



WIPO | MADRID
The International
Trademark System

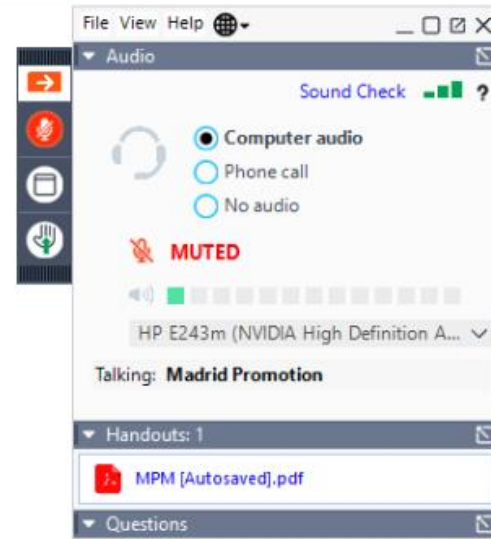
Understanding examination and refusal procedures in the USPTO Madrid System Webinar

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24 November, 2020

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Trademark Examination Policy

How to use GoToWebinar



Structure of the webinar

- Presentation: interactive questions during the webinar
- Question and answer session at the end
- Presentation slides available for download
- Recording will be uploaded on the [Madrid Webinar page](#)
- Short survey to provide feedback

Topics covered

- Examination procedure for requests for extension of protection (REP) to the United States
- Substantive review
- USPTO and WIPO resources

Examination procedure: **background**

- United States joined Madrid Protocol on November 2, 2003
- Provisional refusal period is **18 months** from date of notification of extension from the IB
 - Not the date the IB forwards the provisional refusal to holder
- **Possible** notification of provisional refusal **after 18 months** based on opposition
- **Declaration of intention to use** the mark in the United States must be filed with the IB on WIPO official form **MM18** at the time the REP is filed

Examination procedure: receipt of REP from IB

- Examined under U.S. Trademark Act **Section 66(a)** (15 U.S.C. § 1141f)
- Assigned USPTO application serial number in the **79-series code**; referred to as “Madrid applications,” “66(a) applications,” or “79-series applications”
- All USPTO examining attorneys examine REPs
- Examined the same as national applications
- Subject to the same refusals as national applications:
 - Same substantive **absolute** and **relative** grounds/refusals apply; and
 - Same procedural requirements apply, with some exceptions

Examination procedure: registration process

- **Examination** by examining attorney; mark must be distinctive—inherently distinctive or acquired distinctiveness (secondary meaning)
 - **Approved** for publication
 - **No** proof of use of the mark in U.S. commerce (specimens of use) required before registration
 - **Refused** registration, based on relative, absolute or procedural grounds
 - Comply with requirements or provide arguments to overcome refusal
- **Published** for **opposition**; opposition proceedings are at the USPTO Trademark Trial and Appeal Board (TTAB); 30-day opposition period (extend to 180 days upon request)
 - If opposition NOT successful → registration issued; or
 - If opposition is successful → registration refused; may **appeal** to U.S. court
- **Registration** issued—valid for 10 years

Examination procedure: after registration

- **Maintain** the U.S. registration directly with the USPTO at set periods:
 - File maintenance documents between 5th-6th year and 9th-10th year (Section 71 affidavit)
 - Must submit proof of use of the mark in U.S. commerce (specimens of use)
- **Renew** the U.S. registration with the IB every 10 years

Failure to maintain/renew = registration **expires** and **invalidation** notice to the IB

- **Cancellation** of registration:
 - File petition to **cancel** registration with TTAB
 - Petitioner and registrant have the right to **appeal** TTAB decision to U.S. District Court de novo or U.S. Court of Appeals for the Federal Circuit (CAFC) on the administrative record

Examination procedure: after registration

File maintenance documents (Section 71 affidavit):

- File **online** using Trademark Electronic Application System (TEAS)
- Must be filed by **owner/holder** of the registration (*Trademark Manual of Examining Procedure* (TMEP) § 1604.07(a))
- Attests to **use of mark in commerce in the U.S.** for all the registered goods/services, or asserts excusable non-use (TMEP § 1604.10)
- Goods/Services **not in use** must be **deleted** from the registration (TMEP § 1604.09(b))
 - **Random audits** of registrations to verify proof of use of goods/services

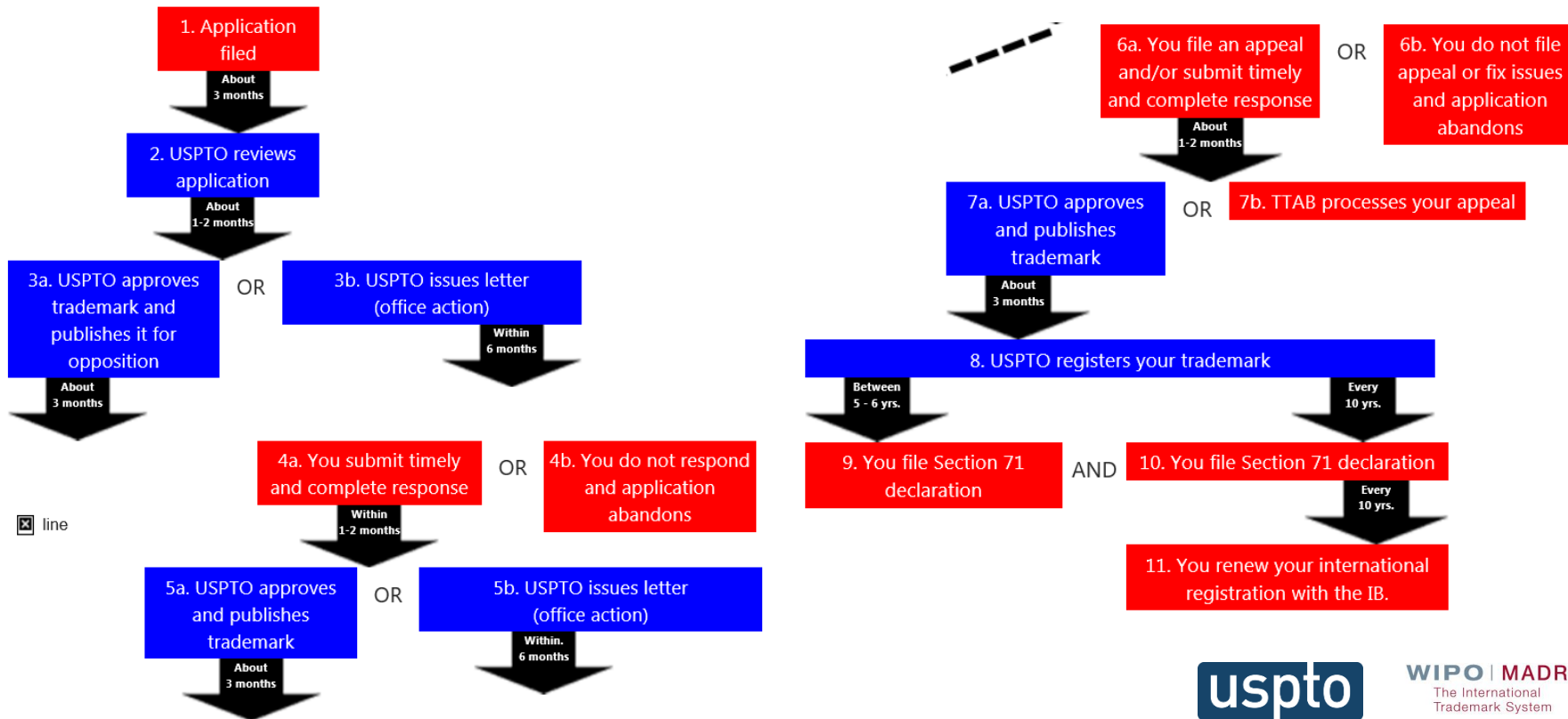
Examination procedure: after registration

File maintenance documents (Section 71 affidavit) - continued:

- **Specimen of use:** Submit proof of use of the mark in U.S. commerce for the registered goods/services (37 C.F.R. § 2.56; TMEP § 904)
 - One specimen of use for each renewed class of goods/services
 - Fee for each class of goods/services
 - Specimen may be refused for not showing use of the mark as a mark in commerce, e.g.:
 - model number; solely a trade name; ornamental matter

Examination procedure: timeline

www.uspto.gov/trademark/trademark-timelines/section-66a-timeline-application-based-madrid-protocol



Substantive review: **types of marks** eligible for registration

- Standard character: word marks
- Special form marks
 - Two-dimensional design marks (may also include wording)
 - Non-traditional marks, for example:
 - Three-dimensional trade dress marks (product design or product packaging)
 - Sound marks
 - Marks comprised of color only
 - Scent marks
 - Certification marks
 - Collective trademarks/service marks
 - Collective membership marks

Substantive review: substantive grounds for refusal

Relative grounds (likelihood of confusion)

- Relative grounds = confusingly similar marks, identical or similar
- Search USPTO trademark database for confusingly similar marks
 - **Registered** marks or marks in prior filed **applications**
 - Can be in any international class if the goods/services in the prior mark are **identical or closely related** to the goods/services in the later REP
- The USPTO does not conduct “common law” search of trademarks in use in the U.S.
 - Common law trademark claims against registrations or applications may be brought before the TTAB in an **opposition** or **cancellation** proceeding, or in a civil action before a U.S. federal court

Substantive review: substantive grounds for refusal

Absolute grounds

- Descriptiveness (i.e., lack of distinctiveness), mis-descriptiveness
- Geographically descriptive or mis-descriptive
- Deceptive
- False suggestion of a connection with a person or institution
- Flags, coat of arms, or other insignia of U.S., state, or municipality, or foreign nations
- Name, portrait, or signature of a particular living individual without his/her consent

Substantive review: **provisional refusal**

- USPTO **provisional refusal** is issued in the first “**Office action**” (letter) and sent to the **IB**
- Provisional refusal may be **partial** as to some goods/services
- Applicant has **six months** to respond to the **USPTO directly**
 - Deadline begins when the USPTO **sends** provisional refusal to the **IB**
 - **U.S. counsel required** for applicants, registrants, or parties to trademark proceedings **not domiciled in the U.S.**
- All **subsequent** USPTO communications are **sent** directly to the **applicant’s** correspondence address of record at the USPTO
 - If attorney → to attorney’s email address
 - If no attorney → to applicant’s email address

Substantive review: **provisional refusal**

www.uspto.gov/dashboard/trademarks/

Percentage of applications approved upon first action

- Madrid designations to the U.S. (Section 66(a)) – 2.5%
 - In many cases, provisional refusals are issued because **identification** of goods/services are too broad

Substantive review: response to provisional refusal

- Response must be filed **electronically** and **directly** with the **USPTO** using the USPTO's electronic forms
 - Mandatory electronic filing rule went into effect February 2020
- Must **address each** refusal/requirement in the provisional refusal
- Should state in writing the required **amendments** or **changes** to be made
- **Amend identification** of goods/services **directly** with the **USPTO**
 - Filing a limitation with the IB is not required
- **Partial provisional refusal as to some goods/services:** If NO response is received → USPTO will **delete** the refused goods/services and **approve** for publication the acceptable goods/services

Substantive review: common grounds for refusal

- U.S. counsel:
 - **Foreign domiciled** applicant, registrant, or party to a trademark proceeding must be represented by a U.S.-licensed attorney (37 C.F.R. §2.11(a))
 - Currently, cannot appoint U.S. counsel in the REP—the WIPO official form does not allow it
- Likelihood of confusion (relative grounds)—stated above
- Descriptiveness/non-distinctiveness
- Indefinite identification of goods/services
- Legal nature and place of organization (entity/citizenship)
- Description of the mark
- Significance of the mark
- Translation/transliteration of the mark

Substantive review: avoiding provisional refusal

- The USPTO requires the following; when possible, include in the REP:
 - Legal nature (entity type) and place of organization
 - Color(s) claimed and description of the location of the color(s)
 - Translation, transliteration
 - Description of the mark, if mark is not in standard characters
 - Disclaimer

- Using the USPTO application serial number, file a **voluntary amendment** (via U.S. counsel) directly with the USPTO to add or correct information
 - The USPTO sends filing receipts for REPs with USPTO application serial number, upon notification from IB
 - Alternatively, the USPTO's online TSDR database can be searched by international registration number to find the USPTO application serial number

Substantive review: legal nature (entity type) and place of organization

- Applicant may identify its legal nature (entity type) and place of organization in the international application, even though the IB does not require it
- U.S. rules require this information of all applicants
- If not provided, the USPTO will require it
- TMEP Appendix D – Foreign Entity Appendix

TMEP § 803.03 – 803.04

Substantive review: **description of the mark**

- Required for special form marks, i.e., non-standard character marks
- State **clearly** and **accurately** what the mark comprises
- Describe all **significant aspects** of the mark, including both literal elements and design elements
- If the mark contains both **wording and design** features, the description should **describe both** aspects of the mark
- Proper format:
 - *“The mark consists of”*
- Use the **voluntary description field** in the international application, if the basic application/registration does not contain a description

TMEP §808

Substantive review: **color(s) claim and description**

- The drawing of the mark in the REP must be a **substantially exact representation** of the mark as it appears in the international registration
- If the mark in the international registration is in color, the mark in the REP must be in color
- If the mark is in color, a **color claim** and a separate **statement** describing where the color(s) appear(s) is required
- Must claim the **same color(s)** as claimed in the international registration

TMEP § 807.07

Substantive review: Translation, transliteration

- Translation and transliteration of non-English wording and non-Latin characters in the mark is required
- Proper format:
 - *“The English translation of the word “_____” in the mark is “_____”.*”
 - *“The non-Latin characters in the mark transliterate to “_____” and this means “_____” in English.”*
- **Check box:** *The words contained in the mark have no meaning (and therefore cannot be translated)*

TMEP § 809

Substantive review: disclaimer

- Disclaimer of descriptive and generic (non-distinctive) elements is required
- Disclaimer is a statement that the applicant or registrant **does not claim the exclusive right** to use a specified element or elements of the mark
- Proper format:
 - *“No claim is made to the exclusive right to use _____ apart from the mark as shown.”*

TMEP § 1213

Substantive review: reproduction of the mark

- **Drawing:** Mark itself cannot be amended **but** the reproduction or “drawing” of the mark may be amended
 - Drawing must comply with U.S. rules and regulations
- **Three-dimensional marks:** Single rendition is required
 - May petition to waive U.S. requirement and show mark in multiple renditions
- **Color marks:** Color(s) must be **claimed** and **description** provided of the location of the color(s) (as stated above)
- **Sound marks:** Reproduction of the **sound itself** and **description** of the sound are required
 - Some countries use picture or musical staff notations to depict sound

Substantive review: classification of goods/services

- IB controls classification
- IB-assigned classification **cannot** be changed by the USPTO
 - Classes cannot be added by the USPTO
 - Goods/Services cannot be moved between classes, in a multiple class application
 - Goods/Services may only be **amended** to goods/services **within the IB-assigned class**
- **NOTE: Relative exam (likelihood of confusion)**
 - When searching for conflicting marks, the USPTO searches and compares goods/services **across classes**, e.g.:
 - barbecue sauce (Cl 30) vs. restaurant services (Cl 43)

Substantive review: **identification of goods/services**

- The USPTO requires **specific, definite, clear, accurate, and concise** identifications
 - Must conform to the same standards of specificity as required in national applications
- Use the USPTO **ID Manual** in selecting identifications (<https://idm-tmng.uspto.gov/id-master-list-public.html>)
- Many REPs contain **broad** wording, including international class headings. Common reason for refusal—requirement for more specific identification
- The USPTO does **not** accept **class headings**. Only amend to goods/services that fall within the “**ordinary meaning**” of the words in the **class heading**.
- The USPTO does **not** accept **parentheses ()**; must incorporate or remove wording

Expedite prosecution

- Submit the required information in the REP, if possible
- Responses to provisional refusals:
 - Filed by U.S. counsel for applicants not domiciled in the U.S.
 - Filed **electronically**
 - Timely and thorough
 - Properly signed
 - Log in to **MYUSPTO.GOV** account (<https://www.uspto.gov/about-us/news-updates/teas-login-requirement>) to access the online Trademark Electronic Application System (**TEAS**) forms to file response (<https://www.uspto.gov/trademarks-application-process/filing-online/index-all-teas-forms>)
 - For information on how to set up a MYUSPTO.GOV account, see <https://www.youtube.com/watch?v=TwGA9NF1bGY>
 - Use **email** and **telephone** communication to **work with the examining attorney** to resolve issues, if possible



TMEP

 Trademark Manual of Examining Procedure
 October 2018

 Search
 Search History

Browsing the Oct2018 Version

- **Foreword - TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP)**
- Introduction - Constitutional Basis
- Change Summary - CHANGES: INDEX TO CHANGES IN TMEP October 2018
- Instructions Page - TRADEMARK MANUAL OF EXAMINING PROCEDURE
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- ▶ 0200 - Application Filing Date
- ▶ 0300 - Filing and Receipt of Documents
- ▶ 0400 - Processing Documents and Fees
- ▶ 0500 - Change of Ownership
- ▶ 0600 - Attorney, Representative, and Signature
- ▶ 0700 - Procedure for Examining Applications
- ▶ 0800 - Application Requirements
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- ▶ 1000 - Applications Under Section 44
- ▶ 1100 - Intent-to-Use Applications and Requests to Divide
- ▶ 1200 - Substantive Examination of Applications
- ▶ 1300 - Service Marks, Collective Marks, and Certification Marks
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- ▶ 1500 - Post-Examination Procedures
- ▶ 1600 - Registration and Post Registration Procedures
- ▶ 1700 - Petitions, Requests for Reinstatement, and Other Matters Submitted
- ▶ 1800 - Public Inquiries About Applications and Registrations
- ▶ 1900 - Madrid Protocol

TRADEMARK MANUAL OF EXAMINING PROCEDURE

UNITED STATES PATENT AND TRADEMARK OFFICE

October 2018

Foreword

 The *Trademark Manual of Examining Procedure* (TMEP) is available on the USPTO website at <http://www.uspto.gov/tmep>

The Manual is published to provide trademark applicants with a reference work that contains guidelines and procedures which Examining Attorneys are required to follow.

Trademark Examining Attorneys will be guided by Notices issued by the Under Secretary of Commerce, or Deputy Commissioner of Patents and Trademarks, or any other statement of Office policy.

Suggestions for improving the form and content of the Manual should be addressed to:

Commissioner for Trademarks

Attention: Editor, Trademark Manual of Examining Procedure

P.O. Box 1451

Alexandria

Virginia

22313-1451

USPTO Trademark Manual of Examining Procedure (TMEP)

<https://tmep.uspto.gov/RDMS/TrademarkManual/Current/Current/d1e2.html>

 WIPO | MADRID
 The International
 Trademark System

▼ 1900 - Madrid Protocol

- 1901 - Overview of the Madrid System of International Registration
- ▶ 1902 - International Application Originating from the United States
- ▶ 1903 - Payment of Fees
- ▼ 1904 - Request for Extension of Protection of International Registration to the United States
 - ▶ 1904.01 - Filing Request for Extension of Protection to United States
 - ▼ 1904.02 - Examination of Request for Extension of Protection to the United States
 - 1904.02(a) - Examined as Regular Application on the Principal Register
 - 1904.02(b) - Examination of Classification of Goods/Services in §66(a)
 - ▶ 1904.02(c) - Examination of Identification of Goods/Services in §66(a)
 - 1904.02(d) - Examination Issues Specific to Certification and Collectible Goods
 - ▶ 1904.02(e) - Corrections to an International Registration
 - ▶ 1904.02(f) - Restrictions to Goods/Services
 - 1904.02(g) - Refusal Must Be Made Within 18 Months
 - 1904.02(h) - Office Actions and Responses
 - 1904.02(i) - Correspondence Address
 - 1904.02(j) - Mark May Not Be Amended
 - 1904.02(k) - Drawings and Descriptions of the Mark
 - 1904.02(l) - Jurisdiction
 - ▶ 1904.03 - Notice of Refusal
 - 1904.04 - Opposition
 - 1904.05 - Certificate of Extension of Protection
 - 1904.06 - Assignment of Extension of Protection to the United States
 - ▶ 1904.07 - Invalidation of Protection in United States
 - 1904.08 - Cancellation of International Registration by IB
 - ▶ 1904.09 - Transformation to Application Under §1 or §44
 - 1904.10 - Affidavits of Use or Excusable Nonuse Required
 - 1904.11 - Incontestability
 - 1904.12 - Replacement
 - ▶ 1904.13 - Amendment and Correction of Registered Extension of Protection
 - 1904.14 - Notification of Correction in the International Register with Respect to the United States
 - ▶ 1904.15 - Notification of Restrictions to Goods/Services with Respect to the United States
- 1905 - Renewal of International Registrations
- ▶ 1906 - Communications with International Bureau Regarding International Registrations

USPTO Trademark Manual of Examining Procedure (TMEP)

Chapter 1900—Madrid Protocol

Section 1904—Request for extension of protection

<https://tmepp.uspto.gov/RDMS/TMEP/current#/current/TMEP-1900d1e1.html>



▸ 1200 - Substantive Examination of Applications

- 1201 - Ownership of Mark
- 1202 - Use of Subject Matter as Trademark
- 1203 - Refusal on Basis of Immoral or Scandalous Matter; De
- 1204 - Refusal on Basis of Flag, Coat of Arms, or Other Insign
- 1205 - Refusal on Basis of Matter Protected by Statute or Co
- 1206 - Refusal on Basis of Name, Portrait, or Signature of Pa
- 1207 - Refusal on Basis of Likelihood of Confusion, Mistake,
 - 1207.01 - Likelihood of Confusion
 - 1207.01(a) - Relatedness of the Goods or Services
 - 1207.01(b) - Similarity of the Marks
 - 1207.01(c) - Design Marks
 - 1207.01(d) - Miscellaneous Considerations
 - 1207.02 - Marks That Are Likely to Deceive
 - 1207.03 - Marks Previously Used in United States but Not
 - 1207.04 - Concurrent Use Registration
- 1208 - Conflicting Marks in Pending Applications
- 1209 - Refusal on Basis of Descriptiveness
 - 1209.01 - Distinctiveness/Descriptiveness Continuum
 - 1209.02 - Procedure for Descriptiveness and/or Genericne
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 - 1209.04 - Deceptively Misdescriptive Marks
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- 1211 - Refusal on Basis of Surname
- 1212 - Acquired Distinctiveness or Secondary Meaning
- 1213 - Disclaimer of Elements in Marks
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- 1215 - Marks Composed, in Whole or in Part, of Domain Nam
- 1216 - Effect of Applicant’s Prior Registrations
- 1217 - Res Judicata, Collateral Estoppel, and Stare Decisis

USPTO Trademark Manual of Examining Procedure (TMEP)

Chapter 1200– Substantive examination and grounds for refusal

<https://tmepp.uspto.gov/RDMS/TMEP/EP/current#/current/TMEP-1200d1e1.html>

Detailed information about examination policies and practices of the USPTO as a designated office

WIPO Madrid Member Profile – United States of America

<https://www.wipo.int/madrid/memberprofiles/result?countries=9212&datafields=9577,9578,9579,9580,9581,9582,9583,9584,9585,9586,9587,9588,9589,9590,9591,9592,9593,9594,9595,9596,9597,9598,9599,9600,9601,9602,9603,9604,9605,9606,9607,9608,9609,9610,9611,9612,9613,9614,9615,9616,9617,9618,9619,9620,9621,9622,9623,9624,9625,9626,9627,9628,9629,9630,9631,9641,9633,9634,9635,9636,9637,9639,9640,9638>

MADRID MEMBER PROFILES

1

Select members

2

Select details

▼ UNITED STATES OF AMERICA

Last update on : Nov 6, 2020

GENERAL INFORMATION AND CONTACT DETAILS

Contact information

Name of Office: United States Patent and Trademark Office (USPTO), Madrid Processing Unit

Address: 600 Dulany Street, MDE 7B87, Alexandria, VA 22314-5793

Phone number: +1-571-272-9375

Email: MPU@uspto.gov

Fax: +1-571-273-0091

Website

Opening hours: Monday - Friday, 8:30 am. to 5:00 pm.

Official holidays: refer to [annual federal holiday calendar](#)

Contact for questions related to international registrations: Ms. LaShawn Cave, Supervisor of Madrid Processing Unit

Email: lashawn.cave@uspto.gov

Phone number: +1-571-272-9560

Membership in Madrid Union, date of entry into force



HIGHLIGHTS

SPECIAL EDITION
THE UNITED STATES PATENT AND
TRADEMARK OFFICE (USPTO)

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Detailed information about examination policies and practices of the USPTO as a designated office

**WIPO Madrid Highlights
Special Edition, March 2015**
www.wipo.int/export/sites/www/madrid/en/highlights/2015/pdf/madrid_highlights_special_edition_uspto.pdf

USPTO & WIPO resources

- Trademark statute and rules: <https://fsr.uspto.gov/RDMS/TFSR/current>
- Trademark Manual of Examining Procedure (TMEP): <https://tmep.uspto.gov/RDMS/TMEP/current#/current/d1e2.html>
 - Chapter 1904: Requests for extension of protection to the U.S.
- Trademark ID Manual: <https://idm-tmng.uspto.gov/id-master-list-public.html>
- Trademark Electronic Search System (TESS) to search the USPTO trademark database:
<http://tmsearch.uspto.gov/bin/gate.exe?f=tess&state=4809:8rnaez.1.1>
- Trademark Status & Document Retrieval (TSDR) to check status of applications and registrations: <https://tsdr.uspto.gov/>
- Trademark Official Gazette (TMOG): https://eog-tmng.uspto.gov/#issues=2020-11-03&pubReason=OPPOSITION&limit=20&orderBy=SERIAL_NR&view=review&subview=tile
- USPTO TEAS electronic forms: www.uspto.gov/trademarks-application-process/filing-online
- USPTO Madrid Protocol webpage: www.uspto.gov/trademark/laws-regulations/madrid-protocol
- WIPO Madrid Member Profile Database – USA:
<https://www.wipo.int/madrid/memberprofiles/result?countries=9212&datafields=9577,9578,9579,9580,9581,9582,9583,9584,9585,9586,9587,9588,9589,9590,9591,9592,9593,9594,9595,9596,9597,9598,9599,9600,9601,9602,9603,9604,9605,9606,9607,9608,9609,9610,9611,9612,9613,9614,9615,9616,9617,9618,9619,9620,9621,9622,9623,9624,9625,9626,9627,9628,9629,9630,9631,9641,9633,9634,9635,9636,9637,9639,9640,9638>
- WIPO Madrid Highlights, Special Edition featuring the USPTO, March 2015:
www.wipo.int/export/sites/www/madrid/en/highlights/2015/pdf/madrid_highlights_special_edition_uspto.pdf



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Q&A session about the webinar

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