

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

Twenty-Second Session
Geneva, October 7 to 11, 2024

PROPOSAL BY THE DELEGATIONS OF BRAZIL, CABO VERDE, GERMANY, JAPAN, MOZAMBIQUE, PORTUGAL AND SAO TOME AND PRINCIPE

Document prepared by the Secretariat

1. In a communication dated September 6, 2024, the International Bureau received a proposal from the Delegations of Brazil, Cabo Verde, Germany, Japan, Mozambique, Portugal and Sao Tome and Principe concerning a possible implementation option for introducing new languages into the Madrid System for the International Registration of Marks for consideration by the Working Group on the Legal Development of the Madrid System for the International Registration of Marks, at its twenty-second session to be held in Geneva from October 7 to 11, 2024.
2. The said proposal is annexed to this document.

[Annex follows]

**PROPOSAL BY THE DELEGATIONS OF BRAZIL, CABO VERDE, GERMANY, JAPAN,
MOZAMBIQUE, PORTUGAL AND SAO TOME AND PRINCIPE**

**ANNEX I: POSSIBLE IMPLEMENTATION OPTION
FOR INTRODUCING NEW LANGUAGES INTO THE MADRID SYSTEM**

I. INTRODUCTION

1. The purpose of this document is to propose a temporary implementation option for introducing new languages into the Madrid System for consideration by the Working Group on the Legal Development of the Madrid System for the International Registration of Marks (hereinafter referred to as “the Madrid System”).

2. This proposal does not intend to rule out the future adoption of the fully fledged working language option. By taking into account concerns and issues raised during past sessions of the Working Group, it is to present a possible option to ease additional burden placed on users caused by the increase in the number of official languages of the Madrid System.

II. BACKGROUND

3. At its seventeenth session, held in Geneva from July 22 to 26, 2019, the Working Group discussed document [MM/LD/WG/17/7 Rev.](#), which suggested five possible implementation options for introducing new languages into the Madrid System, namely, the filing language option, the processing language option, the transmission language option, the communication language option, and the working language option.

4. At its eighteenth session, held in Geneva from October 12 to 16, 2020, the International Bureau proposed the introduction of new languages as filing languages, in view of the complexity of the changes to the ICT systems and of the possible financial implications (document [MM/LD/WG/18/5](#)). However, there are countries which requested the introduction of their languages as working languages (document [MM/LD/WG/18/10](#)). During the informal consultations conducted by the International Bureau following the eighteenth session, Arabic, Chinese and Russian were requested to be treated on an equal footing with English, French and Spanish (paragraph 36 of document [MM/LD/WG/19/7](#)).

5. Some delegations and observers expressed concerns about the possible adoption of the working language option during informal consultations conducted by WIPO and during the Working Group sessions (paragraph 60 of document [MM/LD/WG/21/7](#)). One of the issues is that the holders of international registration receive communications, particularly notifications of provisional refusal, in new languages that are unfamiliar to certain users from the Offices of some designated Contracting Parties. This could mean additional burdens for the holders and third parties who use the Madrid Monitor for monitoring and searching purposes (paragraph 77 of document [MM/LD/WG/21/7](#)).

6. On the one hand, the introduction of new working languages would improve the accessibility of the Madrid System in respect of communications between respective users and the Office of origin or the International Bureau. On the other hand, it could potentially diminish the attractiveness of the System in respect of communications from certain designated Contracting Parties: Users currently deal with as few as three languages when receiving and understanding communications from the Offices of designated Contracting Parties, which is one of pros of the Madrid System when compared to the direct filing route. However, the introduction of new working languages used in communications from designated Contracting Parties means that users could incur additional costs when dealing with them.

7. The contents¹ of notifications of provisional refusal are currently not translated. The International Bureau suggested it could make available machine-translated versions of these notifications in the language chosen by the holder in order to facilitate the understanding of the notifications. However, it is suggested that these versions are translations which would not be subject to post-editing (paragraphs 59, 68, 69 of document MM/LD/WG/21/7).

8. Some would expect that machine-translation technologies will evolve as time goes by and that the evolution will enable sufficiently good accuracy, quality and consistency of machine-translation output so that parties will be able to start to accept the use of the technologies in the framework of the Madrid System. At this point or in the near future, however, there are or will be concerns about accuracy, quality, and consistency in available machine translations.

9. Examples of the working language option is illustrated in Annex II.

III. IMPLEMENTATION OPTION FOR INTRODUCING NEW LANGUAGES

A. Proposal of “International Registration Language Option”

Overview of the international registration language option

10. To alleviate the concerns mentioned above, a new temporary option described below could be worth considering. The option proposed in this document is hereinafter referred to as the “international registration language option” to differentiate it from the previously proposed options (see paragraph 3).

11. Under the international registration language option, new languages are introduced into all stages of the Madrid System, except for communications between the International Bureau and the Offices of designated Contracting Parties, such as notifications of provisional refusal.

(a) Languages used for communications

Whether new languages are used or not depends on who (the applicant or holder, the Office of origin, the International Bureau, and the Office of a designated Contracting Party) communicates with whom (see Figure 1, below). When the Office of a designated Contracting Party is an addresser or addressee, in principle², only the three existing languages are used. For other communications, not only the existing languages but also new languages are used.

For example, when submitting a request for subsequent designation and requests for the recording of various changes in the international registration, as is the case today, the holder can select either the language that was used for filing an application or one of the other (existing or new) languages.

¹ For the content of the notification of provisional refusal, please refer to Rule 17(2).

² See also paragraph 14 and footnote 8 for additional arrangements.

Figure 1: Languages used for communications

		Addressee			
		AP/H ³	O/O ⁴	IB	O/dCP ⁵
Addresser	AP/H		Existing or New Languages	Existing or New Languages	
	O/O	Existing or New Languages		Existing or New Languages	
	IB	Existing or New Languages	Existing or New Languages		Only Existing Languages or possibly New Languages ⁶
	O/dCP			Only Existing Languages or possibly New Languages ⁷	

(b) Languages used for recording and publication

The three existing languages and new languages are used for recording in the International Register and publication in the Gazette.

(c) Translation

The International Bureau makes translations necessary for communications referred to in (a) and recording and publication referred to in (b).

12. Possible examples of the international registration language option are illustrated in Annex II. In order to incorporate this option into the Regulations, modifications to Rule 6 would be required. Possible modifications are presented in Annex III with explanatory comments.

Limited use of new languages in communications to/from designated Contracting Parties

13. Bearing in mind that multilingualism must not increase burden on users and that there are concerns about machine-translation technologies among users at this point (see paragraphs 5 to 9), the international registration language option could be a good temporary solution. The option enables applicants or holders to use the new language when filing an international application and subsequent requests for recording and monitoring international registrations, whereas it continues to limit the maximum number of languages that holders would have to deal with to the three existing languages in respect of notifications from designated Contracting Parties, regardless of whether they use the new language or not.

³ Applicants and the holders of international registrations are referred to as "AP/H" in the chart.

⁴ The Office of origin is referred to as "O/O" in the chart.

⁵ The Office of a designated Contracting Party is referred to as "O/dCP" in the chart.

⁶ See paragraph 14 and footnote 8 for additional arrangements.

⁷ See paragraph 14 and footnote 8 for additional arrangements.

14. The international registration language option would integrate new languages into almost all the stages of the Madrid System, except for communications between the International Bureau and the Offices of designated Contracting Parties. In the special and limited cases where a new language is used in both the country of origin and the country of designation, it might be worth considering additional arrangements for the Offices of designated Contracting Parties to communicate with the IB in a new language under certain conditions⁸.

15. It does not close the door for the future adoption of the working language option. When the progress of machine-translation technologies guarantees reliable quality and consistency of translation in the framework of the Madrid System, it could be expected that more members will gradually accept and support the use of such technologies for communications to/from the Offices of designated Contracting Parties.

Advantage of the introduction of new languages in the International Register

16. As recording in the International Register and publication in the Gazette are made in the three existing languages as well as new languages, there are other advantages of the international registration language option over the other implementation options except the working language option, as described in paragraphs 17 to 20.

17. Under the international registration language option, the holder of the international registration can use a new language in which the holder filed an application for submitting a request for subsequent designation and requests for the recording of various changes in the international registration, including requests for a recording of a limitation of the list of goods and services and a request for recording a change in ownership⁹. Under the other implementation options except for the working language option, the holder could not use a new language when submitting these requests.

18. In addition, it would be preferable for users who speak possible new languages to watch data collection on their international registrations or search and monitor others' international registrations that are available in the Madrid Monitor in their languages.

19. The availability in new languages of official data on international registrations would also be beneficial for administrative and judicial proceedings in certain designated Contracting Parties where new languages are used (see paragraph 73 of document MM/L/WG/21/7).

20. Furthermore, even if the Office of a designated Contracting Party whose local language is one of possible Madrid new languages receives a notification of designation in English, French or Spanish, the Office could refer to and benefit from higher-quality and consistent translations into the new languages that would be prepared by the International Bureau, which would be available to the public in the Madrid Monitor, during examination (see paragraphs 54 to 55 of document MM/L/WG/21/7). This could benefit users who designate such Contracting Parties, too.

B. Other Matters to Consider; Questions about Non-Latin Characters

21. There are other matters that need to be considered and decided by the Working Group before introducing new languages. Although Latin characters and Arabic numerals are used under the current trilingual regime (English, French and Spanish), neither Latin characters nor Arabic numerals are used in some other languages. If such languages are introduced, some

⁸ Under such an additional arrangement, it might also be worth considering ways to alleviate burdens relating to third-party monitoring in the new language, such as providing translations.

⁹ The holder can also select the language that was used by the Office of a certain designated Contracting Party for the notification of provisional refusal of protection, instead of the language in which the holder filed the application.

adjustments would need to be made¹⁰. From the perspective of feasibility and convenience for all the parties of the Madrid System, some restriction to the use of non-Latin characters and non-Arabic numerals might be necessary, unless good solutions are found.

22. In order to assess the necessity of such restrictions, the following questions could be posed to the members of the Working Group and the International Bureau.

(a) Questions on the transliteration of the name and address of a natural person or legal entity:

1. (i) Where an international application or a request for the recording of changes, such as change in ownership, change in the name or address of a holder or representative, contains the name and address in non-Latin characters and non-Arabic numerals, could the International Bureau provide their correct transliterations for recording them in the other languages in the International Register¹¹?
2. (ii) If (i) is not feasible, are the Offices of designated Contracting Parties and third parties confident of identifying the natural person or legal entity in non-Latin characters from another person or legal entity? Could the IT systems in these Offices accommodate non-Latin characters and non-Arabic numerals?
3. (iii) If (i) and (ii) are not feasible, is it better to require those names and addresses to be indicated only in Latin characters and Arabic numerals, even when an international application or a request for the recording of changes is filed in languages that use non-Latin characters and non-Arabic numerals? To reflect this requirement on the Regulations and the Administrative Instructions, modifications to Rule 6 and Section 12 would be necessary (see Annex III for possible modifications to Rule 6 and Section 12).

(b) Questions on the transliteration of the mark:

The current Rule 9(4)(a)(xii) provides that “where the mark consists of or contains matter in characters other than Latin characters or numbers expressed in numerals other than Arabic or Roman numerals, (the international application shall contain or indicate) a transliteration of that matter in Latin characters and Arabic numerals; [...]”.

Technical feasibility to transliterate any non-Latin characters into Latin characters and vice versa is not certain. However, it might be easier and simpler for all the relevant parties of the Madrid System to always have non-Latin characters transliterated into Latin characters, and not the other way around.

To maintain the current requirement, some adjustments to Rule 9(4)(a)(xii) would still be necessary, as the rule includes the text “the transliteration into Latin characters shall follow the phonetics of the language of the international application” (see Annex III for possible adjustments to Rule 9(4)(a)(xii), which follow the proposal made by the International Bureau in Annex III of document [MM/LD/WG/18/5](#)).

¹⁰ Some of these adjustments would need to be made not only under the international registration language option but also the other implementation options.

¹¹ For instance, Japanese characters could be pronounced in various ways. The following characters for the name of a Japanese person could be transliterated as “INAMI Shoko”, “IHA Akiko”, “IBA Sachiko”, and so on. Without learning how it is actually pronounced, the correct transliteration could not be provided.

(c) Questions on the legal nature of a legal entity:

According to the Madrid Member Profiles, many designated Contracting Parties require the indication of the legal nature of a legal entity. Under the current practice, the Madrid Monitor does not show legal natures in all the three language versions.

(i) When the legal nature is given in a new language in an application or another subsequent request, can the International Bureau provide the other official language versions of the legal nature so that they are recorded in the International Register in all the official languages and notified to each designated Contracting Parties?

(ii) If (i) is not easy, it could be suggested that a legal nature is provided in one of the three existing languages even if an international application or a request is submitted in a new language. Otherwise, there would be a possibility that designated Contracting Parties could receive a legal nature in a new language that uses non-Latin characters. It might be problematic for some Offices in relation to their national requirements and practices as well as accommodating such characters in their IT systems.

If the relevant parties in the framework of the Madrid System prefer to have such legal natures given only in one of the current three languages or only in Latin characters, the introduction of new languages would require Rule 9(4)(b)(ii) to be modified. To serve as food for thought, possible modifications to Rule 9(4)(ii) are presented in Annex III.

(d) Questions on the translation of the mark:

The current Rule 9(4)(b)(iii) provides that where the mark consists of or contains a word or words that can be translated, (the international application may also contain) a translation of that word or those words into English, French and Spanish, or in any one or two of those languages¹². However, under the current Madrid System, designated Contracting Parties could not require the mark to be translated into languages other than English, French and Spanish. Therefore, the question would be whether the members of the Working Group could agree not to modify Rule 9(4)(b)(iii).

To assess a possible impact brought by the introduction of new languages, the Working Group might have to see the capacity of the Offices of origin. As a result of the introduction of new languages, some of the Offices of origin whose own IT systems process international application data might need to adapt their systems so that their applicants could include, in their international application, the translations into new languages, some of which would use non-Latin characters. Figure 2 illustrates the possible MM2(E) form to accommodate the translations into new languages.

¹² A request for subsequent designation may also contain the translation of the mark (Rule 24(3)(c)(i)).

Figure 2: Example of the possible MM2(E) form

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INTERNATIONAL REGISTRATION UNDER THE MADRID PROTOCOL
9. MISCELLANEOUS INDICATIONS

(b) Translation of the mark (as it may be required for certain designations; **do not** check the box in item (c) if you provide a translation):

(i) into English:

(ii) into French:

(iii) into Spanish:

(iv) into a new language :

Non-Latin scripts could be provided to translate the mark into the new language.

C. Possible Modifications to the Regulations and the Administrative Instructions

23. Possible modifications to the Regulations and the Administrative Instructions are presented in Annex III, together with explanatory comments. As suggested in some of the comment sections, further modifications might be necessary as a result of these possible modifications. For instance, another question would be whether the official form for the claim of seniority of an earlier mark that is referred to in Rule 9(5)(g)(i) could be in new languages or not. If not, a further modification to the Regulations would be required.

24. It would be desirable that the Working Group invite the Secretariat to study further modifications to the Regulations and the Administrative Instructions based on Annex III.

IV. ADDITIONAL CONDITIONS TO BE MET FOR THE INTRODUCTION OF ANY NEW LANGUAGES

25. The way how a new language is introduced must be user-oriented. What have been heard during the informal consultations before the twenty-first session of the Working Group includes

- (i) No increase in fees;
- (ii) Highest quality of translation with safeguards against possible translation errors referred to in Rule 28¹³; and
- (iii) Timely processing of requests and notifications

¹³ For an explanation about a request for correction made under Rule 28, see paragraphs 61 to 64 of document [MM/LD/WG/21/7](#).

26. The International Bureau and the Contracting Parties would have to cooperate with a view to meeting these conditions to find and implement possible solutions including the enrichment of terminology database to achieve at least the same rate of automatic-translation as 70 to 75 percent maintained under the current trilingual regime (see footnote 6 and paragraph 52 of document MM/LD/WG/21/7).

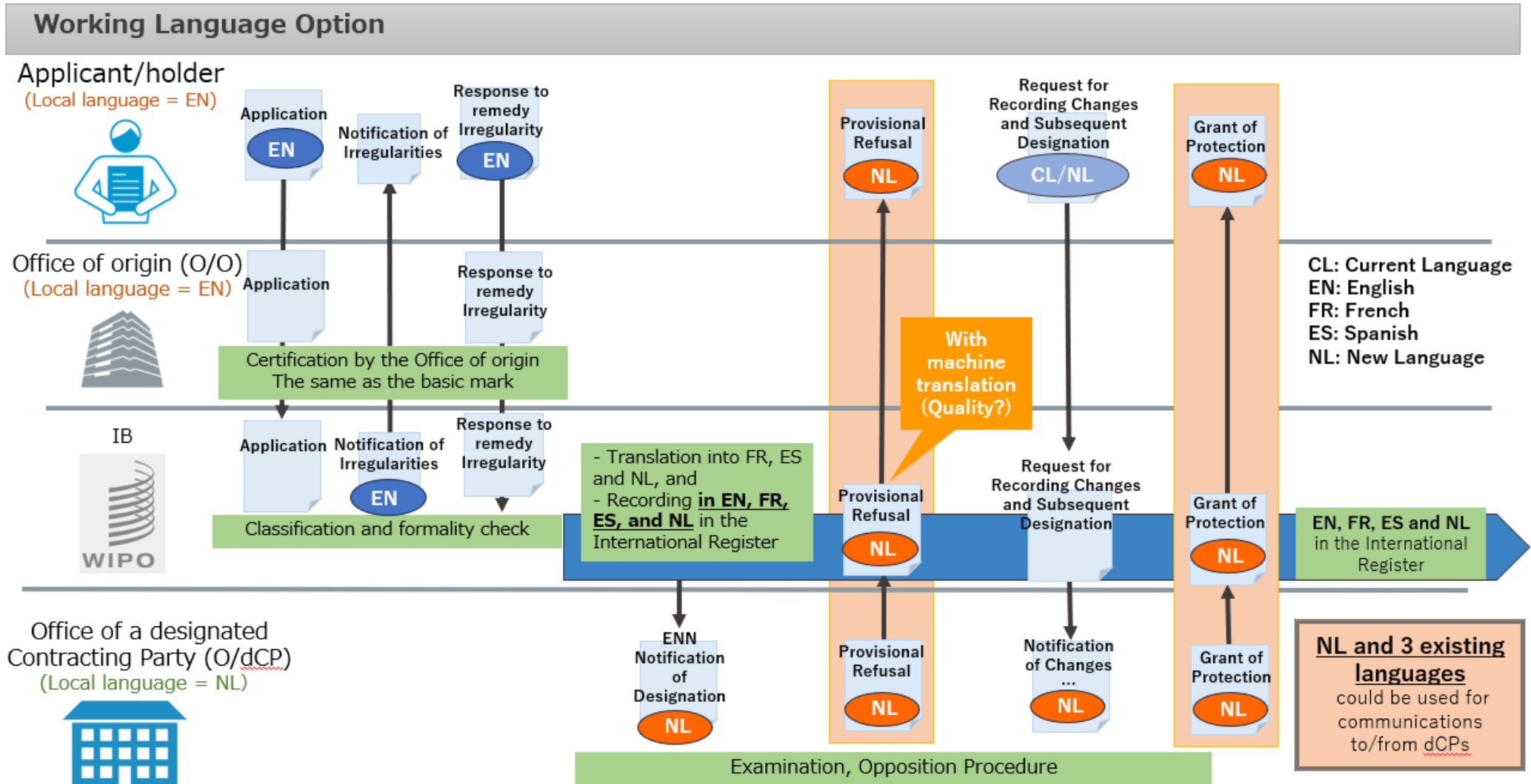
27. *The Working Group is invited:*

(i) to consider and provide comments on the proposed international registration language option as a temporary implementation option for introducing new languages, as referred to in Annex I to III, and

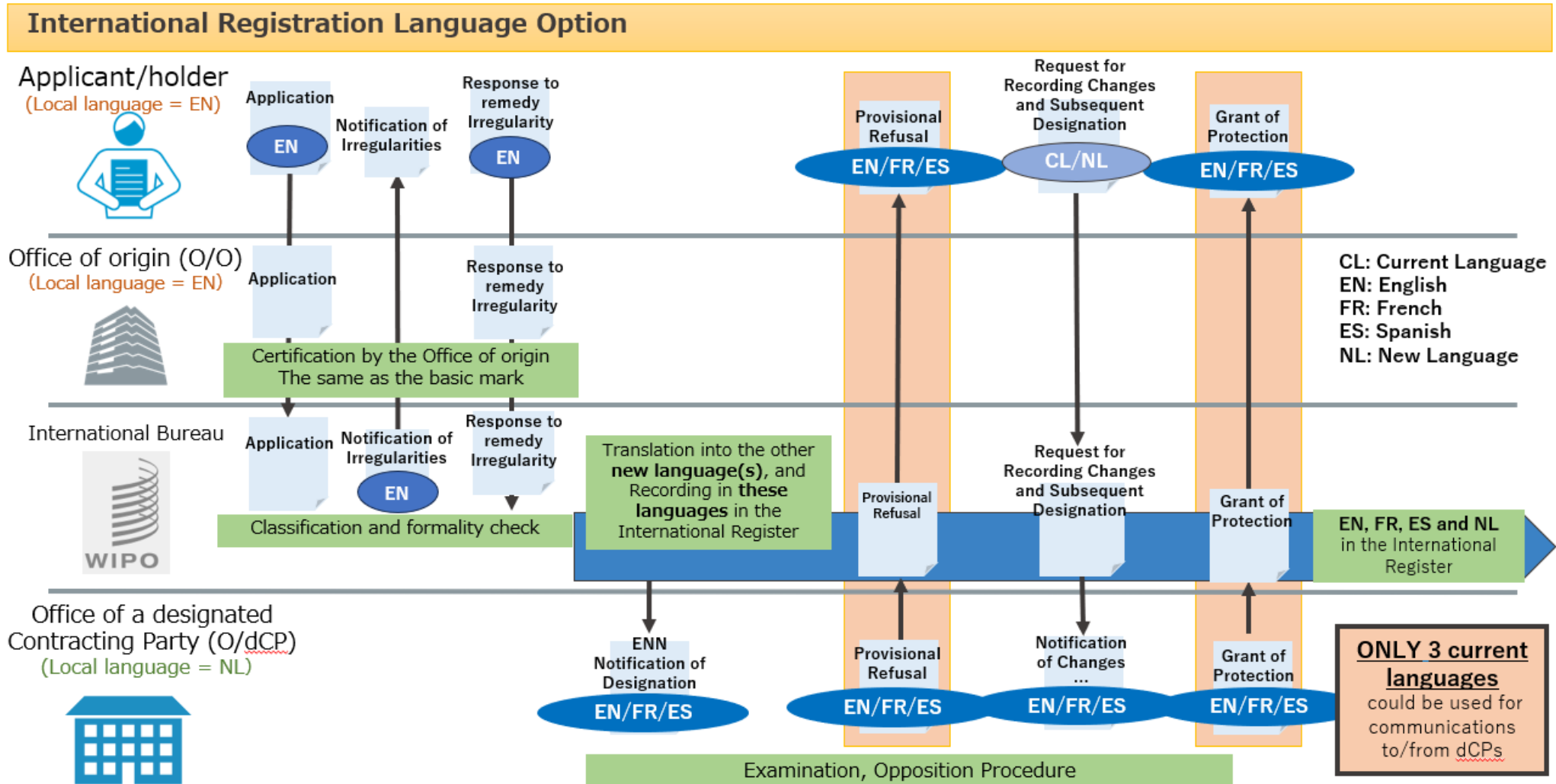
(ii) to consider requesting the Secretariat to take necessary actions, including conducting a feasibility study on the international registration language option and proposing modifications to the Regulations and the Administrative Instructions based on draft possible modifications to Annex III.

ANNEX II: COMPARISON BETWEEN THE WORKING LANGUAGE OPTION AND THE INTERNATIONAL REGISTRATION LANGUAGE OPTION

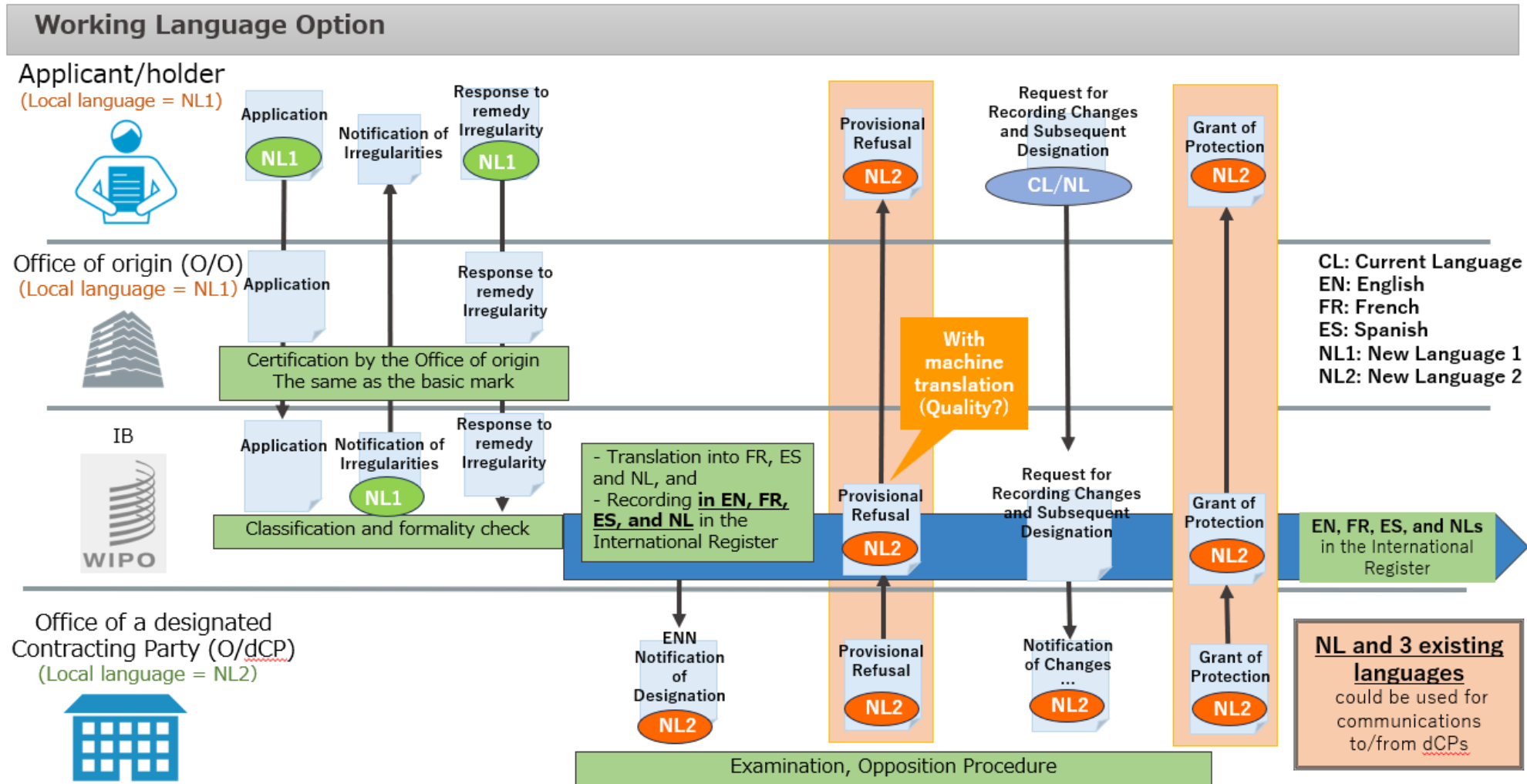
[CASE 1-1] The Office of origin has selected English (EN); and
The local language of the Office of a designated Contracting Party is a Madrid new language, and the Office has selected the new language.



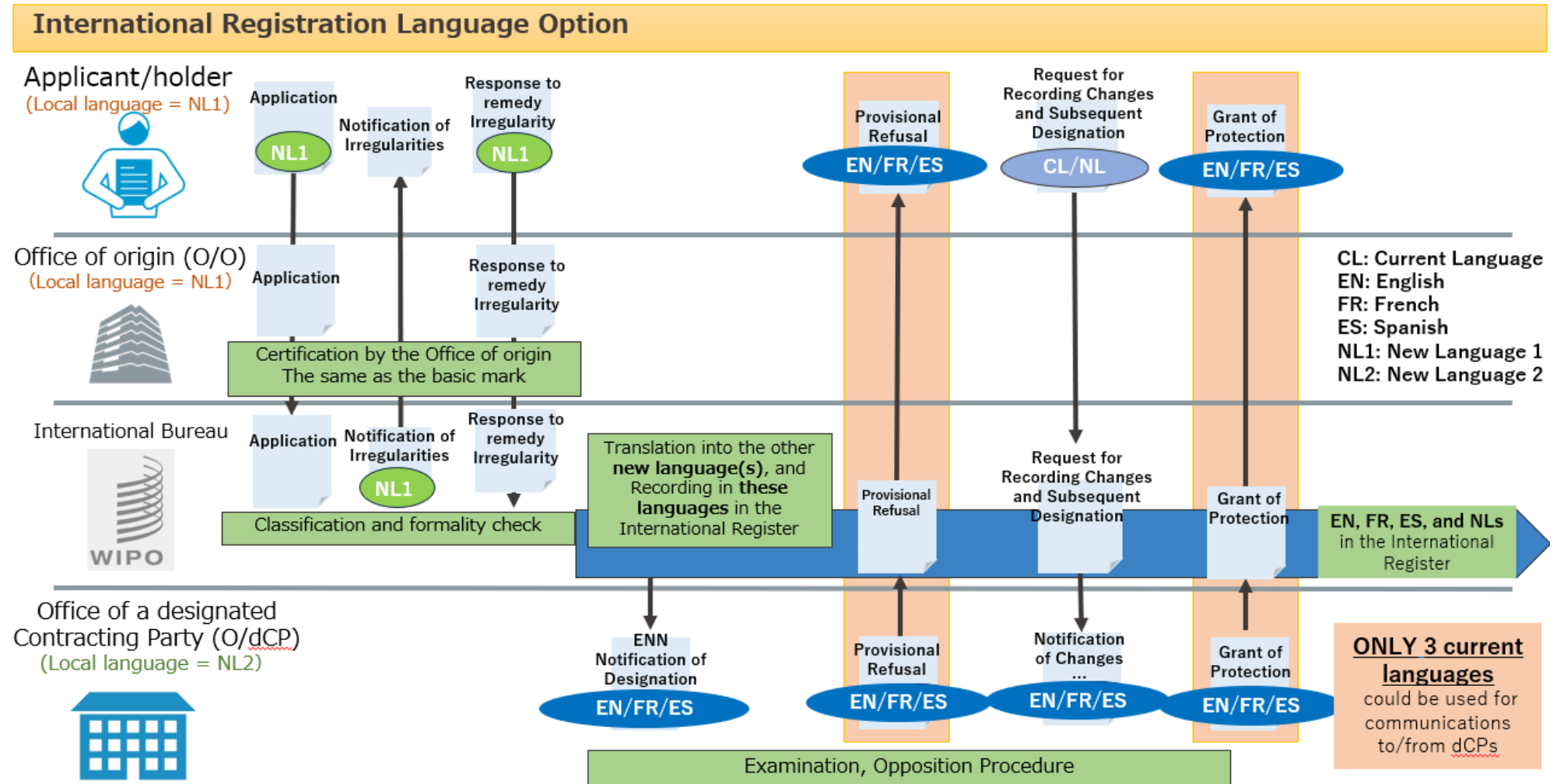
[CASE 1-2] The Office of origin has selected English (EN); and
The local language of the Office of a designated Contracting Party is a Madrid new language, but the Office has selected one from the current three languages.



[CASE 2-1] The Office of origin has selected one of new languages (NL1); and
The local language of the Office of a designated Contracting Party is a Madrid new language (NL2), and the Office has selected the new language.



[CASE 2-2] The Office of origin has selected one of new languages (NL1); and
The local language of the Office of a designated Contracting Party is a Madrid new language (NL2), but the Office has selected one from the current three languages.



ANNEX III: DRAFT
Possible Modifications to the Regulations and
Modifications to the Administrative Instructions ^{14, 15}

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

Chapter 1
General Provisions

Rule 6
Languages

(1) *[International Application]* The international application shall be in English, French, ~~or~~ Spanish, or [New Language(s)] according to what is prescribed by the Office of origin, it being understood that the Office of origin may allow applicants to choose between English, French, ~~and~~ Spanish and [New Language(s)], provided that the name and address of any natural person or legal entity are given in accordance with the Administrative Instructions.

[COMMENT:]

It is proposed that all new languages be used as languages used for international applications according to what is prescribed by the Office of origin.

It is proposed that only Latin characters and Arabic numerals be accepted. Please see the possible modifications to the Administrative Instructions below.]

(2) *[Communications Other than the International Application]* Any communication concerning an international application or an international registration shall, subject to Rule 17(2)(v) and (3), be

(i) in English, French, ~~or~~ Spanish, or [New Language(s)] where such communication is addressed to the International Bureau by the applicant or holder, or by ~~an~~ the Office of origin;

(ii) in English, French or Spanish where such communication is addressed to the International Bureau by the Office of a designated Contracting Party;

[COMMENT:]

It is proposed that all new languages be used for communications from applicants/holders to the International Bureau (see possible modifications to Rule 6(2)(i), above).

It is proposed that all new languages be used for communications from the Office of origin to the International Bureau (see possible modifications to Rule 6(2)(i), above).

¹⁴ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text of Regulations as in force on November 1, 2023 and the Administrative Instructions as in force on February 1, 2023.

¹⁵ COMMENT sections are not parts of the proposed modifications.

It is proposed that no new language be used for communications from the Office of a designated Contracting Party to the International Bureau (see possible modifications to Rule 6(2)(ii), above).]

(~~iii~~iii) in the language applicable under Rule 7(2) where the communication consists of the declaration of intention to use the mark annexed to the international application under Rule 9(5)(f) or to the subsequent designation under Rule 24(3)(b)(i);

(~~iii~~iv) in the language of the international application where the communication is a notification addressed by the International Bureau to ~~an~~the Office of origin, unless that Office has notified the International Bureau that all such notifications are to be in English, or are to be in French, or are to be in Spanish, or are to be in [New Language(s)]; where the notification addressed by the International Bureau concerns the recording in the International Register of an international registration, the notification shall indicate the language in which the relevant international application was received by the International Bureau;

(v) in English, French or Spanish where the communication is a notification addressed by the International Bureau to the Office of a designated Contracting Party, unless that Office has notified the International Bureau that all such notifications are to be in English, or are to be in French, or are to be in Spanish;

[COMMENT:

It is proposed that all new languages could be used for communications from the International Bureau to the Office of origin, according to the preference of the Office of origin (see possible modifications to Rule 6(2)(iv), above).

It is proposed that no new language be used for communications from the International Bureau to the Office of a designated Contracting Party (see possible modifications to Rule 6(2)(v), above).]

(~~iv~~vi) in the language of the international application where the communication is a notification addressed by the International Bureau to the applicant or holder, unless that applicant or holder has expressed the wish that all such notifications be in English, or be in French, or be in Spanish, or be in [New Language(s)].-

[COMMENT:

It is proposed that the language of the international application or a language chosen by the applicant or holder, is used for communications from the International Bureau to the applicant/holder. The language chosen by the applicant/holder can be one of the three existing languages or new languages (see possible modifications to Rule 6(2)(vi), above).

It might also be required to modify other rules, so that an application or another communication may contain an indication of whether the applicant or holder wishes to receive communications addressed by the International Bureau in English, French, Spanish, or a new language.

Please note that this document does not include such proposed modifications.]

provided that the name and address of any natural person or legal entity shall be given in accordance with the Administrative Instructions.

[COMMENT:

It is proposed that only Latin characters and Arabic numerals be used for indicating names and addresses in communications. Please see the proposed modifications to the Administrative Instructions below.]

(3) *[Recording and Publication]*

(a) The recording in the International Register and the publication in the Gazette of the international registration and of any data to be both recorded and published under these Regulations in respect of the international registration shall be in English, French, ~~and~~ Spanish, and [New Language(s)], provided that the name and address of any natural person or legal entity shall be given in accordance with the Administrative Instructions. The recording and publication of the international registration shall indicate the language in which the international application was received by the International Bureau.

[COMMENT:

It is proposed that recording and publication be made in the three existing languages as well as new languages (see proposed Rule 6(3)(a), above).

It is also proposed that only Latin characters and Arabic numerals be used for names and addresses which are recorded in the International Register and published the Gazette. Please see the proposed modifications to the Administrative Instructions below.]

(b) Where a first subsequent designation is made in respect of an international registration that, under previous versions of this Rule, has been published only in French, or only in English and French, or only in English, French and Spanish, the International Bureau shall, together with the publication in the Gazette of that subsequent designation, ~~either~~ publish the international registration in English, ~~and~~ Spanish and [New Language(s)] and republish the international registration in French, or publish the international registration in Spanish and [New Language(s)] and republish it in English and French, or publish the international registration in [New Language(s)] and republish the international registration in English, French and Spanish, as the case may be. That subsequent designation shall be recorded in the International Register in English, French, ~~and~~ Spanish and [New Language(s)].

[COMMENT:

It is proposed to make some adjustments to older international registrations that, under the previous or current language regime, were published only in French, or were published only in English and French, or were published only in English, French and Spanish. Those older international registration would need to be (re)published in English, French, Spanish and new languages (see possible modifications to Rule 6(3)(b), above).

It is also proposed that those subsequent designations themselves will be recorded in the International Register in English, French, Spanish and new languages.

Further modifications to Rule 40(4) [Transitional Provisions Concerning Languages] would be required as a result of the above-mentioned modifications to Rule 6, which are based on the premise that international registrations that have been published only in French, or only in English and French, or only in English, French and Spanish should remain subject to the monolingual (French) regime or the bilingual (English and French) regime or the trilingual (English, French and Spanish) regime until such time as they are the subject of a (new) subsequent designation. Any new subsequent designation would trigger the change from the monolingual, or the bilingual, or the trilingual regime to the multilingual regime (see document [MM/LD/WG/2/4](#), which included proposed modifications to the Common Regulations so as to establish a full trilingual regime under the Madrid system). This document does not include further modifications to Rule 40.]

(4) [Translation]

(a) The translations needed for the notifications under paragraph ~~(2)(iii)~~ and ~~(iv)~~ [\(2\)\(iv\)](#), [\(v\)](#) and [\(vi\)](#), and recordings and publications under paragraph (3), shall be made by the International Bureau. The applicant or the holder, as the case may be, may annex to the international application, or to a request for the recording of a subsequent designation or of a change, a proposed translation of any text matter contained in the international application or the request. If the proposed translation is not considered by the International Bureau to be correct, it shall be corrected by the International Bureau after having invited the applicant or the holder to make, within one month from the invitation, observations on the proposed corrections.

[COMMENT:

It is proposed to make small adjustments as a result of the possible modifications to the preceding paragraphs. Translations needed for notifications from the International Bureau to the Office of origin, the Office of a designated Contracting Party, or the applicant or holder, would continue to be provided by the International Bureau. Translations needed for recordings and publications would also continue to be provided by the International Bureau.]

(b) Notwithstanding subparagraph (a), the International Bureau shall not translate the mark. Where, in accordance with Rule 9(4)(b)(iii) or Rule 24(3)(c), the applicant or the holder gives a translation or translations of the mark, the International Bureau shall not check the correctness of any such translations.

Chapter 2
International Applications

Rule 9
Requirements Concerning the International Application

(1) [Presentation] [No change]¹⁶

(2) [Form and Signature] [No change]

(3) [Fees] [No change]

(4) [Contents of the International Application]

¹⁶ [No change] means that there is no suggested change from the current text of the provision.

(a) The international application shall contain or indicate

(i) the name of the applicant, given in accordance with the Administrative Instructions,

(ii) the address, given in accordance with the Administrative Instructions, and the electronic mail address of the applicant,

(iii) the name and address, given in accordance with the Administrative Instructions, and the electronic mail address of the representative, if any,

(iv) where the applicant wishes, under the Paris Convention for the Protection of Industrial Property, to take advantage of the priority of an earlier filing, a declaration claiming the priority of that earlier filing, together with an indication of the name of the Office where such filing was made and of the date and, where available, the number of that filing, and, where the earlier filing relates to less than all the goods and services listed in the international application, the indication of those goods and services to which the earlier filing relates,

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

(vi) where the applicant wishes that the mark be considered as a mark in standard characters, a declaration to that effect,

(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 or is applied to be or is protected in color, an indication that color is claimed and an indication by words of the color or combination of colors claimed,

(vii*bis*) where the mark that is the subject of the basic application or the basic registration consists of a color or a combination of colors as such, an indication to that effect,

(viii) where the basic application or the basic registration relates to a three-dimensional mark, the indication "three-dimensional mark,"

(ix) where the basic application or the basic registration relates to a sound mark, the indication "sound mark,"

(x) where the basic application or the basic registration relates to a collective mark or a certification mark or a guarantee mark, an indication to that effect,

(xi) where the basic application or the basic registration contains a description of the mark by words and the Office of origin requires the inclusion of the description, that same description; where the said description is in a language other than the language of the international application, it shall be given in the language of the international application,

(xii) where the mark consists of or contains matter in characters other than Latin characters or numbers expressed in numerals other than Arabic or Roman numerals, a transliteration of that matter in Latin characters and Arabic numerals; [where the international application is filed in English, French or](#)

Spanish, the transliteration into Latin characters shall follow the phonetics of the language of the international application, or, where the international application is filed in a language other than English, French or Spanish, the phonetics of one of those languages with an indication of the language concerned.

[COMMENT:

For a question on the transliteration of the mark, please see paragraph 22 b) of Annex I.

The phonetics to be followed was previously suggested by the International Bureau in document MM/LD/WG/18/5, paragraph 20 and Annex III.)]

(xiii) the names of the goods and services for which the international registration of the mark is sought, grouped in the appropriate classes of the International Classification of Goods and Services, each group preceded by the number of the class and presented in the order of the classes of that Classification; the goods and services shall be indicated in precise terms, preferably using the words appearing in the Alphabetical List of the said Classification; the international application may contain limitations of the list of goods and services in respect of one or more designated Contracting Parties; the limitation in respect of each Contracting Party may be different,

(xiv) the amount of the fees being paid and the method of payment, or instructions to debit the required amount of fees to an account opened with the International Bureau, and the identification of the party effecting the payment or giving the instructions, and

(xv) the designated Contracting Parties.

(b) The international application may also contain,

(i) where the applicant is a natural person, an indication of the State of which the applicant is a national;

(ii) where the applicant is a legal entity, indications concerning the legal nature of that legal entity in English, French or Spanish and the State, and, where applicable, the territorial unit within that State, under the law of which the said legal entity has been organized;

[COMMENT:

For questions on the legal nature of a legal entity, please see paragraph 22 c) of Annex I.]

(iii) where the mark consists of or contains a word or words that can be translated, a translation of that word or those words into English, French and Spanish, or in any one or two of those languages;

[COMMENT:

For questions on the translation of the mark, please see paragraph 22 d) of Annex I.]

(iv) where the applicant claims color as a distinctive feature of the mark, an indication by words, in respect of each color, of the principal parts of the mark which are in that color;

(v) where the applicant wishes to disclaim protection for any element of the mark, an indication of that fact and of the element or elements for which protection is disclaimed;

(vi) any description of the mark by words or, if the applicant so wishes, the description of the mark by words contained in the basic application or the basic registration, where it has not been provided under paragraph (4)(a)(xi).

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

(a) [Deleted]

(b) The international application shall contain the number and date of the basic application or basic registration and shall indicate one or more of the following:

(i) where the Contracting Party whose Office is the Office of origin is a State, that the applicant is a national of that State;

(ii) where the Contracting Party whose Office is the Office of origin is an organization, the name of the Member State of that organization of which the applicant is a national;

(iii) that the applicant has a domicile in the territory of the Contracting Party whose Office is the Office of origin;

(iv) that the applicant has a real and effective industrial or commercial establishment in the territory of the Contracting Party whose Office is the Office of origin.

(c) Where the address of the applicant given in accordance with paragraph (4)(a)(ii) is not in the territory of the Contracting Party whose Office is the Office of origin and it has been indicated under subparagraph (a)(i) or (ii) or subparagraph (b)(iii) or (iv) that the applicant has a domicile or an establishment in the territory of that Contracting Party, that domicile or the address of that establishment shall be given in the international application.

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

(i) the date on which the Office of origin received the request by the applicant to present the international application to the International Bureau,

(ii) that the applicant named in the international application is the same as the applicant named in the basic application or the holder named in the basic registration, as the case may be,

(iii) that any indication referred to in paragraph (4)(a)(vii) to (xi) and appearing in the international application appears also in the basic application or the basic registration, as the case may be,

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

(v) that, if color is claimed as a distinctive feature of the mark in the basic application or the basic registration, or the mark in the basic application or the basic registration is applied to be or is protected in color, a color claim is included in the international application or that, if color is claimed as a distinctive feature of the mark in the international application without having been claimed in the basic application or basic registration, the mark in the basic application or basic registration is in fact in the color or combination of colors claimed, and

(vi) that the goods and services indicated in the international application are covered by the list of goods and services appearing in the basic application or basic registration, as the case may be.

(e) Where the international application is based on two or more basic applications or basic registrations, the declaration referred to in subparagraph (d) shall be deemed to apply to all those basic applications or basic registrations.

(f) Where the international application contains the designation of a Contracting Party that has made a notification under Rule 7(2), the international application shall also contain a declaration of intention to use the mark in the territory of that Contracting Party; the declaration shall be considered part of the designation of the Contracting Party requiring it and shall, as required by that Contracting Party,

(i) be personally signed by the applicant and be made on a separate official form annexed to the international application, or

(ii) be included in the international application.

(g) Where an international application contains the designation of a Contracting Organization, it may also contain the following indications:

(i) where the applicant wishes to claim, under the law of that Contracting Organization, the seniority of one or more earlier marks registered in, or for, a Member State of that Organization, a declaration to that effect, stating the Member State or Member States in or for which the earlier mark is registered, the date from which the relevant registration was effective, the number of the relevant registration and the goods and services for which the earlier mark is registered. Such indications shall be on an official form to be annexed to the international application;

[COMMENT:

Another question would be whether an official form referred to in Rule 9(g) could be in new languages or not.]

(ii) where, under the law of that Contracting Organization, the applicant is required to indicate a second working language before the Office of that Contracting Organization, in addition to the language of the international application, an indication of that second language.

Chapter 4

Facts in Contracting Parties Affecting International Registrations

Rule 17

Provisional Refusal

(1) [Notification of Provisional Refusal] [No change]

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

(i) the Office making the notification,

(ii) the number of the international registration, preferably accompanied by other indications enabling the identity of the international registration to be confirmed, such as the verbal elements of the mark or the basic application or basic registration number,

(iii) [Deleted]

(iv) all the grounds on which the provisional refusal is based, together with a reference to the corresponding essential provisions of the law,

(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 of the owner and of the representative, if any, their addresses, if possible, and a 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,

[COMMENT:

It is proposed that the list of goods and services in the application or registration of the former mark which is referred to in Rule 17(2)(v) may be in the language of a conflicting application or registration, and therefore modifications to Rule 17(2)(v) would not be necessary.]

(vi) either that the grounds on which the provisional refusal is based affect all the goods and services or an indication of the goods and services which are affected, or are not affected, by the provisional refusal,

(vii) the time limit, which shall be no less than two months², for filing a request for review of, or appeal against, the ex officio provisional refusal or the provisional refusal based on an opposition and, as the case may be, for filing a response to the opposition,

(viii) where the time limit referred to in paragraph (2)(vii) begins on a date other than the date on which the International Bureau transmits a copy of the notification to the holder or the date on which the holder receives said copy, an indication of the date on which the said time limit begins and ends,

(ix) the authority with which such request for review, appeal or response should be filed, and

(x) an indication, where applicable, that the request for review, the appeal or the response has to be filed through the intermediary of a representative whose address is within the territory of the Contracting Party whose Office has pronounced the refusal.

(3) [Additional Requirements Concerning a Notification of Provisional Refusal Based on an Opposition] Where the provisional refusal of protection is based on an opposition, or on an opposition and other grounds, the notification shall, in addition to complying with the requirements referred to in paragraph (2), contain an indication of that fact and the name of the opponent and of the representative, if any and, if possible, their addresses; however, notwithstanding paragraph (2)(v), the Office making the notification must, where the opposition is based on a mark which has been the subject of an application or registration, communicate the list of the goods and services on which the opposition is based and may, in addition, communicate the complete list of goods and services of that earlier application or registration, it being understood that the said lists may be in the language of the earlier application or registration.

[COMMENT:

It is proposed that the list of goods and services of the earlier application or registration of the former mark which is referred to in Rule 17(3) may be in the language of that earlier application or registration, and therefore, modifications to Rule 17(3) would not be necessary.]

(4) [Recording; Transmittal of Copies of Notifications] [No change]

(5) [Declarations Relating to the Possibility of Review] [No change]

(6) [Deleted]

(7) [Information Concerning the Time Limit to Respond to a Provisional Refusal] [No change]

Administrative Instructions for the Application of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks

Part Four Requirements Concerning Names and Addresses

Section 12 Names and Addresses

- (a) In the case of a natural person, the name to be indicated is the family or principal name and the given or secondary name(s) of the natural person.
- (b) In the case of a legal entity, the name to be indicated is the full official designation of the legal entity.
- (c) In the case of a name in characters other than Latin characters, the indication of that name shall consist of a transliteration into Latin characters ~~which~~; where the international application is filed in English, French or Spanish, the transliteration into Latin characters shall follow the phonetics of the language of the international application, or, where the international application is filed in a language other than English, French or Spanish, the phonetics of one of those languages with an indication of the language concerned. In the case of a legal entity whose name is in characters other than Latin characters, the said transliteration may be replaced by a translation; where the international application is filed in English, French or Spanish, a translation into the language of the international application, or, where the international application is filed in a language other than English, French or Spanish, a translation into one of those languages with an indication of the language concerned.
- (d) An address and an electronic mail address shall be given in such a way as to satisfy the customary requirements for prompt postal or electronic delivery, as the case may be. An address shall consist of transliterations into Latin characters or Arabic numerals, or translations into English, French or Spanish, and shall consist, at least, of all the relevant administrative units up to, and including, the house number, if any. In addition, a telephone number, as well as a different address and an additional electronic mail address for correspondence may be indicated.

[COMMENT:

It is proposed that only Latin characters and Arabic numerals be used to indicate the name and address of a natural person or a legal entity, even if a request is provided in a language that does not use Latin characters or Arabic numerals (see paragraph 22 a) of Annex I).

The current Section 12(c) provides that the indication of the name of a legal entity in non-Latin characters consists of either a transliteration into Latin characters or a translation into the language of the international application. Some adjustments would be required to have different instructions between international applications in the three existing languages and those in new languages.]

[End of Annex and of document]