



**WIPO | MADRID**

The International  
Trademark System

# Role of the International Bureau

Regional Meeting of Intellectual Property Office Officials Responsible  
for the Madrid System

Juan Rodriguez  
Senior Legal Officer  
Legal Division  
Madrid Registry

**Tokyo, December 2016**

# Agenda

- Depositary functions
- International applications
  - Irregularities in international applications
- International registrations
  - The International Register
  - The Gazette
- Administrative duties

# Depositary functions

# Duties of the Director General of WIPO: depository functions

Receive instruments of accession, as well as declarations under the protocol and notifications of denunciation and notify Contracting Parties (Art. 14):

- refusal period (Art. 5(2))
- individual fee (Art. 8(7))
- common office (Art. 9*quater*)

# Brunei Darussalam joined the Madrid Protocol – October 6, 2016



## MADRID (MARKS) Notification No. 212

PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

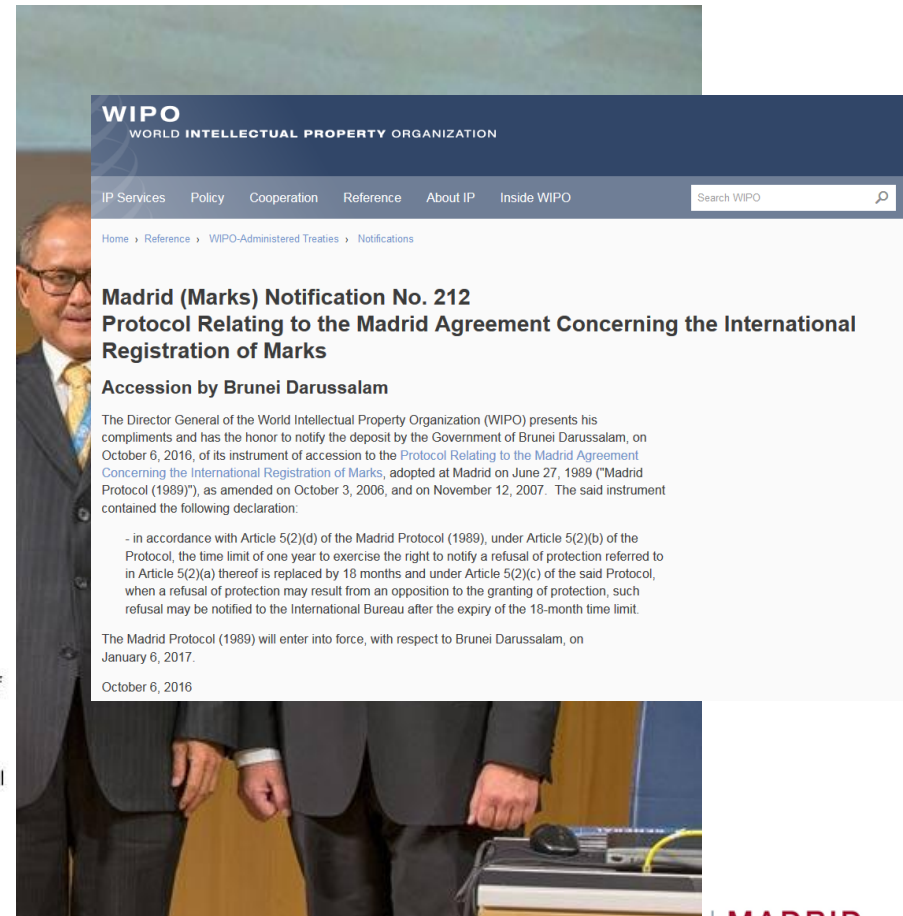
### Accession by Brunei Darussalam

The Director General of the World Intellectual Property Organization (WIPO) presents his compliments and has the honor to notify the deposit by the Government of Brunei Darussalam, on October 6, 2016, of its instrument of accession to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted at Madrid on June 27, 1989 ("Madrid Protocol (1989)"), as amended on October 3, 2006, and on November 12, 2007. The said instrument contained the following declaration:

- in accordance with Article 5(2)(d) of the Madrid Protocol (1989), under Article 5(2)(b) of the Protocol, the time limit of one year to exercise the right to notify a refusal of protection referred to in Article 5(2)(a) thereof is replaced by 18 months and under Article 5(2)(c) of the said Protocol, when a refusal of protection may result from an opposition to the granting of protection, such refusal may be notified to the International Bureau after the expiry of the 18-month time limit.

The Madrid Protocol (1989) will enter into force, with respect to Brunei Darussalam, on January 6, 2017.

The list of the States and the intergovernmental organizations party to the Madrid Protocol (1989) (status on October 6, 2016) is attached to this Notification.



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October 6, 2016

# International applications

# Duties of the International Bureau for international applications – Art. 3

- Receive applications for international registration, filed through the Office of origin (OO)
- Control the classification of goods and services, in association with the OO
- Register the marks filed in accordance with the Protocol
- Notify the international registration to the Offices of the designated Contracting Parties (dCPs)
- Publish registered marks in a periodical gazette
- Record, notify and publish subsequent designations

# Irregularities in international applications



# Irregular international application

## ■ Formalities

no certification, using wrong form, no indication of entitlement, missing form MM18, no payment, etc. (Rule 11)

## ■ Classification of goods and services

no indication of class or terms wrongly classified (Rule 12)

## ■ Indications of goods and services

linguistically incorrect, incomprehensible or too vague for the purposes of classification (Rule 13)

# Remedying an irregular application

## Office of origin:

- using wrong form
- defective application (missing applicant, mark, goods and services or designations)
- missing or defective entitlement
- missing number or date of basic mark
- irregular certification
- goods and services (Rules 12 y 13)

## Applicant:

- address not sufficient for postal communication
- unclear reproduction of the mark
- missing transliteration
- description of the mark not in a working language
- insufficient fees
- missing form MM18

# Time-limit to remedy irregularities

- An extemporaneous priority claim will be disregarded
- Where form MM18 is not received by WIPO within two months from date on which international application was received by the Office of origin, designation of the US is disregarded
- Other irregularities must be remedied within three months from their notification

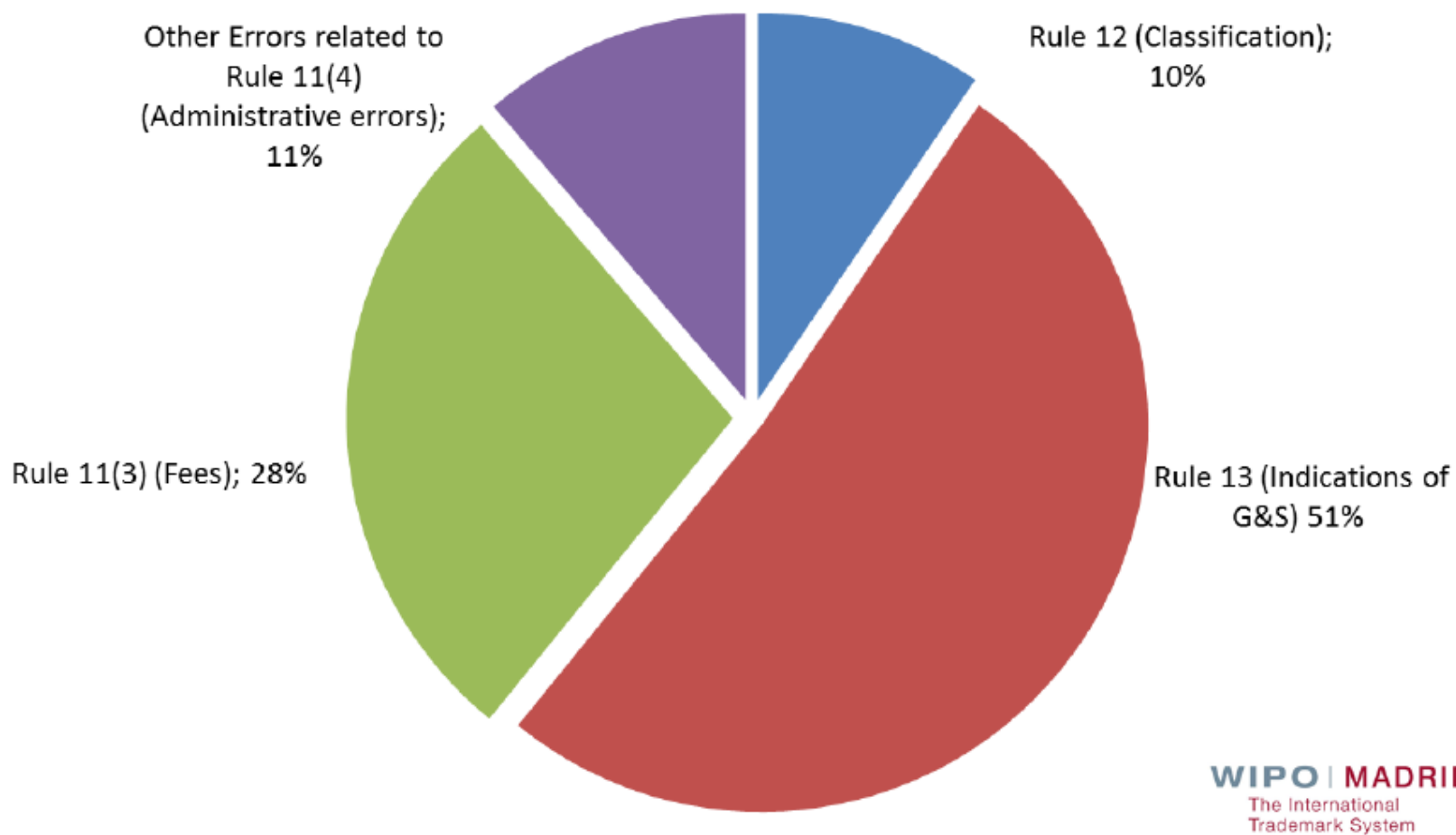
# Consequences

- **Formal (Rule 11)**  
where not remedied, application is declared abandoned
- **Classification of goods and services (Rule 12)**  
recorded with the classification considered to be correct by the International Bureau; applicant has a new deadline to pay any additional fees
- **Indications of goods and services (Rule 13)**  
without a satisfactory proposal from Office of origin, original term is recorded with a note from the International Bureau

# Irregular international applications



# Types of irregularities



**NOTICE CONCERNING AN INTERNATIONAL APPLICATION****ATTENTION:**

The irregularity(ies) indicated in this notice is/are to be remedied by the office of origin.

The response to this notice should be received by the International Bureau no later than 15 November 2016 Please indicate the WIPO Reference number 992050301 in all your communications with the International Bureau.

**Re.:** International application based on  
application N° 015453384  
for the mark **PSA World**  
in the name of **Professional Squash Association**

**Date** of receipt of the international application  
by the Office of origin: 23 June 2016  
by the International Bureau: 4 July 2016

Our ref. : EN-I/992050301/OB  
Office ref. : 015453384\_01  
Applicant ref.:  
Examiner: Oyuntsetsen BADARCH  
Telephone N°: 0041223387501  
E-mail: intreg.mail@wipo.int

The examination of this application has revealed the irregularities which are listed hereafter:

1. The International Bureau considers that the following term(s) of the list of goods and/or services is/are incomprehensible (Rule 13):

(1) "lonone (perfumery)" (class 3)

(2) "ail polish" (class 3)

The International Bureau suggests therefore the following:

(1) Please verify/reword this product in this class. (class 3)

(2) "nail polish". (class 3)



A proposal as to different term(s) may be communicated to the International Bureau. Any such proposal must be communicated **THROUGH THE OFFICE OF ORIGIN**, within three months from the date of the present notification, that is by 15 November 2016. If no proposal acceptable to the International Bureau is made within this period, the International Bureau will include in the international registration the term(s) as appearing in the international application, with an indication to the effect that, in the opinion of the International Bureau, the specified term(s) is/are too vague for the purposes of classification.

Annex to the irregularity notice concerning the  
international application based on the national  
application or the national registration No 015453384

Our ref.: EN-I/992050301/OB  
Office ref. : 015453384\_01  
Applicant ref.:

	Swiss Francs
Basic fee where no reproduction of the mark is i n color (Protocol application):	653.00
Complementary fee (Protocol application):	100.00
Individual fee (international application): IN	62.00
	-----
Total due:	815.00
 To date, your payment is:	
- payment 16/0036176 on 24/06/2016	815.00
<PAYMENT-INFO>	

Education and Science Ministry of Ukraine  
**UKRAINIAN INDUSTRIAL PROPERTY INSTITUTE**  
 Ukraine 01601 Kyiv-42, vul. Glazunova 1  
 tel: (044) 494-05-05, fax: (044) 494-05-06 E-mail:office@ukrpatent.org

**Kyiv,** WORLD INTELLECTUAL PROPERTY ORGANIZATION  
**November 21, 2011** 34, chemin des Colombettes,  
 P.O.Box 18,  
**Our ref:** 927 CH-1211 GENEVA 20  
 Switzerland

**Sector of Trademarks, Industrial Designs and Geographical  
 Indications  
 International Registrations Administration Department  
 Examination and Registration Section  
 Madrid Team 1 (International Applications)**

**Jin-Ou YOO**

Your ref.: EN-I/602541501/JY  
 Office ref.: 59967/1559  
 Re: International application based on **application № m 2010 14056**

for the mark **D.GRASE**  
 in the name of **Zamchij Inna Oleksandrivna**

Date of receipt of the international application  
 by the Office of origin: 12 March 2011  
 by the International Bureau: 10 May 2011

Dear Madame,

We acknowledge receipt of your letter.

The applicant **Zamchij Inna Oleksandrivna** totally agrees on your suggestion to change the incomprehensible name of the good "ail polish" into "nail polish" (class 3), and she has also clarified that the good "lonone (perfumery)" was miswritten and meant to be "ionone (perfumery)" (class 3).

Thank you very much for your attention to the matter.

Yours faithfully,

HEAD  
 Department  
 of International Trademarks



Svitlana Sukhinova

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## CERTIFICATE OF REGISTRATION

The International Bureau of the World Intellectual Property Organization (WIPO) certifies that the indications appearing in the present certificate conform to the recording made in the International Register of Marks maintained under the Madrid Agreement and Protocol.

*Reproduction of the mark where  
the mark is represented in  
standard characters*

# Manzoni

*Registration number* **1 319 721**

*Registration date* **June 3, 2016**

*Date next payment due* **June 3, 2026**

*Name and address of holder* **TRADING & INDUSTRIAL ALEF CORPORATION  
Sobinova Str., 1, Dnepropetrovsk 49083 (Ukraine)**

*Legal nature of the holder (legal  
entity) and place of organization* **corporation, Ukraine**

*Name and address  
of the representative* **Tamara Egorova LLC Patent legal bureau "CKT", T.P. Egorova,  
P.O. Box 7347, Dnipropetrovsk 49098 (Ukraine)**

*List of goods and services  
NCL(10-2016)* **33 Anisette (liqueur); anise [liqueur]; cocktails; curacao; liqueurs.**

*Basic registration* **Ukraine, 10.01.2014, 180368**

*Designations under  
the Madrid Protocol* **European Community, United States of America**

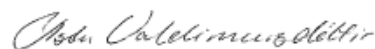
*Designations under  
the Madrid Protocol* **China**

*by virtue of Article 9sexies*

*Declaration of intention to use  
the mark* **United States of America**

*Date of notification* **24.11.2016**

*Language of  
the international application* **English**



**Ásta Valdimarsdóttir**  
Director, Operations Service  
Madrid Registry  
Brands and Designs Sector

Geneva, <date>

## Registrations

## NOTIFICATION

ENN/2016/46

*Reproduction of the mark where  
the mark is represented in  
standard characters*

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*Designations under  
the Madrid Protocol* **China**

*by virtue of Article 9sexies*

*Declaration of intention to use  
the mark* **United States of America**

*Date of notification* **24.11.2016**

*Language of  
the international application* **English**

# International registrations

# Duties of the International Bureau concerning the International Register

- Record, notify to Offices of the dCPs and publish in the gazette subsequent designations (Art. 3*ter*)
- Transmit a copy of the notification of refusal to the holder (Art. 5)
- Issue copies of entries in the International Register (Art. 5*ter*)
- Record, notify the holder and the Offices of the dCPs and publish in the gazette cancellations due to ceasing of effect (Art. 3*ter*)
- Process the renewal of international registrations (Art. 7)
- Record the change in the ownership (Art. 9) and other matters concerning an international registration (Art. 9*bis*)

# Recordings in the International Register

## Cancellation and changes

- Cancellation of the international registration
- Renunciation with respect to a designated Contracting Party
- Limitation of the scope of protection in one or more designated Contracting Parties
- Change in name, address or legal nature of the holder
- Change in ownership
- Merger
- Division & Merger

## Other recordings

- Licenses
- Restriction of the holder's right of disposal
- Appointment of a representative before the International Bureau
- Change in the name or address of the representative
- Final decision, further decisions, invalidations, declarations

# International Register





# The current International Register

M0601M01

Restart at

Office

List by Keyword

Basic registration

Basic application

IRN	Regtn Date	Office	Text
0129204	21/12/1946	CH	EICHHORN
0129205	21/12/1946	CH	PRIMULUS
0129243	23/12/1946	FR	STENOPAN
0129244	23/12/1946	FR	VIOSTEN
0129280	26/12/1946	CH	MULTITEC
0129342	31/12/1946	CH	David Borloz
0129346	31/12/1946	CH	BILVISIN
0129348	31/12/1946	CH	METHIOCIL
0129377	08/01/1947	CH	RAVIX
0129399	10/01/1947	BX	STANLEY
0129400	10/01/1947	BX	RUBLIN
0129440	13/01/1947	FR	FEMME
0129611	27/01/1947	FR	EPILOGUE
0129645	31/01/1947	ES	TENTACION
0129660	03/02/1947	IT	VICISIN MILANO

[MORE](#)

# The current International Register

M0601M01

Restart at

Office

List by Keyword

Basic registration

Basic application

IRN	Regtn Date	Office	Text
0129204	21/12/1946	CH	EICHHORN
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0129244	23/12/1946	FR	VIOSTEN
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0129611	27/01/1947	FR	EPILOGUE
0129645	31/01/1947	ES	TENTACION
0129660	03/02/1947	IT	VICISIN MILANO

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# International registrations

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**M0621M01**

Request : **60500001**

IRN : 0605000 as at ≤ 28/11/2016 ≥ **Actual**

Origin : CH Registration Date : 16/06/1993 Priority : 01/04/1993

Duration : 10 years

Mark Text : ROMARIN

**Holder 1 of 1**

Name : ORGANISATION MONDIALE

Representative :


Nice Classes : **09 35 38**

> Designations : [AG](#) [AL](#) [AM](#) [AT](#) [AU](#) [AZ](#) [BA](#) [BG](#) [BH](#) [BQ](#)  
[BT](#) [BW](#) [BX](#) [BY](#) [CN](#) \* [CO](#) [CU](#) [CW](#) [CY](#) [CZ](#)  
[DE](#) R [DK](#) [DZ](#) [EE](#) [EG](#) [ES](#) [FI](#) [FR](#) [GB](#) [GE](#)  
[GH](#) [GR](#) [HR](#) [HU](#) [IE](#) [IL](#) S [IR](#) [IS](#) [IT](#) [JP](#) R  
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[MA](#) [MC](#) [MD](#) [ME](#) [MG](#) [MK](#) [MN](#) [MX](#) [MZ](#) [NO](#)

Summary  
History  
Holder/Rep.  
Basic  
Priority  
Seniority  
Mark  
Good & Service  
Designation  
Vienna  
Prior IRNs  
Limit'n designation  
Limit'n G & S

Exit (PF4) Back (PF3) Next (ENTR)

# History of the registration

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M1420M11

IRN	Request	Inscribed	Country	Published		
	0605000					
	<a href="#">60500001</a>	03/08/1993	1993	8		
	<a href="#">71447260</a>	27/05/1994	1994	5		
	<a href="#">71463432</a>	15/07/1994	1994	7		
	<a href="#">71471977</a>	09/08/1994	1994	8		
	<a href="#">71474007</a>	19/08/1994	1994	8		
	<a href="#">71559928</a>	05/07/1995	1995	6		
	<a href="#">71559929</a>	05/07/1995	1995	6		
	<a href="#">87666401</a>	Z				
	<a href="#">97294801</a>	Z				
	<a href="#">108870901</a>	:				
	<a href="#">109984201</a>	08/10/1997	1997	20	P	
	<a href="#">110756001</a>	Z				
	<a href="#">111713501</a>	:				
	<a href="#">114167601</a>	21/01/1998	1998	1	P	
	<a href="#">133441101</a>	:				

Summary  
History  
Holder/Rep.  
Basic  
Priority  
Seniority  
Mark  
Good & Service  
Designation  
Vienna  
Prior IRNs  
Limit'n designation  
Limit'n G & S

IMAPS - [8103219]

MADRID PROTOCOL AND AGREEMENT  
FINAL DISPOSITION ON STATUS OF A MARK  
- STATEMENT OF GRANT OF PROTECTION  
Rule 18ter(1)

I.	Sending OFFICE : INTELLECTUAL PROPERTY OFFICE OF NEW ZEALAND PO Box 9241, Marion Square, Wellington 6141, New Zealand or DX SX 11129, Wellington International: +64 3 962 2607 National: 0508 4 IPONZ (0508 447 669)
II.	International registration number : 0605000
III.	Holder: ORGANISATION MONDIALE DE LA PROPRIÉTÉ INTELLECTUELLE
IV.	Mark Reproduction : ROMARIN
V.	Protection is granted to the mark that is the subject of this international registration for all the goods and/or services requested.
V bis.	The following elements are not protected :
VI.	Official sign or seal of sending office :
VII.	Date : 30/04/2014

Ready Page: 001 3 History: 8103219 Folder Conf

Exit (PF4) Previous Page (PF7) Next Page (PF8) Back (PF3) Next (ENTR)

# Extracts from the International Register



## EXTRACT FROM THE INTERNATIONAL REGISTER OF MARKS

The International Bureau of the World Intellectual Property Organization (WIPO) certifies that the details given below are a true copy of the entries made in the International Register of Marks on the date of signature of the present extract in accordance with the Madrid Agreement and Protocol.

**822 232**

Registration date: February 10, 2004  
Date next payment due: February 10, 2014

Balbon GmbH & Co. KG  
Friedrichstrasse 11  
D-30163 Hannover  
(Germany).



Classification of figurative elements:  
26.4, 27.5.

List of goods and services - NCL(8):  
30 Sandwich-biscuit, filled with cocoa, namely chocolate cream.

Basic registration: Germany, 14.10.1997, 395 49 746 9/00.

Designations under the Madrid Agreement: Austria, Bosnia and Herzegovina, Bulgaria, Croatia, Cyprus, France, Italy, Kazakhstan, Portugal, Romania, Slovenia, Spain, Ukraine.

Designations under the Madrid Protocol: Denmark, Greece, Norway, Republic of Korea, United Kingdom.

Declaration of intention to use the mark: United Kingdom.  
Date of notification: 29.04.2004

Language of the international application: English

### Total Protection

United Kingdom: Protection granted for all the goods and/or services (letters of May 19, 2004 and March 23, 2005).

WORLD INTELLECTUAL PROPERTY ORGANIZATION  
T +41 22 938 84 84  
F +41 22 740 34 20  
madrid@iccpi.org/wipo.int  
www.wipo.org

No. 822 232

### Statement of Grant of Protection

Republic of Korea: Statement pursuant to Rule 17(6)(a)(i) of the Common Regulations under the Madrid Agreement and Protocol, granting the protection to the mark (letter of March 25, 2005).

### Total Refusal

Bulgaria: Refusal for all the goods and/or services (letters of February 28, 2005 and October 27, 2005).

Croatia: Refusal for all the goods and/or services (letters of April 26, 2005 and October 24, 2007).

Cyprus: Refusal for all the goods and/or services (letters of November 8, 2004 (correction, notified on February 10, 2005), January 3, 2005 and August 29, 2005).

Norway: Refusal for all the goods and/or services (letters of June 29, 2005, August 5, 2005 and May 19, 2006).

Portugal: Refusal for all the goods and/or services (letters of December 28, 2004 and May 21, 2006).

Romania: Refusal for all the goods and/or services (letters of April 15, 2005 and May 21, 2006).

Ukraine: Refusal for all the goods and/or services (letters of March 10, 2005 and October 31, 2006).

### Final Decision

Kazakhstan: statement pursuant to Rule 18ter(3) of the Common Regulations under the Madrid Agreement and Protocol confirming refusal for all the goods and/or services (letters of April 6, 2005 and January 10, 2010).

Subsequent designation to the international registration: Islamic Republic of Iran.

Geneva, November 18, 2016

Fee: 165.- Swiss francs

No. 822 232

Final decision confirming the refusal of protection Bulgaria; 2005/45 Gaz

Final decision confirming the refusal of protection Romania; 2006/2 Gaz

Final decision confirming the refusal of protection Norway; 2006/25 Gaz

Final decision confirming the refusal of protection Ukraine; 2006/45 Gaz

Final decision confirming the refusal of protection Croatia; 2007/45 Gaz

Final decision confirming the refusal of protection Portugal; 2008/23 Gaz

Final decision confirming the refusal of protection Kazakhstan; 2010/13 Gaz

### Provisional Decision

Islamic Republic of Iran: total provisional refusal pursuant to Rule 17 of the Common Regulations under the Madrid Agreement and Protocol (letter of February 10, 2014).

Morocco: total provisional refusal pursuant to Rule 17 of the Common Regulations under the Madrid Agreement and Protocol (letter of March 13, 2014).

Geneva, November 18, 2016

Fee: 165.- Swiss francs

*Asta Valdimarsdottir*  
Asta Valdimarsdottir  
Director, Operations Division  
Madrid Registry  
Brands and Design Sector

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In accordance with Article 5ter of the Madrid Agreement and the Madrid Protocol, extracts from the International Register requested with a view to their production in one of the Contracting Parties of the Madrid System shall be exempt from any legalization.

*Asta Valdimarsdottir*  
Asta Valdimarsdottir  
Director, Operations Division  
Madrid Registry  
Brands and Design Sector

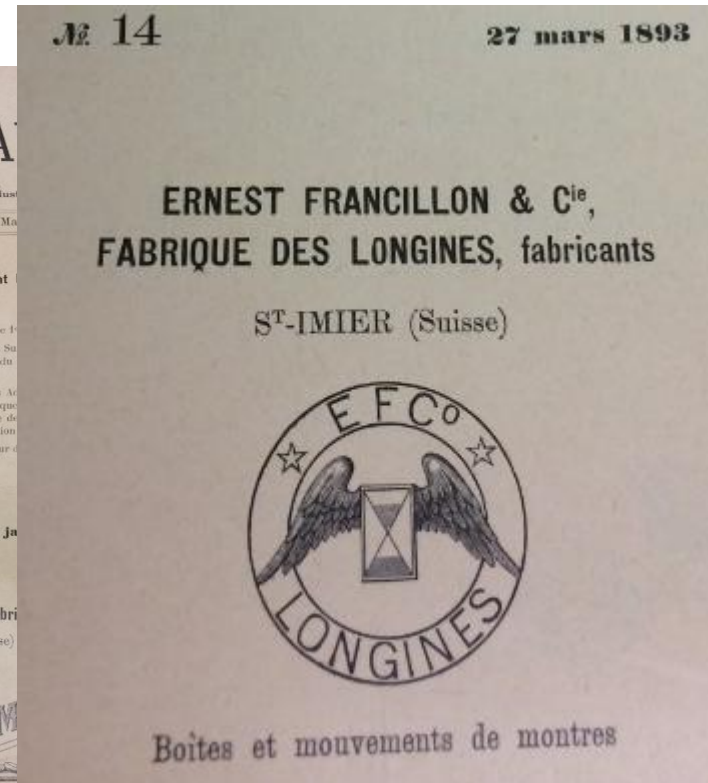
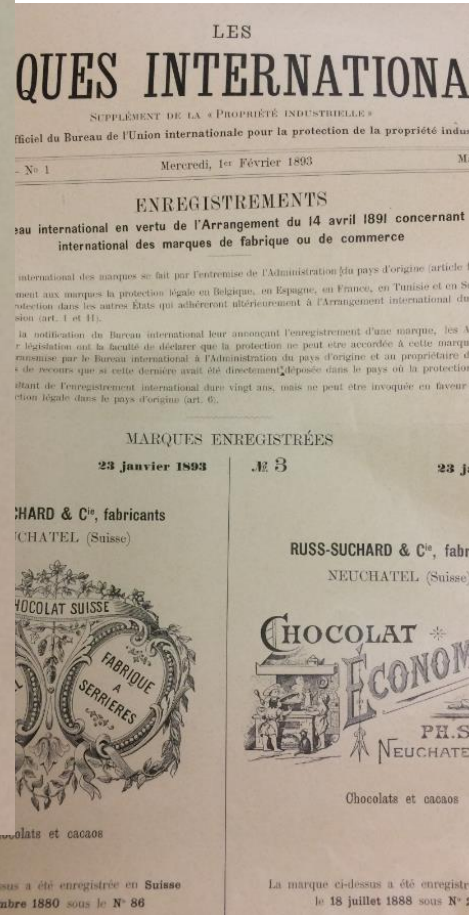
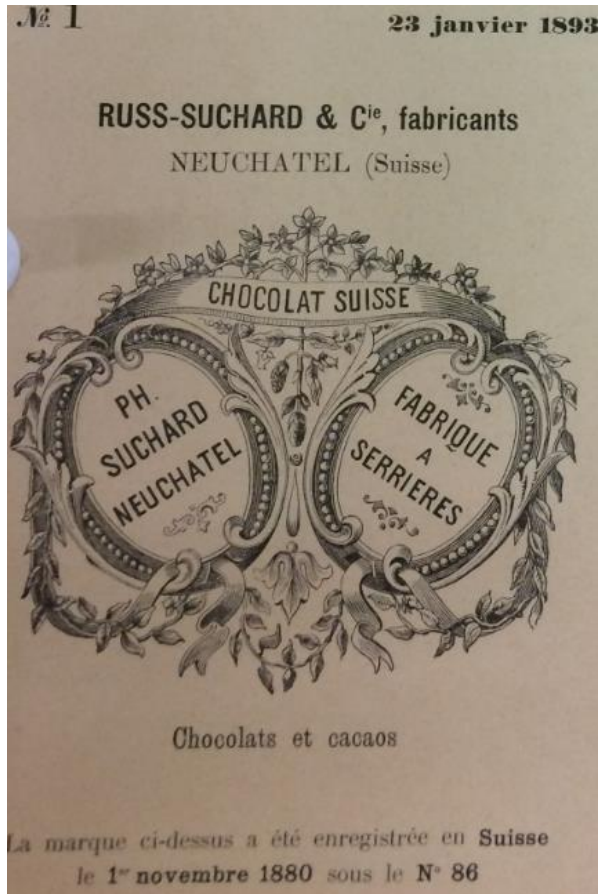
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The International  
Trademark System  
International Register | Certified Copy

Pursuant to Article 5ter of the Madrid Agreement and the Madrid Protocol, extracts from the International Register requested with a view to their production in one of the Contracting Parties of the Madrid System shall be exempt from any legalization.

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# The Gazette

# The original Gazette





# The current WIPO Gazette

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## WIPO Gazette of International Marks

The WIPO Gazette of International Marks is the official publication of the Madrid System. Every week the International Bureau publishes data regarding new international registrations, renewals, subsequent designations and modifications affecting existing international registrations.

Browse by chapter | Search by Registration Number or Mark or Holder | Frequently Asked Questions (FAQs)

Publication date: Year 2016 No. 46 - 24/11/2016



Summary: Registrations

State/IGO: All  Origin  Interested  Designated

Submit Reset

### Registrations

1 - 10 / 1072 Export hit list to Excel format 1 / 108

Mark	IRN	Holder	Origin	Transaction	Gazette
	1319715	Thomas A. Hill Limited	GB	Registration	2016 / 46
	1319716	Informa UK Limited	GB	Registration	2016 / 46
MSQRD	1319717	Masquerade Technologies, Inc.	US	Registration	2016 / 46

# Administrative duties

# Administrative duties of the International Bureau

- Collect fees on behalf of the dCPs and distribute them accordingly (Art. 8)
- Undertake related duties and administrative tasks concerning the Protocol (Art. 11)
- Make preparations for and be Secretariat of assemblies, conferences and other meetings, as well as undertake other tasks, as assigned (Art. 11)

# The Working Group on the Legal Development of the Madrid System

- Meeting of technical delegations from Contracting Parties and observers
- Discuss ways to improve the practice of Offices and the International Bureau
- Request that the International Bureau draft proposals and documents
- Discuss proposals to change the Common Regulations
- Make recommendations to the Assembly of the Madrid Union
- Documents and report available for review on WIPO Website

# The Madrid Union Assembly – Art. 10

- Meeting of delegations from Contracting Parties during the WIPO General Assemblies
- Deal with all matters concerning the maintenance and development of the Madrid Union
- Formally adopt or change the Common Regulations and the amounts of the fees under the Protocol
- Review and approve reports, activities, programs and budget of the Union (in the GA)
- Documents and report available for review on WIPO Website

# Technical assistance and cooperation

## ■ For prospective members :

Accession toolkit; review of legal framework; fact-finding and assessment missions; capacity building; stakeholder outreach

## ■ Form current members :

Legal and operational support; capacity building; outreach activities

Thank you  
for your attention

[juan.rodriguez@wipo.int](mailto:juan.rodriguez@wipo.int)

