

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

**Sixteenth Session
Geneva, July 2 to 6, 2018**

NEW TYPES OF MARKS AND NEW MEANS OF REPRESENTATION

Document prepared by the International Bureau

INTRODUCTION

1. At its fourteenth session, held in Geneva from June 13 to 17, 2016, the Working Group on the Legal Development of the Madrid System for the International Registration of Marks (hereinafter referred to as, respectively, “the Working Group” and “the Madrid System”) agreed on a list of topics for future discussion (“the Road Map”)¹, in the short, medium and long term. The Working Group revised the Road Map at its fifteenth session², held in Geneva from June 19 to 22, 2017.
2. In the short term, the Working Group agreed to discuss types of marks, other than those explicitly mentioned in the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement (hereinafter referred to as, respectively, “the Common Regulations” and “the Protocol”).
3. This document provides an overview of the current legal framework of the Madrid System regarding types of marks, lists a number of matters for the Working Group to consider as a basis for discussions for future work of representation of marks and invites the Working Group to provide guidance on how to move forward on this subject.

¹ See document MM/LD/WG/14/6, Annex IV.

² See document MM/LD/WG/15/5, Annex II.

THE LEGAL FRAMEWORK OF THE MADRID SYSTEM ON TYPES OF MARKS AND GRAPHICAL REPRODUCTION REQUIREMENT

4. Article 2(1) of the Protocol requires that marks, for which protection is sought under the Madrid System, be either the subject of an application for their registration filed with the Office of a Contracting Party or registered in the Register of such an Office (hereinafter referred to as “the Office of origin”).

5. Accordingly, any type of mark that can be registered in accordance with the applicable law of the Contracting Party of the Office of origin can be the subject of an international registration. Moreover, the Common Regulations do not restrict the types of marks for which an international application can be filed. They merely require that an indication be made in the international application for certain types of marks.

6. The above is corroborated by the fact that types of marks not explicitly mentioned in the Common Regulations are registered under the Madrid System. For example, the description of the mark that is the subject of international registration number 1156391 indicates that “[t]he mark consists in part of a hologram image in the center of the mark”. As a further example, the description of the mark that is the subject of international registration number 1169173 indicates that “[t]he trademark is a position mark which depicts a scorpion on the arch of the outsole of a shoe as shown; the dashed outline of the shoe does not form part of the trademark”.

7. While non-traditional marks are small in numbers, the reality is that registration of those marks, in a number of Contracting Parties, does occur. For example, the European Union Intellectual Property Office (EUIPO) received 116,512 applications in 2016; five of these were sound marks and 190 were three-dimensional marks. In its Register, the EUIPO has 196 sound marks, one motion mark, three hologram marks, and 4,621 three-dimensional marks. As a further example, the United States Patent and Trademark Office (USPTO) received 391,837 applications in 2016, with 26 of these being “sound marks and other marks that cannot be presented in drawing”. Furthermore, in 2016, WIPO registered 44,726 marks; two of these were sound marks and 166 were three-dimensional marks. The International Register under the Madrid System currently contains 54 registrations of sound marks and 3,270 registrations of three-dimensional marks.

8. The topic of non-traditional marks has been discussed by the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (hereinafter referred to as “the SCT”). At its twentieth session, held in Geneva from December 1 to 5, 2008, the SCT agreed on areas of convergence relating to the representation of non-traditional marks³ covering three-dimensional marks, color marks, hologram marks, motion or multimedia marks, position marks, gesture marks and sound marks.

9. A requirement for graphical reproduction of marks is set out in Rule 9(4)(a)(v) of the Common Regulations, which says that “[t]he international application shall contain or indicate a reproduction of the mark that shall fit in the box provided on the official form; that reproduction shall be clear and shall, depending on whether the reproduction in the basic application or the basic registration is in black and white or in color, be in black and white or in color”.

INTERNATIONAL APPLICATIONS FOR NEW TYPES OF MARKS AND POSSIBLE NEW MEANS OF REPRESENTATION

10. The following paragraphs briefly identify certain issues concerning the filing of international applications under the Madrid System for new types of marks.

³ See document SCT/20/2.

INDICATION OF THE TYPE OF MARK IN THE INTERNATIONAL APPLICATION

11. Under Rule 9(4)(a)(vii**bis**) to (x) of the Common Regulations⁴, applicants must indicate in the international application whether the mark in the basic application or basic registration (hereinafter referred to as the “basic mark”) consist of a color or combination of colors or is a three-dimensional, sound, collective, certification or guarantee mark. Under Rule 9(5)(d)(iii), the Office of origin must certify that any such indication appearing in the international application also appears in the basic mark.

12. The Madrid System does not restrict the types of marks for which an international application can be filed. Therefore, it could be considered whether it would be desirable or even necessary to amend the Common Regulations to require an indication for types of marks other than those already referred to in Rule 9(4)(a)(vii**bis**) to (x) of the Common Regulations, and if so, what those other types of marks should be.

13. The above-mentioned amendment may not be strictly necessary, because the current legal framework does not preclude any type of mark from being the subject of an international application. On the contrary, such amendment could negatively affect trademark owners where, for example, the Office of origin does not require an indication of the type of mark in the basic application, or where such Office categorizes marks in a different manner. In that case, the Office of origin would not be able to certify that the indication of the type of mark is also present in the basic mark.

14. Alternatively, it may be sufficient that applicants or holders provide an indication concerning the type of mark to satisfy such requirement in designated Contracting Parties. For example, the applicant could, under Rule 9(4)(b)(vi)⁵, include in the description of the mark its specific type, if considered necessary. This would allow the applicant to take advantage of an existing feature in the Common Regulations (voluntary description).

GRAPHICAL REPRODUCTION REQUIREMENT

15. A further important topic for consideration is the fact that, at present, Rule 9(4)(a)(v) provides for a graphic reproduction requirement, in stipulating that the mark be reproduced in a manner to fit in the box provided in the official form. This official form is not available in a format that allows users to avoid graphical reproduction.

⁴ Rule 9(4)(a)(vii**bis**) to (x) of the Common Regulations reads as follows:

“(4) [Contents of the International Application] (a) The international application shall contain or indicate
“[...]”
“(vii**bis**) where the mark that is the subject of the basic application or the basic registration consists of a color or a combination of colors as such, an indication to that effect,
“(viii) where the basic application or the basic registration relates to a three-dimensional mark, the indication “three-dimensional mark”,
“(ix) where the basic application or the basic registration relates to a sound mark, the indication “sound mark”,
“(x) where the basic application or the basic registration relates to a collective mark or a certification mark or a guarantee mark, an indication to that effect,”

⁵ Rule 9(4)(b)(vi) of the Common Regulation reads as follows:

“(4) [Contents of the International Application] [...]”
“(b) The international application may also contain,
“[...]”
“(vi) any description of the mark by words or, if the applicant so wishes, the description of the mark by words contained in the basic application or the basic registration, where it has not been provided under paragraph (4)(a)(xi).”

16. Bearing in mind that the overwhelming majority of marks satisfy a requirement of graphic representation and given that graphic representation is a reproduction standard for marks applied through all Offices of the Madrid Union members, although not necessarily on an exclusive basis by all of those Offices, the question may be asked whether the procedures under the Madrid System should allow for additional means of representation of marks. If so, what should those means be and what would be the legal consequences of introducing such new means of representation, in particular, digital representation.

17. Furthermore, it could be considered that the manner, in which the international application must contain a representation of the mark, as well as the acceptable formats rather be dealt with in the Administrative Instructions for the Application of the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating Thereto, which could initially require a visual representation of the mark.

IMPLICATIONS OF INTRODUCING NEW MEANS OF REPRESENTATION

Legal Implications

18. Graphical representation of marks is still a requirement widely applied by Contracting Parties of the Madrid System, although not necessarily on an exclusive basis. Introducing new means of representation in the Madrid System would have implications for Contracting Parties as the Contracting Party of the Office of origin as well as when being designated.

19. Under Article 2(2) of the Protocol, international applications are filed with the International Bureau through the Office of origin. This means that a first question would be the acceptance, by the Office of origin, for certification purposes, of international applications containing new means of representing the mark.

20. Under Article 5(1) of the Protocol, Offices of designated Contracting Parties can refuse protection of an international registration when, for example, the mark concerned consists of a sign that is not considered as being capable of constituting a trademark under the laws of this Contracting Party, or is represented in a manner not accepted by its Office.

21. However, the acceptance of new means of representation might require changes in the legal framework of certain Contracting Parties. As an alternative, new means of representation could be introduced in the Madrid System with the *proviso* that their acceptance would be gradually phased-in according to the evolving legal framework of the Contracting Parties.

Implications for Electronic Exchange of Communication and for Information and Communication Systems

22. The efficient introduction into the Madrid System of new means of representation has to be considered within the framework of digital representations of marks being transmitted electronically. Advances in information and telecommunication technology have made digital files affordable and easy to transmit. As a result, some Offices now maintain digital representations of marks and are able to exchange them electronically.

23. While the majority of international applications are transmitted electronically to the International Bureau, a number of Offices continue to present international applications on paper. Similarly, a number of Offices still require paper notifications from the International Bureau.

24. The Working Group may wish to consider whether electronic data exchange in the Madrid System should be developed to include transmission of data files with non-graphic contents, for example sound files. The analysis by the Working Group should bear in mind that the exchange of this type of files will affect Offices of origin, where their receiving, certification and transmittal functions will be concerned, and Offices of designated Contracting Parties, which will be notified of international registrations and will need to examine them, and to grant or refuse protection. The analysis of the Working Group would benefit from the experience of Offices already accepting electronic exchanges and of data files with non-graphic contents.

25. Discussions would also have to take into account the potential impact of the introduction of new means of representation could have on the information and communication systems of the Offices of Contracting Parties.

26. *The Working Group is invited to:*

(i) consider the present document;

(ii) indicate its views on the representation of new types of marks in the procedures under the Madrid System; and

(iii) express its views on further work concerning this topic.

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