

World Intellectual Property Organization

Guide to WIPO Services



HELPING YOU

protect inventions, trademarks & designs

resolve domain name & other IP disputes



The World Intellectual Property Organization offers a wide range of global IP services. They provide a highly efficient, fast and cost-effective means of helping innovators and creators – both corporate and individual – protect their inventions, trademarks and designs in multiple countries, and also resolve their IP disputes, including those involving domain names.

This brochure offers a brief overview of these global services. Further information and contact details can be found at www.wipo.int.

THE PCT SYSTEM

SET UP UNDER WIPO'S PATENT COOPERATION TREATY (PCT), THE PCT SYSTEM ALLOWS USERS TO SEEK PATENT PROTECTION SIMULTANEOUSLY IN A LARGE NUMBER OF COUNTRIES BY FILING A SINGLE INTERNATIONAL APPLICATION.

FILING UNDER THE PCT SYSTEM POSTPONES THE NATIONAL PATENT GRANTING PROCEDURE, IN THE MAJORITY OF CASES, BY UP TO 18 MONTHS ON TOP OF THE NORMAL 12-MONTH PRIORITY PERIOD. PAYMENT OF THE FEES AND TRANSLATION COSTS ASSOCIATED WITH NATIONAL PATENT APPLICATIONS IS SIMILARLY DELAYED. AT THE END OF THAT PERIOD (OF USUALLY AT LEAST 30 MONTHS FROM THE FILING DATE OF THE EARLIEST PRIORITY APPLICATION), APPLICANTS SHOULD HAVE RECEIVED IMPORTANT VALUE-ADDED INFORMATION THAT HELPS THEM TO BETTER UNDERSTAND THE POTENTIAL PATENTABILITY OF THEIR INVENTIONS AND THUS TO DECIDE WHETHER AND WHERE TO SEEK PATENT PROTECTION. THE SYSTEM IS WIDELY USED BY APPLICANTS TO KEEP THEIR PATENTING OPTIONS OPEN FOR AS LONG AS POSSIBLE.

PCT INTERNATIONAL APPLICATIONS

Anyone who is a national or resident of a PCT Contracting State may file an international application. Applications may be filed with the national patent office of the Contracting State of which the applicant is a national (or resident), with a competent regional patent office, or with WIPO. Generally, applicants first file a national (or regional) application with their national (or regional) patent office and, within 12 months from the priority date, an international application under the PCT.

The office with which the PCT application was filed transmits a copy of it to WIPO, which is responsible for:

- receiving and storing all application documents;
- performing a second formalities examination;
- publishing the application and related documents;
- translating the title and abstract of the international application and certain associated documents into English and/or French, where necessary;
- communicating documents to offices and third parties;
- providing legal advice on request to users; and
- providing PCT-related assistance to PCT members.

PCT INTERNATIONAL SEARCH

Within 16 months from the priority date, the PCT Regulations require that the international application be subjected to an international search, carried out by one of the competent International Searching Authorities (ISA) under the PCT. These are national or regional patent offices that have met certain qualifications and have been appointed by PCT Contracting States to perform this function. The resulting International Search Report (ISR) provides a listing of all documents considered relevant to the invention's patentability. The ISA also issues a non-binding written opinion containing an analysis of the potential patentability of the invention in the light of the search report results.

Both the ISR and written opinion are communicated to the applicant and WIPO. Applicants pay a search fee that varies depending on the ISA chosen. Where the content of the report and opinion suggests the granting of a patent is unlikely, the applicant may decide to withdraw or amend the application. The international application, ISR and any amendments are published by WIPO 18 months after the priority date. At that point, the claimed invention is disclosed in the public domain.

PCT SUPPLEMENTARY INTERNATIONAL SEARCH

Before the expiration of 19 months from the priority date, the applicant has the option to request a Supplementary International Searching Authority (SISA) (an ISA willing to offer this service) to carry out an additional search of relevant documentation, specifically focusing on documents in the particular language in which that authority specializes. The goal of this additional search is to reduce the likelihood of further documents coming to light in the national phase that would make granting the patent unlikely.

PCT INTERNATIONAL PRELIMINARY EXAMINATION

Applicants can request an optional international preliminary examination (IPE) within 22 months from the priority date. This provides a second evaluation of the potential patentability of an invention during the international phase, typically most useful when an applicant wishes to have the potential patentability of an amended application reviewed. At about 28 months from the priority date, the International Preliminary Examining Authority (IPEA) (all ISAs also act as IPEAs) sends the applicant its opinion on potential patentability. Fees for preliminary examination vary across IPEAs.

FEES

Applicants are required to pay an international filing fee, with a reduction for filing electronically. A 90 percent reduction in the international filing fee, as well as an exemption from the transmittal fee payable to WIPO when the application is filed with it, is available to certain applicants. The international search,

supplementary international search and international preliminary examination all have associated fees.

PCT NATIONAL PHASE

PCT applications do not result in issuance of “international patents”, and WIPO does not grant patents. The decision whether to confer patent rights remains in the hands of national and/or regional patent offices, and patent rights are limited to the jurisdiction of the patent granting authority.

Applicants opting to proceed further, therefore, must enter the national/regional phase, usually within 30 months from the priority date. In addition to paying the official patent office fees, the applicant may need to submit a translation of the application, appoint a local agent and comply with certain national requirements. The national/regional offices then begin the granting procedure according to their national laws and ultimately decide whether to grant patent rights for the claimed invention, taking into account the PCT search, supplementary search and preliminary examination results.

Additional information on PCT services, including the various fees involved in the application procedure, is available at: www.wipo.int/pct/en/

PATENT INFORMATION PRODUCTS

- **THE PATENTSCOPE SEARCH SERVICE** – Provides free and easy access to more than 2 million patent applications disclosed through the PCT system since 1978 (free of charge).
- **PATENTSCOPE WEB SERVICE** – Automated download of published PCT application data on the publication date (cost: CHF 1,200 per year).

ULTIMATELY, THE PCT:

- brings the world within reach;
- postpones the major costs associated with international patent protection;
- provides a strong basis for patenting decisions; and
- is used by the world’s major corporations, research institutions and universities to seek international patent protection.

THE MADRID
SYSTEM FOR THE
INTERNATIONAL
REGISTRATION
OF MARKS

WITH MORE THAN 100 YEARS OF EXPERIENCE, THE MADRID SYSTEM HAS HELPED BUSINESSES ESTABLISH MORE THAN A MILLION MARKS WORLDWIDE. IT ALLOWS AN APPLICANT TO APPLY FOR A TRADEMARK IN ANY – OR MANY – OF THE COUNTRIES (OR THE ORGANIZATION) PARTY TO THE MADRID SYSTEM, BY FILING A SINGLE APPLICATION AT A NATIONAL (OR REGIONAL) TRADEMARK OFFICE OF A MEMBER OF THE SYSTEM. THIS DOES AWAY WITH THE NEED TO FILE MULTIPLE APPLICATIONS AT MULTIPLE TRADEMARK OFFICES. IT ALSO FACILITATES THE SUBSEQUENT MANAGEMENT OF THE MARK, AS CHANGES OR RENEWALS CAN BE RECORDED THROUGH A SINGLE PROCEDURAL STEP.

To use the Madrid system, a trademark applicant must have a connection with a country or organization party to it through:

- a real and effective industrial or commercial establishment;
- domicile; or
- nationality.

Applications for international registration are filed with the trademark office of the territory concerned, the office of origin, which then certifies and forwards the application to WIPO. WIPO examines international applications for conformity with formal requirements and, for those that do comply, the mark is recorded in the International Register of the Madrid system and published in the (electronic) *WIPO Gazette of International Marks*. WIPO then notifies the trademark offices of all countries (or regions) designated in the international application, and those offices carry out the substantive examination leading to confirmation or rejection of the international registration, according to domestic legislation, within a prescribed period of 12, or sometimes 18, months.

A registration recorded in the International Register may have the same effect as one made directly with each designated Contracting Party if no final refusal is issued in any of the jurisdictions concerned. It may subsequently be maintained in force indefinitely by paying the prescribed fees, every 10 years, to WIPO. The scope of an international registration may subsequently be extended through the same procedure by designating additional members of the Madrid system.

The Madrid Protocol provides for a link between the international registration system and the European Community Trade Mark system. Thus, it is possible to use the Madrid system to also obtain trademark protection under the Community Trade Mark system by designating the European Union.

MADRID SYSTEM ONLINE SERVICES

The services and tools available, free of charge, on WIPO's website (www.wipo.int/madrid/en/) include:

- an international application simulator;
- a fee calculator (for applicants whose country of origin is a least developed country (LDC), the basic fee is reduced by 90 percent);
- *WIPO Gazette of International Marks* – online and pdf versions;
- an online database containing all international registrations currently in force or that have expired within the past six months;
- country fact sheets on national/regional intellectual property (IP) office procedures;
- online payment for some transactions and renewal of international registrations;
- **Madrid System Goods & Services Manager** – online tool to help trademark applicants compile the list of goods and services that must accompany an international application;
- **Madrid Real-time Status (MRS)** – provides the status in real time of trademark documents being processed by WIPO;
- **Madrid Electronic Alert (MEA)** – “watch” service designed to inform anyone interested in monitoring the status of certain international trademark registrations; and
- **Madrid Portfolio Manager (MPM)** – secure online access to applicants' international trademark portfolios.

The unique, flexible and cost-effective services offered by the Madrid system facilitate the registration and management of one mark or a large trademark portfolio, empowering businesses to expand their markets abroad.

ADVANTAGES OF USING THE MADRID SYSTEM

Trademark owners can register their marks in many, or some, of the countries party to the system by filing:

- a single international application;
- in one language (English, French or Spanish);
- subject to one set of fees and deadlines.

Thereafter, the international registration can be maintained and renewed through a single procedure.

RUSS-SUCHARD & C^{ie}, fabricants
NEUCHÂTEL (Suisse)



Chocolats et cacaos

La marque ci-dessus a été enregistrée en **Suisse**
le **1^{er} novembre 1880** sous le N^o **86**

>
*Suchard was the first international
trademark registered under
the Madrid Agreement Concerning
the International Registration
of Marks, in 1893.*

THE HAGUE
SYSTEM FOR THE
INTERNATIONAL
REGISTRATION
OF INDUSTRIAL
DESIGNS

THE HAGUE SYSTEM ALLOWS APPLICANTS TO REGISTER AN INDUSTRIAL DESIGN IN MULTIPLE COUNTRIES BY FILING A SINGLE APPLICATION WITH WIPO, THUS ENABLING DESIGN OWNERS TO PROTECT THEIR DESIGNS WITH A MINIMUM OF FORMALITY AND EXPENSE. THIS DOES AWAY WITH THE NEED TO FILE MULTIPLE APPLICATIONS AT NATIONAL OR REGIONAL IP OFFICES. IT ALSO FACILITATES THE SUBSEQUENT MANAGEMENT OF THE INDUSTRIAL DESIGN, AS CHANGES OR RENEWALS CAN BE RECORDED THROUGH A SINGLE PROCEDURAL STEP.

INTERNATIONAL APPLICATIONS

International applications must contain a reproduction of the industrial design(s) for which protection is sought and may include up to 100 different designs. All designs must, however, belong to the same class of the International Classification for Industrial Designs (the Locarno Classification). Applicants may choose to file in English, French or Spanish, and they can also file electronically.

Applicants for international design registration must:

- be a national of a Contracting Party,
- be domiciled in the territory of a Contracting Party, or
- have a real and effective industrial or commercial establishment in the territory of a Contracting Party.

Under the 1999 Act of the Hague Agreement, anyone habitually residing in a Contracting Party may also file an international application.

WIPO checks that international applications comply with the formal requirements, such as those relating to the quality of the industrial design reproductions and payment of the required fees. Three types of fees apply to international applications: a basic fee, publication fee and, for each designated Contracting Party, either a standard or an individual fee. Applicants from LDCs benefit from a 90 percent reduction in filing fees and standard designation fees.

International applications that comply with those requirements are recorded in the International Register. That registration is published in the *International Designs Bulletin* (IDB) – an electronic publication available on WIPO's website that contains all relevant data on international registrations, including a reproduction of the industrial design. International registrations are valid for an initial period of five years and may be renewed for additional periods of five years up to, in most cases, 15 years. Renewals may be made for all or some of the industrial designs included in the international registration and for all or some of the designated Contracting Parties.

WIPO does not examine applications for novelty of design. Upon publication of the registration in the IDB, the office of each designated Contracting Party proceeds with the substantive examination. An industrial design can be registered if it is new or original, and rights are limited to the jurisdiction of the authority with which the design has been registered. A Contracting Party can refuse to protect, in its territory, industrial designs that do not fulfill the substantive conditions for protection provided under its domestic legislation.

Additional information, including a schedule of fees and an automatic fee calculator, is available at: www.wipo.int/hague/en/

MANAGING INDUSTRIAL DESIGNS

A wide range of administrative and legal changes may be recorded in the International Register, such as:

- change in name and address of the holder;
- change in ownership of the international registration;
- renunciation of industrial designs; and
- limitation of some of the industrial designs.

These changes may apply to any or all of the designated Contracting Parties.



Photo: Swatch

**WIPO
ARBITRATION
AND MEDIATION
CENTER**

THE WIPO CENTER SUPPORTS BUSINESSES, ASSOCIATIONS AND THEIR COUNSEL ON THE RESOLUTION OF IP DISPUTES OUTSIDE THE COURTS. IT PROVIDES ACCESS TO HIGH-QUALITY, EFFICIENT AND COST-EFFECTIVE ALTERNATIVE DISPUTE RESOLUTION (ADR) PROCEDURES UNDER THE WIPO MEDIATION, ARBITRATION, EXPEDITED ARBITRATION AND EXPERT DETERMINATION RULES, WHICH PARTIES MAY ADOPT BY INCLUDING A WIPO CLAUSE IN THEIR CONTRACT.

THE WIPO CENTER ALSO PLAYS A LEADING ROLE IN THE DESIGN AND ADMINISTRATION OF TAILOR-MADE DISPUTE RESOLUTION PROCEDURES, MOST PROMINENTLY THE UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (UDRP) – SEE BELOW.

WIPO CENTER PROCEDURES

The WIPO Center has a strong commitment to the business needs of ADR parties. It offers case administration for the following ADR procedures, which may also be combined:

- **Mediation** – An informal, confidential procedure in which a neutral intermediary, the mediator, assists the parties in reaching a settlement of the dispute. Mediation involves minimal risk and potentially significant benefits in the form of contractual settlement based on party interests.
- **Arbitration** – A binding procedure in which a dispute is submitted, by agreement of the parties, to one or more arbitrators whose decision is final and enforceable under arbitral law. This confidential procedure permits parties to choose the arbitrator(s) comprising the tribunal, as well as the applicable law, language and venue of the arbitration.
- **Expedited Arbitration** – An arbitration procedure carried out in a short time and at a reduced cost, involving a sole arbitrator unless the parties desire otherwise.
- **Expert Determination** – A procedure in which a technical, scientific or related business issue between the parties is submitted to one or more experts who make a determination on the matter. The determination is contractually binding, unless the parties agree otherwise.

The WIPO Center maintains a detailed database of 1,500 independent arbitrators, mediators and experts (neutrals) from more than 70 countries, with further neutrals added to meet the specific needs of each case it administers. Cases submitted include both contractual disputes (e.g., patent and software licenses) and non-contractual disputes (e.g., patent infringement).

FACTORS FOR CONSIDERATION IN AN IP DISPUTE

Although IP disputes can be resolved through court litigation, parties are increasingly looking for private and internationally effective means of resolving them out of court. Arbitration and mediation allow parties to sidestep jurisdictional issues and resolve their disputes in a single neutral forum, while saving time and money.

COMMON FEATURES OF MANY IP DISPUTES

INTERNATIONAL

- ADR: Offers a single proceeding even where several jurisdictions are involved. The procedure and nationality of the mediator or decision-maker appointed can be neutral as to law, language and the institutional culture of the parties.
- *COURT LITIGATION: May involve multiple proceedings under different laws, with the risk of obtaining conflicting results. An actual or perceived home court advantage of a party litigating in its own country is also a consideration.*

TECHNICAL

- ADR: Parties to ADR proceedings can select neutral(s) with relevant expertise.
- *COURT LITIGATION: Decision-makers in court litigation may not have the relevant expertise.*

URGENCY

- ADR: Neutrals and parties can opt to shorten the procedure. WIPO arbitration may also include provisional measures and does not preclude seeking court-ordered injunctions.
- *COURT LITIGATION: Procedures are often drawn-out. Injunctive relief is, however, available in certain jurisdictions.*

FINALITY OF DECISION

- ADR: Proceedings have limited appeal options.
- *COURT LITIGATION: Offers the possibility of appeal.*

CONFIDENTIALITY, TRADE SECRETS AND RISK TO REPUTATION

- ADR: The proceedings, settlement and award are all confidential.
- *COURT LITIGATION: Proceedings are public.*

WIPO DOMAIN NAME DISPUTE RESOLUTION

The WIPO Center is internationally recognized as the leading dispute resolution service provider for challenges related to abusive registration and use of Internet domain names, a practice commonly known as “cybersquatting.”

The UDRP is the principal domain name dispute resolution policy administered by the Center. Based on recommendations made by WIPO, the UDRP provides trademark owners worldwide with an effective administrative transfer remedy against clear cases of bad-faith registration and use of domain names infringing on their rights. This concerns all international domains and a growing number of country code domains.

This two-month, WIPO procedure involves cost-effective services such as model pleadings, online filing and communication, and a free legal index. Cases are decided by panelists appointed by the Center or by the parties from a special WIPO list. Transfer decisions normally are implemented directly by domain name registrars. Interested persons may subscribe through the WIPO Center’s website to receive a daily notification of newly published decisions.

WIPO’s paperless UDRP procedure removes the requirement for mandatory filing and notification of paper pleadings, reducing the time and cost involved in submitting UDRP filings and saving up to one million pages of paper per year.

WEB INFORMATION

The Center’s website (www.wipo.int/amc/)

- contains guides and models for its procedures, as well as the WIPO Clauses and Rules in different languages;
- offers constantly updated information on the Center’s activities; and
- allows interested parties to register for Center events or to subscribe to its electronic newsletters.



For more information contact WIPO at
www.wipo.int

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