

Representation of AIPPI

10th Session Working Group
on the Legal Development of the Madrid System
for the International Registration of Marks

Geneva, July 5 and 6, 2012

REPORT

by Elena Molina, Member Q212

Main contents and materials of the roundtable meetings held on July 5, 2012

A roundtable was set up to examine the current situation in certain areas and discuss the possibility of changing certain practices. The agenda of the roundtable meetings is enclosed as **Exhibit 1**¹.

As indicated in the agenda, the three main topics discussed were the following:

I. Role of the office of origin versus the International Bureau of WIPO (IB), specifically regarding the following aspects:

i. *Irregularities.*

The IB gave us an overview of the current figures and latest developments in its internal procedures to reduce irregularities. It also informed us that two cooperation projects -one with the trademark holders and the other one with the national offices- have been set in motion with the same objective. Detailed information, with statistical data, on the type of irregularities was provided. According to these data, approximately 33% of the international trademark applications filed in 2012 present some kind of irregularity and most of the irregularities are related to the payment of taxes and the classification of goods and services.

The IB recommended that the national offices provide more information to the holders and representatives on their respective websites in order to avoid and/or reduce irregularities. The IB also informed that, in order to reduce irregularities in the list of goods and services due to the revision of the Nice Classification, the IB has prepared a draft of all the changes (about 500) made in the 9th version of the Nice Classification.

Finally, the representative of the Japanese delegation explained the method used by the Japanese Trademark Office to reduce irregularities, which have proved successful, and made some recommendations to the other national offices based on its experience.

Three successive presentations were made by Mrs. Asta Valdimarsdottir (Head of Operations Services), Mr. Carlos Espinoza (Program Assistant of the Quality and Planning Section of WIPO) and Mr. Hoshino (representative of the Japanese Trademark Office).

ii. *Indications in the lists of goods and services (appellations of origin and trademarks)*

Some lists of goods and services include appellations of origin and trademarks. Tequila, champagne, cognac, blu-ray (discs) are some examples of this. The IB held that there is no legal basis for it to refuse indications in a international trademark application that contain an appellation of origin or a trademark of a third party and that the measures to avoid this

¹ This is a provisional agenda. The final agenda is not available yet. However, no change was made.

situation must be taken at national level. OHIM supported this approach, but some delegations considered that the IB should have a major role in this respect, specially as far as appellations of original are concerned.

The presentation was made by Mrs. Debbie Roenning, Director.

II. Role of the designated office versus the IB, specifically regarding the following aspects:

i. *Limitations of the list of goods and services*

According to the IB, this issue has become more and more important over recent years due to the increase in the number of limitations. Each scenario in which the list of goods and services may be limited was analysed in detail. The IB asked the national offices for their opinion about a change in the IB's practice; it proposed that the limitations be examined not by the IB but by the national offices only. Many delegations expressed their opposition to a change in the current practice due to a different interpretation of the rules of the Arrangement and the Protocol.

This presentation was made by Mrs. Debbie Roenning.

ii. *Statements of grants of protection*

It is compulsory since January 1, 2011 for the national offices to send a statement of grant of protection to the IB after sending a provisional refusal. The IB indicated that 62 countries comply with this obligation (though no penalisation is prescribed) and most of them by electronic means, which is welcomed by the IB.

This presentation was made by Mr. Juan Rodríguez, Legal Division.

III. Licenses

The IB provided data about the situation of the recordal of licenses in the different Contracting Parties. According to these data, two countries (Australia and Germany) do not allow a license to be recorded on a trademark and there are some countries where a license can be recorded for national trademarks but where the recordal of a license for an international trademark is not recognised. This is the case of China, Russia and Korea, among others. Even though the recordal of a license for international trademarks has not been much used (currently there are about 2,000 recorded licenses), the IB invited those present to debate certain aspects of the recordal. In particular they wished to discuss the benefits of the recordal of a license, the need to record a license, the data required to be recorded and whether or not it would be sufficient to publish the recordal of the license in the Romarin database without any examination by the IB.

Finally to add that the IB asked participants for proposals for the next roundtable.

Main contents and materials of the presentation made on July 6, 2012

The last day of the 10th Session was devoted to explaining the latest developments in the IT systems of the IB for the Madrid System, in both those designed for users and those designed for the national offices. The contents were purely technical.

As far as the electronic tools for users, the IB explained the functionalities and advantages of the tools MPM, MRS, MEA and G&SM. Videos with tutorials on each on these tools are being developed and will be available in short in the website of WIPO.

Three successive presentations were made by Mr. Maurizio Di Mauro, Mrs. Isabelle Vicedo and Mr. Neil Wilson. The presentation made by Mr. Di Mauro is enclosed as **Exhibit 2**.

Summary of the Session by the Chair

The draft summary prepared by the Secretariat is attached as **Exhibit 3**. After its release, some amendments were made following the verbal contributions of the participants, in particular in items 6 and 7 and in paragraph 34. The main changes introduced in the draft summary are the following:

- i. Upon request by Japan and Norwege, the references to the specific country delegations in item 6 will be replaced by a generic reference to "a delegation" or "some delegations". These countries considered that the summary should not be so detailed.
- ii. At the request of INTA, a paragraph 26 bis will be inserted. This new paragraph will essentially as follows: "The Chair took note that all the representatives of the users organizations who spoke, unanimously supported the introduction of the division in the Madrid System and the majority of them supported the proposal by Switzerland". The Algerian delegation opposed to the inclusion of a comment made by the representative of an observer insofar as this could set up a precedent. However, the Chair accepted the proposal made by INTA, arguing that there was already precedent for this and the proposed amendment was reasonable.
- iii. Paragraph 33 was divided into two paragraphs. The new paragraph 33 bis starts with "Upon completion of the discussions...".
- iv. The first sentence of paragraph 34 was amended in order to remove express reference to APRAM. The amended sentence will read as follows: "The Chair took note that the representative of one users organization...".

Finally, I attach the list of participants² as **Exhibit 4**.

² This is a provisional list (no final list was made available)