



ROLES AND JOBS OF TRADEMARK AGENTS AND SPECIALISTS BEFORE THE INTERNATIONAL BUREAU (IB)

WHAT ARE THE REQUIREMENTS FOR CLASSIFICATION AND INDICATION OF GOODS/SERVICES, AND FOR RENEWAL AND TRANSFER AND OTHER PROCEDURE; HOW TO RESPOND TO IRREGULARITY NOTIFICATIONS BY IB, etc.

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Roles and jobs of trademark agents and specialists before the International Bureau (IB)

【1】 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)

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【2】 Irregularity notifications by IB and how to respond

3 categories of irregularities

- 1) Classification of goods and services (Rule 12)
- 2) Indication of goods and services (Rule 13)
- 3) Other irregularities (Rule 11)

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【2】 Irregularity notifications by IB and how to respond

1) Classification of goods and services (Rule 12)

- Notification issued when Goods and services not properly classified
- The IB will make its own proposal and notifies it to the OO and copies to the applicant.
- Office of Origin to remedy (within 3 months from the date of notification)
- The IB cannot accept proposals or suggestions directly from the applicant.

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【2】 Irregularity notifications by IB and how to respond

2) Indication of goods and services (Rule 13)

- Too vague, linguistically incorrect, or incomprehensible

- IB notifies the OO and informs the applicant at the same time.

- IB may suggest either a substitute term or the deletion of the term.

 - (*Substitute terms suggested by IB **may not fall within the scope of** those used in the basic registration or application.)

- Office of origin to remedy (within 3 months from the date of notification)

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【2】 Irregularity notifications by IB and how to respond

3) Other irregularities (Rule 11)

-Entitlement, basic mark/priority, MM18, fees, etc.

-Office or origin, applicant or both to remedy

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【3】 Subsequent designations

1. General

- Possible to add more CPs to the existing IR – MM4
- The forms may be sent directly to the IB by the holder
- Follows the same lifetime cycle (renewal) as the IR
- List of G&S must be within the scope of the IR
- Check the countries that have made a Declaration under Article 14(5) of the protocol, (At present, holder from Cambodia may subsequently designate any CP which is also bound by the Protocol, though)

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2. 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

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3. How to fill in MM4 FORM

【Hypothetical Case Study 2】 Please prepare a MM4 form in accordance with the following:

- Home Cambodian Registration: Reg. No. KH/57016/15 (same as the Basic Mark of Case Study 1)
- International Registration No.: 1234XXX (Assume that the IA in Case Study 1 has matured into Reg. under this No.)
- Assume that the holder has moved to another place in Cambodia after the Int. Reg. and filed MM9 recently (not recorded yet) <Just indicate it as “*New address in Cambodia*” in the MM4 form>
- Assume that you have been a representative of the International Registration No. 123456X, and are continuously appointed as a representative of this subsequent designation.

- Designated contracting parties for which protection for the mark is sought :
South Korea, India and Philippines

- Goods for which the mark is to be protected :
South Korea : all goods covered by the International registration
India : clams, lobsters, oysters, salmon, sardines, tuna fish.
Philippines : lobsters, oysters

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MM4(E)

DESIGNATION SUBSEQUENT TO THE INTERNATIONAL REGISTRATION

For use by the holder	For use by the Office
This subsequent designation includes the following number of: - continuation sheets: - MM17 forms: Holder's reference:	Office's reference:
1 INTERNATIONAL REGISTRATION NUMBER 1234XXX	
2 HOLDER OF THE INTERNATIONAL REGISTRATION (as recorded in the International Register) Name: LSH (CAMBODIA) PTE LTD Address: <i>New address in Cambodia</i> E-mail address: xxxxx@online.com.kh By providing an e-mail address, any further correspondence from the International Bureau related to this international registration will be sent only electronically and, therefore, you will no longer receive any paper correspondence. Likewise, any further correspondence from the International Bureau related to other international applications or international registrations for which the same e-mail address has been, or will be, provided will also be sent only electronically. Please note that, for the purpose of electronic communication, there can be only one e-mail address recorded per each international registration.	
3 APPOINTMENT OF A (NEW) REPRESENTATIVE (only complete this item if you are appointing a (new) representative) Name: Address: Telephone: Fax:	

ITEM 1- international registration No.

- Indicate the full international registration number, for example 123456 or 123456A.
- There can be only one international registration number per form.

ITEM 2- HOLDER of the IR

- Indicate the Holder's name and address exactly as recorded in the International Register.

ITEM 3- Appointment of a new representative

- To appoint a representative for the first time or to appoint a new one, enter this field or attach a PoA or the MM12 form to this MM4 form.

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4 CONTRACTING PARTIES DESIGNATED SUBSEQUENTLY
 (Information concerning national or regional procedures for each Contracting Party designated may be found at the following website: www.wipo.int/madrid/en/members/ipoffices_info.html. Additional information may be found in the information notices available at: www.wipo.int/madrid/en/notices/.)

Check the corresponding boxes:

<input type="checkbox"/> AG Antigua and Barbuda	<input type="checkbox"/> EE Estonia ⁷	<input type="checkbox"/> LI Liechtenstein	<input type="checkbox"/> RS Serbia
<input type="checkbox"/> AL Albania	<input type="checkbox"/> EG Egypt	<input type="checkbox"/> LR Liberia	<input type="checkbox"/> RU Russian Federation
<input type="checkbox"/> AM Armenia	<input type="checkbox"/> EM European Union ¹	<input type="checkbox"/> LS Lesotho	<input type="checkbox"/> RW Rwanda
<input type="checkbox"/> AT Austria	<input type="checkbox"/> ES Spain	<input type="checkbox"/> LT Lithuania	<input type="checkbox"/> SD Sudan
<input type="checkbox"/> AU Australia	<input type="checkbox"/> FI Finland	<input type="checkbox"/> LV Latvia	<input type="checkbox"/> SE Sweden
<input type="checkbox"/> AZ Azerbaijan	<input type="checkbox"/> FR France	<input type="checkbox"/> MA Morocco	<input type="checkbox"/> SG Singapore ²
<input type="checkbox"/> BA Bosnia and Herzegovina	<input type="checkbox"/> GB United Kingdom ²	<input type="checkbox"/> MC Monaco	<input type="checkbox"/> SI Slovenia
<input type="checkbox"/> BG Bulgaria	<input type="checkbox"/> GE Georgia	<input type="checkbox"/> MD Republic of Moldova	<input type="checkbox"/> SK Slovakia
<input type="checkbox"/> BH Bahrain	<input type="checkbox"/> GH Ghana	<input type="checkbox"/> ME Montenegro	<input type="checkbox"/> SL Sierra Leone
<input type="checkbox"/> BQ Bonaire, Saint Eustatius and Saba ⁶	<input type="checkbox"/> GM Gambia	<input type="checkbox"/> MG Madagascar	<input type="checkbox"/> SM San Marino
<input type="checkbox"/> BT Bhutan	<input type="checkbox"/> GR Greece	<input type="checkbox"/> MK The former Yugoslav Rep. of Macedonia	<input type="checkbox"/> ST Sao Tome and Principe
<input type="checkbox"/> BW Botswana	<input type="checkbox"/> HR Croatia	<input type="checkbox"/> MN Mongolia	<input type="checkbox"/> SX Sint Maarten (Dutch Part) ⁶
<input type="checkbox"/> BX Benelux	<input type="checkbox"/> HU Hungary	<input type="checkbox"/> MX Mexico	<input type="checkbox"/> SY Syrian Arab Republic
<input type="checkbox"/> BY Belarus	<input type="checkbox"/> IE Ireland ²	<input type="checkbox"/> MZ Mozambique ²	<input type="checkbox"/> SZ Swaziland
<input type="checkbox"/> CH Switzerland	<input checked="" type="checkbox"/> IL Israel	<input type="checkbox"/> NA Namibia ⁷	<input type="checkbox"/> TJ Tajikistan
<input type="checkbox"/> CN China	<input checked="" type="checkbox"/> IN India ^{2,7}	<input type="checkbox"/> NO Norway	<input type="checkbox"/> TM Turkmenistan
<input type="checkbox"/> CO Colombia	<input type="checkbox"/> IR Iran (Islamic Republic of)	<input type="checkbox"/> NZ New Zealand ²	<input type="checkbox"/> TN Tunisia
<input type="checkbox"/> CU Cuba ⁵	<input type="checkbox"/> IS Iceland	<input type="checkbox"/> OA African Intellectual Property Organization (OAPI) ³	<input type="checkbox"/> TR Turkey ⁷
<input type="checkbox"/> CW Curaçao ⁶	<input type="checkbox"/> IT Italy	<input type="checkbox"/> OM Oman	<input type="checkbox"/> UA Ukraine
<input type="checkbox"/> CY Cyprus	<input type="checkbox"/> JP Japan ⁵	<input checked="" type="checkbox"/> PH Philippines ⁷	<input type="checkbox"/> US United States of America ⁴
<input type="checkbox"/> CZ Czech Republic	<input type="checkbox"/> KE Kenya	<input type="checkbox"/> PL Poland	<input type="checkbox"/> UZ Uzbekistan
<input type="checkbox"/> DE Germany	<input type="checkbox"/> KG Kyrgyzstan	<input type="checkbox"/> PT Portugal	<input type="checkbox"/> VN Viet Nam
<input type="checkbox"/> DK Denmark	<input type="checkbox"/> KH Cambodia	<input type="checkbox"/> RO Romania	<input type="checkbox"/> ZM Zambia
<input type="checkbox"/> DZ Algeria	<input type="checkbox"/> KP Democratic People's Republic of Korea		<input type="checkbox"/> ZW Zimbabwe
	<input checked="" type="checkbox"/> KR Republic of Korea		
	<input type="checkbox"/> KZ Kazakhstan		

Others:

¹ The designation of the European Union covers the following Member States: Austria, Belgium, Bulgaria, Croatia, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Luxembourg, Malta, Netherlands, Poland, Portugal, Romania, Slovakia

ITEM 4-CONTRACTING PARTIES DESIGNATED SUBSEQUENTLY

- Check the corresponding boxes of the Contracting Parties for which protection for the mark is sought.
- Checking the OO is not allowed.
- Check the CPs that have made a declaration under Article 14(5) of the Protocol (see the footnote 7 in ITEM4 of MM4)
- Certain requirements for certain DCPs (see footnotes 1 to 6)

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STATUT (L); PUEB...

5

GOODS AND SERVICES CONCERNED BY THE SUBSEQUENT DESIGNATION (check only one box)

- (a) the subsequent designation is made, in respect of all the Contracting Parties designated in item 4, for all the goods and services listed in the international registration indicated in item 1; or
- (b) the subsequent designation is made, in respect of all the Contracting Parties designated in item 4, only for those goods and services listed in the continuation sheet (which must be grouped in the appropriate class(es)); or
- (c) the subsequent designation is only for those goods and services listed in the continuation sheet in respect of the Contracting Parties identified in the said continuation sheet; in respect of the other Contracting Parties designated in item 4, the subsequent designation is for all the goods and services listed in the international registration identified in item 1.

You can find indications that are pre-accepted by the International Bureau in the Madrid Goods & Services Manager (MGS) at www.wipo.int/mgs/. By using these indications you can avoid possible irregularities concerning the classification of goods and services and a delay in the recording of the international registration.

Please make consistent use of a semicolon (;) to clearly specify the goods and services indications in your list, e.g.:
09 Scientific, optical and electronic apparatus and instruments; screens for photoengraving; computers.
35 Advertising; compilation of statistics; commercial information agencies.

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

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(Continuation sheet)

CONTINUATION SHEET

No: ..1..... of1.....

For India

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clams, not live; lobsters, not live;
oysters, not live; salmon, not live;
sardines, not live; tuna, not live

For Philippines

29

lobsters, not live; oysters, not live

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6 MISCELLANEOUS INDICATIONS

- (a) Indications concerning the holder (as may be required by certain designated Contracting Parties; for example, if the **United States of America** is designated, it is necessary to include these indications):
- (i) if the holder is a natural person, nationality of the holder:
 - (ii) if the holder is a legal entity:
 - legal nature of the legal entity: Private Limited Company *(Please consult the Office of Origin just in case)*
 - State and, where applicable, territorial unit within that State, under the law of which the legal entity is organized:
Cambodia
- (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 word "ROYAL" is in baby blue, "Ocean" is in black, and the device inside "O" of the word "Ocean" is in sky blue color.
(please note this is just an example)
- (c) Translation of the mark (as may be required by certain designated Contracting Parties):
- (i) into English:
 - (ii) into French: océan royal
 - (iii) into Spanish: océano real
- (d) Check this box if the words contained in the mark have no meaning (and therefore cannot be translated).

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):

Change in address of the holder

ITEM 6-MISCELLANEOUS INDICATIONS

- Advisable to provide the information requested here, in order to avoid refusal by DCPs.

ITEM 7- DATE OF EFFECT OF THE SUBSEQUENT DESIGNATION

- May request that the subsequent designation take effect later than another transaction (e.g., recording of a change or after the renewal of the IR).
- May be useful since it will reduce the fees to be paid.

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8	SIGNATURE BY THE HOLDER AND/OR HIS REPRESENTATIVE
<u>Holder</u> (as recorded in the International Register)	<u>Representative of the holder</u> (as recorded in the International Register or herein appointed)
Name:	Name:
Signature:	Signature:
9	DATE OF RECEIPT AND DECLARATION BY THE OFFICE OF THE CONTRACTING PARTY OF THE HOLDER PRESENTING THE SUBSEQUENT DESIGNATION (where the subsequent designation is presented through an Office)
(a)	Date of receipt of the subsequent designation by the Office: (dd/mm/yyyy)
(b)	Declaration that the <u>basic application</u> has matured to registration (only applicable where the international registration was based on a basic application and the present subsequent designation is designating a Contracting Party under the Agreement)
(i)	Date of the registration resulting from the basic application: (dd/mm/yyyy)
(ii)	Number of the registration resulting from the basic application:
10	OFFICE PRESENTING THE SUBSEQUENT DESIGNATION (if applicable)
Name of the Office:	
.....	
Name and signature of the official signing on behalf of the Office:	
.....	
Name and e-mail address of the contact person in the Office:	
.....	

ITEM 8-SIGNATURE BY THE HOLDER AND/OR HIS REPRESENTATIVE

- As a representative, sign the form and indicate the name as recorded in the International Register

ITEM 9, 10

- Leave this space blank. If the form is presented via an Office, the Office will fill in the relevant information.

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FEE CALCULATION SHEET

(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:

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

Basic fee (Swiss francs) 300.--

Complementary fees:

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

Individual fees (Swiss francs):

Designated Contracting Parties	Individual fee	Designated Contracting Parties	Individual fee
India	62
Republic of Korea	233
Philippines	95
.....
.....
		Total individual fees =>	390
		GRAND TOTAL (Swiss francs)	690

Fee Calculation Sheet:

- Basic fee: 300 CHF
- Fees for designating CPs:
 - Complementary (100 CHF per DCP)

-or-

In Individual fees

- Use WIPO's Fee Calculator at <http://www.wipo.int/madrid/en/fees/calculator.jsp>

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【4】 Renewal, transfer and other procedure

(1) Renewal

- 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>

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【4】 Renewal, transfer and other procedure

(2) Transfer (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

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【4】 Renewal, transfer and other procedure

(3) 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

Roles and jobs of trademark agents and specialists before the International Bureau (IB)

【4】 Renewal, transfer and other procedure

(4) Restrictions in the protection of the IR

- An Applicant/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

Roles and jobs of trademark agents and specialists before the International Bureau (IB)

(4)-1 Limitation (MM6)

- If an applicant/holder wants to reduce the list of G&S for all or some of the DCPs in the IR, he/she 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

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(4)-2 Renunciation (MM7)

- If an applicant/holder wants to abandon the effects of the IR for one or some of the DCPs, he/she can use the form for renunciation
- Can be used where the holder 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

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(4)-3 Cancellation (MM8)

- If an applicant/holder wants to cancel the effects of an IR for all or some of the G&S in respect of all the DCPs, he/she 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 a holder later wishes to obtain protection for the part of the IR that has been cancelled, he/she would need to file a new international application
- No fee for the recording of a cancellation

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(4) - 4 Limitation, renunciation and cancellation

	Limitation (MM6)	Renunciation (MM7)	Cancellation (MM7)
Goods and Services	Some	All	Some or All
Designated Contracting Parties	Some or All	Some	All
Subsequent Designations	OK	OK	NG
Fees	177 CHF	Free of charge	Free of charge



Thank you
for your attention

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