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WORKING GROUP ON THE LEGAL DEVELOPMENT OF THE MADRID SYSTEM FOR THE INTERNATIONAL REGISTRATION OF MARKS

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STUDY ON THE POSSIBLE INTRODUCTION OF “FILING LANGUAGES” IN THE MADRID SYSTEM

prepared by the International Bureau

I. BACKGROUND

1. At its fortieth session, held in Geneva from September 22 to 30, 2008, the Madrid Union Assembly¹ considered a document entitled “Proposal for a Study on the Possible Introduction of ‘Filing Languages’ in the Madrid System” (document MM/A/40/2.). According to that proposal (hereinafter referred to as the “basic proposal”) a study would be conducted by the International Bureau on the implications, consequences and advantages of including other languages in the language regime of the Madrid system, focusing on a scenario in which the working languages of the Madrid system remain English, French and Spanish, but in which applicants would also be permitted to file international applications in any of the other working languages of WIPO, i.e. Arabic, Chinese, Portuguese or Russian.

¹ Hereinafter referred to as “the Assembly”. Similarly, the Madrid Agreement Concerning the International Registration of Marks will be hereinafter referred to as “the Agreement”, the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks will be hereinafter referred to as “the Protocol” and the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement will be hereinafter referred to as “the Common Regulations”.

2. During the discussions of the Assembly, the Delegation of Japan indicated that it supported the idea of conducting a study but that it could be useful if a comparative appraisal also included languages other than just the four mentioned in the basic proposal. The Delegation of Japan also suggested that the International Bureau consider as well other statistical figures, such as the number of international applications, estimated domestic filings and the number of native speakers.

3. The Assembly took note of document MM/A/40/2 and agreed that the Secretariat conduct a study on the introduction of additional filing languages in the Madrid system.

4. At the conclusion of its sixth session held, in Geneva, from November 24 to 26, 2008, the Chair of the Working Group on the Legal Development of the Madrid System² concluded that the Working Group had agreed that its next session – the current session – would focus on the study on the introduction of additional filing languages in the Madrid system, with a view to making recommendations to the Assembly of the Madrid Union in that respect³.

5. The present document by the International Bureau is intended to facilitate the discussions of the Working Group in this task.

II. LANGUAGES TO BE CONSIDERED AS “FILING LANGUAGES”

6. Table I, below, shows the major filing Contracting Parties under the Madrid system over the last five years, ranked by the number of international applications received from the Office of each Contracting Party in 2008. It further indicates their shares within total filings in 2008 and the growth rates as compared to 2007. The table shows that, in 2008, the top 10 “Contracting Parties of Origin” were accountable for almost 72% of the filings.

Table I

Number of International Applications Filed by Contracting Parties in 2008 and years before

	<u>Contracting Party of Origin</u>	<u>2004</u>	<u>2005</u>	<u>2006</u>	<u>2007</u>	<u>2008</u>	<u>Share</u>	<u>Growth</u>
1	Germany (DE)	5,395	5,803	5,663	6,090	6,214	14.8%	2.0%
2	France (FR)	3,518	3,497	3,705	3,930	4,218	10.0%	7.3%
3	United States of America (US)	1,737	2,849	3,148	3,741	3,684	8.8%	-1.5%
4	European Community (EM)	354	1,852	2,445	3,371	3,600	8.6%	6.8%
5	Switzerland (CH)	2,133	2,235	2,468	2,657	2,885	6.9%	8.6%
6	Italy (IT)	2,499	2,340	2,958	2,664	2,763	6.6%	3.7%
7	Benelux (BX)	2,482	2,426	2,639	2,510	2,667	6.3%	6.3%
8	China (CN)	1,015	1,334	1,328	1,444	1,585	3.8%	9.8%
9	Japan (JP)	692	893	847	984	1,278	3.0%	29.9%
10	Austria (AT)	1,181	1,191	1,117	1,134	1,245	3.0%	9.8%
11	Russian Federation (RU)	575	604	622	889	1,190	2.8%	33.9%
12	United Kingdom (GB)	917	1,016	1,054	1,178	1,162	2.8%	-1.4%
13	Australia (AU)	683	852	1,100	1,169	1,092	2.6%	-6.6%
14	Spain (ES)	866	854	994	859	981	2.3%	14.2%
15	Turkey (TR)	593	787	733	717	890	2.1%	24.1%

² Hereinafter referred to as “the Working Group”.

³ See Draft Report, document MM/LD/WG/6/7 Prov., paragraph 164.

	<u>Contracting Party of Origin</u>	<u>2004</u>	<u>2005</u>	<u>2006</u>	<u>2007</u>	<u>2008</u>	<u>Share</u>	<u>Growth</u>
16	Czech Republic (CZ)	615	547	559	541	607	1.4%	12.2%
17	Denmark (DK)	441	510	479	573	565	1.3%	-1.4%
18	Sweden (SE)	462	409	400	478	476	1.1%	-0.4%
19	Poland (PL)	344	334	339	294	416	1.0%	41.5%
20	Bulgaria (BG)	334	391	426	431	386	0.9%	-10.4%
21	Norway (NO)	218	235	312	403	368	0.9%	-8.7%
22	Portugal (PT)	175	263	276	355	344	0.8%	-3.1%
23	Slovenia (SI)	201	180	177	182	296	0.7%	62.6%
24	Finland (FI)	198	208	239	278	282	0.7%	1.4%
25	Serbia (RS)	86	107	157	275	282	0.7%	2.5%
26	Ukraine (UA)	78	105	133	195	217	0.5%	11.3%
27	Hungary (HU)	231	152	217	438	214	0.5%	-51.1%
28	Croatia (HR)	135	79	150	185	200	0.5%	8.1%
29	Slovakia (SK)	249	215	241	190	187	0.4%	-1.6%
30	Republic of Korea (KR)	127	148	190	330	186	0.4%	-43.6%
31	Latvia (LV)	109	81	103	115	171	0.4%	48.7%
32	Liechtenstein (LI)	89	96	129	148	169	0.4%	14.2%
33	Singapore (SG)	93	138	161	146	166	0.4%	13.7%
34	Greece (GR)	49	65	81	80	117	0.3%	46.3%
35	Iceland (IS)	33	39	92	110	101	0.2%	-8.2%
36	Romania (RO)	58	101	97	103	99	0.2%	-3.9%
37	Estonia (EE)	75	72	96	101	93	0.2%	-7.9%
38	Lithuania (LT)	63	101	84	78	93	0.2%	19.2%
39	Morocco (MA)	57	66	119	93	73	0.2%	-21.5%
40	Belarus (BY)	29	24	23	63	69	0.2%	9.5%
	Other countries	283	378	370	423	444	1.1%	5.0%
Total		29,472	33,577	36,471	39,945	42,075	100%	5.3%

7. Assuming the basic proposal had already been implemented in 2008, there would thus have been seven filing languages in the Madrid system, i.e. Arabic, Chinese, English, French, Portuguese, Russian and Spanish. Still, this extension would not have sufficed to cover the official language of four of the top 10 “Contracting Parties of Origin” in 2008, namely those of Austria, Germany, Italy and Japan, whose common share of filings amounted to over 27% of the total, according to the figures above.

8. The same can also be said to a large extent about Switzerland (rank 6) and Benelux (rank 7), although in each case one of the working languages of the Madrid system, namely French, is also a working language of their respective Offices. Thus, according to the information made available to the International Bureau by the Swiss Office, for each of the years from 2006 to 2008, about 76% of national trademark applications were filed in German or Italian; it is believed that, amongst those national applications that serve as a basis for international applications presented through that Office, the same proportion was filed in German or Italian. Similarly, according to the information made available to the International Bureau by the Benelux Organisation for Intellectual Property (BOIP), about 85% of the regional trademark applications with that Office were filed in Dutch.

9. One should also take into consideration the fact that Dutch, German, Italian and Portuguese are filing languages of the Office of another “Contracting Party of Origin” among the top 10 in 2008, namely the Office for Harmonization in the Internal Market (Trade Marks

and Designs) (OHIM). Thus, according to the information made available to the International Bureau by OHIM, Dutch, German, Italian and Portuguese were the filing languages of the basic Community Trade Mark application or registration in respect of about 33% of the international applications filed through that Office in 2008.

10. Without putting in question the basic proposal, these data and observations suggest that, when setting up a standard for the acceptance of additional filing languages, other elements that reflect the relevance of a language in the Madrid system should also be taken into account. For example, the number of international applications filed with Offices of origin that recognize a given language as an official language. If, in addition to the basic proposal, one had set a dual threshold of 1,000 international applications and a share of 3% within the total number of applications filed per year for the acceptance of an additional filing language, that would have allowed the inclusion of the official languages used in any of the top 10 “Contracting Parties of Origin” in 2008.

11. Table II, below, shows the 15 top filing Contracting Parties under the Madrid system for the first five months of 2009, ranked by the number of filings received from the Office of each Contracting Party during that period. On the basis of the total of 12,056 international applications received by the International Bureau during that period⁴, the table further indicates in respect of each Contracting Party its actual share of filings, as well as the forecasted total filings for the whole of the year 2009.

Table II

Number of International Applications Filed by Contracting Parties
January–May 2009

	<u>Contracting Party of Origin</u>	<u>International Applications received</u>	<u>Forecast for 2009</u>	<u>Share</u>
1	DE	2070	4968	11.89%
2	EM	1500	3600	8.6%
3	FR	1489	3574	8.6%
4	US	1243	2983	7.1%
5	CH	1057	2537	6.1%
6	IT	935	2244	5.4%
7	BX	868	2083	5.0%
8	JP	554	1330	3.2%
9	CN	539	1294	3.1%
10	AT	454	1090	2.6%
11	RU	447	1073	2.6%
12	GB	421	1010	2.4%
13	AU	371	890	2.1%
14	ES	311	746	1.8%
15	TR	272	653	1.6%

⁴ The actual figures for the first five months of 2009 show a 15% downward trend in filings as compared to 2008.

12. This table shows that, amidst a general downward trend in absolute figures, the top 10 “Contracting Parties of Origin” are still accountable for about 72% of the filings. Moreover, the list of Contracting Parties meeting the suggested dual threshold of 1,000 filings and a 3% share of the total would remain almost identical in 2009, so that, in particular, Dutch, German, Italian and Japanese would continue to be the official languages of a significant portion of the national or regional basic marks used in international filings.

13. In view of both the past and the current figures under the Madrid system, it is thus suggested that for the introduction of filing languages, Dutch, German, Italian and Japanese be taken into consideration, in addition to the four working languages of WIPO already covered in the basic proposal.

14. However, despite this general stability in the relative relevance of languages in the Madrid system, the group of Contracting Parties meeting the dual threshold could change. The introduction of filing languages in the Madrid system should, therefore, not depend on a heavy procedure. On the contrary, the system should be flexible enough to accommodate even further filing languages as the need arises. Conversely, and taking into account the gloomy worldwide economy, the system should be light enough to tolerate that a language that has been introduced as an additional filing language remains so allowed even if, in the subsequent year, the number of filings from the Contracting Party or Parties whose official language it is drops below any of the two criteria under the dual threshold.

III. ALLOWING “FILING LANGUAGES” IN THE CURRENT LEGAL FRAMEWORK

15. The current language regime of the Madrid system is set out in Rule 6 of the Common Regulations, which establishes a full trilingual (English, French and Spanish) regime with respect to all procedures under the Agreement and the Protocol⁵. This provision reads as follows:

*“Rule 6
Languages*

“(1) [*International Application*] The international application shall be in English, French or Spanish 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.

“(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 where such communication is addressed to the International Bureau by the applicant or holder, or by an Office;

⁵ Rule 40(4) [*Transitional Provision Concerning Languages*] further regulates the application of the full trilingual regime with respect to certain international registrations resulting from international applications filed before April 1, 2004, date of introduction of the Spanish language under the Protocol, or before September 1, 2009, date of introduction of the full trilingual regime.

“(ii) 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) in the language of the international application where the communication is a notification addressed by the International Bureau to an Office, 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; 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;

“(iv) 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.

“(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. The recording and publication of the international registration shall indicate the language in which the international application was received by the International Bureau.

“(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, 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 republish the international registration in French, or publish the international registration in Spanish and republish it in English and French, as the case may be. That subsequent designation shall be recorded in the International Register in English, French and Spanish.

“(4) [*Translation*] (a) The translations needed for the notifications under paragraph (2)(iii) and (iv), 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.

“(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.”

16. Rule 6(1) thus provides that the international application ought to be in one of the three working languages. That language is then taken to be the “language of the international application” for the notification purposes envisaged under Rule 6(2) and, pursuant to Rule 6(3), will be indicated as such in the recording and publication of the international registration. Rule 6(4) then provides that the International Bureau shall proceed to “*translations needed for the notifications under paragraph (2)(iii) and (iv), and recordings and publications under paragraph (3)*” and, in the broader context of Rule 6 as a whole, that is meant to refer to the translations into the two working languages other than the “language of the international application”.

17. It is recalled, however, that under the Madrid system, one does not file an international application directly with the International Bureau. That application must be filed through the “Office of origin”⁶. Pursuant to Article 3(4) of both the Agreement and the Protocol, the date on which the international application is filed with the Office of origin becomes the international registration date, provided the international application is received within two months by the International Bureau. For the sake of the present study, a preliminary question, therefore, is how this fundamental principle receives application in case the international application is filed in a language other than a working language of the system.

18. It should first be noted that, as a matter of fact, an office may very well allow users to file in their local language and then assist them with the translation into the working language prescribed by that office, before sending the international application to the International Bureau. If so, this would take place entirely unbeknownst to the International Bureau, and, to the extent, of course, that the application is received by the International Bureau within the time limit set under Article 3(4), would not impact the international registration date.

19. Furthermore, it should be noted that even where an international application is received by the International Bureau in a language other than English, French or Spanish, this would not necessarily have an impact on the international registration date. More precisely, the International Bureau would consider that such an application is missing the required indication of goods and services for which registration of the mark is sought, which is one of the “*irregularities affecting the international registration date*” under Rule 15 of the Common Regulations. However, that Rule further provides that where such irregularities are remedied by the Office of origin before the expiry of the two-month period set under Article 3(4), the registration date is, in the end, not affected but remains that on which the international application was filed with the Office of origin. In other words, provided the Office of origin resubmits the application in English, French or Spanish, within that time-limit, the international application proceeds to examination by the International Bureau (with that language of filing becoming the “language of the international application”), but the filing date remains that on which the Office of origin received the defective application.

⁶ According to Article 2(2) of the Protocol, this expression refers to “the Office with which the basic application was filed or by which the basic registration was made”. The equivalent expression under the Agreement, as defined in Article 1(3) of thereof, is “Office of the country of origin”. For convenience, the expression of the Protocol only will be used throughout the document.

20. Against this background, one could conceive encouraging Offices of origin to allow the filing of international applications in their official, non-Madrid language, without this preventing the recognition of a filing date. To the extent that, as agreed by the Assembly, the introduction of additional languages is to be considered for filing only, that practice could remain in the antechamber of the international procedure and take place without any changes to the Rules. It would only be necessary that, for examination, notification and publication purposes, the practice provide for the clear identification of any one of English, French or Spanish as the “language of the international application”, as expected under Rule 6.

21. Nevertheless, for obvious reasons of transparency for applicants as well as sound management, it would be desirable that, in respect of each office that adopts it, this practice be formalized. This formalization could take place in the context of WIPO’s broader endeavor of a database of acceptable terms, as described below.

IV. WIPO’S PROJECT ON THE ESTABLISHMENT OF A DATABASE OF ACCEPTABLE INDICATIONS OF GOODS AND SERVICES

22. A database of acceptable indications of goods and services for the sake of filing international applications under the Madrid system is currently under construction, and will be made available on-line during the second half of 2009 through an e-classification tool also currently under development.

23. The database of acceptable indications will contain descriptions of goods and services validated by the International Bureau, including those extracted from the alphabetical list of the ninth edition of the International Classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (hereinafter referred to as “the Nice Classification”) and from the class headings of the Nice Classification. In total, the first operational version of this database should contain approximately 27,000 descriptions of goods and services, available in English, French and Spanish.

24. The e-classification tool, which will make the contents of the database available on-line, is designed to help applicants in the task of composing the lists of goods and services to be submitted within the applications for international registration. Using this e-classification tool, Madrid users will be able to:

- select descriptions of goods and services from a pick-list of validated indications from the database, which will guarantee that no irregularity notice will be issued in respect of their list;
- check the acceptance status for each description of a list of classified goods and services;
- get classification proposals for unclassified descriptions through a search facility that will return all acceptable terms from the database which best match an input description;
- get the automatic translation of a list of goods and services into the other filing languages for all accepted descriptions of a list.

25. At a later stage, the International Bureau intends to bring further functionalities to this e-classification tool. In the future, the database itself could be made available in several languages other than the Madrid working languages. Thus, an applicant from anywhere within the Madrid Union could compose its own list of goods and services in its own language and get the automatic translation of all validated descriptions into the selected “language of the international application”. This, however, is a long-term objective that the International Bureau cannot pursue on its own. In order to achieve such results, it would need the cooperation of the Offices of Contracting Parties. The establishment of non-working language versions of the database could, however, be fostered and sped-up in the context of agreements to be established between the International Bureau and interested Offices. Such an agreement would allow to formalize a practice of filing in a non-working language, as explained below.

V. PROPOSAL TO FORMALIZE THE ACCEPTANCE OF FILINGS IN A NON-WORKING LANGUAGE

26. Bearing in mind the need, on the one hand, for a system that is both light and flexible, as identified under Chapter II, above, and, on the other hand, to formalize somewhat the introduction of additional filing languages, the acceptance of filings in a specific language (which is not one of the three working languages but would qualify as an additional filing language as per the criteria specified above), could be made subject to a written agreement to that effect between the International Bureau and the competent Office. A proposal for a procedure resting on a filing language agreement follows.

Premises

27. The first premise is that the Office of the Contracting Party that wishes to enter into a filing language agreement must also enter into, or already be party to an agreement relating to electronic communication with the International Bureau, at least in respect of the transmission of international applications.

28. The filing language agreement referred to above would become a component of the broader electronic communication agreement concluded between the relevant Office and the International Bureau. For convenience, the template currently used by the International Bureau with a view to concluding such type of agreement is provided in the Annex to the present document.

29. The second premise is that the Office of the Contracting Party is to cooperate with the International Bureau on the translation of WIPO’s database of acceptable indications of goods and services into the relevant domestic language(s) of use of that Office.

30. Finally, means allowing applicants to file international applications in the domestic language would of course have to be in place at the Office’s level before such filings may start. This could be provided for in different ways. At the very least, the International Bureau would cooperate with the interested Office in establishing unofficial versions of the relevant application form or forms MM1, MM2 and MM3 in the domestic language. However, given the context of electronic communication with the International Bureau, the Office would make available an electronic filing interface. Obviously, that interface would be linked to the

database of acceptable indications of goods and services available in the domestic language. The International Bureau is interested in developing a standard filing interface that would also contain a number of checks and safeguards and that could be implemented by any office at its own level.

Procedure Under the Agreement

31. The procedure would be as follows:

(a) when filing its international application in the domestic language, the applicant shall choose one of the three working languages of the Madrid system, among those accepted by the Office of origin, for the purpose of having its international application translated into that language, which will later become the “language of the international application” in the sense of what is established in Rule 6;

(b) immediately after its certification related check⁷, the Office of origin shall run the international application filed in the domestic language through an automatic translation tool provided by WIPO (and linked to the database of acceptable indications of goods and services), which will provide the translation of the application into the Madrid system working language chosen by the applicant;

(c) if, after step (b) has been completed, any portion of the international application still remains in the domestic language (e.g., an indication of good or service; the description of the mark, etc.), the Office shall send the international application electronically to the International Bureau for the purposes of having the translation process completed;

(d) the International Bureau shall proceed to translate the relevant contents of the international application still remaining in the domestic language into the working language chosen by the applicant; within five working days, the International Bureau shall submit the translated application back to the Office of origin;

(e) the Office of origin shall invite the applicant to confirm its agreement to the translated version of the international application by signing the international application in the working language;

(f) once the applicant’s agreement has been obtained, the Office of origin shall formally submit the international application in the working language to the International Bureau, electronically;

⁷ See Rule 9(5)(d) of the Common Regulations.

(g) normally, step (f) should take place within the two-month deadline provided under Article 3(4), so as to ensure that the whole process does not, in itself, result in the date of the international registration being affected⁸;

(h) examination of the international application by the International Bureau shall take place, in the usual manner, with the particularity that it should normally not give rise to any Rule 13 objections (*Irregularities With Respect to the Indication of Goods and Services*) as the descriptions contained in the list would have been validated by the International Bureau.

The Case of Terms Unintelligible for the Sake of Translation

32. Such terms would be left in the original language in the translated list returned by the International Bureau, with the appropriate identification provided for in the agreement. The Office of origin will then be responsible for submitting them in the “language of the international application” as part of the international application concerned. The software used by the International Bureau will allow their immediate detection so that they could go through the validation process. However, any term so translated by the Office of origin that is not acceptable to the International Bureau will not accrue to the database and might be the subject of a Rule 13 objection as part of the examination of the international application.

Changes by the Office of Origin to the Translation Provided by the International Bureau

33. If the Office of origin disagrees with any part of the translation provided by the International Bureau, it could make changes to that translation as it sees warranted, without consulting the International Bureau. If any such changes affect the list of goods and services the International Bureau would identify any new indications contained in that list and these would go through the normal examination process, with the risk that Rule 13-type of objections be raised. If no objections are raised, this means that the indication has been validated and will, eventually, accrue to the database.

VI. COST IMPLICATIONS FOR THE INTERNATIONAL BUREAU

34. At present, a new application filed under the system in any of the three working languages triggers a translation into both of the other working languages for the purposes foreseen under Rule 6(4), and notably that of registration. In other words, the ratio is currently of two translations for one registration. If filing languages are introduced in the system, any filing in such a language would trigger three translations: one into the “language of the international application”, as selected from the choice of working languages, and

⁸ In that regard, it should be noted that, according to the observations made by the International Bureau, the “turnaround” time within an Office of origin that sends international applications electronically is generally much shorter than in those that currently do not. Thus, for the whole of 2008, the average number of calendar days for all offices (including those that send applications electronically) is about 28.8 such days. However, the individual averages within those offices that send international applications electronically are, by Contracting Party concerned: Australia, 21.6; Benelux, 31.01; European Community, 16.8; Republic of Korea, 21.17; Switzerland, 23.0; and the United States of America, 1.7.

another two, from that working language into the other two working languages. In other words, in respect of such filings exclusively, the ratio would be of three translations for one registration, instead of two for one. The cost implications of the introduction of filing languages will depend on what the ratio would globally become, taking into account both international applications filed in the working languages and those pre-filed in the other languages. This can be assessed by making an attempt at evaluating how many filings can be expected in languages other than the working languages.

35. If additional filing languages would already have been allowed in 2008 and we take into account the number of international applications received that year, per Office of origin, we could estimate that the following would have been received in Arabic, Chinese, Portuguese and Russian:

- a maximum of 46 international applications in Arabic, originating from Algeria, Egypt, Morocco (given a rate of filings in that language estimated at 1%), Sudan and the Syrian Arab Republic (none were received from Bahrain or Oman);
- a maximum of 1,585 international applications in Chinese, originating from China;
- a maximum of 351 international applications in Portuguese, originating from the Offices of the European Community (given a 0.1% rate of filings in that language), Mozambique and Portugal (none were received from Sao Tome and Principe); and
- a maximum of 1,309 international applications in Russian, originating from Belarus, Kazakhstan, the Russian Federation and Uzbekistan (no applications were received from Kyrgyzstan, Turkmenistan or Tajikistan).

36. Similarly, we could estimate that the following would have been received in Dutch, German, Italian and Japanese:

- a maximum of 2,339 international applications in Dutch, originating from the Offices of Benelux and the European Community (given rates of filings in that language estimated at 85 and 2%, respectively) (no applications were received from the Netherlands Antilles);
- a maximum of 10,775 international applications filed in German, originating from the Offices of Austria, the European Community (given a 28% rate of filings in that language), Germany, Liechtenstein and Switzerland (given a rate of filings in that language estimated at 74%);
- a maximum of 2,945 international applications in Italian, originating from the Offices of the European Community (given a 3% rate of filings in that language), Italy, San Marino and Switzerland (given a rate of filings in that language estimated at 2%);
- a maximum of 1,278 international applications in Japanese, originating from Japan.

37. This means that, if Arabic, Chinese, Portuguese and Russian had been available as additional filing languages in 2008, a maximum of 3,291 additional translations of international applications might have been required (over the total number of 84,150 translations that were required in respect of the 42,075 international applications received that year), which would have represented a 3.9% increase in the volume of translations of new applications to be processed.

38. Similarly, if Dutch, German, Italian and Japanese had been available as additional filing languages in 2008, a maximum of 17,337 additional translations of international applications might have been required, which would have represented a 20.6% increase in the volume of translations of new applications to be processed.

39. While, taken alone, that evolution in the ratio would suggest an overall increase of 24.5% in the translation workload of the International Bureau, the fact that the proposal described in Chapter IV, above, hinges on the development of a database of acceptable indications of goods and services also needs to be taken into consideration.

40. Thus, it is the essence of the proposal to link the introduction of filing languages to the establishment of the database so that, the more filings made in the language concerned, the quicker the database in that language will develop and the actual translation workload of the International Bureau will, gradually, go down. On a broader scale also, the advantages for both the International Bureau and the offices concerned that would result from having the greatest possible number of applicants using the database would need to be taken into consideration.

41. Admittedly, the database would not provide the International Bureau with any assistance with respect to the elements other than the list of goods and services that an international application may contain or indicate and that require translation⁹. However, statistics held by the International Bureau reveal that only 15.4% of all international applications processed in 2008 contained any of these four types of bibliographic data. Moreover, in total, these elements represented 148,411 words, whilst the list of goods in services themselves represented 5,608,464 words. Translation of these elements accounts thus for just a fraction (namely, 2.6%) of the translation workload of the International Bureau in respect of international applications.

VII. CONCLUSION

42. The practical proposal developed above is firmly set in the context of WIPO's efforts to improve the Madrid system by making greater use of information technology. To the extent that is the formalization of a practice that takes place today within certain offices, it remains outside the regulatory framework of the system and thus does not require amendments to the Common Regulations. However, by centralizing such a practice in the International Bureau, the procedure contributes to efficiency and consistency in the system.

⁹ These elements that are: a color claim (Rule 9(4)(a)(vii)); a description of the mark (Rule 9(4)(a)(xi)); an indication, in respect of each color claimed, on the principal parts of the mark which are in that color (Rule 9(4)(b)(iv)), and a disclaimer (Rule 9(4)(b)(v)).

43. If, in light of the present study and as a result of its discussion, the Working Group wanted to recommend the introduction of filing languages in the way developed under Chapter V, above, it could recommend to the Assembly to authorize the International Bureau to enter into a filing language agreement with any office accepting filings in Arabic, Chinese, Dutch, German, Italian, Japanese, Portuguese or Russian, or in any other language that meets the double threshold suggested in paragraph 12, above.

44. The Working Group is invited to consider the above study and indicate a way forward.

[Annex follows]

ANNEX

[TEMPLATE]

Communications by Electronic Means Between the International Bureau
of the World Intellectual Property Organization (WIPO)
and [National/Regional Office] under the Procedures of the Madrid System

On the basis of Section 11 of the Administrative Instructions for the Application of the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating Thereto, WIPO and the [National/Regional Office] agreed to communicate, with effect from [Date], documents electronically, as follows:

1. Communications by Electronic Means from [National/Regional Office] to WIPO

(a) [National/Regional Office] will transmit forms concerning [all documents to be submitted under the procedures of the Madrid system] [certain documents to be submitted under the procedures of the Madrid system, namely, [...]] to WIPO with XML files based on INPUT MECA Document Type Definition (DTD), using character set ISO-8859-1 or UTF-8.

(b) [National/Regional Office] will transmit images, whether in color or in black and white, of marks that are the subject of international applications filed electronically using the following standards:

- size: 8 cm by 8 cm (maximum);
- format: [JPG] [GIF] [TIF](examples);
- resolution: [over 150 dpi] [approximately 300 dpi](examples).

(c) Document images, where required, will be in [TIF] [PDF] [Microsoft Word] [XML] [HTML] format.

(d) [National/Regional Office] will create data concerning these documents on address: *ftp://mecain.wipo.int*

(e) Naming rule and compressing method of the transmittable files will be as follows:

- bibliographic data file: Byymmddx.txt (in the input\biblio folder);
- images file: Byymmddx.zip (in the input\images folder);
- documents file: Byymmddx.zip (in the input\docs folder).

(f) [National/Regional Office] will upload documents [daily] [biweekly, namely, on [...]] [weekly, namely, on [...]].

(g) WIPO will create an XML file containing details of the transactions received from [National/Regional Office] and loaded into the WIPO internal system.

(h) These electronic notifications will replace the paper notifications as from [Date].

2. Communications by Electronic Means from WIPO to [National/Regional Office]

(a) WIPO will transmit documents, in which it notifies [National/Regional Office] of international registrations designating the [territory for which the National/Regional Office is the Office], subsequent changes to such international registrations, using the [XML] [PDF] format. Notifications of irregularities will be transmitted using the XML format.

(b) WIPO will send documents to the following addresses:

- bibliographic data file: *ftp://ftpird.wipo.int/wipo/madrid/notif/;*
- images file: *ftp://ftpird.wipo.int/wipo/madrid/notif/./images.*

(c) WIPO will transmit to [National/Regional Office] the images file in a [JPG] [TIF] and [GIF] format.

(d) The tagging files will be encoded using ISO-8859-1. In the case of Latin special characters in electronic documents, the characters will be expressed with the numeric-coded method (e.g., Ā).

(e) WIPO will upload notifications in XML format of international registrations and changes to such international registrations every Wednesday at 9 p.m. (local time in Geneva) allowing [National/Regional Office] to download them every Thursday. In PDF format, these notifications will be uploaded every Friday, at the latest. Notifications of irregularities will be uploaded daily, from Monday to Friday.

(f) These electronic notifications will replace the paper notifications as from [Date].

4. Network Connection

[National/Regional Office] and WIPO will use FTP (File Transport Protocol) through public network for transmission of electronic documents.

5. Future Development

Where electronic communication is not yet applied in respect of all documents to be submitted under the procedures of the Madrid System, WIPO and [National/Regional Office] will continue their cooperation in order to extend electronic communications to other documents.

In case of modifications to the above, this Memorandum of Understanding will be amended accordingly.

6. Contact Point

WIPO: [Functional unit, name(s) and e-mail address(es)]

[National/Regional Office]: [Functional unit, name(s) and e-mail address(es)]

[End of Annex and of document]