

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

**Nineteenth Session Geneva,
November 15 to 19, 2021**

Founded in 1934, chartered in 2016, The Chartered Institute of Trade Mark Attorneys (CITMA) is a UK-based professional membership organisation representing the interests of over 1,600 trade mark and design legal professionals. Our community of members includes Chartered Trade Mark Attorneys, those in training and support roles, and barristers and solicitors with an interest in trade marks or designs.

In preparation of the forthcoming Madrid Working Group meeting, CITMA welcomes the opportunity to provide the following comments:

1. [MM/LD/WG/19/3](#) and [MM/LD/WG/19/INF/1](#) - Provisional refusal (clear indication of the required response date)

CITMA refers to the Joint Statement [MM/LD/WG/18/JOINT STATEMENT PROVISIONAL REFUSAL](#) submitted on this topic by CITMA and other sister organisations (AIM, APRAM, ECTA and MARQUES) as co-signatories in 2020. Having an exact date as the deadline to reply to a provisional refusal would significantly improve user's confidence in the Madrid system.

Calculating time limits from the date on which the International Bureau transmits the notification to the holder could be beneficial. While harmonisation of the notification time limits is ideal to avoid either the very short or very long deadlines that exist now, we ask for implementation of an immediate interim solution (hopefully without delay), where the International Bureau would make the calculations and provide an exact date as the required response date.

As regards the potential risk of miscalculating a deadline, all participating Offices should accept calculations made by the International Bureau as transmitted to applicants and holders of International Registrations.

2. [MM/LD/WG/19/4](#) - Proposed Amendments to the Regulations

CITMA supports the proposed changes to the Regulations:

- Prescribing the use of a form when recording a representative,
- Removing (for editorial purposes) the references to paragraphs (2) and (3) in paragraph 5 of Rule 5 since paragraphs (2) and (3) had been deleted, and
- A longer renewal period of 12 months (instead of 3 months).

3. [MM/LD/WG/19/5](#) - Dependency

In anticipation of this topic being scheduled for discussion for the Working Group in 2020, CITMA conducted a survey then among its members. The survey results showed

support to reduce the dependency period from 5 to 3 years. However, the survey results didn't show support to the possible reduction of the grounds for cancellation of an international registration due to the ceasing of effect of the basic mark or the elimination of the automatic effect of dependency.

4. MM/LD/WG/18/8 - Proposal by the Delegation of Switzerland (limitations in international applications)

Without having a recommendation of who should carry out this duty, CITMA agrees that Offices should verify that a limitation in the description of goods and services is covered both by the description of goods and services for the underlying mark and in the international registration.

5. MM/LD/WG/19/7 - introduction of the Arabic, Chinese and Russian languages into the Madrid System

CITMA are broadly in support of the introduction of Arabic, Chinese and Russian as new working languages.

As a user association, we naturally do not want increased costs or delays but do feel, if introduced carefully, that the introduction of these languages as working languages could prove to be advantageous for users.

Users do not want additional delays. An additional delay of five days is, in our view, not significant but we feel the International Bureau should strive to avoid any additional delays.

As the International Bureau says, those offices not using the English, French or Spanish languages translate applications into their own language (e.g. Chinese) for examination purposes, and, at the end of the process, the Office translates it back into English, French or Spanish for the purpose of notifying the International Bureau. We invite the International Bureau to undertake a consultation on whether this internal translation process conducted by these Offices take longer than five days overall¹. We suggest these consultations take place with Offices that use Arabic, Chinese or Russian, namely:

- Algeria
- Armenia
- Azerbaijan
- Bahrain
- Belarus
- China
- Egypt
- Kazakhstan
- Kyrgyzstan
- Morocco
- Oman

¹ We recognise that any delay here comes out of the Office's 12 or 18-month examination period, whereas any delay from the International Bureau is additional

- Russian Federation
- Sudan
- Syrian Arab Republic
- Tajikistan
- Tunisia
- Uzbekistan

We also expect, as was the catalyst to add Spanish as a working language, the International Bureau to have information on how the addition of Arabic, Chinese and Russian as working languages would have at attracting new member states.

It feels like the International Bureau is envisaging, and what would be an improvement, would be to get English translations of notifications in other working languages, where English is the filing language. This would actually be an improvement as, for example, Mexican Provisional Refusals are not currently translated from Spanish to English, Swiss Provisional Refusals are not translated from French to English, etc. Of course, English notifications are not currently translated to French or Spanish either.

We feel that having the Chinese Office issuing notifications in Chinese could be useful for enforcement purposes. Currently, to enforce a Chinese designation of an International Registration requires users to go the time and expense of ordering Certified Copies from the Chinese Office. We would like this point clarified with the Chinese Office.

We would expect the International Bureau to continue developing their tools that allow for the automatic translation of specifications of goods and services. Notwithstanding this, it is important that translations are of a high quality and it is noted that many specifications use terms not included in a database and that can be automatically translated, and the use of a comma over a semi-colon, for example, although appearing subtle can result in a fundamental change of meaning. We have concerns of a reliance on automated translation will result in poor quality translations. With External Offices already in Algeria, China and the Russian Federation, we feel there is potential for the International Bureau to cost-effectively handle translation work so that no additional fees are passed on to users.

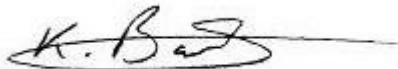
We have experienced errors in translation for the current working languages so we have some apprehension regarding translations and must reiterate our concerns that a reliance on automated translation will result in poor quality translations. Receiving Provisional Refusals from contracting parties because specifications have been mistranslated should be minimised. We do recognise that genuine errors will occur. We would propose exploration of an easy-to-use mechanism for users and designated Offices to *ex officio* request corrections to translations.

As a user association, we are against fee increases and support WIPO efforts to keep translation costs controlled. There actually seems to be potential for lower fees for those national Offices that work in Arabic, Chinese or Russian to lower individual fees

as they will not have to perform internal translation (e.g. from English) so their workload and processes are reduced.

Overall, we want to see continued improvements to the system without additional costs or delays. While we would anticipate there being some additional delays in the beginning, we see potential that adding Arabic, Chinese and Russian as working languages would deliver improvements in time.

For and on behalf of the Chartered Institute of Trade Mark Attorneys

A handwritten signature in black ink, appearing to read 'K. Bader', with a horizontal line extending to the right.

Keven Bader
Chief Executive

11th November 2021