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

Tenth Session
Geneva, July 2 to 6, 2012

REPORT

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") held its tenth session, in Geneva, from July 2 to 6, 2012.

2. The following Contracting Parties of the Madrid Union were represented at the session: Algeria, Australia, Austria, Belgium, China, Colombia[1], Cuba, Cyprus, Czech Republic, Democratic People's Republic of Korea, Denmark, Egypt, Estonia, European Union, Finland, France, Germany, Ghana, Hungary, Iceland, Iran (Islamic Republic of), Israel, Italy, Japan, Kazakhstan, Kenya, Kyrgyzstan, Latvia, Lithuania, Madagascar, Monaco, Morocco, Norway, Philippines[2], Poland, Republic of Korea, Romania, Russian Federation, Sao Tome and Principe, Serbia, Singapore, Slovenia, Spain, Sweden, Switzerland, Turkey, United Kingdom, United States of America and Zambia (49).

3. The following States were represented as observers: Dominican Republic, India, Iraq, Jordan, Mexico, Nigeria, Saudi Arabia and Trinidad and Tobago (8).

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1 On May 29, 2012, the Government of Colombia deposited its instrument of accession to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks. The Madrid Protocol entered into force with respect to Colombia on August 29, 2012.

2 On April 25, 2012, the Government of the Philippines deposited its instrument of accession to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks. The Madrid Protocol entered into force with respect to the Philippines on July 25, 2012.

4. Representatives of the following international intergovernmental organization took part in the session in an observer capacity: Benelux Office for Intellectual Property (BOIP) (1).

5. Representatives of the following international non-governmental organizations took part in the session in an observer capacity: American Intellectual Property Law Association (AIPLA), *Association des praticiens du droit des marques et des modèles* (APRAM), Association of European Trademark Owners (MARQUES), *Association romande de propriété intellectuelle* (AROPI), German Association for the Protection of Intellectual Property (GRUR), International Association for the Protection of Intellectual Property (AIPPI), International Federation of Industrial Property Attorneys (FICPI), International Trademark Association (INTA), Japan Patent Attorneys Association (JPAA), Japan Trademark Association (JTA) and Union of European Practitioners in Industrial Property (UNION) (11).

6. The list of participants is contained in the Annex to this document.

AGENDA ITEM 1: OPENING OF THE SESSION

7. Mr. Francis Gurry, Director General of the World Intellectual Property Organization (WIPO), opened the session and welcomed the participants.

8. The Director General indicated that, since the previous session of the Working Group, the Madrid system had witnessed a new wave of momentous developments. He noted that the accessions to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as “the Protocol”) of Colombia and the Philippines had brought to 87 the number of members of the Madrid Union and expressed the hope that the accession of Colombia, the second member of the Madrid system from Latin America, would augur well for further accessions from that region. With just Algeria remaining party only to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as “the Agreement”), the Director General indicated that it would be a priority for the International Bureau to work with its Delegation towards the accession of Algeria to the Protocol, which would bring about the interesting prospect of a one-treaty system.

9. With regard to further additions to the Madrid Union, the Director General pointed to the fact that several Member States were at an advanced stage in their consideration towards accession to the Protocol. In particular, he mentioned Barbados, Costa Rica, Dominican Republic, Jamaica, and Trinidad and Tobago, in the Latin American and the Caribbean regions. He mentioned also that Cambodia, Indonesia, Malaysia and Thailand, members of the Association of Southeast Asian Nations (ASEAN), had decided to join the Madrid system by the year 2015.

10. Furthermore, the Director General announced that the Governments of India, Mexico and New Zealand, which had already completed the required constitutional processes, had communicated their intention to accede to the Protocol during the course of the current year. He indicated that, with the aforementioned developments, the Madrid system would consolidate its status as a truly global system.

11. In terms of use of the Madrid system, the Director General stated that 2011 had been a good year, with the total number of applications filed increasing by 6.5 per cent, to a record of some 42,000 applications. He noted that there had been sizable increases in the number of applications filed through the Offices of certain members, such as the Russian Federation, which had recorded an increase of 35 per cent, the European Union, with 24 per cent, the United States of America, with 15 per cent, and China, with 11 per cent. The Director General further noted that there were some 540,000 active registrations in the International

Register, containing more than 5.5 million designations and around 178,000 right holders, 80 per cent of which were small and medium sized enterprises. He concluded that, with each passing year, the Madrid system was acquiring increasing relevance.

12. The Director General stated that, during the previous year, commendable work had been done in the area of user-services, such as the establishment of customer service teams, in line with the general orientation of WIPO to be focused on service provision. In addition, he indicated that a number of improvements had been made in the area of information technology. In particular, he recalled that the latest version of the Goods and Services Manager (G&S Manager), launched in January 2012, was available in 10 languages. Moreover, during the annual meeting of INTA, three new web-based client services, namely, the Madrid Portfolio Manager, the Madrid Real-time Status and the Madrid Electronic Alert, had been made available. Further in the area of information technology, the Director General stated that the use of electronic communication for the exchange of documents within the Madrid system was increasing, and, as evidence, he noted the fact that almost 43 per cent of international applications were being transmitted electronically by the Offices of 13 member States, and that by the end of 2011, 60 per cent of the documents received by the International Bureau had been transmitted electronically.

13. In the area of improved delivery of information, the Director General recalled that the sending of statements of grant of protection had become a mandatory feature of the Madrid system in January 2011, noting that in the course of that year, the International Bureau had received some 162,000 of such statements, which confirmed the extent to which this service had been welcomed by users of the Madrid system.

14. The Director General concluded by expressing his gratitude to all the delegations for the work that had been accomplished thus far by the Working Group, underlining that such work was exceptionally important for the modernization of the Madrid system.

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

15. Mr. Mikael Francke Ravn (Denmark) was unanimously elected as Chair of the Working Group, and Ms. Krisztina Kovács (Hungary) and Mr. Xu Zhisong (China) were elected as Vice-Chairs.

16. Mrs. Debbie Roenning (WIPO) acted as Secretary to the Working Group.

AGENDA ITEM 3: ADOPTION OF THE AGENDA

17. The Working Group adopted the draft agenda (document MM/LD/WG/10/1 Prov. 3) without modification.

18. The Chair reminded the delegations that the report of the ninth session of the Working Group had been adopted electronically on March 20, 2012, taking into consideration comments received from the Delegation of Norway and from the Representative of INTA. The Chair indicated that the report of the current session would be similarly adopted.

19. Following a remark made by the Delegation of Iraq concerning the need to update the requirements to accede to the Protocol, which would allow Iraq to join the Madrid system, the Chair indicated that the International Bureau would provide the Delegation with all the necessary information concerning such requirements.

AGENDA ITEM 4: PROPOSED AMENDMENTS TO THE COMMON REGULATIONS UNDER THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS AND THE PROTOCOL RELATING TO THAT AGREEMENT

20. Discussions were based on document MM/LD/WG/10/2.

21. The document was introduced by the Secretariat. The Secretariat stated that the purpose of the proposal was to amend certain rules of the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement (hereinafter referred to as "the Common Regulations") which were no longer applicable. Concerning paragraph (3)(b) of Rule 7, the Secretariat indicated that, on September 16, 2011, the Director General had received from the Minister for Foreign Affairs of Sweden a notice of withdrawal of the notification made under former Rule 7(1). Since Rule 7(1) was no longer in force, this meant that it was no longer possible for a new Contracting Party to make such notification at the time of accession. Sweden had been the only Contracting Party with a standing notification made under the former Rule. This was the background for the proposal to delete, from paragraph 3(b) of Rule 7, the words "paragraph 1, as in force before October 4, 2001, or", as well as the accompanying footnote.

22. Paragraph (2)(a)(i) of Rule 24 required the filling of a subsequent designation through the Office of origin, where Rule 7(1), as in force before October 4, 2001, applied. Since Sweden had withdrawn the notification made under this Rule, paragraph (2)(a)(i) of Rule 24 was also no longer applicable for any Contracting Party. It was therefore proposed that that provision be deleted.

23. Paragraph (5) of Rule 40 established that no Office should be obliged to send statements of grant of protection under Rule 18*ter*(1) before January 1, 2011. Insofar as the period during which the sending of such statements had not been mandatory had expired, paragraph (5) of Rule 40 was no longer applicable. Likewise, it was therefore proposed that that provision be deleted.

24. The Delegation of the European Union expressed its support for the proposed amendments to Rules 7, 24 and 40, as a consequence of the fact that some aspects of those Rules were no longer relevant.

25. The Delegation of China said that it also supported the proposed amendments.

26. The Representative of GRUR indicated that provisions which were no longer relevant or applicable should be removed from the Madrid legal framework. However, the Representative asked whether versions of the Madrid system legal framework that were no longer in force would remain readily available for the purpose of research and noted that, given the potentially long duration of trademark rights, certain issues might arise concerning events which had occurred under provisions that might no longer be in force.

27. The Secretariat confirmed that the versions of the legal framework that were no longer in force were all available on the Madrid system website.

28. The Chair concluded that the Working Group had agreed to recommend to the Madrid Union Assembly the amendment of Rules 7, 24 and 40 of the Common Regulations, as proposed.

AGENDA ITEM 5: INFORMATION RELATING TO THE REVIEW OF THE APPLICATION OF ARTICLE 9*SEXIES*(1)(B) OF THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

29. Discussions were based on document MM/LD/WG/10/3.

30. The Secretariat, introducing the document, recalled that, in 2005, the Director General had convened an *ad-hoc* Working Group in order to facilitate the review of Article 9*sexies* of the Protocol, also known as the safeguard clause. In 2007, upon the recommendation made by the *ad-hoc* Working Group, the Madrid Union Assembly had modified paragraph (1) of Article 9*sexies*, establishing, in a new subparagraph (a), the principle that the Protocol alone applied in the mutual relations between States bound by that treaty and the Agreement. However, in said relations, a new subparagraph (b) rendered inoperative declarations made under paragraphs 2(b) and (c) of Article 5 and paragraph (7) of Article 8 of the Protocol. As a result, in the relations between States bound by both treaties, the standard time limit of one year for the sending of notifications of provisional refusal and the standard fee regime applied.

31. The Madrid Union Assembly had also approved a new paragraph (2) of Article 9*sexies*, under which the Assembly, after the expiry of three years from September 1, 2008, was required to review the application of paragraph (1)(b), and could maintain it or, at any time thereafter, either repeal it or restrict its scope by a three-quarter majority of States which were party to both treaties. Such review had been undertaken during the ninth session of the Working Group, which recommended that paragraph (1)(b) be neither repealed nor restricted. The Working Group had further decided that a review of the application of paragraph (1)(b) should again be included in the agenda for the following session.

32. The Secretariat indicated that the document under consideration provided updated information concerning the application of paragraph 1(b), in particular with respect to the inoperativeness of declarations made under Article 5(2)(b) and (c) and Article 8(7) of the Protocol.

33. In Part I, the document presented the total number of designations recorded in the course of the year 2011, further indicating those designations which had been affected by the application of paragraph (1)(b) of Article 9*sexies* of the Protocol, either in the context of Article 5(2), concerning the refusal period, or Article 8(7), concerning individual fees.

34. Regarding the time limit to refuse, 15 of the 55 States bound by both treaties had made a declaration under Article 5(2)(b), and a further seven of those had also made a declaration under Article 5(2)(c). In 2011, some 346,000 designations had been recorded. Of those, some 144,000 designations concerned Offices of States bound by both treaties. Of the latter, there had been 52,000 designations in which a declaration made under Article 5(2) had been rendered inoperative by the application of paragraph (1)(b) of Article 9*sexies* of the Protocol.

35. With regard to individual fees, 17 of the 55 States bound by both treaties had made a declaration under Article 8(7). In 2011, some 577,000 designations had been recorded or renewed. Of those, some 339,000 designations concerned Offices of States bound by both treaties. Of the latter, there had been some 117,000 designations in which a declaration made under Article 8(7) had been rendered inoperative by the application of paragraph (1)(b) of Article 9*sexies* of the Protocol.

36. In Part II, the document elaborated upon the data, identifying the particular Contracting Parties concerned by the inoperativeness of declarations made under Article 5(2) of the Protocol. The document also provided statistical data in relation to the recording of statements of grant of protection sent in accordance with Rule 18*ter*(1) of the Common Regulations. In Part III, the document performed a similar exercise with regard to Article 8(7) of the Protocol.

37. In Part IV, the document presented the amounts of the standard fees collected and distributed in 2009, 2010 and 2011, resulting from the application of Article 9*sexies*(1)(b) of the Protocol. Finally, in Part V, the document performed a simulation of the amounts of the individual fees that would have been collected and distributed, had declarations made under Article 8(7) of the Protocol been operative during those years, with the assumption that the number of designations and the number of classes in each designation had remained the same.

38. The Delegation of the European Union stated that it continued to be of the opinion that the current system worked fairly well, which was confirmed by the review of the application of Article 9*sexies*(1)(b) undertaken by the International Bureau. The Delegation said that it believed that the amendments to Article 9*sexies* of the Protocol, as adopted by the Madrid Union Assembly in September 2007, had stood the test of time well and that, therefore, there was no need to take further action. Nonetheless, the Delegation indicated that if the issue was of concern to some member States, it would not be opposed to further periodic reviews of the application of Article 9*sexies*(1)(b).

39. The Delegation of Switzerland indicated that, taking into account the interventions that had been made during the previous session of the Working Group and in light of informal consultations undertaken with Swiss stakeholders, it did not believe that there was a need to modify the situation as it stood, given that it seemed satisfactory. Moreover, the Delegation aligned itself with a suggestion made earlier by the Delegation of the European Union, which had diverged from the previous recommendation made by the Working Group to the Madrid Union Assembly, in the sense that the application of paragraph (1)(b) of Article 9*sexies* be reviewed after a year. Accordingly, the Delegation of Switzerland proposed that such review take place after a given regular period, suggesting that it could take place every three to five years.

40. The Delegation of the Russian Federation, agreeing with the intervention made by the Delegation of the European Union, also stated that the accession of Algeria to the Protocol, a possibility envisaged by the Director General in his opening remarks, would lead to further changes in the Madrid system. The Delegation stated that postponing the review of the application of Article 9*sexies*(1)(b) for a period of three to five years would therefore place the matter too far into the future. The Delegation expressed the view that a period of one to two years would be more realistic.

41. The Delegation of Germany stated that it considered that five years would be an adequate period, after which the Working Group could again review this issue.

42. The Chair noted that there appeared to be three proposals concerning the period after which the Working Group would undertake a review of the application of Article 9*sexies*(1)(b). There was one proposal for a period of one to two years, a second for a period of three to five years, and a third proposal for a period of five years. The Chair proposed a compromise period of three years, with the possibility that the Working Group could revisit the issue again, upon the possible accession of Algeria to the Protocol.

43. The Delegation of the Czech Republic expressed the view that a three-year period was reasonable and said that it did not see what relevance the possible accession of Algeria to the Protocol would have to the review of the application of Article 9*sexies*(1)(b) of the Protocol.

44. The Delegations of Algeria, Romania and the Russian Federation expressed their support for the proposal made by the Chair.

45. The Representative of INTA stated that, similarly to the Delegation of the Czech Republic, he failed to see the relevance to the subject under discussion of the possible accession of Algeria to the Protocol. The Representative noted that further clarification was required on the reasons why such event, among others that may come to pass, would have a particular relevance on the review of the application of Article 9*sexies*(1)(b) of the Protocol. The Representative of INTA further said that, should the Working Group decide to have a periodic review of the application of Article 9*sexies*(1)(b) on a three-yearly basis, nothing would prevent it from undertaking an earlier review if an event relevant to the particular issue occurred before the following planned review.

46. Referring to its previous intervention, the Delegation of Algeria stated that Algeria would make all necessary efforts to accede to the Protocol at the earliest possible date, but expressed its concern that the proposal made by the Chair should not relate the matter under discussion to the possible accession of Algeria to the Protocol.

47. The Secretariat, addressing the concerns raised regarding the possible association between the accession of Algeria to the Protocol and the review of the application of Article 9*sexies*(1)(b), explained that the former situation would result in all Contracting Parties of the Madrid system being party to the Protocol. Thus, in a situation where all Contracting Parties were bound by the Protocol, the Secretariat indicated that, perhaps, maintaining exceptions to the application of certain provisions of that treaty referring back to the Agreement might seem peculiar. Considering that in the mutual relations between States bound by both treaties, only the Protocol applied, with the exceptions concerning declarations made under Articles 5(2) and 8(7) of the Protocol, the Secretariat acknowledged that, even with Algeria acceding to the Protocol, Article 9*sexies*(1)(b) could still be applied as it was then in force. Nonetheless, the Secretariat stated that, in the event that the aforesaid situation materialized, it would provide an opportunity to undertake an extensive review of the Common Regulations and an opportunity to take a further look at the application of Article 9*sexies*(1)(b).

48. The Representative of INTA stated that when all parties to the Agreement became party to the Protocol, the Agreement would, in effect, become inoperative. Nonetheless, the Agreement would remain in force. Moreover, the Representative added that paragraph (1)(b) of Article 9*sexies* did not refer to provisions of the Agreement but to provisions of the Protocol. The paragraph in question referred to the Agreement to the extent that it referred to States which were bound by that treaty. The Representative called for further reflection on the issue before ruling that the fact that all parties to the Agreement had become bound also by the Protocol would necessarily imply that Article 9*sexies* would have to be amended, which he did not believe to be the case.

49. The Representative of GRUR stated that he fully supported the interventions made by the Delegations of the European Union, Germany, Switzerland and other delegations, considering that experience had shown that the continued existence of the exceptions contained in Article 9*sexies* concerning particular declarations was a useful element in the operation of the Madrid system and that a need to repeal or amend it had not been demonstrated.

50. The Representative of GRUR added that, from a legal perspective, Article 9*sexies* required that a State be party to both the Agreement and the Protocol. The fact that all members of the Agreement also became members of the Protocol did not imply that the Agreement would turn out to be superfluous or redundant, as the understanding of the members of the Madrid Union was that membership of those treaties would be continuous. The Representative pointed out that, in that regard, the situation was dissimilar to that of the Paris Convention for the Protection of Industrial Property where, in the relations between States members to the 1967 Stockholm Act, previous Acts ceased to apply. In the Madrid system, there were two parallel treaties, a situation which was referred to in Article 9*sexies*, where, even if all States members of the Agreement became also party to the Protocol, those States would remain bound by the Agreement. The Representative concluded by indicating that he would support a further review of the matter after a three to five year period.

51. The Chair proposed a three year period, provided that, in the event that all Contracting Parties of the Madrid system became bound by the Protocol, the Working Group could address the issue again at an earlier stage.

52. Referring to the statement made by the Chair, the Delegation of Algeria asked the Chair to clarify whether Article 9*sexies*(1)(b) of the Protocol would be revised if Algeria acceded to the Protocol within the three year period.

53. The Chair clarified that the issue at hand was not whether Article 9*sexies*(1)(b) would be repealed or amended. The issue was whether a review of the application of that Article should be undertaken again by the Working Group and, if so, when it would be appropriate to do so.

54. The Delegation of Algeria reasserted its concern regarding the possible association between the accession of Algeria to the Protocol and the review of Article 9*sexies*(1)(b). The Delegation added that it would prefer that the decision of the Working Group explicitly state that the said provision would be reviewed in three years, without mentioning the possible accession of Algeria to the Protocol.

55. Responding to the concerns expressed by the Delegation of Algeria, the Chair stated that there appeared to be clear consensus on the fact that Article 9*sexies*(1)(b) should be neither repealed nor restricted. There were, however, several proposals concerning the period after which it would be relevant for the Working Group to undertake a further review of the application of that Article. In this regard, the Chair had advanced a three year period as a compromise solution, provided that the International Bureau could revisit the issue at an earlier time, in case no State remained bound exclusively by the Agreement.

56. The Delegation of Algeria stated that, while taking note of the proposal made by the Chair, it reserved the right to subsequently respond to the said proposal.

57. The Delegation of Switzerland, bearing in mind the interventions made by the Delegation of Algeria, proposed to the Working Group a review of Article 9*sexies*(1)(b) within three years, with the possibility for the International Bureau, or any delegation, to propose an earlier review, without linking it to the possible accession of Algeria to the Protocol.

58. The Delegations of Algeria and the Russian Federation supported the proposal made by the Delegation of Switzerland.

59. The Chair concluded that there was consensus on the fact that, at the present time, Article 9*sexies*(1)(b) of the Protocol should be neither repealed nor restricted and that its application would be reviewed by the Working Group after a period of three years. However, it was further agreed that any member State of the Madrid Union, or the International Bureau, may propose that the issue of the review of Article 9*sexies*(1)(b) be revisited at a time that is earlier than the said period of three years.

AGENDA ITEM 6: PROPOSAL FOR THE INTRODUCTION OF THE RECORDAL OF DIVISION OR MERGER CONCERNING AN INTERNATIONAL REGISTRATION BEFORE THE OFFICE OF A DESIGNATED CONTRACTING PARTY

60. Discussions were based on documents MM/LD/WG/10/4 and MM/LD/WG/10/6.

61. The Secretariat presented some background information on the issue at hand. The Secretariat recalled that, during the fifth session of the Working Group, the Representative of AROPI had referred to an informal paper made available to delegations. The Delegation of Switzerland had proposed, at the seventh session of the Working Group, that the suggestions contained in the document made available by AROPI be included in the agenda of that session. As a result, the Working Group had undertaken a study in order to ascertain the impact and consequences of the possible introduction of a procedure which would permit the division of international registrations. The findings of such study, including the replies to a questionnaire prepared by the International Bureau, had been presented in a document during the ninth session of the Working Group. During that session, the Working Group had discussed the consequences of the possible introduction of division of international registrations in the Madrid system, as well as possible alternatives to division, such as the issuing upon request, by the International Bureau or the Office concerned, of a statement of acceptance of goods or services, a statement of partial grant of protection, where there has been a notification of partial provisional refusal, or the division of a designation before the Office of the Contracting Party concerned. The Chair had noted in his conclusions that there appeared to be no consensus at that time on the need to introduce division in the Madrid system. Nevertheless, the Working Group had requested that the International Bureau, together with some interested Offices and organizations, study the matter in-depth, in order to present a proposal during the following session of the Working Group.

62. The Secretariat remarked that the matter of division of the international registration had been further studied by the International Bureau, with the benefit of contributions from nine Contracting Parties and three non-governmental organizations.

63. Introducing document MM/LD/WG/10/4, the Secretariat indicated that the document presented the results of the aforementioned study. The Secretariat indicated that the Working Group, in its request, had given the International Bureau broad instructions. Moreover, most of the contributions posted on the Madrid System Legal Forum simply considered the need to study division at the level of the designated Contracting Parties, without further details. Thus, the International Bureau had decided to undertake a study based on what it considered to be the minimum common denominator to all the Contracting Parties. As a result, the document introduced a proposal on division of designations made in international registrations before the Offices of designated Contracting Parties.

64. The proposed introduction in the Common Regulations of division of designations made before Offices of designated Contracting Parties would require two new provisions, proposed new Rule 23*bis* and new paragraph 6 of Rule 40, and consequential amendments to two existing provisions, namely, Rule 32, paragraph 1(a)(xi), and Rule 36(xi). The Secretariat added that the proposal applied only to those Contracting Parties where national or regional laws foresaw the possibility of division of designations made in international registrations. The proposal would introduce an opportunity for Contracting Parties, where applicable, to notify to the International Bureau information relating to such divisions, for recording in the International Register and publication in the *WIPO Gazette of International Marks* (hereinafter referred to as “the Gazette”). Such possibility would be optional. Since division, where applicable, would occur in accordance with the national or regional laws of the designated Contracting Parties concerned, the proposed provisions would not require substantial changes to the legal framework of those Contracting Parties. The proposal did not seek to introduce a new kind of

structure to allow for division, but to strike a balanced approach in the distribution of work between the concerned parties involved, namely, the International Bureau and the Offices of designated Contracting Parties. The proposal, while ensuring that information concerning the division or subsequent merger of a designation was recorded in the Madrid Registry, could be implemented with relatively low impact on the operations of the Madrid Registry.

65. Explaining how the proposed new mechanism of division would operate, the Secretariat indicated that the holder, after receiving a notification of a partial provisional refusal, would need to contact the Office concerned to inquire about the possibility of division of such designation. Where said Office allowed for such division, it would do so in accordance with its national or regional legislation and established procedures, including, *inter alia*, time limits, fees, and issuing of a new national or regional number. The Office concerned would notify the International Bureau where such division had been allowed. The International Bureau would then record the fact that a notification had been received to the effect that division had taken place at the level of the designated Contracting Party with respect to the international registration in question. Taking into account the fact that division would have effect solely in the Contracting Party concerned, the International Bureau would not issue a new international registration number.

66. Paragraph (1) of proposed new Rule 23*bis* would set out the content of the notification which would be sent by the Office where division had taken place. The information provided would be recorded in the International Register and published in the Gazette, and it would be made available in ROMARIN. Where an Office, while making a notification under the said paragraph, furnished additional information in a document on paper or in electronic form, an electronic image of such document would be accessible from ROMARIN, in a manner similar to the practice followed with respect to statements of grant of protection sent under Rule 18*ter*(1). For instance, such additional information could be the number of the national or regional applications or registrations resulting from the division, the goods and services covered by each one of those, or other elements of the mark concerned by the division. This additional information would not need to be recorded in the International Register nor published in the Gazette, but there would be benefits derived from its being made available.

67. The Secretariat went on to note that a request for division before the Office of a designated Contracting Party and the sending of the ensuing notification under the proposed new Rule would be independent of the obligation to send a notification of provisional refusal in accordance with Article 5, paragraphs (1) and (2), of the Agreement and the Protocol, and the ensuing notifications under Rule 18*ter*.

68. In addition to the proposed new Rule 23*bis*, the document also proposed consequential amendments to Rule 32, regarding the recording of information and the data to be published in the Gazette; Rule 36, concerning exemption from the payment of fees to the International Bureau; and a new paragraph (6) in Rule 40, establishing a transitional provision specifying a date as from which the proposed new rules may enter into force.

69. The Delegation of Switzerland introduced document MM/LD/WG/10/6, which contained a further proposal relating to the introduction of division of an international registration in the Madrid system. The Delegation indicated that, while the proposal made by the International Bureau contained a number of interesting elements, it did not go far enough on two main issues. Firstly, the Delegation believed that it would be very important to create and assign a new international registration number to the divided part of the request. Secondly, the proposal did not take into account the fact that several Offices of Contracting Parties of the Madrid Union did not maintain a register for international registrations and referred only to the International Register maintained by the International Bureau. In order to elaborate the proposal contained in document MM/LD/WG/10/6, the Delegation indicated that it had held exchanges with the

International Bureau, some delegations, user-associations, as well as consultations with Swiss stakeholders. The proposal also took into consideration contributions posted on the Madrid System Legal Forum by a number of delegations and observers, as well as the interventions made during the previous session of the Working Group.

70. The Delegation of Switzerland stated that the introduction of division of an international registration in the Madrid system should be developed in a way that would ensure a centralized information mechanism maintained by the International Bureau, thus guaranteeing the necessary legal security for the users of the Madrid system, while reducing the effects of the new procedure to a bare minimum, both for the Offices concerned and for the International Bureau. The Delegation considered that such balanced approach could be achieved through a mechanism in which the Office of the designated Contracting Party undertook the substantive examination of the request, according to its national or regional legal framework, leaving as the main tasks of the International Bureau the recording, publication and notification, resulting in a new international registration number for the divided part.

71. The Delegation of Switzerland indicated that the introduction of division of an international registration in the Madrid system would align the system with provisions already contained in the Trademark Law Treaty (TLT) and the Singapore Treaty on the Law of Trademarks (STLT), thereby increasing the synergies among the different treaties administered by WIPO. The Delegation stated that the proposal would end the current discrepancy in Contracting Parties which, while allowing for division through the national route, did not provide for it at the international level. The Delegation stated that it believed that the proposal would result in an increased interest in the Madrid system.

72. The Delegation of Switzerland indicated that the proposed mechanism, as described in document MM/LD/WG/10/6, would be based on the procedures followed for the recording of a partial change in ownership, in accordance with Rules 25 to 27 of the Common Regulations.

73. The Delegation of Madagascar stated that, in its view, the introduction of division of international registrations would respond to a demand from a certain number of users of the Madrid system who were already benefitting from the availability of a similar procedure at the national level. The Delegation further stated that it understood that the legislation of most of the members of the Madrid Union envisaged the possibility of division at the national level and that, for reasons of equal treatment, it was not opposed to the introduction of division in the Madrid system. However, the Delegation indicated that such introduction should not place any burden on members of the Madrid Union whose legislation did not provide for division, as was the case in Madagascar, and should not complicate the procedures within the Madrid system and the tasks of the International Bureau. The Delegation concluded that the proposal made by the International Bureau, as presented in document MM/LD/WG/10/4, seemed to be the proposal which best reflected those principles.

74. The Delegation of the European Union expressed support, in principle, for the introduction of division of an international registration, as a desirable outcome, insofar as it preserved, as an underlying principle of the Madrid system, the making of international registration of marks simpler. The Delegation sought further clarification on the practical differences between the respective proposals outlined by the International Bureau and the Delegation of Switzerland, with a view to understanding the advantages of each proposal and to ensure that they would neither result in a more complex system nor place any undue extra burden on Contracting Parties.

75. The Delegation of Sweden, while expressing support for the statement made by the Delegation of the European Union, emphasized the need for further information and for more time to consider the proposal by Switzerland and, in particular, the impact it would have on the operations of the Madrid system, an assessment of which could be carried out by the

International Bureau. The Delegation emphasized the need to ensure that the introduction of division would only pertain to those Contracting Parties which already provided for division, thus not imposing the need to modify the national or regional applicable legal framework. The Delegation sought to further clarify this particular issue with respect to the proposal by Switzerland. Moreover, the Delegation expressed the view that allowing Contracting Parties to declare that the provisions concerning division of an international registration would not apply in their respective territories would not constitute an ideal solution. Considering that a majority of the Contracting Parties of the Madrid system did not have a legal framework in place that would allow for such possibility, this would result in a significant number of such declarations.

76. The Delegation of the United States of America, having compared the proposal of the International Bureau and the proposal by Switzerland, stated that it was its understanding that the proposal outlined by the International Bureau would record the fact that division had taken place in a designated Contracting Party, so that the public could be aware that an international registration might correspond to two different national registrations, each one uniquely identified. This would mean that an international registration, which had been divided at the national level, could continue to be renewed as a single international registration, and not as multiple international registrations. Such was the case in the United States of America where, even if an international registration was divided into multiple applications or registrations, the international registration would remain intact and only a single renewal fee would be required.

77. The Delegation of the United States of America noted that it would appear that, under the proposal by Switzerland, the international registration could be divided at the international level, where a particular Contracting Party had issued a provisional refusal with respect to some of the goods. This would split the international registration into two international registrations, which the holder would be obliged to track and maintain, paying two separate sets of fees. The Delegation added that matters could become increasingly complicated for the International Bureau and holders alike, should other Contracting Parties issue partial provisional refusals with respect to different goods or different classes, within the same international registration. The Delegation suggested that, given that an international registration could be divided in different ways with respect to different Contracting Parties, the proposal could result in a very complicated and unmanageable situation.

78. The Delegation of the United States of America indicated that it was aware of the importance that division at the national level might have for industry and that such option was available under its national law. Nevertheless, it considered that the proposal to divide an international registration might remove one of the great benefits of the Madrid system, which was having a single international registration, with a single renewal, having effect in multiple designated Contracting Parties. Under a divided international registration, the holder would face multiple international registrations to renew and maintain.

79. The Delegation of the United States of America was of the view that the proposal by Switzerland did not appear to contribute to the simplification of the Madrid system, but that, in fact, it would further complicate matters. Reflecting on the previous discussion concerning the review of the application of Article 9*sexies*(1)(b), the Delegation stated that, instead of moving forward to a single treaty system, the Working Group seemed to be looking back to the various features of the Agreement still in effect, which would not appear to be either forward-thinking or to contribute to the simplification of the Madrid system.

80. The Delegation of Algeria stated that its national legislation did not provide for the division and merger of international registrations. The Delegation added that it supported the statement made by the Delegation of Sweden, as to the need to bring clarity to the fact that the proposal by Switzerland should not, in any case, imply changes in national or regional legislations that did not envisage division and merger.

81. The Delegation of France expressed its support for the comments made by the Delegations of the European Union and Sweden. The Delegation said that it did not oppose the introduction of a procedure allowing for the division of international registrations, provided that it did not place a burden on the Madrid system. The Delegation emphasized that the division procedure was little used in a majority of the Contracting Parties to the Madrid system whose legislation envisaged such possibility. The Delegation advised caution and suggested obtaining further information and clarification on the different proposals under consideration. In particular, the Delegation noted the importance of obtaining further clarification on matters such as whether division would be available in Offices of designated Contracting Parties whose legislation did not provide for division of the international registration, or whether there would be a need to maintain a parallel national register, in order to publish and record the non-litigious part of the international registration which may have been the subject of division. The Delegation indicated that French users had suggested that they would prefer a more centralized procedure within the International Bureau.

82. The Delegation of Israel indicated that, as far as its legislation was concerned, division was available only for national applications. The Delegation, acknowledging the importance of the introduction of division in the Madrid system, stated its view that such procedure should be undertaken by the Offices of the designated Contracting Parties in accordance with the applicable national or regional legislation, and not by the International Bureau. Thus, where a request for division had been filed, the Office concerned would notify the International Bureau once such division had already taken place. Nonetheless, believing that the largest amount of information should be available to users of the system, the Delegation indicated that the resulting national or regional divisional application or registration numbers and their corresponding scope should be made available in ROMARIN. To this effect, the Delegation suggested that such information be included as required content of the notification, in an agreed format. Moreover, the Delegation considered that the sending of the notification should be mandatory and not optional, as the availability of this information would provide holders and all interested parties with a comprehensive view of the current status of protection in all designated Contracting Parties, which would result in the provision of higher quality services.

83. The Delegation of Germany sought further clarification of the situation whereby, while, on the one hand, it understood that the proposal made by the International Bureau would apply only to Contracting Parties which already provided for division in their national or regional laws and, therefore, such laws would not require to be amended, on the other hand, it appeared that the proposal by Switzerland would oblige Contracting Parties to amend their legislation in order to introduce the possibility of division of designations in international registrations. The Delegation further indicated that, in Germany, division, while envisaged for national applications, was not available for international registrations. Moreover, substantial procedural differences would not allow for the analogous application of the rules pertaining to division of national applications to designations of Germany in international registrations. Finally, the Delegation sought further information on the manner in which requests for the recording of a partial change in ownership were handled by the International Bureau.

84. The Secretariat confirmed that the understanding of the Delegation of Germany with respect to the proposal made by the International Bureau was correct.

85. The Delegation of Switzerland stated that the proposal by Switzerland was aimed at ensuring that any Contracting Party which provided for division at the national or regional level could also provide for division of international registrations, with the necessary notifications to the International Bureau. The Delegation drew the attention of the Working Group to the fact that the proposal by Switzerland, as noted by various delegations, would neither oblige Contracting Parties, which did not already provide for division, to introduce it, nor compel them to divide international registrations, following the notification of a partial refusal.

86. The Delegation of Norway, while welcoming proposals that would result in a more user-friendly Madrid system, said that it was important also to avoid unnecessary amendments which could increase its complexity. Thus, the Delegation concluded that the introduction of division and merger within the confines of the Madrid system should address a real need, whose existence was not entirely clear for the Delegation.

87. On the proposals under consideration, the Delegation of Norway considered that the document introduced by the International Bureau, while presenting an easy and manageable solution at the international level, raised some issues at the national level, should Norway decide to allow for division of designations in international registrations. A particular concern was related to the payment of renewal fees, which, in Norway, were due with respect to each resulting registration following division. Under the proposal, only one of those resulting fees would still be administered by the International Bureau, which would result in a deviation from the principle of centralized management. Moreover, Norway would have to consider the issuing of a national certificate for the divisional registration, in addition to the statements of grant of protection that would be sent to the International Bureau. Finally, the proposal could result in further complications with respect to national opposition proceedings, as an opposition could be lodged for the international registration as well as for the divisional application, and such would not be reflected in the communications exchanged with the International Bureau. The Delegation concluded that the proposal had the potential to complicate matters at the national level while perhaps not resulting in a more user-friendly Madrid system.

88. Commenting on the proposal by Switzerland, the Delegation of Norway said that it appeared to reflect the overriding principle of the Madrid system, whereby the International Bureau maintained an International Register which reflected the actual status of international registrations and their various designations. The proposal maintained the transparency of the International Register, allowing third parties to ascertain the status of an international registration and its various designations. Moreover, the proposal seemed to take into account that national practices concerning division and merger differed and it left to the Contracting Parties the decision as to whether to allow for division. However, the Delegation indicated that, as pointed out by the Delegation of the United States of America, the proposal also raised some practical issues concerning the information maintained in the International Register, which might not lead to a more user-friendly system. The Delegation said that it believed that the proposal by Switzerland required further elaboration. The Delegation also expressed interest in learning from the experience of those Contracting Parties which allowed for division of designations in international registrations.

89. The Delegation of Germany supported the comments made by the Delegation of Norway. The Delegation also sought further clarification on the proposal by Switzerland, particularly on the need to amend its current legislation, which did not allow for division of designations in international applications.

90. The Delegation of the Russian Federation stated that both proposals introduced a new procedure which currently did not exist in the Madrid system. The situation in the Russian Federation was closer to that outlined in the proposal by Switzerland, as it would not be possible for its Office to assign a national number to those registrations resulting from the division of an international registration. The Delegation considered that the introduction of division would further complicate matters, as it would result in new time limits for registration procedures, which might allow holders to circumvent the provisions of the Madrid system. Accordingly, the Delegation sought clarification as to how time limits would apply to registrations resulting from the division of an international registration.

91. The Delegation of Italy, supporting the comments made earlier by the Delegations of the European Union and Sweden, said that it would recommend that there be extensive discussions and further clarification on the advantages and disadvantages of each proposal under consideration. The Delegation added that it welcomed changes aiming at the further simplification of the Madrid system.

92. The Delegation of Spain, expressing agreement with the interventions of the Delegations of the European Union, Germany and Norway, said it believed that the introduction of division and merger would not simplify the Madrid system and it doubted its usefulness. Spain contemplated both division and merger of national applications and, in 10 years of experience, both had been practically inoperative, given the scarce number of requests. In the Delegation's view, it had been proven that division stretched proceedings, as would be the case with division after a partial opposition, where proceedings would have to be suspended until the division had been effected and all parties concerned had been notified. During the time it took to process a request for division, the administration could have resolved the matter. Moreover, a decision could become final with respect to a partial grant of protection, while, at the same time, it could be the subject of an appeal limited to the refused part. The Delegation stated that the Spanish system also provided for the merger of several single-class registrations into one multi-class registration, which was a mechanism that had worked. However, in the absence of a similar situation, the Delegation did not see the need for the introduction of such mechanism in the Madrid system. The Delegation concluded that the complications introduced by the proposed mechanisms would not be offset by their purported benefits.

93. The Delegation of Ghana, identifying with the concerns expressed by the Delegations of Germany and Sweden, advised caution before introducing provisions which could further complicate the Madrid system, making it less attractive for prospective Contracting Parties.

94. The Delegation of China informed the Working Group that amendments to its trademarks legislation, which would enter into force the following year, would allow for division. The Delegation expressed its support for the proposal outlined by the Secretariat, stating that it would neither increase the workload nor the costs of the International Bureau, while it would only add some notification-related work for Offices. The Delegation stated that the proposal would facilitate trademark protection and provide more information to users of the system and highlighted that the proposal contemplated a transitional period, which would enable Offices to put in place the necessary procedures.

95. The Delegation of Japan requested that the International Bureau study the matter more in depth, comparing the two proposals under discussion. The Delegation also indicated that it preferred that the matter be discussed during the next session of the Working Group.

96. The Representative of JPAA welcomed the introduction of division of an international registration before the Offices of the designated Contracting Parties, but it also indicated that it would be pleased to have further opportunities to consider the matter.

97. The Representative of INTA drew attention to the contribution posted by INTA on the Madrid System Legal Forum. He expressed the view that a number of findings stood out in the review undertaken by the International Bureau of the laws and practices of Contracting Parties of the Madrid system concerning division. The most important finding was that division was an international standard, enshrined in the TLT and the STLT, applied by a large majority of the member States of the Madrid Union. The second most important finding was the existence of a *de facto* mechanism for division provided by the procedure for the recording of partial changes in ownership. The third most important finding was that, whatever small the use made of division could be, there was a clearly identified need among brand owners for division.

98. Based on the said findings, INTA's contribution suggested a number of guiding principles to solve the question at hand, while meeting the needs of brand owners. The first of those principles was that applicants who chose the international route should have access to the same possibilities for division as those available to those who chose the national or regional route. Contracting Parties that did not provide for division at the national or regional level, should not be obliged to do so at the international level; however, with respect to those Contracting Parties who did so, there should be a procedure for division of international registrations. The second principle was that, in order to maintain the integrity and transparency of the International Register, for holders and third parties alike, division of an international registration should be recorded in the International Register. The final principle, considering that the purpose of division was mainly to set aside goods or services not affected by a refusal or by opposition or cancellation proceedings, was that division should be allowed on a Contracting Party-specific basis.

99. The Representative of INTA said that he recognized those principles in the proposal by Switzerland, which INTA was ready to support as a compromise solution that met the needs of users. On the other hand, INTA considered that the proposal of the International Bureau did not meet those needs. The Representative indicated that the idea was to divide the international registration with respect to a particular Contracting Party. He recalled that the United States of America was the only jurisdiction in the Madrid system which had a procedure in place for the division of territorial extensions. While this solution could be extended to other Contracting Parties, most delegations had expressed the view that this would require amendments to their national or regional laws, while others indicated that such solution would not be possible, as they did not maintain a register parallel to the International Register. The Representative indicated that a further weakness of the proposal made by the International Bureau was that notification of the division was not compulsory, which would not serve transparency. Finally, the Representative said that he shared most of the concerns expressed earlier by the Delegation of Norway.

100. The Representative of GRUR expressed support for the statement made by the Representative of INTA, adding that those delegations participating in the conferences leading to the TLT and STLT treaties had recognized that there was a good cause for the introduction of provisions which would allow for division. Moreover, in the context of the principle of equal treatment, the Madrid system could not be presented as a true alternative to the national route, where division, while provided at the national level, was not available at the international level. As the Representative of INTA had suggested, the way to provide equal treatment would be to introduce a procedure comparable to that in place for the recording of a partial change in ownership. Nonetheless, the Representative of GRUR indicated his willingness to consider a decentralized approach, such as that contained in both of the two proposals under discussion. The Representative urged the Working Group to move to the forefront the interests of users, who were to be served by the system, ahead of those of the national Offices or the International Bureau, reminding the delegations that it was users who paid for the services rendered by national Offices, both at the national and international level.

101. The Representative of GRUR indicated that the proposal by Switzerland was preferable to that of the International Bureau, further noting that there were two possible ways to implement this proposal at the national level. As indicated by some delegations, one way would be to have particular legislation in place providing for the division and merger of designations in international registrations. The second way to implement the proposal by Switzerland would be through the analogous application, *mutatis mutandis*, of provisions concerning national applications. The Representative cited, by way of example, the German Trademark Law, which prescribed that, unless otherwise provided in the Law, the provisions applicable to national

applications and registrations would apply, *mutatis mutandis*, to international registrations. The Representative concluded that there were ways to implement the proposal, without the need for further domestic legislation.

102. The Representative of GRUR said that there was a need to further study the practical implications of implementing the proposal, and that GRUR would be willing to participate in the ensuing discussions, maintaining as principles that the proposal upheld equal treatment and that it was implemented at a reasonable cost; no Contracting Party would be obliged to do more than what was already provided for national or regional applications; the International Bureau would not re-examine that which has already been examined at national level; and, it would uphold the transparency of the International Register, reflecting the current status of protection in each Contracting Party.

103. The Representative of AROPI echoed the comments made by the Representatives of GRUR and INTA. In particular, the Representative indicated that, as stated by the Representative of INTA, the proposal by Switzerland was a good compromise. Referring to the statements made by some delegations concerning the apparently complicated nature of the division procedure, the Representative indicated that users who requested the introduction of division would be the ones encountering the largest complications.

104. The Representative of AROPI said that the proposal by Switzerland would not create any obligation for those Contracting Parties whose legislation did not envisage division. The Representative added that the proposal simply stated that Contracting Parties whose legislation provided for division at the national level would apply the same provisions to allow for the division of international registrations. Recalling that a certain number of delegations had underlined the fact that the number of requests for division filed before their Office was limited, the Representative stated that allowing for division of international registration would not result in an increase in the number of such requests. Furthermore, while noting that the proposal by Switzerland would not cause additional work for the International Bureau, the Representative underlined the importance of assigning an international registration number to the divided part of the international registration.

105. Moreover, the Representative of AROPI, referring back to what had already been stated by the Representative of INTA, said that the proposal made by the International Bureau would apply only to those Contracting Parties whose Offices maintained a separate register for international registrations. However, the Representative recalled that the Offices of most Contracting Parties did not maintain such a separate register. For this reason, the Representative underlined the importance that it would have for users of the Madrid system if the International Bureau could assign a separate number to the divided part of an international registration. The Representative added that the proposal by Switzerland, given the attribution of a distinct international registration number, would provide users with increased certainty as to their acquired rights, enabling them to enforce such rights through appropriate legal actions.

106. The Representative of APRAM welcomed changes to the Madrid system and viewed them as additional opportunities rather than as increased complexity. The Representative stated that the proposal by Switzerland offered a balanced approach, providing additional opportunities without significantly increasing the burden of the International Bureau. Likewise, it would not imply additional work for national Offices, given that those which had national provisions allowing for division could apply them at the international level, while those which did not allow for division could simply make a declaration to that effect. Moreover, division would not add a particular burden to the International Bureau, as it could replicate procedures already in place with respect to requests for the recording of a partial change in ownership.

107. The Representative of APRAM expressed the view that the proposal outlined by the International Bureau was insufficient, as it would not allow for recording at the international level but rather at the national level, which would require maintaining a national register parallel to the International Register, something which, as stated before, would appear to be the case only in the United States of America. There would be a number of jurisdictions which, while providing for division in their national laws, would not be able to effect and record such division for designations in an international registration, due to the fact that in those jurisdictions only a register for national registrations was maintained. Thus, the Representative concluded, there was a need to provide for recording of division at the international level, which was the main compromise reflected in the proposal by Switzerland.

108. The Secretariat, in response to a question previously raised by the Delegation of Germany, delivered a presentation explaining how partial changes in ownership were recorded in the International Register and notified to the holder and the Offices of the Contracting Parties concerned. The Secretariat also provided some statistical information concerning such recordings.

109. The Delegation of Germany commented that it received many queries concerning the scope of protection of international registrations in Germany, a task which was rendered complex by the reunification of two former German States and that, in some cases, the relevant physical files may have been destroyed. The Delegation said that situations, such as a partial change in ownership or division, could further add to this complexity and make it ultimately impossible to determine the actual scope of protection in a given designated Contracting Party.

110. The Delegation of Colombia indicated that, even though it had provisions in place allowing for division, recording such in the International Register might be rather complex, given that division could actually happen between goods or services within one class, resulting in two registration certificates concerning one mark with one international registration number. The Delegation sought further clarification with respect to the two proposals under consideration. In principle, the Delegation stated, it did not see further financial implications, as division would not result in additional classes in the international registration. However, the Delegation warned that this might not be the case at the level of a designated Contracting Party, where, upon renewal, the holder might not pay the fees required to maintain the divisional registration. The Delegation wondered how this particular situation would be reflected in the International Register.

111. The Secretariat, addressing a question posed by the Delegation of Madagascar, explained the manner in which the recording of a partial change in ownership concerning one particular Contracting Party was notified to the Office concerned. Additionally, in response to a question posed by the Delegation of the United States of America, the Secretariat outlined the manner in which the recording and notification of a partial change in ownership, concerning some only of the designated Contracting Parties and some of the goods or services, was handled.

112. Referring to a question raised by the Representative of APRAM, the Secretariat indicated that requests for the recording of a partial change in ownership concerning only one Contracting Party would not be particularly more complex than other similar requests. In addition, the Secretariat confirmed that the International Bureau could use the solutions developed to handle requests for the recording of a partial change in ownership to handle requests for the recording of division. However, the Secretariat also warned that, using solutions, developed to address one particular issue, to deal with a new situation, might eventually make it more difficult to ascertain the actual scope of protection of an international registration in designated Contracting Parties. The Secretariat further added that, from a theoretical modeling perspective, a solution to this particular problem might be found by uniquely identifying each designation.

113. The Delegation of the United States of America, commenting on the possibility that each designation could bear a unique identifier, such as a serial or tracking number, questioned whether such would not interfere with the work of Offices which already provided for such unique identifiers in their national systems, such as the Office of the United States of America, as it would add another number to monitor.

114. The Chair, noting that there did not appear to be consensus for either of the two proposals under consideration, said that some general concerns had been raised by a number of delegations and that more information on division and merger of international registrations had been requested. The Chair also recalled that some delegations had stressed the need to have as much information as possible available in ROMARIN but that any new mechanism should neither increase the complexity of the system nor require Contracting Parties to amend their applicable laws. The Chair concluded that some general guidelines had been afforded but urged delegations to provide more detailed information as to how the International Bureau should continue to pursue the matter.

115. The Delegation of Switzerland said that there appeared to be a general interest in continuing to work on the possible introduction of division in the Madrid system. The Delegation therefore suggested that the International Bureau, as it had done the previous year, work with interested Offices and user-organizations to present a new proposal on the introduction of division in the Madrid system during the following session of the Working Group. The Delegation said that the new proposal should bring to an end the discrepancy between the national or regional route for trademark registration, which allowed for the division of registrations, and the international route, which currently did not so provide. The Delegation added that, regarding Contracting Parties whose legislation provided for division at the national or regional level, such provisions should also be applied to allow for the division of international registrations of marks. Meanwhile, the Delegation stated that those Contracting Parties whose legislation did not provide for division at the national or regional level should not be obliged to introduce provisions to that effect.

116. The Delegation of Switzerland stated that the new proposal should minimize the additional work introduced by the division procedure for designated Offices and for the International Bureau. The Delegation considered that, in line with what had been proposed in document MM/LD/WG/10/6, the Office of the designated Contracting Party should undertake the substantive examination of the division request, according to its national or regional legislation, while the International Bureau should record, notify and publish such request as its main task.

117. The Delegation of Switzerland said that the new proposal should take into consideration the fact that the majority of the members of the Madrid Union did not maintain a national register for international registrations. In that sense, the Delegation indicated that the new proposal should provide for a new international registration number to be assigned to the divided part.

118. The Delegation of Switzerland suggested that the International Bureau publish, at the end of the year, a draft proposal on the Madrid System Legal Forum, allowing Offices and user-organizations to post comments for a period of two months. The Delegation further recommended that, based on those comments, the International Bureau prepare a final proposal for consideration during the following session of the Working Group.

119. The Delegation of the Russian Federation expressed support for the proposal made by the Delegation of Switzerland which, it said, was practical.

120. The Delegation of Japan stated that it viewed the issue as the combination of roughly three ideas, namely, maintaining the Madrid system reasonably simple, the use of certain built-in mechanisms to carry out the current operations of the Madrid system and the assessment of the actual need of users. The Delegation expressed the wish that these ideas be kept in mind when revisiting the issue during the following session of the Working Group.

121. The Delegation of Japan indicated that, as a result of the discussions, it had come to realize that the issue was more complex than it had initially thought and expressed its concern that it might increase the complexity of the Madrid system. The Delegation said that it had considered, from the beginning of the discussion, that the two proposals originally outlined, while providing a good starting point for the ensuing discussions, missed certain elements. The Delegation highlighted, as some of these elements, firstly, the need to introduce more detailed provisions into the Common Regulations, as the proposal would induct decisions taken by the designated Contracting Parties into the Madrid arena, as well as the need to consider some transitional provisions; secondly, the need to amend provisions concerning payment of the second part of the two-part individual fee; thirdly, the need to introduce detailed merger procedures, as the inevitable consequence of the introduction of division; and, fourthly, to take into account that the quality of the recording effected in the International Register would be a product of the way such information had been first recorded in the national registers.

122. The Delegation of Germany said that it failed to see the difference between the original proposal and the new proposal by Switzerland. The Delegation indicated that the latter would also imply the need to introduce changes to national legislations, which had been opposed by several delegations. Under such circumstances, the Delegation of Germany failed to see that there was a path to move forward with the subject at hand.

123. The Delegation of Italy, agreeing with the Delegation of Germany, stated its belief that the proposed change was not in the spirit of the further simplification of the Madrid system. The Delegation wondered whether the proposed change was really necessary.

124. The Delegation of the Czech Republic, while agreeing with the comments made by the Delegations of Germany and Italy, stated that the proposal regarding division was a positive development which responded to the expressed needs of users. However, noting that the legislation of the Czech Republic did not provide for division, the Delegation stated that it failed to see how the discussion could be moved forward, as most of the Contracting Parties did not seem to have legislation allowing for division of international marks. Finally, the Delegation thought that the introduction of division could result in increased fees for users of the system.

125. The Delegation of Romania, while indicating that it would require more time to evaluate the new proposal by Switzerland, said that it supported it, in principle.

126. The Delegation of the European Union re-stated its earlier position concerning the two proposals originally under discussion.

127. The Delegation of Colombia, expressing its support for the proposal which had just been made by the Delegation of Switzerland, invited the Working Group to consider not just the need to simplify the system but also the need to serve right holders. The Delegation suggested that, provided national laws allowed for division, the Working Group should find a common denominator which would enable such provisions to be aligned with the Madrid system.

128. The Delegation of Morocco stated that, while the new proposal by Switzerland appeared to be interesting, it seemed that it did not take into consideration all the aspects which had already been mentioned, in particular, required changes to national or regional legislation of some Contracting Parties which did not already provide for division. Therefore, agreeing with

comments made by the Delegation of Germany and other delegations, the Delegation of Morocco concluded that the new proposal by Switzerland, while requiring some modifications, could be the basis for further discussions.

129. The Chair indicated that, while there was consensus on the need for further discussions, there appeared to be two proposals on how to move forward. On the one hand, it was suggested that the International Bureau undertake a comparative study of the proposals originally outlined, while, on the other hand, it was recommended that the International Bureau prepare a completely new proposal.

130. The Delegation of Switzerland stated that it would be difficult for the International Bureau to take into account all the comments that had been made during the discussion in order to present a new proposal. The Delegation said that it had previously suggested that interested Offices and observers interact with the International Bureau in order to present such new proposal. Therefore, the Delegation proposed the use of the Madrid System Legal Forum as a mechanism to facilitate such interaction. However, the Delegation noted that some delegations had encountered problems while accessing the forum. Accordingly, should the Madrid System Legal Forum not be available, the Delegation underlined the importance of providing for another mechanism for the holding of preliminary consultations and submission of comments on a draft proposal, which would then assist the International Bureau to elaborate a final proposal.

131. The Secretariat indicated that the International Bureau could produce a new document and that, to this effect, it would welcome further contributions from Offices and user-organizations. The Secretariat suggested having a first draft available for comments before the end of the year. The draft could be posted on the Madrid System Legal Forum as well as sent to Offices. Based on the comments received, the International Bureau could present a new document on the subject during the following session of the Working Group.

132. The Delegation of the European Union stated that the time limit proposed by the Secretariat seemed to be rather short. The Delegation said that, as the European Union had internal constraints, it needed time to discuss the issue of division and, in particular, to consider any new proposal which would be prepared by the International Bureau. The Delegation preferred that any new proposal prepared by the International Bureau be considered during the following session of the Working Group, once the document containing the proposal had been made available on the Madrid system website, and the proposal could then be the subject of possible modifications.

133. The Delegation of Switzerland stated that delegations which could do so, should be able to provide comments to the International Bureau, and that such comments would be useful in order to elaborate a new proposal. The Delegation of Switzerland added that those delegations which could not submit comments would have the opportunity to do so during the following session of the Working Group. The Delegation recalled that decisions were taken during the sessions of the Working Group, further noting that the place where decisions were taken would not change. The Delegation said that it thought that the use of the Madrid System Legal Forum could be constructive, as it would allow delegations to interact among themselves between the sessions of the Working Group.

134. The Chair proposed four months as a suitable period to provide comments on the first draft of the document to be presented by the International Bureau during the following session of the Working Group.

135. The Delegation of the European Union stated that, while it was not opposed to an informal consultation process among the International Bureau and the Offices and user-organizations concerned, discussions leading to the amendment of any proposal presented by the International Bureau should only take place during the following session of the Working Group.

136. The Chair indicated that the consultation process proposed to take place during the aforementioned period, which would lead to the final version of the document to be presented by the International Bureau, would be completely informal.

137. The Delegation of Germany, supporting what had been said by the Delegation of the European Union, stated that comments on the document produced by the International Bureau should not be confined to a specific period and that they should not lead to a revised version of such document.

138. The Delegation of the European Union indicated that it supported the preparation by the International Bureau of a new document, taking into account all the observations raised by various delegations, with a view to discussing it in the following session of the Working Group. The Delegation said that it did not support the idea of producing an intermediate document, which would then be revised based on informal comments received through the Madrid System Legal Forum.

139. The Delegation of Switzerland stated that it believed that proposals and comments made by the participants in the Working Group would not interfere with the work of the International Bureau, and that it considered that such collaboration could take place through the use of the Madrid System Legal Forum. The Delegation of Switzerland further stated that it considered that delegations not partaking in this process would always have an opportunity to express their point of view during the following session of the Working Group.

140. The Chair concluded that the Working Group had agreed to request that the Secretariat prepare a new document concerning division and merger, taking into account all the comments and concerns raised by delegations during the current and previous sessions of the Working Group; and that, for this purpose, the Secretariat would, before the end of the year, invite delegations and user-organizations to provide further contributions or suggestions.

AGENDA ITEM 7: REVIEW OF THE PROPOSAL ON TRANSLATIONS REQUESTED BY THE MADRID UNION ASSEMBLY

141. Discussions were based on document MM/LD/WG/10/5.

142. The Secretariat began by presenting a fragmentary view of certain elements of the Madrid system, where the evolution of the number of inscriptions effected by the International Bureau was recalled. The Secretariat then went on to provided statistical information concerning the operations of the Madrid system during the previous year, describing the objectives under which the International Bureau was implementing a strategic plan to improve the performance of such operations. Finally, the Secretariat delivered a brief update on information technology developments, such as the automation of some of its processes, *inter alia*, classification, examination and translation, and on the modernization program of the legacy solutions used to administer the International Register.

143. The Secretariat, addressing a question posed by the Delegation of the Russian Federation, stated that a web-based form for the request for translation of statements of partial grant of protection, following a provisional refusal, and limitations, was already available on the Madrid system website. With respect to automation, it was confirmed that 30 per cent of the translation work undertaken by the International Bureau concerning international applications was automated. Such automation leverage was higher with respect to applications filed before the Offices of certain Contracting Parties, such as the Russian Federation, due to the fact that the terminology used in such applications generally corresponded to standard descriptions used in the International Classification of Goods and Services for the Purposes of the Registration of

Marks (Nice Classification). The Secretariat stated that, following the modernization of the technological environment, there would be an increase in the percentage of automated translation work; however, at that stage, it was too early to determine the magnitude of such increase.

144. The Secretariat, referring to a question raised by the Delegation of the European Union, indicated that, without considering translation, the processing time to record a request for a limitation was 45 days. Moreover, under the new practices concerning translation, anyone could request that statements of partial grant of protection, following a provisional refusal, and limitations, be translated into any working language of the Madrid system in which it was not already available.

145. The Delegation of Spain stated that albeit complete, the presentations delivered by the Secretariat leaned heavily on economic arguments, which were aimed at presenting the reforms proposed by the Secretariat as the only alternative which would make the system more efficient and economically viable in the future. The Delegation stated its belief that the presentations failed to provide more detailed budgetary information to determine whether the resources required would, indeed, be high in the context of the current economic situation of the Madrid system, which would not appear to be fragile when, in fact, the system had experienced a surplus.

146. The Secretariat, addressing a question posed by the Delegation of Italy, indicated that the current increase in the workload resulted from higher use of the Madrid system in current Contracting Parties, but that further increases in workload resulting from future accessions could not be excluded. With respect to an increase in the number of filing languages that could be used in the Madrid system, the Secretariat stated that there were no ongoing discussions on the subject, but that the International Bureau had worked on the expansion of the G&S Manager into 10 languages and that the addition of other languages would certainly be welcomed.

147. The Delegation of Cuba thanked the International Bureau for its ongoing support, particularly for the implementation of a system developed by WIPO to facilitate the administration of industrial property Offices, which included a Madrid system module, and for establishing electronic communication with the Office of Cuba. The Delegation encouraged Offices of other Contracting Parties to use electronic communication. The Delegation stressed the importance of the role that Offices played, both as Offices of origin and as Offices of designated Contracting Parties, in bringing about a decrease in the incidence of irregularities in the operations of the Madrid system.

148. The Secretariat, introducing document MM/LD/WG/10/5, recalled that the matter had been initially discussed during the previous session of the Working Group, where the International Bureau had proposed amendments to Rule 6 of the Common Regulations with the purpose of regularizing a situation that had been in existence for some time.

149. During that session, the International Bureau had informed the delegations that there was an increasing translation backlog of statements of grant of protection, following a provisional refusal, made under Rule 18*ter*(2)(ii). The International Bureau had also stated that there had been a practice in place for some time under which such communications had not been routinely translated into the two other working languages of the Madrid system. It had been further explained that the proposed changes would allow for a more rational allocation of the existing resources, placing the International Bureau in a better position to absorb future growth, resulting from increased use and future accessions, while still satisfying the needs of the users of the system.

150. The Working Group had not achieved consensus on the proposed amendments to Rule 6, but it had agreed to recommend to the Madrid Union Assembly that it take note of the proposal as a practice concerning translations of the aforesaid statements. The Working Group had further recommended that the International Bureau implement a similar practice with respect to limitations, and had recommended the Madrid Union Assembly to take note accordingly. The Madrid Union Assembly, while taking note of those practices, had referred the issue to the following session of the Working Group for further review.

151. The Secretariat recalled that the standing practices concerning the aforesaid communications entailed that the International Bureau record them in the language in which they were received. The International Bureau would then translate them into the language of the international application and the language of communication of the holder, where different, ensuring that the holder received all the necessary information in his chosen language. Translation of those communications into another working language would be provided only upon request.

152. The Secretariat stated that the document under consideration provided a conceptual framework on the scope of the trilingual regime in the Madrid system, presented background information on the overall translation tasks undertaken by the International Bureau, in particular, such related to the translation practices under review, and reintroduced a financially sustainable proposal resulting from a more rational allocation of the resources, which was attuned to the linguistic regime of the Madrid system.

153. The Secretariat indicated that the trilingual regime entailed that a given operation could be performed in any of the three working languages indicated in Rule 6 of the Common Regulations, at the choice of Offices, applicants or holders. It further entailed that operations were to be carried out in all three working languages, where the given operation was to be performed in respect of or by the International Bureau. Where the operation concerned the relation between Offices of origin and applicants, the Offices were entitled to restrict the principle of the trilingual regime by limiting the number of languages in which international applications could be filed with such Offices.

154. In February, 2012, the number of pending translations relating to decisions sent under Rule 18*ter*(2)(ii) had reached more than 179,000, the equivalent of roughly 17.74 million words, with an outsourcing cost of 4.43 million Swiss francs. At the same time, there had been no externally motivated requests for translation, which could be seen as a confirmation that there had not been much demand for such translation.

155. The Secretariat further stated that the proposed amendments to Rule 6 equally applied to operations concerning statements of grant of protection, following a provisional refusal, and limitations in any of the three working languages. The recording and publication of such transactions would be, respectively, first, in the working language in which the statement or request had been received; second, in the language of communication of the designated Offices concerned; and, third, where applicable, in the language of the relevant international application and in the language of communication of the holder.

156. As the proposed amendments applied equally to operations in the three working languages and produced the same effects in all of them, they were, in fact, respecting the Madrid trilingual regime. The proposed amendments would only impinge on the moment on which information, in a given language, would be made available to interested parties, but it did not prejudge or limit the languages in which this information could be made available. The proposal would also contribute to the sustainable expansion of the Madrid system, while effectively and efficiently serving the needs of its users, as almost all transactions effected under the Madrid system would still be systematically translated into the three working languages.

157. The Secretariat further suggested that the proposed changes to the Common Regulations, while upholding the principle of the trilingual regime, would result in a financially sustainable linguistic policy which balanced the interests of holders of international registrations and Contracting Parties, along with the legitimate interest of third parties. The proposal addressed in earnest a long-standing and increasing problem faced by the Madrid system.

158. The Delegation of Spain stated that it considered that the proposal contained in the document under discussion contradicted the policy of multilingualism of the United Nations, which did not just entail non-discrimination of certain languages, but the equitable use of all languages. The Delegation, recalling that the United Nations General Assembly, in resolution A/RES/65/311, dated July 19, 2011, had stressed the equality of all United Nations official languages, said that that required actions aimed at redressing certain inequalities. Such inequalities were perceived in the proposal and in the practices adopted by the International Bureau, where, for instance, the highest numbers of translations pending were into Spanish.

159. Furthermore, the Delegation of Spain advised of the danger of considering linguistic matters from a purely economic perspective. Referring to its previous intervention, the Delegation stated that the presentations delivered by the Secretariat lacked arguments in favor of a multilingual system guaranteeing access to information regarding proceedings, in their language, to an increasing number of citizens. The Delegation cited paragraph 194 of document JIU/REP/2011/4, a report prepared in 2011 by the Joint Inspection Unit of the United Nations System concerning multilingualism in the United Nations system organizations, which stated that "*As far as multilingualism is concerned, budgetary constraints cannot be the Procrustean bed for aligning fair treatment of languages on inadequate standards and for the degradation in the quality of services due to Member States*". The Delegation further said that, in the current economic context and with the financial limitations faced by all, the inclination toward monolingualism for the sake of pragmatism was far from diminishing, and the cited document alerted of such risks whenever multilingualism was debated.

160. Concerning the proposal at hand, the Delegation of Spain said that it had the impression that neither necessary economic efforts had been undertaken nor had potential economic savings, which existed, been envisaged. The Delegation said also that the document lacked budgetary and economic data concerning the Madrid system which would allow Contracting Parties to make an informed decision, taking into account all possible aspects.

161. The Delegation of Spain questioned the way in which the Rule change had been proposed. The Delegation recalled that, when the linguistic regime of the Madrid system had been expanded to incorporate Spanish, it had been said that such reform would result in great benefits and that it would simplify the system. The Delegation said that a budgetary assessment of the costs resulting from the proposed changes should have been conducted at that time. Instead, a few years later, without actually having implemented the trilingual regime as envisaged by the Common Regulations, it had been reported to the Working Group and to the Madrid Union Assembly that there was a problem and thus the norm had had to be changed. Concerning the proposed amendments, the Delegation concluded that they had been introduced to give legal coverage to a practice that, in fact, the International Bureau had carried out for a number of years, without previously seeking authorization, and which was in contradiction of the current legal framework.

162. The Delegation of Spain stated that it should be made clear that this particular way of dealing with this apparent problem was a problem in itself. The Delegation said that the original problem probably had been that the International Bureau had understood that it was spending more than what it had originally budgeted or estimated for the implementation of the trilingual regime, and that such conclusion had been reached without first complying with the Common Regulations or reporting the issue to the member States. A practice had been adopted, without prior consent, and then changes to the Common Regulations had been presented as the only

solution. The Delegation expressed the view that such conduct was reprehensible and said that it posed a very serious risk of legal uncertainty, perhaps more serious than the potentially high costs of having a trilingual regime.

163. The Delegation of France, aware of the stresses affecting the International Bureau and in a spirit of compromise, stated that it agreed with the current practices of translation upon request of the list of goods and services in statements of partial grant of protection and limitations. However, the Delegation said that those practices should not be legalized in the Common Regulations, as proposed in Document MM/LD/WG/10/5. The Delegation underlined the importance of keeping the current practices as an *ad hoc* mechanism. The Delegation indicated that it believed that the legalization of those practices would put into question the policy of multilingualism. The Delegation expressed its support for the intervention made by the Delegation of Spain concerning respect for the policy of multilingualism within the United Nations system and echoed its warning concerning the danger of taking a purely economic approach. Finally, the Delegation said that the International Bureau could propose other ways to address the problem posed by translation costs.

164. The Delegation of Japan stated that it agreed with the proposal made by the International Bureau which, in addition to providing a solution to the increasing growth of the Madrid system, solved a problem faced by the Office of Japan. Where a holder filed a request for the recording of a limitation concerning Japan before the International Bureau, prompted by a notification of provisional refusal issued by the Office of Japan, such recording would be notified to their Office more than a year later, after it had been translated into all working languages of the Madrid system. In such cases, while the Office of Japan withheld its final decision, out of respect for the holder, the holder could have benefited from earlier protection. The Delegation added that the current practice on translation had worked effectively to reduce the aforementioned problem. The Delegation stated that it viewed the problem at hand as one concerning delayed processing and not just limited to the issue of translation. From that perspective, the Delegation concluded, the proposals contained in the document under discussion offered a more reasonable approach to solving the mounting workload than merely increasing the budget of the International Bureau or expanding its functions.

165. The Delegation of Sweden expressed its support for the proposal submitted by the International Bureau. The Delegation underlined the need to keep procedures simple, in order to maintain a well-functioning system. As described by the International Bureau, the current legal standard for translations had resulted in significant backlogs and delays, negatively affecting users. The Delegation, aware of the fact that the proposal for a simplified translation procedure had been questioned from a linguistic perspective, stated that it considered that the proposal would not affect the trilingual regime, as all three languages would still enjoy equal legal treatment. Such fact ought to be considered independently from the actual demand for translation in different languages, which may result in more translations carried out into some languages.

166. Considering the current situation, where the International Bureau had been forced to simplify its procedures without legal coverage, the Delegation of Sweden said that it believed that the Working Group could not ignore the need to change the current legal framework, and it believed that a point had been reached where there was a strong need for member States to seek a flexible approach. As had already been pointed out by the International Bureau, the proposed changes would result in a cost-saving and financially sustainable policy, which the Delegation believed would take into account the interests of holders, member States and third parties alike. The introduction of the proposed changes would allow for a more rational allocation of the existing resources, while still satisfying the needs of users. The Delegation stated that it was convinced that the proposal would speed up procedures and contribute to serving the needs of users.

167. Compared to previous proposals, the Delegation of Sweden expressed the view that the proposal under discussion was a reasonable solution. The Delegation concluded by reaffirming its support for the proposal, as presented; nevertheless, while awaiting future legal changes to be introduced, the Delegation indicated that it would support a continuation of the current practice.

168. The Delegation of the Republic of Korea expressed the opinion that the new translation practice, in place since January 2012, had shown a certain impact in the shortening of the backlog in the operations of the International Bureau, which it considered to be the most important issue in order to shorten the pendency period in the Madrid system. Thus, the Delegation said that it supported the proposed changes in the Common Regulations. However, the Delegation considered that the phrase "*in that language*", used at the end of proposed new paragraphs (4)(c) to (4)(f) of Rule 6, was confusing and, in the absence of the explanation provided by the Secretariat, could be interpreted in different ways. The Delegation suggested that, for the sake of clarity, that phrase could be replaced, in the proposed new paragraph (4)(c) with the phrase "*in the language of the international application*". In addition, the same phrase could be replaced, in the proposed new paragraphs (4)(d) to (4)(f), with the phrase "*in the language notified under paragraph (2)(iii)*".

169. The Delegation of Hungary said that recognizing the trend in the evolution of the Madrid system which had triggered the operational problems described by the Secretariat, it acknowledged the need to find a legally consistent solution. Nevertheless, the Delegation said that it wished to associate itself with the observations and suggestions made by the Delegations of France and Spain, agreeing that, in order to find the appropriate solution, it could be fruitful to engage in further consultations and in-depth analysis regarding the proposal contained in the document under consideration and its practical implications. In this regard, the Delegation, made reference to what had been said earlier by the International Bureau regarding a possible future increase in automated translations and suggested that such might be an important factor in finding a solution.

170. The Delegation of Israel indicated its support for the proposal introduced by the International Bureau as necessary in order to address costs and expedite services concerning translation.

171. The Delegation of the Russian Federation, also indicating its support for the proposal made by the International Bureau, stated that it understood that the Madrid system was a system of mechanisms with clearly set rules, which applied to all the stakeholders in the system, namely, users, right holders, Offices and the International Bureau. Where such rules were breached, the party committing such breach, as, for example, in the case of an international applicant, would receive a notification of irregularity to ensure proper adherence to the rules. The Delegation added that all the stakeholders in the system should follow the legal mechanisms and that, where the practices of the International Bureau slightly differed from the rules, the legal framework should be amended, as was now particularly the case with Rule 6 of the Common Regulations. The Delegation recalled, as had been done earlier by the Delegations of Hungary and Sweden, that one of the main advantages of the Madrid system was its flexibility, which had allowed the system to exist for so many years. Accordingly, the Delegation expressed its belief that the Working Group had to show flexibility and understand that the current situation had to be resolved through amendments to the Common Regulations. The Delegation said that it envisaged that emerging scenarios, such as an increase in the percentage of automated translations, could offer a different solution in the future, so that a policy of translation upon request would no longer be needed. Referring to the low number of requests for translation that had been received by the International Bureau, the Delegation queried whether this might have been due to the fact that few users actually knew that such request could be made online.

172. Concerning the issue of multilingualism, the Delegation of the Russian Federation stated that, in its view, this could be considered from different perspectives and interpreted in various ways; however, the Delegation said that it understood that the resolutions previously invoked were an appeal to the various United Nations organizations for a broader use of all United Nations official languages in all its systems. The Delegation recalled that such was not the case with the Madrid system with respect to Arabic, Chinese and Russian. In that sense, the Delegation recalled that the Russian Federation was, in collaboration with the International Bureau, translating the contents of the Madrid System Goods and Services Database (G&S Database), an exercise that could be envisaged with respect to other United Nations languages. Finally, the Delegation called upon the Working Group to ultimately remain focused on the interests of the users of the Madrid system.

173. The Delegation of Switzerland said that, while it was in favor of multilingualism within the United Nations system, it thought that a distinction should be made between the promotion of multilingualism and the equal use of various languages in the different Working Group documents. The Delegation added that the translation of such documents should be made on time and should be of quality. Moreover, the Delegation stated that the interpretation provided during the sessions of the Working Group should also be of quality. The Delegation stated that, from its point of view, the case under consideration was different, as it did not concern Working Group documents, but individual requests. The Delegation said it believed that the proposal under consideration did not discriminate against any language, as such. Therefore, the Delegation remarked, the proposal preserved multilingualism within the Madrid system.

174. The Delegation of Switzerland stated that, up to that time, Swiss stakeholders had not raised any issues concerning the current practice. The Delegation said that, as had been its position in the previous year, it was in favor of formalizing the practices of translation upon request, which would create legal security and allow for the rational allocation of the funds of the Madrid Union. However, the Delegation stated that, in the spirit of compromise, it could be content with maintaining the practice as it stood.

175. The Delegation of Sweden, agreeing with the statements made by the Delegations of Japan and Norway, stated that it fully supported the proposal on translation presented by the International Bureau, as a sensible solution which reflected a pragmatic approach to the implementation of the trilingual regime in the Madrid system. The proposal reduced the workload and costs associated with the translation of documents for which users appeared to have small interest, while balancing the needs of third parties by facilitating their translation upon request. The proposal would align the Common Regulations with the standing practice, while maintaining an efficient system where costs and workload were kept at a manageable level. Evoking the principle of a user-friendly Madrid system, the Delegation said that it considered that the changes should be adopted as proposed. Nevertheless, until such changes had been approved, the Delegation supported a continuation of the current practice which, while reducing costs, could allow the International Bureau to focus its attention on tasks beneficial to Contracting Parties and users alike, such as providing for the automated translation of the list of goods and services into more languages.

176. The Delegation of Denmark, commenting on the document under discussion, said that it supported, in principle, the proposal put forward by the International Bureau. The Delegation, as it had done during the previous sessions of the Working Group, further noted that all three working languages of the Madrid system would receive equal treatment, and that translation would be made available upon request. Moreover, in respect of limitations, the International Bureau would routinely translate the limitations into the language of the international application, ensuring that holders would have all documents concerning their rights in their preferred language. The Delegation, stating that the Madrid system ought to operate in an efficient and user-friendly manner for its administrators and for its users, recalled that several Offices were faced with challenges and were required to examine their systems and workflows in order to

improve the delivery of timely and cost-effective services. The Delegation, stressing the fact that the proposal would allow the Madrid system to increase its efficiency while decreasing its costs, indicated that it had listened to the arguments put forward and that it had realized that the Working Group had to deliver a flexible solution which would allow it to move forward. The Delegation said it believed that such solution could be found in the information provided by the Secretariat. Thus, the Delegation wondered whether it could be possible to allow for the continuation of the current practice, for a certain period, while the International Bureau explored the further development of automated translation.

177. The Delegation of Italy, after studying the document under discussion, expressed support, in general terms, for the views expressed by the Delegations of France, Hungary and Spain. Nonetheless, after listening to the interventions of other delegations, such as the Delegations of Japan and the Russian Federation, the Delegation of Italy stated that it remained flexible and that it did not strongly oppose the proposed changes. The Delegation noted that further advances in automated translation could be achieved through the increased use of online tools already available to users. Taking into account the intervention made by the Delegation of Japan, the Delegation of Italy said that it believed that it was also important to avoid any potential backlogs which could, in turn, delay the decisions delivered by Offices.

178. The Delegation of Cuba, after reviewing the document under consideration, stated that the underlying concern around practices which could affect the use of any of the working languages of the Madrid system, particularly Spanish, remained. The Delegation said that it believed that the proposal, in spite of being practical and non-discriminatory, left a bad taste, at least among the Spanish speaking Contracting Parties. Their expectations, concerning the expansion, eight years ago, to three working languages or, in other words, to a trilingual regime, were being affected, which was discouraging. The Delegation stated that for Cuba, a country with serious economic limitations, it remained essential that the trilingual regime be fully preserved. Even though a sustainable solution was already in place, such solution had left, according to the International Bureau, 92,069 documents not translated into Spanish, which represented 50.3 per cent of the total number of documents sent under Rule 18*ter*(2)(ii) awaiting translation. In other words, out of the 4.53 million Swiss francs required to address the 182,989 pending translations, roughly two million Swiss francs would have guaranteed this undertaking into Spanish.

179. The Delegation of Cuba questioned the neutrality of the decision taken with respect to languages as well as its contribution towards the preservation of the interests of holders, whose documents were not being translated into other languages, mainly from English and French into Spanish, as the statistics provided had shown. The Delegation also questioned whether demand would remain the same, once users of the system knew of the practice which had been implemented. The Delegation said it believed that neither users of the system, nor Offices, had been fully aware of the fact that the practice in question would not result in a fully transparent situation with respect to industrial property rights in the Contracting Parties of the system. The Delegation cited, by way of example, the fact that one of the documents which was not being published in all working languages concerned final decisions, which could have been the result of administrative or judicial proceedings. Such decisions, which could initiate further proceedings, would not be known by all Contracting Parties insofar as translation had not been requested.

180. The Delegation of Cuba stated that the need to guarantee that all documents be translated could be resolved taking into account, on the one hand, the surplus resulting from the increased use of the Madrid system, which, as a result of the record number of international applications filed as from 2010, might not be slight; and, on the other hand, the possible implementation of more productive information technology solutions. The Delegation expressed its disagreement with the proposal contained in the document under consideration. In addition, the Delegation expressed its dissatisfaction with the fact that, concerning a few of the

documents of the Working Group, only the English versions had been published at an early date. This fact forced Offices to study and review highly complex texts, in which even amendments to legal provisions were proposed, only in English. Nevertheless, the Delegation acknowledged the efforts made by the Secretariat to publish documents for the current session of the Working Group some time in advance and requested that this practice be maintained in the future.

181. The Delegation of Colombia, taking into account the presentations made by the Secretariat and the interventions made by previous delegations, said it viewed the Madrid system as analogous to an endurance race where, while the current translation backlog concerned mainly Spanish, evolving circumstance could eventually shift this backlog into another language. In consequence, the Delegation considered that the practice was not discriminatory but rather egalitarian. In addition, the Delegation said that it envisaged a future scenario where technological advances could enable the International Bureau to overcome the current translation backlog, rendering obsolete the proposed changes to the Common Regulations. As a result, the Delegation stated its belief that the current practice could stand, subject to periodic reviews, within a reasonable period, to assess emerging technologies in order to find the most suitable solutions to address the problem. Moreover, the Delegation expressed the view that further studies could be undertaken with a view to standardizing the way in which information was provided with respect to the four transactions discussed in the document under consideration.

182. The Delegation of Spain, while still of the view that the proposal contained in the document was inadequate, said that it was also aware of the difficulties faced by the International Bureau in dealing with the current translation backlog. In that sense, the Delegation of Spain thanked the Delegation of Colombia for its constructive intervention and stated that it could agree with a continuation, for a limited time, of the practice in place concerning translation. The Delegation said that, during such time, efforts should be made to assess possible solutions to the problem at hand, such as those provided by information technology. The Delegation further stated that those efforts should not be limited to recommending a modification of the Common Regulations in order to align them with a practice adopted by the International Bureau, a practice which was neither an adequate nor a permanent solution to the problem.

183. The Delegation of France expressed its support for the proposal made by the Delegation of Colombia.

184. The Delegation of China stated that there appeared to be a backlog concerning translation and that resources needed to be allocated to resolve that issue. The Delegation also noted that demand for the translation of the documents concerned appeared to be low and that, in any case, interested parties could request such translation. The Delegation was of the view that the standing practice concerning translation had not caused any problems for the proper functioning of the Madrid system. The Delegation said it believed that the proposal made by the International Bureau to regularize the practice was reasonable and that it could improve the functioning of the system by increasing its efficiency and considerably reducing the translation backlog. Notwithstanding that, however, the Delegation of China said that it did not oppose the proposal made by the Delegation of Colombia and supported by other delegations and it hoped that increased automated translation could be possible in the future.

185. The Delegation of Cuba endorsed the proposal made by the Delegation of Colombia and said that it also hoped that the current situation, which concerned mostly documents to be translated into Spanish, could be resolved.

186. The Representative of MARQUES expressed his support for the proposal presented by the International Bureau. The Representative stated that users were very much interested in an efficient system and that they welcomed a reduction in processing time by reducing the number of documents which would be routinely translated. The Representative added that the policy of translation upon request met the needs of users. The Representative indicated that, for that reason, MARQUES supported the current practices of translation upon request and that it would not welcome a limitation of the practice. The Representative recalled an issue raised earlier by the Delegation of the Russian Federation concerning user-awareness and requested that the possibility of filing an online request for translation be made known and available to users more widely. The Representative suggested that a link to the online request form be introduced in ROMARIN so that a request for translation concerning a given international registration could be more easily filed.

187. The Secretariat, in response to a question posed by the Representative of MARQUES, confirmed that ROMARIN offered users the possibility to simultaneously display the information concerning an international registration in the three working languages of the Madrid system. In addition, the Secretariat welcomed the proposal concerning the introduction of a link to the online translation request form in ROMARIN and indicated that it would determine what would be the technical implications for implementing such proposal.

188. The Delegation of Sweden indicated that while some delegations had supported the proposal made by the International Bureau, other delegations had expressed concerns about it, in particular, in the context of the United Nations policy on multilingualism. The Delegation concluded that there was no consensus on the proposal made by the International Bureau and that a compromise solution would have to take notice of the concerns raised by the Delegations of France, Spain and other delegations. The Delegation of Sweden said that it believed that such compromise solution would be to allow the International Bureau some time to further assess the issues raised and, in particular, the introduction of information technology solutions in the area of automated translation.

189. The Chair proposed that the Working Group recommend to the Madrid Union Assembly that it continue to take note of the practice in place concerning translation. The Chair further proposed that the Working Group recommend to the Madrid Union Assembly that it mandate the International Bureau to, after a period of three years, or earlier at the request of the Working Group, undertake a review of the said practice in light of the views expressed by the delegations and user-organizations in the Working Group, and in light of ongoing developments, including information technology and automated translations.

190. The Working Group agreed to pursue the approach proposed by the Chair.

AGENDA ITEM 8: OTHER MATTERS

191. The Secretariat, responding to a question posed by the Representative of APRAM concerning a recent practice implemented by the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) with regard to class headings, stated that the overall implications of such practice for the Madrid system would have to be ascertained in discussions which would have to be held between officials from OHIM and the International Bureau. The Secretariat further stated that the International Bureau would keep users informed of the outcome of such discussions.

AGENDA ITEM 9: SUMMARY BY THE CHAIR

192. The Working Group approved the Summary by the Chair, as contained in document MM/LD/WG/10/7.

AGENDA ITEM 10: CLOSING OF THE SESSION

193. The Chair closed the session on July 6, 2012.

[Annex follows]

F - E

OMPI | WIPO
ORGANISATION MONDIALE DE LA PROPRIÉTÉ INTELLECTUELLE
WORLD INTELLECTUAL PROPERTY ORGANIZATION

MM/LD/WG/10/INF/1
ORIGINAL: FRANÇAIS/ENGLISH
DATE: 6 JUILLET 2012 / JULY 6, 2012

Groupe de travail sur le développement juridique du système de Madrid concernant l'enregistrement international des marques

Dixième session
Genève, 2 – 6 juillet 2012

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

Tenth Session
Geneva, July 2 to 6, 2012

LSTE DES PARTICIPANTS
LIST OF PARTICIPANTS

établie par le Secrétariat
prepared by the Secretariat

I. MEMBRES/MEMBERS

(dans l'ordre alphabétique des noms français des États/in the alphabetical order of the names in French of the States)

ALGÉRIE/ALGERIA

Malika HABTOUN (Mme), chef d'études à la Division de la qualité et de la sécurité industrielle, Ministère de l'industrie, de la petite et moyenne entreprise et de la promotion des investissements, Alger

Fatma Zohra BOUGUERRA (Mme), administrateur, Ministère de l'industrie, de la petite et moyenne entreprise et de la promotion des investissements, Alger

Ahlem Sara CHARIKHI (Mlle), attachée, Mission permanente, Genève

ALLEMAGNE/GERMANY

Carolin HÜBENETT (Ms.), Head, International Registrations Team, Department 3 Trade Marks, Utility Models, Designs, German Patent and Trade Mark Office, Munich

Heinjorg HERRMANN, Counsellor, Permanent Mission, Geneva

AUSTRALIE/AUSTRALIA

Tanya DUTHIE (Ms.), Assistant Director, International Policy and Cooperation, IP Australia, Woden ACT

David KILHAM, First Secretary, Permanent Mission to the World Trade Organization (WTO), Geneva

AUTRICHE/AUSTRIA

Karoline EDER-HELNWEIN (Ms.), Legal Department International Trademarks, Austrian Patent Office, Vienna

BELGIQUE/BELGIUM

Leen DE CORT (Mme), attaché, Office belge de la propriété intellectuelle (ORPI), Service public fédéral de l'économie, PME, classes moyennes et énergie, Bruxelles

Mathias KENDE, deuxième secrétaire, Mission permanente, Genève

CHINE/CHINA

XU Zhisong, Director, International Registration Division, Trademark Office, State Administration for Industry and Commerce (SAIC), Beijing

CHYPRE/CYPRUS

Myrianthi SPATHI (Ms.), Second Secretary, Permanent Mission, Geneva

Yiangos-Georgios YIANGOULLIS, Expert Legal Affairs, Permanent Mission, Geneva

Christina TSENTA (Ms.), Attaché, Permanent Mission, Geneva

COLOMBIE/COLOMBIA[1]

José Luis LONDOÑO FERNÁNDEZ, Superintendente Delegado para la Propiedad Industrial, Superintendencia de Industria y Comercio (SIC), Ministerio de Industria, Comercio y Turismo, Bogotá

Catalina GAVIRIA BRAVO (Sra.), Consejera, Misión Permanente ante la Organización Mundial del Comercio (OMC), Ginebra

CUBA

Clara Amparo MIRANDA VILA (Sra.), Jefa del Departamento de Marcas y Otros Signos Distintivos, Oficina Cubana de la Propiedad Industrial (OCPI), La Habana

DANEMARK/DENMARK

Mikael Francke RAVN, Senior Legal Advisor, Trademarks and Designs, Danish Patent and Trademark Office, Ministry of Economic and Business Affairs, Taastrup

Anja Maria BECH HORNECKER (Ms.), Special Legal Advisor, Policy and Legal Affairs, Danish Patent and Trademark Office, Ministry of Economic and Business Affairs, Taastrup

ÉGYPTE/EGYPT

Amr HEGAZY, Head, Trademarks and Industrial Designs Office, Cairo

ESPAGNE/SPAIN

José María DEL CORRAL PERALES, Subdirector General Adjunto, Departamento de Signos Distintivos, Oficina Española de Patentes y Marcas (OEPM), Ministerio de Industria, Energía y Turismo, Madrid

---

1 Le 29 mai 2012, le Gouvernement de la Colombie a déposé auprès du Directeur général de l'Organisation Mondiale de la Propriété Intellectuelle (OMPI) son instrument d'adhésion au Protocole relatif à l'Arrangement de Madrid concernant l'enregistrement international des marques. Le Protocole de Madrid entrera en vigueur à l'égard de la Colombie, le 29 août 2012.

1 On May 29, 2012, the Government of Colombia deposited its instrument of accession to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks. The Madrid Protocol will enter into force with respect to Colombia on August 29, 2012.

ESTONIE/ESTONIA

Janika KRUUS (Mrs.), Head, International Trademark Examination Division, Trademark Department, The Estonian Patent Office, Tallinn

ÉTATS-UNIS D'AMÉRIQUE/UNITED STATES OF AMERICA

Amy P. COTTON (Mrs.), Senior Counsel, Office of Policy and External Affairs, United States Patent and Trademark Office (USPTO), Department of Commerce, Alexandria

Jennifer CHICOSKI (Mrs.), Administrator, Classification, Office of the Commissioner for Trademarks, United States Patent and Trademark Office (USPTO), Department of Commerce, Alexandria

Felicia BATTLE (Ms.), Supervisor, Madrid Processing Unit, United States Patent and Trademark Office (USPTO), Department of Commerce, Alexandria

Todd REVES, Intellectual Property Attaché, Permanent Mission, Geneva

FÉDÉRATION DE RUSSIE/RUSSIAN FEDERATION

Vladimir G. OPLACHKO, Head, International Organizations Cooperation Division, International Cooperation Department, Federal Service for Intellectual Property, Patents and Trademarks (ROSPATENT), Moscow

Tatiana ZMEEVSKAYA (Mrs.), Head of Division, Federal Service for Intellectual Property, Patents and Trademarks (ROSPATENT), Moscow

Larisa TITOVA (Mrs.), State Examiner, Federal Institute of Industrial Property, Federal Service for Intellectual Property, Patents and Trademarks (ROSPATENT), Moscow

FINLANDE/FINLAND

Païvi RAATIKAINEN (Ms.), Deputy Director, Trademarks and Designs, National Board of Patents and Registration, Helsinki

Kari JUUSELA, Lawyer, Trademarks and Designs, National Board of Patents and Registration, Helsinki

FRANCE

Daphné DE BECO (Mme), chargée de mission, Service des affaires européennes et internationales, Institut national de la propriété industrielle (INPI), Paris

Marianne CANTET (Mme), chargée de mission, Service juridique et contentieux, Institut national de la propriété industrielle (INPI), Paris

Katerina DOYTCHINOV (Mme), premier secrétaire, Mission permanente, Genève

GHANA

Oladele Kwaku ARIBIKE, Senior State Attorney, Registrar-General's Department, Ministry of Justice, Accra

HONGRIE/HUNGARY

Krisztina KOVÁCS (Ms.), Head, Industrial Property Law Section, Legal and International Department, Hungarian Intellectual Property Office (HIPO), Budapest

Marta TÓHÁTI (Ms.), Head, International Trademark Section, Trademark, Model and Design Department, Hungarian Intellectual Property Office (HIPO), Budapest

IRAN (RÉPUBLIQUE ISLAMIQUE D')/IRAN (ISLAMIC REPUBLIC OF)

Ali NASIMFAR, First Secretary, Permanent Mission, Geneva

ISLANDE/ICELAND

Ásdís KRISTMUNDSDÓTTIR (Ms.), Head, Trademark and Design Division, Icelandic Patent Office, Reykjavik

ISRAËL/ISRAEL

Anat Neeman LEVY (Mrs.), Head, Trademark Department, Israel Patent Office (ILPO), Ministry of Justice, Jerusalem

ITALIE/ITALY

Renata CERENZA (Mrs.), Senior Trademark Examiner, Italian Patent and Trademark Office, Division XIII, Directorate General for the Fight Against Counterfeiting, Ministry of Economic Development, Rome

JAPON/JAPAN

Kazuo HOSHINO, Director for Policy Planning and Research, International Affairs Division, Japan Patent Office (JPO), Tokyo

Katsumasa DAN, Deputy Director, Trademark Policy Planning Office, Trademark Division, Trademark, Design and Administrative Affairs Department, Japan Patent Office (JPO), Tokyo

Maya MITSUI (Ms.), Official, Coordinating Office for PCT and Madrid Protocol Systems, International Application Division, Trademark, Design and Administrative Affairs Department, Japan Patent Office (JPO), Tokyo

Satoshi FUKUDA, First Secretary, Permanent Mission, Geneva

Kunihiko FUSHIMI, First Secretary, Permanent Mission, Geneva

KAZAKHSTAN

Madina SMANKULOVA (Ms.), Third Secretary, Permanent Mission, Geneva

KENYA

Christian LANGAT, Trademark Examiner, Kenya Industrial Property Institute (KIPI), Ministry of Trade and Industry, Nairobi

KIRGHIZISTAN/KYRGYZSTAN

Sultan ALYBAEV, Chairman Advisor, State Intellectual Property Service of the Kyrgyz Republic (Kyrgyzpatent), Bishkek

LETTONIE/LATVIA

Dzintra MEDNE (Ms.), Senior Expert, International Trademark Division, Department of Trademarks and Industrial Designs, Patent Office of the Republic of Latvia, Riga

LITUANIE/LITHUANIA

Arūnas ŽELVYS, Head, Law and International Affairs Division, State Patent Bureau of the Republic of Lithuania, Vilnius

MADAGASCAR

Mathilde Manitra RAHARINONY (Mlle), chef du Service de l'enregistrement international des marques, Office malgache de la propriété industrielle (OMAPI), Antananarivo

MAROC/MOROCCO

Abderrahmane BAKHOUYA, chef du Département opérations signes distinctifs, Office marocain de la propriété industrielle et commerciale (OMPIC), Casablanca

MONACO

Gilles REALINI, deuxième secrétaire, Mission permanente, Genève

NORVÈGE/NORWAY

Jens Herman RUGE, Head of Section, Design and Trademark Department, Norwegian Industrial Property Office (NIPO), Oslo

Thomas HVAMMEN NICHOLSON, Senior Legal Advisor, Design and Trademark Department, Norwegian Industrial Property Office (NIPO), Oslo

PHILIPPINES[2]

Andrew Michael S. ONG, Deputy Director-General, Intellectual Property Office of the Philippines (IPOPHL), Taguig City

POLOGNE/POLAND

Marta CZYŻ (Mrs.), Director, Trademark Examination Department, Polish Patent Office, Warsaw

Agnieszka ANTONOWICZ (Ms.), Expert, Trademark Examination Department, Polish Patent Office, Warsaw

RÉPUBLIQUE DE CORÉE/REPUBLIC OF KOREA

YOO Jin-Ou, Deputy Director, Trademark Examination Policy Division, Korean Intellectual Property Office (KIPO), Daejeon

MOON Gi-Kwon, Deputy Director, International Trademark Examination Team, Korean Intellectual Property Office (KIPO), Daejeon

YOON Seok-Young, Assistant Deputy Director, International Application Division, Korean Intellectual Property Office (KIPO), Daejeon

KIM Yong-Sun, Intellectual Property Attaché, Permanent Mission, Geneva

RÉPUBLIQUE POPULAIRE DÉMOCRATIQUE DE CORÉE/DEMOCRATIC PEOPLE'S REPUBLIC OF KOREA

KIM Tonghwan, conseiller, Mission permanente, Genève

RÉPUBLIQUE TCHÈQUE/CZECH REPUBLIC

Zlatuše BRAUNŠTEINOVÁ (Ms.), Trademarks Department, Industrial Property Office, Prague

Jan WALTER, Third Secretary, Permanent Mission, Geneva

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2 Le 25 avril 2012, le Gouvernement des Philippines a déposé auprès du Directeur général de l'Organisation Mondiale de la Propriété Intellectuelle (OMPI) son instrument d'adhésion au Protocole relatif à l'Arrangement de Madrid concernant l'enregistrement international des marques. Le Protocole de Madrid entrera en vigueur à l'égard des Philippines, le 25 juillet 2012.

2 On April 25, 2012, the Government of the Philippines deposited its instrument of accession to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks. The Madrid Protocol will enter into force with respect to the Philippines on July 25, 2012.

ROUMANIE/ROMANIA

Liviu BULGĂR, Director, Legal Affairs and International Cooperation Department, State Office for Inventions and Trademarks (OSIM), Bucharest

Cornelia Constanta MORARU (Mrs.), Head, Legal Affairs and International Cooperation Department, State Office for Inventions and Trademarks (OSIM), Bucharest

Liliana DRAGNEA (Ms.), Legal Advisor, State Office for Inventions and Trademarks (OSIM), Bucharest

ROYAUME-UNI/UNITED KINGDOM

Thomas WALKDEN, Senior Policy Advisor, Bilateral Relations Team, Intellectual Property Office, London

SAO TOMÉ-ET-PRINCIPE/SAO TOME AND PRINCIPE

Maria José DOS SANTOS RITA AFONSO (Mme), technicienne supérieure, Service national de la propriété industrielle (SENAPI), Direction de l'industrie, Sao Tomé

SERBIE/SERBIA

Marija BOŽIĆ (Mrs.), Head, International Trademarks, Distinctive Signs Department, Industrial Property Office, Belgrade

SINGAPOUR/SINGAPORE

Mei Lin TAN (Ms.), Director, Legal Counsel, Intellectual Property Office of Singapore (IPOS), Singapore

SLOVÉNIE/SLOVENIA

Saša POLC (Ms.), Advisor, Slovenian Intellectual Property Office (SIPO), Ministry of Economy, Ljubljana

Grega KUMER, Third Secretary, Permanent Mission, Geneva

SUÈDE/SWEDEN

Gustav MELANDER, Senior Legal Officer, Designs and Trademarks Division, Swedish Patent and Registration Office, Söderhamn

Tina HOLM (Ms.), Legal Officer, Designs and Trademarks Division, Swedish Patent and Registration Office, Söderhamn

SUISSE/SWITZERLAND

Alexandra GRAZIOLI (Mme), conseillère juridique principale à la Division droit et affaires internationales, Institut fédéral de la propriété intellectuelle (IPI), Berne

Julie POUPINET (Mme), coordinatrice marques internationales à la Division des marques, Institut fédéral de la propriété intellectuelle (IPI), Berne

TURQUIE/TURKEY

Erman VATANSEVER, Trademark Examiner, Turkish Patent Institute, Ankara

UNION EUROPÉENNE (UE)/EUROPEAN UNION (EU)

Myriam TABURIAUX (Ms.), Operations Department, Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM), Alicante

Kelly BENETT (Ms.), Legal Practice, International Cooperation and Legal Affairs Department, Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM), Alicante

Michael PRIOR, European Commission, Brussels

ZAMBIE/ZAMBIA

Joe SIMACHELA, Deputy Chief State Advocate, Civil Litigation Department, Ministry of Justice, Lusaka

Sunduzwayo ZIMBA, Senior Examiner, Patents and Companies Registration Agency (PACRA), Ministry of Commerce, Trade and Industry, Lusaka

Lillian BWALYA, First Secretary (Trade), Permanent Mission, Geneva

II. OBSERVATEURS/OBSERVERS

ARABIE SAOUDITE/SAUDI ARABIA

Mohammed Ahmad ALMALKI, Commercial Marks Department, Ministry of Commerce and Industry, Riyadh

Abdullah Abdulaziz AL MOUSA, Commercial Marks Department, Ministry of Commerce and Industry, Riyadh

INDE/INDIA

Babu NEDIYAM PARAMBATHU, Senior Examiner of Trademarks, Office of the Controller-General of Patents, Designs and Trademarks, Department of Industrial Policy Promotions (DIPP), Ministry of Commerce and Industry, Mumbai

IRAQ

Abbas Saeed AL ASADI, Director General, Ministry of Industry and Minerals, Baghdad

JORDANIE/JORDAN

Khaled ARABEYYAT, Director, Industrial Property Protection Directorate, Ministry of Industry and Trade, Amman

Zain AL AWAMLEH (Mrs.), Deputy Director, Industrial Property Protection Directorate, Ministry of Industry and Trade, Amman

MEXIQUE/MEXICO

Eliseo MONTIEL CUEVAS, Director Divisional de Marcas, Instituto Mexicano de la Propiedad Industrial (IMPI), Ciudad de México

Paulina FERNÁNDEZ CASTRO HELLER (Sra.), Coordinadora Departamental de Negociaciones Internacionales, Instituto Mexicano de la Propiedad Industrial (IMPI), Ciudad de México

Zuily ZÁRATE DÍAZ (Sra.), Especialista A en Propiedad Intelectual, Instituto Mexicano de la Propiedad Industrial (IMPI), Ciudad de México

José R. LÓPEZ DE LEÓN, Segundo Secretario, Misión Permanente, Ginebra

NIGÉRIA/NIGERIA

William Keftin AMUGA, Assistant Chief Registrar, Registry of Trademarks, Patents and Designs, Federal Ministry of Trade and Investment, Abuja

RÉPUBLIQUE DOMINICAINE/DOMINICAN REPUBLIC

Ivette Yanet VARGAS TAVÁREZ (Sra.), Directora del Departamento de Signos Distintivos, Oficina Nacional de la Propiedad Industrial (ONAPI), Santo Domingo

TRINITÉ-ET-TOBAGO/TRINIDAD AND TOBAGO

Tene REECE (Ms.), Deputy Controller, Intellectual Property Office, Ministry of Legal Affairs, Port of Spain

Justin SOBION, First Secretary, Permanent Mission, Geneva

III. ORGANISATIONS INTERNATIONALES INTERGOUVERNEMENTALES/ INTERNATIONAL INTERGOVERNMENTAL ORGANIZATIONS

OFFICE BENELUX DE LA PROPRIÉTÉ INTELLECTUELLE (OBPI)/BENELUX OFFICE FOR INTELLECTUAL PROPERTY (BOIP)

Camille JANSSEN, juriste, Département des affaires juridiques, La Haye

IV. ORGANISATIONS INTERNATIONALES NON GOUVERNEMENTALES/ INTERNATIONAL NON-GOVERNMENTAL ORGANIZATIONS

Association allemande pour la propriété intellectuelle (GRUR)/German Association for the Protection of Intellectual Property (GRUR)
Alexander VON MÜHLENDAHL, Munich

Association américaine du droit de la propriété intellectuelle (AIPLA)/American Intellectual Property Law Association (AIPLA)
Jody DRAKE (Ms.), Attorney, Washington, D.C.

Association des praticiens du droit des marques et des modèles (APRAM)
Giulio MARTELLINI, Turin
Emmanuelle EYRAUD, Genève

Association des propriétaires européens de marques de commerce (MARQUES)/Association of European Trademark Owners (MARQUES)
Markus FRICK, Vice-Chair, MARQUES Trademark Law and Practice Team, Zurich

Association internationale pour la protection de la propriété intellectuelle (AIPPI)/International Association for the Protection of Intellectual Property (AIPPI)
Alexander VON MÜHLEN THAL, Co-Chair, Special Committee Q212 (Trademarks), Zurich
Abdurrahim AYAZ, Member, Special Committee Q212 (Trademarks), Zurich
Elena MOLINA LÓPEZ, Member, Special Committee Q212 (Trademarks), Zurich

Association japonaise des conseils en brevets (JPAA)/Japan Patent Attorneys Association (JPAA)
Keiko HONDA (Ms.), Chairman, Trademark Committee, Tokyo
Hideki TANAKA, International Activities Centre, Tokyo

Association japonaise pour les marques (JTA)/Japan Trademark Association (JTA)
Shunji SATO, Chair, International Activities Committee, Tokyo

Association romande de propriété intellectuelle (AROPI)
Éric R. NOËL, président, Commission “droits, conventions et relations internationales”, Genève
Éric ROJAS, président, Commission “droit suisse et relations nationales”, Lausanne
Marc-Christian PERRONNET, membre, Genève

Fédération internationale des conseils en propriété industrielle (FICPI)/International Federation of Industrial Property Attorneys (FICPI)
Volker HEUCKEROTH, Member, Stuttgart

International Trademark Association (INTA)
Bruno MACHADO, Geneva Representative, Rolle
Louise GELLMAN (Ms.), Chair, Madrid System Subcommittee, London

Union des praticiens européens en propriété industrielle (UNION)/Union of European Practitioners in Industrial Property (UNION)
Laurent OVERATH, President, Trademarks Commission, Brussels

V. BUREAU/OFFICERS

Président/Chair:	Mikael Francke RAVN (Danemark/Denmark)
Vice-présidents/Vice-Chairs:	XU Zhisong (Chine/China)
	Krisztina KOVÁCS (Mme/Mrs.) (Hongrie/Hungary)
Secrétaire/Secretary:	Debbie ROENNING (Mme/Mrs.) (OMPI/WIPO)

VI. SECRÉTARIAT DE L'ORGANISATION MONDIALE DE LA PROPRIÉTÉ INTELLECTUELLE (OMPI)/SECRETARIAT OF THE WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO)

Francis GURRY, directeur général/Director General

Binying WANG (Mme/Mrs.), vice-directrice générale/Deputy Director General

Debbie ROENNING (Mme/Mrs.), directrice de la Division juridique, Service d'enregistrement Madrid, Secteur des marques et des dessins et modèles/Director, Legal Division, Madrid Registry, Brands and Designs Sector

Diego CARRASCO PRADAS, directeur adjoint de la Division juridique, Service d'enregistrement Madrid, Secteur des marques et des dessins et modèles/Deputy Director, Legal Division, Madrid Registry, Brands and Designs Sector

William O'REILLY, juriste principal à la Division juridique, Service d'enregistrement Madrid, Secteur des marques et des dessins et modèles/Senior Legal Officer, Legal Division, Madrid Registry, Brands and Designs Sector

Antonina STOYANOVA (Mme/Mrs.), conseillère à la Division juridique, Service d'enregistrement Madrid, Secteur des marques et des dessins et modèles/Counsellor, Legal Division, Madrid Registry, Brands and Designs Sector

Marie-Laure DOUAY (Mlle/Miss), juriste adjointe à la Division juridique, Service d'enregistrement Madrid, Secteur des marques et des dessins et modèles/ Assistant Legal Officer, Legal Division, Madrid Registry, Brands and Designs Sector

Juan RODRÍGUEZ, consultant à la Division juridique, Service d'enregistrement Madrid, Secteur des marques et des dessins et modèles/Consultant, Legal Division, Madrid Registry, Brands and Designs Sector

Kazutaka SAWASATO, consultant à la Division juridique, Service d'enregistrement Madrid, Secteur des marques et des dessins et modèles/Consultant, Legal Division, Madrid Registry, Brands and Designs Sector

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