



European Communities Trade Mark Association

**ECTA 28<sup>th</sup> Annual Conference – 24-27 June in Vilnius, Lithuania**

## **A Trade Mark Symphony**

### **First Movement : The latest Music from the Main Players in the Trade Mark World**

Conductor : **Annick Mottet Haugaard**, First Vice President of ECTA, lawyer, Lydian, BE

Soloists : **Wubbo de Boer**, President of OHIM, ES

**Grégoire Bisson**, Head of International Registration Systems Legal Service, WIPO, CH

**Oliver Varhelyi**, Head of Unit D2 Industrial Property, DG Internal Market, EU Commission, BE

#### **Annick Mottet Haugaard**

First of all, thanks to all of you for accepting our invitation to participate to the first movement of our Trade Mark Symphony.

Intellectual property law has been receiving a growing amount of attention from the European Commission and it is increasingly viewed as a priority for economic development. In the last few years, various initiatives have been carried out by the Commission and, in most cases, the results have been positive.

Oliver, what are the next steps to be taken at European level regarding intellectual property?

#### **Oliver Varhelyi, EU Commission**

First, thank you for inviting me. It is a great pleasure to talk to you and to be able to exchange our views with IP practitioners and trade marks users organization.

We have a very active year behind us, if I only have to list the achievements of last year in the trade mark field, I must emphasize the importance of the September Agreement which has been struck between Member States and the Office and with the active participation of the Commission whereby we have managed to lower significantly the accession fees of the Community Trade Marks, and hopefully we will be able to construct a new avenue in the cooperation between the Office and the National Offices providing direct benefit to the users by providing better enforcement of trade mark rights.

As to the future of course we have an enormous task ahead of us, which is just about to begin, and that is the first step in the revision of the trade mark system.

We plan to launch a study, which is well-known to all of you, a comprehensive study which should address the experience gained during the application of the Community Trade Mark Regulation, and the use of the Community Trade Mark, and also the Directive harmonizing national Trade Mark Laws. The aim of the study is to see what can be learned from these experiences, and there again we count on your support and your input in this because we think that you are best placed to explain to us how this whole system works in practice.

This is a major task for next year and on that basis, on the outcome of that study, we will launch a revision of the Community Trade Mark Regulation and the Directive as well, that is going to be a major legislative process.

Apart from the Trade Mark area it is of course needless to tell you that we are busy with the creation of the Community Patent and the Unified Patent Jurisdiction. My colleagues in the enforcement department are very busy with the creation of the European Observatory and we are anticipating quite some progress on the field of GIs as well.

### **Annick Mottet Haugaard**

Referring the fact that you mentioned the famous study, which we are really looking forward to and many of our Committees are working on it and discussing it, can you be more specific with regard to the timing and the scope of this study?

### **Oliver Varhelyi**

I am happy to tell you that I can be quite specific. We hope to launch the Study in the coming weeks, which means that the call for the tender for the Study will be published in the Official Journal at the

beginning of July, which should leave us with the possibility of concluding a contract with the consultancy at around end of September/ beginning of October of this year.

We hope to finish the whole experience of the study including the final report and including an interim report, and the discussions with you about it, within one year, which means that we should be able to start working on our proposals in the second half of next year. This is our plan and I do not know if you would like me to go into further details about this.

**Annick Mottet Haugaard**

It is quite ambitious and we would certainly like you to go into further details. Indeed, I presume that you have already draft your tender offer and I guess that you can be rather more specific with regard to its scope. As I understood it will be a comprehensive study. What will it cover?

**Oliver Varhelyi**

Well it was quite a headache to actually fix the scope of the study. There were so many issues so many question, so many diverging ideas on how to approach it. But at the end of the day we thought that there are two main paths that we need to go down. The first would be an assessment of the link between the functioning of the Community Trade Mark System and the national systems and what is the inter-reaction between those.

**Annick Mottet Haugaard**

This is very good news because one of the main concerns of ECTA is the balance between the two systems.

**Oliver Varhelyi**

This is going to be stream number one. The second of course is about the analysis on the functioning of the Community Trade Mark and the functioning of the Office and what experiences we can gain there and what conclusions can we achieve. Of course within these frameworks we will try to address all the issues which are already voiced by quite a number of user associations including ECTA.

**Annick Mottet Haugaard**

One of the questions that we had with regard to the Study, is the matter of use. When the CTM was created, the EEC Community was quite a small Community, limited to a small number of countries. It

was then stipulated that the use in a certain country or region in the EU would be sufficient for maintaining the registration of a Community Trade Mark. Of course, now with a Community of 27 countries, the situation has quite changed. To maintain such a principle in such a situation seems too rigid. It appears to constitute in itself an obstacle to trade marks within a true Community spirit because the registration of one Community Trade Mark can be prevented by trade marks which are registered at a Community level but just merely used at a national or regional level. I would like to have your thoughts about this. We hope that this issue is also covered in the Study.

### **Oliver Varhelyi**

This is one of the very sensitive questions and it will be addressed in the Study. We think this needs to be looked into because of the reasons you have listed and I am very interested in hearing that you have the same sort of dilemma. Although one avenue that we do not want to open is that we should start assessing the intentions of trade mark applicants - so that whenever they are applying for a Community Trade Mark we do not have to ask them why they are doing so.

### **Annick Mottet Haugaard**

I turn to Wubbo with another issue regarding the use of trade marks.

A trademark registration confers exclusive rights to use a particular sign. This involves exclusive rights or a monopoly which the State or supranational authorities grant to private individuals. The alterations recently made to the CTMR have set the registration fee at zero. Thus, there is now a single fee for the application/registration of a Community trade mark, and a trade mark which is refused or abandoned by the applicant during the application stage is now treated in the same way as, and with equal dignity to a trademark which matures to registration and grants exclusive rights for a period of 10 years. Does this not discredit trademark registrations as rights? Will this measure not overload the system even further with valid registrations which in reality are not of any interest to their owners?

### **Wubbo de Boer, President of the OHIM**

Thank you very much for inviting me, as usual I feel very warm that my predecessor is controlling what I am saying. It is good to see you, Jean-Claude, in the front row.

I am happy to say that I cannot disagree more with what you say. I think this is mistaken. What has happened is that Member States and the Commission have decided to do away with the registration

fee which actually in most jurisdictions does not even exist. So rather than introducing novelty, we are aligning the Community Trade Mark with what happens at national level.

Also I think it is exaggerated to compare an abandoned or withdrawn or refused trade mark with a trade mark which reaches maturity, that is registration. What has happened is that a significant fee reduction has been accompanied by a significant reduction in administrative burden, welcomed throughout the users community, and I can say that to my mind it helps lessen the administrative burden, speed up the procedure and is therefore very welcome.

If the argument would be that it is now so much more expensive to lose. You lose so much money when your trade mark does not mature. Just look at the figures. Until 2005, 975 EUR would have been "lost". Then, between the period of 2005 to 2009, there was the period that it was 750 EUR, and now it has gone up to 900 EUR. So, in terms of money that is relatively little and, if you think that all these things happen in a minority of cases, whereas in the majority of cases people enjoy a 45% reduction of fee plus a significant reduction in administrative burden, I think we should not take the viewpoint that doing away with the registration fee is a bad thing.

**Annick Mottet Haugaard**

Yes but, with regard to the overload of the Community trade Marks system?

**Wubbo de Boer, President of the OHIM**

Well the overload, that is what people say, I think that last year in the whole of the European Community something like 800 000 trade marks have been applied for. So the argument that it is so difficult to find trade marks is not really borne out by the facts. If it may occasionally require a serious search to find an appropriate trade mark, I think that is part of the game. It is not because there are so many trade marks, it is because there are so many products on the market.

So unfortunately I am on a completely different track than you.

**Annick Mottet Haugaard**

With regard to the overload of the CTM register, what do you think, Olivér, of the solution adopted in some other states. For instance, in the US, there is a requirement of use and, at the time of the renewal of a trade mark ten years after its registration, there is a requirement of evidence of the use of the trade mark to be able to renew the said trade mark registration. Do you plan to adopt such a measure at the EU level?

## **Oliver Varhelyi, EU Commission**

That is again something we will need to look into when we are doing the study, but for the time being this is not part of our major ideas.

## **Annick Mottet Haugaard**

Talking about money, could you explain to us, Wubbo, what the Cooperation Fund and its financial provision consists of?

## **Wubbo de Boer**

For those of you who are not clear what we are talking about, when last year there was an agreement on the fee reduction, this formed part of a set of agreements that also dealt with other financial aspects. One of these aspects is what to do with the very very substantial reserve that is in the bank in Alicante, which is now touching €400,000,000 which is of course an unusual situation.

Well actually that problem has not been solved, but Member States, Commission and Office agreed that €50,000,000 of this reserve would be set apart to finance projects that would help to improve the trade mark situation - the trade mark protection in Europe at the registration level. So what is foreseen is that a number of projects undertaken at the level of the national offices could find financial assistance from this so called "fund" which in reality is part of our budget, in order to achieve for instance modernization, to achieve more harmonized practices, which I think is still something that we need to go into.

The state of play in all this is that we, the management of the Office, have started discussions on how to do this with delegations in our Administrative Board in April. That led to a lively discussion. The next step – and that was taken yesterday – is that we have sent round an additional proposal, and additional details in order for all of this to be able to get started as soon as possible and be operational round about the beginning of 2010.

The main characteristic and also the thing which is discussed most is of course on the one hand what are we taking about, what sort of projects, in what field? But more importantly, and I think certainly from our side we insist a lot on that, we would like to see that actually it is users and users organizations whose input into the question and in what respects can we actually improve the situation in Europe. What are the things that from a daily practitioner point of view need to be addressed or need to be harmonized? That input needs to be guaranteed and needs to be the fuel from which the programme of the fund will have to be made up. Quite soon, I hope, we will be able to

address all of you, user organizations and individual users, asking you for proposals, lines of thinking, and communication in order to have as a first input the real needs of users. Because this is after all Community money, but actually I still consider this to be users money which you have been paying too much in the past.

**Annick Mottet Haugaard**

I see that quite good progress has been made because we just received a communication with a notice to which we have to reply by 10 July. Our committees are working hard on this and we already listed a few projects. Did you already have any projects in mind?

**Wubbo de Boer, President of the OHIM**

It may be interesting to highlight here that as of April, ECTA and four other user organizations are observers in our Administrative Board and thereby in a unique position to contribute to this debate.

The stage we are in is still the constitution of the fund and a number of arrangements, but we will be looking forward to any thought or any project that you would like to bring to our attention.

**Annick Mottet Haugaard**

Thank you. We will forward you our “wish list”,

With regard to the improvement of the CTM system, one of our members raised the question as to what measure is OHIM planning to speed up the opposition proceeding and the registration proceeding, in order to shorten the gap presently existing between the final submission of all facts/material by opponent/applicant in support of/reply to the opposition and the decision rendered by the Trademark Division, and the withdrawal of the opposition and obtaining the registration certificate of the mark.

**Wubbo de Boer**

I do agree with those who say that things at opposition level take too long, but we must also see that there are two types of – if I may use the word – “delays” – the ones created by the Office not fast enough etc., but of course there is a large part of the opposition period that is in the hands of parties - cooling off, speed of reply, etc.

Now at the Office level, I think that a very major improvement will be one of administrative nature. We hope that, by the first quarter of 2010, we will have in place an electronic outside tool for parties to an opposition procedure not to be dependant on the Office as far as the exchange of documents, etc go. But really exchange in internet form the necessary documents that will certainly speed up the procedure.

If you will allow me I think that it is about time that all of us should start thinking, do we still need the three months opposition period, is that still realistic in this day and age?

### **Annick Mottet Haugaard**

This was indeed already raised by our colleague Joao Miranda de Sousa during the ECTA workshop of yesterday afternoon on the comparison between the EU, US and Canadian opposition proceedings.

### **Wubbo de Boer, President of the OHIM**

And there are other things, do we really want the admissibility of each opposition – 16,000 or something which never leads to anything apart from 0.00001% cases – do we want to have that at the beginning or can we handle that later?

In the Office we are thinking about, what is called the adversarial part, should there be so many exchanges as there is foreseen now or could we do with less?

Of course a large part of the length of time is in the hands of the parties, cooling off 22 months, 24 months, can it be quicker? I think there is a good reason for all of us to look into shortening this period. The Office feels responsibility of course for their part. The present average is that we achieve on taking a decision where a decision is required, is not good enough, we are working on that and I am quite optimistic that we will improve there.

I think that this whole users community and the Office should work together with looking at the whole procedure and doing in a pragmatic way the things that will make it easier to speed up and of course not having the registration fee will help at the end of the process.

### **Annick Mottet Haugaard**

The OHIM is the office for registration of trademarks and designs Community wide.

There have been proposals to involve OHIM in "enforcement" issues. Could you please briefly explain the OHIM's involvement or initiatives of further "enforcement" of such IP rights? Would the OHIM be

prepared e.g. to assign funds to promote public consumer awareness campaigns to fight IP counterfeiting, or support other organizations in doing so?

### **Wubbo de Boer, President of the OHIM**

It is obvious that this is not our main task, we are the registration office and we are having the register to maintain – that is what we are there for. Of course there is pressure on us also from Member States to fund their activities in Anti-Counterfeiting. There is a legal problem there, but that might still be overcome to a certain degree, but I do not have much idea that the capabilities and competences of our Office are very special to contribute there.

So we have chosen a few fields which I think are helpful and well within reach of our Office, like a very successful activity, and I think that it is not known enough, and that is bring judges of the 27 countries together and that is a successful programme. We had 300 judges over the last 18 months who talk not with us but with each other, practically all countries participate and it seems that that gives results in terms of better understanding among themselves on what to do.

Another thing we try to do is in our cooperation with China and enhance the notion of trade mark protection – these are small and long steps.

But no I do not think our Office should as such develop activities in Anti-Counterfeiting, but at some stage a discussion as to whether part of the money that is in our budget could be used for well-defined activities will take place, I have no doubt.

### **Annick Mottet Haugaard**

I am jumping to the question of what is done outside the European Union. As the EU trade mark system seems rather satisfactory and efficient although it may need to be reviewed after so many years, one concern of the trade mark user is also to see what the Commission is doing vis-à-vis the outside community. Oliver, can you briefly comment on this?

### **Oliver Varhelyi, EU Commission**

We have a number of initiatives ongoing. For the time being we are trying to build on what we already have. Since Counterfeiting is a new area that we need to fight, we cannot wait for new legislative regulations to come by. We just have to work with what we have. Meaning that we have already

measures in relation to border controls, there is an ongoing discussion and reinforced contacts between the national authorities, initiated by the Commission.

We have multinational discussions on enforcement and hopefully this will be fruitful and be concluded at the ACTA agreement. The ACTA agreement is an agreement between the Community and its Member States, Japan, the US, Switzerland, Canada and some other countries, agreeing on the common clauses of enforcement law of IP rights and this will include criminal sanctions, not only civil sanctions but also criminal sanctions, and this would significantly ease and open new possibilities to have proper enforcement all around these countries.

This is the idea behind this, however, the progress on this has been somewhat delayed due to the change of government in the US, but it seems that discussion will be restarted from very early July, and hopefully they will be fruitful very soon.

But on these enforcement issues, I think you will have a much better speaker than I Alvydas Stancikas, my colleague who heads actually the Enforcement Unit.

### **Annick Mottet Haugaard**

Thank you, we will surely raise the question also to him. Another issue that we will raise to him concerns the status of the Internet Stakeholders Dialogue hosted by Unit D3 of DG Market but we will leave the floor for Alvydas Stancikas on these issues this afternoon.

We took note that ACTA is to include criminal sanctions; We know that there was a draft proposal on criminal sanctions also at the EU level but, as this tackles National sovereignty, it was a rather sensitive issue which has been postponed. Do you think that the progress made at the ACTA level will increase the chances of having criminal sanctions also covered at the EU level?

### **Oliver Varhelyi, EU Commission**

Yes, I think so because this was a very difficult debate already to make the Member States accept that it is not enough to provide for common civil law sanctions and that we need to address this problem in relation to criminality law.

The ACTA negotiations are carried on with the Commission in the lead but with the participation of the Member States on a so called" mixed competence" basis which means that for criminal sanctions, it would be still the Member States which have the lead but the Commission has the mandate to negotiate with these countries and we think that this would pave the way for an internal matter since this international agreement would have to be incorporated into the Community law once it is

concluded. On that basis hopefully we will be able to get an internal measure of the Community as well, although discussions are not progressing for the time being on that but we also have a supporting court case.

### **Annick Mottet Haugaard**

I turn now to Grégoire Bisson, with issues concerning WIPO, and in particular with a question raised by one of our members relating to the issue of Replacement. After concluding the Forum on Article 4 bis Replacement, what are the conclusions drawn? Can you first explain briefly what is the replacement issue and then what are the conclusions to be drawn?

### **Grégoire Bisson, WIPO**

Thank you for this opportunity to brief you and update the ECTA members on a number of issues of concern to them which are in our hands at WIPO.

Replacement is a fundamental principle of the Madrid System, it is enshrined in Article 4bis of both the Agreement and the Protocol. It is the principle whereby if an additional registration holder already possesses for the same trade mark for the same goods and services, a national or regional registration in one of the designated countries in this international registration, well this prior registration for the same mark and for the same goods and services is absorbed by the international registration. So the essence, the whole rationale, behind this provision which was not there the first time the Agreement was concluded in the 19 century, but was added later, the whole rationale is to foster the central management of the trade mark by allowing the holder to safely drop the national registration that was absorbed and still benefit from the rights that accrued from that national registration. So you are tacking on this prior registration, you are tacking your international registration onto this prior registration, you can drop it, you can let it lapse and you would still enjoy the rights that accrued from this prior registration.

It is quite a fundamental principle in the system.

Now why was there an open forum on the issue of replacement. Well in the context of the Working Group on the Legal Development of the System it has been expressed by Norway and a number of user groups that there was uncertainty as to how replacement operated and it was recommended that the Working Group studied the issue. So the Working Group focused on the issue and quickly identified that as to the procedural aspect of replacement there was something that could be done and this led the Working Group to develop model provisions to assist national trade mark offices to implement properly the procedure that relates to replacement international legislation.

But that relates only to the procedure of replacement. When I am talking about procedure, I am talking about the mere fact that the holder at the time that he feels he can enjoy and rely on replacement, may ask the national or regional office to take note of that fact in its register, so that the information is stored somewhere that even though this prior registration lapsed it is tacked on to an international registration, so a third party needs to take into consideration that the rights continue under a different title which is the international registration title.

The Working Group devised some model provisions to help the national trade mark offices to improve and clarify their legislation and office practices in that respect.

But when it comes to the substantive effect of replacement, questions such as in which precise conditions does replacement happen? What are the effects, at which point in time may one safely rely on replacement and let go his or her prior registration?, we thought that we needed more information on how this substantive aspect of replacement was handled at the national or regional level, and we needed also more information as to what were the users needs in respect of replacement.

To this end we have launched two investigation processes. One was a questionnaire that we sent to national trade mark offices asking them what were the procedures, what were the effects under their national legislation, and we also launched what you referred to Annick – the Open Forum.

Regarding the first fact finding process, the questionnaire, I must say that the offices played their part beautifully. All major offices in the Madrid System replied fully to the questionnaire and WIPO was then able to put these replies on the website and also to reorganize their answers to the questions, so that if anyone wants to find how replacement is handled in a specific jurisdiction with respect to a specific aspect of the issue, one simply can find information and also compare how these similar issues are being handled in the various jurisdictions. So again this fact finding process has been a great success.

The other fact finding project was the Open Forum to users. Well there is no nice way of saying this, but this has been hugely disappointing. There has not been a single contribution of substance to the Open Forum by users, there have been only four contributions and the only contribution that came somewhat close to a contribution of substance was a one paragraph comment by ECTA suggesting that a way to improve replacement would be to make it non-automatic, but make it conditional to a petition by the holder, very much like seniority works. This is of course an interesting comment but that cannot be developed, because again Replacement is enshrined in the Treaties, it is not in the common Regulation so we cannot change so fundamentally the issue of Replacement.

So what conclusion can we draw from this silence? Should one infer that users are not ready to rock the boat when it comes to Replacement? Why do we have such a silence? I would like to see things positively and conclude that perhaps all that was really required in respect of Replacement was more information as to the various ways this principle is implemented in the different contracting parties. Maybe it is not implemented in the most efficient way everywhere, maybe there are some disparities in the way it is being implemented in different contracting parties, but at least now that we have this information available on the website and again users can check how a specific issue relating to Replacement is being handled in various jurisdictions. Maybe this was sufficient to answer the users' needs.

**Annick Mottet Haugaard**

Another concern is the Nice Classification. What is going on now with the modifications to the Nice Classification? Did you already receive suggestions? Would they be put online?

**Grégoire Bisson, WIPO**

This is a very specific question which falls somewhat outside my area. You are referring to the Working Group meeting for the Nice Classification that will take place in November and indeed there has been a great number of proposals; in fact the deadline to submit such proposals ended in March so there is no longer any possibility to make any proposals. These proposals are currently being studied with the view to reporting back to the Committee of Experts meeting that will take place in the second half of 2010 if I am not mistaken. They are currently available online on the relevant page of WIPO's website.

**Annick Mottet Haugaard**

Another concern which has been raised is the following:

It has been noted that with respect to more recent international registrations, WIPO has commenced to include in the ROMARIN database pdf-files of all communications issued by the designated parties (e.g. notifications of refusal, confirmations on grant of protection).

Is it planned to also subsequently include such notifications with regard to the older international registrations?

In addition, we consider that it is desirable to also include WIPO's communications regarding the last change of ownership as pdf-file in the ROMARIN database. At present, the date of the recordal of the last change of ownership is not traceable online with WIPO or in other databases. For this purpose, a separate extract from the international register would have to be ordered with WIPO which would incur official fees and which would require additional time.

For CTMs the OHIM provides respective information online, i.e. immediately and at no additional costs.

What are your plans and maybe Wubbo can first comment on the CTM system?

**Wubbo de Boer, President of OHIM**

Well I cannot actually, so let Grégoire go first.

**Grégoire Bisson, WIPO**

That is an interesting question. It is always a bit unfair to ask this comparison with OHIM, not only is My Page a very efficient tool but also one has to bear in mind that the Madrid System is quite a unique machinery in the trade mark world.

Going back to the underlying thread of music, I would say that the Madrid System is not like a piano solo; it is very much like a jazz trio. You have the ball kicking back and forth between the office of origin, the international bureau, the offices of the designated parties, all that makes it a very complex matrix , and up until very recently even after registration, most of the requests that related to the management of your international registration, you had to file through the office of origin. So that very condition prevented WIPO from being pro-active in terms on on-line services and on line information, but this is changing. And I take the point.

You did indeed notice that last year we made available notifications of refusal and the like, final decisions, invalidations, all these are now available on the website.

I would like to correct something that I think I heard in the question. This not only in relation to new registrations, this is also in relation to long-standing registrations. In fact everything that we have received as of 2005 is now available. If I take the example of the oldest standing international registration which I think is SUCHARD and dates back from the 19 Century. If today we were to receive such a notification for a new designation it will be available even though that it quite an old registration like you said.

Now you are asking what are our plans to expand the coverage of information available in the ROMARIN? We are very much in your hands in fact. I am not sure what kind of information we could provide in respect of changes in ownership. But that is not the issue, the issue is that we made these notifications of refusals available on the ROMARIN because at one point during the meetings of the Working Group on the Legal Development, users said that they were interested in receiving or in being able to consult such information in ROMARIN. So similarly, if there is a legitimate and expressed interest in having other types of information available in ROMARIN, we will certainly do whatever is necessary to make it available.

### **Annick Mottet Haugaard**

One of the concerns of our members is to speed up communications and so that is why the concern is to see why we cannot do more online, why we still have to communicate with WIPO by fax and by letter. Is there any plan to modify this and to be able to communicate by e-mail and of course there is a problem of evidence I imagine but can you see where you stand there?

### **Grégoire Bisson, WIPO**

Yes, that is the other interesting aspect of your question. We are not talking about information on what is recorded but on availability of online services, the possibility of filing online. We have been slow on the game, that is for sure, but again that has to do with the fact that the Madrid System used to imply that quite a number of these requests were in fact filed with national offices, and many offices in the Madrid System are not automated at all.

But again things are changing and recently I think the turn of the century, the Common Regulations were revised so that a lesser number of such requests needed to be filed through the national offices. And the fact that safeguard clause has been repealed also is something that fosters direct filing by holders with the international bureau, as apposed to being required to file through their office.

But I am not fishing for excuses, indeed we have to do better in terms of providing on-line services and there are plans indeed within WIPO to expand the coverage of online services. In 2007 the Madrid Union assembly validated an IT modernization plan for the Madrid System and I can mention two specific endeavours in that context that I think will please you, one is called EMBOS . EMBOS will be a portfolio management tool whereby holders would receive not only receive all the information that concerning the portfolio directly through this electronic interface, but also would be able to induct requests, and in fact would also be able to manage their registrations through this secured interface. So I think that is really what would answer your wish.

The other project is something for third parties that wish to keep an eye on other parties registrations. This other model would allow someone to receive electronic information that concerns international registrations, not in their portfolio, but in someone else's portfolio.

So these are the two projects that have been validated and they are being developed.

### **Annick Mottet Haugaard**

Last but not least, what is the situation after the repeal of the safeguard clause? Have WIPO's hopes been fulfilled?

### **Grégoire Bisson, WIPO**

Let us say that the repeal of the safeguard clause has been a huge success. This is really a milestone event in the history of the Madrid System. Basically what we have done is that we have reversed the classic principle that the Agreement prevailed over the Protocol when the two treaties were in competition and replaced that by the principle that is now the Protocol which prevails on the Agreement. And we have done so not only for new filings, but also for the existing portfolios. It has been a huge success. Everything went very smoothly for users, there was ample information available and I must give a tip of the hat to our colleagues, the 50 or so national offices that were concerned by the process – that means the national offices of those countries party to both the Agreement and Protocol. They very efficiently relayed information to their users.

This could in fact have been a cacophony, but in fact it was a beautifully played symphony.

Now the situation is exactly what we were hoping would happen, the number of situations where the agreement applies has diminished drastically, that means that today the system instead of relying on two Treaties is relying almost entirely on the Protocol and only on the Protocol, and that leads to a global simplification of the system and also to a more user-friendly system because, going to what I was referring to earlier on, under the Protocol you do not have to file all these requests through the Office of origin you can do so directly with the International Bureau, so this is what allows us now to start thinking about electronic interfaces that will provide online services to holders because the procedure is no longer dependent on filing through the various offices.

Finally, another spin-off to that repeal of the safeguard clause, is that it puts the pressure on the few remaining countries that were bound only by the Agreement, to finally accede to the Protocol, so that they are not left isolated in a corner, and I am happy to inform you that Egypt, which, Madrid-wise, was perhaps the most important of the six remaining countries bound only to the Agreement,

has ratified the Protocol just last month and this means that the Protocol will come into effect in respect of Egypt early in the Autumn. That is really important because that means that whenever you would be designating Egypt, it will be the Protocol and no longer the Agreement that will apply. So we are really achieving the underlying aim of having the system driven by and relying only the Protocol.

**Annick Mottet Haugaard**

Thank you all for your fruitful input to this session.