

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

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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”) 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. During their interventions, several delegations stressed the need to make the Madrid system more attractive for its users, namely applicants, right-holders, interested third parties and Offices of the Contracting Parties, through its increased efficiency. Thus, consensus was reached on the need to continuously focus on the simplification of the Madrid system. It was further understood that, at this stage, the said simplification would be undertaken without touching upon the core pillars of the Madrid system.
2. In line with the above, the International Bureau has begun a review of its organization, processes and practices in order to streamline them. As a result of this process, it became clear that certain 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, respectively, as “the Common Regulations” and “the Protocol”) might be required.

3. The exercise of the said review has taken into account the changes that have occurred in the Madrid system since the entering into force of the Common Regulations.
4. This document concerns itself with amendments to the Common Regulations dealing with translation upon request of statements of grant of protection, following a provisional refusal, made under Rule 18*ter*(2)(ii), translation of the list of goods and services affected by a limitation in an international application, subsequent designation or request for limitation, 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 efficient publication of the Gazette.

I. TRANSLATION UPON REQUEST OF STATEMENTS OF GRANT OF PROTECTION, FOLLOWING A PROVISIONAL REFUSAL, MADE UNDER RULE 18*TER*(2)(II)

a. Current Situation

5. As from April 1, 1996, after the introduction of English as a working language of the Madrid system and with the new obligation to notify the outcome of final decisions, under former Rule 17(4)(b), the International Bureau was in a position to translate all communications using its internal resources.
6. On January 1, 2005, 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 to manage constraints imposed by financial restrictions in the International Bureau and the introduction of Spanish as a working language of the system, the International Bureau suspended the translation and publication of the indications of the goods and services mentioned in the notifications of final decisions under former Rule 17(4)(b), publishing just a mention of whether these notifications concerned all of the goods and services in the international registration.
7. Upon further consideration, the International Bureau decided to introduce the practice of translation upon request of the notifications of final decisions. These notifications follow proceedings resulting from the lodging of a request for review or an appeal against a provisional refusal, before the Office of the concerned Contracting Party, with the involvement or, at least, the awareness of the holder of the international registration in question. Therefore, it was considered that the translation and publication of these notifications satisfied the information needs of interested third parties. It is to be noted that, while this practice was in place, the International Bureau received very few complaints or requests for the translation of these notifications.
8. In early 2007, to adequately manage the continuous growth of the Madrid system, the International Bureau allowed for the possibility of outsourcing the translation of all the communications concerning final decisions, by means of external translation services.
9. In early 2009, due to financial constraints, the International Bureau was compelled to reinstate the practice of translation upon request of the statements of grant of protection, following a provisional refusal, notified now under Rule 18*ter*(2)(ii). Nonetheless, a few of these statements were translated using external resources, while others were translated at the International Bureau, taking advantage of the sporadic availability of some internal

translators. During this period, the International Bureau observed that the number of requests received concerning the translation of the statements under Rule 18ter(2)(ii) averaged 50 per month. By comparison, the statements recorded per month under Rule 18ter(2)(ii) average 2,047.

10. According to Rule 6(3)(a), the recording in the International Register and the publication in the *WIPO Gazette of International Marks* (hereinafter referred to as “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.
11. Under Rules 18ter(5) and 32(1)(a)(iii), among the information that needs to be translated for its corresponding recording and publication is the contents of the notification of statements of partial grant of protection, following a provisional refusal, made under Rule 18ter(2)(ii), namely, the indication of the goods and services for which protection of the mark is granted in the Contracting Party concerned.
12. In the Program and Budget for the 2010-11 biennium, approved by the Assemblies of the Member States of WIPO on October 1, 2009, no provision was made for the engagement of external services concerning the translation of statements made under Rule 18ter(2)(ii). The International Bureau has continued the practice of translating the statements upon request, while additionally allowing for the translation of these statements, whenever internal resources are available.
13. This continued practice has confirmed the fact that there is very low demand for the translation of statements made under Rule 18ter(2)(ii). In fact, during the first trimester of 2011, the International Bureau has only received 47 requests for the translation of statements made under Rule 18ter(2)(ii).
14. On February 10, 2011, the number of pending translation of statements made under Rule 18ter(2)(ii) was 133,794 (see Table I). The International Bureau has estimated that the average number of words concerning translation of the statements made under Rule 18ter(2)(ii) is 99; therefore, the total number of words to be translated with respect to these transactions would almost be 13.25 million. At a fixed rate of 0.25 Swiss francs per translated word, the cost of outsourcing this task would reach over 3.31 million Swiss francs.
15. On the other hand, the International Bureau estimates that an internal translator is able to process, on average, 24,000 words per month. Just to complete the pending transactions concerning translation of the notifications made under Rule 18ter(2)(ii), it would take the equivalent 552 months or 46 years of the work of an internal translator.

Table IStatements Under Rule 18*ter*(2)(ii)
Pending Translations on February 10, 2011

Translations	
French to English	11,482
Spanish to English	0
English to French	53,105
Spanish to French	97
English to Spanish	55,410
French to Spanish	13,700
Total	133,794

16. Just in 2010, 24,567 new statements made under Rule 18*ter*(2)(ii), representing 49,134 translations, were added to the number of statements awaiting translation. Assuming zero growth in the number of statements received under Rule 18*ter*(2)(ii), each year the International Bureau would have to make provisions for the translation of 4.86 million words. This means that each year the International Bureau would have to allocate 1.22 million Swiss francs to outsource this task or it would have to engage 17 internal translators, working full time, to complete this task within the same year.
- b. Proposed Changes**
17. Taking into account the low demand for the translated versions of statements of grant of protection, following a provisional refusal, made under Rule 18*ter*(2)(ii), consideration should be given to the formal introduction, in the legal framework of the Madrid system, of the policy of translation, upon request, of these statements.
18. The implementation of the previously described policy would require amendments to Rules 6 and 40. With respect to Rule 6(4), a new subparagraph (c) would include 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 only upon request.
19. In order to preserve 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), where the language in which the statement was received is not the same as the language of the international application, the proposed new subparagraph (c) of Rule 6(4) provides for the additional recording and publication in the latter. As a result, for instance, where the language of an international application is English and a statement made under Rule 18*ter*(2)(ii) is received in French, to preserve the linguistic unity of the international registration in question, the statement would also be translated, recorded and published in English, as the language of the international application.

20. The proposed new Rule 6(4)(c) would read as follows:

(c) The recording in the International Register and the publication in the Gazette of statements of grant of protection, following a provisional refusal, made under Rule 18*ter*(2)(ii) shall be in the language in which the relevant statement was received by the International Bureau. Where the language of recording and publication of the statement under Rule 18*ter*(2)(ii) is not that in which the relevant international application was received by the International Bureau, such recording and publication shall also be in the language in which the relevant international application was received by the International Bureau. Other translations concerning such statements will, upon request, be made and provided by the International Bureau.

21. Correspondingly, a minor addition, which is explained in paragraph 39 of this document, would have to be made to Rule 6(3)(a), in order to align it to the proposed new subparagraph (c) of Rule 6(4) (see paragraph 39, below).
22. Finally, concerning Rule 40(4), a new transitional provision, which is explained in paragraph 40 of this document, would be required in order to allow for the translation, upon request, of all existing statements of grant of protection, following a provisional refusal, under Rule 18*ter*(2)(ii) pending translation on the date of entry into force of the proposed new subparagraph (c) of Rule 6(4) (see paragraph 40).

c. Expected Results

23. The introduction of the proposed changes would allow a more rational allocation of the existing resources, while still satisfying the needs of the users of the system. Furthermore, a sensible allocation of the existing resources would, in turn, place the International Bureau in a better position for the further expansion of the Madrid system into new geographical areas and to absorb the future growth, thus fulfilling the mandate of achieving a more attractive Madrid system.
24. The recording in the International Register and the publication in the Gazette of the statements of grant of protection, following a provisional refusal, made under Rule 18*ter*(2)(ii) will be in the working language in which it was communicated to the International Bureau and in the language of the international application. A reproduction of the statements, if received, would still be notified to the relevant holders. Furthermore, upon request, the International Bureau would translate the contents of the said statements.

II. TRANSLATION OF THE LIST OF GOODS AND SERVICES AFFECTED BY A LIMITATION IN AN INTERNATIONAL APPLICATION, SUBSEQUENT DESIGNATION OR REQUEST FOR LIMITATION

a. Current Situation

25. 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.

26. 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.
27. A request for the recording of a limitation concerning the scope of protection of the mark in a designated Contracting Party might be prompted for various reasons (e.g., to comply with a more stringent application of the specialty principle by an Office in a designated Contracting Party or to meet a private commitment in a particular jurisdiction). In any event, it is often the case that the indication of the goods and services affected by the limitation is presented in an increasingly more complex fashion, compared to the indications used to establish the original scope of protection. In turn, this linguistic complexity imposes an increased burden on the translation tasks undertaken by the International Bureau.
28. It is often the case that holders of international registrations file a request for the recording of a limitation in an effort to secure rights in a designated Contracting Party, following a notification of provisional refusal issued by the concerned Office which indicates that protection could be afforded if the scope was to be limited with respect to the Contracting Party in question. Furthermore, it is also the case that compliance with the limitation indicated by the concerned Office is subject to a time limit.
29. In this particular case, holders of international registrations who have filed a request for the recording of a limitation, prompted by an Office action, would have to wait until the request is translated before it could be recorded in the International Register, published in the Gazette and finally notified to the Offices of the Contracting Parties concerned with the limitation. Therefore, the current situation has the potential to adversely affect holders of international registrations, pursuing rights in a particular Contracting Party, preventing them from acquiring these rights. In this particular case, the Madrid system is not adequately serving the needs of its principal users.
30. The International Bureau has made steady efforts to decrease the pendency time concerning translations. In fact, between 2007 and 2010, the average number of days a document waited to be translated by the International Bureau into English went from 7.48 to 2.11; into French from 33.46 to 18.87; and, into Spanish, from 51.07 to 37.01. Despite these efforts, there remains an increased probability that the request for the recording of a limitation could be notified to the Office of the concerned Contracting Party beyond any applicable time limit to overcome a provisional refusal, rendering all the efforts undertaken by the holder of the international registration in question futile.
31. On the other hand, the International Bureau has taken note that, in a significant number of cases, the request for the recording of a limitation is presented to the International Bureau in the same language of communication notified under Rule 6(2)(iii) by the Office concerned with the limitation.

32. 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

33. 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

34. 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

35. 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.

b. Proposed Changes

36. Proposed new subparagraphs (d), (e) and (f) in Rule 6(4) 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 paragraph would provide for the recording and publication of the indications affected by the limitation in this language.
37. 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. As a result, for instance, where the language of an international application is French and a request for the recording of a limitation is presented direct to the International Bureau in English, even if the request concerns an Office which communicates with the International Bureau in this language, to preserve the linguistic unity of the international registration in question, the request would also be translated, recorded and published in French, as the language of the international application.

38. The proposed new subparagraphs (d), (e), (f) and (g) of Rule 6(4) would read as follows:

(d) The recording in the International Register and the publication in the Gazette of the list of goods and services affected by a limitation in an international registration recorded under Rule 14 shall be in the language in which the relevant international application was received by the International Bureau and in the language notified under paragraph (2)(iii) to the International Bureau by the concerned designated Office;

(e) The recording in the International Register and the publication in the Gazette of the part of the goods and services listed in an international registration concerned by a subsequent designation recorded under Rule 24(8) shall be in the language of the subsequent designation and in the language notified under paragraph (2)(iii) to the International Bureau by the concerned designated Office;

(f) The recording in the International Register and the publication in the Gazette of the list of goods and services affected by a limitation recorded under Rule 27(1), shall be in the language of the limitation, and in the language notified under paragraph (2)(iii) to the International Bureau by the concerned designated Office.

(g) Where the language of recording and publication of the list of goods and services under (e) or (f), is not that in which the relevant international application was received by the International Bureau, such recording and publication shall also be in this language.

39. A minor addition would have to be made to Rule 6(3)(a) in order to align it with the proposed new subparagraphs (c), (d), (e), (f) and (g) in Rule 6(4). Therefore, Rule 6(3), with the proposed new wording in subparagraph (a), would read as follows:

(3) [*Recording and Publication*] (a) Subject to paragraphs 4(c) to (g), the recording in the International Register and the publication in the Gazette of the international registration and of any data to be both recorded and published under these Regulations in respect of the international registration shall be in English, French and Spanish. The recording and publication of the international registration shall indicate the language in which the international application was received by the International Bureau.

40. Concerning Rule 40(4), a new transitional provision would be required in order to allow for the prompt implementation of the new policy concerning translation of the indications of goods and services affected by a limitation and with the previously described policy of translation, upon request, of statements made under Rule 18ter(2)(ii). A proposed new subparagraph (c) of Rule 40(4) would read as follows:

(c) Rule 6(4)(c) to (g) as in force from [...], shall be applicable to any statement of grant of protection under Rule 18ter(2)(ii), any limitation in an international registration recorded under Rule 14, the part of the goods and services listed in any international registration concerned by a subsequent designation recorded under Rule 24(8), or the list of goods and services affected by any limitation recorded under Rule 27(1), pending translation on [...].

41. Finally, a small phrase would have to be appended to Rule 40(4)(a) to align it with the proposed new subparagraph (c). Rule 40(4)(a), as appended, would read as follows:

(4) [*Transitional Provisions Concerning Languages*] (a) Subject to paragraph (c), Rule 6 as in force before April 1, 2004, shall continue to apply to any international application filed before that date and to any international application governed exclusively by the Agreement filed between that date and August 31, 2008, inclusively, to any communication relating thereto and to any communication, recording in the International Register or publication in the Gazette relating to the international registration resulting therefrom, unless [...].

c. Expected Results

42. The proposed amendments to subparagraphs (a) in Rule 6(3) and (a) in Rule 40(4), as well as the new subparagraphs (d) in Rule 6(4) and (c) in Rule 40(4) would allow for the expedited recording, publication and notification of limitations, thus, preserving the possibility that holders of international registrations secure rights in a designated Contracting Party, by complying with a possible time limit to effect the aforementioned limitation.
43. Should the request for the recording of a limitation be made in the language of communication of the concerned Office, the International Bureau would be in a position to record, publish and notify the request without further delays. The linguistic unity of the international registration is maintained, as the request would, if required, be translated to the language of the international application.
44. Furthermore, in line with the previous proposal, the introduction of the new subparagraph (d) in Rule 6(4) would result in a more rational allocation of the existing linguistic resources with an overall decrease in processing time, which in turn would allow the International Bureau to accommodate for the anticipated geographical expansion of the Madrid system with the accession of new Contracting Parties and for an increased use, i.e., more international applications from Contracting Parties of the Madrid system.

III. 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

a. Current Situation

45. It must be noted that, according to the Regulations under the Madrid (Stockholm) Agreement, as in force on April 1, 1994, the notifications of refusal of protection and invalidation, where these did not affect all the goods and services, had to indicate the goods and services in respect of which protection was refused (Rule 16(2)(v)) or the invalidation had been pronounced (Rule 18(2)(iv)). In other words, the communications concerning the status of protection of the mark had to be sent in a negative manner; that is, indicating the goods and service for which protection had not been granted.

46. The Common Regulations introduced the possibility of notifying the scope of protection of the mark in a positive or negative manner. During the sixth session of the Working Group on the Application of the Madrid Protocol of 1989, it was proposed that “in the case of a partial refusal, the Office communicating the refusal have the option to indicate either the goods and services which are affected by the refusal or those which are not affected, [...]”¹ indicating that the same applied with respect to invalidations.
47. The current Common Regulations have extended the possibility of notifying the scope of protection of the mark in a positive or negative manner to three communications, other than those dealing with refusals and invalidations, sent by the concerned Offices; namely, with respect to declarations that the recording of a given license has no effect, to notifications relating to the ceasing of effect of the basic mark, and to declarations that a limitation has no effect. Therefore, with respect to these communications, Offices may indicate the goods and services which, as a result of the communication, are protected or, alternatively, those which are not protected.
48. Allowing for the sending of the information in a positive or negative manner does result in inconsistent recordings in the International Register. Furthermore, under certain conditions, holders of international registrations and other users of the data maintained in the International Register might find it very difficult to determine the actual scope of protection afforded to the mark in a particular Contracting Party. The clarity and accuracy of the International Register could be directly compromised, thus affecting the principle of legal certainty, inherent to the International Register.
49. It will be recalled that former Rules 17(5)(a)(iii) and 17(5)(b), as in force on April 1, 2007, successfully introduced the sending of statements dealing with the status of protection of the mark in a positive manner, providing that said statements indicate the goods and services for which the mark is protected in the Contracting Party concerned.
50. Provisions in a similar fashion were maintained with the introduction of new Rules 18*ter*(2)(ii) and 18*ter*(4), as in force on September 1, 2009, dealing correspondingly with statements of partial grant of protection, following a provisional refusal, and further decisions. Concerning both of these statements, Offices are required to indicate the goods and services for which the mark has been afforded protection.

b. Proposed Changes

51. The International Bureau considers that the sending of information in a positive manner could be extended to all statements dealing with the scope of protection of the mark. In consequence, it is proposed that the provisions dealing with notifications of provisional refusals (Rule 17(2)(vi)), notifications of invalidation (Rule 19(1)(v)), declarations that the recording of a given license has no effect (Rule 20*bis*(5)(b)(ii)), notifications relating to the ceasing of effect of the basic mark (Rule 22(1)(a)(iv)) and declarations that a limitation has no effect (Rule 27(5)(b)(ii)), are amended to provide for the sending of the statements indicating, accordingly, the goods and services for which protection has not been affected or those which are not affected by the declaration or decision in question.

¹ Please see document GT/PM/VI/3 “Comments on Some of the Rules of the Draft Regulations Under the Madrid Agreement and Protocol”, pp. 16 and 18.

52. With respect to Rule 17(2)(vi), the phrase “*are affected, or*” would have to be deleted, providing for the sending of the notification with the indication of the goods and services which are not affected by the notification of provisional refusal. Rule 17(2)(vi) would then read as follows:

(vi) either that the grounds on which the provisional refusal is based affect all the goods and services or an indication of the goods and services which are not affected by the provisional refusal, [...].

53. Accordingly, concerning Rule 19(1)(v), the phrase “*those in respect of which the invalidation has been pronounced or*” would have to be deleted to allow for the sending of a notification of invalidation indicating those goods and services for which the invalidation has not been pronounced. Rule 19(1)(v) would then read as follows:

(v) if the invalidation does not concern all the goods and services, those in respect of which the invalidation has not been pronounced, and [...].

54. Furthermore, with regard to Rule 20bis(5)(b)(ii), the deletion of the phrase “*those which are affected by the declaration or*”, would provide for the making of the declaration that a recording of a given license has no effect in a positive manner. Rule 20bis(5)(b)(ii) would then read as follows:

(ii) where the declaration does not affect all the goods and services to which the license relates, those which are not affected by the declaration, [...].

55. As regards Rule 22(1)(a)(iv), deleting the phrase “*those goods and services which are affected by the facts and decisions or,*” would permit the sending of notifications relating to the ceasing of effect of the basic mark with the indication of those goods and services not affected by the aforesaid facts and decisions. Rule 22(1)(a)(iv) would then read as follows:

(iv) where the said facts and decisions affect the international registration only with respect to some of the goods and services, those which are not affected by the facts and decisions.

56. Finally, in terms of declarations that a limitation has no effect, amending Rule 27(5)(b)(ii) by deleting the phrase “*those which are affected by the declaration or*”, would provide for the making of the said declaration, indicating in a positive manner those goods and services which are not affected by it. Rule 27(5)(b)(ii) would then read as follows:

(ii) where the declaration does not affect all the goods and services to which the limitation relates, those which are not affected by the declaration, [...].

57. The standardized forms for the use of the Offices of the Contracting Parties will be modified to be aligned with the proposed amendments to the Rules mentioned above.

c. **Expected Results**

58. With the adoption of the proposed changes, the information in the International Register would clearly state the scope of protection for an international registration in a designated Contracting Party.

59. As it was concluded during the eighth session of the Working Group, efforts should be made to achieve a Madrid system that is, *inter alia*, simple and reliable. These two principles rest upon the clarity and accuracy of the information that the International Bureau records and maintains in the International Register, which, in turn, rely on the consistency of the information provided to the latter.
60. The International Bureau shall faithfully record and maintain the information submitted by the users of the International Register, namely right-holders and Offices of the Contracting Parties, without any interpretation of the received information.
61. In order to meet the test of simplicity and reliability of the information contained in the International Register, the Madrid system needs to ensure that the information is communicated to the International Bureau in an unambiguous, straightforward and consistent manner. Significant progress has been achieved with the release of model forms, which have been made available to the Offices of the Contracting Parties of the Madrid system for their communications with the International Bureau, in addition to the official forms available to the applicants, right-holders and their representatives.
62. Nevertheless, further efforts could be made with respect to the information concerning the status of protection of the mark in the Contracting Parties designated in an international registration. Effecting recordings in a positive manner would ensure that the information in the International Register is maintained in a consistent, clear and precise manner, with increased legal certainty for holders of international registrations and other users of this information.

V. EFFICIENT PUBLICATION OF THE GAZETTE

a. Current Situation

63. 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 Madrid Protocol and information regarding the working days of the International Bureau.
64. 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.
65. 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.

66. 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.
67. 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.

b. Proposed Changes

68. It is apparent that the introduction of the Gazette in electronic form, facilitated by emerging publication technology, has made Rule 32(3) outdated.
69. 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.

c. Expected Results

70. A more flexible legal framework is required to accommodate improvements concerning the publication of the Gazette. Furthermore, 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 referred to in Rule 1(1)(ix) shall be published on the website of the Organization.*"

71. *The Working Group is invited to:*
- (i) *consider the proposals made in this document for the possible simplification of the Madrid system;*
- (ii) *indicate any further course of action, including whether it would recommend to the Madrid Union Assembly some or all of the proposed amendments to Rules 6, 17, 19, 20bis, 22, 27, 32 and 40 of the Common Regulations, as presented in the Annex to this document or in amended form.*

[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 6 Languages

[...]

(3) [*Recording and Publication*] (a) Subject to paragraphs 4(c) to (g), the recording in the International Register and the publication in the Gazette of the international registration and of any data to be both recorded and published under these Regulations in respect of the international registration shall be in English, French and Spanish. The recording and publication of the international registration shall indicate the language in which the international application was received by the International Bureau.

[...]

(4) [*Translation*] (a) [...]

[...]

(c) The recording in the International Register and the publication in the Gazette of statements of grant of protection, following a provisional refusal, made under Rule 18ter(2)(ii) shall be in the language in which the relevant statement was received by the International Bureau. Where the language of recording and publication of the statement under Rule 18ter(2)(ii) is not that in which the relevant international application was received by the International Bureau, such recording and publication shall also be in the language in which the relevant international application was received by the International Bureau. Other translations concerning such statements will, upon request, be made and provided by the International Bureau.

(d) The recording in the International Register and the publication in the Gazette of the list of goods and services affected by a limitation in an international registration recorded under Rule 14 shall be in the language in which the relevant international application was received by the International Bureau and in the language notified under paragraph (2)(iii) to the International Bureau by the concerned designated Office;

(e) The recording in the International Register and the publication in the Gazette of the part of the goods and services listed in an international registration concerned by a subsequent designation recorded under Rule 24(8) shall be in the language of the subsequent designation and in the language notified under paragraph (2)(iii) to the International Bureau by the concerned designated Office;

(f) The recording in the International Register and the publication in the Gazette of the list of goods and services affected by a limitation recorded under Rule 27(1), shall be in the language of the limitation, and in the language notified under paragraph (2)(iii) to the International Bureau by the concerned designated Office.

(g) Where the language of recording and publication of the list of goods and services under (e) or (f), is not that in which the relevant international application was received by the International Bureau, such recording and publication shall also be in this language.

Rule 17
Provisional Refusal

[...]

(2) [*Content of the Notification*] A notification of provisional refusal shall contain or indicate

[...]

(vi) either that the grounds on which the provisional refusal is based affect all the goods and services or an indication of the goods and services which ~~are affected, or~~ are not affected, by the provisional refusal,

[...]

Rule 19
Invalidations in Designated Contracting Parties

(1) [*Contents of the Notification of Invalidation*] Where the effects of an international registration are invalidated in a designated Contracting Party under Article 5(6) of the Agreement or Article 5(6) of the Protocol and the invalidation is no longer subject to appeal, the Office of the Contracting Party whose competent authority has pronounced the invalidation shall notify the International Bureau accordingly. The notification shall contain or indicate

[...]

(v) if the invalidation does not concern all the goods and services, ~~those in respect of which the invalidation has been pronounced or~~ those in respect of which the invalidation has not been pronounced, and

[...]

Rule 20bis
Licenses

[...]

(5) [*Declaration That the Recording of a Given License Has No Effect*] (a) [...]

(b) The declaration referred to in subparagraph (a) shall indicate

[...]

(ii) where the declaration does not affect all the goods and services to which the license relates, ~~those which are affected by the declaration or~~ those which are not affected by the declaration,

[...]

*Rule 22
Ceasing of Effect of the Basic Application,
of the Registration Resulting Therefrom,
or of the Basic Registration*

(1) [Notification Relating to Ceasing of Effect of the Basic Application, of the Registration Resulting Therefrom, or of the Basic Registration] (a) Where Article 6(3) and (4) of the Agreement or Article 6(3) and (4) of the Protocol, or both, apply, the Office of origin shall notify the International Bureau accordingly and shall indicate

[...]

(iv) where the said facts and decisions affect the international registration only with respect to some of the goods and services, ~~those goods and services which are affected by the facts and decisions or~~ those which are not affected by the facts and decisions.

*Rule 27
Recording and Notification of a Change or of a Cancellation;
Merger of International Registrations; Declaration That a Change in Ownership or a Limitation
Has No Effect*

[...]

(5) [Declaration That a Limitation Has No Effect] (a) [...]

(b) The declaration referred to in subparagraph (a) shall indicate

[...]

(ii) where the declaration does not affect all the goods and services to which the limitation relates, ~~those which are affected by the declaration or~~ those which are not affected by the declaration,

[...]

*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.~~

*Rule 40
Entry into Force; Transitional Provisions*

[...]

(4) *[Transitional Provisions Concerning Languages]* (a) [Subject to paragraph \(c\),](#) Rule 6 as in force before April 1, 2004, shall continue to apply to any international application filed before that date and to any international application governed exclusively by the Agreement filed between that date and August 31, 2008, inclusively, to any communication relating thereto and to any communication, recording in the International Register or publication in the Gazette relating to the international registration resulting therefrom, unless

[...]

[\(c\) Rule 6\(4\)\(c\) to \(g\) as in force from \[...\], shall be applicable to any statement of grant of protection under Rule 18ter\(2\)\(ii\), any limitation in an international registration recording under Rule 14, the part of the goods and services listed in any international registration concerned by a subsequent designation recorded under Rule 24\(8\), or the list of goods and services affected by any limitation recorded under Rule 27\(1\), pending translation on \[...\].](#)

[...]

[End of Annex and of document]