



Q&A Sheet

Roving Webinar on WIPO Services and Initiatives

June 25, 2020

Service	Question	Answer
Patent Cooperation Treaty (PCT) https://www.wipo.int/pct/en/	Where and how do you file a PCT application?	<p>In most cases, you can file a PCT application with your national patent Office, or directly with WIPO if permitted by your State's national security provisions. Both of those Offices act as PCT "receiving Offices". If you are a national or resident of a country which is party to the ARIPO Harare Protocol, the OAPI Bangui Agreement, the Eurasian Patent Convention or the European Patent Convention, you may alternatively file your international patent application with the regional patent Office concerned, if permitted by the applicable national law.</p> <p>Most applicants file PCT applications electronically. Using ePCT service will help you prepare your applications by automatically validating the entered data and drawing your attention to incorrectly or inconsistently completed parts. You can also manage your applications and monitor time limits for relevant actions. Filing electronically also entitles you to certain PCT fee reductions. Please see more details about PCT electronic filing at https://www.wipo.int/pct-safe/en/index.html.</p>
	Is the applicant required to designate the States it wants to seek protection in at the time of filing a PCT application?	It is not necessary to indicate your designations because upon filing the PCT application, all 153 Contracting States are automatically designated (see PCT Rule 4.9(a)(i)). This means that your PCT application has the effect of a regular national application in each of the 153 States as of the PCT application filing date.
	If I have 18 additional months under the PCT (compared to the Paris Convention) to decide where to seek for patent protection, how can I be sure that meanwhile a similar patent application is not filed in that country?	Because the PCT application has the effect of a regular national application in each of the 153 Contracting States , the PCT filing date will be considered as the actual filing date in each Contracting State in which you ultimately seek for patent protection. So any national patent application filed after you file your PCT application would have a later filing date.

	Do I have to first file a national application in the country where the invention was made before filing a PCT application?	<p>Under the PCT, there is no requirement that you first file a national application before filing a PCT application. Most applicants find it easier to first file a national application under their local laws and subsequently file a PCT application within 12 months, claiming priority to the first national application.</p> <p>If the PCT application is your first filing, keep in mind that some PCT Contracting States have restrictions on foreign filings for national security reasons and may require government permission depending on the national law. Please see https://www.wipo.int/pct/en/texts/nat_sec.html for further details.</p>
	Considering that the PCT is the preferred choice in comparison to the Paris Convention, why would an applicant file a patent application under the Paris Convention instead of filing under the PCT?	<p>Applicants seeking for patent protection in a country that is not one of the 153 Contracting States of the PCT would need to file a national application directly in that country under the Paris Convention.</p> <p>The PCT works as a strategic tool for applicants that want to seek for foreign protection in numerous countries. So, for applicants who are interested in only one or two countries, it may be more cost effective to file directly with those countries under the Paris Convention.</p>
Madrid System - Trademarks https://www.wipo.int/madrid/en	Are classification of goods and services for trademark filing in Madrid different from the local national level classification?	<p>WIPO applies the International Classification of Goods and Services (Nice Classification).</p> <p>In the international application, the names of the goods and services for which the international registration of the mark is sought must be indicated. These must be grouped in the appropriate classes of the Nice Classification.</p>
	Does Madrid System generally differentiate between word mark and device mark or they are all in one as a trademark.	<p>WIPO will assign a classification in accordance with the International Classification of the Figurative Elements of Marks (Vienna Classification) when the mark is not a mark in standard characters, and the mark consists of or contains non-Latin characters or non-Arabic numerals.</p>

	<p>Is there any unitary method for maintenance of trademarks granted in different countries?</p>	<p>Trademarks are territorial in nature, this means that the rights granted by trademark registration are limited to the territory in which the mark is registered. How a trademark is protected and enforced differs from country to country under the relevant legal frameworks.</p>
	<p>What advice would you give to small businesses that are looking to do research on the existing trademarks currently registered with WIPO?</p>	<p>Before filing an international application, it is advisable to search to find out if identical or similar marks already exist in your target markets. This knowledge will enable you to make appropriate filing decisions.</p> <p>If you need assistance to search prior to filing, or advice on strategies to avoid conflicts with already existing marks, you can consult a trademark attorney, agent or lawyer in your country or in the country of interest. Some national/regional IP Offices maintain lists of registered attorneys.</p> <p>In case it can be of assistance, WIPO provides various tools and e-services, among them the Global Brand Database. This database is a gateway to more than 41 million records from some 55 national and international collections, to search whether a mark similar or identical to yours already exists.</p>
	<p>Is there any time frame to file an international trademark using the Madrid System after the local filing? May I use the priority date from the local registry?</p>	<p>There is no time limit to apply for international registration. The international registration resulting from an international application will bear the date on which the international application was received by your “home” IP Office (the Office of origin)</p> <p>Priority of an earlier filing may be claimed under Article 4 of the Paris Convention. That earlier filing will normally be the basic application or the application which resulted in the basic registration. WIPO will disregard any claimed priority date which is more than six months earlier than the date of the international registration.</p>
<p>Lisbon System https://www.wipo.int/lisbon/en/</p>	<p>What benefits an individual could get if his/ her product gets a GI tag?</p>	<p>Through the registration of their geographical indication (GI), producers acquire the legal means to prevent the use of their GI on products that would not comply with the mandatory product specifications (defined by the producers themselves) or that would originate in a different geographical area than the one specified in the product specifications.</p>

		<p>On a multilateral level, the Lisbon System for the International Registration of Geographical Indications, and the Geneva Act of the Lisbon Agreement in particular, offers a means of obtaining protection for a GI in multiple foreign markets through a single registration and one set of fees. Further information on the main provisions and benefits of the Geneva Act of the Lisbon Agreement is available at https://www.wipo.int/edocs/pubdocs/en/wipo_lisbon_flyer.pdf</p> <p>Regarding the socio-economic aspects of securing GI protection, the following potential benefits have been identified over time:</p> <ul style="list-style-type: none"> • Benefits for the producers: product differentiation in competitive markets, improved livelihood (quality GI products can be sold at a premium price) • Benefits for the consumers: access to reliable information on the origin of the product/ traceability (consumers are able to make an informed decision when purchasing a product) • Benefits for rural areas: stimulate local development (participation of local actors, employment, improve level of income) • Benefits for regions and countries: positive spillover effects (tourism, additional income, improved reputation of a region and its products)/ contribute to preserve traditions and folklore
	<p>What prospects are there that the membership of the Lisbon system may grow in the medium term?</p>	<p>Several new accessions are expected before the end of 2020, and a continuous growth of the Lisbon System over the next few years can be reasonably anticipated as a result of the increased flexibilities provided by the Geneva Act of the Lisbon Agreement (i.e. extension of the international protection to GIs in addition to appellations of origin (AOs), recognition of different national protection systems for AOs and GIs, possible accession of intergovernmental organizations, etc.) A steady expansion of its geographic coverage can already be observed following the accession of both individual States and intergovernmental organizations.</p>

	Does the Lisbon system on GIs require a registration in each other country where it should be valid?	<p>In order to qualify for registration at the International Bureau of WIPO under the Lisbon System, an appellation of origin or geographical indication must already be protected at the national level, in the country of origin.</p> <p>The Lisbon System is designed to help ensure that holders of appellations of origin and geographical indications can file a single application and pay one set of fees to seek protection in multiple jurisdictions. An internationally registered appellation of origin or geographical indication can be protected in all the countries of the Lisbon System through a single procedure with the International Bureau of WIPO. Separate, individual registrations in each country of the Lisbon System are therefore not necessary.</p>
	Is there a GI office in the US?	The competent authority on industrial property matters, including GI-related issues, in the United States is the United States Patent Office (USPTO). Their website provides comprehensive information on Geographical Indication Protection in the United States and geographical indications in general.
Hague System - Industrial Designs https://www.wipo.int/hague/en/	Can you give an example of costs for design protection using the Hague system?	Please refer to the Hague Fee Calculator and the Schedule of Fees .
	Will China participate in the Hague agreement for International Design registration? If yes, when is it expected?	Yes, China has already announced that it is seeking accession to the Hague System. We anticipate that it will happen sometime in 2020-2021.
	How many designs can be included in an international application?	You can include up to 100 industrial designs per application. If more than one design is included in the international application, all the designs must belong to the same class of the Locarno Classification .

	<p>What is the term of protection of an international registration?</p>	<p>The total minimum duration of protection is 15 years under the Hague System and many Members of the Hague System provide for a maximum duration of protection well beyond 15 years (consult maximum duration of protection for each Contracting Party). The term of protection is effected in periods of five years counted from the date of the international registration. An international registration is therefore renewable for one or more additional terms of five years, in respect of each designated Contracting Party, up to the expiry of the total duration of protection allowed by those Contracting Parties' respective laws.</p>
	<p>How can I receive information on recent developments in the Hague System?</p>	<p>By subscribing to the Hague News alert service.</p>
	<p>What mechanisms to solving conflicts arising from a protected design offer the Hague System?</p>	<p>Any conflict or legal case in relation to a protected design covered by an international registration under the Hague System is subject to and may be resolved in accordance with the legal and regulatory framework, including established procedures, of the relevant jurisdictions in which protection has been granted. There is no centralized mechanism to raise and solve such conflicts in the International Bureau of WIPO.</p>
	<p>What advice would you give to small businesses that are looking to do research on the existing industrial designs currently registered with WIPO?</p>	<p>WIPO's Global Design Database (GDD) is a very useful tool for any research concerning industrial designs protected by an international registration under WIPO's Hague System (current and expired international registrations) as well as the registrations of some 30 participating national offices, with more national offices in the pipeline to join the GDD.</p>
	<p>Can I get industrial design, trademark and copyright for one company logo?</p>	<p>As you may know, copyright, industrial design and trademark rights protect different subject matter and are governed by different rules on ownership, registration, duration and infringement. In addition, the possibility of cumulative protection depends on the applicable legislation in each country.</p> <p>Furthermore, the scope of protection of those rights differ from one another.</p>

		<p>Copyright protects literary and artistic works (i.e., the creative expression of ideas) and subsists for a finite period, after which the work falls into the public domain where it can be used by anyone.</p> <p>The protection of a design covers the ornamental or aesthetic aspect of a product, and as such must meet, among others, the requirements of novelty or originality. Industrial design rights are granted for a limited period, determined by national law (generally between 10 and 25 years) and under the Hague System (ie., for all countries covered by the Hague System), the maximum duration of protection is at least 15 years.</p> <p>A trademark is a sign that serves to distinguish products or services of one undertaking from those of others, and should therefore have distinctive character in relation with those goods or services. Trademark protection can be indefinite, as long as the registration is renewed.</p> <p>For further information, you can consult the following pages on the WIPO website, respectively on copyright, industrial designs and trademarks: https://www.wipo.int/copyright/en/, https://www.wipo.int/designs/en/faq_industrialdesigns.html and https://www.wipo.int/trademarks/en/, or contact an intellectual property lawyer or the national intellectual property office(s) in the country(ies) of your interest.</p>
	<p>I am, as the industrial design holder, interested in the reproduction licence of the industrial designs being in my property. I have got the prototypes of the products designed with all rights. How could I give a licence for the reproduction of the prototype to a manufacturer safely ?</p>	<p>Design rights are territorial and therefore, the conditions for registering designs, as well as the scope of the rights conferred are determined by the applicable legislation and practice of each country. (The Hague System for the International Registration of Industrial Designs is an international procedural mechanism, meaning, it is concerned with the formal requirements relating to an international application for registration.)</p> <p>Therefore, we would suggest that you contact an industrial property lawyer in your country, in order to obtain detailed advice as to the possibility and requirements for licensing design rights.</p>

<p>WIPO Mediation, Arbitration, and Domain Name Dispute Resolution</p> <p>https://www.wipo.int/amc/en/</p> <p>https://www.wipo.int/amc/en/domains/</p>	<p>As the GDPR has made the registrant name extremely difficult to be found, how can a UDRP case be started, considering that the identity of the adversarial "target" is unknown?</p>	<p>The WIPO Center makes available online a Q&A on the “Impact of Changes to Availability of Whols Data on the UDRP”, which provides informal guidance on this subject. See in particular the first two questions and answers at: www.wipo.int/amc/en/domains/gdpr/</p>
	<p>Please explain some initiatives taken by WIPO to provide input on the protection of trademarks in the Domain Name System and the domain name dispute resolution process.</p>	<p>A starting point for such initiatives would be the Final Report of the First WIPO Internet Domain Name Process. www.wipo.int/amc/en/processes/process1/report/summary.html. The WIPO Center also makes available online “Selected Correspondence with ICANN”, which highlights policy work in this area. www.wipo.int/amc/en/domains/resources/icann/</p>
	<p>When the domain name is not similar to a trademark (first element of UDRP is not available), but the trademark is severely infringed in the content of the website itself, what actions might be taken through WIPO Arbitration and Mediation Center?</p>	<p>Where there is no standing to file a UDRP case, a court of competent jurisdiction is an alternative; brand owners may also turn to webhosts, ISPs, registrars, and sometimes seek to communicate directly with the registrant.</p>
	<p>Is it possible now to file a complaint claiming the transfer of a cTLD and a gTLD if the complainant is the same person and on the basis of the same trademark?</p>	<p>Where a ccTLD has adopted the UDRP, those domain names may be consolidated with gTLD and other ccTLD domain names against a single registrant in a single UDRP complaint – this may result in significant cost savings.</p> <p>ccTLDs adopting the UDRP include .ag, .ai, .as, .bm, .bs, .bz, .cc, .cd, .co, .cy, .dj, .ec, .fj, .fm, .gd, .gt, .ki, .la, .lc, .md, .me, .mw, .nr, .nu, .pa, .pk, .pn, .pr, .pw, .ro, .sc, .sl, .so, .tj, .tt, .tv, .ug, .ve, .vg, and .ws.</p> <p>General ccTLD information is available at: https://www.wipo.int/amc/en/domains/cctld/.</p>

	<p>Why is the procedure more expensive for domain name holders than negotiating with the squatters? Often, trademark owners are advised to negotiate with the squatters and repurchase it from them.</p>	<p>The strong case filing levels under the UDRP would seem to indicate that where there is obvious infringement, many brand owners find value in a public UDRP decision also to deter future infringers. At the same time, in some cases, some brand owners are able to negotiate quickly with a registrant for an acceptable fee.</p> <p>(Where a trademark also corresponds to a dictionary term and there is no infringing content on the webpage, the UDRP is not seen as the appropriate vehicle for acquiring a domain name.)</p>
	<p>How can I be a WIPO mediator or arbitrator?</p>	<p>Applicants for the WIPO List of Mediators and Arbitrators can send a message to the Arbitration and Mediation Center (arbiter.neutrals@wipo.int) noting their interest in a covering message and providing an updated CV that details their professional experience in IP and technology, as well as in mediation and/or arbitration.</p>
	<p>What is the cost for an arbitration or a mediation session? How is it adjusted?</p>	<p>The Arbitration and Mediation Center believes that mediation and arbitration should be cost effective. In consultation with parties and the mediator or arbitrator, the WIPO Center ensures that fees charged in a WIPO procedure are appropriate in light of the circumstances of the dispute.</p> <p>For detailed information on the costs of WIPO ADR procedures, you may wish to consult Schedule of Fees and Costs of WIPO Mediation and Schedule of Fees and Costs of Arbitration/Expedited Arbitration. A 25% reduction on the WIPO Center's registration and administration fees applies if a party (or both parties) to the dispute is (are) named as applicant or inventor in a published PCT application, holders of international registrations under the Hague system or the Madrid system, or WIPO Green technology providers or seekers.</p> <p>The WIPO Center also offers a fee calculator for current and prospective parties to estimate fees and costs for mediation, arbitration, expedited arbitration or expert determination cases filed with WIPO.</p>
	<p>How can I make a request for WIPO unilateral mediation?</p>	<p>In the absence of a mediation agreement between the Parties, pursuant to Article 4 of the WIPO Mediation Rules, a prospective party may</p>

		<p>complete sections 1 and 2(a) of the Request for Mediation, in particular the responding party's contact information, and submit it to the WIPO Arbitration and Mediation Center at arbiter.mail@wipo.int.</p> <p>Alternatively, a unilateral Request for Mediation may be submitted online using the WIPO IP Portal forms. Upon submission, the WIPO Center will assist the other party to consider the Request for Mediation and to understand the mediation procedure.</p> <p>The filing of a Unilateral Request for Mediation is not subject to an administration fee. If the parties agree to continue with the mediation process, the administration fee required by Article 22 of the WIPO Mediation Rules and the Schedule of Fees and Costs will be applicable.</p> <p>For further information, you may wish to consult WIPO Mediation Case Filing Guidelines. Another great source of information is the Guide to WIPO Mediation. https://www.wipo.int/edocs/pubdocs/en/wipo_pub_449_2018.pdf</p>
	Where can the mediation or arbitration take place? In different countries/languages?	<p>One of the fundamental advantages of ADR procedures is the significant control that the parties have over the proceedings.</p> <p>WIPO ADR procedures are open to any person or entity, regardless of nationality or domicile. Meetings or hearing in the course of the procedure may be held anywhere in the world, in any language, and under any law chosen by the parties.</p> <p>Furthermore, parties and neutrals in WIPO cases may agree to hold meetings or hearings remotely via online tools, including videoconferencing facilities, lending to further time and cost efficiencies.</p>
	Does WIPO offer ADR Courses?	<p>We invite you to check the WIPO Academy Distance Learning Program, in particular DL-317 (Arbitration and Mediation Procedure under the WIPO Rules). Provided in several languages, demand for the course has been high.</p>
WIPO Global Databases	Does WIPO keep track of search strings used in WIPO databases?	<p>What you search in WIPO Global Databases is confidential and stays between WIPO and you. WIPO does not keep track of search strings.</p>

https://www.wipo.int/global ip/en/		
	Is it possible to search and specify different technologies and technical domain?	In PATENTSCOPE you can search free of charge the different technologies using keyword as well as patent classification in order to specify a technical domain of interest.
	Is it possible to structure search In chemical search?	It is possible with a dedicated button for search by structure.
	How to search for existing patents in particular area, country wise or specific area wise e.g. agriculture or fisheries?	You can define the collection/s you would like to search in by using a dedicated field or by selecting the collection. You can then use the IPC and/or keyword to limit to a specific field.
	Is mobile application available for WIPO Services?	There is no specific mobile application but the database webpage adapts to the size of the screen of your device.
	What's the level of reliability of those databases? Is research made by the databases accurate or do I need to extend the research using other databases such as the EUIPO databases for example?	For all databases, you can check the content to make sure the collection and the exact date of the coverage is covered. The collection of EUIPO is included in the Global Brand Database .
	Can we find information about how patents are related to one another (claim priority) through a computer-to-computer connection?	Family information is available in PATENTSCOPE .
	Is there any TM search facility available under the Madrid System?	You can use the Global Brand Database to search for trademarks registered under the Madrid System.
WIPO IP Portal https://ipportal.wipo.int/	It seems that there are many functionalities provided through the IP Portal such as the widgets and the messages inbox. Where can I find guidance on how to use these functionalities?	If you click on HELP in the black navigation bar on top of the IP Portal page https://ipportal.wipo.int/ you may find detailed information about the functionalities under the About and FAQs pages. However, if you still have questions about the IP Portal we will be happy to hear from you. Please fill in the form you may find in the Contact Us page under HELP.
	Do I have to log out from one application in order to visit another	Once you have logged in to the IP Portal or any of the integrated applications there is no reason to log out if you want to visit another

	application (e.g. proceed with payments)?	application. The navigation among applications is possible if you click on the MENU which is available in the black navigation bar on top of the page https://ipportal.wipo.int/ .
	How easy is it to create a WIPO account?	The creation of a WIPO account is very easy and is free of charge. You can click on “Create WIPO Account” button in the landing page of the IP Portal https://ipportal.wipo.int/ and provide your user information. It will take only 2 minutes and it will provide great value since you will be able to navigate around all the WIPO applications, access additional features when searching the databases and make full use of the IP Portal functionalities.
	Can you clarify if all the WIPO services are available through the IP Portal?	Currently, more than 40 WIPO applications are available through the IP Portal providing access to the majority of WIPO IP services. You may find the list of available IP services if you click on the MENU in the black navigation bar on top of the page https://ipportal.wipo.int/ . IP Portal is being continuously improved in order to include the complete list of IP services. We will keep our customers informed, through our Newsletters, about all the additional services included.
	What is the benefit of using the widgets? Do they replace the actual IP services?	Currently, there are more than 15 available widgets in the IP Portal’s dashboard. The benefit of these widgets is that they provide quick access to your information, such as payment transactions or allow you to perform some basic tasks, like searches. Additionally, there are some generic widgets, such as the world clock in which you can add multiple clocks in different time zones, or the latest news, where you may find all the news shared through the available communication sources. For more information about the use of each widget please add one in your dashboard and select “How to use” from the Settings. Please note that the widgets do not replace the IP services. They present summary information from the existing IP services and provide you with a quick entry point into the services.

