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The International
Trademark System



Transformation and Replacement Madrid System Webinar

Lucy Headington-Horton

**Geneva
September, 2023**

Our speaker

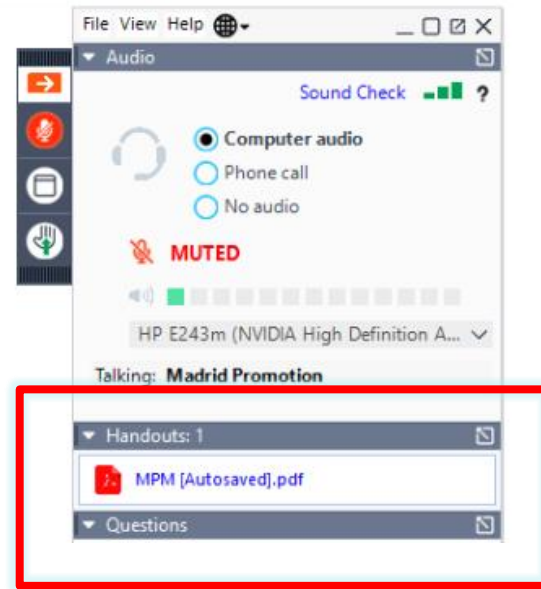


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How to use GoToWebinar



Program

- Transformation

- Replacement



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Transformation

Question 1

Have you ever filed a transformation application following the cancellation of an international registration?

- a. Yes, many times
- b. Yes, but not many
- c. No

Dependency principle

- International registration (IR) is **dependent** on the basic mark for **5 years** (from the date of the IR)
- Where the **basic mark ceases to have effect** during the 5 years dependency period, the **IR** will be **cancelled** to the same extent (partially or totally)

What is transformation?

- Transformation is available where an IR has been **cancelled** following the **ceasing of effect** of the **basic mark**
- The IR may be “transformed” into national/regional applications (for **continued protection**)
- The transformed application **retains the date** of the IR and any applicable priority date

What are the conditions, and what do you need to do?

- File a national/regional application **directly** with the Office concerned for **only the cancelled goods/services**
- **Three months time limit** from the **date of recording** of the cancellation in the International Register
- The IR must **have had effect** in the territory concerned (*for all goods and services to be transformed*)

What happens next?

- Treated as a “**regular**” national/regional application (with an earlier date)
- **No WIPO procedure** (follows domestic requirements, national laws, regulations and practices)
- Status of protection determined by the national/regional Office concerned

Question 2

The holder has voluntarily requested cancellation of their international registration, the time-limit to apply for transformation applications in the countries/regions of interest is:

- a. 5 years from the date of the recording of the cancellation
- b. 3 months from the date of the recording of the cancellation
- c. None of the above

Replacement

Question 3

- Have you ever filed a request for an Office to take note of a replacement?

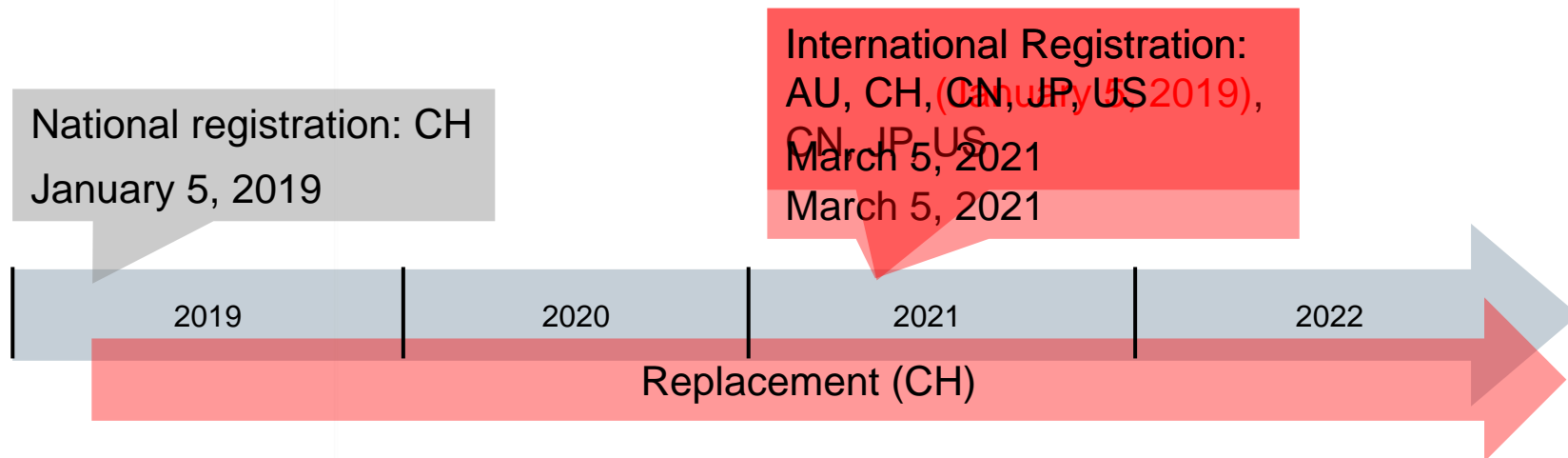
What is replacement?

- Feature of the Madrid System, giving the holder of an existing national or regional right in a territory later designated in their IR, the option to allow the national or regional right to lapse **without loss of rights**

What are the conditions for replacement?

- The mark and the holder **must be the same**
- The goods/services must overlap (**partial replacement possible**)
- IR must designate the territory concerned
- The designation must be dated later than the national/regional mark
- Replacement is automatic

How does replacement work?



Taking note of replacement

- Request the Office **to take note**
- The Office determines whether conditions are met
- The Office acknowledges in its Register, protection in the IR is from the date of the national/regional right
- The Office notifies WIPO that it has taken note and WIPO will record that fact in the International Register

Benefits and Recommendations

- Centralized management
- Cost savings

But wait until

- the Office has taken note of replacement
- the end of the dependency period
- the designated Office has granted protection

before allowing the national/regional right to lapse

Question 4

- Are you now interested in filing a request for an Office to take note of replacement?
 - Yes
 - No
 - I will think about it

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When?

November 2 and 3, 2025



Where?

WIPO Headquarters,
Geneva, Switzerland



Who should attend?

Advanced users (holders and representatives); not for IP Office staff

Why attend?

- **Gain Insightful tips** from WIPO experts and guest speakers from **Australia, China, Republic of Korea and the USA** about examination practices in these IP Offices
- **Master** Madrid System **online tools** and **procedures**
- **Increase** your **global network**



Hear from a past attendee!



“It was a very good combination of **presentations** and **case studies**.

The format made it much more **interesting, informative and entertaining**.

The low number of participants greatly helped the **discussion and interaction** among them.”

Michael Best, Partner/Attorney-at-law | BEST Rechtsanwaelte, Germany

Registration fee: 600 Swiss francs

Event language: English

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- Would you like to learn more about the benefits, principles and operation of the Madrid System?
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Testimonials and Case Studies

Madrid System Case Study Highlight: Panasonic, Branding for Further Growth and Greater Value

October 5, 2021

We continue with our highlights of key case studies giving you practical insights on how companies across various industries use the Madrid System globally to their advantage. Our latest study focuses on [Panasonic, the renowned Japanese electronics corporation](#).

Panasonic provides a wide range of products and services that are used in consumers' daily lives worldwide. These include home appliances, the electronic components used in them, housing and various services.



With more than a hundred years of experience, the company has been thoroughly committed to creating a better life for its users under the brand slogan of "A Better Life, A Better World".

Over the years, Panasonic introduced several business brands to achieve further growth and greater brand value in each area of business. In 2008, the corporation changed its name from the Matsushita Electric Industrial Co., Ltd to the Panasonic Corporation, consolidating its brand identity.

Discover how, with such a varied portfolio and an expansion strategy geared internationally, Panasonic uses the Madrid System to simplify the administrative procedures and greatly reduce costs.

[Read the full Panasonic case study](#)



Micromax on How WIPO's Madrid System Supports its International Growth Strategy

World Intellectual Property Organization – WIPO



MixMediaWorx on the Benefits of Using the Madrid System

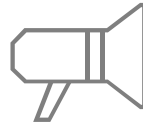
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