

Madrid Working Group Roundtable

17 June 2016

Proposed solution for the script issue

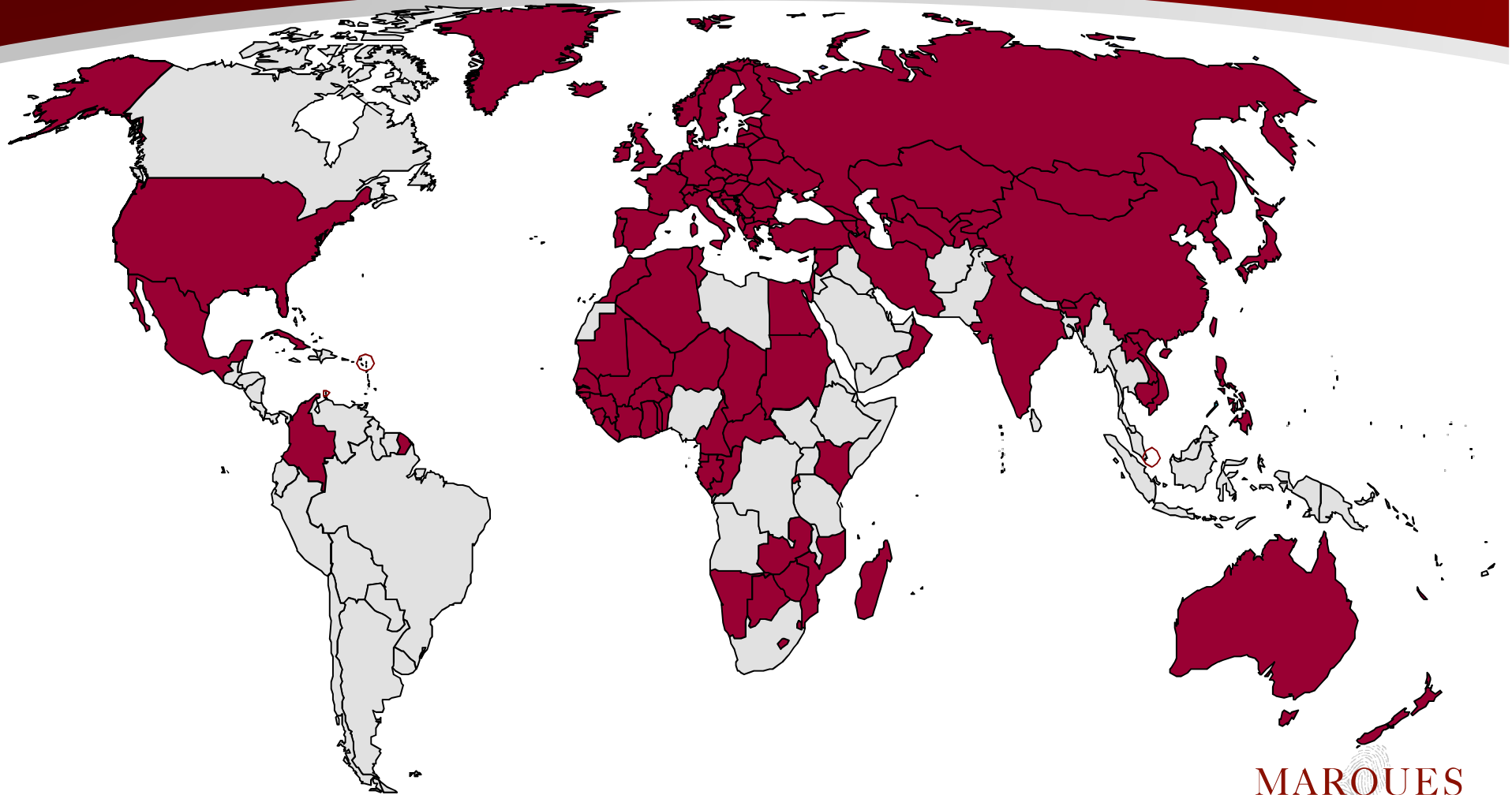
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Background

- The Madrid System is built on the basis of the Latin script
- Brand owners coming from Contracting Parties using non-Latin scripts, are obliged to file a new mark in Latin script for the purpose of using the Madrid System
- This “new” mark filed in the Office of origin will be considered as the “basic mark” for an international application
- Added vulnerability: Non-use cancellation actions (“central attack”)

Members of the Madrid System



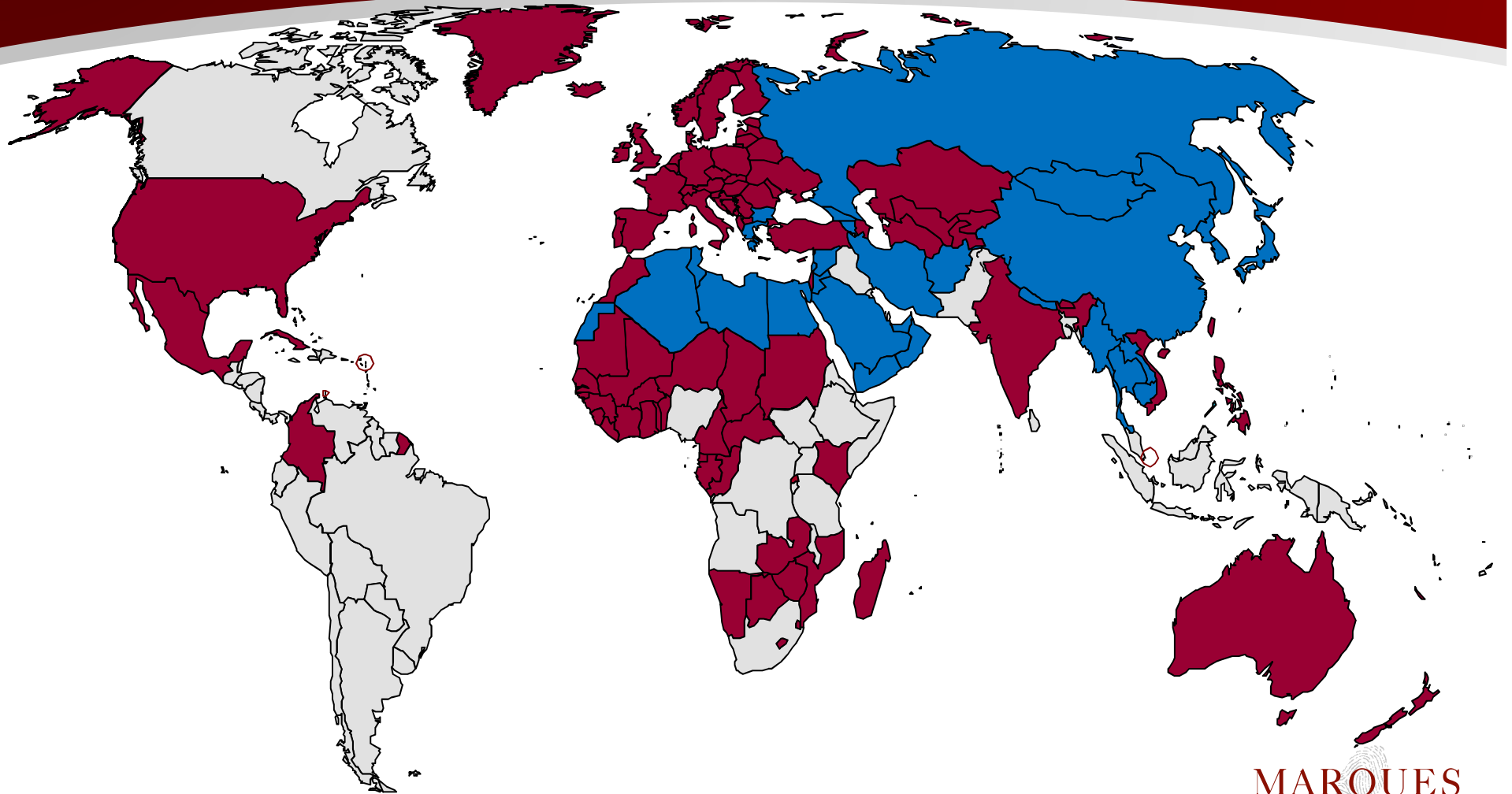
97 members* (including EU and OAPI) covering 113 countries

MARQUES

Members of the Madrid System

- 28 CPs having non-Latin script as official language
- A number of potential future members will also have non-Latin script as official language
- A legitimate need to add flexibility resulting from the increasing expansion of global trade
- Reduce obstacles to expansion of the System
- Increase use of the Madrid System

Non Latin Script



97 members* (including EU and OAPI) covering 113 countries

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Proposal

MARQUES proposes a solution that means that users in this position can file an "equivalent" translation or transliteration during the International Registration process, and then use this equivalent trademark for some or all of the designations, as follows

Proposal

- At filing of IR: Other script versions of the trademark
 - Either in the form of a translation or a transliteration
- Only one version per script
- Only one script version per designation
- A certification by a certified translator
 - Certify translation or appropriate transliteration
 - No examination by office of origin
 - In the procedural language of IR
 - No requirement for legalisation

Proposal

- WIPO will forward the basic mark as well as the relevant script version together with the certification to the designated office
- The designated office will examine only the script version of the trademark that is indicated for the designation

Proposal

- Publication on ROMARIN of all versions of the mark and the certification(s), indicating clearly what script version is relevant for each designation
- If a third party wishes to challenge a translation or transliteration, this must be done individually through the designated office concerned and will only concern that designation

Proposal

- When filing the basic mark, the applicant should be allowed to, for the sole purpose of claiming priority at later filing of an International Registration, include other script versions of the trademark

Other solutions

- Removal of the requirement for a basic mark
- Reduction of the dependency period
- However, this does not remove the unfairness of having to file a basic mark in a script that will never be used in basic country



Thank you!

International Trademark Team

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