Council of the European Union

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NOTE

From:	Presidency
To:	Delegations
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Subject:	22nd Session of the WIPO Working Group on the Legal Development of the Madrid System for the International Registration of Marks (WIPO, Geneva, 7-11 October 2024) - Final EU/Member States statements

Delegations will find attached the final EU/Member States statements delivered at the above-mentioned WIPO meeting.

ANNEX

Working Group on the Legal Development of the Madrid System for the International Registration of Marks
22nd Session

(WIPO, Geneva, 7-11 October 2024)

Agenda item 4

E-mail Address as a Required Indication for Selected Requests for Recording

(MM/LD/WG/22/2 and MM/LD/WG/22/2 Corr)

Agenda item 5

Recalculation of the Amounts of the Individual Fees in Swiss Francs

(MM/LD/WG/22/3)

Agenda item 6

Proposal by the Delegation of the Republic of Moldova

(MM/LD/WG/22/4)

Chair,

1. The EU and its Member States can show openness towards the proposal by the delegation of Moldova, however we would like to seek further clarification about certain points. In particular we would be interested to hear further information about Option A, as proposed by the delegation.

2. In this respect, some technical comments: the role of the Office of origin should be clarified as regards the qualification of the applicant in relation to the contracting party which is not the Office of origin. In particular, the scope of its examination should be clear. Should the Office assume good faith or require evidence in case of doubts? The assessment of the qualification linked to the real and effective establishment could be difficult for the Offices of origin when dealing with contracting parties whose regulations are unknown to them. We already face difficulties regarding real and effective establishments in the EU for International applications and representation.

Agenda item 7

Dependency

(MM/LD/WG/22/5; MM/LD/WG/21/8 Rev; MM/LD/WG/20/5**)**

Chair,

1. The European Union and its Member States would like to thank the WIPO Secretariat for preparing document MM/LD/WG/23/5 compiling proposals and observations on dependency. We also would like to thank the Delegations of Australia, Chile, Ghana, the Philippines, the Republic of Korea and the United States of America for submitting their proposal contained in document MM/LD/WG/21/8 REV and the Delegation of China for the proposal contained in document MM/LD/WG/22/14.

2. The European Union and its Member States would like to reiterate their support to the current Madrid System, including the principle of dependency.

3. The European Union and its Member States are therefore not able to support the proposal contained in document MM/LD/WG/21/8 REV in its current form. The proposal aims at creating different options within the Madrid system, one of them being the removal of the dependency principle. The EU and its Members States would like to underline that international agreements in the field of industrial property protection generally only allow opt-out-declarations in very specific and exceptional cases, primarily if national law prohibits or does not provide for the corresponding legal concept. Second, we consider that such proposal would compromise the consistency and unity of the Madrid system, including by making one of the cornerstones of the Madrid system optional for Contracting Parties. It would also result in considerable legal uncertainty if some Contracting Parties abandoned the basic requirement, while others retained it, but possibly with different periods of dependency. The resulting designations, depending on which Contracting Party they originate from, would either be completely unchecked but independent, or pre-checked but dependent and thus subject to central attack. This would therefore result in a more complex and unpredictable system, to the detriment of the users.

4. The European Union and its Member States are not able to support the proposal contained in document MM/LD/WG/22/14 in its current form. This proposal aims at creating an option for contracting parties to limit and narrow the grounds for applying dependency. In this context we would like to reiterate our concerns about making dependency optional, which would result in legal inconsistencies and uncertainty within the Madrid System. Furthermore, as already expressed in past sessions of the Madrid working Group, we cannot support limiting the grounds for applying dependency. Such limitation would unduly weaken the instrument of central attack, which is of key importance for trade mark owners, and therefore affect the current balance of interests between trade mark owners and third parties.

5. We reiterate, that it is crucial to strike a fair balance between the rights of trademark holders and those of third parties. Therefore, we continue to support the reduction of the dependency period from five to three years.

6. In that respect, the European Union and its Member States would like to address the possible convening of a diplomatic conference to amend Article 6 of the Protocol in order to tackle the issue of dependency (document MM/LD/WG/20/5).

7. We reiterate our support for this solution and endorse a recommendation to the Madrid Union Assembly to convene a Diplomatic Conference, with the aim to reduce the dependency period from five to three years.

8. As regards the composition of the Diplomatic Conference as addressed in point 19 of the document, it is our view that “Member Delegations” of the Conference should be Contracting Parties of the Madrid Union.

9. As we can agree to make a recommendation on convening a Diplomatic Conference, we would also like to request the Secretariat to prepare a revised version of the Protocol, including final and administrative provisions, to be discussed by the Working Group at its next session.

10. Finally, as to other possible amendments to the Protocol going beyond Article 6, we support the identification of the Secretariat of Articles 3(2), 3(3)(ii), 3(5), 4bis(1), 5(2)(c)(ii), 5(3) and 5ter(2) as relevant articles that would benefit from an update or where some modernisation would be appropriate.

11. We remain interested to hear the opinions of other participants of the Working Group. The EU and its Member States look forward to further discussions on this issue.

Thank you.

Agenda item 8

The Possible Introduction of New Languages

(MM/LD/WG/21/7, MM/LD/WG/22/6 REV., MM/LD/WG/22/7, MM/LD/WG/22/8, MM/LD/WG/22/9)

Chair,

1. The European Union and its Member States would like to thank the WIPO Secretariat for preparing documents MM/LD/WG/22/6 Rev, MM/LD/WG/22/7, MM/LD/WG/22/8 and MM/LD/WG/22/9. 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 technical consultations during the past year.

   These efforts proved very fruitful, with highly relevant new information to assess.

2. On what refers to the Detailed draft implementation plan for the enhancement of the terminology database, we value the plan prepared by the Secretariat. This plan includes very comprehensive steps towards the introduction of new languages in the Terminology Database. We have, however, noted that Portuguese, Japanese and German have not been included in the analysis, even when an interest had been shown by the relevant Member States for such introduction. We consider that such analysis is needed before this Working Group makes any decision in respect to the implementation of the enhancement of the Terminology Database. Moreover, the database should only be made public if it can ensure a high-quality standard to avoid legal uncertainty in case of infringements. Finally, the publication of the database presents significant technical challenges and we would appreciate information on how the Secretariat plans to address these issues.

3. On the update on the development of specifications for the transmission of machine-readable data in communications from offices, we thank the efforts of the International Bureau in adopting the new XML templates and APIs solutions described in the document.

4. Lastly, on what refers to the Detailed draft implementation plan for the introduction of a differentiated translation practice, we appreciate the analysis presented by the Secretariat. We consider that the introduction of this differentiated practice is justified as a cost effective and time saving option for a language that was not used to notify the designated Contracting

Party, and due to the low volume of the data that was translated using WIPO Translate. Therefore, the EU and its Member States support the introduction of a differentiated translation practice as described in the document. This differentiated translation practice can be beneficial to the system, without prejudice to continuing the debate on the introduction of new languages.

5. We thank the delegations of Germany, Portugal, Japan, Brazil, Cabo Verde, Mozambique, and Sao Tome and Principe for their proposals. In our view, these proposals require that we further analyse the introduction of new languages in the system.

6. We understand the rationale behind introducing new languages into the Madrid System, on the condition that it represents an advantage and not a burden to the users of the system. The proposal on an 'International Registration Language Option', introduced by the delegations mentioned above, could be a good way forward to ensure that the system does not become too burdensome for users. In our view, this proposal should be carefully assessed in all its elements considered before deciding on the introduction of any new language.

7. In any case, should new languages be introduced, we reiterate our support to the objective and user-oriented criteria, proposed by WIPO and agreed last year by this Working Group, for determining which languages should be included. Against this background, the EU and its Member States stand ready to continue discussions about the introduction of new languages into the Madrid System and how to best proceed with such introduction.

8. Chair, we reiterate our view that the maintenance of a good functioning of the Madrid system services should remain a key priority and you can count in this respect on the support of the EU and its Member States.

Thank you.