



European Communities Trade Mark Association

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

WIPO 5-9 July 2010

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Norway proposed in a document at the sixth session of the Working Group on the Legal Development of the Madrid System for the International Registration of marks at WIPO (24-28 November 2008) to the International Bureau (in charge of the Madrid System) to do away with the necessity to base the international registration on a home application or registration in the country of origin of the applicant. The document can be found [HERE](#).

All the working documents from the November 2008 session can also be found [HERE](#).

If this would be accepted, it would have as immediate effect that

- international applications would be filed directly with WIPO in Geneva;
- the country of origin could be designated as any other country;
- the dependency clause, which is now five years, would disappear (Article 6);
- the need for transformation (Article 9*quinquies*) would also be suppressed as it would no longer be required.

This would be the biggest change in the Madrid System, more or less of the same magnitude as the Madrid Protocol. The change, if accepted, would need a Diplomatic meeting and will consequently take five to ten years.

The last meeting on this subject took place at WIPO from 5 to 9 July 2010 at the eighth session of the Working Group on the Legal Development of the Madrid System for the International Registration of Marks.

As for the meeting of [November 2008](#) ECTA submitted written comments for the meeting of [July 2010](#). The papers were also distributed to all the participants of the said sessions.

It is ECTA's view that, when comparing today's system with the Norwegian proposal, the current system is better for the trade mark holder.

Generally speaking, the Norwegian proposal received very cautious reception by the other Member States, with the exception of South Korea, Japan and Australia.

South Korea and Japan underlined the difficulties resulting from the fact that for the export market, they usually had to file in Latin characters, whilst for their own country, they obviously filed in Korean and Japanese characters respectively.

Surprisingly, China did not seem to share the same opinion.

The delegation of the European Union, representing the 27 Member States, was more than cautious. They support the development of the Madrid System with the aim of making the system more efficient and attractive for users. They consider that the current system is working well and that the adoption of fundamental changes to it, such as the proposed removal of the basic mark requirement, should only be considered with great caution and not without having a clear and complete picture of the impact in particular on users. The Working document [MM/LD/WG/8/2](#) raises concerns that the abolition of the basic mark requirement could have negative implications on the level of support and services being provided to users and that it "*may, ultimately, have negative consequences in the context of the overall perception of the Madrid system in terms of its efficiency, effectiveness and user-friendliness*". The document further makes clear that there are two important aspects in this context which have not yet been addressed by the Working Group, those being the filing structure in the revised regime and the question whether the new regime would allow for self-designation. The delegation of the EU concluded that more thorough analysis was required and that the proposed abolition of the basic mark requirement should only be envisaged if there were very strong reasons for doing so and if it was clear that the overall benefits, especially for users, would outweigh the negative impacts. As this assessment cannot be made on the basis of the information available to date, the EU delegation is open to pursuing the review of any of the various issues addressed in working document [MM/LD/WG/8/4](#). Nevertheless, they do not consider the concerned matter to be one of priority.

ECTA made two verbal comments during the session:

- 1) The first comment referred to the fact that the owner of a trade mark is, generally speaking (except maybe for export markets), interested in first obtaining registration in his own country. In that line of thinking, it would be interesting to see statistics from WIPO for transformation (Article 9*quinquies*).

If the Norwegian proposal would be adopted, and the country of origin would be requested as an extension, as any other Member State, this will mean that the examination in the home country will only start after the conclusion of the examination by WIPO. The consequence is that examination in the home country will start much later than it does with today's system which is a clear disadvantage.

- 2) The second comment was to underline some of the ECTA written comments distributed to the delegates.

Most delegations underlined the importance of the help they give to international trade mark applicants and this in their own language. This would most probably disappear with direct filings at WIPO.

It has been deplored by some delegations that, whilst the merits of the Norwegian proposal have been underlined, hardly anything was discussed on the advantages of the existing system. When this is done, both must be compared.

In connection with the document [MM/LD/WG/8/4](#), some delegations asked for further details regarding the paragraphs 83 and 84.

Paragraph 83 states: “ *If the Working Group so wished, the International Bureau could assemble further statistics breaking down ceasings of effect according to whether or not they are the result of central attack, properly speaking. To this end, it would be necessary that Offices agree to include in, or attach to, their notifications under Rule 22 of the Common Regulations, for a period of time, an indication to the effect that the facts or decisions that led to the notification are, or not, the result of, or follow from, inter partes proceedings. This would, of course, not capture “hidden” central attacks (for example, voluntary limitation of the list of goods or services in a basic registration under threat of a cancellation action), but it should allow for a better assessment of the actual number of real central attacks.*”

Paragraph 84 states: “ *Similarly, the International Bureau could seek to assemble statistics on transformation, if Offices are in a position, over a period of time to be determined, to provide it with lists of numbers of international registrations which have been the subject of a national or regional application invoking the benefit of Article 9quinquies of the Madrid Protocol.*”

The Secretariat of the International Bureau has proposed that the Offices indicate the reasons for the ceasings. Information on central attacks can be submitted to the Secretariat by the beginning of 2011. The Secretariat would like to get statistics from the Offices. Certain delegations declared that they will provide the said statistics; some others declared that they were not willing to have additional work. To be clearer, the Secretariat will send a circular explaining what they exactly expect and how the information should be sent.

Australia expressed that having an electronic forum where comments could be posted regarding the deletion of the basic mark and the central attack, could be a good option.

The Secretariat of the International Bureau declared that they noted that some delegations used the terms “cautious”, “prudence” and “premature” in connection with the Norway proposal. The Secretariat stated that they were not pushing for the deletion of the basic trade mark requirement. At the next session, which should take place in May or June 2011, the present topic will remain on the list with possible focus on simplifications of the system without touching the treaty. There will also be discussions on the evaluation of electronic tools needed for the future and on the Swiss proposal on the division of International Registrations (a questionnaire will be sent in this regard).

INTA Association, represented by Bruno Marchado, asked for some clarifications and made the following comments:

- There is a general agreement that the Madrid system should be simplified without touching the treaty. How can it be done?
- When will the Article 9quinquies discussion be re-opened?
- Discussion on Article 4bis (replacement) has been pending for a long time and should be listed in the Agenda of the next session of the Working Group in 2011.
- Opinion from the users should be known via electronic forum.

Vesela Venisnik, the Slovenian President of the Working Group, responded in connection with two comments as follows:

- There should not be any modification of principles and the legal framework should not be touched.
- The replacement issue should be retained, but it will not be part of the agenda of the next session as there are already too many topics.

The Secretariat of the International Bureau made the following comments in connection with the two remaining issues:

- They cannot say much in connection with *9quinquies* at the present stage. They should see if the three remaining countries will accede to the Madrid Protocol. They should look first at the Madrid Agreement and thereafter look at the work needed for this Article.
- The forum for Article 4bis has not been a success and there is a lack of support from the Working Group. So far only three contributions were received, amongst them ECTA's comments.

At these early days of discussion, it is not possible to predict what is going to happen. WIPO does not seem very enthusiastic to make additional examination which inevitably will be requested if the Norwegian proposal is accepted. It is however possible that the proposal will be rejected as such, but that some ameliorations will be brought to the system such as for instance the possibility after five years to integrate the home registration into the international trade mark and take the opportunity to come with a solution for replacement, which is interpreted differently by each Member State.

All documents of the eighth session can be found [HERE](#). At the time of the report, the summary of the session has not yet been published.

After the session, Ernesto Rubio, WIPO Senior Director Advisor, made a presentation in connection with Madrid system goods and services database. His presentation covered the languages, structure, contents, sources and advantages of the database. The next steps and areas of cooperation with Madrid Union members were also discussed. Once the slides are available, they will be published on the ECTA website (Law Committee – Working documents section).

Neil Wilson, WIPO Director, Functional Support Division, also made a presentation on "*Improving communication in the Madrid System*". The communications between the International Bureau, the clients and the Offices were discussed (what each could do for the other to improve the system). Once the slides are available, they will be published on the ECTA website (Law Committee – Working documents section).

14 July 2010