



**WIPO | MADRID**

The International  
Trademark System

# How to obtain and maintain protection through the Madrid System

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**Madrid Registry**

**Phnom Pehn, June, 2015**

# Who may use the Madrid System?

- The Madrid System is a closed system
- The applicant must have a connection (entitlement) with a CP to use the system, through:
  - real and effective industrial or commercial establishment
  - domicile, or
  - nationalityin a CP
- A basic mark is required: a registration or application filed with the Office where applicant is entitled (OO)

# Abbreviations

- International Bureau (IB)
- International registration (IR)
- International application (IA)
- Office of origin (OO)
- Contracting Party (CP)
- Designated Contracting Party (DCP)
- Goods and services (G&S)

# International application: Contents of MM2

## **Mandatory**

- Applicant's name/address
- Entitlement
- Priority, if any
- The mark, its indications and/or description, if any
- Transliteration
- List of goods/services
- Designations
- Special requirements DCPs
- Fees

## **Optional**

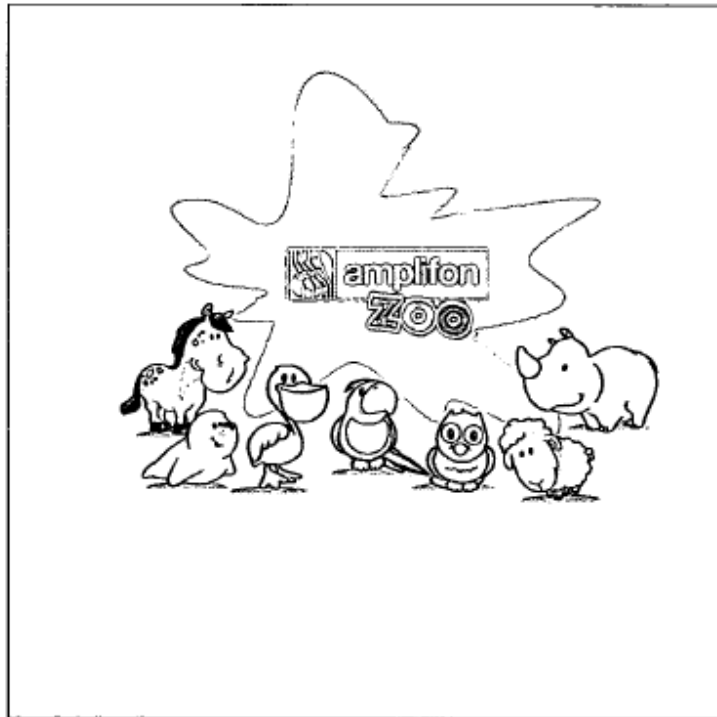
- Nationality or nature of legal entity
- Translation
- Where color is claimed, indication by words of the principal parts of the mark which are in color
- Disclaimer

# Appointment of a representative

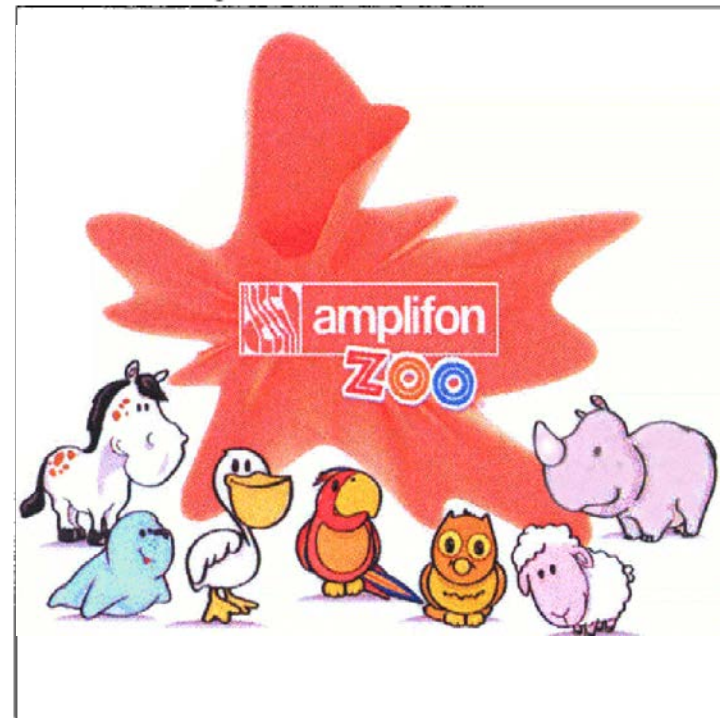
- To record the appointment in the International Register
  - Use MM12 form (optional), a simple letter, a power of attorney or even fill in information in most of the MM forms
- To record a representative to act on your behalf before the Offices of the designated Contracting Parties
  - You would need to check with the Offices concerned, to meet their requirements

**7****THE MARK**

(a) Place the reproduction of the mark, as it appears in the basic registration, in the square below.



(b) Where the reproduction in item (a) is in black and white and color is claimed in item 8, place a color reproduction of the mark in the square below.



(c)  The applicant declares that he wishes the mark to be considered as a mark in standard characters.

(d)  The mark consists of a color or a combination of colors as such

Where the Office of origin has addressed this form by telefacsimile, the present space must be completed before addressing the original of this page to the International Bureau.

Number of basic registration or Office reference as shown on the first page of this form: .....

Signature by the Office of origin: .....

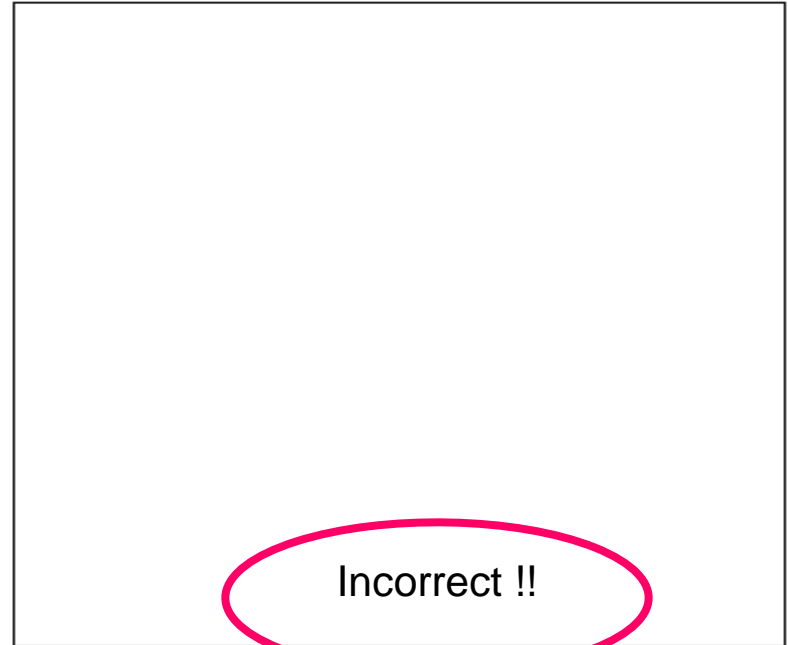
7

THE MARK

(a) Place the reproduction of the mark, as it appears in the basic application or basic registration, in the square below.



(b) Where the reproduction in item (a) is in black and white and color is claimed in item 8, place a color reproduction of the mark in the square below.



Incorrect !!

(c)  The applicant declares that he wishes the mark to be considered as a mark in standard characters.

(d)  The mark consists of a color or a combination of colors as such.

Where the Office of origin has addressed this form by facsimile, the present space must be completed before addressing the original of this page to the International Bureau.

Number of basic registration or Office reference as shown on the first page of this form: .....

Signature by the Office of origin: .....

# Item 7(d): Color mark

7

## THE MARK

(a) Place the reproduction of the mark, as it appears in the basic application or basic registration, in the square below.



- A color or combination of colors is used to distinguish goods and services of one enterprise from another
- It is not that the mark is in color nor that color is claimed
- Can only be claimed if also claimed in the basic mark
- In many jurisdictions, color, as such, may not be registered as a mark

(c)  The applicant declares that he wishes the mark to be considered as a mark in standard characters.

(d)  The mark consists exclusively of a color or a combination of colors as such, without any figurative element.



# Transliteration and translation

**7** THE MARK

(a) Place the reproduction of the mark, as it appears in the basic application or basic registration, in the square below.

(b) Where the reproduction in item (a) is in black and white and color is claimed in item 8, place a color reproduction of the mark in the square below.

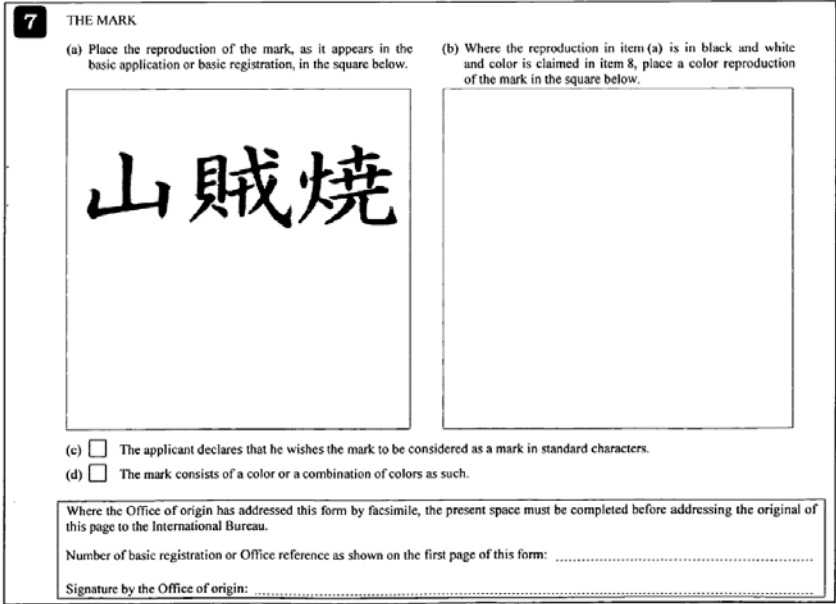
(c)  The applicant declares that he wishes the mark to be considered as a mark in standard characters.

(d)  The mark consists of a color or a combination of colors as such.

Where the Office of origin has addressed this form by facsimile, the present space must be completed before addressing the original of this page to the International Bureau.

Number of basic registration or Office reference as shown on the first page of this form: .....

Signature by the Office of origin: .....



山賊焼

- (a) Transliteration of the mark (this information is compulsory where the mark consists of or contains matter in characters other than Latin characters, or numerals other than Arabic or Roman numerals):

The transliteration of the mark is “SANZOKU-YAKI.”

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- (b) Translation of the mark (as may be required by certain designated Contracting Parties):

- (i) into English: The first two Japanese characters may be translated as “bandits” and the third Japanese characters may be translated as “grill.”
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# Indication of goods & services (G&S)

- Indicate the G&S for which the mark is to be protected
- The G&S must reflect the scope of the basic mark
- The list cannot be broader than the list in the basic mark
- Indications should be grouped according to the Nice Classification
- The IB will not accept indications such as “*all goods in cl. X*”
- The IB accepts class headings, but the DCPs may not
- If possible, use the Madrid Goods and Services Database (MGS); pre-approved indications with check-acceptance feature

# Designations

- At least one CP must be selected
- Cannot designate the country of origin
- Some CPs require specific information
- The European Union:
  - Indicate a second language before the Office of the EU
  - Seniority claim (MM17)
- Intent to use: India, Ireland, New Zealand, Singapore or the UK
  - You declare your intent to use simply by designating these CPs
- The USA: Declaration of intention to use the mark (MM18)
- Fees to be paid in two parts: Cuba, Ghana and Japan

# Fees

- Fees payable to WIPO in Swiss francs
  
- Basic fee\* includes 3 classes of goods/services
  - 653 Swiss francs - b/w reproduction of mark
  - 903 Swiss francs - color reproduction of mark
  
- Fees for designating CPs:
  - Standard fees: Complementary (100 Swiss francs per DCP and supplementary (100 Swiss francs per class beyond 3)

OR

- Individual fees where this is declared

\* Applicants from Least Developed Countries pay only 10% of the basic fee

# Certification by the OO

## 13 CERTIFICATION AND SIGNATURE OF THE INTERNATIONAL APPLICATION BY THE OFFICE OF ORIGIN

### (a) Certification

The Office of origin certifies

- (i) that the request to present this application was received on 12/05/2014 (dd/mm/yyyy).
- (ii) that the applicant named in item 2 is the same as the applicant named in the basic application or the holder named in the basic registration mentioned in item 5, as the case may be,  
that any indication given in item 7(d), 9(d) or 9(e) appears also in the basic application or the basic registration, as the case may be,  
that the mark in item 7(a) is the same as in the basic application or the basic registration, as the case may be,  
that, if color is claimed as a distinctive feature of the mark in the basic application or the basic registration, the same claim is included in item 8 or that, if color is claimed in item 8 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  
that the goods and services listed in item 10 are covered by the list of goods and services appearing in the basic application or basic registration, as the case may be.

Where the international application is based on two or more basic applications or basic registrations, the above declaration shall be deemed to apply to all those basic applications or basic registrations.

(b) Name of the Office: THE SWEDISH PATENT AND REGISTRATION OFFICE

Kerstin Dullaghan

Name and signature of the official signing on behalf of the Office: 16/05/2014

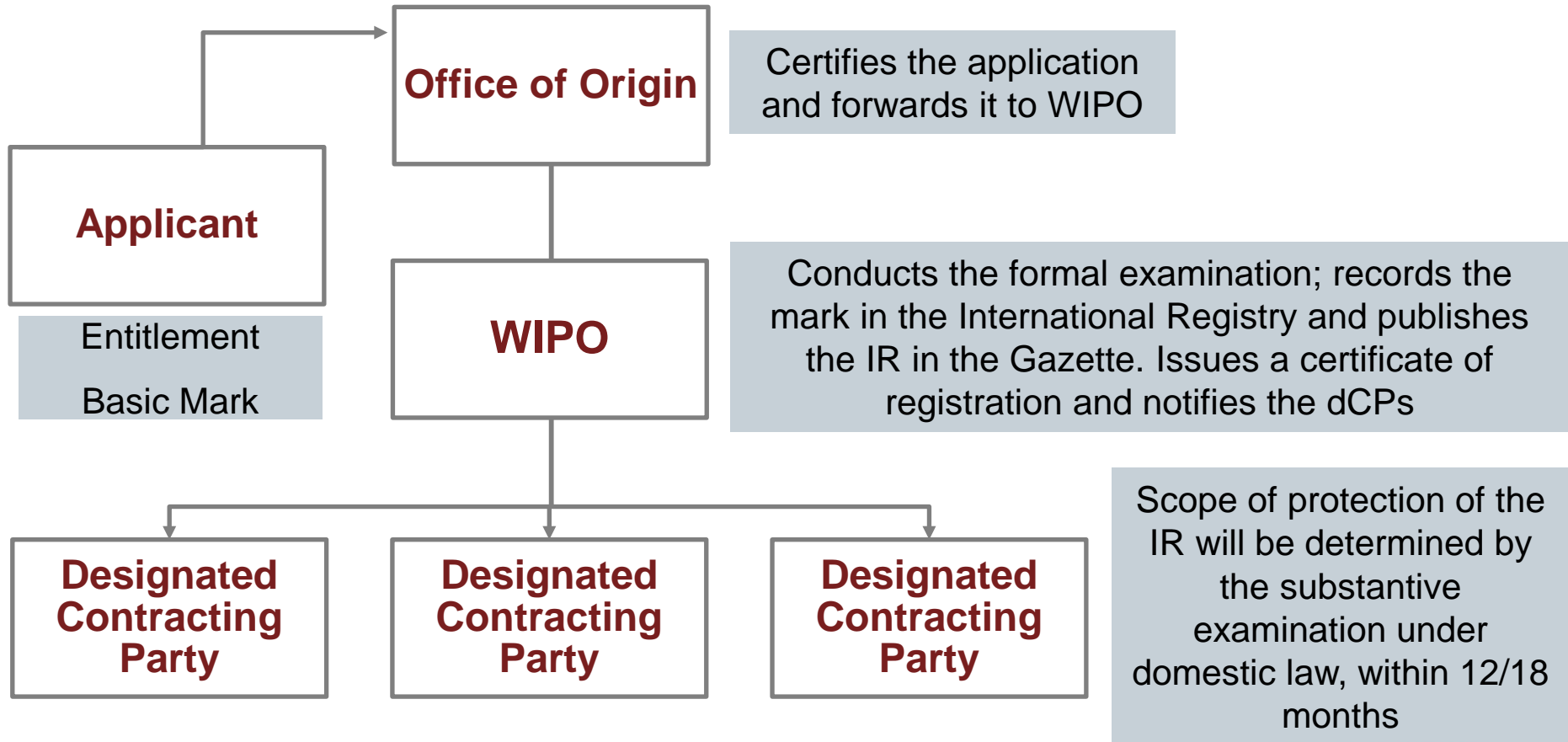
K Dullaghan



# The role of the Office of origin

- Provide advice to applicants
- Certify the international application (IA)
- Reply to or remedy irregularities
- Keep track of basic mark in a 5 year period
  - Notify ceasing of effect
- Forward official forms to the IB on behalf of the holder

# The international procedure



# Role of the International Bureau (IB)

- The IB examines the formalities, such as
  - Information in the international application
  - Classification of goods and services (Nice)
  - Classification of figurative elements (Vienna)
  - Fees
  
- The IB will
  - Register the mark in the International Register
  - Notify the Offices of DCPs, inform the OO and send a certificate to the holder/representative
  - Publish the mark in the WIPO Gazette of International Marks (e-Gazette)



# 3 categories of irregularities

## 1) Classification of goods and services (Rule 12)

- Goods and services not properly classified
- Office of origin to remedy

## 2) Indication of goods and services (Rule 13)

- Too vague, linguistically incorrect, or incomprehensible
- Office of origin to remedy

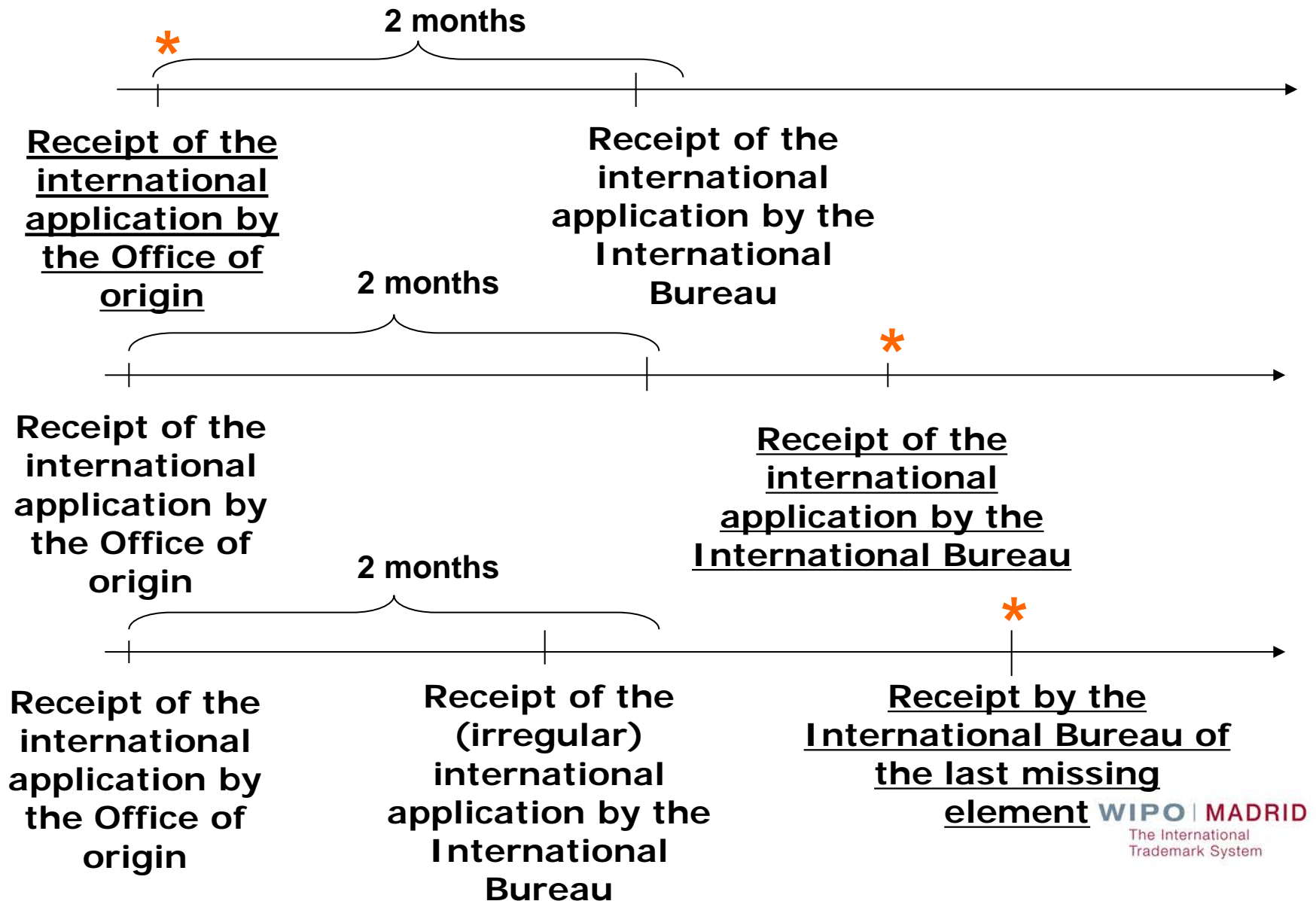
## 3) Miscellaneous (Rule 11)

- Entitlement, basic mark/priority, MM18, fees, etc.
- Office or origin, applicant or both to remedy

# Date of the International Registration (IR)

- Date of reception of the international application by OO, if received by IB within 2 months
- If received by the IB after the period of 2 months, then the date of registration will be the date of receipt in the IB
- The date of IR may be affected if the following substantive elements are missing (Rule 15)
  - Identity of the applicant
  - Designated CPs
  - Reproduction of the mark
  - Indications of G&S
- The date of IR will be the date the last missing element was received by the IB

# Date of the IR\* (2)



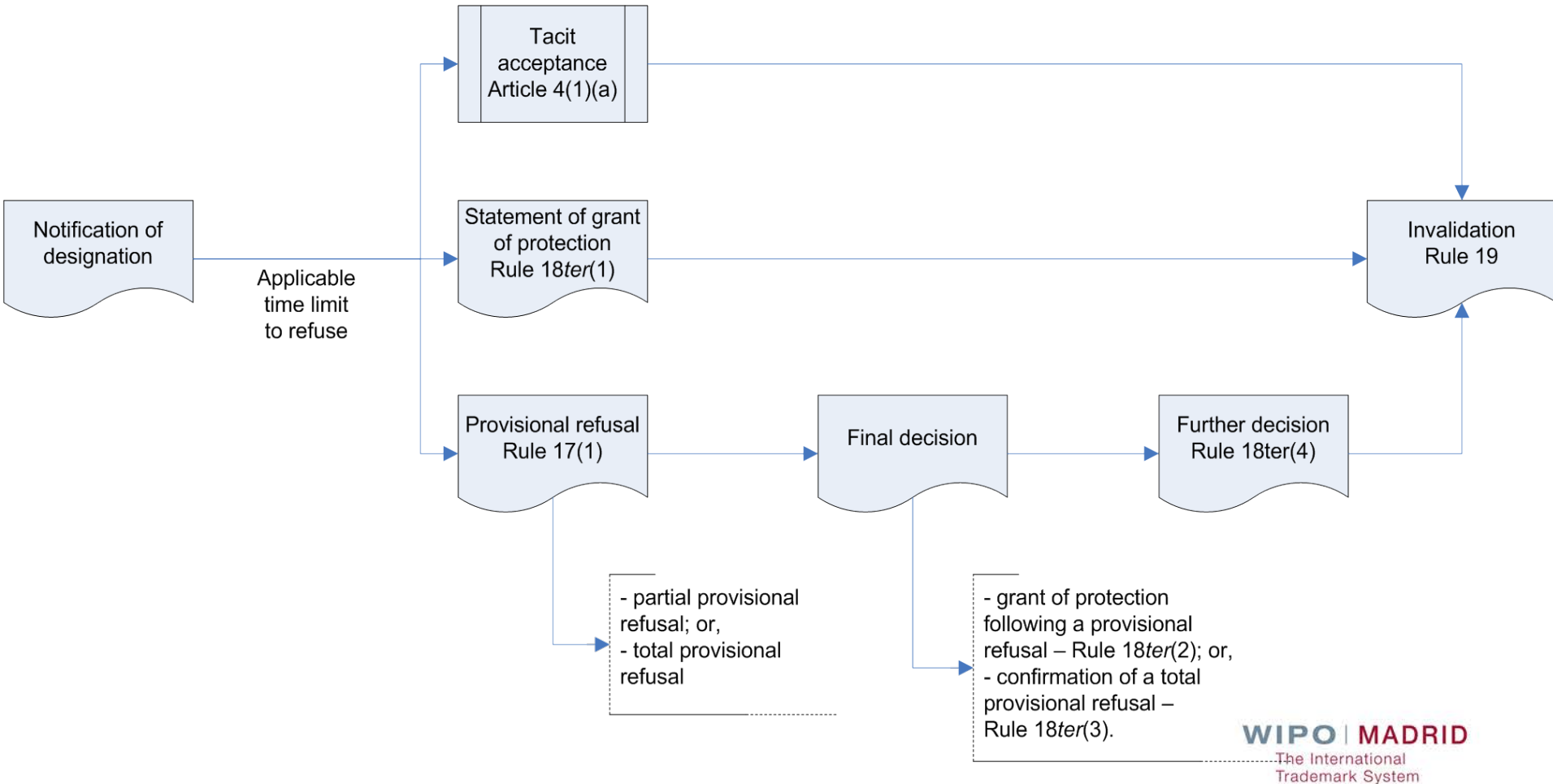
# Effects of an international registration

- From the date of the IR, the protection of the mark in each of the DCPs is the same as if
  - the mark had been filed directly with the Office of that Contracting Party, and
  - the mark had been registered by the Office of that Contracting Party, if no refusal is notified within the applicable time limit

# Role of the Office of a DCP

- The role of the designated Office will follow from the domestic legislation, which set the conditions for protecting a trademark
- Offices of DCPs may communicate the status of protection of a mark through various statements in the course of their examination
  - Provisional refusal – Rule 17
  - Interim status – Rule 18*bis*
  - Statement of grant of protection – Rule 18*ter*(1)
  - Final decisions – Rule 18*ter*(2) and (3)
  - Further decision – Rule 18*ter*(4)
  - Invalidation – Rule 19

# Communications on scope of protection



# How to manage and maintain an IR

- Various processes you may take advantage of during the lifespan of an IR
  - Subsequent designations
  - Restrictions in the protection of an IR
    - Limitations, renunciations and cancellations
  - Change in ownership
  - Change in name/address of holder/representative
  - Renewal
  - Transformation
  - Replacement

# Subsequent designation

- Possible to add more CPs to the existing IR – MM4
- A holder from Cambodia may subsequently designate any CP which is also bound by the Protocol
- Declaration under Article 14(5)
- Follows the same lifetime cycle (renewal) as the IR
- Certain requirements for certain DCPs
- List of G&S must be within the scope of the IR
- The forms may be sent directly to the IB by the holder
- Webform - <https://www3.wipo.int/osd/>
- Recording, publication and notification: Refusal procedure of Rules 16 to 18 applies



# Date of subsequent designation

- MM4 presented directly to the IB – it will bear the date it was received by the IB
- MM4 presented through an Office – it will bear the date it was received by the Office, provided that the IB received it within 2 months from that date
- Where subsequent designation contains a request that it take effect immediately after some other event, the subsequent designation will bear the date of the recording of that other event
- Irregularities may effect the date of subsequent designation

# Restrictions in the protection of the IR

- The holder may wish to record restrictions in the protection of his IR as
  - a limitation (MM6)
  - a renunciation (MM7) or
  - a cancellation (MM8)
- Forms to be presented to the IB directly by the holder or by the Office of the CP of the holder

# Limitation (MM6)

- If you want to reduce the list of G&S for all or some of the DCPs in the IR, you can use the form for limitation
- Can be used to prevent or overcome a provisional refusal
- One MM6 form may contain a limitation for several IRs
- Fee of 177 Swiss francs per form payable to the IB
- The G&S are not removed from the IR as recorded in the International Register
- The G&S can later be subject to subsequent designation
- The DCP affected by the limitation may declare that it has no effect
  - 18 months time limit from date of notification

# Renunciation (MM7)

- If you want to abandon the effects of the IR for one or some of the DCPs, you can use the form for renunciation
- Can be used where you may have received a total refusal or no longer wish to obtain protection in a DCP
- One form may be used to request the recording of a renunciation of several IRs
- The G&S may be subject to subsequent designation
- No fee for the recording of a renunciation

# Cancellation (MM8)

- If you want to cancel the effects of an IR for all or some of the G&S in respect of all the DCPs, you can use the form for cancellation
- Total or partial cancellation – all or some only of the G&S
- The G&S concerned will be permanently removed from the International Register
- No subsequent designation will be possible
- If you later wish to obtain protection for the part of the IR that has been cancelled, you would need to file a new international application
- No fee for the recording of a cancellation

# Limitation, renunciation and cancellation

	<b>Limitation (MM6)</b>	<b>Renunciation (MM7)</b>	<b>Cancellation (MM8)</b>
Goods & Services	Some	All	Some or All
Designated Offices	Some or All	Some	All
Subsequent Designations	✓	✓	✗
Fees	177 CHF	Free of charge	Free of charge

# Change in Ownership – MM5

- New owner must be entitled
- Total or partial change in ownership
  - Partial: Create new IR; using same number + A,B,C...
- MM5 to be presented to the IB by the holder, by the Office of the CP of the holder or by the Office of the CP of the transferee
- A fee of 177 Swiss francs per IR in the MM5 form
- The IB will record the change and notify the DCPs concerned
- The effects of the recording is a matter for the jurisdictions concerned
- Declaration that a change in ownership has no effect
  - 18 months time limit from date of notification

# Changes in the name and/or address

- Change of name and/or address of the **holder**
  - Form MM9 is compulsory
  - To be presented to the IB directly by the holder or through the Office of the CP of the holder
  - A fee of 150 Swiss francs for one or several IRN
- Change of name and/or address of the **representative**
  - Form MM10 is optional
  - To be presented to the IB directly
  - No fee for the recording



# Renewal of an IR

- The IR is valid for a period of 10 years
- The IB will send unofficial notice 6 months before the expiry of the IR
- Any modifications to be made, shall be duly presented on the required form, **before** or **after** the renewal
  - Possible to renew for some DCP only
  - Partial renewal possible where DCP has issued final decision
- Payment directly with the IB
- Fees are due at the date of expiry at the latest
  - 6 months grace period (+ 50% basic fee)
  - Payment by credit card or current account with WIPO
  - E-renewal <http://www.wipo.int/e-marks>

# Ceasing of effect and transformation

- For a period of 5 years from the date of its registration, the IR remains dependent on the basic mark
- If the basic mark ceases to have effect, the OO shall request the cancellation of the IR to the same extent
- Not necessarily due to a 3rd party “Central Attack”
- The IB will record the notification, cancel the IR to the extent applicable, inform the DCPs and the holder
  
- Transformation is possible to preserve acquired rights
- Need to file with the national/regional Office
- No WIPO procedure

# Replacement

- Where you have a prior national/regional registration with a Madrid member, you may request replacement
- May reduce costs related to renewals and local agents
- Requirements:
  - Both registrations must be the name of the same holder
  - Protection of the IR extends to the said CP
  - All the G&S in the prior registration are also listed in the IR
- You may request the Office to take note in its Register, to alert 3<sup>rd</sup> parties of your continuation of rights
- More details in Article 4*bis* and Rule 21

# Contact details

- For general questions about the Madrid System
  - Madrid Customer Service [intreg.mail@wipo.int](mailto:intreg.mail@wipo.int)
  - Telephone: + 41 22 338 8686
  
- For questions regarding specific international applications or international registrations
  - Madrid Team 2: [madrid.team2@wipo.int](mailto:madrid.team2@wipo.int)
  - Telephone: + 41 22 338 750 2

Thank you  
for your attention

[debbie.roenning@wipo.int](mailto:debbie.roenning@wipo.int)

