



WIPO | MADRID

The International
Trademark System

Your International Application

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The International Application

- Basic requirements
- How to file
- Fees
- Irregularity statistics for Australian Madrid filings
- Some common goods and service irregularities to avoid

Basic requirements

- To be **entitled** to use the Madrid System, the applicant must:
 - Be a national of, or
 - Be domiciled in, or
 - Have a real and effective industrial or commercial establishment in a Contracting Party of the Madrid System
- The applicant needs to have registered or filed an application (**basic mark**) in the IP Office of the applicant's entitlement (Office of origin)
- The international application must be sent through the Office of origin

How the Madrid System works



Preparing your International Application

- Make sure that you have all of the information required
 - Although IP Australia uses Madrid e-filing, think about printing the MM2 form prior to applying
- If you are designating the United States, ensure that you have the MM18 form filled out and signed
- Look over the goods and services you have claimed

Goods and Services

- must reflect the scope of the basic mark. i.e. they can be narrower, but not broader than those in the basic mark
- Must be grouped in the appropriate classes of the NICE classification
 - If you are unsure, you can check the Madrid Goods and Services Manager on the WIPO website

Requirements for some designated Contracting Parties

- The European Union:
 - Indicate a second language before the Office of the European Union: French, German, Italian or Spanish.
- The mere fact of designating some Contracting Parties is taken as a declaration of intention to use
- United States of America: Form MM18 Declaration of intention to use the mark
- WIPO maintains a Madrid Member Profile database.
 - Contains information about specific national requirements and contact details for each national office

Fee Calculation

- The fees are payable in Swiss francs to WIPO
 - Basic fee: 653 or 903 Swiss francs (reproduction of the mark in black/white or color)
 - Fees for designations
 - Standard fees
 - 100 Swiss francs (each class of goods and services beyond three classes)
 - 100 Swiss francs per designated Contracting Party
 - Individual fees
 - Individual fees payable in 2 parts

Fee calculation

International Registration of Marks - Fee Calculation

For date:	07.09.2019	Office of origin:	Afghanistan
Number of classes:	1	Type:	New application
<input type="checkbox"/> Colour	<input type="checkbox"/> Collective mark, certification mark, or guarantee mark		

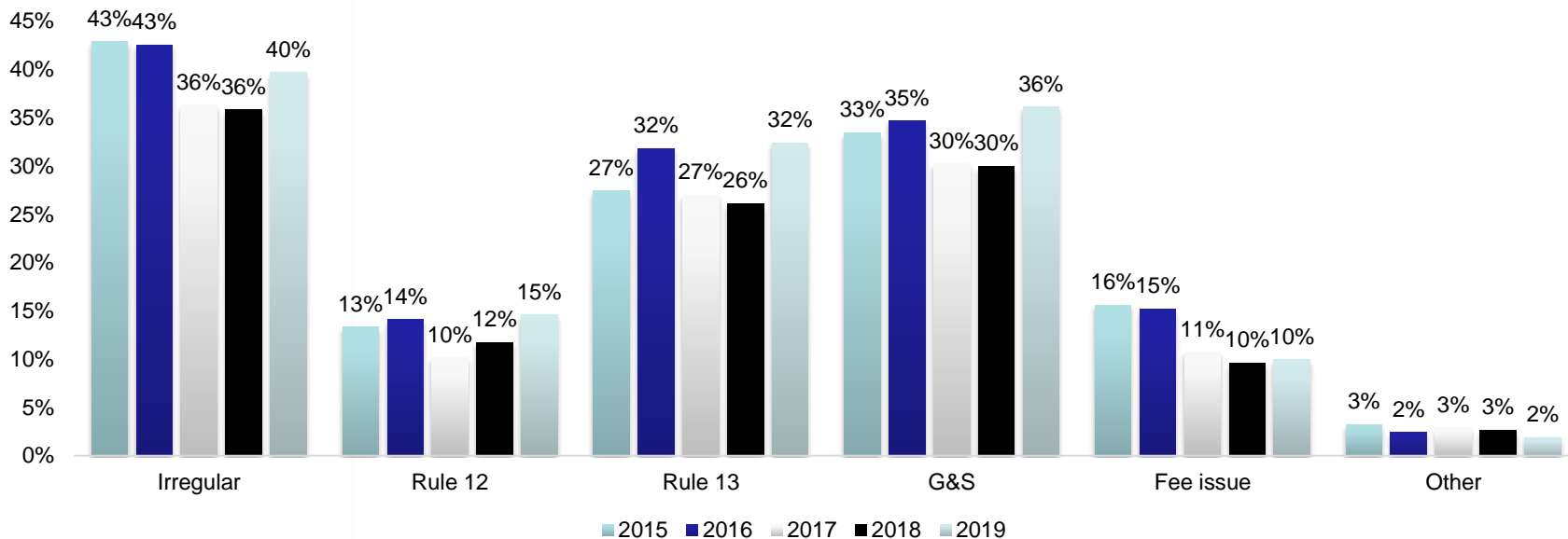
Continue

A designation of the Benelux (BX) covers Belgium, Luxembourg and the Netherlands
A designation of the European Union (EM) covers its [28 Member states](#)
A designation of the African Intellectual Property Organization (OA) covers its [17 Member states](#)
Bonaire, Saint Eustatius and Saba (BQ), Curaçao (CW) and Sint Maarten (Dutch part) (SX) are autonomous territories of the Kingdom of the Netherlands that can be individually designated

Disclaimer - Fee Calculator results are based on information you have provided and the [Schedule of Fees](#) in effect at the time the estimate is generated. The estimate is provided for information purposes only. For the most accurate estimate, consult the Fee Calculator immediately before you submit a request or your payment order.

Irregularity statistics

Irregularity Rate 2015-2019 - Australia (AU)



Classification – role of the IB

- The IB shall register the international applications “with the classifications and grouping that the IB considers to be correct” based on the NICE CLASSIFICATION edition and version in force at the time of filing the application

The IB principles – Classification of G&S

- Alphabetical list of the NICE classification
- Explanatory notes to the NICE classification
- The “General remarks” for G&S in the NICE classification
- The class number defines the scope of the product/service (with exceptions)
- Internal guidelines – available on the WIPO website

Receiving an Irregularity

- Generally have 3 months to respond
- Most items must be forward through the office of origin
 - Through Madrid eFiling with IP Australia
- If the irregularity is under Rule 13, the application may be registered with comments
- If the irregularity is under Rule 12, the application may be registered if there are no outstanding fees
- If the application is not complete or fees are underpaid, it will be taken that the application is abandoned.

Common G/S Irregularities

The following are some of the more common irregularities that are raised in relation to classification from Australian applicants.

Rule 13

- These irregularities cover terms that are considered too vague / unclear for classification in the class applied in or are linguistically incorrect

Linguistically Incorrect:

Applicant claims:

Class 3: Non-medicated creams for paling the skin

WIPO suggestion:

Class 3: Non-medicated creams for lightening the skin

Too vague

Applicant claims:

Class 29: Food Protein for human consumption / protein for human consumption

WIPO suggestion:

- Please specify these goods. They are too vague as they could be:
 - Proteins for the food industry (Class 1)
 - Protein supplements for human consumption (Class 5)
 - Protein Milk (Class 29)
 - High protein cereal bars (Class 30)
 - Protein-enriched sports beverages (Class 32)

Applicant claims:

Class 35: Business relocation Services

WIPO suggestion:

- administrative services for the relocation of businesses

Applicant claims:

Class 35: Data handling

WIPO suggestion:

- Data processing / data management services

Applicant claims:

Class 35: Design for advertising

WIPO suggestion:

- Development of advertising concepts

Rule 12

- These irregularities cover terms that have been applied for in the incorrect class.

Incorrect class

Applicant claims:

Class 29: Milk / Soya / Whey protein

WIPO response:

As listed they would be transferred under Rule 12 to class 1 based on the below NICE positions:

- Protein [raw material] - 010452
- Proteins for the food industry - 010699
- Proteins for use in the manufacture of food supplements - 010698

- To maintain in class 29, Protein Milk would be an acceptable term

Partial Rule 12 and Rule 13

Applicant claims:

Class 42: consultancy in relation to occupational health and safety (ergonomics and design)

WIPO response:

consultancy in relation to occupational health and safety (ergonomics)

- transferred under Rule 12 to class 45 based on analogy with the below NICE position:
 - Safety consultancy and services are classified in class 45 - 450202

consultancy in relation to occupational health and safety (design)

WIPO suggestion (Rule 13):

- design consultancy in relation to occupational health and safety equipment



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Questions?


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