

■ The Madrid System

Preparing an International Application

Maintaining an International Registration

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Madrid Registry

MADRID AGREEMENT AND PROTOCOL CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

APPLICATION FOR INTERNATIONAL REGISTRATION GOVERNED EXCLUSIVELY BY THE MADRID PROTOCOL

(Rule 9 of the Common Regulations)

IMPORTANT

1. The present **MM2** form is to be used where the international application is governed exclusively by the **Madrid Protocol**. This will be the case:
 - where the *Office of origin* (see items 1 and 3) is the Office of a Contracting Party which is bound by the *Madrid Protocol only*, or
 - where the *Office of origin* is the Office of a Contracting Party which is bound by both the *Madrid Agreement and the Protocol*, and where all the designated Contracting Parties are party to the *Protocol*, irrespective of whether or not they are also party to the Agreement.
2. If the international application is governed exclusively by the **Madrid Agreement**, the form to be used is form **MM1**. If it is governed by both the **Madrid Agreement** and the **Protocol**, the form to be used is form **MM3**.
3. This form must be sent to the **Office of origin**. It must not be sent directly to the International Bureau.

Contents - 4 Substantive Requirements

- The applicant
- The reproduction of the mark
- The designations of Contracting Parties
- The list of goods and services

Other Contents

- OO
- Entitlement to file
- Priority claim
- Representative
- Seniority claim
- Declaration of intention to use the mark
- Fees
- Certification with date and signature/seal
- Basic registration
- Basic application
- Type of mark
 - Color, three-dimensional, sound, certification, collective, guarantee mark, disclaimer, translation, etc...
- Transliteration of the mark

Representation

4

APPOINTMENT OF A REPRESENTATIVE (if any)

Name:

Address:

.....

Telephone: Fax:

E-mail address:

- Appointment of a representative is not required
- No special formalities or documents to appoint a representative
- No “blanket” appointments; each IRN must be indicated
- No special requirements to be a representative
- Only one recorded representative per international application
- Any member of a law firm may act as representative
- A new appointment cancels a previous appointment
- Appointment may be cancelled at any time at the request of the holder or the representative

The 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.

(b) Where the reproduction in item (a) is in black and white and color is claimed in item 5, 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: _____

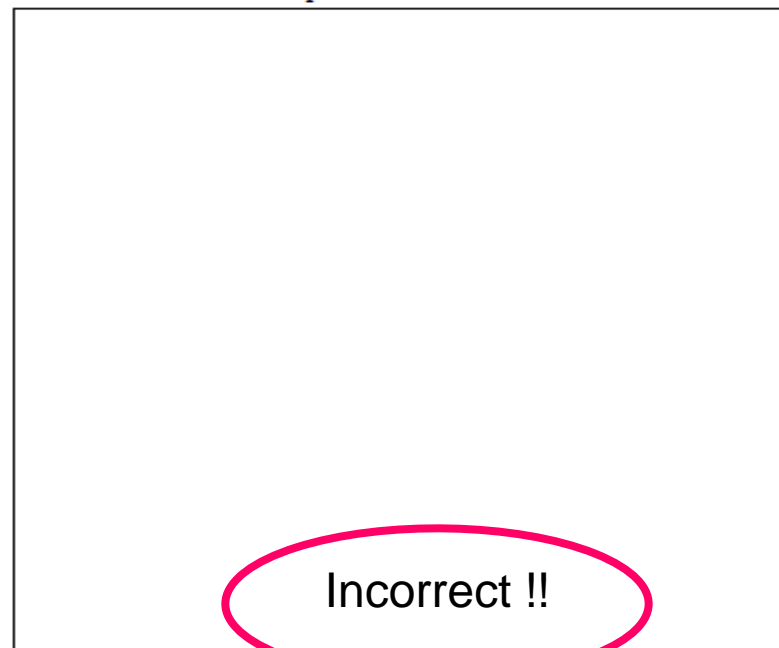
- Reproduction must be **identical** to the basic mark
- Sufficient quality for recording, publication and notification
- Mark may be typed, printed, pasted, etc.
- Two-dimensional reproduction of the mark should fit in the 8x8cm box (a)
- Box (b) should only be used if:
 - basic mark is in color, and
 - color was claimed, but
 - OO does not allow registration or reproduction in color

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:

8

COLOR(S) CLAIMED

- (a) ☒ The applicant claims color as a distinctive feature of the mark.

Color or combination of colors claimed: Red and green.

- (b) Indication, for each color, of the principal parts of the mark that are in that color (as may be required by certain designated Contracting Parties):

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:

8

COLOR(S) CLAIMED

- (a) ☒ The applicant claims color as a distinctive feature of the mark.

Color or combination of colors claimed: Orange (Pantone 151).

- (b) Indication, for each color, of the principal parts of the mark that are in that color (as may be required by certain designated Contracting Parties):

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:

- (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.”

.....

- (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.”

Goods and Services

10 GOODS AND SERVICES

(a) Indicate below the goods and services for which the international registration is sought:

Please use font “**Courier New**” or “**Times New Roman**”, size 12 pt, or above

Class

Goods and services

42 SCIENTIFIC AND TECHNOLOGICAL SERVICES AND RESEARCH AND DESIGN RELATING THERETO; INDUSTRIAL ANALYSIS AND RESEARCH SERVICES; DESIGN AND DEVELOPMENT OF COMPUTER HARDWARE AND SOFTWARE (SERVICES ON BEHALF OF THIRD PARTIES)

43 SERVICES FOR PROVIDING FOOD AND DRINK; TEMPORARY ACCOMMODATION (SERVICES ON BEHALF OF THIRD PARTIES).

- Must correspond to the scope of the basic mark. It can be narrower, but not broader
- Indications should be grouped in the appropriate class of the [Nice classification](#), preferably using terms of the [G&S Manager](#)
- IB accepts class headings; although, not all designated Offices will
- IB would not accept indications such as “*all goods in class X*”

Designated Contracting Parties

- Certain requirements for certain CPs
- To declare in the MM2 form:
 - 2nd language EU – chose among English, French, German, Italian and Spanish
 - Intent to use-declaration by designating UK, Singapore, Ireland and New Zealand
- To declare on separate forms:
 - Seniority claim for earlier mark registered in or for a Member State of the EU (MM17)
 - Declaration of intention to use the mark for USA (MM18)
- 3 CPs require fees to be paid in two parts (CU, GH, JP)

Designating the US

MM18(E)

DECLARATION OF INTENTION TO USE THE MARK: UNITED STATES OF AMERICA

By designating the United States in the international application/subsequent designation, the person signing below declares that:

- (1) the applicant/holder has a *bona fide* intention to use the mark in commerce that the United States Congress can regulate on or in connection with the goods/services identified in the international application/subsequent designation;
- (2) he/she is properly authorized to execute this declaration on behalf of the applicant/holder;
- (3) he/she believes applicant/holder to be entitled to use the mark in commerce that the United States Congress can regulate on or in connection with the goods/services identified in the international application/subsequent designation; and
- (4) to the best of his/her knowledge and belief no other person, firm, corporation, association, or other legal entity has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive.

I declare under penalty of perjury under the laws of the United States of America that all the foregoing statements are true and correct to the best of my knowledge and belief. I understand that willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, and are punishable by fine or imprisonment, or both (18 U.S.C. §1001). 35 U.S.C. §25(b).

Signature

Date of execution (dd/mm/yyyy)

Signatory's Name (Printed)

Signatory's Title

INSTRUCTION

This declaration must be signed by:

- (1) the applicant/holder or a person with legal authority to bind the applicant/holder; or
- (2) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the applicant/holder; or
- (3) an attorney who is authorized to practice before the United States Patent and Trademark Office under 37 C.F.R. §10.1(c), who has an actual written or verbal power of attorney or an implied power of attorney from the applicant/holder.

INFORMATION REQUIRED BY THE INTERNATIONAL BUREAU

- (a) Where the present declaration refers to an international application based on a basic application, indicate:
Basic application number: Date of the basic application: (dd/mm/yyyy), or
- (b) Where the present declaration refers to an international application based on a basic registration, indicate:
Basic registration number: Date of the basic registration: (dd/mm/yyyy), or
- (c) Where the present declaration refers to a subsequent designation of an international registration, indicate:
International registration number:
- International Bureau's reference (where applicable):
- Name of applicant/holder:

■ Declaration of intention to use the mark:

http://www.wipo.int/edocs/madrdocs/en/2003/madrid_2003_23.pdf

■ Indications of goods and services:
http://www.wipo.int/edocs/madrdocs/en/2003/madrid_2003_24.pdf

■ Filing affidavit of continued use in commerce:
http://www.wipo.int/edocs/madrdocs/en/2010/madrid_2010_16.pdf

WIPO | MADRID
The International
Trademark System

Calculating the Fees

■ Basic fee:

■ B/W 653 CHF

■ Color 903 CHF

■ Standard fees:

■ Complementary 100 CHF

■ Supplementary* 100 CHF
* per class beyond three

■ Individual fees**

** except for Article 9sexies(1)(b)

■ Use fee calculator

(b) AMOUNT OF FEES (see Fee Calculator: www.wipo.int/madrid/en/fees/calculator.jsp)

Basic fee: 653 Swiss francs if the reproduction of the mark is in black and white only and 903 Swiss francs if there is a reproduction in color. (For international applications filed by applicants whose country of origin is a Least Developed Country, in accordance with the list established by the United Nations (www.wipo.int/lde/en/country), 65 Swiss francs if the reproduction is in black and white only and 90 Swiss francs if there is a reproduction in color.)

Complementary and supplementary fees:

Number of designations for which complementary fee is applicable	Complementary fee	Total amount of the complementary fees
..... x 100 Swiss francs	= =>

Number of classes of goods and services beyond three	Supplementary fee	Total amount of the supplementary fees
..... x 100 Swiss francs	= =>

Individual fees (Swiss francs):

Designated Contracting Parties	Individual fee	Designated Contracting Parties	Individual fee
.....
.....
.....
.....
.....

Total individual fees =>

GRAND TOTAL (Swiss francs)

Payment

(a) INSTRUCTIONS TO DEBIT FROM A CURRENT ACCOUNT

☐ The International Bureau is hereby instructed to debit the required amount of fees from a current account opened with the International Bureau (if this box is checked, it is not necessary to complete (b)).

Holder of the account: Account number:

Identity of the party giving the instructions:

(c) METHOD OF PAYMENT

Identity of the party effecting the payment:

Payment received and acknowledged by WIPO

☐

WIPO receipt number

.....

Payment made to WIPO bank account
IBAN No. CH51 0483 5048 7080 8100 0
Credit Suisse, CH-1211 Geneva 70
Swift/BIC: CRESCHZZ80A

☐

Payment identification

dd/mm/yyyy

.....

Payment made to WIPO postal account
IBAN No. CH03 0900 0000 1200 5000 8
Swift/BIC: POFICHBE

☐

Payment identification

dd/mm/yyyy

.....

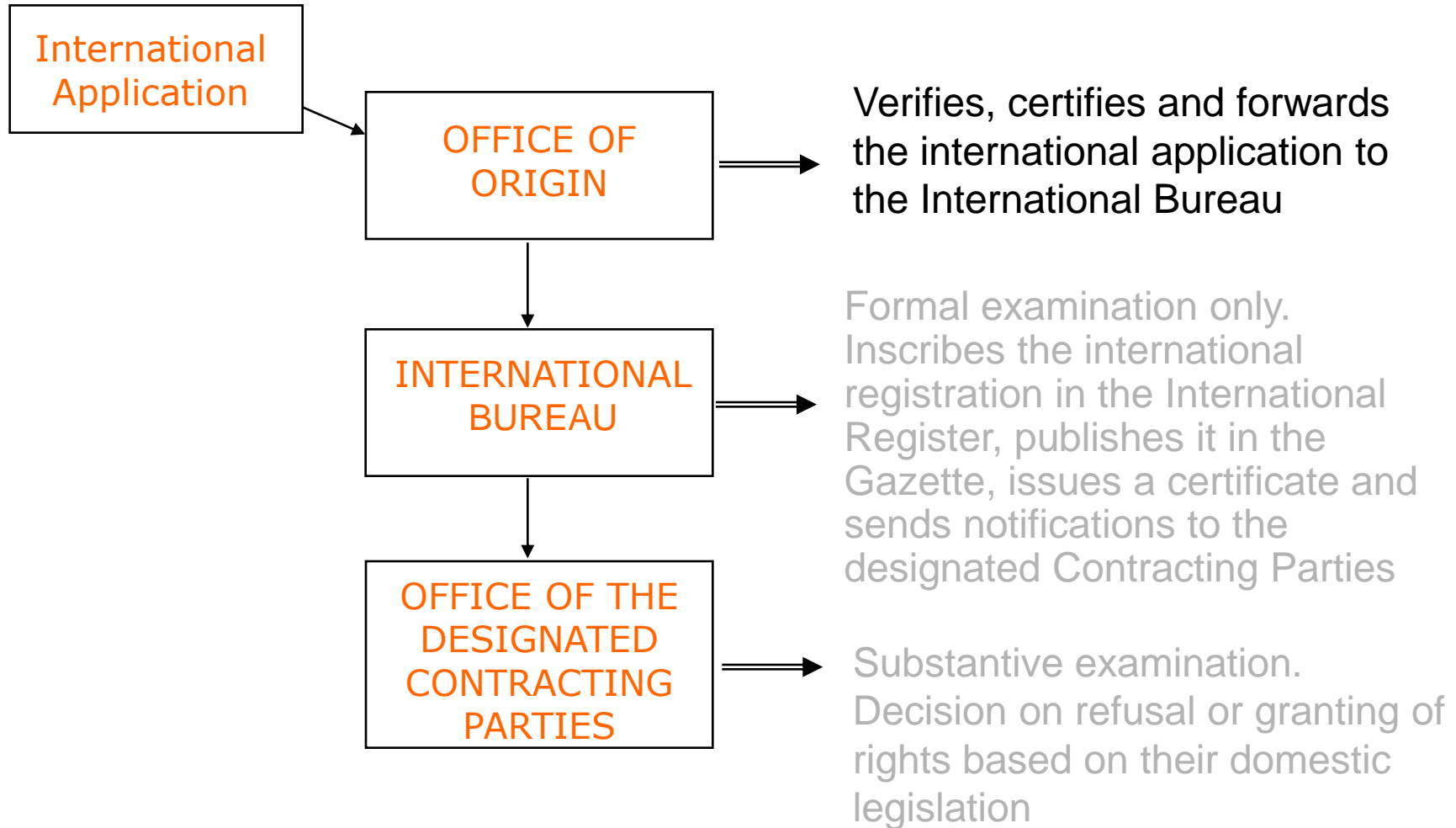
Office of Origin (OO)

- Providing advice to applicants
- Certification of the international application (IA)
- Reply to or remedy irregularities
- Keeping track of basic mark in a 5 year period
 - Notifications of ceasing of effect
- Forwarding official forms on behalf of holder

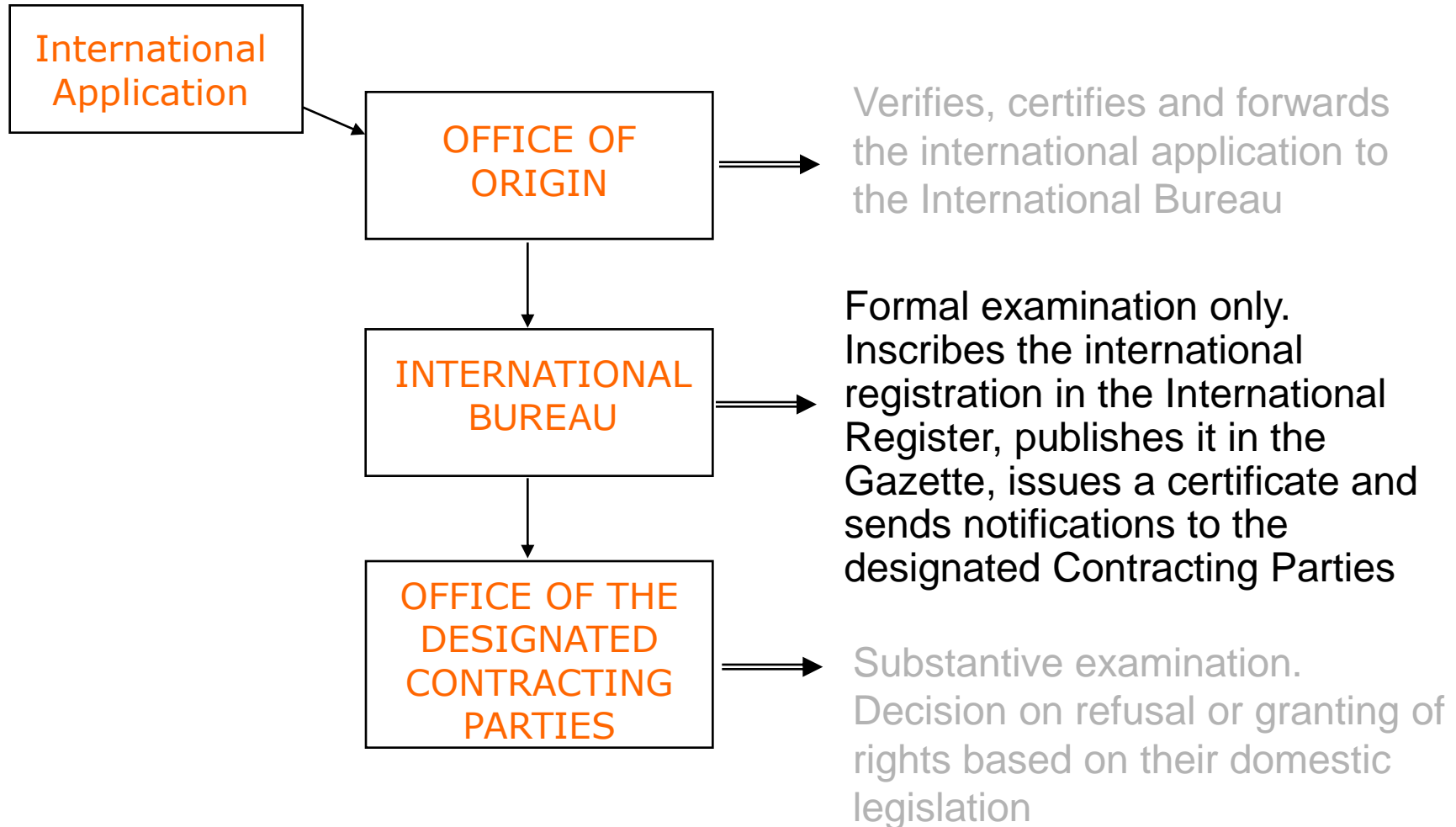
Certification and Signature

- Basic mark and international mark
- Applicant (s)
- Goods and services (G&S)
- Date on which the OO received the IA
- Other contents of the IA
- Signature/seal on the IA

International Registration Procedure



International Registration Procedure



3 Categories of Irregularities

- Miscellaneous – **OO, applicant or both to remedy**
 - OO: Entitlement, Basic registration/application, priority, MM18, fees, etc. (**Rule 11**)
- Classification of G&S – **OO to remedy**
 - G&S not in the appropriate classes or not classified (**Rule 12**)
- Indication of G&S – **OO to remedy**
 - Too vague, linguistically incorrect, or incomprehensible (**Rule 13**)

Irregularities Rule 11

■ To be remedied by Office of origin:

- official form is not used
- application is defective
- entitlement issues found
- date or number of basic application or registration is missing
- certification is irregular
- signature of the Office is missing
- insufficient fees, where Office collects and forward fees
- *Form MM18 missing*

■ To be remedied by the applicant:

- address is not sufficient for postal delivery
- reproduction of the mark is not clear
- transliteration of the mark is missing
- description of the mark is in a non working language
- insufficient fees, where paid directly by applicant
- *Form MM18 is missing*

Rule 11: Procedure

- Proposal from IB (3 months time-limit)
- OO' s / applicant' s response
 - Corrected = registered
 - Not corrected = **abandoned**
- No response from OO / applicant = **abandoned**
- Refund: Fees paid minus ½ basic fee (black & white)

Rule 12: Procedure

- Proposal from IB (3 months time-limit/+ reminder)
- OO' s response
 - IB withdraws (fees paid) = registered as filed
 - IB modifies or confirms (fees paid) = registered as per modification or IB' s proposal
- No response from OO
 - Fees paid = registered as per IB' s proposal
 - Fees not paid = **abandoned (refund)**
- **IB' s OPINION PREVAILS (Art. 3(2))**
- Refund: Fees paid minus ½ basic fee (black & white)

Rule 13: Procedure

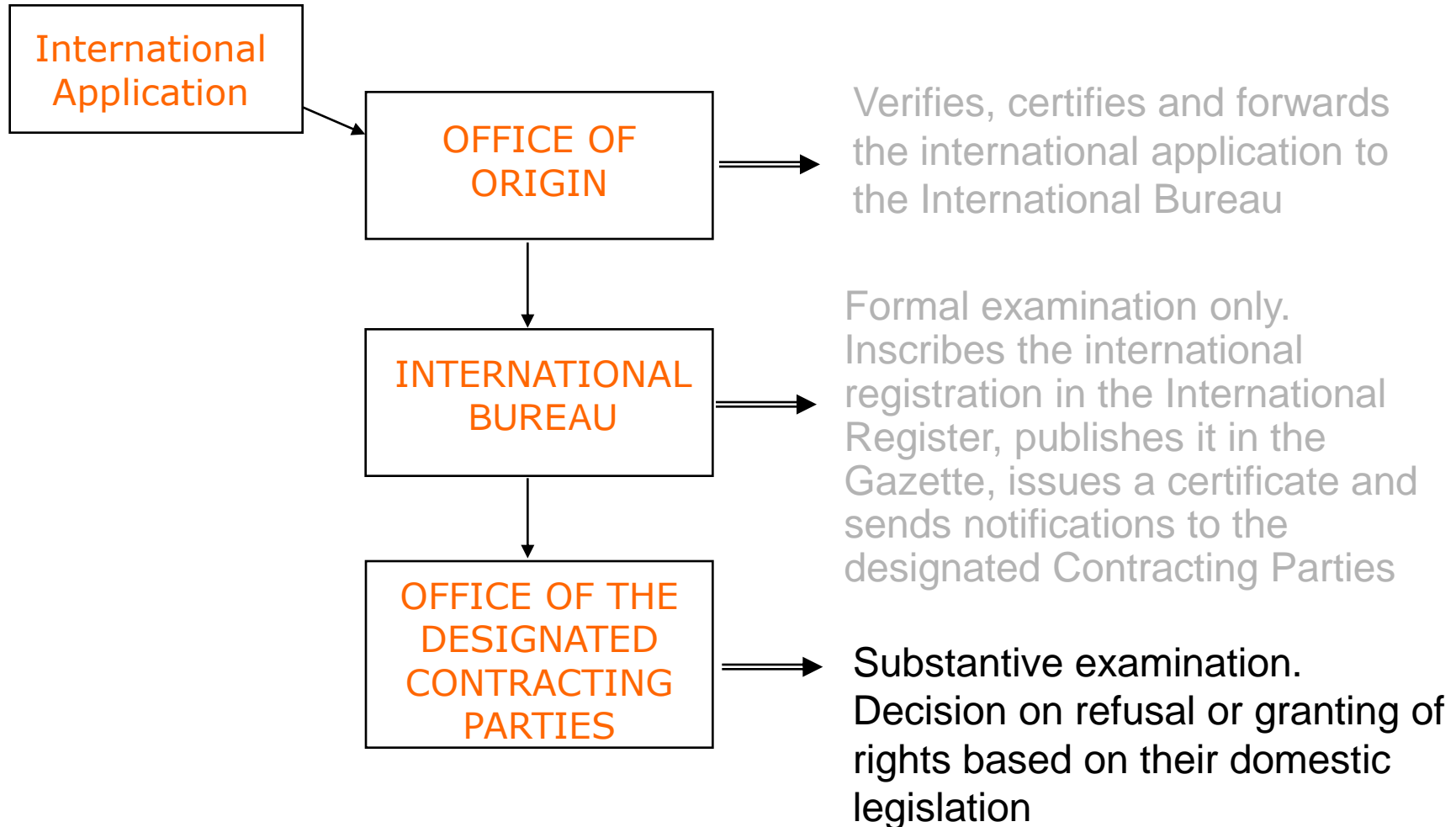
- Suggestions from IB (3 months time-limit)
- OO' s response
 - Accepted by IB = Registered as per OO' s opinion
 - Rejected by IB :
 - Registered (term deleted if not classified)
 - Registered as filed (if term is classified, with annotation)
- No response from OO
 - Registered as filed, with annotation

Date of the International Registration (IR)

- Date of reception of the IA by OO, if received 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 any of the following substantive elements is 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

Maintaining an International Registration

International Registration Procedure



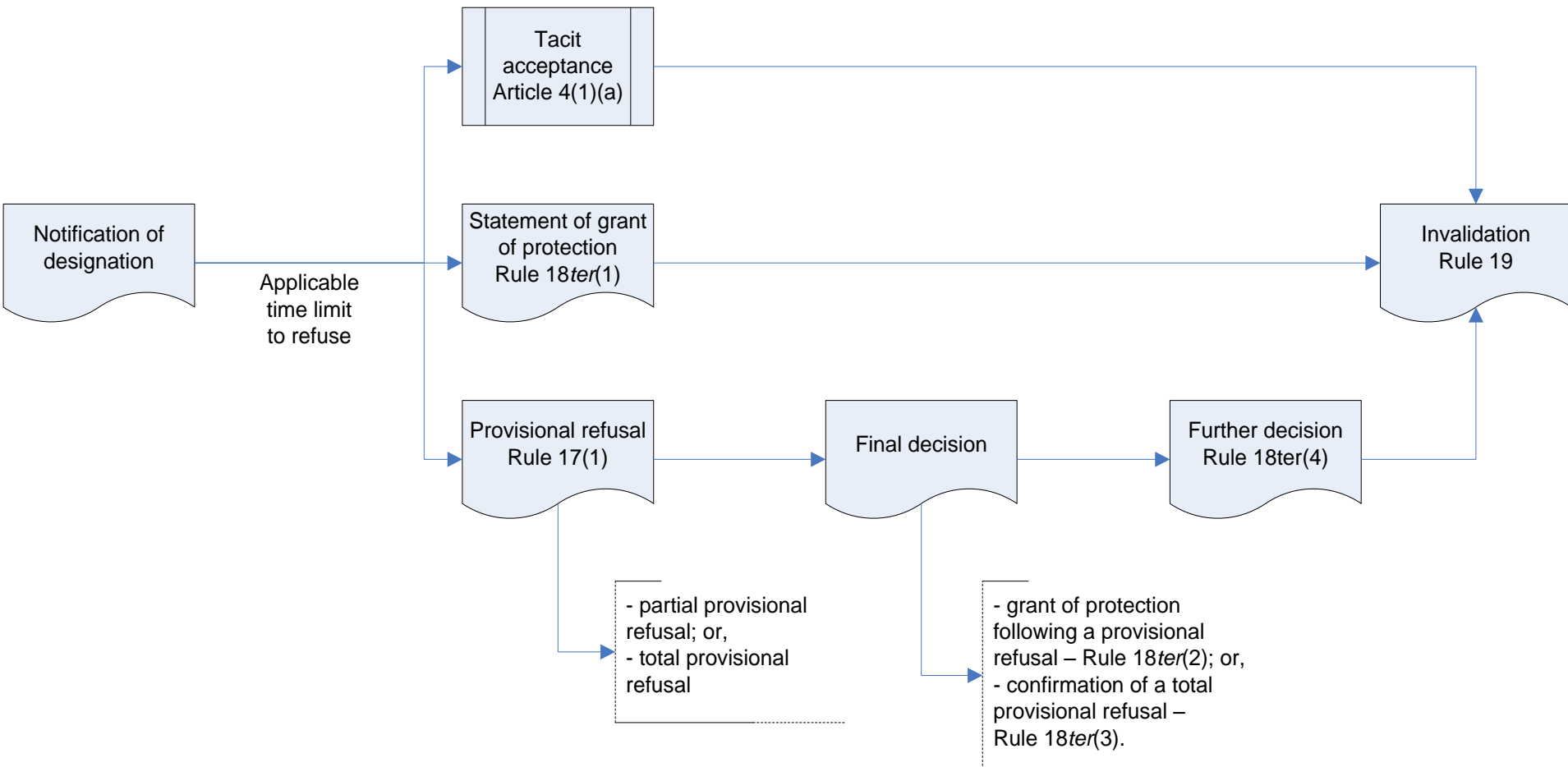
The Role of the Office of the DCP

- The role of the designated Office will follow from the domestic legislation
- The domestic legislations of the designated CPs set the conditions for protecting a trademark and determine the rights which result from protection
- The Madrid system offers the possibility for these Offices to issue decisions on the status of protection
 - Provisional refusals, statements of grant of protection, final decisions
 - Replacement
 - Transformation

Various Statements from DCPs

- Offices of designated Contracting Parties (DCPs) may communicate the status of protection of a mark through various statements in the course of their procedure
 - 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 Concerning the Scope of Protection



Managing the International Registration

- Appointment of Representative
- Subsequent Designation
- Change in Ownership
- Limitation, Cancellation, Renunciation
- Change in Name / Address of the Holder / Representative
- Renewal
- Replacement
- Ceasing of Effect and Transformation
- Restrictions on the Right of Disposal
- Recording of a License

Appointment of a Representative

- MM12 Form is not compulsory
 - A simple letter or a power of attorney will be accepted
- The appointment of a representative can be included in different types of requests: in a new application, in a subsequent designation, in a change of name / address of the holder, in a change in ownership, in a limitation, in a renunciation, in a cancellation (total or partial)

Subsequent Designation (1)

- “Territorial extension of protection” – MM4
- A holder from NZ may subsequently designate any CP which is also bound by the Protocol
- Declaration under Article 14(5)
- The subsequent designation does not have an independent lifetime of 10 years, but expires on the same date as the IR to which it relates
- The subsequent designation may relate to one IR only
- May subsequently designate several CPs
- May be presented directly to the IB by the holder or via the Office of the CP of the holder

Subsequent Designation (2)

- Recording of necessary changes should be made before making the subsequent designation
- Certain requirements for certain DCPs
 - To declare in the form (2nd language EU and intent to use)
 - To declare in separate forms (seniority claim, declaration of intention to use the mark)
- List of G&S must be within the scope of the IR
- Similar fee structure as for international applications
- Recording, publication and notification
 - Refusal procedure of Rules 16 to 18 applies

Subsequent Designation Item 7 of MM4

In order to avoid problems, where a subsequent designation contains a request that it takes effect immediately after some other event (such as renewal or the registration, a recording of a change or cancellation), the subsequent designation will bear the date of the recording of that other event.

7

DATE OF EFFECT OF THE SUBSEQUENT DESIGNATION

(if neither of these boxes is checked, the date of this subsequent designation will be the date of its receipt by the International Bureau or, if it has been presented through the intermediary of an Office, the date of receipt by that Office)

- (a) ☐ this subsequent designation shall take effect immediately after the renewal of the international registration indicated in item 1;
- (b) ☐ this subsequent designation shall take effect immediately after the recording in the International Register of the following change concerning the international registration indicated in item 1 (specify the change):
-
-
-

Date of Subsequent Designation

- MM4 presented directly to the IB – it will bear the date on which it was received by the IB
- MM4 presented through an Office – it will bear the date on which 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

Conversion (Opting-back provision)

- Where a designation of EU in an IR has been withdrawn, refused or has ceased to have effect
- The holder may request conversion through subsequent designation of its Member States under the Madrid system
- Form MM16 to be presented through OHIM
- Must indicate ground for the conversion
- A subsequent designation resulting from conversion will bear the date on which the EU was recorded in the International Register

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)

- **A limitation** is a procedure to remove some G&S in respect of all or some of the DCP in an IR
- One form may contain a limitation for several IRs
- The G&S will not be removed from the IR as recorded in the International Register
- The G&S may be subject to subsequent designation
- Voluntary limitation – no transformation later is possible
- Declaration that a limitation has no effect
- New practice for translation

Recording of a Limitation

5 GOODS AND SERVICES

☐ If the space provided below is not sufficient, check the box and use a continuation sheet

Please use font “**Courier New**” or “**Times New Roman**”, size 12 pt, or above

(a) If there are any changes in a given class, specify the full new wording of the list of goods or services for that class:

(WARNING: It shall be understood that the list of goods and services which are the subject of the limitation may not be broader than the list contained in the international registration.)

(b) If an entire class is to be deleted, indicate only the class number:

(WARNING: Any class mentioned under item 5(a), above, must not be indicated under the present item.)

.....
.....
.....
.....
.....

☐ Check this box to confirm that any class that is not mentioned under 5(a) or 5(b), above, shall not be affected by the limitation.

Renunciation (MM7)

- **A renunciation** is a procedure intended to abandon the effects of an IR for all the G&S in respect of some of the DCPs
- One form may be used to request the recording of a renunciation of several IRs
- The G&S may be subject to subsequent designation
- Voluntary renunciation – no transformation later is possible

Cancellation (MM8)

- **A cancellation** is a procedure to cancel the effects of an IR for all or some of the G&S in respect of all the DCPs
- G&S will be permanently removed from the International Register
 - No subsequent designation will be possible
 - Would need to file a new international application
- Voluntary cancellation – no transformation later is possible

Limitation, Renunciation, Cancellation

	Limitation (MM6)	Renunciation (MM7)	Cancellation (MM8)
Goods & Services	Some	All	Some or All
Designated Offices	Some or All	Some	All
Effects for Register	Remain	Remain	Removed
Subsequent Designations	✓	✓	✗
Renewals	✗	✗	✗
Fees	177 CHF	N/A	N/A

Change in Ownership (1)

- May result from a contract, court decision or operation of law
- Partial or total change in ownership
- IB is only concerned with the recording – the effects of the recording is a matter for the jurisdictions concerned
- One MM5 form may relate to several IRs
- 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

Change in Ownership (2)

- Entitlement of the new owner is considered in respect of each DCP
 - Accumulation of entitlement
- Partial change in ownership: Separate IR is created with indication of capital letter
 - Possible merger
- Recordal and notification of the change in ownership
- The validity of a change in ownership is governed by the law of the CP concerned
- Declaration that a change in ownership has no effect
 - 18 months time limit from date of notification

Change in Ownership - Form MM5

5 APPOINTMENT OF A REPRESENTATIVE BY THE NEW OWNER¹

Name:

Address:

..... Telephone:

Fax: E-mail address:

Signature of the new owner appointing the above representative (compulsory)

¹ This item should be used where the new owner (*transferee*) wishes to appoint a representative. Note that, if the person recorded as the representative of the *transferor* is to be recorded as the representative of the *transferee*, such appointment should be made by completing this item. Alternatively, the new owner may appoint a representative by means of a power of attorney annexed to the present request.

Changes in the Name and/or Address

- Change of name / 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
 - Fee: CHF 150 for one or several IRN

- Change of name / address of the **representative**
 - Form MM10 is optional
 - To be presented to the IB directly
 - No fee

Renewal of an IR

- The IR is valid for a period of 10 years
- When renewing an IR, no modifications may be made
- 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
- Unofficial notice of renewal 6 months before the date of expiry
- 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

- For a period of five years from the date of its registration, the IR remains dependent on the basic mark
- If the basic mark ceases to have effect, the IR will be cancelled to the same extent
- It will cause “**Domino Effect**”
- Not necessarily due to a 3rd party “Central Attack” on the basic mark

Transformation

- Limits the effects of dependency
- Must file in national / regional Office within 3 months from the date on which the IR was cancelled by the IB
- Preserves acquired rights
- Actual process subject to national laws, regulations and practices (no WIPO procedure)

Replacement

- Article 4*bis* and Rule 21
- 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 NR are also listed in the IR
- Where the list of the NR is broader than that of the IR, the Office can notify the IB of the replacement within the overlap between the two

Useful Resources

- <http://www.wipo.int/madrid/en/>
- Legal texts, Forms, Guide and Information Notices
- WIPO Gazette and ROMARIN
- E-Renewal Tool, Fee Calculator, Simulator, Goods & Services Manager, Statistics
- Madrid Real-time Status (MRS), Madrid Electronic Alert (MEA), Madrid Portfolio Manager (MPM)
- Madrid Highlights
- Intreg.mail@wipo.int / Tel. + 41 22 338 91 11
- Madrid.team3@wipo.int / **Tel. + 41 22 338 75 03**

Thank you
for your attention

debbie.roenning@wipo.int

