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

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

18th Session

(WIPO, Geneva, 12 – 16 October 2020)

Agenda item 4

Proposed Amendments to the Regulations Under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks(MM/LD/WG/18/2)

Thank you Chair,

1. The European Union and its Member States would like to thank the WIPO Secretariat for preparing document MM/LD/WG/18/2. We welcome the proposed amendments to the Regulations under the Madrid Protocol in response to severe disruptions for users of the Madrid System resulting from the COVID-19 pandemic.
2. We welcome the proposals presented in the Annex in principle. Nevertheless, we still see a need for further discussions. These should include in particular Rule 3(2)(a) and 5. Coming to the proposal to amend Rule 3(2)(a) to eliminate the possibility that holders appoint a representative in a subsequent designation or in a request under Rule 25, unfortunately we cannot agree to the entry into force of the amendment already two months after its adoption. As a result of this change, IT systems will have to be modified. Taking into account already planned work priorities, in our view the proposed amendment to Rule 3(2)(a) should enter into force nine months after its adoption at the earliest. With regard to Rule 5 we see a need for a closer alignment with the wording of Rule 82^{quater} of the regulations under the PCT.

Thank you.

Agenda item 5

New Means of Representation(MM/LD/WG/18/3)

Thank you Chair,

1. The European Union and its Member States would like to thank the WIPO Secretariat for preparing document MM/LD/WG/18/3 on new means of representation. As this topic is of crucial importance to us in light of our new harmonised legislation, we are most appreciative of continued efforts from the International Bureau to address this complex issue in a comprehensive and solutions-oriented manner.
2. We reiterate our view that embracing the use of latest technologies in actual application practices would facilitate the modernisation, digitalisation and enhanced user-friendliness of the Madrid System.
3. Against this background, we welcome the new document prepared for this session. We would like to lend our support to all the proposals from the Secretariat regarding amendments to Rule 9 of the Regulations under the Madrid Protocol. Namely, we endorse the proposal to amend Rule 9(4)(a)(v) by eliminating the graphic reproduction requirement and introducing a representation requirement. We are also in favour of the proposed amendment to Rule 9(4)(a)(vii) to eliminate the requirement to provide a second reproduction in colour. Likewise, we support the proposed amendment to Rule 9(5)(d)(iv) by requiring that the Office of origin certify that the mark in the international application corresponds to the mark in the basic application or basic registration. Finally, we support the proposed consequential amendments to Rule 15(1)(iii), Rule 17(2)(v), Rule 32(1)(b), Rule 32(1)(c) and Items 2.1.1. and 2.1.2 of the Schedule of Fees.

4. As regards practical implications for the International Bureau, we are mindful of its estimation that it needs two years to develop, test and deploy the required changes to its services and systems. Nevertheless, it should be borne in mind that the Offices also need to adapt their systems. It is considered that a period of two years from the date on which the technical formats and specifications are established by WIPO should also be sufficient for this purpose. If we know the technical formats and specifications by 1 February 2021, we can also endorse the date of entry into force of the proposed amendments on 1 February 2023.
5. As to introducing flexibilities allowing users to meet representation requirements in the designated contracting parties, the possible solution, namely to allow a second representation of the mark raises concerns as to legal certainty, practical feasibility and effectiveness. However, we are open to further exploring this solution.
6. The EU and its Member States look forward to hearing the opinion of other participants in the Working Group. We stand ready to work with the Secretariat, the Members of the Madrid Union and interested user associations in elaborating sound technical and legal solutions for adequate protection also of non-traditional trademarks via the Madrid System.

Thank you.

Agenda item 6

Partial Replacement (MM/LD/WG/18/4)

Thank you Chair,

1. The European Union and its Member States would like to thank the WIPO Secretariat for preparing document MM/LD/WG/18/4 proposing an amendment to Rule 21(3)(d) of the Regulations under the Madrid Protocol clarifying the possibility of partial replacement and the introduction of a new paragraph (7) in Rule 40 as a transitional provision.
2. At our last session, we reiterated our concerns as to the former of those proposals and were not ready to endorse that a national or regional registration may be partially replaced by an international registration. At the same time, we agree that replacement would benefit from a harmonisation exercise and we have consequently supported the continuation of discussions aimed at finding a consensual solution.
3. We have studied with interest the explanations elaborated by the International Bureau as to different interpretations of Article 4*bis*(1)(ii) of the Madrid Agreement and the Protocol. We tend to agree that a flexible reading, which acknowledges partial replacement in respect of goods and services covered by both the international registration and the national or regional registration is more in line with the purpose of replacement, which is to simplify the management of trademark portfolios for trademark holders.
4. We note that our concerns were related not only to implications necessitating changes in our information and communication technology systems to cater partial replacement. In addition, we foresaw complications in the examination of such requests where the overlap was not straightforward and ultimately, in the determination of the list of goods and services benefitting from the replacement.
5. Against this background, we welcome the proposal presented by the Secretariat to allow Offices time to make necessary changes and prepare for ramifications in practices by means of a transitional provision in Rule 40, whereas no Office shall be obliged to apply the amended provision on partial replacement before 1 February 2025.

6. In light of the evolving context of the proposed solution to achieve increased harmonisation on replacement, we now find ourselves in the position to endorse the concrete proposals made by the International Bureau in the Annex of the new document.

Thank you.

Agenda item 7

Study of the Cost Implications and Technical Feasibility of the Gradual Introduction of the Arabic, Chinese and Russian Languages into the Madrid System (MM/LD/WG/18/5 and MM/LD/WG/18/5 Corr.)

Thank you Chair,

1. The European Union and its Member States would like to thank the WIPO Secretariat for preparing a study of the cost implications and technical feasibility of the gradual introduction of the Arabic, Chinese and Russian languages into the Madrid System. We appreciate that the proposal before this session has become much clearer in its scope and that sufficient light has been shed on the overall context in which it is submitted for discussion.
2. On the basis of the new document, we find ourselves in a much better position to assess the actual financial and administrative burdens implied by the introduction of new languages. We have also studied with great interest the further elaboration on whether and to what extent a new translation regime could appropriately address all the complexities involved.
3. As a result of our deliberations on the above factors as facilitated by the new study and all the pertinent information submitted in Annexes I and II of the document, we still have a number of doubts about the introduction of Arabic, Chinese and Russian as filing languages at this point. It might cause an increase of errors due to translation divergences and administrative delays due to an increase of workload. Against the background of a prudent approach necessitated by the current global economic uncertainty we think it is not the right time to decide on measures that will impose more burdens to the Madrid System at this stage.
4. As the proposed amendments to Rules 6 and 9 are meant to enter into force no earlier than 1 February 2024 a decision should be taken when we can better assess the consequences of the worldwide pandemic on the Madrid System.

Thank you.