



WIPO | MADRID

The International
Trademark System



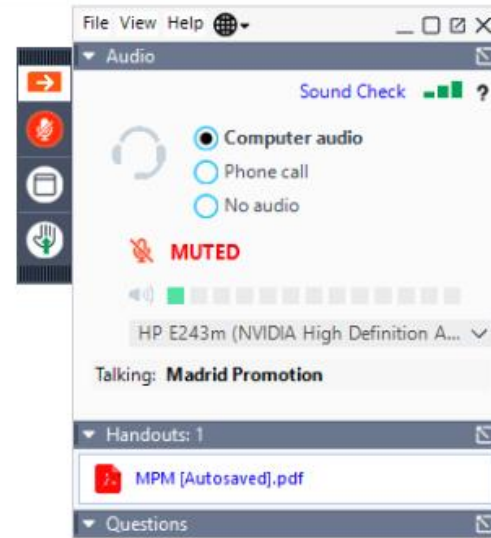
Everything you Have Always Wanted to Know About the Madrid System but Never Dared to Ask

Madrid System Webinar

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Madrid Information and Promotion Division

**Geneva
December 9,
2020**

How to use GoToWebinar



Structure of the Webinar

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



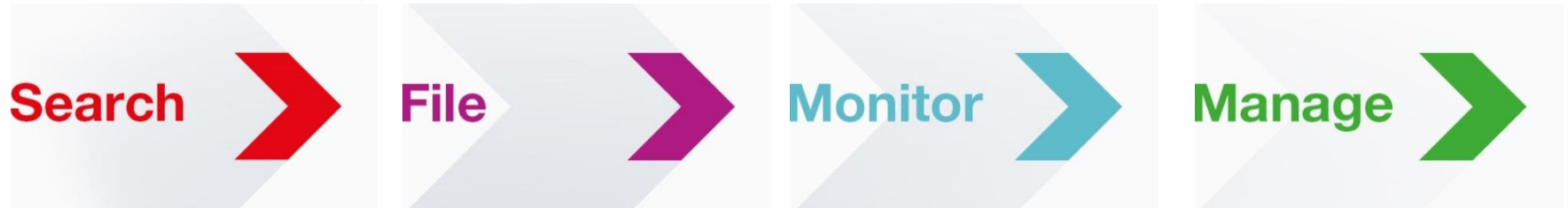
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Trademark System



Why the Madrid System?

Lifecycle of an International Registration



SearchFileMonitorManage

Does a similar mark already exist in my target markets?

- Search the [Global Brand Database](#)

Global Brand Database

- More than **40 million records** from **55 national and international collections**
- Downloadable search results and records
- Easy to search
- Automatic search suggestions
- Unique AI-powered image search for similar brands

Poll No 1

Can you find information on national registrations in countries that are not members of the Madrid System?

■ Yes

■ No

Perform a trademark search by text or image in brand data from multiple national and international sources, including trademarks, appellations of origin and official emblems. V: 2019-11-07 21:43

Data from Madagascar available Over 20,000 records added 2019-10-17

Data from Uruguay available Over 266,000 records added 2019-08-01

Data from 9 ARIPO member states available Over 407,000 records added 2019-04-06

A new AI-powered image search available Use the "Concept" Strategy 2019-04-01

Data from Registro Nacional Costa Rica available Over 326,000 records added 2019

SEARCH BY

Brand Names Numbers Dates Class Country

Text = e.g. wipo OR omp, tel, ompl

Image Class = e.g. 05.07.13, apple AND tree

Goods/Services = e.g. footwear, comput*

search

CURRENT SEARCH

BRAND:car X

FILTER BY

Source Image Status Origin App. Year * Expiration *

AE TM	111	AU TM	1,726	BL TM	27
BN TM	11	BW TM	15	CA TM	1,271
CH TM	216	CL TM	36	CR TM	391
DE TM	1,456	DK TM	114	DZ TM	14
EE TM	29	EG TM	74	EM TM	1,000
ES TM	794	FR TM	1,876	GE TM	17

Display: List

Sort: Value - asc

filter

1 - 30 / 27,652

TMview

Display: 30 per page

options

1 / 922

	Brand	Source	Status	Relevanc	Origin	Holder	Number	App. Date	Image Class	Nice Cl.	Image
<input type="checkbox"/>	car	EG TM	Active	33	EG	كارلوسيو سى - شركة بريطانية محدودة عامه	EG210868	2007-12-26	VC.28.11	43	CARLUCCIO'S
<input type="checkbox"/>	DRKIZZ, CAR, CAR, CAR, CAR	JP TM	Active	27	JP	日産部品九州販売株式会社	4724684	2003-03-13		37, 42	
<input type="checkbox"/>	しすおCAR	JP TM	Active	26	JP	損害保険ｼﾞｯﾊﾟﾝ日本興亜株式会社	5888735	2016-05-11		36	
<input type="checkbox"/>	CAR	JP TM	Active	26	JP	ｷﾞﾝｼﾞﾝ株式会社	4356717	1998-08-24		9	
<input type="checkbox"/>	Bright rent a car	OM TM	Active	26	OM	الديفاعة الساطعة لتأجير السيارات ش م م	OMT1126374	2019-02-24	VC.07.01, VC.20.01, VC.29.01	39	
<input type="checkbox"/>	CAR	JP TM	Active	25	JP	ザﾌﾞﾚﾝﾀｰ-ｱﾝﾄﾞ-ｷﾞﾝｼﾞﾝﾙｶﾝﾊﾞﾆ-	5582552	2012-10-09	VC.18.01, VC.27.03, VC.27.05	5, 11	



Questions?

Search**File**MonitorManage

Why do I need to have a national mark as a basis to file an international application?

- Conditions to use the Madrid System (Article 2 of the Madrid Protocol)
 - Entitlement
 - Basic Mark
 - File the international application through that Office, which would be your Office of origin

When do I have to provide an “address for correspondence” of the holder in an International Application?

- The holder wishes to receive communication to a different address than the one under “address of the holder”.
- ! It cannot be the address of the representative !
- Provide an email

Poll No 2

Should a translation of the mark be provided only if the mark is not in Latin characters?

■ Yes

■ No

Example: Item 9(b): Translation of the Mark



9 MISCELLANEOUS INDICATIONS

(b) Translation of the mark (as may be required by certain designated Contracting Parties):

(i) into English: "NICOLINE SMALL ITALIAN TAILOR SHOP"

.....

(ii) into French: "NICOLINE PETITE BOUTIQUE DU TAILLEUR ITALIENNE"

.....

(iii) into Spanish: "NICOLINE PEQUEÑA SASTRERÍA ITALIANA"

.....

When should the verbal elements of the mark be entered in the form?

- At any time, it is voluntary.
- It is recommended when the verbal elements are not clear in the image.

If the priority is claimed only for some classes, but for all the G&S in those classes, can I indicate only the class number?

- Yes, if the priority refers to all the G&S in one class.

Poll No 3

Should I notify WIPO when I submit the International Application to my Office of Origin?

■ No

■ Yes

What's the difference between the Intention to use and Proof of use?

■ Intention to use:

- “Tacit declaration”

- USA MM18 form - [Watch webinar about USPTO](#)

- [Declarations made by Contracting Parties](#)

■ Proof of use:

- Proof of the actual use of the mark

- [Madrid Member Profiles](#)

If I receive an International Registration certificate does it mean that my mark is protected worldwide?

- **No**, protection is granted on a national/regional basis

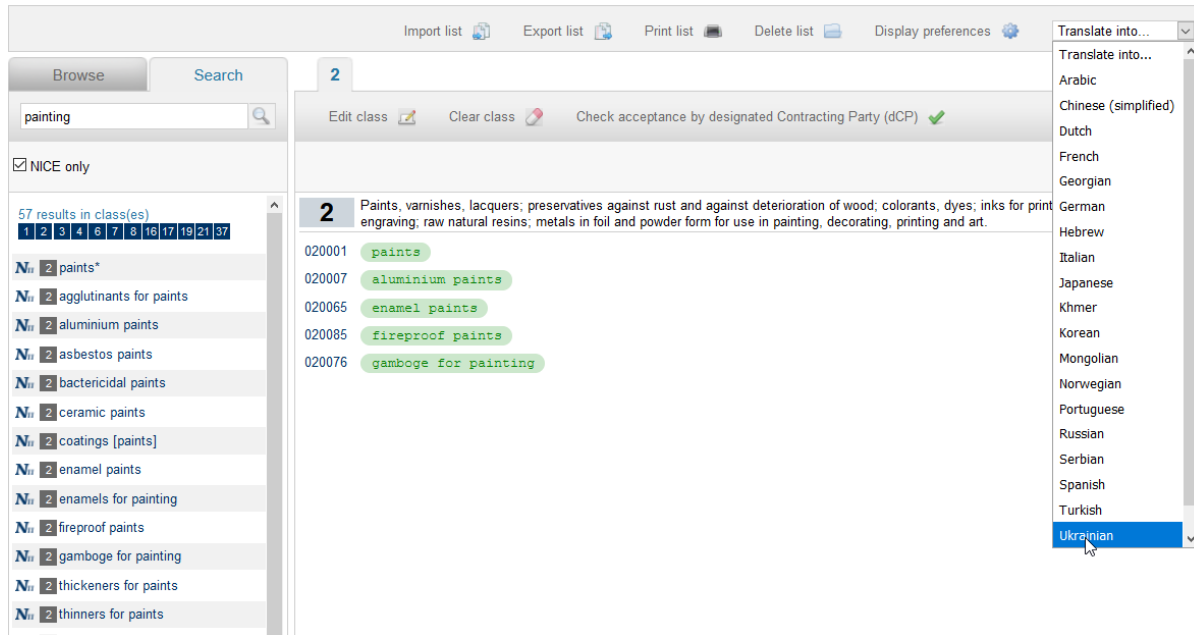
Poll No 4

As an employee of an affiliated organization, can I file an international application without authorization?

■ Yes

■ No

How to translate terms in Madrid Goods & Services Manager?



The screenshot displays the Madrid Goods & Services Manager interface. The search bar contains the term "painting". The results are filtered to "NICE only" and show 57 results in class(es). The class 2 results are listed as follows:

- 2 paints*
- 2 agglutinants for paints
- 2 aluminium paints
- 2 asbestos paints
- 2 bactericidal paints
- 2 ceramic paints
- 2 coatings [paints]
- 2 enamel paints
- 2 enamels for painting
- 2 fireproof paints
- 2 gamboge for painting
- 2 thickeners for paints
- 2 thinners for paints

The class 2 description is: "Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants, dyes; inks for printing; engraving; raw natural resins; metals in foil and powder form for use in painting, decorating, printing and art."

The interface also shows a dropdown menu for "Translate into..." with the following options:

- Arabic
- Chinese (simplified)
- Dutch
- French
- Georgian
- German
- Hebrew
- Italian
- Japanese
- Khmer
- Korean
- Mongolian
- Norwegian
- Portuguese
- Russian
- Serbian
- Spanish
- Turkish
- Ukrainian

Madrid Goods & Services Manager

- Nice Classification class headings, terms and explanatory notes
- Over 100,000 indications in English, 59,600 in French and 56,200 in Spanish of G&S acceptable to WIPO
- Compile and translate your list in 21 languages
- Check acceptance of terms by WIPO and 35 participating offices

Can we use the item 10. b) of the MM2 form to include a more specific description of G&S for the USA designation?

- (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

■ Yes, you can.

How can I pay fees at WIPO ?

- Current Account at WIPO
- Bank transfer
- Credit Card

More information on payment

Current Account at WIPO

- Guide to the Current Account at WIPO (updated terms and conditions)
- No minimum number of transactions
- Initial payment of at least CHF 2,000
- Minimum balance – notification sent to users if balance is less than CHF 200
- Only required a WIPO Account (email address)
- Account statement sent by email only

Where can I ask for an invoice?

- The Madrid System does not issue invoices.

Poll No 5

Can I pay WIPO fees in Arab Dirham ?

- No, only in Swiss Francs (CHF)
- Yes, in any currency
- No, only in Euro (€)



Questions?

SearchFile**Monitor**Manage

How do I reply to a Provisional Refusal of Protection?

- All info available in the Refusal notification
 - Grounds for refusal
 - How to reply
 - Time-limit to reply
 - Whom to reply to



In case of questions contact the National Office directly

Why a Provisional Refusal from the Chinese IP Office is not subject to review?

- Rule 17(5)(e) applies
- Ex-Officio Provisional Refusal pronounced by the IP Office of China is not open to review

How can we make sure that a grant of protection after a provisional refusal in China is shown in Madrid Monitor?

- Where following the refusal, the IP Office of China grants protection to your IRN, this is viewable in Madrid Monitor as a **further decision**.

How to know if an Office has opted for 12 or 18 months?

- Declarations made by the Contracting Parties
- Madrid Members Profile Database

What does «Interim Status» mean?

- “Interim” means “intermediate”
- The mark is still subject to opposition or observations by third parties
- No action is required from the holder

What is a notification of possible opposition?

- IP Office of a dCP informing that the *ex-officio* examination is closed and the mark is published for opposition
- Refusal based on opposition is possible after 18 months
- No action is required from the holder

Why are oppositions from Brazil not notified to WIPO but to the local representative?

- The opposition system in Brazil, the Office would notify WIPO only opposition where the Office would side with the opponent and issue a provisional refusal based on opposition.

Poll No 6

What is the meaning of “*The refusal period has expired and no notification of provisional refusal has been recorded (application of Rule 5 preserved)*”?

- The trademark is:
 - Expired
 - Considered protected
 - It is not protected

How can I check the status of my request?

- Madrid Monitor (To track the status in real time of your mark)

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 communications under the Madrid System. Find out why this is necessary.

Search | WIPO Gazette | Support

Refine Terms

holder only

mark only

Filters

- ▼ Status
 - Active 2
 - Pending 0
 - Inactive 0
- ▼ Origin
 - CH 2

Current Search

MARK_ALL,HOL:patentscope

image search

download

monitor

1 - 2 / 2 Display: 30 per page options

Trademark	Image	Status	Orig	Holder	Reg. No	Reg. Date	Nice Cl.	Vienna Cl.
PATENTSCOPE		Active	CH	Organisation Mondiale de la Propriété Intellectuelle	879539	2005-12-27	9, 16, 35, 38, 41, 42	16.03, 27.05
WIPO PATENTSCOPE		Active	CH	Organisation Mondiale de la Propriété Intellectuelle	1358297	2017-07-06	9, 16, 35, 38, 41, 42, 45	

1 - 2 / 2 1 / 1

How much time does WIPO take to record a request?

- Monthly average pendency rates are published online



Questions?

SearchFileMonitor**Manage**

What's the difference between a change in ownership and a change in the holder's name ?

- A change in ownership results from a change of property of the trademark (two holders transferor-transferee) - **MM5 Form**
- Change in the holder's name: person or legal entity continues to be the holder of the international registration - **MM9 Form**

Poll No 7

Which form should I use to change of the legal nature of the holder?

■ MM9 Form

■ MM5 Form

Do designated offices perform a repeated examination of the same mark after a change in Ownership? If yes, what are the time limits?

- The dCP when notified about a change in ownership cannot question the protection of the IRN but it examines the validity of the change.
- Time limit : 18 months
- More information: [Madrid Member Profiles](#)

How does a new edition of the Nice Classification impacts the list of G&S of an existing international registration?

- The Madrid System does not reclassify according to a new edition of the Nice Classification.
- WIPO notifies the dCP of the version of the Nice classification used for this particular IRN.

What should I do if I don't want to pay fees for some G&S at the time of Renewal?

- Before the renewal due date, you can request:
 - Limitation
 - Cancellation

What's the difference between a limitation and a cancellation

- Limitation: G&S are not removed from the the main list of IRN. They can be subsequently designated. ([Online limitations](#))
- Cancellation: The G&S are permanently removed from the IRN.(MM8)
- [Madrid «How-to» videos](#) “How to restrict the list of goods and services of the international registration”

How can I remove a designated Contracting Party ?

- Renunciation. One CP
- CP can be subsequently designated
- MM7

The money has been withdrawn but the Renewal is not recorded in Madrid Monitor

- Renewals are never recorded before the expiry date of your mark even if:
 - the examination is completed
 - the money has been received

Why was the Notification of “non-renewal” sent to the holder although I am the recorded representative?

- The Notification of “non-renewal” is addressed to the holder and the recorded representative.



Questions?

SearchFileMonitorManage



Conclusion

Keep Updated on the Madrid System

- Visit the [Madrid Website](#)
- Access [Madrid Webinar](#) recordings and stay tuned for new topics
- Play our [Madrid 'How-to' videos](#)
- Subscribe to [Madrid Notices](#)
- Contact us: [Contact Madrid](#)

