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Q&A Sheet

Roving Webinar on WIPO Services and Initiatives – Day 1

organized by

the World Intellectual Property Organization (WIPO)

and

the Canadian Intellectual Property Office (CIPO)

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Service	Question Asked	Answer
<p>Madrid System - Trademarks https://www.wipo.int/madrid/en</p>	<p>Does WIPO send the Statement of Grant of Protection by regular mail or by email? If a WIPO representative is appointed, will the representative get a copy of the Statement of Grant of Protection?</p>	<p>WIPO will communicate with the holder electronically (by email) where we have their email address; otherwise, WIPO will send received communications from designated Contracting Parties by regular mail.</p> <p>As of February 1, 2021, it is mandatory to provide an email address for new applicants, new holders and new representatives. See Information Notice No. 78/2020 and Further details on the requirement of an email address.</p> <p>Where the holder has appointed a representative before WIPO, WIPO will send the statement of grant of protection (and other decisions) to the representative.</p>
	<p>If a designated Contracting Party (CP) issued a provisional refusal “only 1 day before” the expiry of the applicable refusal period, say 18 months from the IR date, (a) does it mean that protection will not be granted in that particular CP? (b) If the IR Holder then responds to the provisional refusal within the prescribed deadline stated in the provisional refusal, what sort of timeline is the CP obliged to comply with to complete examining the IR, since the refusal period of 18 months would likely to have expired in this case when the IR holder responds to the provisional refusal?</p>	<p>Where a designated Contracting Party has issued a provisional refusal within the applicable time limit for such (12 or 18 months), it means that protection is not granted. However, the holder has at their disposal all the available mechanisms set out in the domestic legislation to contest that refusal, for example, by requesting the Registrar to review their decision or file an appeal to the Boards of appeal or the court. The time limit of 12/18 months only apply for Offices of Contracting Parties to send their provisional refusals to WIPO. In the respective provisional refusals, which WIPO will forward to the holders, the Offices are obliged to give a time limit to the holder to contest or respond to the refusal. The time limit is set by the Office concerned and follow their domestic rules and procedures.</p> <p>For more information of the various procedures and time limits by Offices of Contracting Parties, see the Member Profiles Database</p>
	<p>In relation to Madrid application system, we said one language is enough. Hence, does the system goes about procedural issues like notification and opposition requirements in member countries. Who will take</p>	<p>The Madrid System has three working languages, English/French/Spanish. Where an international application is filed in, for example, English, WIPO will translate this to French and Spanish. The Contracting Parties will inform WIPO of their</p>

	<p>responsibility translation in member countries in which English or French is not spoken?</p>	<p>language of communication with WIPO (English, French or Spanish). The provisional refusal will be in one of these languages, following the choice of the Office concerned. Where the holder would receive a decision and contest this, in most cases, the holder would be required to appoint a local attorney to represent them before the Office concerned and the following procedure would then be in the official language of that Office, which could be in other languages. Where that Office concerned is ready to make their final decision, they will send this to WIPO in their official Madrid language. Where WIPO receives final communications from Contracting Parties (statements of grant of protection, final decisions following a provisional refusal, further decisions or invalidations), WIPO will ensure that these are translated into the other two languages, so that the holder will receive this in their preferred language.</p>
	<p>My firm has a registered Trademark in Canada. What is the benefit of registering with Madrid System if your company is not doing business or have any plans to do business in other countries in the near future?</p>	<p>If you do not have any plans to do any business outside Canada for the moment, you should rather stick to your national registration. When you perhaps in the future would consider exporting your goods/services abroad and it would be important for you to secure protection of your trademark in these export markets, then you should consider if you could use the Madrid System – providing your export markets are among the members of the Madrid Protocol.</p>
	<p>I would like to know the ways to protect trade secrets in Madrid system and also about the ways to proceed legal protection against Trade secret infringement.</p>	<p>The Madrid System is for protecting trademarks, it facilitates an easier access to potential export markets. The Protocol does not have any provisions concerning trade secret.</p> <p>It is up to the designated Contracting Parties to determine protection in line with their domestic legislation. You would need to see with the potential Contracting Parties on what provisions they may have for trade secrets.</p>

	<p>In case of subsequent Application do an Applicant need to again pay the Basic Fees or not?</p>	<p>Yes, there is a basic fee for subsequent designation as well, but this is only 300 Swiss francs. You can check out the Fee Calculator here for more fees. More specific to Canada, an individual fee in Swiss Francs is required for the subsequent designation as stated in the Individual Fees under the Madrid Protocol</p>
	<p>With Madrid system, if the applicant has appointed an agent/ reps, can we use the agent's email instead of Applicant's email?</p>	<p>No, you cannot use the same email as your representative. The applicant and the representative have to provide their own email addresses. Please note that this will not be published on WIPO's website and not disclosed to the public nor the designated Contracting Parties. See Information Notice No. 78/2020 and Further details on the requirement of an email address.</p>
	<p>Mr. Andy Chow mentioned that if you file in the US via Madrid specimens of use are not required. I assume that specimens be required on the 5th/6th anniversary? Will USPTO send a notification of this anniversary via WIPO?</p>	<p>No, the USPTO will not alert the holder via WIPO as the use-requirement is a national procedure, which is outside the Madrid System. According to information WIPO has received from the USPTO in the Member Profiles Database, the USPTO issues courtesy reminder notices via email to those registrants that have provided a valid email address to receive such notices. Check the USPTO's website - https://tmep.uspto.gov/RDMS/TMEP/current#/current/TMEP-1600d1e2763.html</p>
	<p>I have a question regarding guarantees for trust and honesty from hired professional service providers worldwide in case service fees are paid to the agent but the response to substantially response to IP Office is not filed timely and the application is lapsed; or IP patent agent deliberately develops extra rounds of communication with IP Offices that involve higher number of invoices and expenses involved; or the hired IP agent is deliberately lying to minimize IPR prosecution and scope. Is there any chance to seek for rights protection by the Applicant at WIPO in case of dishonest service</p>	<p>This would be a matter between the holder and the attorney concerned, and the legislation covering offering such services. This is outside WIPO's area.</p> <p>If an applicant's rights have been lost as a result of negligence or error on the part of the hired professional, the applicant may wish to consider whether insurance could cover such loss. The applicant could contact the regulator of the hired professional to inquire about insurance coverage.</p> <p>Additionally, the applicant should consider retaining and asking an another professional (trademark agent or trademark attorney) to independently review the file and prosecution history.</p>

	<p>provision by IP Agents? Please, advise how the Applicant can protect himself and "punish" in case of dishonest service provision. Please, further advise whether Power of Applicant should be introduced to protect the rights of the applicant versus Power of Attorney.</p>	
	<p>I am Trademark Attorney in India so can I register myself at CIPO portal?</p>	<p>Information on how to become a trademark agent in Canada is available here: https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr00066.html.</p> <p>However please note these requirements are in the process of being amended in view of the implementation of a new Canadian Agent College. Information in this regard can be found here: https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/h_wr04936.html</p>
	<p>Could you please re-confirm that a WIPO application requires the applicant's email address (not the attorney's email address). And, if this applies to all applications or just ones that are based on Canadian app/reg or a Canadian designation.</p>	<p>It is mandatory for all applicants, new holders and representatives to provide an email address. See Information Notice No. 78/2020 and Further details on the requirement of an email address.</p>
	<p>Filing for protection be it via National or Madrid system are both prohibitive to start-up in my country. As a result, most innovations are lost to those that have resources. Is there a way of payment by instalment over say 2 Years based on business income rate considerations?</p>	<p>Unfortunately, for using the Madrid System, the applicant would need to pay all the relevant fees at the time of filing.</p>
	<p>What would you recommend to a country that is just starting with the Madrid system like Chile? from the point of view of your experience with Canada</p>	<p>WIPO is following up closely with the IP Office of Chile – as we do with all countries that have expressed an interest to join the Madrid Protocol – to help them with having Madrid-compatible legislation and all relevant Madrid-specific procedures in place. If you want to know more of the type of assistance that WIPO may provide to potential members, please see here.</p>

		For Canada's experience, discussions with Offices who have joined the Madrid system and have similar legislative frameworks can be very helpful. WIPO was very supportive during the accession process and is always available to answer questions and provide assistance.
Hague System - Industrial Designs https://www.wipo.int/hague/en/	How are some countries valid longer than the WIPO record? Should not they expire at the same time?	Indeed, they should and they do. 15 years of protection is just the guaranteed minimum. Where legislation provides for a term that is longer, Hague registrations enjoy that longer term. For example, your Hague registration can be renewed for up to 25 years in respect of the European Union, as this is the term applicable under the EU regulation.
	Kindly advise how we can defer publication	When using eHague (the electronic filing interface), you will be asked to make your choice between immediate, standard (i.e., 6 months after filing), or deferred publication. eHague will also remind you of your choice of designated Contracting Parties that may limit the availability or duration of deferment
	What is the difference between the WIPO Hague Express database vs the WIPO Global Design database, especially in relation to the data?	The GDD includes the Hague Express, alongside many other national or regional collections. If you are interested in finding out about what your competitors are protecting around the world, use the GDD. If you are more interested in looking for examples of successful strategies under the Hague System, using the Hague Express database is sufficient and easier to navigate
	I note that my country (Malawi) is not a member of the Hague System. Kindly assist me with requirements for a country to join. I want to be knowledgeable before going about knocking on my Government officials doors asking on why we are not a member	As a WIPO Member State, Malawi is welcome to join any time. All this is needed is an accession instrument, signed by the Head of State or Minister of Foreign Affairs. Governments would typically get in touch with us to state their interest so that we can guide them more specifically and ensure proper implementation. For the moment, alas, we have not been approached by the government of Malawi. It is generally important for a government to hear from the local business community of their interest in seeing an accession before they would make a move with us.