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Adding new countries/regions to international registrations: the subsequent designation

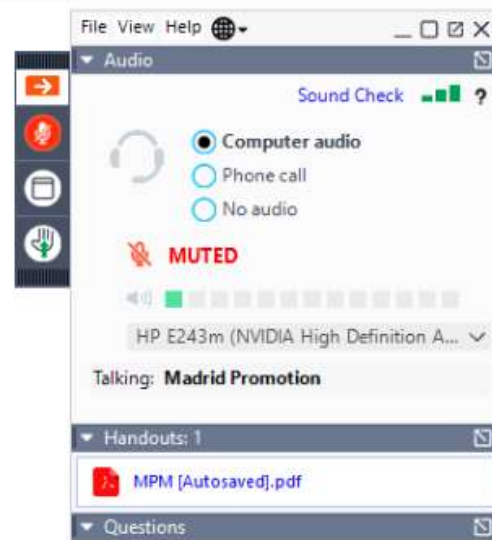
Webinar of the Madrid System

Aurea Plana
Madrid Legal Division

WIPO PUBLIC

Geneva
March 18, 2020

How to use GoToWebinar



Structure of the Webinar

- Presentation: adding new countries/regions to international registrations: the subsequent designation
- Interactive questions during the webinar
- Questions & answers session at the end
- Presentation slides available for download. Recording will be uploaded on the [Madrid Webinar page](#)
- Short survey to provide feedback

Subsequent Designation

- It is possible to expand the geographical scope of an international registration by adding Contracting Parties to an existing international registration

Subsequent Designation

- Form MM4 / [e-Subsequent Designation](#)
- It must relate to a single international registration number
- Multiple Contracting Parties may subsequently be designated
- Can be presented to WIPO directly

Question

- Can I present a subsequent designation while my application is still pending? I just want to add one Contracting Party to the list of designations

■ Yes

■ No

Subsequent Designation: Requirements for some designated Contracting Parties

■ European Union:

- 2nd language: English, French, German, Italian or Spanish
- Seniority claim of an earlier mark registered in a Member State (Form [MM17](#))

Subsequent Designation: Requirements for some designated Contracting Parties

- The mere fact of designating some Contracting Parties is taken as a declaration of intention to use
- Declaration of intention to use the mark in the United States of America (Form [MM18](#))
- The holder declares that he effectively and lawfully conducts business in connection with the goods and services for which Brazil is being designated

Questions

- I have an international registration since 2011.
Can I subsequently designate Brazil, Canada and the Philippines?
 - Yes, you can subsequently designate all
 - You can designate Canada and the Philippines but not Brazil
 - No, you cannot subsequently designate these Contracting Parties

Subsequent Designation

■ Declarations under Article 14(5) of the Protocol:

Contracting Party	
Brazil	October 2, 2019
India	July 8, 2013
Philippines	July 25, 2012
Namibia	June 30, 2004
Turkey	01/01/1999
Estonia	November 18, 1998

Form MM4: miscellaneous indications

- Indications concerning the holder: nationality or legal nature and State of organization
- Indication, for each color, of the principal parts of the mark that are in that color
- Translation of the mark into English, French and/or Spanish
- Indication that the words contained in the mark have no meaning
- Voluntary description of the mark

Question

- I did not claim priority in the international application.
Can I add a priority claim in an subsequent designation?

- Yes

- No

Subsequent Designation: Priority

- If the international registration has a priority claim and the subsequent designation is filed within the 6 months priority period, the priority claim will also apply to the subsequent designation

Subsequent Designation: Date

- The subsequent designation is presented directly to WIPO: is recorded with the date it was received by WIPO
- The subsequent designation is presented through an Office: is recorded with the date it was received by the Office, provided that WIPO receives it within 2 months
- The subsequent designation contains a request that it takes effect after some other event

Subsequent Designation form MM4: Date

7**DATE OF THE SUBSEQUENT DESIGNATION**

(if neither of these boxes is checked, the date of this subsequent designation will, subject to Rule 24(6)(c)(i) of the Regulations under the Protocol, be the date of its receipt by the International Bureau if it has been presented direct to the International Bureau, or, if it has been presented through the intermediary of an Office, the date of receipt by that Office, provided that the said designation has been received by the International Bureau within a period of two months from that date and subject to Rule 24(6)(c)(i) and (d) of the Regulations under the Protocol)

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

.....

.....

.....

e-Subsequent Designation: Date

LA (Laos People's Democratic Republic)

ZM (Zambia)

ZW (Zimbabwe)

[select all](#) [unselect all](#)

Classes

1; 3; 4; 5; 6; 8; 9; 10; 11; 12; 13; 14; 15; 16; 17; 18; 19; 20; 21; 22; 23; 24; 25; 26; 27; 2

options



Total



Partial

Subsequent
designation
after renewal



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Question

- If I request a subsequent designation for Switzerland one week before the renewal, do I need to include Switzerland in the renewal?
 - No, I have to renew for Switzerland 10 years after its designation
 - Yes, there is only one date of renewal for all designations

Subsequent Designation: Date

- **A subsequent designation follows the same lifetime cycle (renewal) as the international registration**

Subsequent Designation: Irregularities

- If the subsequent designation does not comply with the applicable requirements, the holder will be notified. The holder will have 3 months to remedy the irregularity.
- Irregularities relating to MM18

Subsequent Designation: Fees

- The fees to be paid to WIPO for a subsequent designation:
 - Basic fee: 300 Swiss francs
 - Fees for designations:
 - Standard fees
 - 100 Swiss francs per designated Contracting Party
 - Individual fees
 - Individual fees payable in 2 parts for Brazil, Cuba and Japan

Subsequent Designation: Fee Calculation

WIPO IP PORTAL	MENU	Madrid Fee Calculator	HELP	ENGLISH	LOGIN	WIPO
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FEE CALCULATOR

Information The Fee Calculator helps you estimate the cost of registering your mark through the Madrid System, a simple, easy and cost-effective International registration procedure. It also helps you estimate other costs related to managing your international trademark such as the renewal, the subsequent designation, the second fee tax for certain Contracting Parties and all the Madrid transactions with fees.

MARK INFORMATION

Please select which transaction you wish to estimate the cost of:

Type of transaction *
Subsequent designation

Date *
2020/03/16

Office of the Contracting Party of the Holder *
Spain

Number of classes covered by the mark *
3

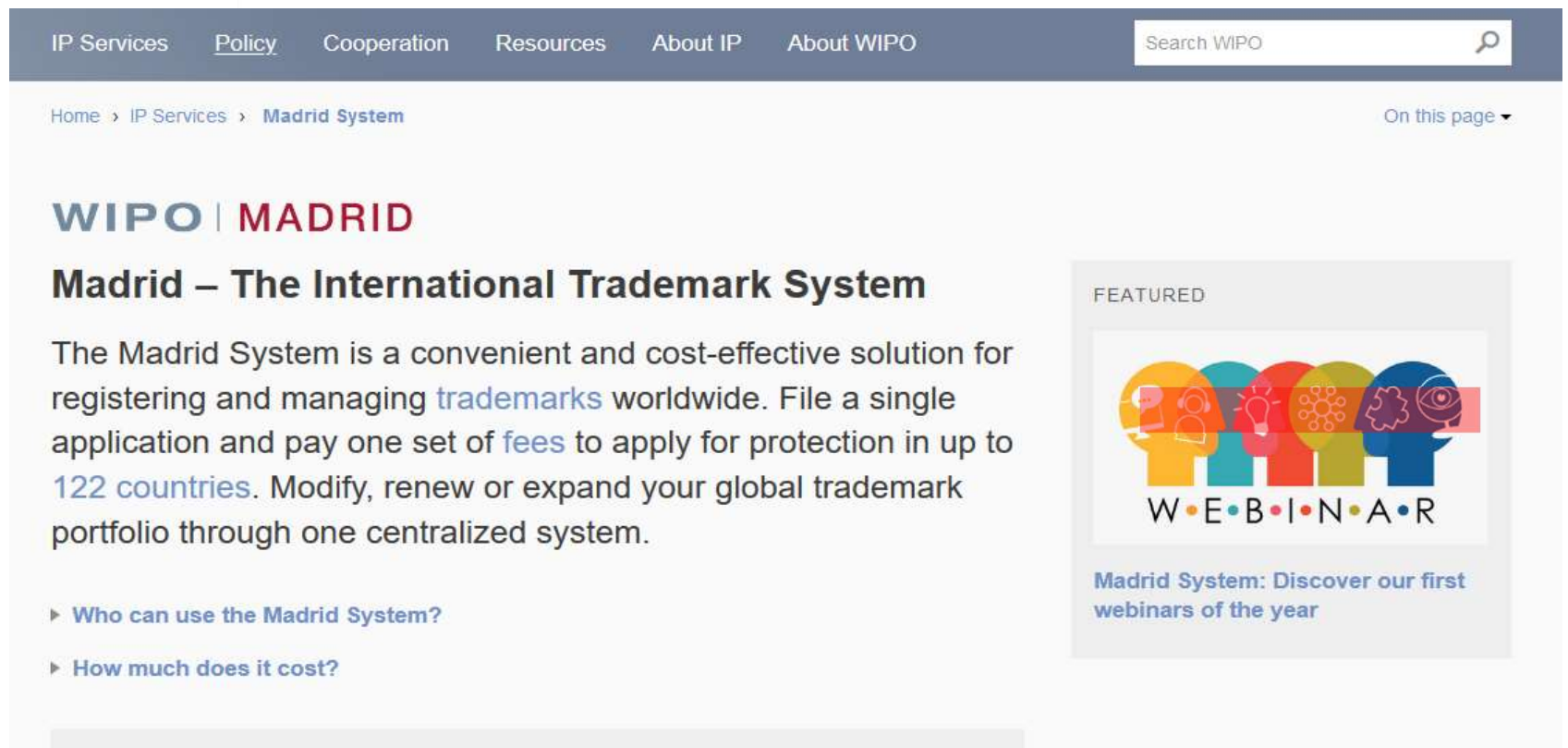
Is your mark a [collective mark](#), [certification mark](#) or [guarantee mark](#)?

↑

Payment methods

- Option 1: Current Account at WIPO
- Option 2: Credit card payments
- Options 3: Bank or Postal transfer

E-Subsequent designation



The image is a screenshot of the WIPO Madrid System webpage. At the top, there is a dark blue navigation bar with links for 'IP Services', 'Policy', 'Cooperation', 'Resources', 'About IP', and 'About WIPO'. A search bar on the right contains the text 'Search WIPO' and a magnifying glass icon. Below the navigation bar, a breadcrumb trail reads 'Home > IP Services > Madrid System'. On the right side of the page, there is a link 'On this page' with a dropdown arrow. The main content area features the WIPO logo followed by 'MADRID' in red. Below this is the heading 'Madrid – The International Trademark System'. The text describes the Madrid System as a convenient and cost-effective solution for registering and managing trademarks worldwide, mentioning that a single application can be filed for protection in up to 122 countries. At the bottom of the main text, there are two blue links: 'Who can use the Madrid System?' and 'How much does it cost?'. On the right side, there is a 'FEATURED' section with a graphic of five stylized human heads in different colors (orange, teal, red, green, blue) containing icons for a speech bubble, a lightbulb, a gear, and a brain. Below the graphic is the text 'W•E•B•I•N•A•R'. Underneath the graphic is a blue link: 'Madrid System: Discover our first webinars of the year'.

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Home > IP Services > [Madrid System](#) On this page ▾


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Madrid – The International Trademark System

The Madrid System is a convenient and cost-effective solution for registering and managing [trademarks](#) worldwide. File a single application and pay one set of [fees](#) to apply for protection in up to [122 countries](#). Modify, renew or expand your global trademark portfolio through one centralized system.

- ▶ [Who can use the Madrid System?](#)
- ▶ [How much does it cost?](#)

FEATURED



W•E•B•I•N•A•R

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E-Subsequent Designation

Please enter your International Registration Number

IRN

Submit

Reset



E-Subsequent Designation

1234567

Trademark details

IRN	1234567
Holder	Aurea Plana chemin des Colombettes 34 GENÈVE 20 CH

Contracting
Parties

- AF (Afghanistan)
- AG (Antigua and Barbuda)
- AL (Albania)
- AT (Austria)
- AU (Australia)
- BG (Bulgaria)
- BH (Bahrain)
- BN (Brunei Darussalam)
- BQ⁴ (Bonaire, Sint Eustatius and Saba)
- BT (Bhutan)
- BW (Botswana)
- CA (Canada)
- CU² (Cuba)
- CW⁴ (Curaçao)
- DE (Germany)
- EE (Estonia)
- EM (European Union)
- FR (France)
- GB¹ (United Kingdom)
- GE (Georgia)
- GH² (Ghana)
- GM (Gambia)
- HU (Hungary)
- ID (Indonesia)
- IE¹ (Ireland)
- LA (Lao People's Democratic Republic)
- LI (Liechtenstein)
- LR (Liberia)
- LS (Lesotho)
- MC (Monaco)
- MD (Republic of Moldova)
- MG (Madagascar)
- MW (Malawi)
- MY (Malaysia)
- MZ (Mozambique)
- NA (Namibia)
- NZ¹ (New Zealand)
- OA (African Intellectual Property Organization (OAPI))
- OM (Oman)
- PH (Philippines)
- RO (Romania)
- RW (Rwanda)
- SD (Sudan)
- SE (Sweden)
- SG¹ (Singapore)
- SI (Slovenia)
- SL (Sierra Leone)
- SM (San Marino)
- ST (Sao Tome and Principe)
- SX⁴ (Sint Maarten (Dutch part))

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Classes 9; 35; 38

options



Total



Partial

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Next

Classes 9; 35; 38

options Total Partial

Some goods and services for all CPs *Some goods and services for some CPs*

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Select classes

CPs	Nice Classes
BN	<input type="text" value="9; 35; 38"/>
MW	<input type="text" value="9; 35; 38"/>
ZW	<input type="text" value="9; 35; 38"/>

« « « « « « « » » » » » » »

Language of the limitation ▾

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Select classes

CPs	Nice Classes		
BN	9; 35; 38		
MW	Nice Class	Goods & Services	Edit
ZW	<input checked="" type="checkbox"/> 9	<input type="radio"/> all <input checked="" type="radio"/> some	Edit
««««	<input checked="" type="checkbox"/> 35	<input checked="" type="radio"/> all <input type="radio"/> some	Edit
	<input checked="" type="checkbox"/> 38	<input checked="" type="radio"/> all <input type="radio"/> some	Edit
OK			

Language of the limitation English ▾

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Select classes

Language of the limitation English

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Next

CPs	Nice Classes		
BN	9; 35; 38		
MW	Nice Class	Goods & Services	Edit
ZW	<input checked="" type="checkbox"/> 9	<input type="radio"/> all <input checked="" type="radio"/> some	Edit
««««	<input checked="" type="checkbox"/> 35	<input checked="" type="radio"/> all <input type="radio"/> some	
	<input checked="" type="checkbox"/> 38	<input checked="" type="radio"/> all <input type="radio"/> some	
OK			

Machine-readable bibliographic and graphic data media, including magnetic tapes, optical disks, CD-ROM disks for mark documentation software on magnetic or optical media.

1234567

CPs selected

BN (Brunei Darussalam)
MW (Malawi)
ZW (Zimbabwe)

Classes selected

9 (BN (limitation); MW; ZW)
35 (BN)
38 (BN)

Fees Details

Description	Details	Amount
✕		
Extension basic fee:	1 x 300	300
Extension complementary fee:	1 x 100	100
✕ BN (Brunei Darussalam)		
Individual fee per additional class (subsequent designation):	2 x 107 (1class(es) free)	214
Individual fee (subsequent designation):		196
✕ ZW (Zimbabwe)		
Individual fee (subsequent designation):		97
Total (CHF)		907

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Next

Transaction ID	TMFRMEX-200152509
Transaction subject	EX
Amount to pay	907.00 CHF

Your reference (optional, free text box for your own purposes)

E-mail address

Payment Method:

- Credit card
- Current account at WIPO

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Submit

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Subsequent designation resulting from conversion (Opting-back)

- The designation of the European Union has been withdrawn, refused, etc.
- Conversion through a subsequent designation of the European Union's Member States
- Conversion form (EUIPO form or [MM16](#)) must be presented to the EUIPO directly
- A subsequent designation resulting from Conversion is recorded with the same date as the designation of the European Union

Monitor your subsequent designation

- [Madrid Monitor](#): how to track the status of your subsequent designation as it moves through the examination process
- Watch our Madrid Monitor [Real-time updates](#) tutorial to learn how to follow the status of a subsequent designation

Subsequent designation: useful information

- Check the [Madrid Member Profiles](#) to access a wide range of information on the practices and procedures of Madrid System members.

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Q&A Session about Modifications

Aurea Plana
Madrid Legal Division

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