

## **Special Union for the International Registration of Marks (Madrid Union)**

### **Assembly**

**Forty-Fourth (19<sup>th</sup> Ordinary) Session**  
**Geneva, September 26 to October 5, 2011**

#### **PROPOSALS FOR THE SIMPLIFICATION OF THE MADRID SYSTEM**

*Document prepared by the International Bureau*

#### **INTRODUCTION**

1. It is recalled that at the eighth session of the Working Group on the Legal Development of the Madrid System for the International Registration of Marks (hereinafter referred to as “the Working Group”), held from July 5 to 9, 2010, it was agreed that the next session of the Working Group would deal with issues relating to the further simplification of the internal processes carried out by the International Bureau, in order to make the Madrid system simpler, more efficient, reliable, flexible, user-friendly as well as time- and cost-effective (document MM/LD/WG/8/6).
2. At its ninth session held from July 4 to 8, 2011, the Working Group considered document MM/LD/WG/9/4, prepared by the International Bureau. The document contained four proposals requiring amendments to the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement (hereinafter referred to as “the Common Regulations”): (1) translation upon request of statements of grant of protection, following a provisional refusal, made under Rule 18~~ter~~(2)(ii);

(2) translation of the list of goods and services affected by a limitation in an international application, subsequent designation or request for limitation; (3) communications concerning the status of protection of the mark sent by the Offices of the Contracting Parties to the International Bureau in a positive manner; and (4) efficient publication of the *WIPO Gazette of International Marks* (hereinafter referred to as “the Gazette”).

3. During that session, the Working Group agreed to recommend that the Madrid Union Assembly (hereinafter referred to as “the Assembly”) take note of the practice of the International Bureau concerning the translation upon request of statements of grant of protection following a provisional refusal made under Rule 18~~ter~~(2)(ii), and to take note of the recommendation by the Working Group that the International Bureau implement a practice concerning the translation of the list of goods and services affected by a limitation in an international application, subsequent designation or request for limitation, with the inclusion of the option of translation upon request.

4. The Working Group also agreed to recommend that the Assembly amend Rule 32(3) of the Common Regulations regarding the publication of the Gazette as provided for in the draft contained in the Annex of document MM/LD/WG/9/4. For easier reference, the proposed amendment to Rule 32(3) is reproduced in the Annex of this document. The deleted text is struck through; the added text is underlined.

5. Explanatory notes on the recommendations of the Working Group regarding statements of grant of protection and limitations and the proposed amendment to Rule 32(3) are provided in the paragraphs that follow.

#### **NOTES ON THE PRACTICES IN RELATION TO TRANSLATIONS UPON REQUEST OF STATEMENTS OF GRANT OF PROTECTION, FOLLOWING A PROVISIONAL REFUSAL, MADE UNDER RULE 18~~TER~~(2)(II)**

6. According to Rule 6(3)(a), the recording in the International Register and the publication in the Gazette of international registrations or any other information recorded and published according to the Common Regulations, shall be performed in the three working languages of the Madrid system, namely, English, French and Spanish. Furthermore, Rule 6(4)(a) has an explicit mandate that, for its recording and publication, the International Bureau translates this information.

7. As a result of an increase in the volume of the operations pertaining to the Madrid system due to several accessions to the Madrid Protocol, and in order to manage constraints imposed by financial restrictions in the International Bureau as well as the introduction of Spanish as a working language of the system, the International Bureau decided to introduce the practice of translation upon request of the notifications of final decisions under former Rule 17(4)(b), and subsequently of statements of grant of protection following a provisional refusal made under Rule 18~~ter~~(2)(ii).

8. This practice provides for the recording and publishing of statements in the received language, and an automatic translation into the language of the international application, if that is different, thus preserving the linguistic unity of all the recordings in an international registration concerned with a statement of grant of protection, following a provisional refusal, made under Rule 18~~ter~~(2)(ii). The holder thus has all documents related to his right in his preferred language. All other translations are made upon request. The practice described above introduces a flexibility of translation upon request for documents that experience has shown may not be much sought after; it does not impinge upon the rights of holders of the concerned international registrations or the concerned Offices.

9. This continued practice has confirmed the fact that there is very low demand for the translation of statements made under Rule 18*ter*(2)(ii). In fact, during the first six months of 2011, the International Bureau has received more than 18,000 statements, and has only received 128 requests for the translation of such statements.

10. On June 30, 2011, the number of pending translations of statements made under Rule 18*ter*(2)(ii) was 154,719 (see Table I). The International Bureau has estimated that the average number of words concerning translation of the statements made under Rule 18*ter*(2)(ii) is 99; therefore, the total number of words to be translated with respect to these transactions would almost be 15.20 million. At a fixed rate of 0.25 Swiss francs per translated word, the cost of outsourcing this task would reach over 3.8 million Swiss francs.

Table I

Statements Under Rule 18*ter*(2)(ii), Pending Translations on June 30, 2011

Translations		
French to English	13,942	9%
Spanish to English	0	
English to French	61,095	40%
Spanish to French	128	
English to Spanish	63,366	51%
French to Spanish	16,188	
Total	154,719	100%

11. The International Bureau introduced to the Working Group the document entitled "Proposals for the Simplification of the Madrid System" (document MM/LD/WG/9/4). The mentioned document described the current practice of translation upon request of statements made under Rule 18*ter*(2)(ii). The document also made a proposal for the formal introduction, in the legal framework of the Madrid system, of the policy of translation, upon request, of these statements.

12. The legalization of this translation practice (described in paragraph 6, above) would have required amendments to Rules 6 and 40. With respect to Rule 6(4), a new subparagraph (c) would have included the possibility of recording and publishing the statements made under Rule 18*ter*(2)(ii) in their original language, while introducing the possibility of translating the statements upon request.

13. At the conclusion of the session, the Working Group did not endorse the proposed legalization of the current practice of the International Bureau embodied by the proposal, but agreed to recommend to the Assembly to take note of the current practice of the International Bureau concerning translation upon request of statements of grant of protection, following a provisional refusal, made under Rule 18*ter*(2)(ii) (paragraphs 5 to 24 of document MM/LD/WG/9/4).

**NOTES ON THE PRACTICES IN RELATION TO TRANSLATION OF THE LIST OF GOODS AND SERVICES AFFECTED BY A LIMITATION IN AN INTERNATIONAL APPLICATION, SUBSEQUENT DESIGNATION OR REQUEST FOR LIMITATION**

14. As it has been previously stated, according to Rule 6(3)(a), the recording in the International Register and the publication in the Gazette of international registrations or any other information recorded and published according to the Common Regulations, shall be performed in the three working languages of the Madrid system, namely, English, French and Spanish. Furthermore, Rule 6(4)(a) has an explicit mandate that the International Bureau shall translate this information for its recording and publication.

15. Under Rules 14, 24(8), 27(1) and 32(1)(a)(i), (v) and (vii), among the information that needs to be translated for its corresponding recording and publication is the indication of the goods and services affected by a limitation in an international application, in a subsequent designation or in a request for recording.

16. In 2010, the International Bureau recorded 3,436 international registrations which included a request for the recording of a limitation. In 2,091 of these requests, the language of the international application was the same as the language of communication notified under Rule 6(2)(iii) by the Office concerned with the limitation (see Table II).

Table II

Requests for the Recording of a Limitation Made in an International Application in 2010

	Language of IA = Language of Office Concerned With Limitation			Language of IA ≠ Language of Office Concerned	Total Number of Limitations in IA
	English	French	Spanish		
Limitations in an International Application (IA)	2,044	36	11	1,345	3,436
Words in Indications of Goods and Services Affected by the Limitation	206,411	5,948	647	163,901	376,907

17. Under Rule 24(3)(a)(iv), a subsequent designation may indicate only part of the goods and services listed in the international registration concerned, thus providing for the possibility of a partial subsequent designation which implies a limitation of the original scope of protection of the international registration in question. It is to be noted that in 2010, the International Bureau recorded 1,592 partial subsequent designations. In 751 of these partial designations, the language used to file the subsequent designation was the same as the language notified under Rule 6(2)(iii) by the Office concerned with the limitation (see Table III).

Table III

## Partial Subsequent Designation in 2010

	Language of Subsequent Designation = Language of Office Concerned with Partial Designation			Language of Designation ≠ Language of Office Concerned	Total Number of Partial Subsequent Designations
	English	French	Spanish		
Partial Subsequent Designation	620	125	6	841	1,592
Words in Indications of Goods and Services Affected by the Partial Designation	33,038	6,121	67	46,919	86,145

18. Finally, in 2010, the International Bureau recorded 2,771 limitations. In 1,608 of these limitations, the language used to file the request for recording was the same as the language of communication notified under Rule 6(2)(iii) by the Office concerned with the limitation (see Table IV).

Table IV

## Requests for the Recording of a Limitation Made in 2010

	Language of Request for Recording a Limitation = Language of Office Concerned With Limitation			Language of Request ≠ Language of Office Concerned	Total Number of Request for Recording a Limitation
	English	French	Spanish		
Request for the Recording of a Limitation	1,472	132	4	1,163	2,771
Words in Indications of Goods and Services Affected by the Limitation	185,785	13,154	284	82,667	281,890

19. In summary, in 2010, for the purposes of recording in the International Register and publication in the Gazette, the International Bureau had to translate 451,455 words concerning the indication of the goods and services affected by a limitation, before it could notify the concerned Office, even though the language in which the request was presented to the International Bureau was the same as the language of communication of the Office in question.

20. The International Bureau proposed new subparagraphs (d), (e) and (f) in Rule 6(4) that would introduce a more sensible approach to the translation of the indications of goods and services affected by a limitation. Where the language used in the request for the recording of a limitation is the same as the language of communication chosen by the Office concerned with the said limitation, the proposed new subparagraphs would provide for the recording and publication of the indications affected by the limitation in this language.

21. In order to preserve the linguistic unity of all the recordings in an international registration concerned with a limitation, where the language used in the request for the recording of a limitation or in a partial subsequent designation is not the same as the language of the international application, a proposed new subparagraph (g) of Rule 6(4) would provide for the additional recording and publication in the latter.

22. The Working Group did not endorse the proposed amendments, but recommended that the International Bureau implement a practice concerning the translation of the list of goods and services affected by a limitation in an international application, subsequent designation or request for limitation, as described in paragraphs 25 to 44 of document MM/LD/WG/9/4, with the inclusion of the option of translation upon request, and agreed to recommend that the Assembly take note accordingly.

#### **NOTES ON PROPOSED AMENDMENT TO RULE 32 OF THE COMMON REGULATIONS**

23. Under Rule 32, the International Bureau publishes on the Madrid system website the Gazette, which contains all relevant data on new international registrations, renewals, subsequent designations and other entries affecting international registrations. The Gazette also contains information of general interest such as declarations and notifications made by Contracting Parties concerning particular requirements, the amounts of the individual fees under Article 8(7) of the Protocol and information regarding the working days of the International Bureau.

24. Responding to the information needs of the users of the Madrid system and in an effort to disseminate the information contained in the International Register in the most reliable, efficient and effective manner, the International Bureau has published the Gazette, throughout the years, in various forms, which have corresponded to the technological means available at the time.

25. The Gazette was traditionally published on paper and, later, on microfiche, and it was available under paid subscription. The microfiche edition of the Gazette was discontinued at the end of 1998, upon the introduction of a monthly cumulative edition of the Gazette published on CD-ROM. As from September, 2005, an exact replica of the paper edition of the Gazette, in PDF form, became available free of charge on the Madrid system website. The paper version of the Gazette was discontinued at the end of 2008.

26. From January 2008 through December 2010, the Gazette was issued in two versions. It was available on CD-ROM, under paid subscription, and online, in PDF, free of charge.

27. In early 2010, the International Bureau introduced an electronic version of the Gazette, which can be browsed by chapter or searched by mark. As from January, 2011, with the discontinuation of the versions on CD-ROM and in PDF, the electronic version, free of charge, has become the only version of the Gazette currently available.

28. It is apparent that the introduction of the Gazette in electronic form, facilitated by emerging publication technology, has made Rule 32(3) outdated.

29. It is proposed that Rule 32(3) is amended to indicate that the publication of the Gazette is done on the website of WIPO. New Rule 32(3) would read as follows:

“(3) The Gazette shall be published on the website of the World Intellectual Property Organization.”

30. The proposed new paragraph (3) would align the mode of the publication of the Gazette with the standing practice of the International Bureau concerning other treaties administered by WIPO. It is to be noted that Rule 26(3) of the Common Regulations under the 1999 and the 1960 Act of the Hague Agreement Concerning the International Registration of Industrial Designs provides that “The Bulletin shall be published on the website of the Organization”.

31. The Working Group agreed to recommend to the Assembly the adoption of the amendment to Rule 32(3), on the efficient publication of the Gazette, as proposed.

32. The proposed date of entry into force of the amendment to the Common Regulations, if adopted, is January 1, 2012.

33. *The Assembly is invited to:*

*(i) take note of the practice of the International Bureau concerning translation upon request of statements of grant of protection, following a provisional refusal, made under Rule 18ter(2)(ii), as referred to in paragraph 3;*

*(ii) take note of the recommendation by the Working Group that the International Bureau implement a practice concerning the translation of the list of goods and services affected by a limitation, in an international application, subsequent designation or request for limitation with the inclusion of the option of translation upon request, as referred to in paragraph 3; and*

*(iii) adopt the proposed amendment to Rule 32(3) of the Common Regulations with a date of entry into force on January 1, 2012, as set out in the attached Annex.*

[Annex follows]

## PROPOSALS FOR THE MODIFICATION OF THE LEGAL FRAMEWORK OF THE MADRID SYSTEM

PROPOSALS CONCERNING THE COMMON REGULATIONS UNDER THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS AND THE PROTOCOL RELATING TO THAT AGREEMENT

### *Rule 32 Gazette*

[...]

(3) The Gazette shall be published on the website of the World Intellectual Property Organization. ~~[Number of Copies for Offices of Contracting Parties] (a) The International Bureau shall send to the Office of each Contracting Party copies of the Gazette. Each Office shall be entitled, free of charge, to two copies and, where during a given calendar year the number of designations recorded with respect to the Contracting Party concerned has exceeded 2,000, in the following year one additional copy and further additional copies for every 1,000 designations in excess of 2,000. Each Contracting Party may purchase every year, at half of the subscription price, the same number of copies as that to which it is entitled free of charge.~~

~~(b) If the Gazette is available in more than one form, each Office may choose the form in which it wishes to receive any copy to which it is entitled.~~

[End of Annex and of document]