

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

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REVIEW OF THE PROPOSAL ON TRANSLATIONS REQUESTED BY THE MADRID UNION ASSEMBLY

Document prepared by the International Bureau

I. INTRODUCTION

1. It is recalled that at the ninth 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 recommended that the Madrid Union Assembly take note of practices concerning the translation of the list of goods and services in statements of grant of protection, following a provisional refusal, made under Rule 18~~ter~~(2)(ii) of 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”, “the Agreement” and “the Protocol”), and those affected by a limitation in an international application, a subsequent designation or a request for the recording of a limitation, as described in document MM/LD/WG/9/4¹.

2. The Madrid Union Assembly, while taking note of the aforementioned practices, as described in document MM/A/44/1, referred the issue to the next session of the Working Group for further review².

3. The purpose of the present document is to provide a conceptual framework on the scope of the trilingual regime under the Madrid system, to present background information on the overall translation tasks undertaken by the International Bureau under the Madrid system,

¹ See document MM/LD/WG/9/6, paragraphs 39 to 48.

² See document MM/A/44/5.

to focus on the tasks related to the translation practices under review, and to reintroduce a financially sustainable proposal, resulting from a more rational allocation of resources, which is attuned to the language regime of the Madrid system.

II. THE TRILINGUAL REGIME UNDER THE MADRID SYSTEM

4. It is recalled that the rules governing the languages which may or must be used for the filing of international applications and all subsequent operations under the Agreement and the Protocol (hereinafter referred to as “the language regime”), are laid down in the Common Regulations implementing the treaties.

5. It is also recalled that, at its thirty-fifth session (September-October 2003), the Madrid Union Assembly amended Rule 6 of the Common Regulations, with effect from April 1, 2004, in order to introduce Spanish as a third language of the Madrid system, initially for new international applications governed at least in part by the Protocol, and for the international registrations resulting therefrom. The Assembly further amended Rule 6 at its thirty-eighth session (September-October 2007), establishing one single (trilingual) language regime for all international applications and all international registrations.

6. A trilingual regime, as the one envisaged by Rule 6, means:

(a) that the Madrid system features three languages of international applications and registrations, for the procedural purposes of filing, recording, publication, communication and notification; and

(b) that the three languages enjoy equal legal treatment.

7. The trilingual regime aims at attaining three main goals:

(a) simplification of the system for Offices of Contracting Parties, as it offers them additional possibilities for the choice of languages of filing and also of communication with (to and from) the International Bureau in respect of international registrations;

(b) increased user-friendliness of the system, as international applications may be in one or more of the three languages, according to the Office of origin’s choice as well as information related to international registrations is available in the three languages; and

(c) increased access to enhanced information on the nature and scope of registered marks, and the extent of the rights granted to holders of international marks, for the benefit of Offices of Contracting Parties and other authorities, as well as the public at large, including third parties, that have access to entries in the International Register in three languages. This enables users, stakeholders and competitors (third parties) to better manage their intellectual property portfolios.

8. It is understood that Rule 6 does not endorse a maximalist approach, meaning a possible interpretation of the trilingual regime to encompass that every single operation under the Madrid system would or could be performed by Contracting Parties, holders or the International Bureau in the three languages or in any of them. However, Rule 6 endorses a mixed approach, in the following respect³:

³ Rules 7(2) and 17(2)(v) and (3) of the Common Regulations envisage specific cases for declarations of intentions to use the mark and lists of goods and services concerning notifications of provisional refusals, which are of no relevance for the purposes of this document.

(a) international applications shall be in English, French or Spanish, according to what is prescribed by the Office of origin, which may choose to allow applicants to file in any of the three languages, or to limit the options of the applicants to two or to only one of them (Rule 6(1)). In fact, the Offices of four Contracting Parties allow filings in any of the three languages, 34 Offices envisage filings in two of the three languages foreseen in Rule 6, and 47 Offices allow filings in only one language;

(b) communications concerning international applications or registrations shall be:

(i) in English, French or Spanish, where such communications are addressed to the International Bureau by the applicant or holder, or by an Office (Rule 6(2)(i)). The principle of full trilingual regime applies here, since stakeholders of the system may choose to address the International Bureau in any of the three languages contemplated in Rule 6;

(ii) in the language of the international application where a communication is a notification addressed by the International Bureau to an Office, unless that Office has notified the International Bureau that all such notifications are to be in any of the two other languages (Rule 6(2)(iii)). Similarly, Offices may freely decide the language for these notifications;

(iii) in the language of the international application where the communication is a notification addressed by the International Bureau to the applicant or holder, unless that applicant or holder has expressed the wish that all such notifications be in any of the two other languages (Rule 6(2)(iv)). The full trilingual regime is once again applicable, as applicants or holders may freely choose the language of notification;

(c) recordings in the International Register and publications in the *WIPO Gazette of International Marks* (Gazette) of any data to be both recorded and published under the Common Regulations in respect of international registrations shall be in English, French and Spanish (Rule 6(3)). Here, too, the full trilingual regime applies, in the sense that all recordings and operations are effected in the three languages of Rule 6.

The translations needed for the above notifications under item (b)(ii) and (iii), and for recording and publication purposes under item (c), shall be made by the International Bureau (Rule 6(4)(a)). The same applies to subsequent designations (Rule 6(3)(b)).

9. The full trilingual regime as described above, in the sense that a given operation can be performed in any of the three languages of Rule 6, at the choice of Offices, applicants or holders, or that operations are to be carried out in all three languages, always applies where the given operation and, if needed, the translation, is to be performed in respect of or by the International Bureau. Where the operation concerns the relation between Offices of origin and applicants, the former are entitled to restrict the principle of the trilingual regime, by limiting the number of languages in which international applications can be filed with such Offices.

III. TRANSLATION TASKS UNDERTAKEN BY THE INTERNATIONAL BUREAU UNDER THE MADRID SYSTEM

10. In the year 2011, the International Bureau recorded 453,477 transactions, which represent a 20.5 per cent increase compared to the previous year. It is to be noted that some of these transactions, e.g., the renewal of an international registration or the creation of a statement of grant of protection in the form of an electronic list, might not require human intervention to be translated (see paragraph 12). Thus, in the same year, the International Bureau performed 123,239 translations related to the aforementioned transactions, which resulted in the translation of almost 17.09 million words. This represents an increase of 30.62 per cent in the number of words translated, compared to 2010 (see Table I).

TABLE I – TRANSLATION-RELATED ACTIVITIES (2010 – 2011)

	Transactions Registered by the International Bureau	Number of Translations	Number of Words Translated
2010	376,400	117,245	13,079,848
2011	453,477	123,239	17,085,746

11. Over 81 per cent of the words translated by the International Bureau in 2011 correspond to the translation of the indications of goods and services in international registrations. In addition, the International Bureau performed translations concerning 13 other types of transactions affecting international registrations (see Table II). 91.7 per cent of those translated words correspond to transactions initiated by the holder of an international registration. Furthermore, 2.7 per cent correspond to notifications of a provisional refusal, 4.5 per cent correspond to notifications of a ceasing of effect, and only 1.2 per cent correspond to other decisions taken by the Office of a designated Contracting Party.

TABLE II – TRANSLATED WORDS PER TYPE OF TRANSACTION RECORDED IN 2011

	English		French		Spanish	
	Translations	Words	Translations	Words	Translations	Words
International Registration (Rule 14)	9,926	1,994,627	31,639	5,068,431	39,526	6,788,913
Refusal (Rule 17(1))	1,021	55,809	2,772	169,474	3,829	228,774
Final and Further Decision (Rules 18 <i>ter</i> (2)(ii) and (4))	2,834	62,049	1,742	50,219	3,694	82,949
Invalidation (Rule 19)	44	616	53	1,293	53	1,519
Restriction of the Holder's Right (Rule 20)	62	4,306	156	9,606	90	5,988
License (Rule 20 <i>bis</i>)	71	3,986	120	1,411	148	2,566
Ceasing of Effect (Rule 22)	420	33,675	3,603	419,010	3,723	318,926
Subsequent Designation (Rule 24)	846	138,502	1,699	219,999	2,185	225,425
Change in Ownership (Rule 25(1)(a)(i))	15	3,269	53	7,664	37	6,461
Limitation (Rule 25(1)(a)(ii))	489	45,634	3,318	296,451	3,141	233,897
Partial Cancellation (Rule 25(1)(a)(v))	79	962	248	4,627	149	3,088
Limitation Has no Effect (Rule 27(5))	1	24	14	641	10	342
Subsequent Designation (Rule 40(4))	1,771	169,452			3,598	422,473
Replacement (Article 4 <i>bis</i>)	5	82	32	1,858	23	748
Total	17,584	2,512,993	45,449	6,250,684	60,206	8,322,069

12. In the year 2011, 40.8 per cent of the translation-related tasks were undertaken by external translators under Special Service Agreements, which represented a steep decrease compared to the previous year. On the other hand, 33.5 per cent of those tasks were performed internally by translators working at the International Bureau, resulting in a slight increase compared to 2010. Finally, 25.7 per cent of the translation-related tasks were completed without human intervention. The automated translation process was first put in place in June 2010. Since then, automated translation has steadily gained ground to what is considered to be an optimal level. Nonetheless, it is to be noted that, for quality assurance purposes, the translations performed externally, as well as those done automatically, undergo a validation process performed by an internal translator (see Tables III and IV).

TABLE III – TRANSLATED WORDS PER MEANS OF TRANSLATION (2010)

	English	%	French	%	Spanish	%	Total	%
Outsourced	1,300,330	52.6%	2,466,637	55.7%	2,952,197	47.7%	6,719,164	51.4%
Automatically	294,609	11.9%	904,448	20.4%	1,099,287	17.8%	2,298,344	17.6%
Internally	876,582	35.5%	1,053,518	23.8%	2,132,240	34.5%	4,062,340	31.1%
Total	2,471,521	100%	4,424,603	100%	6,183,724	100%	13,079,848	100%

TABLE IV – TRANSLATED WORDS PER MEANS OF TRANSLATION (2011)

	English	%	French	%	Spanish	%	Total	%
Outsourced	1,015,254	40.4%	2,914,387	46.6%	3,047,017	36.6%	6,976,658	40.8%
Automatically	566,549	22.5%	1,647,333	26.4%	2,174,667	26.1%	4,388,549	25.7%
Internally	931,190	37.1%	1,688,964	27.0%	3,100,385	37.3%	5,720,539	33.5%
Total	2,512,993	100%	6,250,684	100%	8,322,069	100%	17,085,746	100%

13. It must be noted that an advanced degree of specialization is essential where it concerns the translation of indications of goods and services contained in trademark applications. It is often the case that the terms used to indicate the items for which protection is sought are industry specific. In some cases, original terms are used to describe innovations introduced in a particular industry, which represents a unique challenge when it comes to their translation.

14. Furthermore, just to illustrate the magnitude of the translation-related work concerning the International Register, it will be recalled that the alphabetical list of the latest edition of the International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Classification) presents almost 9,000 (8,800) terms. On the other hand, the Goods & Services Manager is comprised of over 40,000 terms, including all those contained in the Nice Classification and the terms most frequently used in international applications. Meanwhile, an internal database of frequently used terms in international applications, compiled by the International Bureau for internal purposes, contains, thus far, more than 2 million terms.

15. The translation work undertaken in the framework of the Madrid system is paramount, as the terms used will define the scope of protection sought in an international registration with respect to the Contracting Parties concerned. Thus, complexity and scale considerations aside, the International Bureau strives to achieve the highest standard of quality in its translation work.

IV. STATEMENTS OF GRANT OF PROTECTION FOLLOWING A PROVISIONAL REFUSAL MADE UNDER RULE 18TER(2)(II)

16. Statements made under Rule 18ter(2) and (3) are statements which are sent to the International Bureau following the sending of a notification of a provisional refusal under Rule 17. While statements made under Rule 18ter(2)(i), which result in total protection with respect to the scope of goods and services, and statements made under Rule 18ter(3), which confirm a total provisional refusal, do not require further translation to be inscribed and notified, the statements made under Rule 18ter(2)(ii) result in a partial grant of protection and contain a list with the indications of the goods and services for which protection has been granted.

17. The sending of the statements made under Rule 18ter(2)(ii) most likely follow the proceedings resulting from the lodging of a request for review or an appeal against a provisional refusal, before the Office of the concerned designated Contracting Party, with the involvement or, at least, the awareness of the holder of the international registration in question. The translation and publication of these statements mainly serve the information needs of third parties.

18. A clear indication of the above is the fact that, as stated in paragraph 7 of document MM/LD/WG/9/4, while the practice of translation upon request of these statements was first implemented in 2005, the International Bureau has received very few requests to translate these statements. As stated in paragraph 38 of this document, in 2011, the International Bureau received just slightly over 400 requests for translation of the indications of goods and services contained in statements made under Rule 18ter(2)(ii). Nevertheless, almost all of those requests were internally motivated as they were submitted in connection with another request, such as a request for a certified extract or for renewal.

19. Since February 2011, the number of pending translations related to statements made under Rule 18ter(2)(ii) has increased by 45,349 translations (33.89 per cent), reaching now 179,143 (see Table V). At an estimated 99 words per each statement, the International Bureau would have to allocate over 4.43 million Swiss francs (at a fixed rate of 0.25 Swiss francs per translated word) to outsource the translation of an estimated 17.74 million words, which is more than the number of words the International Bureau translated in 2011 concerning the totality of operations under the Madrid system.

20. Furthermore, under a zero growth assumption, each year the International Bureau would have to assign over 1.12 million Swiss francs to outsource the translation of an estimated 4.49 million words, which would represent an increase of more than 26 per cent in the total number of words translated by the International Bureau in 2011 concerning operations under the Madrid system.

TABLE V – STATEMENTS MADE UNDER RULE 18TER(2)(II) AWAITING TRANSLATION (2011 – 2012)

Pending Translations	On February 2011	On February 2012
French to English	11,482	16,648
Spanish to English	0	0
English to French	53,105	70,611
Spanish to French	97	173
English to Spanish	55,410	72,683
French to Spanish	13,700	19,028
Total	133,794	179,143

21. There are three reasons which compel taking a nuanced approach to the translation of the list of the indications of goods and services in statements made under Rule 18ter(2)(ii) instead of indiscriminately translating all of these indications:

(a) the recording of these statements rarely serves the needs of the holders of international registrations;

(b) an indiscriminate approach would have serious financial implications for the Madrid system; and

(c) this approach would result in an unmerited burden for holders of international registrations and the Contracting Parties, in order to satisfy a minimal demand for the translation of the aforementioned statements.

22. In fact, as early as January 2005⁴, the International Bureau began publishing notifications sent under former Rule 17(4)(b) with just a mention on whether these concerned all the goods and services in the international registration. At the same time, it introduced a policy of translation of those indications upon request, further noting that, while this practice was in place, the International Bureau received very few requests for the translation of these statements.

23. In 2011, if the International Bureau had translated all the indications of goods and services contained in statements made under Rule 18ter(2)(ii), some 4.49 million words as seen in paragraph 20, the overall number of words translated by the International Bureau in the framework of the Madrid system would have increased by more than 26 per cent. Furthermore, 21.7 per cent of the translation work undertaken by the International Bureau would have been allocated to translate statements for which, as seen in paragraphs 18 and 38, there is almost no demand.

24. An indiscriminate translation of statements made under Rule 18ter(2)(ii), as set out in Rule 6, has a direct and permanent financial implication for the Madrid system which would have to be addressed by sustainable means rather than on an *ad-hoc* basis. It is appropriate to question burdening holders of international registrations and Contracting Parties with the financial implications of undertaking an operation that does not directly satisfy their needs and for which demand is almost nil (see Table VI).

TABLE VI – TOTAL NUMBER OF WORDS TRANSLATED IN 2011

	Number of Translated Words in 2011				
	Actual	%	Simulation with Rule 18ter(2)(ii)	%	Increase
International Registrations	13,851,971	81.1%	13,851,971	64.2%	
Changes	1,808,455	10.6%	1,808,455	8.4%	
Refusals	454,057	2.7%	454,057	2.1%	
Ceasing of Effect	771,611	4.5%	771,611	3.6%	
Other Decisions	199,652	1.2%	4,689,203	21.7%	2248.7%
Total	17,085,746	100%	21,575,297	100%	26.3%

⁴ See document MM/LD/WG/9/4, paragraphs 6 and 7.

25. The International Bureau is proposing a language policy that would preserve the current translation regime for all transactions initiated by the holder, while allowing for a policy of translation upon request of statements made under Rule 18ter(2)(ii). Such policy would be financially sustainable and in line with the two main objectives of the Madrid system, namely the possibility that the holder could request the extension of the protection resulting from the international registration to a Contracting Party of the system, and the possibility that such holder could centrally manage the rights acquired in each of the aforementioned Contracting Parties.

26. This policy is based on the basic principle that supply and demand should fall in lockstep, and it offers four main advantages:

- (a) it is a policy which is in step with the legal framework of the Madrid system;
- (b) it is also a policy which is fiscally responsible;
- (c) the solution acknowledges and serves the legitimate interest of anyone wishing to obtain a translated version of these statements in any of the working languages of the Madrid system; and
- (d) the policy results in services rendered more efficiently with results delivered in a faster manner.

V. LIMITATIONS MADE IN AN INTERNATIONAL APPLICATION, A SUBSEQUENT DESIGNATION OR A REQUEST FOR THE RECORDING OF A LIMITATION IN THE INTERNATIONAL REGISTRATION

27. The issue concerning the translation of the list of goods and services affected by a limitation is promptly serving the needs of the holders of international registrations while acknowledging the information needs of concerned third parties⁵.

28. Before the current practice of translations upon request was implemented, presentation of limitations was growing increasingly complex⁶. Whilst the International Bureau has significantly reduced the pendency time concerning translations, the aforementioned complexity had a direct impact on the time it takes to provide for the translations required, under Rule 6, to record, publish and notify these transactions.

29. In the year 2010, the total number of limitations requested in an international application, a subsequent designation or a request for the recording of a limitation was 7,799. In 4,450 of those requests, 57 per cent of the total, the language in which the request was filed was the same as the language of communication of the Office concerned with the limitation (see Table VII).

⁵ See document MM/LD/WG/9/4, paragraphs 25 to 35.

⁶ See document MM/LD/WG/9/4, paragraph 27.

TABLE VII – REQUESTS FOR THE RECORDING OF A LIMITATION IN 2010

	Language of the Request = Language of Office Concerned	Total Number of Requests Recorded
Limitations in an International Application	2,091	3,436
Limitations in a Subsequent Designation	751	1,592
Requests for the Recording of a Limitation	1,608	2,771
Total	4,450	7,799

30. In the year 2011, the total number of limitations requested in an international application, a subsequent designation or a request for the recording of a limitation was 9,560. In 5,554 of those requests, 58 per cent of the total, the language in which the request was filed was the same as the language of communication of the Office concerned with the limitation (see Table VIII).

TABLE VIII – REQUESTS FOR THE RECORDING OF A LIMITATION IN 2011

	Language of the Request = Language of Office Concerned	Total Number of Requests Recorded
Limitations in an International Application	2,519	3,979
Limitations in a Subsequent Designation	1,062	2,248
Requests for the Recording of a Limitation	1,973	3,333
Total	5,554	9,560

31. It is evident that a policy of translation upon request of the indications of goods and services affected by a limitation in an international application or a subsequent designation directly benefits the holders of the international registrations, where the language in which a request for a limitation is made and that of communication of the Office concerned is the same. In those cases, the transaction is promptly inscribed and notified to the Office in question.

32. Where the language of communication of the Office concerned is different to the language in which the transaction is being filed, the International Bureau will provide for a translation to the former in order to notify the said Office. Even in these cases, the holders of the international registrations in question would continue to benefit from a more expedited service, as the translation resources of the International Bureau would concentrate on the cases in which translation is actually required.

33. It must be noted that there were 982,406 translated words in 2011, representing six per cent of the total number of words translated, in connection with requests for a limitation where the language in which the request was made was the same as the language of communication of the Office concerned.

34. Furthermore, the new practice of translation upon request of limitations closely follows the policy concerning translations of statements made under Rule 18~~ter~~(2)(ii), as it also upholds the linguistic unity of the international registration, by providing for the translation of the indications in question into the language of the international application. It also takes into account the legitimate interests of third parties wishing to obtain a translation of the said indications into any of the working languages of the Madrid system, as it allows anyone to request such translations.

VI. NOTES ON THE PROPOSED AMENDMENTS TO THE COMMON REGULATIONS

35. The proposal on translations upon request contained in this document specifically affects recording and publication by the International Bureau of operations relating to statements of grant of protection, limitations and subsequent designations. It foresees that translations concerning the abovementioned operations will be made upon request and not *ex officio* and systematically by the International Bureau.

36. The proposed amended Rule 6 applies equally to operations of the International Bureau concerning statements of grant of protection, limitations and/or subsequent designations in any of the three languages. The proposed changes would not result in an undermining of the current trilingual regime of the Madrid system, but would rather provide equal legal treatment of the three official languages, as the same legal provisions on the language regime apply to all three, and the applicable provisions produce the same legal effects on documents in any of the three languages, i.e., that the recording and publication of a statement of grant of protection following a provisional refusal and of the limited list of goods and services shall be, respectively:

(a) in the official languages, irrespective of which of the three languages, of the received statement, or of the request for a limitation of the list of goods and services, irrespective of whether this request for limitation is presented in an international application (Rule 14), a subsequent designation (Rule 24) or a request for recording of limitation (Rule 27);

(b) in the language, irrespective of the fact that such language be English, French or Spanish, of the designated Office; and

(c) where applicable, in the language, irrespective of the fact that such language be English, French or Spanish, of the relevant international application.

37. As the proposed amendments apply equally to operations in the three working languages and produce the same effects in the three languages, they are in fact respecting the Madrid trilingual regime. Translations upon request of certain operations merely restrict the principle of automatic translation in the three working languages, not the trilingual regime in the Madrid system.

38. An altogether different issue is how availability of information in official languages would be affected by the application of the proposed amended Rule 6, as a consequence of the translation upon request principle. The current rate of translation requests per year concerning statements sent under Rule 18~~ter~~(2)(ii) is slightly over 400, but as seen in paragraph 18, above, these are mostly internally motivated. Assuming that few translations of documents will be systematically requested and considering the language breakdown in Table V, above, it is easy to infer the amount of information that would not be immediately available and/or translated into each language. However, this is not a consequence of proposed amended Rule 6, but of the intensity of use of the Madrid system in each of the official languages. These figures would obviously vary should changes in the number of applications, limitations and subsequent designations in one or more of the official languages occur, irrespective of the operation of the proposed amendment, thus suggesting that it is language-neutral.

39. The proposed amendment only impinges on the moment on which information in a given language or languages can be made available to interested parties, but does not prejudice or limit the language or languages in which this information can be made available.

40. From a strictly formal point of view, the amendment of Rule 6 would result in less information being automatically recorded and published in the three official languages. Yet, the reduced ratio of requests for translation received by the International Bureau, during the periods of application of its current practice, raises a serious doubt on whether the review of the current formulation of the trilingual regime would have a serious impact on users' perception of the Madrid system as a user-friendly one. This is even more so if consideration is given to the expected efficiency-related benefits resulting from the proposed amendment, as described in paragraphs 17 to 22 and 36 to 41 of document MM/WG/LD/9/4.

41. One of the goals of the trilingual regime is to enhance legal certainty, as it widens the quality and amount of information which is relevant to ascertain the nature and scope of the protection conferred by the international registration. The proposed amendment of Rule 6 does not impinge on the availability of registration-related information, but on its immediacy. All the information on statements of grant of protection, limitations and subsequent designations would continue to be fully available in the three official languages under the proposed amendment; the only difference with the current formulation of the trilingual regime would be that, under certain circumstances, and for a given official language or languages (any of the three), the very same information that would have been initially recorded and published in one or two of the official languages would be provided in the other(s) by the International Bureau upon request. From an empirical outlook, the fact that during a number of years the informal practice of the International Bureau has not been controversial for users and/or third parties supports the conclusion that the formalization of the practice in an amendment to Rule 6 would not negatively affect legal certainty.

42. From a policy perspective, it has been adduced that the proposed amendment, as opposed to the benefits of automatic recording and publication in all three official languages, may adversely affect third parties and/or users of the system. However, the ratio of translations upon request effected during the periods in which the International Bureau developed its translation practice seems to dispel this notion.

43. It has been stated that the proposed amendment might negatively affect the expansion of the Madrid system in Spanish-speaking countries. The Madrid Union Assembly, in its thirty-fourth session (September-October 2002), and on the occasion of the analysis of a study on the implications and advantages of including Spanish in the language regime of the Madrid system⁷, noted that a large number of delegations of the Madrid Union Assembly, and of observers, had expressed support for the idea of including Spanish as an additional language in the Madrid system, particularly as a way of encouraging the accession of new members. In 2003, the Madrid Union Assembly amended Rule 6, thus introducing Spanish in the Madrid language regime. There is no factual evidence to surmise that the proposed amendment to Rule 6 would have any repercussion on the likelihood of accession of new Spanish-speaking Contracting Parties to the Madrid system. The reason for this is that the proposal is language-neutral and does not affect the status of the Spanish language in the Madrid system.

44. A continuation of the current practices without amending the legal framework of the Madrid system would just represent the deferment of a rigorous discussion concerning a rising quandary which undoubtedly would have a sizable financial effect on the Madrid system and on

⁷ See document MM/A/34/1. For the financial implications of the inclusion of Spanish as a working language of the Madrid system, see especially paragraphs 59 to 69 of the same document.

its stakeholders. The International Bureau has concluded that the policies of translation upon request of statements made under Rule 18^{ter}(2)(ii) and of the indications of goods and services affected by a limitation in an international registration, a subsequent designation or a request for the recording of a limitation ought to be included in the Common Regulations.

45. Continuing a practice simply taken note of by the Madrid Union Assembly amounts to situating this issue in a legal limbo. Such situation is far from being either a solution or a safe approach, as it does not discharge the liability of the Madrid Union Assembly or the International Bureau. Nor can it be adduced that it is a temporary measure, as both the evolution of the use of the system and its own expansion suggests that the issue at stake will only increase in size in the years to come.

46. Accordingly, the International Bureau proposes to submit for the consideration of the Working Group amendments and additions to Rules 6 and 40⁸ of the Common Regulations. This proposal is revised from the one described in paragraphs 17 to 22 and 36 to 41 of document MM/WG/LD/9/4.

47. Such amendments would not only address issues concerning statements currently pending translation, but it would also contribute to the sustainable expansion of the Madrid system, while effectively and efficiently serving the needs of its users, as almost all transactions effected under the Madrid system would still be systematically translated into its three working languages (see Table IX).

TABLE IX – TRANSLATION AND PUBLICATION PROCESSES IN THE INTERNATIONAL BUREAU

PUBLICATION PROCESSES	English	French	Spanish
International Registration	√	√	√
Ceasing of Effect	√	√	√
Refusal	√	√	√
Partial Cancellation	√	√	√
Restriction of the Holder's Right	√	√	√
Withdrawal of the Restriction of the Holder's Right	√	√	√
License	√	√	√
Limitation with no Effect	√	√	√
Replacement	√	√	√
Invalidation	√	√	√
Transmission	√	√	√
Refusal of Change in Ownership	√	√	√
Refusal of License	√	√	√
Subsequent Designation	√	√	√
Limitation Made in an International Application, a Subsequent Designation or a Request for the Recording of a Limitation in an International Registration	PUBLICATION IN THE NOTIFIED LANGUAGE(S) – OTHER(S) LANGUAGES(S) ON REQUEST		
Statement of Grant of Protection Under Rule 18 ^{ter} (2)(ii)	NOTIFIED IN ONE LANGUAGE – PUBLICATION ON REQUEST		

⁸ See document MM/LD/WG/9/4, paragraphs 17 to 22 and 36 to 41.

VII. THE PROPOSED AMENDMENTS IN PRACTICE

HOW WOULD A POLICY OF TRANSLATION UPON REQUEST OF STATEMENTS MADE UNDER RULE 18*ter*(2)(II) WORK?

48. Concerning statements made under Rule 18*ter*(2)(ii), such statements will be inscribed and notified in the working language in which they are received. Where the language of the international application is different to that in which a corresponding statement has been received, the International Bureau will translate this statement into the language of the international application in order to preserve the linguistic unity of the international registration, i.e., all inscriptions concerning an international registration in at least one of the working languages of the Madrid system and always in the language of the international application.
49. Where an international application has been filed in Spanish, the resulting international registration and all ensuing inscriptions, for the sake of linguistic unity, will always be published in the language of the international application, namely Spanish, including statements made under Rule 18*ter*(2)(ii), regardless of the language in which they are communicated to the International Bureau.
50. The interests of third parties are preserved. An image of the individually received statement, in the original language, will always be published in the Gazette and the document image is made available online and at no charge in ROMARIN, the electronic database maintained by the International Bureau. Furthermore, the International Bureau can be requested by any third party to provide a translation of the indications of goods and services contained in a statement made under Rule 18*ter*(2)(ii) into any of the working languages of the Madrid system.
51. Thus, for instance, where such a statement has been sent in English, if the language of the international application is Spanish, the International Bureau will always publish a translation of the aforesaid indications contained in that statement in Spanish. In addition, an image of the statement, in the original language, namely English, will always be published and made available in ROMARIN for viewing and downloading.
52. Furthermore, following the same example, where a statement made under Rule 18*ter*(2)(ii) is sent in English and its contents are translated into Spanish, as the language of the international registration, anyone can request, at no charge, that the International Bureau provide a translation of said contents into the third working language of the Madrid system, namely French. An online request form will be provided to this effect.
53. Under the proposed changes to the Common Regulations, the International Bureau would be in a position to actually identify and meet the demand for the services it provides efficiently and effectively. All the translations performed by the International Bureau following a request, will be inscribed in the International Register and their corresponding contents will also be available in the Gazette and ROMARIN.
54. The same principle would apply where the language of the international application is the same as the language in which a statement made under Rule 18*ter*(2)(ii) is sent. In the previous example, if the language of the international application and the language in which the statement is communicated are both Spanish, while the original inscription would be made in Spanish, anyone would be in a position to request, at no charge, that the contents of said statement be translated into any of the other two working languages of the Madrid system, namely English and French.

HOW WOULD A POLICY OF TRANSLATION UPON REQUEST OF THE LIST OF GOODS AND SERVICES AFFECTED BY A LIMITATION MADE IN AN INTERNATIONAL APPLICATION, A SUBSEQUENT DESIGNATION OR A REQUEST FOR THE RECORDING OF A LIMITATION WORK?

55. On the other hand, where it concerns the translation of the list of goods and services affected by a limitation made in an international application, a subsequent designation or a request for the recording of a limitation, a policy similar to that in effect concerning translation upon request of statements made under Rule 18ter(2)(ii) would apply.

56. Where a request for a limitation is made in an international application, the list of goods and services affected by such limitation would be inscribed in the International Register in the language of the international application and said list will be then translated into the language of communication of the Office concerned with the limitation, for the purposes of sending the corresponding notification to said Office, while the information would be published in the Gazette and made available in both languages in ROMARIN.

57. Where the international application is filed in French and, in this application, a request for a limitation is made concerning an Office communicating in English, the ensuing inscription, where it concerns the list of goods and services affected by such limitation, will be inscribed and published in the International Register in French, as the language of the international application, and in English, as the language of communication of the Office concerned.

58. In the aforesaid example, anyone could request, at no charge, that the International Bureau provide a version of the list of goods and services affected by the limitation in Spanish. The translated version of the said list would be inscribed in the International Register, published, and it would also be available in ROMARIN.

59. Where a limitation is made in a subsequent designation or in a request for the recording of a limitation, the holder may submit the request directly to the International Bureau. The holder may choose to submit the request in the language of communication of the Office concerned with the limitation, even if this is different from the language of the international application. In this case the International Bureau, for the sake of linguistic unity, would always translate and publish the list of goods and services affected by the limitation into the language of the international application.

60. Thus, where the language of the international application is French and a request for the recording of a limitation is filed directly before the International Bureau in English concerning an Office which communicates in this language, the list of goods and services affected by such limitation will be translated into French, as the language of the international application. As with the previous case, anyone could request, at no charge, that such list be translated also into Spanish.

61. Furthermore, even when the language of the international application, the language in which the request is made and the language of the Office concerned with a limitation are all the same, anyone could request, at no charge, that the International Bureau translate the list of goods and services affected by the limitation into any of the other working languages of the Madrid system. As for the previous cases, all such translations will also be published.

62. Following the previous example, where the language of the international application is French, a request for the recording of a limitation is filed in French and the language of communication of the Office concerned with the limitation is also French, while the original inscription of the aforementioned limitation would be made in French, anyone could request, at no charge, that the International Bureau provide for the translation of the list of goods and

services affected by the limitation into the other two working languages of the Madrid system, namely English and Spanish. The International Register would be updated accordingly and the information would be published in the Gazette and be made available in ROMARIN.

63. The introduction in the Common Regulations of a policy of translation upon request of the indications of goods and services in a statement made under Rule 18ter(2)(ii), or of those affected by a limitation in an international application, a subsequent designation or a request for the recording of a limitation, addresses in earnest a longstanding and increasing problem faced by the Madrid system. It is suggested that the proposed changes to the Common Regulations, while upholding the principle of the trilingual regime, result in a financially sustainable linguistic policy which balances the interests of holders of international registrations and the Contracting Parties, with the legitimate interest of third parties.

64. *The Working Group is invited to:*

(i) consider the information provided in the present document; and

(ii) indicate any further course of action, including whether it recommends to the Madrid Union Assembly the proposed amendments to Rules 6 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

Chapter 1 General Provisions

[...]

Rule 6 Languages

[...]

(3) *[Recording and Publication]* (a) Subject to paragraphs 4(c) to (h), ~~F~~ 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 the language in which the relevant international application was received by the International Bureau, such recording and publication shall also be in that language;

(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 registered under Rule 14 shall be in the language in which the relevant international application was received by the International Bureau. Where such language is not the language notified under paragraph (2)(iii) to the International Bureau by the concerned designated Office, such recording and publication shall also be in that language;

(e) where a subsequent designation is for only part of the goods and services listed in an international registration, the recording in the International Register and the publication in the Gazette of the part of the goods and services concerned by a subsequent designation shall be in the language of the subsequent designation. Where such language is not the language notified under paragraph (2)(iii) to the International Bureau by the concerned designated Office, such recording and publication shall also be in that language;

(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. Where such language is not the language notified under paragraph (2)(iii) to the International Bureau by the concerned designated Office, such recording and publication shall also be in that language.

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

(h) Translations of the recordings effected under paragraphs (c), (d) (e) and (f) into another of the languages indicated in paragraph (1) will, upon request, be made and provided by the International Bureau. Such translations will be recorded and published by the International Bureau.

Chapter 9 Miscellaneous

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 (h) as in force from [...], shall be applicable to any statement of grant of protection sent under Rule 18ter(2)(ii), any limitation in an international registration registered 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), and shall be applicable also to any of the above, remaining untranslated, as of the said date.

[...]

[End of Annex and of document]