

The International Application Step by Step

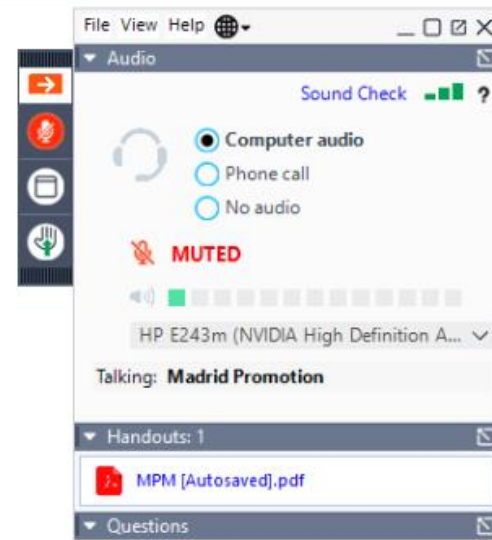
Webinar of the Madrid System

Xiaodan Dai
Examiner MOT3

Eric Fontaine
Examiner MOT2

Geneva
September 29, 2020

How to use GoToWebinar



Structure of the Webinar

- Presentation: The International Application
- Interactive questions during the webinar
- Questions and answers session at the end
- Presentation slides available for download
- Recording will be uploaded on the [Madrid Webinar page](#)
- Short survey to provide feedback

The International Application

- Overview
- Basic requirements
- How to file
- Fees
- Track your application
- Available WIPO tools and e-services



The Madrid System

- ***Centralized*** filing & management
- ***One*** (application, language, set of fees)
- Seeking protection in ***multiple*** markets

Question

- How many countries does the Madrid System cover to date?
- a. 120
 - b. 122
 - c. 121



Basic Requirements

■ **Entitlement** to use Madrid System :

- National of ...
- Domiciled in ...
- Real and effective industrial / commercial establishment in ...

■ Registration / filed application (**basic mark**) in IP Office of entitlement (**Office of Origin**)

How to file?

- Form MM2 or E-filing
- ***Must*** be sent to the Office of origin

For more information see the [webinar: How to Make the Most of the Madrid Member Profiles Database](#)



MADRID APPLICATION ASSISTANT

COMPLETING YOUR INTERNATIONAL APPLICATION ONLINE

[Get started](#)

<https://www.wipo.int/madrid/application-assistant/>

How the Madrid System works

The International Trademark Registration Process



Contents of the International Application Form MM2

<https://www.wipo.int/madrid/en/forms/>

Applicant's details

- Applicant's **name/address**
- Address for correspondence
- Telephone &
E-mail address

APPLICANT

(a) Name: **World Intellectual Property Organization**

(b) Address: **34, Chemin de Colombettes**

1211 Genève

Suisse

(c) Address for correspondence: WIPO Brazil Office |
Avenida Atlântica No 1130 5th Floor - Part B
Copacabana, Rio de Janeiro, Brazil Zip code: 22021-000

(d) Telephone : +41 22 338 86 86 Fax:

E-mail address: **wipo@wipo.int**

Preferred language for correspondence

Preferred language for correspondence: ☒ English ☐ French ☐ Spanish

Indications of legal nature

■ Natural person:

if the applicant is a **natural person**, nationality of the applicant:

■ Legal entity:

if the applicant is a **legal entity** (please, provide **both** the following indications):

- legal nature of the legal entity:
- State (country) and, where applicable, territorial unit within that State (canton, province, state, etc.), under the law of which the said legal entity has been organized:
.....

Entitlement to file

ENTITLEMENT TO FILE

(a) Check the appropriate box:

- (i) ☐ where the Contracting Party mentioned in item 1 is a State, the applicant is a national of that State; or
- (ii) ☐ where the Contracting Party mentioned in item 1 is an organization, the name of the State of which the applicant is a national:; or
- (iii) ☐ the applicant is domiciled in the territory of the Contracting Party mentioned in item 1; or
- (iv) ☐ the applicant has a real and effective industrial or commercial establishment in the territory of the Contracting Party mentioned in item 1.

(b) Where the address of the applicant, given in item 2(b), is not in the territory of the Contracting Party mentioned in item 1, indicate in the space provided below:

- (i) if the box in paragraph (a)(iii) of the present item has been checked, the domicile of the applicant in the territory of that Contracting Party, or,
- (ii) if the box in paragraph (a)(iv) of the present item has been checked, the address of the applicant's industrial or commercial establishment in the territory of that Contracting Party.

.....

Appointment of a representative

- Details: ***name***, ***address***, phone, ***email address***
- Only one representative
- Communications exclusively to the representative

Basic mark and priority

- Basic application / registration ***number & date***
- Priority claim, if any

Question

- What is the applicable period to claim priority?
 - a. 3 months
 - b. 6 months
 - c. 12 months

The reproduction of the mark



The mark - standard characters

- The applicant declares that he wishes the mark to be considered as a mark in standard characters

ROMARIN

The mark – color(s) as such

- The mark consists exclusively of a color or a combination of colors as such, without any figurative element



The mark - color(s) claimed



COLOR(S) CLAIMED

- (a) ☒ The applicant claims color as a distinctive feature of the mark.

Color or combination of colors claimed: Blue, red and purple

- (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):

Question

■ Is this mark?



- a. A mark in color
- b. A color mark *per se*

Transliteration of the mark

麗子

Transliteration of the mark (this information is compulsory where the mark consists of or contains matter in characters other than Latin characters, or numerals other than Arabic or Roman numerals):

REIKO

Miscellaneous indications

- Translation of the mark
- The words contained in the mark have ***no*** meaning
- Description of the mark

Types of marks

- Three-dimensional mark
- Sound mark
- Collective mark, certification mark, or guarantee mark

Verbal elements of the mark



Verbal elements of the mark (where applicable):

bee happy

Disclaimer



The applicant wishes to disclaim protection for the following element(s) of the mark:

Pharmaceuticals

Goods and services

■ Class number & G/S

■ Within the scope ...

■ Limitation possible

■ MGS

(a) Indicate below the goods and services for which the international registration is sought:

Class

Goods and services

3 **Non-medicated cosmetics and toiletry preparations; non-medicated dentifrices; perfumery; essential oils.**

18 **luggage and carrying bags; umbrellas and parasols.**

25 **Clothing; footwear; headwear.**

(b) ☒ The applicant wishes to **limit** the list of goods and services in respect of one or more designated Contracting Parties, as follows:

Contracting Party

Class(es) or list of goods and services for which protection is sought in this Contracting Party

...JP... **Class 3 & 18**

...US... **Class 3** **Non-medicated dentifrices; perfumery; essential oils.**

Class 18 **Carrying bags; umbrellas and parasols.**

Class 25 **Clothing, namely, T-shirts, shirts, coats, vests; shoes and boots;**

Hats and caps.

Designations

AF Afghanistan	EE Estonia	LA Lao People's Democratic Republic	RS Serbia
AG Antigua and Barbuda	EG Egypt	LI Liechtenstein	RU Russian Federation
AL Albania	EM European Union ¹	LR Liberia	RW Rwanda
AM Armenia	ES Spain	LS Lesotho ²	SD Sudan
AT Austria	FI Finland	LT Lithuania	SE Sweden
AU Australia	FR France	LV Latvia	SG Singapore ²
AZ Azerbaijan	GB United Kingdom ²	MA Morocco	SI Slovenia
BA Bosnia and Herzegovina	GE Georgia	MC Monaco	SK Slovakia
BG Bulgaria	GH Ghana	MD Republic of Moldova	SL Sierra Leone
BH Bahrain	GM Gambia	ME Montenegro	SM San Marino
BN Brunei Darussalam ²	GR Greece	MG Madagascar	ST Sao Tome and Principe
BQ Bonaire, Saint Eustatius and Saba ^{6,7}	HR Croatia	MK North Macedonia	SX Sint Maarten (Dutch part) ⁶
BR Brazil ^{5,8}	HU Hungary	MN Mongolia	SY Syrian Arab Republic
BT Bhutan	ID Indonesia	MW Malawi ²	SZ Eswatini
BW Botswana	IE Ireland ²	MX Mexico	TH Thailand
BX Benelux ⁹	IL Israel	MY Malaysia ²	TJ Tajikistan
BY Belarus	IN India ²	MZ Mozambique ²	TM Turkmenistan
CA Canada	IR Iran (Islamic Republic of)	NA Namibia	TN Tunisia
CH Switzerland	IS Iceland	NO Norway	TR Turkey
CN China	IT Italy	NZ New Zealand ²	UA Ukraine
CO Colombia	JP Japan ⁵	OA African Intellectual Property Organization (OAPI) ³	US United States of America ⁴
CU Cuba ⁵	KE Kenya	OM Oman	UZ Uzbekistan
CW Curacao ⁶	KG Kyrgyzstan	PH Philippines	VN Viet Nam
CY Cyprus	KH Cambodia	PL Poland	WS Samoa
CZ Czech Republic	KP Democratic People's Republic of Korea	PT Portugal	ZM Zambia
DE Germany	KR Republic of Korea	RO Romania	ZW Zimbabwe
DK Denmark	KZ Kazakhstan		
DZ Algeria			

Question:

- Can we designate the Office of origin in the International Application?
 - a. Yes
 - b. No

Special requirements

- ***Compulsory second language*** for the European Union
- Possible MM17 for the European Union
- ***Compulsory MM18*** for US

Certification by the Office of origin

- Certifies the ***receipt date***
- Certifies the content of the International Application:
 - Applicant's Name/address
 - Mark
 - Goods/Services

Fees calculation

- Payable in ***Swiss francs*** to WIPO
- Fees composition:
 - ❖ Basic fee: 653 (black/white) or 903 (color)
 - Complementary fee: 100 per designation
 - Supplementary fee: 100 for each class beyond 3
 - Individual fees: required by some designations
 - Individual fees paid in two parts (BR + CU + JP)

Fee Calculator

 <http://www.wipo.int/madrid/feescalculator/>

FEE CALCULATOR

Information The Fee Calculator helps you estimate the cost of registering your mark through the Madrid System, a simple, easy and cost-effective International registration procedure. It also helps you estimate other costs related to managing your international trademark such as the renewal, the subsequent designation, the second fee tax for certain Contracting Parties and all the Madrid transactions with fees.

MARK INFORMATION

Please select which transaction you wish to estimate the cost of:

Type of transaction *

New application

Date *

2020/08/02

Your office of origin *

Number of classes covered by the mark *

☐ Is your mark a [collective mark](#), [certification mark](#) or [guarantee mark](#)?

☐ Is your mark in colour or colours?

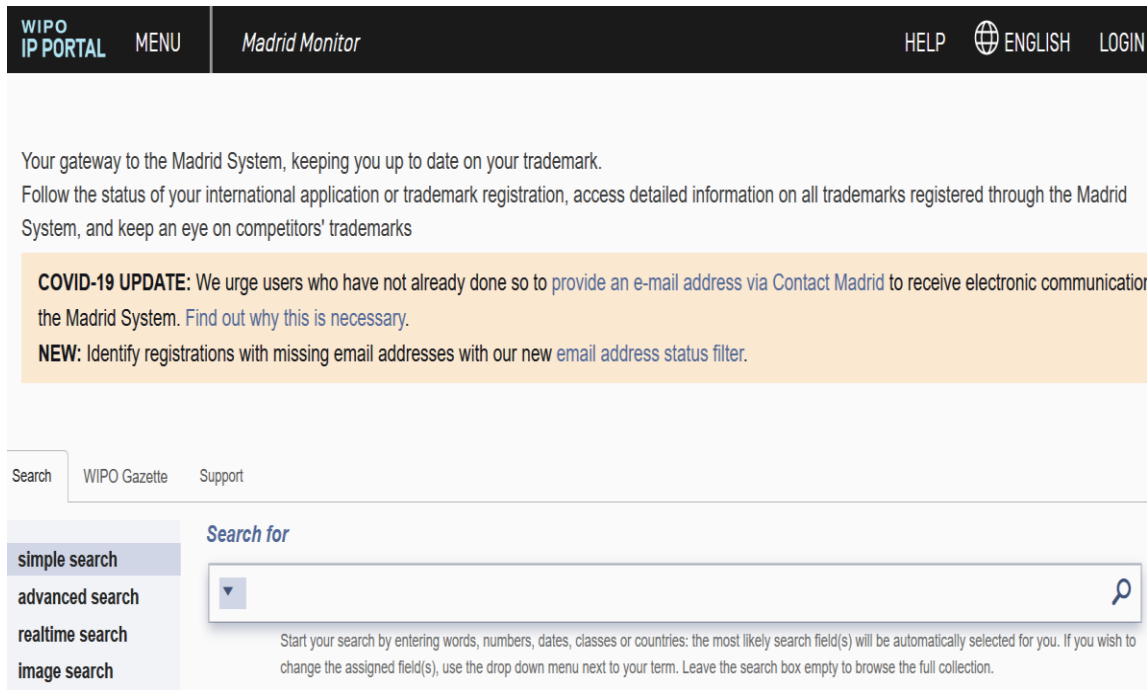
Payment methods

- Current Account opened with WIPO, *or*
- Credit card payments, *or*
- Bank or Postal transfer


Track your application

■ Madrid Monitor

■ Realtime search



The screenshot shows the WIPO IP Portal Madrid Monitor interface. The top navigation bar includes the WIPO IP PORTAL logo, a MENU button, the Madrid Monitor title, and links for HELP, ENGLISH, and LOGIN. The main content area features a welcome message, a COVID-19 update, and a new feature announcement. Below this is a search section with a sidebar for simple search, advanced search, realtime search, and image search. The main search area has a search box with a dropdown menu and a search button.

WIPO IP PORTAL MENU Madrid Monitor HELP  ENGLISH LOGIN

Your gateway to the Madrid System, keeping you up to date on your trademark.
Follow the status of your international application or trademark registration, access detailed information on all trademarks registered through the Madrid System, and keep an eye on competitors' trademarks


COVID-19 UPDATE: We urge users who have not already done so to [provide an e-mail address via Contact Madrid](#) to receive electronic communication the Madrid System. [Find out why this is necessary.](#)

NEW: Identify registrations with missing email addresses with our new [email address status filter](#).

Search WIPO Gazette Support

Search for

simple search
advanced search
realtime search
image search

▼ 

Start your search by entering words, numbers, dates, classes or countries: the most likely search field(s) will be automatically selected for you. If you wish to change the assigned field(s), use the drop down menu next to your term. Leave the search box empty to browse the full collection.



Q&A Session about the Webinar

Xiaodan Dai
Examiner MOT3

Eric Fontaine
Examiner MOT2

Available WIPO tools and e-services

- Madrid Application Assistant
- Madrid Goods & Services Manager
- Member Profiles Database
- Fee Calculator
- Madrid Monitor
- Contact Madrid

Keep Updated on the Madrid System

- Visit the [Madrid Website](#)
- Access [Madrid Webinars](#) records and stay tuned for new topics
- Play our [Madrid “How-to” videos](#)
- Subscribe to [Madrid Notices](#)
- Contact us: [Contact Madrid](#)

