

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

Eighteenth Session
Geneva, October 12 to 16, 2020

NEW MEANS OF REPRESENTATION

Document prepared by the International Bureau

INTRODUCTION

1. At its seventeenth session, held in Geneva from July 22 to 26, 2019, the Working Group on the Legal Development of the Madrid System for the International Registrations of Marks (hereinafter referred to as “the Working Group”) discussed document MM/LD/WG/17/8. The document described possible amendments to Rule 9 of the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement that would give applicants the possibility to file an international application with new means of representing the mark. The document also discussed further practical and technical considerations regarding the said amendments.

2. Following the above-mentioned discussions, the Working Group requested that the International Bureau prepare a document, for discussion at its eighteenth session, proposing amendments to Rule 9 of the Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to, respectively, as “the Regulations” and “the Protocol”)¹. The proposed amendments should provide for new means of representing marks while introducing the necessary flexibilities that would allow applicants to meet different representation requirements in the designated Contracting Parties.

¹ See document MM/LD/17/11 “Summary by the Chair”, paragraph 25 (https://www.wipo.int/edocs/mdocs/madrid/en/mm_ld_wg_17/mm_ld_wg_17_11.pdf).

3. The Working Group also requested that the document discuss the role of the Office of origin in the certification of the representation of the mark in the international application and address the implications of the proposed changes in the information and communication technology infrastructure of the Offices and of the International Bureau. Finally, the Working Group requested that the document address ways to enhance access to information regarding acceptable types of marks and representation requirements in the Contracting Parties.

4. As requested by the Working Group, this document proposes amendments to the Regulations that would provide for new means of representing marks and discusses the matters related thereto referred to in the preceding paragraph. The proposed amendments to the Regulations are reproduced in the Annex to this document.

PROPOSED AMENDMENTS TO RULE 9 OF THE REGULATIONS PROVIDING FOR NEW MEANS OF REPRESENTATION AND CONSEQUENTIAL AMENDMENTS

5. It is proposed that Rule 9(4)(a)(v) of the Regulations be amended by eliminating the graphic reproduction requirement and introducing a representation requirement. The amended Rule would simply require that the international application contain or indicate a representation of the mark furnished in accordance with the Administrative Instructions for the Application of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as “the Administrative Instructions”).

6. The proposed amendments would benefit holders of non-traditional marks, for example, sound marks, moving marks or multimedia marks by allowing for new means of representation, without negatively affecting the large majority of holders of traditional marks who could continue to file international applications with a graphic representation (e.g., a picture or a drawing). Currently, only 66 of the more than 750,000 international registrations in force are for sound marks, while in 16 international registrations the holder described the mark as a position mark, in 12 of them as consisting of or containing a hologram and in four of them as being a pattern mark.

7. The proposed amendments to Rule 9 would, for example, give a holder whose basic mark is a sound mark represented by an electronic sound recording (e.g., an MP3 file) the possibility to file an international application with that representation. The International Bureau would be in a position to process the application, register the mark, publish and notify the international registration.

8. The Administrative Instructions would specify the acceptable formats and technical specifications for the representation of the mark, which would follow those recommended in the relevant WIPO standards. As required in the Regulations, the Director General of WIPO would establish the Administrative Instructions in consultation with the Offices of the Contracting Parties.

9. It is also proposed that Rule 9(4)(a)(v) of the Regulations be amended to eliminate the requirement to provide a second reproduction in color, when the reproduction in the basic application or basic registration is in black and white and color is claimed. In those cases, one representation of the mark in color, certified by the Office of origin, would be sufficient.

10. Finally, it is proposed that consequential amendments be made to:

- Rule 15(1)(iii) of the Regulations, concerning the effects on the date of the international registration of an irregularity related to the absence of the representation of the mark from the international application;

- Rule 17(2)(v) of the Regulations to require that, in a notification of provisional refusal, the Office of a designated Contracting Party either include a representation of the mark in a means that is acceptable to the Office or indicate how to access such representation;
- Rule 32(1)(b) of the Regulations, concerning the publication in the *WIPO Gazette of International Marks* (hereinafter referred to as “the Gazette”) of the representation of the mark furnished in accordance with Rule 9(4)(a)(v);
- Rule 32(1)(c) of the Regulations, that requires the publication of both black and white and color reproductions of the mark, which would be abolished as it would no longer apply; and,
- Items 2.1.1 and 2.1.2 of the Schedule of Fees, and to the corresponding footnote, concerning the basic fee prescribed for the international application.

THE ROLE OF THE OFFICE OF ORIGIN IN THE CERTIFICATION OF THE REPRESENTATION OF THE MARK

11. Article 3(1) of the Protocol requires that the Office of origin certify that the particulars in the international application “correspond” to those in the basic application or basic registration at the time of the certification. Where it concerns the mark, the Office of origin must certify that the mark in the international application “corresponds” to the mark in the basic application or registration.

12. The provision in Rule 9(5)(d)(iv) of the Regulations requires that the Office of origin certify that the mark that is the subject of the international application “is the same” as the mark in the basic application or registration. Some Contracting Parties have interpreted this Rule as requiring absolute identity between the reproduction of the mark in the international application and that in the basic application or registration. The said Rule and that interpretation go beyond what is required in Article 3(1) of the Protocol.

13. Based on the findings of a survey conducted in 2017², a significant number of Offices of origin exercise flexibility regarding the certification of the representation in the international application. For example, when the representation of the mark in the national register or database is a low-quality paper reproduction, those Offices would allow applicants to file an international application with a better-quality digital graphic representation of the mark. While the survey contains concrete examples illustrating that Offices exhibit varying degrees of flexibility, overall the findings underscore that most Offices would certify a representation that corresponds to the mark in the basic application or registration, without requiring absolute identity.

14. Therefore, it is proposed that Rule 9(5)(d)(iv) be amended by requiring that the Office of origin certify that the mark in the international application corresponds to the mark in the basic application or basic registration, instead of requiring it to certify that it is the same. This proposed amendment would align the Regulations with the Protocol and recognize that Offices may appropriately exercise flexibility in their certification function.

² Sixty Offices participated in the survey. Thirty-eight Offices replied that they would certify an international application with a clearer representation of the mark. Nine Offices replied that they would do so, depending on the circumstances. See document MM/LD/WG/15/RT/2 “Correspondence of Marks for Certification Purposes”, page 7 (https://www.wipo.int/edocs/mdocs/madrid/en/mm_ld_wg_15_rt/mm_ld_wg_15_rt_2.pdf).

PRACTICAL IMPLICATIONS OF THE PROPOSED AMENDMENTS

(A) PRACTICAL IMPLICATIONS FOR OFFICES OF THE CONTRACTING PARTIES

15. Some Offices, acting as the Office of origin, have developed their own paper forms, e-forms or e-filing solutions. Those Offices would have to determine whether changes to those forms or solutions are necessary to allow applicants to file an international application represented by non-traditional means by the time the proposed amendments enter into force.
16. As the Offices of the designated Contracting Parties, the Offices would have to determine whether non-graphical means of representation are acceptable under their applicable laws and practices. If they are acceptable, the Offices would need to determine whether changes to their infrastructure are necessary to process, publish and notify marks represented by these new means by the time the proposed amendments enter into force.
17. To facilitate the registration of marks represented by non-traditional means, Offices and the International Bureau would need to exchange communications electronically. Presently, this does not appear to be a problem because international applications and notifications of international registration, subsequent designation and of other recordings are now exchanged electronically in almost all cases.
18. In 2019, all the 91 Offices that transmitted an international application to the International Bureau did so electronically. Where it comes to communications other than the international application, 96 Offices transmitted most of them to the International Bureau electronically. In fact, 99 Offices have access to the Madrid Office Portal (MOP), a secure online platform to exchange communications with the International Bureau.
19. The International Bureau makes all notifications to the Offices of the designated Contracting Parties available on a File Transfer Protocol (FTP) server, as eXtended Markup Language (XML) data or as Portable Document Format (PDF) files, or both, along with an electronic representation of the mark, where applicable. Offices may also download the PDF files using MOP. In May 2020, only one Office still received a paper copy of the notifications sent by postal services, in addition to the copy made available on the FTP server and MOP as a PDF file.
20. Finally, most holders are now transmitting communications to the International Bureau by electronic means, a trend that is likely to be reinforced because the International Bureau plans to make available online forms for all requests for recording in the future.
21. In view of the above, when the proposed amendments to the Regulations enter into force, the Administrative Instructions would specify that, in accordance with Rule 2 of the Regulations, communications to the International Bureau must be addressed by electronic means only.
22. The above would only mean that users of the Madrid System could no longer address communications to the International Bureau by postal mail. All users could continue to address communications to the International Bureau using the Contact Madrid online platform. Holders could continue to present their requests for recording by downloading, completing, scanning and uploading the paper forms, as PDF files, using Contact Madrid. In the future, they will also be able to present all those requests using online forms. Offices could continue to send documents, as PDF files, and other electronic files to the International Bureau through MOP or the FTP services. They could also continue to send XML data through the FTP server.

(B) PRACTICAL IMPLICATIONS FOR THE INTERNATIONAL BUREAU

23. The International Bureau would promptly update the international application paper form (MM2), the Madrid Filing Assistant and its e-filing solution to conform to the new prescribed requirements. Offices receiving international applications in the MM2 form or using the International Bureau's e-filing solution would then be able to receive international applications under the proposed amendments.

24. The International Bureau is able to receive, manage and transmit electronic representations of the mark. Until now, those have been electronic graphic representations only (e.g, pictures). Nevertheless, the processes would be the same for any electronic representation of the mark.

25. The International Bureau would be required to adapt its online publication and information services to make non-graphic representations of the mark accessible to the public. For example, where the representation consists of a digital recording of a sound or moving images, the Gazette and the Madrid Monitor would have to provide for an online mechanism to reproduce that recording. In addition, the International Bureau would need to adapt its internal processing systems for the same purpose. Taking into account already planned work priorities, the International Bureau estimates that it needs two years to develop, test and deploy the required changes to its services and systems.

26. The International Bureau would continue to include a representation of the mark in the certificate of registration and renewal and in the notification of the international registration transmitted to the designated Contracting Parties. Where the representation consists of an image or characters, the said documents would continue to include a reproduction of the mark. Otherwise, the documents would include an address on the WIPO Website, where all interested parties could access the representation of the mark.

27. Finally, as requested by the Working Group, the International Bureau would continue to maintain, update and improve its Member Profiles Database to enhance access to information regarding acceptable types of marks and representation requirements in the Contracting Parties of the Madrid Protocol.

POSSIBLE FUTURE AMENDMENTS TO THE REGULATIONS INTRODUCING FLEXIBILITIES ALLOWING USERS TO MEET REPRESENTATION REQUIREMENTS IN THE DESIGNATED CONTRACTING PARTIES

28. Under the proposed amendments to the Regulations, holders who file an international application with a non-graphic representation of the mark might be unable to obtain protection in the several Contracting Parties that continue to require a graphic representation of the mark. The same would occur when an applicant files an international application with a graphic representation and designates Contracting Parties that require a non-graphic representation for the type of mark that is the subject of the application. The above could result in a provisional refusal that the holder might not be able to overcome.

29. While the Working Group requested that this document also propose amendments to the Regulations introducing flexibilities allowing users to meet various representation requirements, the Working Group may wish to discuss further the implications and effectiveness of introducing such flexibilities.

30. As a possible solution, the Working Group may wish to consider whether allowing for a second representation of the mark also furnished in accordance with the Administrative Instructions would be beneficial for holders who find themselves in the situations described above, as it might allow them to meet different representation requirements in the designated Contracting Parties.

31. The Office of origin would not be required to certify the second representation of the mark. As a practical matter, most Offices of origin would be unable to certify a mark represented by means which are not accepted by the Office. For example, an Office that requires a sound mark to be represented by musical notation might not be able to certify the same mark represented by a digital sound recording.

32. Offices of the designated Contracting Parties, while not required to do so, could take into account the second representation of the mark to determine whether it meets the prescribed requirements and grant or refuse protection to the mark in accordance with their applicable laws. When doing so, the Office could assess the second representation of the mark against the representation certified by the Office of origin. Further, the Office might require or the holder could provide additional elements to help the Office make that assessment, such as, for example, a voluntary description of the mark.

33. There may be concerns as to whether allowing for a second representation of the mark might introduce legal uncertainty and questions as to whether it would be an effective solution to the problem at hand. However, this could be the only practical solution for avoiding provisional refusals when attempting to obtain protection in Contracting Parties with different representation requirements.

DATE OF ENTRY INTO FORCE OF THE PROPOSED AMENDMENTS

34. Provided they meet with the approval of the Working Group, it is suggested that proposed amendments to Rules 9, 15, 17 and 32 of the Regulations and to Items 2.1.1 and 2 of the Schedule of Fees enter into force on February 1, 2023.

35. *The Working Group is invited to:*
- (i) consider the proposals made in this document; and,*
 - (ii) recommend to the Madrid Union Assembly the adoption of the proposed amendments to the Regulations, as presented in the Annex to this document or in amended form, and their entry into force on February 1, 2023.*

[Annex follows]

PROPOSED AMENDMENTS TO THE REGULATIONS UNDER THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS AND CONSEQUENTIAL AMENDMENTS TO THE SCHEDULE OF FEES

Regulations Under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks

as in force on ~~February 1, 2020~~ February 1, 2023

[...]

Chapter 2 **International Applications**

[...]

Rule 9 **Requirements Concerning the International Application**

[...]

(4) *[Contents of the International Application]*

(a) The international application shall contain or indicate

[...]

(v) a ~~reproduction~~representation of the mark, furnished in accordance with the Administrative Instructions, 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~~shall be in color where color is claimed under item (vii),

[...]

(vii) where color is claimed as a distinctive feature of the mark in the basic application or basic registration, or where the applicant wishes to claim color as a distinctive feature of the mark and the mark contained in the basic application or basic registration is in color, an indication that color is claimed and an indication by words of the color or combination of colors claimed ~~and, where the reproduction furnished under item (v) is in black and white, one reproduction of the mark in color,~~

[...]

(5) *[Additional Contents of the International Application]*

[...]

- (d) The international application shall contain a declaration by the Office of origin certifying

[...]

- (iv) that the mark that is the subject matter of the international application ~~is the same as~~ corresponds to the mark in the basic application or the basic registration, as the case may be,

[...]

[...]

[...]

Chapter 3
International Registrations

[...]

Rule 15
Date of the International Registration

- (1) *[Irregularities Affecting the Date of the International Registration]* Where the international application received by the International Bureau does not contain all of the following elements:

[...]

- (iii) a ~~reproduction~~ representation of the mark,

[...]

[...]

Chapter 4
Facts in Contracting Parties Affecting International Registrations

[...]

Rule 17
Provisional Refusal

[...]

(2) *[Content of the Notification]* A notification of provisional refusal shall contain or indicate

[...]

- (v) where the grounds on which the provisional refusal is based relate to a mark which has been the subject of an application or registration and with which the mark that is the subject of the international registration appears to be in conflict, the filing date and number, the priority date (if any), the registration date and number (if available), the name and address of the owner, and a ~~reproduction,~~representation of the former mark or an indication of how to access that representation, together with the list of all or the relevant goods and services in the application or registration of the former mark, it being understood that the said list may be in the language of the said application or registration,

[...]

[...]

Chapter 7
Gazette and Data Base

Rule 32
Gazette

(1) *[Information Concerning International Registrations]*

[...]

- (b) The ~~reproduction,~~representation of the mark shall be published as it ~~appears~~was furnished in the international application. Where the applicant has made the declaration referred to in Rule 9(4)(a)(vi), the publication shall indicate that fact.
- (c) ~~[Deleted]Where a color reproduction of the mark is furnished under Rule 9(4)(b)(v) or (vii), the Gazette shall contain both a reproduction of the mark in black and white and the reproduction in color.~~

[...]

Schedule of Fees

as in force on ~~February 1, 2020~~ February 1, 2023

Schedule of Fees

Swiss francs

1. [Deleted]

2. *International application*

The following fees shall be payable and shall cover 10 years:

2.1. Basic fee (Article 8(2)(i) of the Protocol)*

2.1.1. where no ~~reproduction~~representation of the mark is in color 653

2.1.2. where any ~~reproduction~~representation of the mark is in color 903

[...]

[End of Annex and of document]

* For international applications filed by applicants whose country of origin is a Least Developed Country, in accordance with the list established by the United Nations, the basic fee is reduced to 10% of the prescribed amount (rounded to the nearest full figure). In such case, the basic fee will amount to 65 Swiss francs (where no ~~reproduction~~representation of the mark is in color) or to 90 Swiss francs (where any ~~reproduction~~representation of the mark is in color).