



**WIPO | MADRID**

The International  
Trademark System



# Madrid System Legal Update

## Madrid System Webinar

Lucy Headington-Horton

**Geneva**  
**February 8, 2023**

# Our speaker

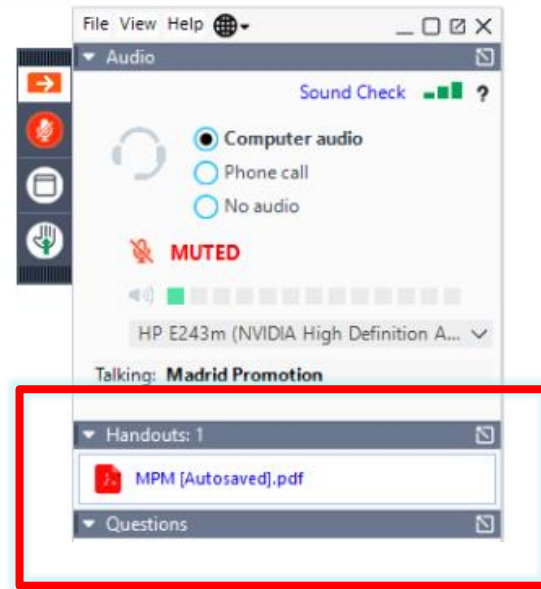


## Lucy Headington-Horton

Senior Legal Officer  
Madrid Legal Division  
**WIPO**



# How to use GoToWebinar



# Program

- In force as from November 1, 2022
- In force as from February 1, 2023
- New members since January 2022



In force as from  
November 1, 2022

# Question 1

The holder can no longer request the recording of the appointment of representative by....

- a) Using “manage your representative” in eMadrid
- b) Uploading form MM12 using eMadrid
- c) Uploading a signed document using eMadrid

# Appointment of a representative

- Amendment to Rule 3(2)(b) of the Regulations
- Holder must use official form (MM12 or the online form) to request the recording of the appointment of a representative
- Appointment will not be recorded if the holder fails to use the form

# Madrid System online services

## Madrid System online services – eMadrid

Use **eMadrid** to file your applications and manage your trademark portfolio, in a secure and self-service environment.

[Go to eMadrid](#)

[Access supporting tools](#)





# eMadrid

## PREPARE YOUR APPLICATION

Use the Madrid Application Assistant to prepare your international registration

Get started

## MONITOR YOUR REGISTRATION

Use Madrid Monitor to track the status of your international application or registration.

Get started

## EXPAND PROTECTION OF YOUR REGISTRATION

Use our Subsequent Designation service to expand the geographical scope of your international registration.

Get started

## LIMIT THE GOODS AND SERVICES

Restrict the list of goods and services for the Contracting Parties designated in your international registration.

Get started

## RENOUNCE PROTECTION IN CONTRACTING PARTIES

Abandon the effects of your international registration for all goods and services, for some of the designated Contracting Parties.

Get started

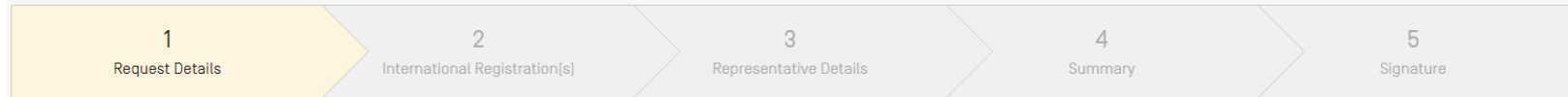
## MANAGE YOUR REPRESENTATIVE

Appoint, cancel or change name and/or contact details of your representative, as recorded in the International Register.

Get started

# Management of representative

## MANAGEMENT OF REPRESENTATIVE



### REQUEST DETAILS

You may use this form to appoint a Representative to act on your behalf to manage your International Registration before the International Bureau [WIPO]; request a recording of a change in the contact details [including name or address] of the Representative already recorded in the International Register; or to cancel a Representative.

A single form may be used by the Holder to request the Appointment, or the cancellation of a Representative for multiple International Registrations provided that all registrations listed are recorded in the name of the Holder making the request. A single form may also be used by a Representative to request a change in contact details, or to cancel the Appointment of a Representative for multiple International Registrations provided all registrations listed are recorded in the name of the Representative making the request.

I am \*

- The recorded Holder
- The recorded Representative

My request concerns \*

- The Appointment and Replacement of a representative
- A change of name and/or contact details of an existing representative
- The cancellation of a representative

# Question 2

How early can I renew an international registration?

- a) Twelve months before its expiry date
- b) Six months before its expiry date
- c) Three months before its expiry date

# Renewal

- Amendment to Rule 30(1)(b) of the Regulations
- Renewal is possible as early as six months before the due date to coincide with the renewal reminder

# eRenewal

## RENEWAL

**Information** Renewal is available as of 6 months before the renewal date of your international registration. It is also available during the grace period, subject to a surcharge.

Enter your International Registration Number [IRN]

IRN

1178699

It is premature to renew this international registration at this time.

Please try again no earlier than six months before this international registration expires; that is, no earlier than February 28, 2023.

For more information, please refer to your international registration status on the [Madrid Monitor](#)

[e.g. 123456]

Reset

Start the renewal process

# Important considerations

- Changes must be recorded if they are to be taken into account during renewal
- Where subsequent designations are requested after the registration is renewed, but before the new period begins, the holder must request:
  - that the subsequent designation take effect at the start of new period of protection; or,
  - a complementary renewal to pay the renewal fees for the newly designated member



In force as from  
February 1, 2023

# Question 3

I can represent a sound mark in the international application using

- a) musical notation
- b) a digital sound recording
- c) the representation that appears in the basic mark



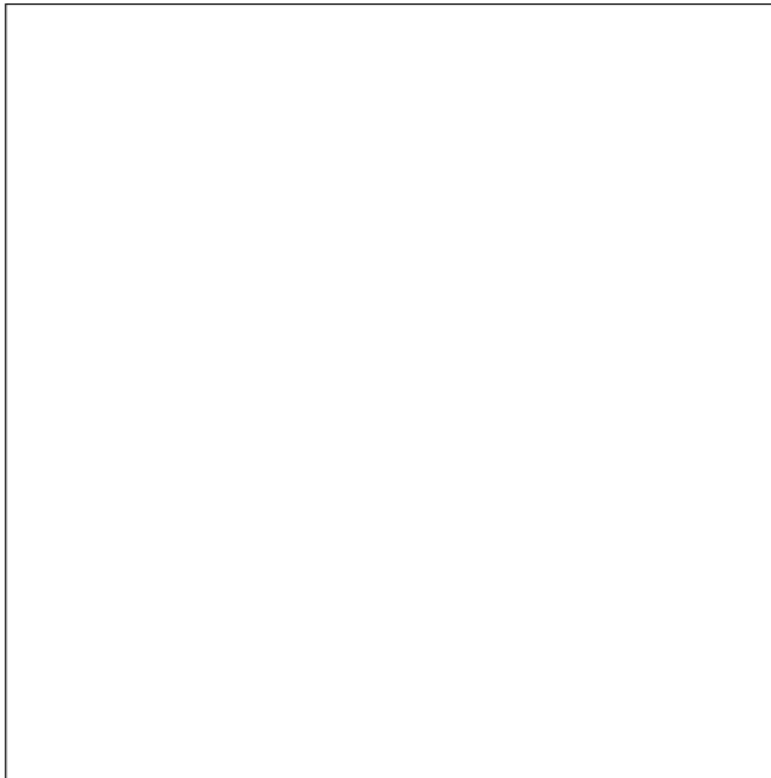
# Only one representation of the mark

- Amendment to Rules 9(4)(a)(v) and (5)(d)(v) and 32(1)(c) of the Regulations
- Only one representation of the mark is required in black and white or color, as applicable

# Form MM2

## 7. THE MARK

- (a) Place the representation of the mark as it appears in the basic application or basic registration in the square below<sup>11</sup>; or attach it to this application as a single digital file<sup>12</sup>.



<sup>11</sup> A visual representation of the mark that shall not exceed a maximum size of 20 by 20 centimeters.

<sup>12</sup> The single digital file can be a visual representation, in JPEG, PNG or TIFF format, a sound recording, in MP3 or WAV format (not exceeding 5 MB in size) or a motion or multimedia recording, in MP4 format (with AVC/H.264 or MPEG-2/H.262 codecs, not exceeding 20 MB in size).

# New means of representation

- Amendment to Rule 9(4)(a)(v) and consequential amendments to Rules 15(1)(ii), 17(2)(v) and 32(1)(b) of the Regulations, as well as to Item 2(1) of the Schedule of Fees
- Representation of the mark in accordance with the administrative instructions

# Representation of the mark (1)

- New Section 11 *bis* of the Administrative Instructions
- Visual representation in the international application no bigger than 20cm by 20cm (about 7.8in by 7.8in)

# Representation of the mark (2)

- Alternatively, a single digital file may be filed with the international application, when the representation consists of
  - an image, in JPEG, PNG or TIFF (ST.67)
  - a sound recording, in MP3 or WAV, max 5MB (ST.68)
  - a motion or multimedia recording, in MP4, max 20MB (ST.69)

# MAA – Image file

## Application for international registration

◀ Representative Goods and services ▶

Basic application or registration	☑
Designated Contracting Parties	☑
Applicant(s)	☑
Representative	☑
Languages and correspondence	☑
<b>Mark</b>	
Goods and services	
Limitations	
Claimed priorities	
Seniority claim	
Declaration of Intention to use	
Fee calculations	
Payment	
Summary	

### Mark

Type

Figurative

Kind \*

Individual

### Representation



The mark is in color

Image representation as it appears in the basic application or registration

Preferred representation format: j-peg or tiff and never gif

Choose File No file chosen

Upload

The applicant claims color(s) as a distinctive feature of the mark

# MMA – Sound File

## Application for international registration

◀ Representative    Goods and services ▶

Basic application or registration	☑
Designated Contracting Parties	☑
Applicant(s)	☑
Representative	☑
Languages and correspondence	☑
<b>Mark</b>	
Goods and services	
Limitations	
Claimed priorities	
Seniority claim	
Declaration of Intention to use	
Fee calculations	
Payment	
Summary	

**Mark**

Type:

Kind \*:

**Representation**

MP3 or wav and not to exceed 5 MB in size

No file chosen

No file chosen

# MAA – Multimedia file

## Application for international registration

◀ Representative      Goods and services ▶

Basic application or registration	✔
Designated Contracting Parties	✔
Applicant(s)	✔
Representative	✔
Languages and correspondence	✔
<b>Mark</b>	
Goods and services	
Limitations	
Claimed priorities	
Seniority claim	
Declaration of Intention to use	
Fee calculations	
Payment	
Summary	

**Mark**

Type:

Kind \*

**Representation**

The mark is in color

Required format: MP4 and not to exceed 20 MB in size

No file chosen

The applicant claims color(s) as a distinctive feature of the mark



# Madrid Member Profile Database

## MADRID MEMBER PROFILES

[Back](#)[Save as PDF](#)[Save as Excel](#)[Restart](#)

1

Select members

2

Select details

3

Member information

## CANADA

Last update on : Apr 14, 2022

### INFORMATION ON PROCEDURES AS A DESIGNATED CONTRACTING PARTY

Types of marks, requirements and acceptable formats for representation of the mark

Formats for representation of the mark before the Office

- Word marks:

CIPO has created a standard character set that lists the letters, numerals, punctuation marks, diacritics and typographical symbols that may be used when filing a standard character trademark. The standard character set is available within the practice notice on Standard character trademarks.

- Figurative marks (device marks):

The acceptable file formats for documents submitted electronically are: PNG, TIFF, JPEG, GIF, MP3, MP4, PDF, BMP and Doc.  
Combination marks (figurative/device + word elements):

The acceptable file formats for documents submitted electronically are: PNG, TIFF, JPEG, GIF, MP3, MP4, PDF, BMP and Doc.

- Hologram marks:

The acceptable file formats for documents submitted electronically are: PNG, TIFF, JPEG, GIF, MP3, MP4, PDF, BMP and Doc.

Three-dimensional marks (shape marks):

The acceptable file formats for documents submitted electronically are: PNG, TIFF, JPEG, GIF, MP3, MP4, PDF, BMP and Doc.

# MAA – International application form



## MM2 - APPLICATION FOR INTERNATIONAL REGISTRATION UNDER THE MADRID PROTOCOL

Summary

### **Mark**

---

#### Mark kind & text

Mark feature: Sound  
Mark type : Individual

#### Other information

Transliteration: --  
Translation: English translation: --  
French translation: --  
Spanish translation: --

Protection disclaimers for  
the following element(s) of  
the mark: --

# International registration certificate

## Enregistrements



## NOTIFICATION

ENN/1993/8

### Reproduction de la marque

de dessin. Pour voir la reproduction de la marque, suivez le lien/code QR ci-dessous



[https://multimedia.wipo.int/wipo/en/madrid/madrid\\_how\\_to\\_subsequent-720p.mp4](https://multimedia.wipo.int/wipo/en/madrid/madrid_how_to_subsequent-720p.mp4)

**Numéro d'enregistrement** 605 000  
**Date d'enregistrement** 16 juin 1993  
**Date d'échéance** 16 juin 2023  
**Nom et adresse du titulaire** ORGANISATION MONDIALE DE LA PROPRIÉTÉ INTELLECTUELLE  
chemin des Colombettes 34, CH-1211 GENÈVE 20 (Suisse)  
**Liste des produits et services**  
9 Supports de données bibliographiques et graphiques lisibles par machine, y compris bandes magnétiques, disques optiques, disques CD-ROM pour la documentation de marques; logiciels sur support magnétique ou optique.  
35 Services relatifs à une banque de données dans le domaine de l'information en matière de marques, à savoir collecte, stockage, mise à jour, mise en forme, analyse, archivage, tri et documentation de données, y compris d'informations, de communications, d'images, de films et de documents.  
38 Services relatifs à une banque de données dans le domaine de l'information en matière de marques, à savoir diffusion et livraison de données, y compris d'informations, de communications, d'images, de films et de documents.  
**Enregistrement de base** Suisse, 01.04.1993, 402 418  
**Données relatives à la priorité selon la Convention de Paris** Suisse, 01.04.1993, 402 418  
**Désignations selon l'Arrangement de Madrid** Algérie, Allemagne, Autriche, Bélarus, Benelux, Bulgarie, Chine, Croatie, Cuba, Egypte, Espagne, Fédération de Russie, France, Hongrie, Italie, Kazakhstan, Liechtenstein, Maroc, Monaco, Mongolie, Pologne, Portugal, République populaire démocratique de Corée, République tchèque, Roumanie, Saint-Marin, Serbie-et-Monténégro, Slovaquie, Slovénie, Soudan, Ukraine, Viet Nam  
**Date de notification** 22.09.1993  
**Langue de la demande internationale** Français

# Representation in refusals



- Amendment to Rule 17(2)(v) of the Regulations
- Where Offices notify WIPO of a refusal based on earlier mark, the Office must:
  - include a representation in the notification; or
  - information on how to access such representation

# Electronic communication

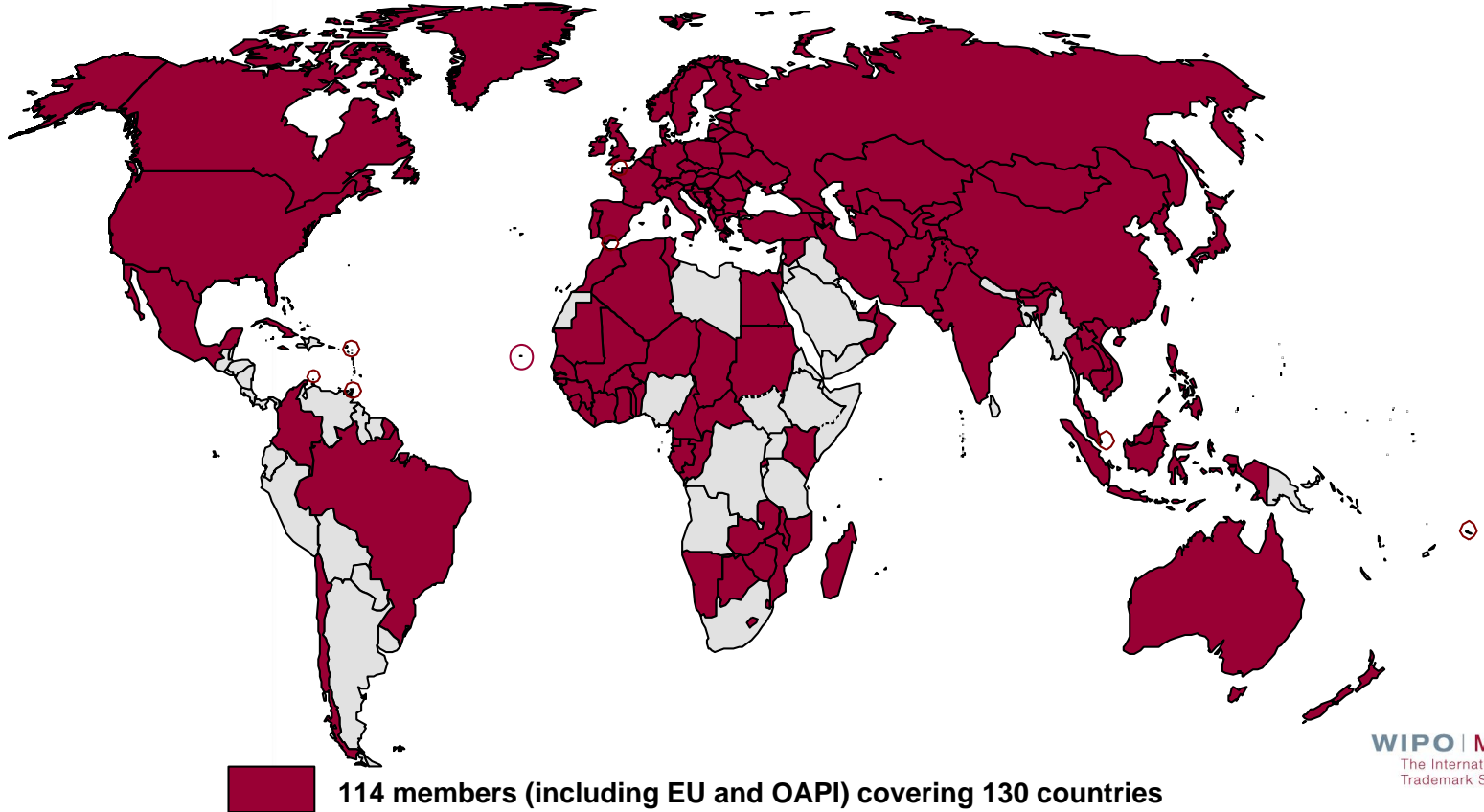
- Amendment to Sections 6(b), 11, 14 and 15(b) of the Administrative Instructions
- Applicants, holders and their representatives must exchange communications with WIPO by electronic means

# New members since January 2022

# New Madrid Members

Member		Entry into force	Individual fee	Extend refusal period	Licenses no effect	No division or merger	Intend to use
Jamaica		March 27 2022	X	X	X		
Chile		July 4 2022	X	X	X	X	
Cabo Verde		July 6 2022				X	X
Belize		February 24 2023	X	X	X	X	
Mauritius		May 6 2023	X	X	X		

# Members of the Madrid System







**WIPO | MADRID**

The International  
Trademark System

■ Questions?

# Certificates of Attendance

- Share your certificate on [LinkedIn](#), [Twitter](#) and other social media channel.



Tag WIPO **#MadridSystem**

# Madrid System User Group

Help us shape the future of our Madrid System online services under [eMadrid!](#)

[Sign up to our Madrid System User Group](#)



# Madrid System Podcast

## WIPOD – International Trademark System Talks

- Spotify 
- Apple Podcasts 
- Google Podcasts 



# Testimonials and Case Studies

## Madrid System Case Study Highlight: Panasonic, Branding for Further Growth and Greater Value

October 5, 2021

We continue with our highlights of key case studies giving you practical insights on how companies across various industries use the Madrid System globally to their advantage. Our latest study focuses on [Panasonic, the renowned Japanese electronics corporation](#).

Panasonic provides a wide range of products and services that are used in consumers' daily lives worldwide. These include home appliances, the electronic components used in them, housing and various services.



With more than a hundred years of experience, the company has been thoroughly committed to creating a better life for its users under the brand slogan of "A Better Life, A Better World".

Over the years, Panasonic introduced several business brands to achieve further growth and greater brand value in each area of business. In 2008, the corporation changed its name from the Matsushita Electric Industrial Co., Ltd to the Panasonic Corporation, consolidating its brand identity.

Discover how, with such a varied portfolio and an expansion strategy geared internationally, Panasonic uses the Madrid System to simplify the administrative procedures and greatly reduce costs.

[Read the full Panasonic case study](#)



### Micromax on How WIPO's Madrid System Supports its International Growth Strategy

World Intellectual Property Organization – WIPO



### MixMediaWorx on the Benefits of Using the Madrid System

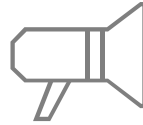
World Intellectual Property Organization – WIPO

# Stay informed



## ■ Website

Visit the [Madrid System Website](#)



## ■ Madrid News

Subscribe to [Madrid News](#)



## ■ Webinars

Access [Madrid Webinars](#) recordings and stay tuned for new topics



## ■ Podcast and YouTube

Check our WIPO Madrid [YouTube](#) playlists and listen to our [podcasts](#)



## ■ Tutorials

Play our Madrid [“How-to” videos and tutorials](#)



## ■ Questions

[Contact us](#) online