

Trilingual Regime of International Registration System of Marks: "Trade Marks, Marques and Marcas"

Following the Thirty-Fifth session of the Assembly of the Madrid Union ("the Assembly"), taking place from 22 September to 1 October 2003, trade mark filers seeking protection in multiple countries through the Madrid Protocol will be able to file their international applications in Spanish as of 1 April 2004. Currently, international trade mark applications under the Madrid System are required to be filed in English or French.

The Director General of the World Intellectual Property Organization ("WIPO"), Dr. Kamil Idris, welcomed the decision stating: "[This] heralds a new era for international trademark protection. The adoption of Spanish as the third working language of the Madrid System is an historic development. It is an added incentive for hispanophone countries to join the system and paves the way for its wider use, making it a truly global registration system."

Spanish as the third working language of the International Registration System of Marks ("the Madrid System") has been under the spotlight since the Thirty-Third session in 2001 where the Secretariat of the Assembly ("the Secretariat") was requested to conduct a study on "The implications and advantages of including Spanish in the language regime of the Madrid System".

At the previous session, the Assembly acknowledged that a large number of the Madrid Union members had endorsed the initiative of adding Spanish within the Madrid System whilst others had asked for clarification of some issues before taking a clear position on the question. Accordingly, the Assembly decided to review this issue at the Thirty-Fifth session after holding further consultation with Madrid Union members and examining in detail the two scenarios of inclusion for Spanish set out in the Secretariat's study.

Background

More than 122 years old, the Madrid System has evolved; the Madrid Agreement was the first of its components, dating from 1891 and revised several times, completed subsequently by the Madrid Protocol, operational since 1 April 1996, introducing English as the second working language in the Madrid System.

The present adoption of Spanish as the third working language thus seems consistent with the evolutionary trend of the Madrid System. However, French remains the sole language of the Madrid Agreement.

It is therefore not surprising to note that the language regime of the Madrid System is set out in the Common Regulations, which administers both Madrid System treaties, and not in the treaties as such; so that any amendment in this regard can simply be made by the Assembly of the Madrid Union modifying the Common Regulations.

Incentive for inclusion of Spanish within the Madrid System

The addition of Spanish to the Madrid System is clearly connected with the drive to add new Contracting Parties. Although Spanish is the official language of 20 countries in the world representing around 400 million people, only Cuba and Spain are the current Spanish-speaking Contracting Parties to the Madrid System. Latin-American countries are thus under-represented within the Madrid Union. Furthermore, the absence of Spanish as a working language has been an insurmountable obstacle for many Latin-American countries to join the Madrid System. In many of these countries, use of the official language is a constitutional requirement impossible to circumvent. Publication of trade marks in the official language is indeed a prerequisite for validity of rights.

As a consequence, the inclusion of Spanish was perceived as a clear and strong incentive for those 18 remaining Spanish-speaking countries to join the Madrid System or, at the very least, to facilitate their accession.

Moreover, the inclusion of Spanish may also have the effect of encouraging the accession of non-hispanophone countries with strong commercial interests in Spanish-speaking markets and therefore with a need to secure trade mark protection in those jurisdictions.

Considering the number of designations of Cuba and Spain under the Madrid System coupled with the high volume of national filings in the remaining 18 hispanophone countries, it is anticipated that the participation of the latter to the Madrid System is likely to present a considerable interest to current users of this system as well.

Finally, a clear advantage is viewed for those Offices of Spanish-speaking countries already party to the Madrid System which have previously needed to work either in French or English.

Secretariat's Study

The Secretariat's study has identified two scenarios regarding the inclusion of Spanish within the Madrid System.

Scenario A consisted of putting Spanish on "the same footing as English". This means that the use of Spanish, as of English, would be permitted only insofar as the provisions of the Madrid Protocol are applicable in respect of international applications or registrations concerned.

Scenario B provided for "full integration of English, French and Spanish" into the entire Madrid System. This implies that all international applications could be filed in one of three languages, irrespective of whether the international applications are governed by the Madrid Agreement or the Madrid Protocol or both treaties.

Selected Scenario

The Spanish-speaking potential new members of the Madrid System/Union were represented by a specific entity "the Group of Latin American and Caribbean Countries" (GRULAC) and it is interesting to note that a majority of GRULAC expressed a clear preference for Scenario B.

However, many Madrid Union members (including China, Germany, Italy, Japan, Morocco, Monaco, Switzerland) as well as the delegation of the European Commission favored the implementation of Scenario A.

In the light of the obvious preference for Scenario A among the Madrid Union members, GRUTAC reconsidered its position and agreed on the inclusion of Spanish into the Madrid System on the basis of Scenario A.

Conclusion

With the forthcoming US accession, the European Union's instruments of accession expected to be submitted next year and with at least the potential accession of South American countries, the Madrid System is becoming more and more attractive as the option of choice for global trade mark protection.

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