

Working Group on the Legal Development of the Hague System for the International Registration of Industrial Designs

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LANGUAGE REGIME UNDER THE HAGUE SYSTEM

Document prepared by the International Bureau

I. INTRODUCTION

1. During the preparation for the present session of the Working Group on the Legal Development of the Hague System for the International Registration of Industrial Designs (hereinafter referred to as the “Working Group”), the International Bureau received a proposal to include Russian as an official language of the Hague System¹.
2. The International Bureau also received from the Commissioner of the State Intellectual Property Office of the People’s Republic of China (SIPO) a request to consider a possible inclusion of Chinese as a working language of the Hague System.
3. It is recalled that the Delegation of China called for the inclusion of Chinese as a working language at the past sessions of the Working Group to assist the users of the Hague System². The above request was made in anticipation of China’s accession to the 1999 Act.
4. The present document offers background information concerning the current language regime of three of the global intellectual property (IP) protection systems administered by the World Intellectual Property Organization (WIPO), namely, the Hague, Madrid and Patent Cooperation Treaty (PCT) Systems, as well as some general considerations concerning the resources required for operating a multi-language regime and the potential benefits users can derive from such regime.

¹ Refer to document H/LD/WG/7/5 “Proposal by the Delegation of the Russian Federation”.

² Refer to documents H/LD/WG/3/8 “Report”, paragraph 15, H/LD/WG/4/7 “Report”, paragraph 16, and H/LD/WG/6/7 Prov. “Draft Report”, paragraph 100.

II. THE GLOBAL SYSTEMS AND THEIR RESPECTIVE LANGUAGE REGIMES

TRILINGUAL REGIME UNDER THE HAGUE SYSTEM

5. International applications and registrations under the Hague System are governed by the language regime established by Rule 6 of the Common Regulations under the 1999 Act and the 1960 Act of the Hague Agreement (hereinafter referred to as the “Common Regulations”).
6. Rule 6, as adopted at the Diplomatic Conference for the Adoption of a New Act of the Hague Agreement Concerning the International Deposit of Industrial Designs held from June 16 to July 6, 1999, provided English and French as the languages for international application, recording, publication and communications.
7. Rule 6 was amended by the Hague Union Assembly, at its twenty-eighth (17th ordinary) session held in 2009, to introduce Spanish³ on an equal footing with English and French. The amended rule came into force on April 1, 2010.
8. Rule 6(1) provides that the international application shall be in English, French or Spanish. Accordingly, the international application form (DM/1) and the E-Filing interface on the WIPO’s website are available in all these languages. An international application may be filed, at the option of the applicant, either directly with the International Bureau or indirectly through the Office of the applicant’s Contracting Party (Article 4(1)(a) of the 1999 Act)⁴.
9. In the case of such an indirect filing, the Office may limit the language of international applications which it handles to one or two of the three languages. However, applicants are always given the possibility to file their international applications directly with the International Bureau. In 2017, 95 per cent of international applications were filed directly with the International Bureau.
10. Rule 6(2) provides that the recording in the International Register and the publication in the *International Designs Bulletin* (hereinafter referred to as the “Bulletin”) of an international registration shall be in English, French and Spanish. Translations required for the recordings and publications shall be made by the International Bureau (Rule 6(4))⁵. The filing language shall be indicated in the recording and publication (Rule 6(2)).
11. Any communication to the International Bureau by the applicant or holder, or by an Office concerning an international application or registration shall be in English, French or Spanish, at the option of the applicant or holder, or an Office (Rule 6(3)(i)). On the other hand, the International Bureau shall communicate to the applicant or holder, or an Office, in English, French or Spanish at the option of the applicant or holder, or an Office (Rule 6(3)(ii) and (iii)).
12. Neither the term “working language” nor “official language” is used in Rule 6. However, as far as the International Bureau is concerned, all services, not only for international procedures (*i.e.*, application, publication and communication) but also customer support and outreach (all information materials⁶, answering to queries orally or in writing), are currently supported in the three languages.

³ Refer to documents H/A/28/1, Chapter III, H/A/28/4, paragraphs 15 and 17, and H/A/26/2 “Study on the Implications of the Possible Inclusion of Spanish in the Language Regime of the Hague System”.

⁴ Any Contracting Party may prohibit such an indirect filing, pursuant to Article 4(1)(b) of the 1999 Act. At the date of this document, those Contracting Parties are the African Intellectual Property Organization (OAPI), Croatia, the European Union, France, Latvia, Monaco, Montenegro, Slovenia, The former Yugoslav Republic of Macedonia, Ukraine, and the United Kingdom.

⁵ The applicant may annex to the international application a proposed translation of any text matter contained in the international application, but the International Bureau has the responsibility for the translation (Rule 6(4)).

⁶ For instance, the “Hague Guide for Users” (<http://www.wipo.int/hague/en/guide/>) and Hague Information Notices (<http://www.wipo.int/hague/en/notices/>) are available in the three languages.

Workload: Statistics and Translation

13. On a daily basis, translation transactions concern certain text matters in the international application. These are the indication of the product which constitutes the industrial design or in relation to which the industrial design is to be used (Rule 7(3)(iv)), a description of the characteristic features of the industrial design (Rules 7(4)(b) and (5)(a) and 11(2)), and a brief description of the reproduction (so-called “legend”) (Rules 7(4)(b) and (5)(a) and Section 405(c) of the Administrative Instructions for the Application of the Hague Agreement).

14. In 2017, the International Bureau received 5,213 international applications, of which 86.8 per cent were filed in English, 12.4 per cent in French and 0.8 per cent in Spanish. On the other hand, more than 99 per cent of decisions received from Offices were in English.

15. During the same period, the International Bureau translated 432,059 words, of which 40 per cent were translated using automated translation tools. The remaining words were translated by human translation resources. The percentage of words that were translated through automated tools is the result of an on-going process that has happened over time⁷. Therefore, it cannot be expected that a similar automated translation rate into additional languages could be immediately achieved as the development of automated translation tools takes considerable time.

16. Since, as stated above, the majority of communications are received and processed in English, only five per cent of the translation workload was into English, while 45 per cent was into French and 50 per cent into Spanish⁸.

LANGUAGE REGIME UNDER THE MADRID SYSTEM

17. The language regime of the Madrid System is similar to that of the Hague System, featuring the same three languages, *i.e.*, English French and Spanish. The language regime is established by 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 “Madrid Regulations”).

18. At the time of writing this document, with 101 Contracting Parties to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, the International Bureau received 56,200 international applications in 2017.

19. Rule 6(1) of the Madrid Regulations provides that the international applications shall be in English, French or Spanish according to what is prescribed by the Office of origin.

20. Since the international application must always be presented through the Office of origin, the applicants’ options in terms of filing languages are naturally reduced to the Office’s own choice of the prescribed languages (usually a single language).

⁷ Reliance on such an automatic retrieval is subject to the amount of terms stored. In 2017, the automatic retrieval (matching) ratios for each transaction were the following: English to French (43 per cent), English to Spanish (39 per cent), French to English (29 per cent), French to Spanish (33 per cent), Spanish to English (20 per cent), and Spanish to French (25 per cent).

⁸ As the translation of an international application currently takes place into two languages, each of those accounts for half of the translation workload. Furthermore, the correlation with the distribution of languages mentioned in paragraph 14 is not a strict one as these workload ratios reflect the number of words actually translated, and these may vary from one given international application to another.

21. As under the Hague System, the contents of an international registration, including the list of goods and services, are translated into the other two languages by the International Bureau. Thus, the recording and publication of the international registration are in those three languages. An applicant/holder and an Office may communicate with the International Bureau in any of the three languages.

22. Neither the term “working language” nor “official language” is used in the aforementioned rule. As under the Hague System however, all services (including all information materials⁹, answering queries orally or in writing) are currently supported by the International Bureau in the three languages.

23. Finally, the International Bureau has received proposals to include three additional languages in the Madrid System, namely, Chinese, Indonesian and Russian, for discussion at the upcoming sixteenth session of the Working Group on the Legal Development of the Madrid System for the International Registration of Marks, which will take place from July 2 to 6, 2018¹⁰.

LANGUAGE REGIME UNDER THE PCT SYSTEM

24. The PCT System is the largest of WIPO’s global systems with 152 Contracting Parties and over 243,000 international applications (in 2017).

25. The PCT itself does not provide for specific languages for its implementation. The treaty is flexible enough to provide different languages for application, publication and communication, which is the case at present (PCT Articles 3(4)(i) and 21(4)).

26. Rule 48.3 of the Regulations under the Patent Cooperation Treaty provides for 10 publication languages, namely, Arabic, Chinese, English, French, German, Japanese, Korean, Portuguese, Russian and Spanish. However, no documents are translated into all publication languages.

27. The international application shall contain a *request*, a *description*, one or more *claims*, one or more *drawings* (where required), and an *abstract* (PCT Article 3(2)).

28. An international application may be filed in any language accepted by the receiving Office¹¹. If the international application is filed with the receiving Office in a language that is not among those 10 publication languages listed above, the applicant must provide a translation of the application into one of those publication languages¹².

29. For the filing of an international application directly with the International Bureau, as a receiving Office, any language is accepted as long as the application contains a request in a publication language (PCT Rule 12.1). Furthermore, if the international application (*i.e.* its components other than a *request*) was filed in a language other than one of the 10 publication

⁹ For instance, the “Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol” (<http://www.wipo.int/madrid/en/guide/>), Madrid Information Notices (<http://www.wipo.int/madrid/en/notices/>), and Madrid Highlights (http://www.wipo.int/newsletters-archive/en/madrid_highlights.html) are available in the three languages.

¹⁰ Refer to documents MM/LD/WG/16/7, MM/LD/WG/16/8 and MM/LD/WG/16/9.

¹¹ Under the PCT System, different authorities exist, such as a receiving Office, designated Office, the International Searching Authority, the Authority specified for supplementary search, and the International Preliminary Examination Authority, as well as the International Bureau. The same Office may perform some of these functions in their respective contexts.

¹² The applicant may also need to provide a translation, if required by the competent International Searching Authority (ISA), to allow an international search to be carried out in a language accepted by the ISA.

languages, the applicant must furnish to the International Bureau its translation into one of the publication languages, within certain time limits. Moreover, ePCT, the electronic filing interface provided by the International Bureau for international applications, is available in the 10 publication languages.

30. The international application is published in one of the 10 publication languages. If the filing language is one of the publication languages, the application will be published in that language (PCT Rule 48.3(a))¹³.

31. If the international application is published in a language other than English, the title of the invention, the abstract, and any text matter pertaining to the figure(s) accompanying the abstract shall be both in that language and in English. This translation is prepared under the responsibility of the International Bureau (PCT Rule 48.3(c)).

32. The International Bureau also publishes the “*PCT Gazette*” (PCT Article 55(4)) in both English and French (PCT Rule 86.2(a))¹⁴, containing certain information on each published international application¹⁵. Consequently, the International Bureau is responsible for providing both English and French translations of those elements (if the original text or applicant’s translation was in a different publication language) at the time of international publication¹⁶.

33. Most communications with the International Bureau are currently expected to be in English or French (PCT Rule 92.2(d) and (e)), though this is gradually being opened up to a wider range of languages as systems and staff permit.

34. Moreover, as far as the International Bureau is concerned, services and information materials relating to the PCT System are not necessarily available in all of the 10 publication languages, and to an equal extent¹⁷.

ADDING LANGUAGES UNDER THE HAGUE SYSTEM AND POSSIBLE IMPLICATIONS

35. From a legal point of view, adding languages to the Hague System would require amending Rule 6 of the Common Regulations. While this would only entail a decision by the Hague Union Assembly, without the need to amend the 1999 and 1960 Acts, such a change would have significant implications.

¹³ If the filing language is not one of the publication languages, the applicant will provide its translation (PCT Rule 48.3(b)).

¹⁴ The international publication, in the context of PCT Article 21, takes place, every week, electronically on the PATENTSCOPE Portal. Moreover, the publication of the *PCT Gazette*, in the context of PCT Rule 86 and Administrative Instructions Section 407(b), also takes place in the same manner, *i.e.* on the PATENTSCOPE Portal.

¹⁵ Refer to PCT Rule 86.1 for contents of the Gazette.

¹⁶ The International Bureau is also responsible for translating the international search report (ISR) into English, if it is not established in that language (PCT Rule 45.1) or into the filing language when the ISA has established the ISR on the basis of an English translation provided by the applicant. The International Bureau is also responsible for translating the international preliminary report on patentability into English, if not in that language (PCT Rules 44*bis*.3 and 72.1).

¹⁷ For instance, at the time of writing this document, the following information materials are available in the languages provided:

- text of the PCT Administrative Instructions: English, French and Spanish,
- PCT Applicant’s Guide (updated almost every week): English, French, Spanish, Russian and Japanese,
- Official Notices Collection (PCT Gazette): English and French,
- PCT Newsletter: English, and excerpts in Chinese, Japanese and Korean, and
- ePCT User Guides and Training Material: Japanese and Korean.

36. An in-depth study would be necessary to fully analyze all possible implications of adding languages to the Hague System. The study would have to elaborate on the practical, operational, staffing, Information Technology (IT) related and overall financial impact of the aforementioned decision.

POSSIBLE MODELS FOR THE INTRODUCTION OF NEW LANGUAGES

37. The study could identify various possible models for the introduction of new languages into the Hague System, describing their implications. *A priori*, those models could range from partial to full introduction of additional languages.

38. The partial introduction of new languages could involve, for example, the introduction of several languages for the purposes of filing an international application while maintaining the current trilingual regime for the purposes of registration, recording, communication and publication. In particular, an international application filed in one of the newly introduced filing languages would be translated into the current three languages, but not the other way around.

39. Another possible model could be adding new languages on an equal footing with the current three languages provided for in Rule 6 of the Common Regulations. However, the consequential volume of translations under this approach would be by far the highest of all possible models and would increase exponentially with every new language added.

40. To reduce the volume of translations, an alternative model could be translating the international registration into a new language only if it designates a Contracting Party whose Office is operating in that language.

41. Moreover, additional languages could also affect users, who would receive decisions from the Offices of the designated Contracting Parties, including notifications of refusal, in any one of the newly introduced languages. In this regard, it is recalled that 99 per cent of notifications of refusal received in 2017 were actually in English.

OPERATIONAL IMPLICATIONS

42. A significant impact on the operations of the Hague System has to be expected as a result of a decision to add one or more languages to the current language regime of the Hague System, regardless of the model chosen for their introduction. Following such a decision and depending on the model selected, communications, registration, recordings and publication would need to be conducted in all languages.

43. Additional languages would, at the very least, mean that international applications could be filed in any of these languages; these applications would need to be examined by the International Bureau in the language in which they were filed and, depending on the model selected, translated into some or all other languages for registration and publication.

44. WIPO officials conducting examination and providing customer support would need to be able to work in all languages, regardless of the model selected, which would have a direct impact on staffing levels and required staff profiles.

45. Additional translation resources would become necessary, which, to some extent and over time, could be absorbed by the use of enhanced automated translation tools. Nevertheless, adding one or more languages to the current language regime would substantially increase the volume of translation work. Moreover, added translation work could negatively affect transactional processing times.

IT RELATED IMPLICATIONS

46. Introducing new languages into the Hague System would result in a number of important IT related implications. For example, all externally and internally facing IT tools under the Hague System currently operate in all three languages. Those IT tools would need to be enhanced and maintained to provide for the recording, publication, notification and dissemination of information in all concerned languages, including those using non-Latin scripts¹⁸.

FINANCIAL IMPLICATIONS

47. It is realistic to expect that the work that needs to be put in place to accommodate one or more additional languages alongside the current languages will have financial implications.

48. These financial implications would concern, in particular, the costs associated to IT development, further translation resources and, possibly, more staff capable to work in the new language or languages. In the short term, these costs would not necessarily be offset by increased income. By way of reference, experience with the most recently added language in the Hague System, Spanish, shows that currently, while 50 per cent of the translation costs are accrued to Spanish, only 0.8 per cent of all international applications are filed in this language (in 2017).

49. While it is a reality that adding new languages to the Hague System will come at a cost, it should not be overlooked that, due to their inherent international character, the WIPO global IP protection systems are conducive to multilingual regimes, as is demonstrated, for example, by the PCT System.

50. In this context, reference can be equally made to the general WIPO language policy concerning documentation for meetings of the WIPO Main Bodies, Committees and Working Groups, as well as for core and new publications, extending the language coverage to the six official languages of the United Nations. Most notable, WIPO Member States recommended in that respect to introduce the six-language coverage in a phased and cost effective manner under rationalization and control measures¹⁹.

51. Increasing the number of languages used in a global IP system may lead to improved customer experience and satisfaction, as well as greater use of that system.

52. Adding one or more languages to the Hague System should be considered in a holistic manner, defining the main objectives to be achieved by extending the language regime while, at the same time, taking full advantage of the latest trends in translation technology. Furthermore, such a move should take inspiration from the general WIPO language policy (in particular in terms of a phased approach and cost effectiveness requirements) and look at lessons learned from similar exercises under the PCT System. Finally, the needs and prerogatives of all users of the system must be kept in mind, especially their expectation that the international design registration system needs to be efficient, reactive and continue delivering high-quality services.

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¹⁸ For processing international applications and other transactions, the International Bureau is currently developing a new core IT system for The Hague Registry. The new system is multilingual including non-Latin characters. According to the current project plan, the new Hague IT system is foreseen to be operational from the end of 2018.

¹⁹ Refer to documents WO/PBC/21/21, WO/PBC/21/22 and A/51/14.