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From:	Presidency
To:	Delegations
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Subject:	16th Session of the WIPO Working Group on the Legal Development of the Madrid System for the International Registration of Marks (Geneva, 2-6 July 2018) - Final EU/Member States statements

Delegations will find attached, for information, the EU/Member States' statements delivered at the above mentioned WIPO meeting.

A short debriefing on the outcomes of the WIPO meeting will be given at the meeting of the Intellectual Property Working Party on 18 July 2018.

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

16th Session

(WIPO, Geneva, 2 – 6 July, 2018)

Replacement (MM/LD/WG/16/2)

Agenda item 4

Mr. Chairman,

1. The European Union and its Member States would like to thank the WIPO Secretariat for preparing document MM/LD/WG/16/2 on issues concerning a date for the entry into force of amended Rule 21 of the Common Regulations and the amount of the fee to be specified in new item 7.8 of the Schedule of Fees, as requested by the Working Group at its previous session.
2. We reiterate our view that replacement would benefit from a harmonisation exercise and we support the continuation of discussions with a view to trying to achieve consensus and to having a harmonised practice as far as the scope of replacement is concerned.
3. Against this background, we regret to note that the WIPO Secretariat does not make any concrete suggestions on either of the two outstanding issues following the 15th session of the Working Group. While we acknowledge with appreciation that the International Bureau will undertake an extensive assessment of all its Madrid System services with a view to developing a comprehensive customer centred platform, we do not find that it would be premature to recommend a possible date of entry into force of the proposed amendments to Rule 21, or to propose an amount for new item 7.8 of the Schedule of Fees.
4. We are hopeful that the International Bureau will be in the position to share some tentative suggestions on both elements at the next session of the Working Group, together with a new proposal to amend Rule 21 of the Common Regulations reflecting the principles governing replacement.

Thank you.

**Working Group on the Legal Development of the Madrid System
for the International Registration of Marks
16th Session
(WIPO, Geneva, 2 – 6 July, 2018)
Transformation (MM/LD/WG/16/3)
Agenda item 5**

Mr. Chairman,

1. The European Union and its Member States would like to thank the WIPO Secretariat for its excellent working document MM/LD/WG/16/3 on transformation.
2. We find it crucial that all Contracting Parties of the Madrid System should provide for the possibility of transformation. We also agree that it is important to build on feedback from users and we fully support the endeavour to identify some possible improvements that could be made.
3. As regards the recommendations for the transformation procedure by designated Contracting Parties contained in point 9 of the document, we can support them in general but we have concerns about the recommendation in point (iii) relating to added costs. In our view, Contracting Parties should remain free to opt for a fee arrangement as they find appropriate relating to transformation applications.
4. At the same time, we fully agree with the recommendations in point (v) relating to the avoidance of unnecessary duplication of work. We can also add that in the EU such practice can already be observed. For example, Article 204 of the European Union Trade Mark Regulation (EU) 2017/1001 contains provisions that are in line with this principle.

Thank you.

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

16th Session

(WIPO, Geneva, 2 – 6 July, 2018)

New Types of Marks and New Means of Representation (MM/LD/WG/16/4)

Agenda item 6

Mr. Chairman,

1. The European Union and its Member States would like to thank the WIPO Secretariat for preparing document MM/LD/WG/16/4 on new types of marks and new means of representation.
2. At the WIPO General Assembly last year, we reported on the new EU Trade Mark Regulation (EU) 2017/1101 that entered into force on 1 October 2017 and on the new Trade Mark Directive 2015/2436 the implementation of which EU Member States are working towards. Our new EU legislation repealed the requirement of graphical representability, replacing it with a general condition that a trade mark must be capable of being represented on the register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of protection.
3. Following that change, the EU and its Member States consider it of utmost importance that EU trade mark applicants and holders would have the opportunity to seek extended protection for their non-traditional marks by using the Madrid route under the same modernised conditions that are available for them under the new EU legislation. We reiterate our view that embracing the use of latest technologies in actual application practices would also facilitate the modernisation, digitalisation and enhanced user-friendliness of the Madrid System.

4. Against this background, we studied document MM/LD/WG/16/4 with due consideration. We find that the assessment of the legal framework of the Madrid System requires further elaboration of some details. For example, while paragraphs 9 and 15 of the document clearly state there exists a requirement for graphical reproduction of marks set out by Rule 9(4)(a)(v) of the Common Regulations and while the respective official form is not available in a format that allows users to avoid graphical reproduction, paragraph 5 suggests the Common Regulations do not restrict the types of marks for which an international application can be filed. Likewise, paragraph 12 expresses doubts whether it would be desirable or even necessary to amend the Common Regulations. At the same time, paragraph 17 considers that the acceptable formats rather be dealt with in the Administrative Instructions, which in our view would not be possible without also amending the underlying Rule in the Common Regulations. In light of these considerations, we would like to request further clarification from the Secretariat.
5. As regards implications of introducing new means of representation discussed in paragraphs 18-25, we fully understand and appreciate concerns expressed by the International Bureau on the difficulties some Contracting Parties may have to face if new means of representation could be introduced in the Madrid System. However, we find that the document does not delve deeper into this matter and does not include any suggestions on how to overcome these concerns and as to how a reform could actually be envisaged.
6. The EU and its Member States have already engaged in exploring possible ways forward to align the Madrid System with technical developments. As a result of that ongoing work, we would like to present a proposal to the Working Group at its next session.
7. We remain open to hear the opinion of other participants in the Working Group. The EU and its Member States look forward to further discussions on this important issue, and we stand ready to work with the International Bureau, the Members of the Madrid Union and interested user associations to find technical and legal solutions for adequate protection also of non-traditional trade marks via the Madrid System.

Thank you.

**Working Group on the Legal Development of the Madrid System for the International
Registration of Marks
16th Session
(WIPO, Geneva, 2 – 6 July, 2018)**

**Proposal by the Delegation of China and Proposal by the Delegation of
the Russian Federation (MM/LD/WG/16/7, MM/LD/WG/16/9 Rev. and
MM/LD/WG/16/INF/2)
Agenda items 9 and 10**

Mr. Chairman,

1. The European Union and its Member States would like to thank the WIPO Secretariat for preparing the very helpful background information document in regard to recent requests to introduce additional languages to the Madrid System.
2. While we are open to explore possible measures to make the system even more attractive, inter alia by taking into consideration the introduction of additional languages we hold the opinion that such significant steps should only be performed following in-depth examination and evaluation of all implications.
3. We therefore would like to kindly request the International Bureau to build upon the information already provided in the documents under consideration and to perform an in-depth study on the practical and financial implications of introducing additional languages to the Madrid System.

Thank you.
