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NOTE

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To:	Delegations
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Subject:	19th Session (Hybrid) of the WIPO Working Group on the Legal Development of the Madrid System for the International Registration of Marks (WIPO, Geneva, 15 – 19 November 2021) - Final EU/Member States statements

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**

19th Session (hybrid)

(WIPO, Geneva, 15 – 19 November 2021)

Provisional Refusal (MM/LD/WG/19/3 and MM/LD/19/INF/1)

Agenda item 5

Chair,

1. The European Union and its Member States would like to thank the WIPO Secretariat for preparing documents MM/LD/WG/19/3 and MM/LD/19/INF/1 on provisional refusal.
2. We reiterate our openness to exploring measures to harmonise the calculation of time limits for users to respond to provisional refusals, which would serve the benefit of users of the system. We welcome the new working document exploring the best possible way forward to achieve such goal.
3. As to the harmonisation of time limits, we support the option of a minimum time limit of two months. As compared to the alternative option of a fixed time limit of three months, a minimum time limit would give more flexibility to Contracting Parties as to their practices and the need to amend their respective legislations to cater the targeted change.
4. As regards the suggestion of delayed implementation of any proposed amendment to allow Contracting Parties for making changes to the applicable legislations, practices and information and communication technology systems, we fully endorse such proposal.

Thank you.

**Proposed Amendments to the Regulations Under the Protocol Relating to the Madrid
Agreement Concerning the International Registration of Marks**

(MM/LD/WG/19/4)

Agenda item 6

Chair,

1. The European Union and its Member States would like to thank the WIPO Secretariat for preparing document MM/LD/WG/19/4. We welcome the proposed amendments to the Regulations under the Madrid Protocol and agree that they would support the ongoing process of simplifying the Regulations and making the Madrid System more user-friendly.
2. Accordingly, we endorse the proposals presented in the Annex of the working document containing concrete suggestions for amending Rules 3(2)(b), 5(5) and 30(1)(b) of the Regulations.

Thank you.

Dependency (MM/LD/WG/19/5)

Agenda item 7

Chair,

1. The European Union and its Member States would like to thank the WIPO Secretariat for preparing document MM/LD/WG/19/5 on dependency. 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.
2. As regards the possible way forward, we welcome the further exploration of possible options. In our view, a route that may lead to a consensual solution could be oriented towards the reduction of the dependency period from five to three years. We can support such option.
3. Nevertheless, we are not ready to endorse the reduction of the grounds as discussed and further elaborated in paragraphs 19-25 of the document and the elimination of the automatic effect of dependency. In our view, these latter options raise heavy concerns.
4. The reduction of grounds would mean that a mark which is not eligible for protection may remain permanently in the International Register. In this case, we no longer need the basic mark. The proposal results in the abolition of the basic mark, not (yet) legally but de facto. The option to eliminate the automatic effect of dependency raises heavy concerns as to legal certainty.
5. We share the view of the International Bureau that looking at a possible way forward, it is crucial to strike a fair balance between the rights of the holders and those of third parties. The possible reduction of the dependency period appears to be the only element on which there is broad consensus. Therefore, we suggest that the Working Group should focus further discussions on reaching agreement on that consensual issue.
6. 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.

Proposal by the Delegation of Switzerland (MM/LD/WG/19/6)

Agenda item 8

Chair,

1. The European Union and its Member States would like to thank the Delegation of Switzerland for submitting its proposal concerning the limitations provided for in the Madrid System, as contained in document MM/LD/WG/19/6.
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 can also agree that a possible way forward could imply some adjustment of the legal framework. Against this background, we studied the new document with interest. In our understanding, Switzerland's proposal gives primacy to the Office of origin (and then to the International Bureau "in case of gross errors by the Office of origin") in determining if the proposed limitations fall under the scope of the main list of the international registration, and seeks to prohibit designated offices to object on the basis of their own interpretation.
3. We welcome the amendment to Rule 9(5)(d)(vi) of the Regulations. Most Offices of Origin already examine whether limitations contain extensions. We endorse taking a decision on that at this stage, as the Working Group has been discussing about limitations for nine years now.
4. Regarding the role of the IB, it would be most important that the IB examines the limitations in subsequent designations (Rule 24) and limitations recorded as a change under Rule 25. More than 90% of these requests are submitted directly to the IB and the limitations made in these requests are therefore not examined at all.
5. As to the role of designated Offices, we support alternative 2 (no amendments to Rule 17). Rule 17 applies *mutatis mutandis* to subsequent designations as stated in Rule 24(9). The limitations made in subsequent designations are generally not examined, as stated above. Therefore, the designated Office should have the right to examine whether the limitation is covered by the main list of the international registration.
6. The EU and its Member States are open to further discussions on this issue.

Thank you.

**Revised Study of the Cost Implications and Technical Feasibility of the Gradual Introduction
of the Arabic, Chinese and Russian Languages into the Madrid System and Other Relevant
Information
(MM/LD/WG/19/7)**

Agenda item 9

Chair,

1. The European Union and its Member States would like to thank the WIPO Secretariat for preparing a revised version of the study of the cost implications and technical feasibility of the introduction of the Arabic, Chinese and Russian languages into the Madrid System. We also thank the Secretariat for all the efforts made to address the issues raised by delegations at the last session, in particular for holding informal consultations and for conducting a formal request for information process with a view to obtaining more precise cost estimates from external translation companies.
2. We appreciate that resulting from all such efforts, document MM/LD/WG/19/7 contains highly relevant new information to assess.
3. We have studied with great interest the elements identified by the Secretariat that have emerged from informal consultations and can facilitate further discussions on this highly complex issue. In this context, we recognise and welcome that the Secretariat embraces a rapid evolution of AI-based technologies, in particular with respect to machine translation.
4. We welcome the new working document as a basis for further discussions on this matter. In this context, we reiterate our view that the maintenance of a good functioning of the Madrid system services is key. We support the continuation of further exploring the best possible way forward with special consideration given to the impact on fees and the convenience for users.
5. Chair, while we believe that further information is needed, the EU and its Member States stand ready to continue discussions on the basis of the new working document prepared by the Secretariat.

Thank you.