

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

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

### **LANGUAGE REGIME UNDER THE MADRID SYSTEM**

*Document prepared by the International Bureau*

#### **INTRODUCTION**

1. During the preparation for the sixteenth 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”), which will take place in Geneva from July 2 to 6, 2018, the International Bureau received two proposals concerning the introduction of additional languages to the Madrid System, namely, Chinese<sup>1</sup> and Russian<sup>2</sup>.
2. The present document offers background information concerning the current language regime of three of the global intellectual property (IP) protection systems administered by WIPO, namely, the Madrid System, the Hague System and the Patent Cooperation Treaty (PCT), 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.

---

<sup>1</sup> See document MM/LD/WG/16/7 “Proposal by the Delegation of China”.

<sup>2</sup> See document MM/LD/WG/16/9 “Proposal by the Delegation of the Russian Federation”.

## THE GLOBAL SYSTEMS AND THEIR RESPECTIVE LANGUAGE REGIMES

### THE TRILINGUAL REGIME UNDER THE MADRID SYSTEM

3. When the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks became operational in 1996, English was added as a language to the Madrid System, which until that point in time had only operated in French. Moreover, in 2004<sup>3</sup>, Spanish was introduced as an additional language.
4. Since 2004, the Madrid System thus operates under a trilingual regime. This means that the Madrid System uses three languages for international applications and registrations; in particular, for the purposes of filing, registration, recording, publication, communication and notification.
5. The provisions concerning the language regime are in Rule 6 of 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”).
6. Under Rule 6 of the Common Regulations, the international application must be filed in English, French or Spanish, as prescribed by the Office of origin, which may allow applicants to file in only one or in only two of those languages or file in any of them. Any communication addressed to the International Bureau must be in English, French or Spanish, as chosen by the party sending the communication. Finally, Offices, applicants and holders can choose to receive communications from the International Bureau in any one of the above-mentioned languages.
7. While Rule 6 of the Common Regulations does not mention the terms “working language” or “official language”, the three languages acceptable under the Madrid System are informally referred to as “working languages”.

#### Workload: Statistics and Translation

8. A given transaction in the Madrid System can be processed in any one of its three working languages, at the choice of Offices, applicants or holders; the translation of the particulars of each transaction into the other two languages concerned must be made by the International Bureau.
9. The majority of the translation work performed by the International Bureau concerns the translation of lists of goods and services from one working language into the other two.
10. In 2017, the International Bureau received 56,200 international applications, of which 83 per cent were filed in English, 14 per cent in French and three per cent in Spanish. A similar proportion also applies to other transactions, such as subsequent designations and requests for recording filed by holders as well as decisions on the scope of protection sent by Offices.
11. During the same period, the International Bureau translated 37,410,427 words, of which 70 per cent were translated using automated translation tools. The remaining words were translated by human resources. The percentage of words that were translated through automated tools is the result of an on-going process that has happened over time. 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.

---

<sup>3</sup> See documents MM/A/34/1 and MM/A/35/1.

12. The Madrid System makes available the *Madrid Goods & Services Manager*, a tool developed to assist applicants compile the lists of goods and services for an international application. It currently contains 94,743 terms in English, 59,722 terms in French and 56,155 terms in Spanish. In addition, it includes terms in the following 15 languages, with the number of terms appearing in brackets: Arabic (25,184); Chinese (33,571); Dutch (40,783); German (27,126); Hebrew (44,586); Italian (31,241); Japanese (38,772); Korean (36,084); Mongolian (9,363); Norwegian (32,393); Portuguese (44,477); Russian (32,656); Serbian (28,264); Turkish (10,352); and Ukrainian (9,353).

13. More terms, in the current languages as well as in further languages, could be included with the necessary investment and in cooperation with the Offices of the Contracting Parties concerned. To date, the International Bureau has received requests for inclusion of additional languages in this tool from Cambodia, Georgia, Indonesia and Thailand.

#### LANGUAGE REGIME UNDER THE HAGUE SYSTEM

14. The Hague System also has a trilingual regime, featuring the same languages as the Madrid System for filing, registration, recording, publication, communication and notification.

15. With its 54 Contracting Parties to the Geneva Act (1999) of The Hague Agreement Concerning the International Registration of Industrial Designs and 5,213 international applications filed in 2017, the Hague System operates with much smaller volumes than the Madrid System. These two systems are also different in that, for example, the Hague System allows for direct filing, does not offer subsequent designations under an international registration, and offers fewer post-registration transactions to be recorded in its International Register due to the limited period of protection.

16. The International Bureau has received a proposal to introduce Russian to the Hague System, as well as a request to consider the possible inclusion of Chinese. These matters will be discussed during the upcoming session of the Working Group on the Legal Development of the Hague System for the International Registration of Industrial Designs, which will take place in Geneva from July 16 to 18, 2018.

#### LANGUAGE REGIME UNDER THE PATENT COOPERATION TREATY (PCT) SYSTEM

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

18. The PCT System currently provides for 10 languages of publication, namely Arabic, Chinese, English, French, German, Japanese, Korean, Portuguese, Russian and Spanish. Simply put, an international application in the PCT System may be filed in any language accepted by the receiving Office. If the international application is filed with the receiving Office in a language that is not among those 10 languages listed above, the applicant has to provide a translation of the application into one of those publication languages. 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. If the application is in non-Latin script, the applicant has to provide a transliteration into Latin script.

19. The application will then be published in one of the 10 listed languages. The International Bureau will translate the title and the abstract into English and French. The International Bureau will also translate the international search report and the international preliminary report on patentability into English. No further translations are required.

20. While English is the language of communication between the International Bureau and applicants and Offices, the PCT Operations Division has teams that are able to communicate in the 10 languages mentioned above.

### **ADDING LANGUAGES UNDER THE MADRID SYSTEM AND POSSIBLE IMPLICATIONS**

21. From a strictly legal point of view, adding languages to the Madrid System would require amending Rule 6 of the Common Regulations. While this would only entail a decision by the Madrid Union Assembly, without the need to amend the Protocol, such change would have significant implications.

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

### **POSSIBLE MODELS FOR THE INTRODUCTION OF NEW LANGUAGES**

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

24. The partial introduction of new languages could involve, for example, the introduction of a number of languages for the purposes of filing an international application while maintaining the current trilingual regime for the purposes of recording, inscription, communication and publication. In other words, an international application filed in one of the newly introduced filing languages would be translated into the current working languages for the purposes of recording and publication.

25. Another possible model could be the full introduction of additional working languages, in application of the language regime as currently established in Rule 6 of the Common Regulations. This would result in the introduction of a number of languages for the purposes of not just filing but also of registration, inscription, communication and publication. 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.

### **OPERATIONAL IMPLICATIONS**

26. A significant impact on the operations of the Madrid System has to be expected as a result of a decision to add one or several languages to the current language regime, regardless of the model chosen for their introduction. Following such decision and depending on the model selected, registration, recording, communication and publication might need to be conducted in all languages.

27. Additional languages would mean that international applications would, at the very least, be filed in any of these languages; depending on the manner the decision is implemented, these applications might need to be examined by the International Bureau in the language in which they were filed and translated for registration, publication and notification.

28. WIPO officials conducting examination and providing customer support would be expected 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.

29. 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 several languages to the current language regime, regardless of the model chosen for their introduction, would substantially increase the volume of translation work. In turn, increased translation work could negatively affect transactional processing times.

30. Additional languages could also affect users, who might receive decisions on the scope of protection from the Offices of the designated Contracting Parties, including notifications of provisional refusal, not just in English, French or Spanish but in any one of the newly introduced languages, depending on the way these languages are introduced.

#### IT RELATED IMPLICATIONS

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

#### FINANCIAL IMPLICATIONS

32. 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.

33. 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 Madrid System, Spanish, shows that currently, while 50 per cent of the translation costs under the Madrid system are accrued to Spanish, only three per cent of all international applications are filed in this language.

34. While it is a reality that adding new languages to the Madrid 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.

35. 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 measures<sup>4</sup>.

36. 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. Intensified use of the Madrid System would be an advantage for trademark owners and for the Contracting Parties where protection is sought.

---

<sup>4</sup> See documents WO/PBC/21/21, WO/PBC/21/22 and A/51/14.

37. Adding one or several languages to the Madrid 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. Finally, the needs and prerogatives of all users of the system must be kept in mind, especially their expectation that the international trademark registration system needs to be efficient, reactive and continue delivering high-quality services.

[End of document]