



Filing international applications with IPONZ

March 2017

ePCT Applications

Leon Davis



File view of a ePCT application

Office Profile Search & Reporting Notifications New IA History

- File Ref. IA Status Not yet Published Office Comments Send ePCT Message

File View Bibliographic Data Timeline History Access Rights Fees Upload Documents Actions

Applicant(s)
Inventor(s)

Int. Filing Date 27 Jan 2017 Filing Type E-Filing (PDF) Team at IB PCT Operations Team 4 Search Status Search copy sent (01 Mar 2017)
Date of Receipt at RO 27 Jan 2017 Priority Date 29 Jan 2016 IA Status Report

Title

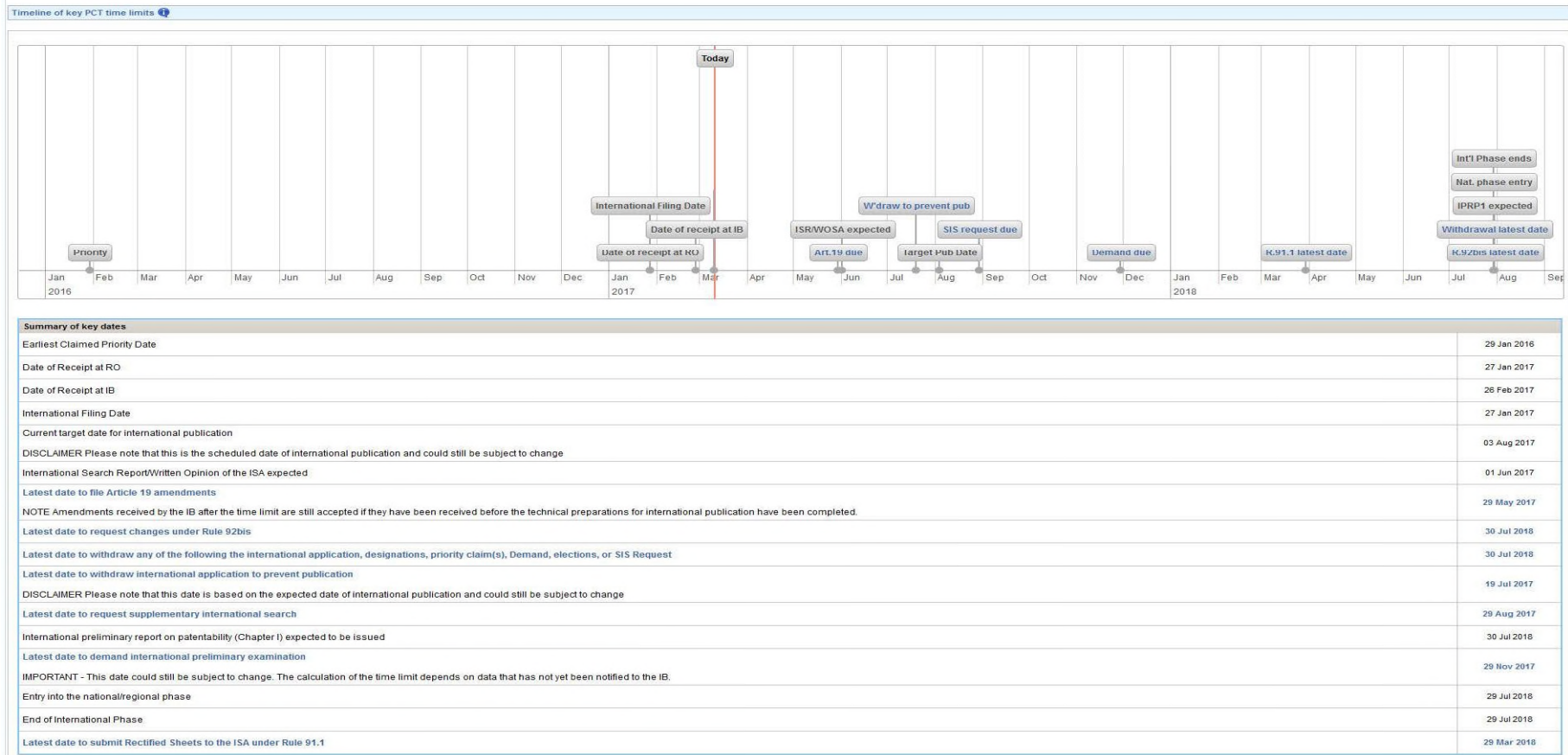
Upload Documents

Record as held by the IB Documents for RO/NZ Documents for ISA/AU Documents for IPEA

Documents [Doc ID] ↑	Source ↓	Date ↓	Status ↓	Pages ↓		
Related Documents						
Replacement, Substitute sheets (Rule 26) [44]	RO	07 Mar 2017	18	9		
ePCT Office Cover Letter [43]	RO	07 Mar 2017	18	1		
(ISA/202) Notification of Receipt of Search Copy [42]	IB	03 Mar 2017	18	1		
(IB/304) Notification Concerning Submission or Transmittal of Priority Document [41]	IB	01 Mar 2017	18	1		
Priority Document [40]	RO	26 Feb 2017	18	34		
(IB/301) Notification of receipt of record copy [30]	IB	28 Feb 2017	18	1		
ePCT Office Cover Letter [28]	RO	26 Feb 2017	X	1		
(RO/105) Notification of the International Application Number and of the International Filing Date [27]	RO	26 Feb 2017	18	1		
Confirm Search Fee to IB [26]	RO	26 Feb 2017	X	1		
ePCT Office Cover Letter [25]	RO	26 Feb 2017	X	1		
(RO/102) Notification Concerning Payment of Prescribed Fees [24]	RO	26 Feb 2017	18	2		



Key PCT timelines





ePCT application history

Items: 1 - 55 of 55 | ALL | per page

Start Date: [] End Date: 09/03/2017 [] Include detailed document history [] Search [] Reset []

User Name	Type Of Action	Audit Info	Event Date
(NZ) Leon Davis	Manage Fees	Retrieved IA fees information	09 Mar 2017
(NZ) Leon Davis	Upload document	Recipient ISA - ePCT Office Cover Letter [45] Replacement, Substitute sheets (Rule 26) [46]	07 Mar 2017
(NZ) Leon Davis	Upload document	Recipient IB - ePCT Office Cover Letter [43] Replacement, Substitute sheets (Rule 26) [44]	07 Mar 2017
(NZ) Leon Davis	Transmit Priority Doc(s) to IB	Recipient IB - ePCT Office Cover Letter [28] Priority Document [29]	26 Feb 2017
(NZ) Leon Davis	ePCT Action	Form(s) Sent via EMAIL to Sent	26 Feb 2017
(NZ) Leon Davis	Transmit Record Copy to IB	Recipient IB - ePCT Office Cover Letter [25] Confirm Search Fee to IB [26]	26 Feb 2017
(NZ) Leon Davis	Transmit	Document (RO/102) Notification Concerning Payment of Prescribed Fees[13] transmitted from RO to IB	26 Feb 2017
(NZ) Leon Davis	Transmit	Document Rule 4.17 (iv) Declaration of Inventorship (US only)[9] transmitted from RO to IB	26 Feb 2017
(NZ) Leon Davis	Transmit	Document Power of Attorney[10] transmitted from RO to IB	26 Feb 2017
(NZ) Leon Davis	Transmit	Document Fee-related Correspondence[14] transmitted from RO to IB	26 Feb 2017
(NZ) Leon Davis	Transmit	Document (RO/101) Request form[11] transmitted from RO to IB	26 Feb 2017
(NZ) Leon Davis	Transmit	Document Abstract[21] transmitted from RO to IB	26 Feb 2017
(NZ) Leon Davis	Transmit	Document Claims[20] transmitted from RO to IB	26 Feb 2017
(NZ) Leon Davis	Transmit	Document Description[19] transmitted from RO to IB	26 Feb 2017
(NZ) Leon Davis	Transmit	Document Fee Calculation Sheet[7] transmitted from RO to IB	26 Feb 2017
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(NZ) Leon Davis	Transmit	Document Rule 4.17 (ii) Declaration - Applicant's Entitlement to Claim Priority[6] transmitted from RO to IB	26 Feb 2017
(NZ) Leon Davis	Transmit	Document Rule 4.17 (ii) Declaration - Applicant's Entitlement to Apply for and Be Granted a Patent[5] transmitted from RO to IB	26 Feb 2017
(NZ) Leon Davis	Transmit	Document Validation Log[12] transmitted from RO to IB	26 Feb 2017
(NZ) Leon Davis	Transmit	Document Application Body as Filed[3] transmitted from RO to IB	26 Feb 2017
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(NZ) Leon Davis	Form generated	Recipient IB - (RO/102) Notification Concerning Payment of Prescribed Fees [24]	26 Feb 2017
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(NZ) Leon Davis	Manage Fees	Fees updated	26 Feb 2017
(NZ) Leon Davis	Manage Fees	Retrieved IA fees information	26 Feb 2017
(NZ) Leon Davis	Manage Fees	Retrieved IA fees information	26 Feb 2017
(NZ) Leon Davis	Process	Document Rule 4.17 (ii) Declaration - Applicant's Entitlement to Claim Priority[6] Processed	26 Feb 2017
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(NZ) Leon Davis	Delete	Document (RO/105) Notification of the International Application Number and of the International Filing Date[16] Deleted	26 Feb 2017
(NZ) Leon Davis	Set to new	Document (RO/105) Notification of the International Application Number and of the International Filing Date[16] status set to NEW	26 Feb 2017
(NZ) Leon Davis	Process	Document Description[19] Processed	29 Jan 2017
(NZ) Leon Davis	Process	Document Claims[20] Processed	29 Jan 2017
(NZ) Leon Davis	Process	Document Abstract[21] Processed	29 Jan 2017
(NZ) Leon Davis	Process	Document Fee-related Correspondence[14] Processed	29 Jan 2017
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(NZ) Leon Davis	Process	Document (RO/105) Notification of the International Application Number and of the International Filing Date[16] Processed	29 Jan 2017
(NZ) Leon Davis	Upload document	Recipient RO - Fee-related Correspondence [14] Power of Attorney [15] (RO/105) Notification of the International Application Number and of the International Filing Date [16] (RO/106) Invitation to Correct Defects in the International Application [17] (RO/101) Request form [18] Description [19] Claims [20] Abstract [21] Drawings [22] Fee Calculation Sheet [23]	29 Jan 2017
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(NZ) Leon Davis	Form generated	Recipient IB - (RO/102) Notification Concerning Payment of Prescribed Fees [13]	29 Jan 2017
(NZ) Leon Davis	File Draft IA	Draft IA filed as NZ20170501	26 Jan 2017



Document upload IB

Office Profile Search & Reporting Notifications New IA History

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Date of Receipt at RO: 27 Jan 2017 Priority Date: 29 Jan 2016 IA Status Report: [PDF icon] [PDF icon] [PDF icon] ISA/AU

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Documents for ISA/AU tab

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<input type="checkbox"/>	Documents [Doc ID] ↓	Source ↓	Date ↓	Pages ↓
<input type="checkbox"/>	Replacement, Substitute sheets (Rule 26) [46]	RO	07 Mar 2017	9
<input type="checkbox"/>	ePCT Office Cover Letter [45]	RO	07 Mar 2017	1

Perform action on selected document(s)

Select Action

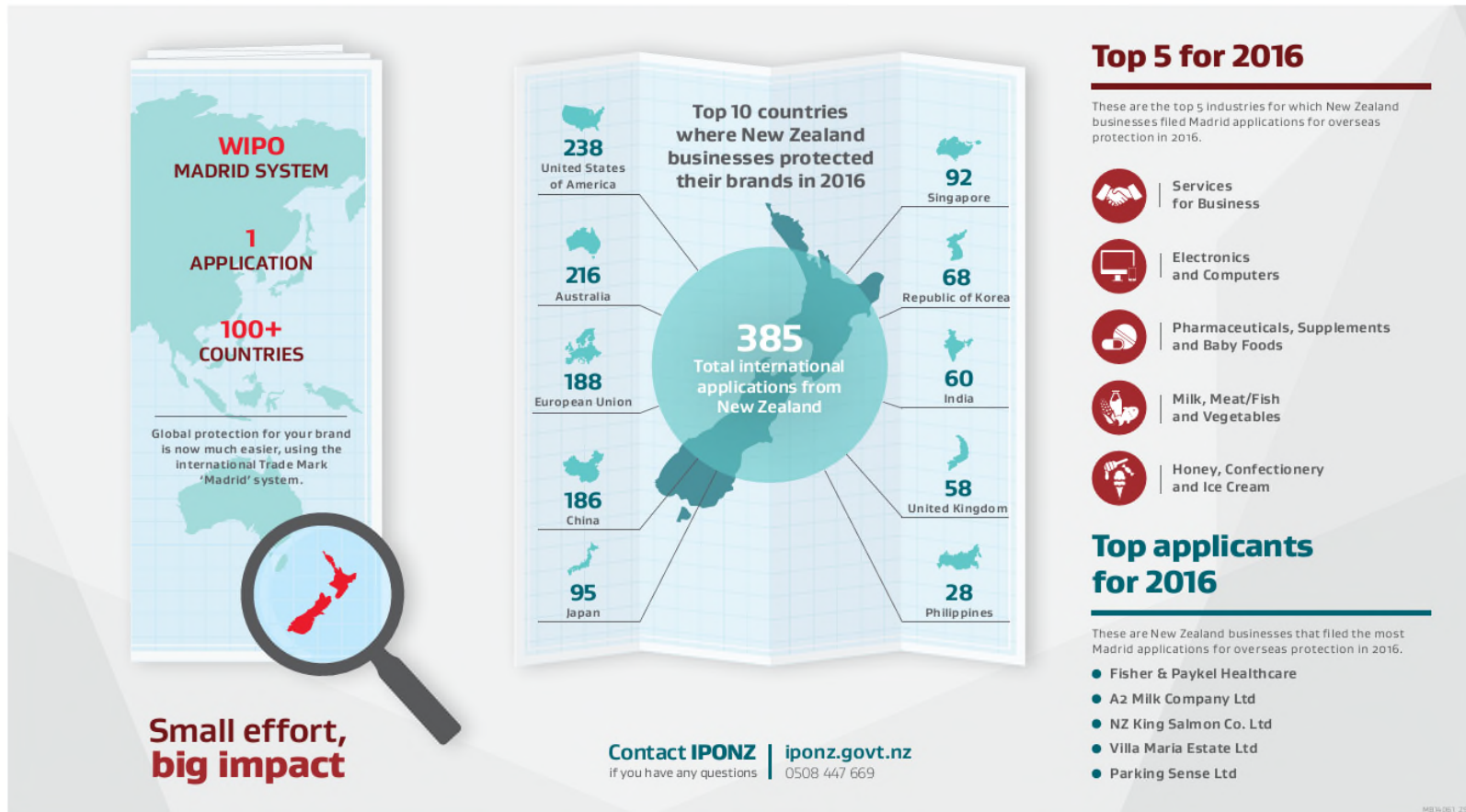
Madrid Applications

Tanya Carter





How New Zealand businesses are protecting their **Trade Marks** around the world





Overview of 2016

- 385 international applications were based on NZ TMs – a similar number to 2015
- The top ten countries designated are mostly the same, and are designated a greater number of times. The UK and Philippines replace Vietnam and Russia in the top ten
- The classes most frequently included have not changed
- We improved our system for managing certification and irregularities – with new tasks and reminders for clients to respond!



Irregularities

- 56% of NZOOs certified had at least one irregularity
- 70% of irregularities included missing fees
- 20% of irregularities included broad terms only
- High numbers of fee irregularities are anticipated, as e-payment requires an irregularity letter issued first
- Broad terms continue to be an issue, IPONZ is working with WIPO on this
- WIPO's draft practice guidelines:
http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=339997



Tips for filing - Get to know your designations

Investigate:

- Prior marks – noting opportunities for trade mark maintenance (Applicant details, Seniority Claims and/or Replacement, or to tailor a limitation to avoid a citation)
- Filing requirements (MM18, second language etc.)
- Processing times
- Who can respond to provisional refusals
- Whether requesting a Limitation via WIPO in response to a refusal is a more desirable that waiting for Partial Acceptance



Tips for ownership details

- Identifying the Applicant as an organisation or company allows the entry of more specific information, relevant to some designations like the US
- Ensure that name and address details match any provided on the registers of designations – check the registers, then update the IPONZ record, international application, international registration (via WIPO), or the mark on the register of the designation

Specific information is available under *How to prepare...* and *How to apply...* topics at: <https://www.iponz.govt.nz/about-ip/trade-marks/international/>



Corrections

Before registration:

- Are often possible if requested by the Office of Origin (OO) – we ask that clients call or email IPONZ, then we email WIPO

After registration:

- An error attributable to an OO, where the correction would affect the rights deriving from the International Registration (IR) (e.g. G&S, mark, designations), may only be corrected if the request is received by WIPO within 9 months of the date of publication of the error in the register - refer to Rule 28 of the Common Regulations:

http://www.wipo.int/madrid/en/legal_texts/

We recommend clients carefully check the details after registration and contact IPONZ if they require corrections



WIPO Forms and Fees for Request Types

Name	Effect	Form	Fee
Subsequent Designation	Add designations to an IR	MM4	300+
Limitation	Limit G&S/classes of all/some DCPs	MM6 (one form, multiple IRs)	177
Cancellation	Cancel an IR for some or all G&S for all DCPs	MM8	N/A
Renunciation	Abandon all G&S for one or more DCPs	MM7 (one form, multiple IRs)	N/A
Change Owner	Partial/Full Transfer	MM5 (one form, multiple IRs)	177
Change Owner Name/Address	Change if details of same owner	MM9 (one form, multiple IRs)	150
Change Agent Name/Address	Change if details of same agent	MM10 (optional)	N/A
Renewal		MM11	653+
Appoint Agent	New agent	MM12 (or letter)	N/A



Differences in NZDs:

- No Address for Service unless a response to the Office is necessary
- Mark representations cannot be changed for NZ –
 - IPONZ may request supplementary images for 3D marks
- Partial acceptance after the deadline to respond
- No renewal date – renewal via WIPO every ten years after IR date
- No division yet – coming soon
- Specification objections/Corrections. Options are:
 - Delete the wording and/or amend the wording of another class to include that description
 - Amend the wording to fit the class
 - Request a correction via WIPO



Request types for NZDs

Trade Mark

- Search the Trade Mark Register
- Apply for a Trade Mark
- Apply for a Search and/or Preliminary Advice
- Apply for an International Registration (NZ Office of Origin)
- Maintain a Trade Mark
- Maintain an International Registration Designating NZ (NZD)**
- Renew Trade Mark

INBOX > INTERNATIONAL REGISTRATION DESIGNATING NZ CHANGE REQUEST(S)

Abeyance

Allows an Applicant, or an Agent on their behalf, to request Abeyance of an application while a Proceeding is outstanding on a "related" trade mark.

Select case for Abeyance

Change Agent

Allows an agent to be assigned to, or changed for, a trade mark.

Select case for Change Agent

Change Goods and Services Specification

Allows you to edit and delete elements of your Goods and Services specification.

Select case for Change Goods and Services Specification

Continued Processing

Allows you to upload a response to your compliance report for consideration up to two months after the deadline for doing so has passed. You may do this only once per application.

Select case for Continued Processing



iFAQs

- How do I add myself as agent to an NZOO?
- Can I withdraw my NZOO?
- Can I add a designation?
 - Before certification, call IPONZ
 - After certification, email mail@iponz we will ask WIPO
 - After registration, submit the correct form via WIPO
- My basic is cancelled, do I need to notify WIPO?
 - No IPONZ monitors changes to the basic mark, and will do this in due course.



iFAQs

- Can I submit my change of owner via IPONZ?
 - No real reason to, only where new owner does not have an address in a Madrid member state as IPONZ must assess the new owner's entitlement – Tip: have the current holder sign the MM5!
- I have missed a deadline to respond, what can I do?
 - Consider continued processing – available for some international applications and NZDs
 - Designate again for the refused goods (a great option until division is available, may not be possible on e-subsequent designation but is ok)
- What's the status of my application?
 - See **Madrid Monitor *BETA***



For regular users

Search	File	Monitor	Manage
Global Brand Database	Forms	Madrid Monitor <i>Beta</i>	Madrid Portfolio Manager
Member procedures	Madrid Goods & Services Manager	ROMARIN	E-Subsequent Designation
	International Application Simulator	Madrid Real-Time Status	E-Renewal
	Fees	Madrid Electronic Alert	Extracts

Transaction History

EXPAND all none or, only those pertinent to selected countries

BH CN CY OM SG US VN

▼ Pending Subsequent designation

270 Language of the application
English

Date of receipt by the International Bureau
15.02.2017

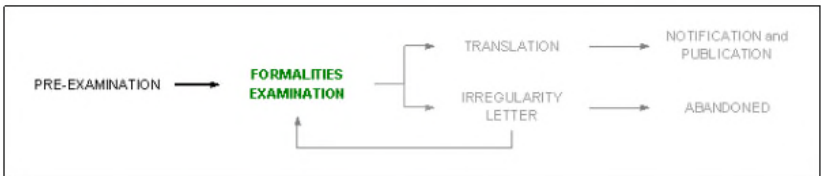
831 Designation(s) under the Madrid Agreement
US

851 Limitation of the list of goods and services
US

List limited to:

43 Services for providing food and drink namely cafe services, coffee bar and coffee house services, restaurant

Status



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    graph LR
      A[PRE-EXAMINATION] --> B[FORMALITIES EXAMINATION]
      B --> C[TRANSLATION]
      B --> D[IRREGULARITY LETTER]
      C --> E[NOTIFICATION and PUBLICATION]
      D --> F[ABANDONED]
      D --> B
  
```

- From <http://www.wipo.int/madrid/en/>, click **Madrid Monitor *Beta***
- Search for your mark
- Click on Pending to see details of pending applications, subsequent designations



Search Advanced Search WIPO Gazette Support

Click on **Real-time Status** tab to see pending documents

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Support

1198191- Mojo

Full details Summary By Office **Real-time Status**

International Trademark
WIPO | MADRID

Current Status

WIPO reference	Type	Office	Inscription date
789603801	New application	NZ	26/03/2014
816832901	Subsequent designation		03/06/2014
834413301	Intermediate Status	SG	26/08/2014
849696501	Grant of protection	SG	05/11/2014
873517201	Refusal	CN	25/02/2015
886208501	Refusal	VN	06/05/2015
901556201	Limitation		22/07/2015
909683501	Subsequent designation		28/07/2015
925855701	Refusal	CY	06/10/2015
934745601	Limitation		07/12/2015
937596901	Refusal	CY	25/11/2015
1024635101	Final Decision	CY	
1042175801	Subsequent designation		

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International Trademark
WIPO | MADRID





Replacement

- Allows the holder of an international registration (IR) to have the IR replace a nationally filed registration for the same G&S and retain the priority/filing date
- The IR is then maintained via WIPO
- Applications for replacement are made to the DCP, different fees and procedures apply
- To qualify an IR must have the same owner, same mark, cover at least all of the G&S of national mark (G&S cannot be narrower)



Replacement – IPONZ process

- A request is made by email to mail@iponz.govt.nz
- It is uploaded to the case and reviewed by an examiner
- The examiner checks:
 - Does the request list the IRN, national registration number, name & address of the agent/contact (if any)?
 - Is there a case for this IR? Have we been notified of the designation?
 - If so, do the cases have the same owner?
 - Does the specification on the IR designating NZ cover **all** of the goods/services of the national registration? (i.e. the IR can have the same or broader specification, but **cannot** be narrower)



Replacement – example TM 231408

- NZ trade mark registrations 231408 and 231409 cover:
 - 1: Chemical products used in industry; synthetic waxes in this class
 - 4: Synthetic waxes
- The international registration covers:
 - 1: Industrial chemicals
 - 4: Synthetic waxes for industrial use

The international registration may be broader than the national registrations being replaced but not narrower, so NZ registration 231408 required an Alteration request to limit the scope of the registration to take advantage of replacement.



Replacement – IPONZ process

If the request is acceptable, then Explanations are entered on the register on each case

Example of an Explanation on the national case:

- International Registration 848635 (NZ 1011918) replaces this registration due to Article 4bis of the Madrid Protocol.

Example of an Explanation on the IR designating NZ case:

- Article 4bis of the Madrid Protocol applies. The priority date 18 Nov 2004 based on national registration 721677 applies to the following goods/services: roof windows and skylights of metal; roof windows and skylights (not of metal).



Replacement – IPONZ process

Then WIPO is notified by an email to madrid.team3@wipo.int. For example:

Subject: Please be advised IRN 848635 (NZ 1011918) designating New Zealand replaces national registration 721677

Good morning,

Please be advised that in respect of IRN 848635 (NZ 1011918) designating New Zealand Article 4bis of the Madrid Protocol applies. The priority date 18 Nov 2004 based on national registration 721677 applies to the following goods: roof windows and skylights of metal; roof windows and skylights (not of metal).

1. Filing date of registration being replaced - 18 Nov 2004
2. Filing number of registration being replaced - 721677
3. Registration date of registration being replaced - 19 May 2005
4. Registration number of registration being replaced – 721677

Please let me know if you require any further information.

Regards,



More information is available here:

- The Guide to the International Registration of Marks Part B II, 105:
<http://www.wipo.int/export/sites/www/madrid/en/guide/pdf/partb2.pdf>
- Article 4bis of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, and Rule 21 of the Common Regulations:
http://www.wipo.int/madrid/en/legal_texts/
- Madrid Member information:
http://www.wipo.int/madrid/en/members/ipoffices_info.html
- Additional information based on a survey of Offices:
<http://www.wipo.int/madrid/en/members/replacement.html>



Transformation

- Allows the holder of an international registration (IR) to transform the IR into a nationally filed application/registration following a ceasing of effect, to retain the IR Date or Subsequent Designation date
- Cannot be requested following voluntary cancellation/limitation with WIPO
- Applications for transformation are made to the DCP, different fees and procedures apply. IPONZ requests must be emailed to mail@iponz.govt.nz
- Minimum request information is IR number, date of cancellation and if not a total transformation, the classes/goods/services



Transformation – IPONZ process

- The request is allocated to an examiner, to assess:
 - Does the request list the international registration (IR) number, date of cancellation and if not a total transformation, the classes/goods/services cancelled, address for service
 - Is there an NZD case for that IR number?
 - Does ROMARIN confirm the IR has been cancelled at the request of the Office of Origin, and did IPONZ receive the transformation request within 3 months of the notification date of the cancellation?
 - Has IPONZ been notified that the IR has been cancelled in part or full?
 - Are the list of goods/services in the transformation request covered by the list cancelled on the NZD?



Transformation – example IRN 1171328

- IRN 1171328 was based on AU 1555368
 - 25 September 2014 the AU application lapsed
 - 8 February 2015 WIPO received the Ceasing of Effect document
 - 13 February 2015 IPONZ received the transformation request
 - IPONZ responded it could not be processed as the cancellation of the IR had not been recorded by WIPO
 - 8 May 2015 IPONZ was notified of the cancellation
 - 18 May 2015 IPONZ received a further transformation request
 - 27 May 2015 the transformation was completed



Transformation – IPONZ process

- If acceptable a national mark case is created based on the NZD details, some details may be different, e.g.:
 - IP Number (new case number will be created)
 - Submission Date (the date we received the transformation request)
 - Reference (same as the NZD or a new one given in the transformation request)
 - Status (a National mark status but the equivalent to the NZD status)
 - Application Type (will be National)
 - Image (same as NZD)
 - Goods/Services (same as cancelled NZD, unless a partial transformation)
 - Convention Claim (if a valid one existed on the NZD, it can be included on the transformation case)
- Agent



Transformation – IPONZ process

If acceptable, Explanations are entered on each case, e.g.:

An Explanation on a National case:

- 1017551 is the transformation of cancelled International Registration 1171329 (NZ 982917).

(OR, for partial transformation):

- 1015908 is the transformation of partially cancelled International Registration 1207285 (NZ 1000739).

An Explanation on the NZD case:

- International Registration 1171329 (NZ 982917) is transformed as NZ 1017551.

(OR, for partial transformation):

- International Registration 1207285 (NZ 1000739) is partially transformed as NZ 1015908.



More information is available here:

- The Guide to the International Registration of Marks Part B, paragraph 88.01:
<http://www.wipo.int/export/sites/www/madrid/en/guide/pdf/partb2.pdf>
- Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, Article 9*quinquies*:
http://www.wipo.int/treaties/en/text.jsp?file_id=283484#P104_18930
- Madrid Member information:
http://www.wipo.int/madrid/en/members/ipoffices_info.html
- By entering “transformation” in the Search WIPO query box on the Madrid home page <http://www.wipo.int/madrid/en/> you will also find the “Model Provisions on Transformation” which may be of interest in understanding how WIPO suggest Offices interpret their role with regard to Transformation.
- Working Group 2013 document, [MM/LD/WG/11/4](#), Information Concerning Ceasing of Effect, Central Attack and Transformation:
http://www.wipo.int/meetings/en/details.jsp?meeting_id=29762



WIPO resources

Refer to <http://www.wipo.int/madrid/en/> for:

- Legal texts – the Madrid Protocol and Common Regulations
- Guide to the International Registration of marks
- Members information <http://www.wipo.int/madrid/en/members/>
- Madrid forms – for applicants and representatives
- Making the Most of the Madrid System handbook

http://www.wipo.int/export/sites/www/madrid/en/forms/docs/making_the_most_of_the_madrid_system_mm_forms.pdf

- WIPO newsletters – Madrid Highlights



WIPO services of interest

Refer to <http://www.wipo.int/madrid/en/services/> for:

- ROMARIN
- Madrid Goods & Services Manager (MGS)
- Madrid Portfolio Manager (MPM) and Madrid Real-time Status (MRS)
- E-payment
- E-subsequent designation
- E-renewal
- Global Brands Database

Also, we regularly use Madrid Office Portal (MOP) as a bridge between public and private documents.



How to contact WIPO

For queries relating to filed applications and IRs:
madrid.team3@wipo.int

For payment queries: income.mark-dm@wipo.int

For general queries: intreg.mail@wipo.int

Proceedings against International Trade Marks

Simon Pope



Overview

- Treated the same as NZ proceedings (for the most part)
- TM Act, TM Regs 2003 & TM (International Registration) Regs 2012, Protocol, Common Regulations
- Priority date: International reg 12(3)
 - (a) date of the International Registration; or
 - (b) date the extension for protection to NZ recorded at WIPO.
- WIPO are only interested in the beginning and the end
- Must appoint a local agent



Oppositions

- IPONZ case management facility automatically notifies WIPO of possibility of an opposition after 18 months
- Period to notify WIPO on an opposition under article 5(2)(c)(ii) is *“one month from the expiry of the opposition period and... not later than seven months from the date on which the opposition period began”*.
- IPONZ notifies WIPO of the opposition, and confirms to the opponent that it has admitted its opposition, via our case management facility
- WIPO serves the rights holder with a copy of the notice of opposition.



Revocation & Invalidity

- IPONZ Hearings Office serves applications for revocation or invalidity directly on rights holders
- New Hearings Office practice is to use both WIPO service address and contact email address to serve applications
- Article 5(6) *“Invalidation.. May not be pronounced without holder.. Having, in good time, been afforded the opportunity of defending the rights.”*
- Administrative Instructions Part 4, Section 12, subsection (d), covers the address requirements for an International registration *“...e-mail address may be indicated”*