

**AGENDA ITEM 14: CLOSING OF THE SESSION**

31. The Chair closed the session on July 26, 2019.

[Annexes follow]

**PROPOSED AMENDMENT TO RULE 21 OF THE REGULATIONS UNDER THE PROTOCOL  
RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL  
REGISTRATION OF MARKS (DOCUMENT MM/LD/WG/17/2)**

**Regulations Under the Protocol Relating to the Madrid Agreement  
Concerning the International Registration of Marks**

(as in force on February 1, 2021)

[...]

*Rule 21*

*Replacement of a National or Regional Registration  
by an International Registration*

(1) [Request and Notification] From the date of the notification of the international registration or of the subsequent designation, as the case may be, the holder may present directly to the Office of a designated Contracting Party a request for that Office to take note of the international registration in its Register, in accordance with Article 4bis(2) of the Protocol. Where, ~~in accordance with Article 4bis(2) of the Protocol~~ following the said request, the Office of ~~a designated Contracting Party~~ has taken note in its Register, ~~following a request made direct by the holder with that Office,~~ that a national or a regional registration or registrations, as the case may be, has have been replaced by ~~an~~ the international registration, that Office shall notify the International Bureau accordingly. Such notification shall indicate

- (i) the number of the international registration concerned,
- (ii) where the replacement concerns only one or some of the goods and services listed in the international registration, those goods and services, and
- (iii) the filing date and number, the registration date and number, and, if any, the priority date of the national or regional registration or registrations which ~~has~~ have been replaced by the international registration.

The notification may also include information relating to any other rights acquired by virtue of that national or regional registration or registrations, ~~in a form agreed between the International Bureau and the Office concerned.~~

(2) [Recording] (a) The International Bureau shall record the indications notified under paragraph (1) in the International Register and shall inform the holder accordingly.

(b) The indications notified under paragraph (1) shall be recorded as of the date of receipt by the International Bureau of a notification complying with the applicable requirements.

(3) [Further Details Concerning Replacement] (a) Protection to the mark that is the subject of an international registration may not be refused, even partially, based on a national or regional registration which is deemed replaced by that international registration.

(b) A national or regional registration and the international registration that has replaced it shall be able to coexist. The holder may not be required to renounce or request the cancellation of a national or regional registration which is deemed replaced by an international registration and should be allowed to renew that registration, if the holder so wishes, in accordance with the applicable national or regional law.

(c) Before taking note in its Register, the Office of a designated Contracting Party shall examine the request referred to in paragraph (1) to determine whether the conditions specified in Article 4*bis*(1) of the Protocol have been met.

(d) The goods and services concerned with replacement, listed in the national or regional registration, shall be covered by those listed in the international registration.

(e) A national or regional registration is deemed replaced by an international registration as from the date on which that international registration takes effect in the designated Contracting Party concerned, in accordance with Article 4(1)(a) of the Protocol.

[Annex II follows]

**PROPOSED AMENDMENTS TO THE REGULATIONS UNDER THE PROTOCOL  
RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL  
REGISTRATION OF MARKS (DOCUMENT MM/LD/WG/17/3)**

**Regulations Under  
the Protocol Relating to the Madrid Agreement  
Concerning the International Registration of Marks**

(as in force on February 1, 2020)

[...]

**Chapter 5  
Subsequent Designations; Changes**

[...]

*Rule 25  
Request for Recording*

[...]

(4) *[Several Transferees]* Where the request for the recording of a change in the ownership of the international registration mentions several transferees, each of them must~~that change may not be recorded in respect of a given designated Contracting Party if any of the transferees does not~~ fulfill the conditions under Article 2 of the Madrid Protocol to be holder of the international registration ~~in respect of that Contracting Party.~~

[...]

*Rule 27bis  
Division of an International Registration*

[...]

(3) *[Irregular Request]* (a) If the request does not comply with the **applicable** requirements specified in paragraph (1), the International Bureau shall invite the Office that presented the request to remedy the irregularity and at the same time inform the holder.

(b) If the ~~irregularity is not remedied by the Office within three months from the date of the invitation under subparagraph (a), the request shall be considered abandoned and~~amount of the fees received is less than the amount of the fees referred to in paragraph (2), the International Bureau shall notify accordingly the ~~Office that presented the request~~holder, it shall inform and at the same time inform the ~~holder and refund any fee paid under paragraph (2), after the deduction of an amount corresponding to one-half of that fee~~Office that presented the request.

(c) If the irregularity is not remedied within three months from the date of the communication under subparagraph (a) or (b), the request shall be considered abandoned and the International Bureau shall notify accordingly the Office that presented the request, it shall inform at the same time the holder and refund any fee paid under paragraph (2), after the deduction of an amount corresponding to one-half of that fee.

[...]



[...]

## Chapter 6 Renewals

[...]

### Rule 30 Details Concerning Renewal

(1) *[Fees]* (a) [...]

[...]

(c) Without prejudice to paragraph (2), where a statement under Rule 18ter(2) or (4) has been recorded in the International Register for a Contracting Party in respect of which payment of individual fee is due under subparagraph (a)(iii), the amount of that individual fee shall be established taking into account the goods and services included in the said statement only.

(2) *[Further Details]* (a) [...]

(b) Where the holder wishes to renew the international registration in respect of a designated Contracting Party notwithstanding the fact that a statement of refusal under Rule 18ter is recorded in the International Register for that Contracting Party in respect of all the goods and services concerned, payment of the required fees, including the complementary fee or individual fee, as the case may be, for that Contracting Party, shall be accompanied by a statement by the holder that the renewal of the international registration is to be recorded in the International Register in respect of that Contracting Party for all the goods and services concerned.

(c) The international registration shall not be renewed in respect of any designated Contracting Party in respect of which an invalidation has been recorded for all goods and services under Rule 19(2) or in respect of which a renunciation has been recorded under Rule 27(1)(a). The international registration shall not be renewed in respect of any designated Contracting Party for those goods and services in respect of which an invalidation of the effects of the international registration in that Contracting Party has been recorded under Rule 19(2) or in respect of which a limitation has been recorded under Rule 27(1)(a).

~~(d) [Deleted] Where a statement under Rule 18ter(2)(ii) or (4) is recorded in the International Register, the international registration shall not be renewed in respect of the designated Contracting Party concerned for the goods and services that are not included in that statement, unless payment of the required fees is accompanied by a statement by the holder that the international registration is to be renewed also for those goods and services.~~

~~(e) The fact that the international registration is not renewed under subparagraph (d) in respect of all the goods and services concerned, shall not be considered to constitute a change for the purposes of Article 7(2) of the Protocol.~~ The fact that the international registration is not renewed in respect of all of the designated Contracting Parties shall not be considered to constitute a change for the purposes of Article 7(2) of the Protocol.

[...]

**Chapter 9**  
**Miscellaneous**

[...]

*Rule 40*  
*Entry into Force; Transitional Provisions*

[...]

(6) *[Incompatibility with National or Regional Laws]* If, on the date this Rule comes into force or the date on which a Contracting Party becomes bound by the Protocol, paragraph (1) of Rule 27*bis* or paragraph (2)(a) of Rule 27*ter* are not compatible with the national or regional law of that Contracting Party, the paragraph or paragraphs concerned, as the case may be, shall not apply in respect of this Contracting Party, for as long as it or they continue not to be compatible with that law, provided that the said Contracting Party notifies the International Bureau accordingly before the date this Rule comes into force or the date on which the said Contracting Party becomes bound by the Protocol. This notification may be withdrawn at any time.

[...]

[End of Annex II and of document]