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From:	Presidency
To:	Delegations
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Subject:	17th Session of the WIPO Working Group on the Legal Development of the Madrid System for the International Registration of Marks (Geneva, 22-26 July 2019) - Final EU/Member States statements

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

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

17th Session

(WIPO, Geneva, 22 – 26 July 2019)

Replacement (MM/LD/WG/17/2)

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/17/2 proposing an amendment to paragraph (1) of Rule 21 of the Common Regulations as well as a new paragraph (3) of the same Rule to reflect the principles governing replacement, 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 aimed at finding a consensual solution and at harmonising practices as far as the scope of replacement is concerned.
3. Against this background, we welcome the proposal presented by the Secretariat as reflected in the working document and the Annex with concrete suggestions for amending Rule 21. We acknowledge with appreciation that the document focuses on clarifying the key principles governing replacement, most of which we can support as appropriate reflections of our own understanding. We endorse suggestions about the time at which a request under Article 4*bis*(2) of the Protocol may be filed, the principles concerning the previous national or regional registration and the examination of a request under Article 4*bis*(2) of the Protocol. We also find that respective parts in the proposed amendments contained in the Annex are appropriately drafted in accordance with those suggestions.

4. Nevertheless, when it comes to the list of goods and services of the previous national or regional registration, we cannot fully support all proposals made by the Secretariat. While we can agree with suggestions in paragraphs 20 and 21 of the working document, we are not ready to endorse that a national or regional registration may be partially replaced by an international registration.
5. In light of such concerns, we fully support the proposal by the Secretariat that the Working Group hold further discussions on replacement focused on the way in which replacement operates in the Offices of the Contracting parties with the objective of making it more accessible and aligned with the needs of the users of the Madrid System. We also welcome the idea that such discussions could take place at a future Roundtable.
6. We stand ready to engage actively in continued discussions on this issue.

Thank you.

Agenda item 4 – Reactive statement

Mr. Chairman,

1. The European Union and its Member States would like to thank the WIPO Secretariat for preparing the informative background document MM/LD/WG/17/2 regarding replacement as well as the draft of a new paragraph in Rule 21 for a provisional regime for partial replacement.
2. The European Union already presented its statement on this point in the opening session of this Working Group. In that statement the European Union has shown its intention to continue the debate with caution, as long as there are still some points that should be considered. Specifically, we are concerned about the possible misalignment of the proposed draft of paragraph 3d, sentence 2 of Rule 21 with Article 4bis, paragraph 1 (ii) of the Protocol. The introduction of this new paragraph will certainly change the procedures of the Madrid system. Even with a provisional exemption until 2025 the consequences are important enough to take this issue into further consideration. For this reason, we suggest we take the draft provided by the Secretariat as a first step and postpone the decision on this issue to the next Working Group.
3. Nevertheless, we are open to further discussion on this important issue.

Thank you.

**Working Group on the Legal Development of the Madrid System for the International
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**Notification of Provisional Refusal – Time Limit to Reply and Ways in Which to Calculate
that Time Limit (MM/LD/WG/17/5)**

Agenda item 7

Mr. Chairman,

1. The European Union and its Member States would like to thank the WIPO Secretariat for preparing document MM/LD/WG/17/5 on time limits.
2. We are open to exploring measures to harmonise as much as possible the ways in which to calculate time limits for the benefit of the users of the system. In particular, we support the proposal to harmonise the calculation of the start date.
3. On the other hand, we have concerns about the proposal to reduce to one year the time limit for all offices to notify *ex officio* provisional refusals, as this measure might create difficulties for some contracting parties to meet the deadline due to legal constraints and jeopardise their right to declare that protection cannot be granted in their territory.
4. That said, we appreciate the list of issues for consideration compiled by the Secretariat and we can support the proposals contained in paragraphs 34-37. As regards the issue in paragraphs 38(i) and (ii), the EU can support that the Working Group explore the potential for setting a minimum time limit or, alternatively, even for harmonising the time limit to respond to a provisional refusal. However, we are not ready to endorse harmonizing the time limit Offices have to notify an *ex officio* provisional refusal to one year.

Thank you.

**Working Group on the Legal Development of the Madrid System for the International
Registration of Marks
17th Session
(WIPO, Geneva, 22 – 26 July 2019)
Possible Reduction of the Dependency Period (MM/LD/WG/17/6)
Agenda item 8**

Mr. Chairman,

1. The European Union and its Member States would like to thank the WIPO Secretariat for preparing document MM/LD/WG/17/6 on the possible reduction of the dependency period.
2. In general, we are supportive of the endeavour to make a further step towards the simplification of the Madrid System on this important and complex issue. Nonetheless, we reiterate our preference for abstaining from any fundamental and radical changes carried out at once or in the near or distant future, including the suspension of the operation of dependency.
3. As regards the possible way forward, we thank the Secretariat for elaborating possible options regarding dependency. In our view, a route that may lead to a consensual solution could be oriented towards the reduction of the dependency period as proposed in paragraphs 22-25 of the working document, for example to three years instead of five. Alternatively, the reduction of the grounds as discussed in paragraphs 26-27 could also be envisaged. In our opinion, the latter option is a new suggestion that could be further explored with caution. We would be in favour of the tendency for the Working Group to focus on the first of these two possible options, namely the reduction of the dependency period to three years, in trying to reach compromise.
4. We remain interested to hear the opinion of other participants in the Working Group. The EU and its Member States look forward to further discussions on this issue.

Thank you.

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

17th Session

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**Possible Options for the Introduction of New Languages into the Madrid System / Proposal
by the Delegations of Algeria, Bahrain, Egypt, Morocco, Oman, Sudan,
the Syrian Arab Republic and Tunisia (MM/LD/WG/17/7 REV, MM/LD/WG/17/10)
Agenda items 9 and 12**

Mr. Chairman,

1. The European Union and its Member States would like to thank the WIPO Secretariat for preparing the informative background document MM/LD/WG/17/7 REV regarding the possible options for the introduction of new languages into the Madrid System.
2. Given the fundamental importance of the language regime, it remains challenging for us to take a definite position at this stage. We continue to be concerned that the addition of new languages could go against the key objective of this working group, which is simplifying and improving the efficiency of the system as a whole.
3. On the basis of the new document, we are still not in the position to immediately assess the real financial and administrative burdens implied by the introduction of new languages. Furthermore, we are not certain whether the introduction of a new translation regime could appropriately address all the said complexities.
4. Nevertheless, we are open to further discussion on this important issue.

Thank you.

Agenda items 9 and 12 – Reactive statement

Mr. Chairman,

1. The European Union and its Member States would like to thank the WIPO Secretariat for the additional explanations provided during this Working Group about possible options for the introduction of new languages into the Madrid System.
2. We reiterate our position about the complex nature of this issue and of its various implications.
3. We are of the view that completing the information, which has been brought about so far will be beneficial for this Working Group, in order to be able to properly develop an informed opinion on the topics, which are being discussed. Therefore, we favour conducting a more comprehensive study, which should encompass all the various factors at stake, without excluding any possible option. The study is to shed light about aspects, which at this moment remain unclear, such as the whole range of costs or the potential impact in the financing system currently in place.
4. Accordingly, we consider that, at this stage, it is clearly premature to take any decision other than to undertake a comprehensive study of the impacts of adding the languages proposed to the Madrid system and not to undertake a wider review of language policy at this time.

Thank you.

**Working Group on the Legal Development of the Madrid System for the International
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New Types of Marks and New Means of Representation (MM/LD/WG/17/8)

Agenda item 10

Mr. Chairman,

1. The European Union and its Member States would like to thank the WIPO Secretariat for preparing document MM/LD/WG/17/8 on new types of marks and new means of representation.
2. First, we would like to recall that our new harmonised 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. Following that change, the EU and its Member States consider it of utmost importance that trade mark applicants and holders in the EU 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.
3. We fully understand and acknowledge indications from the Secretariat about the difficulties some Contracting Parties may have to face if new means of representation could be introduced in the Madrid System. We also note concerns expressed on whether the possibility to file an international application with any representation of the mark (graphic or non-graphic) would remove the inconvenience holders would still face of having to comply with different representation requirements in designated Contracting Parties for a given type of mark, provided it can constitute a mark in those territories. We therefore fully recognise the complexity of the problem to solve.
4. At the same time, 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.

5. Against this background, we very much appreciate document MM/LD/WG/17/8 and have studied it with great interest. We would like to lend our full support to the Secretariat in its efforts to address this complex issue in a comprehensive and solutions-oriented manner. We also thank the Secretariat for preparing document MM/LD/WG/17/4 on sharing “Findings of the survey on acceptable types of marks and means of representation”. The information compiled in this document is a good basis for further discussions and adds a valuable practical context to our continued work on this issue.
6. As to our guidance on a possible way forward, it appears to us that with all the practical realities and legal difficulties, the Working Group may wish to take a step-by-step approach and build up a systemic solution that is as flexible as possible. We fully agree that taking into consideration a wide range of different situations in Madrid Member States is crucial.
7. We remain open to hearing 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 may have more comments to make during this session in response to views from other delegations. We stand ready to work with the Secretariat, 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.

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Proposal by the Delegation of Switzerland (MM/LD/WG/17/9)

Agenda item 11

Mr. Chairman,

1. The European Union and its Member States would like to thank the Delegation of Switzerland for submitting a proposal concerning the limitations provided for in the Madrid System, as contained in document MM/LD/WG/17/9.
2. We recognise and support the ultimate aim of the proposal, which is to bring more clarity and transparency to this issue and to improve a situation which merits further reflection. We also note with appreciation the consensual spirit of the proposal, reflected in the endeavour to take into account various interests at stake in order to achieve a solution satisfactory to all parties.
3. We can also agree that a possible way forward could imply some adjustment of the legal framework. We propose that the Working Group continue to work on the problem of limitations in order to find a solution that is acceptable to all.
4. The EU and its Member States are open to further discussions on this issue.
