



**Working Group on the Legal Development of the Madrid System for the International
Registration of Trade Marks, Sixteenth Session**

WIPO, Geneva - 2 – 6 July 2018

MARQUES' comments on official languages and non-Latin Script Marks

MARQUES is the European association representing brand owners' interests. **MARQUES'** mission is to be the trusted voice for brand owners.

MARQUES is an official non-governmental organisation that was granted observer status at the World Intellectual Property Organization - WIPO in 1989 by the Governing Bodies at their Twentieth Series of Meetings (cf. paragraph 213 of General Report, document AB/XX/20).

MARQUES has reviewed the Proposals made by the Russian Federation, Chinese and Indonesian delegations (documents MM/WG/16/7,8,9) in relation to the inclusion of additional languages as official languages of the Madrid System of International Registration of Trade Marks.

MARQUES supports improvements and changes to the Madrid System to enhance access to efficient and cost-effective protection of trade marks around the world. In particular, **MARQUES** is committed to ensuring that all brand owners (particularly those with an interest in European brands) can utilise the Madrid System.

For this reason, **MARQUES** looks with sympathy on requests to expand the working languages of the Madrid System, if it will facilitate businesses, particularly SMEs, using the Madrid System. However, **MARQUES** considers this would only be possible if the International Bureau is in a practical position to implement such a change without a detriment to users. We are concerned that, at the present time, expanding the working languages of the Madrid System could disadvantage brand owner users of the System by:

1. increasing the cost of administration of the Madrid System;
2. increasing the processing time of examination and translations, and a consequential slowing of granting of protection for brand owners; and
3. increasing the rate of errors or introducing legal uncertainty to the protection of marks under the International Registration regime.

MARQUES believes that, with the rapid improvement in technology allowing for accurate translation of various languages, any solution implemented by the International Bureau now would quickly become obsolete. **MARQUES** encourages Working Group participants to only consider introducing new working languages at a time when this can be done in a simple, cost-effective and safe manner.

Ideally the Madrid System would be easily accessible to users in all languages, but given the conditions set out above, **MARQUES** is cautious about expanding the working languages of the System. **MARQUES** considers that the immediate priority is to find ways to protect brands that are used in Latin and non-Latin scripts, and to increase access to the Madrid System by implementing a solution to this issue. **MARQUES** advocates to improve access to the Madrid System for brand owners with a "home" language in a non-Latin character script, including Cyrillic and Chinese languages as trade marks in scripts other than Latin should not be regarded as device marks.

MARQUES is of the view that the Madrid System should allow for marks in these circumstances to be considered identical for the purposes of designating Contracting Parties. This would greatly increase the utility of the Madrid System for countries where brand owners and users do not use Latin characters in their home language.

MARQUES attaches its proposal on the use of equivalents in non-Latin scripts along with examples of a transliterated trade mark for consideration by the Working Group, and for immediate ease of reference also a copy of its former comments on proposed improvements to the Madrid System of International registration of Trade Marks.

Yours faithfully,

27th July 2018

On behalf of **MARQUES**



Michael Leonard, Chair of **MARQUES** International Trade Mark Law and Practice Team

Enclosures: as above

MARQUES' further proposals for improving the Madrid System of International Registration of Trade Marks

On the occasion of bilateral talks with the World Intellectual Property Organisation since as early as the year 2016, **MARQUES** expressed to the International Bureau its willingness to contribute the discussion on potential improvements to the Madrid system of International Trade Mark Registrations. In view and ahead of the Fourteenth Session of the Madrid Working Group being held in Geneva **MARQUES** submitted to the International Bureau and participants in the Round Table an initial set of comments featuring proposed solutions to enhance the accessibility and attractiveness to right holders of the Madrid International trade mark system. A copy of that paper is attached hereto for ease of consideration.

These additional comments are now presented to outline **MARQUES'** proposed solution to handling the issues with scripts that are not Latin characters.

MARQUES proposes that a solution be considered to improve access to the Madrid system for those users whose home territory (and therefore the likely Office of Origin they would use for filing an International Registration) does not routinely use Latin script. The proposal also necessarily includes the extension of International Registrations in Latin script into non-Latin script countries thereby improving the position for all Madrid users.

It has long been understood that the Madrid system has disadvantages for users in non-Latin script territories who may wish to obtain protection for a basic mark in their local non-Latin script/language but seek protection for an equivalent version/transliteration of the mark in Latin (or other) script in certain designated territories under the corresponding International Registration. As the system currently operates, this is not possible because the vast majority of National Offices require that the International Registration and any designation thereunder must be identical to the basic mark in terms of their form. Only a very small number of Offices will consider a basic mark consisting of letters in a given script to correspond to an international mark that consists of a transliteration into other scripts. Thus, at present, affected users must (if using the Madrid system) file another application in Latin (or other) script in their home territory and use that as the basic mark, which increases the cost of accessing the Madrid system, and – in some countries – also potentially leaves the basic mark vulnerable to non-use cancellation proceedings during the dependency period. In fact, some members of the Madrid system have a use requirement term that is shorter than 5 years.

MARQUES therefore proposes a solution whereby “equivalent” marks (transliterations) will be treated as corresponding marks even though they may be written in different scripts. This solution would mean that users could file a transliteration of their basic mark during the International Registration process, and then use this corresponding mark for some or all of the designations, as follows:

- a. When filing an application for International Registration the applicant should be allowed to include other script versions of the trade mark in the form of transliteration(s).
- b. Only one transliterated version of the mark per script should be allowed.
- c. Only one script version of the mark should be used per designation and this must be clearly indicated in the International Registration application form (MM2).
- d. The applicant must include a certification or certifications by a certified translator when filing the International Registration. The examining office for the basic mark will not examine the transliteration or any certification.
- e. The certification(s) must certify that the script version(s) used for the International Registration are a correct or appropriate transliteration of the basic mark, i.e. there is the required degree of identity or equivalence.
- f. The certification(s) must be in the official language of the International Registration.
- g. There should be no requirement for legalisation of the certification(s).
- h. WIPO would forward the basic mark as well as the relevant script version together with the certification to the designated office(s).
- i. The designated office would examine only the script version of the trade mark that is indicated for the designation (Latin or local script).
- j. WIPO would publish in the Mark Monitor all versions of the mark and the certification(s), indicating clearly what script version is relevant for each designation.
- k. If a third party wished to challenge a transliteration, this would have to be done individually through the designated office concerned and would only concern that particular designation.

If these measures were to be put in place, a trade mark in Latin script would be considered the same as the transliterated trade mark for instance in Cyrillic, Arab or Thai script. Each relevant group of consumers would be presented with a pertinent local script version that they could easily understand, and all applicants would have equal access to the Madrid system. It would benefit all applicants, whether they are from Latin script countries or elsewhere.

In this context, we would like to mention that the practice of transliteration is familiar, and pursuant to Rule 9(4)(a)(xii) an applicant must file a transliteration of non-Latin script trade marks into Latin. Perhaps it would be possible to amend this Rule open for the above proposal.

For the information of the Working Group, we attach examples of a transliterated trade mark that we believe should be accepted in an International registration following the above proposal.

Examples of a trademark in different scripts

Latin

NUTELLA

Arabic

نوتيللا

Cyrillic

Нутелла

Hebrew

נוטלה

Katakana

ヌテラ

Korean

누텔라

Thai

นุเทลล่า