

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

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### **REVIEW OF THE TRANSLATION PRACTICE MANDATED BY THE MADRID UNION ASSEMBLY**

*Document prepared by the International Bureau*

#### **INTRODUCTION**

1. The recording in the International Register and publication in the *WIPO Gazette of International Marks* (“the Gazette”) of an international registration and of any data recorded and published under 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”) related to an international registration shall be in English, French and Spanish. This trilingual regime follows from paragraph (3) of Rule 6 of the Common Regulations. Under paragraph (4) of the same Rule, the International Bureau shall make the necessary translations for the said recordings and publications and for their communication to Offices of the Contracting Parties, to applicants and to holders.

2. Nevertheless, under the current translation practice implemented by the International Bureau, the list of goods and services for two specific recordings is only translated, before recording, publication and notification, into the language of communication of the holder and of the Offices concerned and into the language of the international application. Any translation of the list of goods and services into another working language of the Madrid System for the International Registration of Marks (hereinafter referred to as “the Madrid System”), as required by Rule 6 of the Common Regulations, is only made upon receiving a request from any interested party (the holder, an Office or a third party).

3. This practice applies to the list of goods and services in the following two recordings:
- statements of grant of protection made under Rule 18*ter*(2)(ii) of the Common Regulations (i.e., after a provisional refusal); and,
  - limitations requested in an international application, a subsequent designation or as the recording of a change.
4. The translation practice currently in place was last reviewed by the Working Group on the Legal Development of the Madrid System for the International Registration of Marks (“the Working Group”), at its tenth session, when it recommended that the Madrid Union Assembly continue to take note of the translation practice in place.
5. The Madrid Union Assembly, at its forty-fifth session, continued to take note of the practice, as described in document MM/A/45/1, and mandated the International Bureau to review this practice after a period of three years\*.
6. The purpose of the present document is to review the current translation practice, after the three year period, as mandated by the Madrid Union Assembly. More specifically, this document presents background information on the overall translation tasks undertaken by the International Bureau since this issue was last reviewed by the Working Group, describes the impact of the translation practice, and reviews this practice in light of ongoing developments in information technology and automated translation.
7. For a more detailed explanation of the current translation practice, a further reference is made to document MM/LD/WG/10/5, paragraphs 48 to 63.

#### **TRANSLATION RELATED TASKS UNDERTAKEN BY THE INTERNATIONAL BUREAU UNDER THE MADRID SYSTEM: 2012 TO 2014**

8. Between 2012 and 2014, there has been a substantial increase in the translation workload. The number of recordings has increased by 15%, while, in the same period, the number of translated words increased by 77%. In 2012, the International Bureau made 612,712 recordings, translating over 15 million words. In 2014, these numbers had increased to 704,748 recordings, involving the translation of more than 26.6 million words (see Table I).

*Table I: Translation Activities – 2012 to 2014*

	Recordings in the International Register	Number of Translations	Number of Words Translated
2012	612,712	123,668	15,029,668
2013	722,363	123,624	24,511,019
2014	704,748	116,632	26,608,859

9. The main cause of the increase in the translation workload is a surge in the number of words in international registrations. Indeed, the number of translated words in international registrations went from almost 12.6 million, in 2012, to almost 23 million, in 2014, an increase of over 82%, while the number of words translated in other recordings increased by 50% (see Table II).

\* See document MM/A/45/5, paragraphs 21 to 24.

10. Taking into account the number of words translated, the highest translation workload continues to result from international registrations, representing over 86% of all translations, followed by statements of grant of protection sent under Rule 18ter of the Common Regulations, which, under the current practice, account for 8%.

*Table II: Translated Words per Recording Type – 2012 to 2014*

	2012		2013		2014	
	Translations	Words	Translations	Words	Translations	Words
International Registration (Rule 14)	103,110	12,579,875	96,061	21,179,259	91,383	22,927,428
Refusal (Rule 17(1))	809	58,093	133	4,006	194	7,877
Final and Further Decision (Rules 18ter(2)(ii) and (4))	6,497	781,150	11,310	1,752,731	10,606	2,207,104
Invalidation (Rule 19)	49	1,508	418	16,822	866	66,700
Restriction of the Holder's Right (Rule 20)	178	17,871	581	41,447	598	44,773
License (Rule 20bis)	293	4,517	604	8,195	684	13,133
Ceasing of Effect (Rule 22)	4,441	618,012	9,167	1,063,896	7,299	871,835
Subsequent Designation (Rule 24)	2,880	360,246	2,054	149,742	2,286	195,673
Change in Ownership (Rule 25(1)(a)(i))	116	19,612	222	58,784	87	11,749
Limitation (Rule 25(1)(a)(ii))	4,391	572,441	1,745	186,706	1,873	224,113
Partial Cancellation (Rule 25(1)(a)(v))	403	11,618	605	25,000	567	29,453
Limitation Has no Effect (Rule 27(5))	61	2,587	442	11,259	61	3,738
Replacement (Article 4bis)	41	2,138	282	13,172	126	5,180
Translation on Request					2	103
Total	123,668	15,029,221	123,624	24,511,019	116,632	26,608,859

11. The distribution of the translation workload by target language has varied since it was last reported to the Working Group in 2011, when English represented 15%, French 36% and Spanish 49%. In 2014, English represented 10%, French 45% and Spanish also 45% (see Table III).

Table III: Translated Words per Recording Type and Target Language in 2014

	English		French		Spanish	
	Translations	Words	Translations	Words	Translations	Words
International Registration (Rule 14)	9,850	2,101,772	37,279	9,649,441	44,254	11,176,215
Refusal (Rule 17(1))	28	488	6	187	160	7,202
Final and Further Decision (Rules 18ter(2)(ii) and (4))	3,565	501,058	6,126	1,548,579	915	157,467
Invalidation (Rule 19)	46	1,378	782	61,446	38	3,876
Restriction of the Holder's Right (Rule 20)	94	6,858	248	18,319	256	19,596
License (Rule 20bis)	124	1,424	252	7,426	308	4,283
Ceasing of Effect (Rule 22)	322	24,706	3,377	417,173	3,600	429,956
Subsequent Designation (Rule 24)	632	35,202	1,052	105,364	602	55,107
Change in Ownership (Rule 25(1)(a)(i))	13	2,290	37	4,478	37	4,981
Limitation (Rule 25(1)(a)(ii))	341	33,459	1,310	166,834	222	23,820
Partial Cancellation (Rule 25(1)(a)(v))	68	1,303	264	14,430	235	13,720
Limitation Has no Effect (Rule 27(5))	1	6	58	3,621	2	111
Replacement (Article 4bis)	16	410	54	2,322	56	2,448
Translation on Request	1	9	1	94	0	0
Total	15,101	2,710,363	50,846	11,999,714	50,685	11,898,782

### IMPACT OF THE TRANSLATION PRACTICE ON STATEMENTS OF GRANT OF PROTECTION SENT UNDER RULE 18TER(2)(II) OF THE COMMON REGULATIONS RECORDED IN 2014

12. In 2014, under the current practice, the International Bureau translated almost 2.3 million words resulting from the recording of decisions sent by Offices. Had the current translation practice not been in place, the International Bureau would have been required to translate more than 12.5 million words resulting from the recording of those decisions. In relative terms, the translation workload of the International Bureau would have been 39% higher (see Table IV).

Table IV: Translated Words in 2014

	Number of Translated Words in 2014				
	Actual	Percentage	Simulation with Rule 18ter(2)(ii)	Percentage	Increase
International Registrations	22,927,428	86.2%	22,927,428	62.1%	
Changes	527,812	2.0%	527,812	1.4%	
Refusals	7,877	0.0%	7,877	0.0%	
Ceasing of Effect	871,835	3.3%	871,835	2.4%	
Other Decisions	2,273,907	8.5%	12,574,672	34.1%	453%
Total	26,608,859	100.0%	36,909,624	100.0%	38.7%

13. The International Bureau took a nuanced approach to the translation of statements of grant of protection sent under Rule 18ter(2)(ii) of the Common Regulations because their recording rarely serves the needs of the holders, as they would probably have taken part in the proceedings leading to the statement.

14. Since 2011, a simple electronic form to request the translation of a document not translated under the current practice has been available on the Madrid System website. The demand for the translation of statements of grant of protection has been minimal. The International Bureau has received only three valid translation requests, two of them in 2014. The low demand for this service may be explained by the fact that the translation of these statements of grant of protection mainly serves the information needs of third parties.

#### **IMPACT OF THE TRANSLATION PRACTICE ON LIMITATIONS MADE IN INTERNATIONAL APPLICATIONS, SUBSEQUENT DESIGNATIONS AND REQUESTS FOR THE RECORDING OF A CHANGE RECORDED IN 2014**

15. The rationale for the current practice of selectively translating limitations is to expedite their recording and notification. Typically, limitations are requested by the holder to satisfy a time-sensitive need, such as to respond to a provisional refusal or to reduce the scope in a designated Contracting Party before the renewal of the international registration.

16. In 2014, the total number of limitations recorded, either as a change or simultaneously and as part of an international registration or subsequent designation, was 14,123. In 7,195 of those recordings, 51% of the total, the language in which the request was filed was the same as the language of communication of the Office where the limitation was to have effect (see Table V).

17. In other words, the time required to record more than half of the limitations was substantially reduced because they did not require translation. This, as explained earlier, had significant benefits for the holders concerned.

*Table V: Limitations recorded in 2014*

	Language of the Limitation = Language of Office Concerned	Limitations Recorded
Limitations in an International Application	1,770	6,154
Limitations in a Subsequent Designation	2,510	3,580
As a Requests for the Recording of a Change	2,915	4,389
Total	7,195	14,123

## DEPLOYMENT OF A NEW INFORMATION TECHNOLOGY BASED TRANSLATION PROCESS BY THE INTERNATIONAL BUREAU

18. Starting in 2012, to ensure consistency and quality in the translation output as well as a pre-emptive move to manage a foreseeable increase in translation workload, the International Bureau elected to deploy SDL WorldServer (WS) as its translation management system (TMS) of choice for Madrid, Hague and PCT procedures. WS automates translations tasks based on an ever growing internal database of translation precedents and carefully vetted terms. The decision to adopt WS was made after completing a thorough audit of potentially suitable TMS technologies and its deployment was undertaken within the IT Modernization Program.

19. As it was previously indicated, the number of words translated by the International Bureau increased by 77% between 2012 and 2014. The International Bureau has been able to manage this increase through the deployment of WS. In 2011, almost 26% of all translations were performed automatically. In 2014, the percentage of translations that were performed automatically by using WS, without human intervention, had increased to more than 66% (see Table VI).

*Table VI: Translated Words per Means of Translation and Target Language in 2014*

	English	Percentage	French	Percentage	Spanish	Percentage	Total	Percentage
Outsourced	523,100	19.30%	3,359,920	28%	1,499,247	12.60%	5,382,267	20%
Automatically	1,761,736	65%	7,883,812	65.70%	8,031,678	67.50%	17,677,226	66.50%
Internally	425,527	15.70%	755,982	6.30%	2,367,858	19.90%	3,549,367	13.50%
Total	2,710,363	100%	11,999,714	100%	11,898,782	100%	26,608,859	100%

20. To further complement the translation approach opted by the International Bureau, TAPTA4MARKS, a custom-trained machine translation (MT) engine has been added. This is a customized version of the TAPTA technology (Translation Assistant for Patent Texts and Abstracts), developed by the Global Infrastructure Sector of WIPO and which is already deployed within a number of PCT procedures and used in other United Nations agencies for administrative documents. A MT is a system configured to statistically analyze translation material and to leverage internal and external resources in order to render a likely translation that may require post translation editing (post-editing).

21. TAPTA4MARKS takes the 34% of indications of goods and services that are not translated by WS and proposes, with a high degree of reliability, their most likely translation. A post-editing review is conducted by either internal or external resources. After this review, the translation proposed by TAPTA4MARKS is either validated or enhanced, thus reducing human translation input to post-editing process.

22. As a result of WS and TAPTA4MARKS, there is, for each indication of the list of goods and services subject to translation, always an automated translation proposal, significantly enhancing the efficiency of the process. The automated translation leveraging achieved has resulted in a reduction in translation backlog and processing time.

23. The introduction of the MT post-editing process has expanded the International Bureau's translation capacity, whilst allowing for efficient management of an ever-increasing workload yet avoiding the need to augment human resources. Internal resources focus on managing the translation inputs to the automated solutions and on deploying and overseeing a quality assurance process to safeguard the overall quality of the end-product.

24. As part of its overall translation strategy, the International Bureau has forged long-term partnerships with external translation agencies, which has reduced the cost of outsourcing translation, now averaging 0.05 Swiss francs per post-edited word, instead of the prior average of 0.25 Swiss francs per translated word.

25. Finally, as the International Bureau changed its translation process to align it with translation industry best practices, it also reformed its internal organization from three linguistic units to a single section (the Madrid Translation and Terminology Section) managing all internal, external and automated translation processes. Following this change, the combined section acts as a service-focused group with a sole point of contact to distribute the work to the internal translators and the external translation partners.

#### **SPECIAL ACTION ON THE TRANSLATION BACKLOG OF STATEMENTS OF GRANT OF PROTECTION UNDER RULE 18TER(2)(II) OF THE COMMON REGULATIONS RECEIVED BEFORE 2012**

26. As reported in 2012, there were 133,794 pending translations resulting from statements of grant of protection under Rule 18ter(2)(ii) of the Common Regulations received prior to 2012.

27. Following the deployment of the previously mentioned automated solutions and under a special action that took place between 2012 and 2013, the International Bureau has cleared this backlog, using automated tools to translate close to 32 million words.

28. The translation of the indications of goods and services in these statements of grant of protection was completely automated, without any human intervention or MT post-editing revision.

#### **REVIEW OF THE TRANSLATION PRACTICE AND POSSIBLE FURTHER ACTIONS**

29. The translation practice has permitted the International Bureau to implement an adequate process to manage the ever-growing translation workload without the need for an escalation of human resources. The process leverages technological solutions to deliver a previously vetted translation or to propose a new translation, with a high-degree of reliability.

30. The International Bureau has been able, under the current practice, to focus its technical and human resources on the translation surge resulting from international registrations. From the users' perspective, this is one of the most important transactions because it is the one in which the scope of the protection that is being sought is first recorded in the International Register and, as such, notified to the Offices of the designated Contracting Parties.

31. The automated translation process established by the International Bureau still requires human intervention for overall process management, for quality assurance purposes, to reflect the nuances of the indications of goods and services or to post-edit or translate new terms used to describe innovations in a particular field. Nevertheless, as demonstrated by the aforementioned special action taken by the International Bureau, the information technology solutions deployed are capable of rendering further increases in automated translation.

32. While the results achieved in terms of automated translation are encouraging, continued work is required to ensure that the yield obtained from the technological solutions deployed remains stable and to further increase the degree of automation already accomplished. Human resources are still required to maintain and ensure the quality level of the translation output.

33. In view of the above, the International Bureau would now be in a position to automatically translate the list of goods and services in statements of grant of protection, sent under Rule 18ter(2)(ii) of the Common Regulations, using the implemented technological solutions (WS and TAPTA4MARKS), with post-editing limited to translations into the language of communication of the holder, a process that is already covered by the current practice.

34. Similarly, the International Bureau would also be able to translate the list of goods and services in limitations into a language other than that of communication of the holder or the Office concerned. Since the translation solutions put in place by the International Bureau have reduced translation backlog and overall processing time, the suggested course of action would not affect the holders by increasing the pendency time of the recording and notification of limitations.

35. Following the implementation of the proposed measures described above, the current practice of translation upon request would no longer be required, as the list of goods and services in statements of grant of protection sent under Rule 18ter(2)(ii) of the Common Regulations and in limitations would be translated into all the working languages of the Madrid System prior to their inscription, notification and publication.

36. To ensure that all the necessary technological adjustments are in place, it is proposed that the International Bureau would apply the suggested measures to the translation of the list of goods and services in statements of grant of protection sent under Rule 18ter(2)(ii) of the Common Regulations and in limitations received as from April 1, 2016.

37. Finally, under the current practice, between 2012 and 2014, the International Bureau has not been required to translate 26 million words contained in the lists of goods and services of statements of grant of protection sent under Rule 18ter(2)(ii) of the Common Regulations and three million words contained in the list of goods and services in limitations. A special action, similar to the one described in paragraphs 26 to 28 above, could be taken for these documents received prior to April 1, 2016.

38. *The Working Group is invited to:*

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

*(ii) indicate whether it agrees with the actions proposed in paragraphs 33 to 37.*

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