

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

Twentieth Session
Geneva, November 7 to 11, 2022

SUMMARY BY THE CHAIR

approved 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 November 7 to 11, 2022.
2. The following Contracting Parties of the Madrid Union were represented at the session: African Intellectual Property Organization (OAPI), Algeria, Armenia, Australia, Austria, Azerbaijan, Bahrain, Belarus, Brazil, Bulgaria, Cabo Verde, Cambodia, Canada, Chile, China, Colombia, Croatia, Czech Republic, Democratic People’s Republic of Korea, Denmark, Egypt, Estonia, European Union, Finland, France, Gambia, Georgia, Germany, Greece, Hungary, Iceland, India, Indonesia, Iran (Islamic Republic of), Ireland, Israel, Italy, Jamaica, Japan, Kazakhstan, Kenya, Kyrgyzstan, Latvia, Lithuania, Madagascar, Malaysia, Mexico, Morocco, Namibia, New Zealand, North Macedonia, Norway, Oman, Pakistan, Philippines, Poland, Portugal, Republic of Korea, Republic of Moldova, Romania, Russian Federation, Samoa, Singapore, Slovakia, Spain, Sudan, Sweden, Switzerland, Syrian Arab Republic, Tajikistan, Thailand, Trinidad and Tobago, Tunisia, Türkiye, Ukraine, United Arab Emirates, United Kingdom, United States of America, Viet Nam (79).
3. The following States were represented as observers: Iraq, Kuwait, Mauritius, Peru, Saudi Arabia, Uganda, Yemen (7).
4. Representatives of the following international intergovernmental organization took part in the session in an observer capacity: Benelux Organization for Intellectual Property (BOIP), Eurasian Economic Commission (EEC) (2).

5. Representatives of the following international non-governmental organizations took part in the session in an observer capacity: *Association des praticiens du droit des marques et des modèles* (APRAM), *Association romande de propriété intellectuelle* (AROPI), Brazilian Association of Intellectual Property (ABPI), Centre for International Intellectual Property Studies (CEIPI), China Council for the Promotion of International Trade (CCPIT), China Trademark Association (CTA), European Communities Trade Mark Association (ECTA), German Association for the Protection of Industrial Property (GRUR), Intellectual Property Latin American School (ELAPI), International Trademark Association (INTA), Japan Intellectual Property Association (JIPA), Japan Patent Attorneys Association (JPAA), Japan Trademark Association (JTA), MARQUES - Association of European Trademark Owners, The Chartered Institute of Trade Mark Attorneys (CITMA) (15).

6. The list of participants is contained in document MM/LD/WG/20/INF/3.

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. LONG Kemvichet (Cambodia) was elected as Chair of the Working Group and Mr. Dustyn TAYLOR (Australia) was elected as Vice-Chair.

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/20/1 Prov. 3).

AGENDA ITEM 4: NEW GUIDE TO THE MADRID SYSTEM

11. Discussions were based on document MM/LD/WG/20/INF/1.

12. The Working Group took note of document MM/LD/WG/20/INF/1 and of the publication of the new version of the Guide.

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

13. Discussions were based on documents MM/LD/WG/20/2 and MM/LD/WG/20/2 Corr.

14. The Working Group agreed to recommend to the Madrid Union Assembly the adoption of the proposed amendments to Rules 21(3)(b), 23bis(1) and 32(1)(a)(xi) 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 November 1, 2024, as the date of their entry into force.

15. The Working Group agreed to continue its discussions, at the next session, on the following topics:

- (i) proposals concerning the entitlement requirement and the connection claim;
- (ii) clarification of the nature of the standard character declaration;
- (iii) reference to the alphabetical list of the Nice Classification;
- (iv) direct filing of requests for the recording of subsequent designations, changes and licenses;
- (v) requirement to notify ceasing of effect promptly; and
- (vi) notifying all parties concerned of recordings and modifications resulting from a declaration that a change in ownership has no effect.

AGENDA ITEM 6: PROVISIONAL REFUSAL

16. Discussions were based on document MM/LD/WG/20/3.

17. The Working Group agreed to recommend to the Madrid Union Assembly the adoption of the proposed amendments to Rules 17(2), (3) and (7), 18(1), 32(2) and new Rule 40(8) of the Regulations, as amended by the Working Group and as set out in Annex II to the present document, with November 1, 2023, as the date of their entry into force.

AGENDA ITEM 7: UPDATED INFORMATION ON THE TIME LIMIT TO RESPOND TO NOTIFICATIONS OF PROVISIONAL REFUSAL AND ON THE WAY TO CALCULATE THEM

18. Discussions were based on documents MM/LD/WG/20/INF/2 and MM/LD/WG/20/INF/2 Corr.

19. The Working Group took note of documents MM/LD/WG/20/INF/2 and MM/LD/WG/20/INF/2 Corr. and encouraged Offices of the Contracting Parties to carefully review these documents and to provide the International Bureau with updated information on this subject without delay.

AGENDA ITEM 8: DEPENDENCY

20. Discussions were based on document MM/LD/WG/20/4.

21. The Working Group:

- (i) agreed to maintain the topic of dependency on the agenda; and,
- (ii) requested the Secretariat to invite Contracting Parties, other WIPO Members States and observer organizations to submit proposals on other possible options regarding dependency for consideration at a later session of the Working Group.

AGENDA ITEM 9: THE POSSIBLE CONVENING OF A DIPLOMATIC CONFERENCE TO AMEND ARTICLE 6 OF THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

22. Discussions were based on document MM/LD/WG/20/5.

23. The Working Group agreed to continue discussing the possibility of convening a diplomatic conference to amend Article 6 of the Protocol, described in document MM/LD/WG/20/5, at a later session.

AGENDA ITEM 10: REPORT FOLLOWING THE REQUEST IN PARAGRAPH 23(II) AND (III) OF DOCUMENT MM/LD/WG/19/8 “SUMMARY BY THE CHAIR” (DOCUMENT MM/LD/WG/19/7 “REVISED STUDY OF THE COST IMPLICATIONS AND TECHNICAL FEASIBILITY OF THE GRADUAL INTRODUCTION OF THE ARABIC, CHINESE AND RUSSIAN LANGUAGES INTO THE MADRID SYSTEM AND OTHER RELEVANT INFORMATION”)

24. Discussions were based on document MM/LD/WG/19/7.

25. The Working Group:

(i) acknowledged the *Revised Study on the Cost Implications and Technical Feasibility of the Gradual Introduction of the Arabic, Chinese and Russian Languages into the Madrid System and other Relevant Information*, contained in document MM/LD/WG/19/7;

(ii) requested the International Bureau to continue to hold technical consultations with interested Contracting Parties of the Madrid Protocol and other WIPO Member States as well as with users' organizations, in particular regarding the elements mentioned in paragraph 38 of document MM/LD/WG/19/7 and report back to the Working Group, at its following session, on those consultations; and,

(iii) requested the International Bureau to prepare a document proposing a way forward in particular regarding the elements mentioned in paragraphs 39 to 60 of document MM/LD/WG/19/7, taking into account the above-mentioned consultations, to be discussed at the following session of the Working Group.

AGENDA ITEM 11: AN UPDATED ROAD MAP FOR THE EVOLUTION OF THE MADRID SYSTEM

26. Discussions were based on document MM/LD/WG/20/7.

27. The Working Group took note of document MM/LD/WG/20/7 and requested that the Secretariat prepare an updated version of the road map for the evolution of the Madrid System in preparation for its following session, taking into account the suggestions made by the Working Group during its twentieth session.

AGENDA ITEM 12: MADRID WORKING GROUP ROUNDTABLE

28. The International Bureau presented the Latest Developments in the Madrid Registry.

AGENDA ITEM 13: SUMMARY BY THE CHAIR

29. The Working Group approved the Summary by the Chair, as contained in the present document.

AGENDA ITEM 14: CLOSING OF THE SESSION

30. The Chair closed the session on November 11, 2022.

[Annexes follow]

ANNEX I: PROPOSED AMENDMENTS TO THE REGULATIONS UNDER THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

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

as in force on ~~November 1, 2022~~ November 1, 2024

[...]

Rule 21

Replacement of a National or Regional Registration by an International Registration

[...]

(3) *[Further Details Concerning Replacement]*

[...]

- (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~~shall be allowed to renew that registration, if the holder so wishes, in accordance with the applicable national or regional law.

[...]

[...]

Rule 23bis

Communications from the Offices of the Designated Contracting Parties Sent Through the International Bureau

(1) *[Communications Not Covered by These Regulations]* ~~Where the law of a designated Contracting Party does not allow the Office to transmit a communication concerning an international registration directly to the holder, that~~The Office of a designated Contracting Party may request the International Bureau to transmit ~~that~~ communications concerning an international registration to the holder on its behalf.

[...]

Rule 32
Gazette

(1) *[Information Concerning International Registrations]*

(a) The International Bureau shall publish in the Gazette relevant data concerning

[...]

(xi) information recorded under Rules 20, 20*bis*, 21, 21*bis*, 22(2)(a), 23 and 27(4)
[and \(5\)](#);

[...]

[Annex II follows]

ANNEX II: PROPOSED AMENDMENTS TO THE REGULATIONS UNDER THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

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

as in force on ~~November 1, 2022~~November 1, 2023
[...]

Rule 17 Provisional Refusal

[...]

(2) *[Content of the Notification]* A notification of provisional refusal shall contain or indicate

[...]

(v) where the grounds on which the provisional refusal is based relate to a mark which has been the subject of an application or registration and with which the mark that is the subject of the international registration appears to be in conflict, the filing date and number, the priority date, ~~(if any)~~, the registration date and number, ~~(if available)~~, the name ~~and address~~ of the owner and of the representative, if any, their addresses, if possible, and a reproduction~~7~~ of the former mark, together with the list of all or the relevant goods and services in the application or registration of the former mark, it being understood that the said list may be in the language of the said application or registration,

[...]

(vii) the time limit, ~~reasonable under the circumstances~~which shall be no less than two months¹, for filing a request for review of, or appeal against, the *ex officio* provisional refusal or the provisional refusal based on an opposition and, as the case may be, for filing a response to the opposition,

(viii) where the time limit referred to in paragraph (2)(vii) begins on a date other than the date on which the International Bureau transmits a copy of the notification to the holder or the date on which the holder receives said copy, preferably with an indication of the date on which the said time limit ~~expires~~ begins and ends,
~~and~~

(ix) the authority with which such request for review, appeal or response should be filed, ~~with~~and

(x) ~~the~~an indication, where applicable, that the request for review, the appeal or the response has to be filed through the intermediary of a representative whose address is within the territory of the Contracting Party whose Office has pronounced the refusal.

¹ In adopting this provision, the Assembly of the Madrid Union understood that Contracting Parties whose legislation provides for a time limit of 60 calendar or consecutive days meet the requirement specified in Rule 17(2)(vii).

- (3) *[Additional Requirements Concerning a Notification of Provisional Refusal Based on an Opposition]* Where the provisional refusal of protection is based on an opposition, or on an opposition and other grounds, the notification shall, in addition to complying with the requirements referred to in paragraph (2), contain an indication of that fact and the name ~~and address~~ of the opponent and of the representative, if any and, if possible, their addresses; however, notwithstanding paragraph (2)(v), the Office making the notification must, where the opposition is based on a mark which has been the subject of an application or registration, communicate the list of the goods and services on which the opposition is based and may, in addition, communicate the complete list of goods and services of that earlier application or registration, it being understood that the said lists may be in the language of the earlier application or registration.

[...]

- (7) *[Information Concerning the Time Limit to Respond to a Provisional Refusal]* Contracting Parties shall notify the International Bureau of the length of the time limit referred to in paragraph (2)(vii) and of the way in which this time limit shall be calculated.

Rule 18 **Irregular Notifications of Provisional Refusal**

(1) *[General]*

- (a) A notification of provisional refusal communicated by the Office of a designated Contracting Party shall not be regarded as such by the International Bureau

[...]

- (iii) if it is sent too late to the International Bureau, that is, if it is sent after the expiry of the time limit applicable under Article 5(2)(a) or, subject to Article 9sexies(1)(b) of the Protocol, under Article 5(2)(b) or (c)(ii) of the Protocol, from the date on which ~~the recording of the international registration or the recording of the designation made subsequently to the international registration has been effected, it being understood that the said date is the same as the date of sending~~ the International Bureau sent the notification of the international registration or of the designation made subsequently.
- (b) Where subparagraph (a) applies, the International Bureau shall nevertheless transmit a copy of the notification to the holder, shall inform, at the same time, the holder and the Office that sent the notification that the notification of provisional refusal is not regarded as such by the International Bureau, and shall indicate the reasons therefor.
- (c) If the notification
- (i) is not signed on behalf of the Office which communicated it, or does not otherwise comply with the requirements of Rule 2 or with the requirement applicable under Rule 6(2),
 - (ii) does not contain, where applicable, the details of the mark with which the mark that is the subject of the international registration appears to be in conflict (Rule 17(2)(v) and (3)),
 - (iii) does not comply with the requirements of Rule 17(2)(vi), or
 - (iv) ~~does not comply with the requirements of Rule 17(2)(vii), or~~ [Deleted]

- (v) [Deleted]
- (vi) does not contain, where applicable, the name and address of the opponent and the indication of the goods and services on which the opposition is based (Rule 17(3)),

the International Bureau shall, ~~except where subparagraph (d) applies,~~ nonetheless record the provisional refusal in the International Register. The International Bureau shall invite the Office that communicated the provisional refusal to send a rectified notification within two months from the invitation and shall transmit to the holder copies of the irregular notification and of the invitation sent to the Office concerned.

- (d) Where the notification does not comply with the requirements of Rule 17(2)(vii) to (x), the provisional refusal shall not be regarded as such and shall not be recorded in the International Register. The International Bureau shall inform the Office that communicated the provisional refusal of this fact, indicate the reasons therefor and transmit to the holder a copy of the defective notification. If However, if the Office sends a rectified notification is sent within the time limit referred to in subparagraph (e) two months from the date on which the International Bureau informed this Office of the defective notification, ~~the rectified notification~~ shall be regarded, for the purposes of Article 5 of the Protocol, as having been sent ~~to the International Bureau~~ on the date on which the defective notification had been sent to ~~it~~ the International Bureau [and shall be recorded in the International Register]. ~~If the notification is not so rectified, it shall not be regarded as a notification of provisional refusal. In the latter case, the International Bureau shall inform, at the same time, the holder and the Office that sent the notification that the notification of provisional refusal is not regarded as such by the International Bureau, and shall indicate the reasons therefor.~~
- (e) Any rectified notification shall, where the applicable law so permits, indicate a new time limit, ~~reasonable under the circumstances, and provide information, in accordance with Rule 17(2)(vii) to (x),~~ for filing a request for review of, or appeal against, the *ex officio* provisional refusal or the provisional refusal based on an opposition and, as the case may be, for filing a response to the opposition, ~~preferably with an indication of the date on which the said time limit expires.~~
- (f) The International Bureau shall transmit a copy of any rectified notification to the holder.

[...]

Rule 32 Gazette

[...]

- (2) *[Information Concerning Particular Requirements and Certain Declarations of Contracting Parties]* The International Bureau shall publish in the Gazette
 - (i) any notification made under Rules 7, 17(7), 20*bis*(6), 27*bis*(6) 27*ter*(2)(b) or 40(6) and (7) and any declaration made under Rule 17(5)(d) or (e);

Rule 40
Entry Into Force; Transitional Provisions

[...]

(8) [Transitional Provision Relating to Rules 17(2)(v) and (vii) and (3) and 18(1)(e)] Contracting Parties may continue to apply Rules 17(2)(v) and (vii) and (3) and 18(1)(e), as in force on November 1, 2021, until [February 1, 2025] or until a later date, provided the Contracting Party concerned sends a notification to the International Bureau before February 1, 2025, or before the date on which this Contracting Party becomes bound by the Protocol, whichever occurs later. The Contracting Party may withdraw the said notification at any time thereafter².

[End of Annex II and of document]

² In adopting this provision, the Assembly of the Madrid Union understood that Contracting Parties are not required to specify in the notification the date on which they will apply Rules 17(2)(v) and (vii) and 18(1)(e), as in force on November 1, 2023.