

INTA comments to the proposal for the introduction of the Arabic, Chinese and Russian languages into the Madrid System for the International Registration of Marks

Upon the International Bureau's request, the International Trademark Association (INTA) is providing comments to the proposal for the introduction of Arabic, Chinese and Russian languages into the Madrid System for the International Registration of Marks. INTA appreciates the opportunity to weigh into this important discussion and expresses that it is a preliminary view which may be reviewed based on the advancement of the discussions at the World Intellectual Property Organization (WIPO). These comments were prepared by INTA's Madrid System Subcommittee.

INTA Recommendations

INTA takes note of the discussions between WIPO and the "demanders". In this connection, the Association cannot take a position on the subject matter until the following issues are addressed:

- i. There should be no increase in official fees for users of the system.
- ii. Communications issued in Russian, Chinese and Arabic should not lead to additional administrative burden for users of the system (other than the possible cost of translation, although that should be avoided- discussed further below). Key information, including the date of notification, the deadline for a response, and the method for filing a response should be clear and easily identifiable for users.
- iii. The introduction of the new working languages should not discourage or add hurdles for new members to become part of the Madrid system in the future.
- iv. The communications introduced in the new working languages should be translated into any one of the existing full working languages.
- v. The additional burden to the applicant of having to receive communication in 6 different languages rather than 3 should be offset by key service enhancements/benefits. These are outlined below:
 - o INTA supports WIPO making it a mandatory requirement for Offices to use its standard forms and templates for issuing communications so all applicants can easily identify key information.
 - o The method for applicants to respond to communications should be simplified. For example, there should be a check box "accept" option to accept an

examiner's proposal to overcome an official action (and a similar "reject" option).

- Notifications should be issued in a format that facilitates the applicant's use of a public machine translation tool.
- The introduction of new languages should significantly speed up the timeline for examination of designations in countries where Russian, Chinese and Arabic are the official languages used by the offices.
- Registration certificates and statements of grant of protection should be issued in time and commercially efficient manner for users of the system.

Other Considerations

Clearance searches/accessibility of WIPO register to non-speakers of Arabic, Chinese and Russian

Users need to be able to review international registrations and understand the stage that the rights are at whilst conducting clearance searches. Having information in Arabic, Chinese and Russian will make it cumbersome to review and readily translate the information for users from Roman language backgrounds.

Making the system more cost effective and accessible may clutter the registers

Opening the system to make it cheaper and easier to obtain global rights, creates another cost for brand owners. As the register becomes more cluttered with unused and unwanted marks then users need to commit more time and cost in challenging and removing obstacles to their own registrations.

Deadlines

The national offices will need to allow enough time to respond to official communications as users may need extra time to arrange translations of decisions.

There are some challenges with this as it may require changes to domestic legislation.

Quality of decisions issued

The quality of decisions issued may improve and there may be more consistency amongst examiners and in the examination process if examiners in national offices can issue decisions in their own languages.

WIPO offers templates to national offices to issue standardised information to users when issuing decisions but these are not used by all offices.

Floodgates to other languages

Opening the system to Arabic, Chinese and Russian will create a floodgate for additional languages (such as Japanese, Korean and Portuguese) to be considered full working languages.

Introduction of one language at a time

It would be a smoother transition if WIPO opens the system up to one additional language first.

Integration of computerised translation

If communications could be issued in Arabic, Chinese and Russian, then it would be reasonable to fully integrate a computerised translation system into Madrid Monitor so that the system would still be accessible to all users. There was a suggestion for a translation system akin to the PCT translation database.

Speed of decisions

If offices can issue decisions in their own languages then as well as better quality decisions being issued, this may encourage offices to issue decisions more quickly. This is in the interests of brand owners as often there is a compelling commercial reason for users to obtain a registration more quickly. At the moment, if some users wish to litigate promptly then they file via the national route rather than via WIPO for some key jurisdictions.

Consensus for implementation

Provided that a consensus is reached between member states (and no one country refuses the change) then Arabic, Chinese and Russian will be implemented on the basis agreed (with a timeline to be confirmed).

About INTA

The International Trademark Association (INTA) is a global association of brand owners and professionals dedicated to supporting trademarks and related intellectual property (IP) to foster consumer trust, economic growth, and innovation. Members include nearly 6,500 organizations, representing more than 34,350 individuals (trademark owners, professionals, and academics) from 185 countries, who benefit from the Association's global trademark resources, policy development, education and training, and international network.

Founded in 1878, INTA, a not-for-profit organization, is headquartered in New York City, with offices in Brussels, Santiago, Beijing, Singapore, and Washington, D.C., and a representative in New Delhi.

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