



# International Registration Procedures at WIPO

**Geneva**  
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# International Application & Registration

- No Direct Filing (Office of origin)
- Formality Check
- Classification
- Fees

## Contents IA (MM2)

Madrid Protocol - Articles 2 & 3

Common Regulations - Rules 8, 9, 10, 11, 12, 13, 14 & 15

Administrative Instructions - Sections 9, 12, 13 & 19

# Applicant

- Name
- Address
- Address for Correspondence
- Telephone
- Fax
- E-mail
- Preferred Language for Correspondence
- Other Indications – Rule 9(4)(b)(ii)

# Basic Mark & Priority Claim

- Basic Application or Registration
  - One
  - More than One

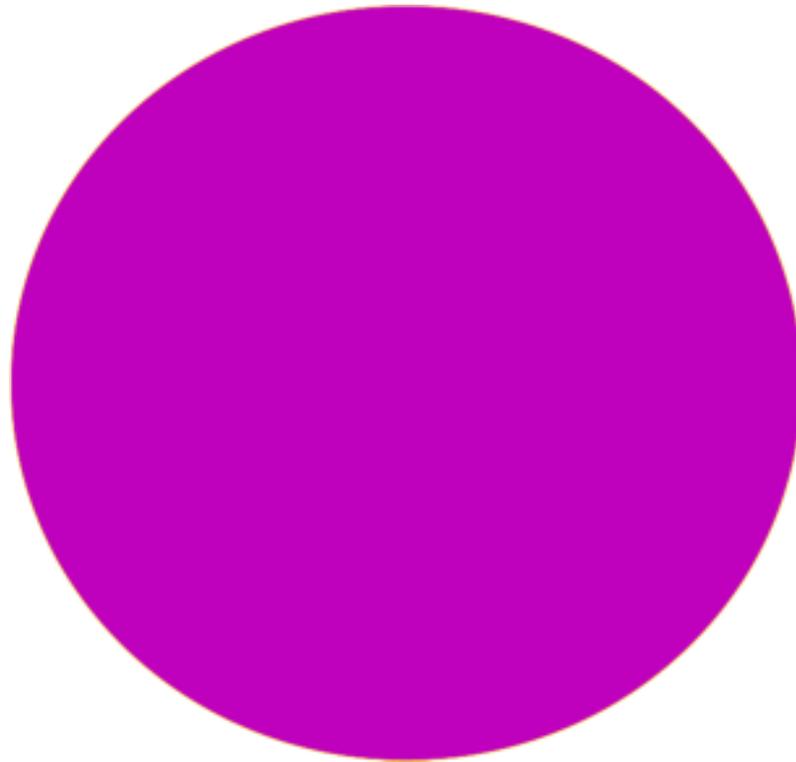
- Priority Claim
  - Office
  - Number
  - Date

# The Mark



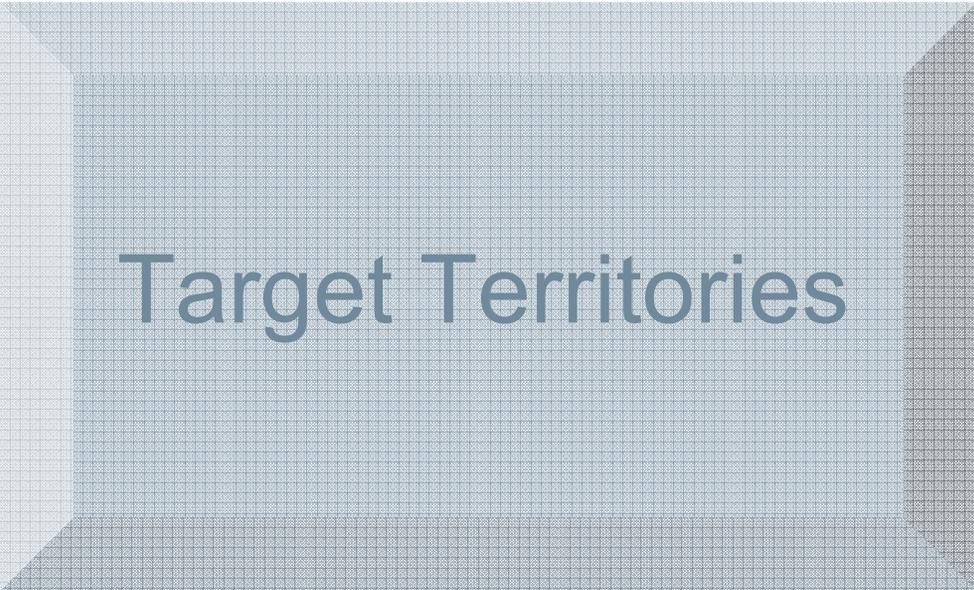
- Standard Characters
- Fax Transmission

# Color Claim – Color Only

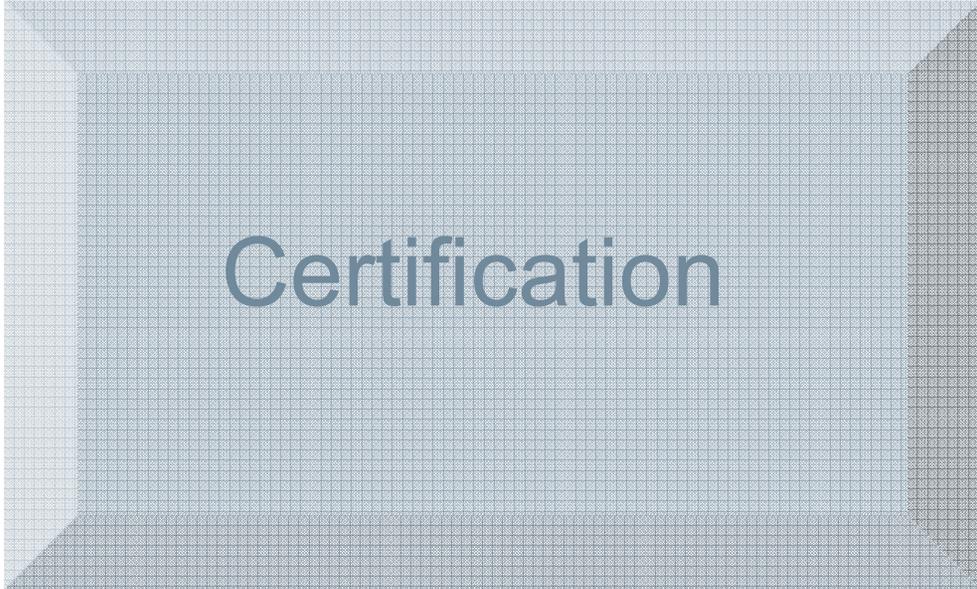


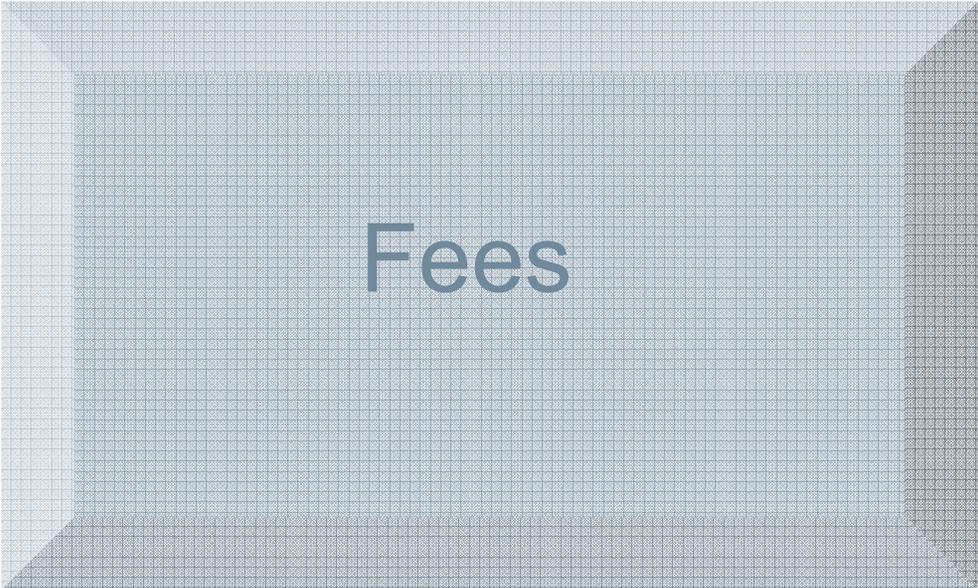
# Goods & Services

- Main List
- Limitation



# Target Territories





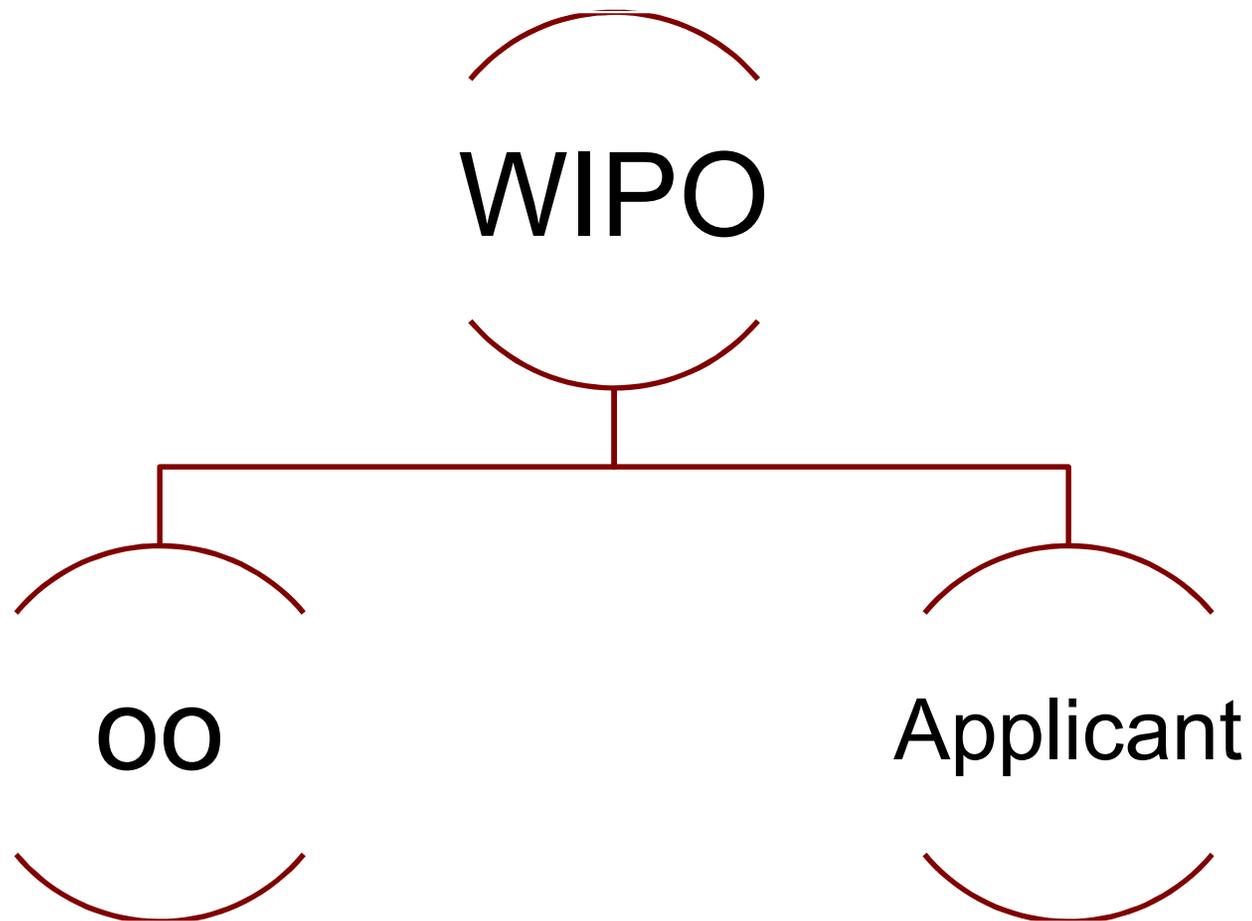
# Fees



## Irregularities

Common Regulations – Rules 11, 12  
& 13

# Irregularities: Roles



# Contents

- Addressee
- Date/Deadline
- Responsibility
- References
- Examiner
- Object (One/More)
- Consequences (No Response)
- Fees

## 3 Types

Rule 11

Miscellaneous

Rule 12

G&S  
Classification

Rule 13

G&S  
Indication

# Rule 11: Procedure

- WIPO's Notice
- Deadline: 3 Months
- Corrected: Recorded
- No Reply/Not Corrected: Abandoned

<sup>1</sup> Refund: fees paid minus 1/2 basic fee for black & white reproduction

## Rule 11 – Office of Origin

- Official Form ≠ Used
- No Office Signature
- Omission of Four Substantive Elements (Rule 15)
- Entitlement
- BA/BR Details
- No Certification
- MM18
- Fees (Office Collects and Forwards Fees)

## Rule 11 - Applicant

- Address Insufficient
- Transliteration
- Description of the Mark ≠ Madrid Working Language
- Priority Claim (Insufficient Details)
- Reproduction ≠ Clear
- Color Claim (No Color Reproduction)
- Limitation ≠ Reflected in Main List
- Fees (Applicant Pays Directly to WIPO)
- MM18

# Rule 11: Case Study (1) - Reproduction

## Office of Origin

- Sent by Facsimile
- Deadline: One month
- Signature
- Details
- Incorrect Response = **Abandoned**
- No response = **Abandoned**

## Applicant

- Not Clear
- ≠ Fascimile
- Deadline: 3 months
- Incorrect Response = **Abandoned**
- No Response = **Abandoned**

<sup>1</sup> Refund: fees paid minus 1/2 basic fee for black & white reproduction

## Rule 11: Case Study (2) – Entitlement

- BA = USPTO
- Entitlement = SG (Establishment/Domicile)
- Item 3.b of Form = No Address in US
- 3 Months from Date of Notification, if not, **Abandoned**

<sup>1</sup> Refund: fees paid minus 1/2 basic fee for black & white reproduction

## Rule 12: Procedure

- **WIPO's Notice** (3 month time-limit/reminder after 2 months)
- **Response**
  - WIPO withdraws/fees paid = registered as filed
  - WIPO modifies or confirms/fees paid = registered as per modification or WIPO's proposal
- **No Response**
  - Fees paid = registered with WIPO's proposal
  - Fees not paid = **abandoned (refund)**

### WIPO's OPINION

<sup>1</sup> Refund: fees paid minus 1/2 basic fee for black & white reproduction

# Rule 12: Case Study

Health Club Services (CL 44) – transferred to CL 41



Corrected within time limit - recorded

Not corrected within time limit → abandoned!!!

# Rule 13: Procedure

- **WIPO'S Notice** (3 month time-limit/no reminder)
- **Response**
  - Accepted by WIPO = Registered with OO's opinion
  - Rejected by WIPO
    - Registered (term deleted if not classified)
    - Registered as Filed (if term is classified with annotation)
- **No Response**
  - Registered as Filed with note

## Rule 13: Case Study

«Tobacco Shred» (CL 34)

March 16, 2017 - Irregularity Notice

Too Vague for the purposes of classification

Proposal – «specify» - «shredded tobacco»

Warning – note signalled in irregularity notice

Deadline – June 16, 2017

No Response – Fees Paid

Outcome!

Recorded in International Register with note

# International Registration

- IRN
- IR Date (Rule 15)
- Period of Validity: 10 Years

Avoiding  
Irregularities &  
Refusals

# Irregularities (WIPO)

- Read irregularity notice carefully
- Act swiftly
  - Determine party to respond
  - Contact OO – avoid responding in place of OO
  - Contact WIPO for any clarifications
- Indicate all references to allow connection
  - Our ref. : EN-I/588841101/LC
- Reply within time-limit
  - Watch out for late responses: Change in IR Date or **Abandonment**

# Irregularities (WIPO)

- Specify terms that exist in several classes
  - Threads of plastic (classes 17 & 23)
- Only reply to terms that are object of an irregularity in a classification case – avoid sending entire (new) list
- Continued Processing – Rule *5bis*
  - *MM20*

# Refusals (DCPs)

- Legal Nature & Nationality
- Reproduction of the Mark
  - Standard Character
  - Color Mark
  - Special Type or Category of Mark
  - Disclaimer
  - Discription of the Mark
  - Translation
- Classification – Specificity, National Laws, Practices & Policies

# Contact Us

## Madrid System – Contacts

Madrid Customer Service opening hours:

Monday – Friday, 9:00 a.m. to 6:00 p.m.  
(Geneva time)

Telephone: + 41 22 338 86 86

Inquiries / submitting forms:

<http://www.wipo.int/madrid/en/contact/>

## Mailing address

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