

MADRID AGREEMENT AND PROTOCOL
CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

EXPLANATORY NOTES ON THE OFFICIAL APPLICATION FORM MM2
APPLICATION FOR INTERNATIONAL REGISTRATION
GOVERNED EXCLUSIVELY BY THE MADRID PROTOCOL
(Rule 9 of the Common Regulations)

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EXPLANATORY NOTES FOR COMPLETION OF OFFICIAL INTERNATIONAL APPLICATION FORM MM2

1. This document aims to facilitate the completion of the official application form MM2 for the international registration of trademarks under the Madrid system. The form must be completed legibly, and handwritten forms are not acceptable to the International Bureau of WIPO. If an Office decides to produce its own self-generated version of the official form, such document must include the same content, format and numbering as the official form MM2. The final layout and spacing of self-generated forms may be modified to take account of the particular circumstances (for example, the inclusion, in sequential order, of the particulars of more than one single applicant).

Language of the International Application

2. The international application may be in English, French or Spanish, according to what is prescribed by the Office of origin. That is, the Office of origin is entitled to restrict the choice of the applicant to just one language, or to two languages, or indeed, the Office may permit the applicant to choose between any of the three languages. Thus, the applicant should ascertain from the Office of origin which language or languages must or may be utilized, in advance of the filing of the application through that Office.

3. If the requirements concerning language are not complied with, an international application will not be considered as such and will be returned to the sender.

4. The application form contains two boxes at the top of the first page. The box on the top left side may be used to indicate firstly, the number of additional continuation sheets (for example, if there is a long list of goods and services in item 10 of the form), and secondly, to indicate the number of forms MM17 that may have been sent with the application form. (MM17 is the form that is used to file a claim of seniority in the event that the international application includes a designation of the European Union (see paragraph 104 below)).

APPLICATION FORM

Item 1: Contracting Party whose Office is the Office of Origin

5. The Office of origin is the Office of the Contracting Party through which the applicant derives entitlement to file the international application. It is the Office in which the basic application will have been filed or the basic registration will have been recorded.

6. The name of the State whose Office is the Office of origin should be given in item 1 – for example, “China”. If the Office of origin is the Office of the intergovernmental organization which is the European Union, then the indication “European Union” should be given.

7. If there is more than one applicant, the name of only one Contracting Party should be indicated as the Contracting Party whose Office is the Office of origin. However, each applicant should be eligible or qualify, with respect to that Contracting Party, to file the international application through the Office in question (see paragraph 14 below).

Item 2: The Applicant

Name

8. Where the applicant is a natural person, the name to be indicated is the family (or principal) name and the given (or secondary) name(s) of the natural person as customarily used by that person and in the order in which they are customarily used. Where the applicant is a legal entity, its full official designation must be given.

9. Where the name of the applicant is in characters other than Latin characters, the name must be indicated as a transliteration into Latin characters, following the phonetics of the language of the international application. Where the applicant is a legal entity, the transliteration may be replaced by a translation into the language of the international application.

Address

10. The address of the applicant must be given in such a way as to satisfy the customary requirements for prompt postal delivery. Where no address of a representative is given in item 4, all communications will be sent to the address of the applicant given in item 2(b).

11. In addition, in item 2(d), telephone or facsimile numbers and an e-mail address may be given. The numbers or e-mail address given should be those of the person whom the International Bureau should contact when it needs to get in touch with the applicant.

Address for Correspondence

12. Where the applicant requires that communications be sent to an address other than that indicated in item 2(b), an address for correspondence may, at the option of the applicant, be indicated in this space. Otherwise, the field “Address for correspondence” should be left blank. An example of where it may be appropriate to indicate an address for correspondence may be the case where the international application is being filed by the in-house counsel of a company, and the company’s address may differ from the address used by the in-house counsel.

13. NOTE: if it is intended to appoint a representative and thus to have all communications addressed to such representative, it is not correct to indicate the particulars of such representative in item 2(c) “*Address for correspondence*”. The appointment of a representative is achieved by completing item 4, which is discussed below.

Several Applicants

14. Two or more applicants may jointly file a single international application, provided that the basic application or the basic registration is jointly owned by them. Each of the applicants will be required to have entitlement to file (see Item 3: “Entitlement to File”) with the Contracting Party whose Office is the Office of origin, which will be indicated in item 1 of the form. However, it is not necessary that the nature of the particular connection be the same for each applicant. Thus, Applicant 1 may be a national of the State which is the Contracting Party whose Office is to be the Office of origin, Applicant 2 may be domiciled in that State, and Applicant 3 may have a commercial establishment in that State. See also paragraph 7, above.

15. Where there is more than one applicant, the name and address of each applicant should be given, if necessary using a continuation sheet.

16. Where the international application is jointly filed by two or more applicants with different addresses, and neither the name and address of a representative nor an address for correspondence has been indicated, communications will be sent to the address of the applicant first named in the international application. In the event that there are several applicants, it may therefore be useful to indicate a single address for correspondence in item 2(c). All correspondence will then be sent to that address.

Preferred Language for Correspondence

17. The applicant may (by checking the appropriate box) indicate whether he wishes to receive communications from the International Bureau in English, in French or in Spanish, regardless of the language in which the international application was transmitted from the Office of origin to the International Bureau. On the other hand, if the applicant simply wishes to receive communications from the International Bureau in the language in which the international application was filed, it is not necessary to check any box.

18. NOTE: this applies only to communications *originating from the International Bureau*; communications from Offices that are simply transmitted by the International Bureau, such as notifications of refusal, are sent in the language in which they are received from the Office in question.

Other Indications

19. It is not compulsory to complete this part of the international application form. Nevertheless, the indications which are provided for in this part of the form are required by a number of Contracting Parties and if such indications are omitted, the applicant will be likely to meet with a provisional refusal from those Contracting Parties. It is therefore advised that applicants complete this part of the form.

20. Where the applicant is a natural person, he may indicate the State of which he is a national.

21. Where the applicant is a legal entity, such as an incorporated body, the nature of the legal entity may be indicated, along with the name of the State in which it is incorporated or organized.

Item 3: Entitlement to File

22. Under the Madrid system, an applicant's entitlement to file an international application is constituted by nationality, domicile or real and effective commercial or industrial establishment in one of the States that is a Contracting Party of the system. In the case of the intergovernmental organization which is the European Union, an applicant must have the nationality of a Member State of the Union, or be domiciled or have a commercial or industrial establishment in the territory of the Union.

23. The interpretation of what may be considered nationality, domicile or real and effective commercial or industrial establishment is a matter for the law of the Contracting Party concerned and is not an issue that the International Bureau is competent to concern itself with. However, nationality is taken to include both natural persons and legal entities. In the case of a legal entity, its nationality, depending on national legislation, may be considered as the State in which the legal entity has been constituted or organized, or the place of their actual headquarters.

24. The term "real or effective commercial or industrial establishment" is taken to mean an establishment at which some commercial or industrial activity takes place, but it is not required that this be the principal place of business of the applicant. Thus, an applicant may have several real and effective commercial or industrial establishments in different States that are Contracting Parties to the Madrid system. In such case, the Office of any of those States may qualify as the Office of origin. However, it is considered that the existence, for example, of a mere warehouse would not constitute "real and effective" establishment.

25. It is a matter for the Office through which the international application is presented (the Office of origin) to decide whether it requires evidence as to the claimed entitlement of the applicant to file an international application. As far as the International Bureau is concerned, all that is required is that the applicant checks one of the four boxes in item 3(a). If the second box is checked (indicating entitlement by virtue of holding the nationality of a State which is a Member State of the European Union), the name of the State in question should be indicated.

26. If the applicant is in a position to claim entitlement by virtue of more than one type of connection, (through domicile, nationality or commercial or industrial establishment), with the Contracting Party whose Office is the Office of origin, as indicated in item 1 of the application form, then more than a single box may be checked accordingly by the applicant.

27. Item 3(b) is concerned with a particular situation. If the applicant has checked either the third or fourth box in item 3(a), indicating domicile or establishment in a given Contracting Party and, at the same time, in item 2(b) has indicated as his address an address which is not in the territory of the Contracting Party that has been indicated at the top of the form in item 1 (i.e., the Contracting Party whose Office is the Office of origin), then he is required, in item 3(b), to indicate the address of his domicile or establishment in that Contracting Party.

28. An example may clarify the matter. The applicant has indicated, in item 1, that the State through which he claims entitlement, and whose Office is therefore the Office of origin, is Germany. In item 2(b), he indicates as his address an address which is, for example, in Peru (as, of course, he is entitled to do). He then checks either box three (domicile in Germany) or four (establishment in Germany) in item 3. Given that the address indicated earlier is an address that is not in Germany, the applicant is therefore required to indicate, in item 3(b), an address, in Germany, which is his domicile or establishment in that State, as the case may be.

Entitlement to File Where There are Several Applicants

29. It has already been noted in paragraphs 7 and 14 above that two or more applicants may jointly file a single international application. In such case, information concerning the entitlement of each of the applicants must be supplied in accordance with item 3 of the application form. Unless a self-generated form is used, this information should be given on a separate continuation sheet.

Item 4: Appointment of a Representative

30. It is not necessary to appoint a representative before the International Bureau in order to file an international application under the Madrid system. If the applicant wishes to appoint a representative before the International Bureau, item 4 of the application form must be completed (see also paragraph 12, above regarding address for correspondence). If a representative before the International Bureau has been appointed, all communications from the International Bureau will be sent *only* to that representative.

31. The Madrid system does not provide for any requirement as to who may act as representative, in terms of professional qualification, enrolment, nationality, residence or domicile.

32. Indicating the particulars of the representative in item 4 of the application form is all that is required in order to constitute representation. It is not necessary to furnish to the International Bureau a power of attorney or any other supplementary documentation.

33. The information given in item 4 should be sufficiently clear to enable the International Bureau to send correspondence to the representative. Preferably, a telephone and fax number should be indicated, along with an email address.

34. If a partnership or firm composed of attorneys or agents is indicated in the application form as representative, only the partnership or firm itself will be recorded as representative. In other words, if the names of individual attorneys or agents are also included, they will not be considered or recorded as representatives.

35. The question of representation before the Office of origin, at the national level, or representation before the Office of a designated Contracting Party (for example, for the purpose of responding to a notification of provisional refusal that has been issued by such Office) are outside the scope of the provisions of the Madrid system and are regulated by the law and practice of each individual Contracting Party.

Item 5: Basic Application or Basic Registration

36. The particulars of the basic application or basic registration (“basic mark”) are required to be indicated in item 5 of the international application form.

37. If the basic mark is a registration in the Office of origin, its registration number and its date of registration should be indicated.

38. NOTE: where an international application is founded on a basic registration in the Office of origin, the applicant should not also indicate the particulars of the application which led to that registration. In other words, simply the particulars of the registration number and date should be indicated. If, at the same time, the applicant includes the particulars of the application which led to that registration, it is liable to cause confusion.

39. If the basic mark is an application, rather than a registration, in the Office of origin, its application number and its date should be indicated.

40. It is possible that an international application may be founded on more than one basic mark. In such case, the details of each of the basic marks should be indicated, as above. If there is not sufficient space, then (unless a self-generated form has been used) the basic mark with the earliest date should be indicated in item 5 and the remaining details should be indicated on a separate continuation page.

Item 6: Priority

41. The claiming of priority should not be confused with a claim of seniority, in the case of a designation of the European Union (EM) – see paragraph 104 below.

42. If an applicant wishes to claim priority, the box which has been included in item 6 should be checked by the applicant. The applicant should then indicate the name of the Office with which the earlier filing was made, along with the date of the earlier filing (in order to establish the validity of the claim by virtue of the non-expiry of the six month period). If the number of the earlier filing is available to the applicant, that should be indicated also.

43. NOTE: it is not necessary or appropriate to send to the International Bureau any documentation supporting a priority claim.

44. It is possible that a priority claim may arise from more than one earlier filing – the goods and services may have been different in the earlier filings, and it is now intended to file a single international application incorporating all the goods and services in a single international registration. In such case, the details of each earlier filing should be indicated and if there is not sufficient space, then (unless a self-generated form has been used) the necessary indications should be given on a separate continuation page, with the earliest date indicated in item 6. The applicant should also check the box indicating that more than one priority is being claimed.

45. It is possible also that an applicant may file an international application for certain goods and services, all of which may not be covered by the priority claim. Where that arises, the applicant is required to indicate in item 6 the particular goods and services that are in fact covered by the priority claim. If those goods or services correspond to all the goods or services specified in a given class in the international application form, then it will not be necessary to re-list the goods or services at this point. It will be sufficient to state, for example, “All goods in classes 9 and 12”.

Item 7: The Mark

46. An applicant is required to provide a reproduction of the mark for which international registration is being sought, and this is the subject matter of item 7 of the form.

47. The reproduction should be two-dimensional and graphic or photographic. It must be identical with the mark as it appears in the basic application or the basic registration. Thus, if the mark in the basic application or the basic registration is in black and white, so must the mark be in the international application. Likewise, if the basic mark is in color, so must be the mark in the international application.

48. The two boxes in item 7 of the form measure 8cm x 8cm, which is the standard size for publication of the mark in the *WIPO Gazette of International Marks* (the Gazette). Where an applicant uses a self-generated form, the reproduction must still comply with these size parameters. That is to say, the reproduction of the mark must be of a size that would fit within a box measuring 8cm x 8cm.

49. The reproduction of the mark should be sufficiently clear for the purposes of recording, publication and notification. If it is not, the International Bureau will treat the international application as irregular and will inform the Office of origin and the applicant accordingly.

50. As to the format of the reproduction, it may be typed, printed, pasted or reproduced by any other means. This may often depend upon what is prescribed by the Office of origin. The mark will ultimately be published in the Gazette exactly in the format in which it has been presented.

51. If the Office of origin has sent the application form to the International Bureau by fax, it will still be necessary to send to the International Bureau the *original* of page 2 of the form, bearing the representation of the mark. Please note that, in such case, *only* page 2 should be sent and not the entire application form. If the entire application form is sent in such case, it may be confused as a new international application. When sending the original of page 2 in the above situation, sufficient indications should appear to enable the International Bureau to identify the

international application in question – for example, the number of the basic mark, or the Office reference number contained in the faxed international application. The Office should also sign the page 2 that is being sent. The Office should endeavour to ensure that the original of page 2 is sent to the International Bureau without delay, and preferably on the same day as the faxed international application is sent.

52. A box at the bottom of item 7 of the application form is required to be completed by the Office in cases where the Office is sending the original of page 2 in the circumstances just outlined.

53. Item 7 includes two boxes, side by side. In most cases, the representation of the mark will be contained in the left hand box, numbered (a) on the form.

54. A number of Offices do not provide for registration or publication in color. This is primarily the reason why the second box on the right hand side, numbered (b), has been included in the form. The only situation when it will be necessary to utilize box (b) will be where color was claimed as a distinctive feature of the basic mark (and thus must be claimed also in the international application), but the reproduction of the basic mark in box (a) is, for the reason indicated above, in black and white. In such case, the mark must be represented in color also, and reproduced in box (b). The Gazette will then include representations of the mark in black and white, and also in color, for the purpose of establishing the scope of the color claim.

55. If the mark is a non-traditional mark – for example, a sound mark, or a three-dimensional mark – the representation of the mark in box (a) that appears in the international application form should correspond with the mark as it appears in the basic application or the basic registration – it being understood that the representation must fit within the box in item 7 of the form. Thus, if, in the basic application or the basic registration, the representation of a three-dimensional mark is shown by a perspective view, that is how the mark should be represented in the international application form. If several views have been used to represent the basic mark, those representations should be included in the international application, up to a number such that the representation of the mark, within the box in item 7 of the form, will remain clear. If the basic mark is a sound mark, it may be represented in the basic application or the basic registration in the format of musical notation or a description in words. That then is how the mark should be represented in the international application form.

56. These representations of non-traditional marks may require to be supplemented by a description in item 9(e) of the form. Non-graphical representations – for example, a sound recording of a sound mark – must not be included with the international application.

Mark in Standard Characters/Figurative Mark

57. Item 7 of the international application form contains two boxes that may be checked by the applicant. The first of these is to indicate that the applicant declares that he wishes the mark to be considered as a mark in standard characters.

58. Generally, a mark that is in standard characters will be equivalent to a regular mark that is a word or words, or letters or numerals, or a combination of those elements, as opposed to a stylised or figurative mark, or a mark that is depicted in a special style, font or color, rather than in a uniform style. A word mark that is in a stylised script would not normally be considered as a mark in standard characters. A mark that contains special characters or stylised elements should not be claimed as a mark in standard characters.

59. The issue as to whether a mark is in standard characters is not always straightforward because of the different indications, such as accents, which may be standard in one language and not in another. It is therefore entirely up to each designated Contracting Party to decide what is the effect of an indication that a mark is in standard characters.

60. Where the box indicating standard characters has been checked and the mark is *clearly not* a mark in standard characters, the International Bureau will delete the indication of standard characters.

61. In this regard, a mark consisting of, or containing non-Latin characters or non-Arabic numerals will not be considered by the International Bureau as a mark in standard characters.

62. The International Bureau will assign a classification in accordance with the International Classification of the Figurative Elements of Marks (Vienna Classification) where the mark is not a mark in standard characters.

Mark Consists of a Color or of a Combination of Colors, as Such

63. In many jurisdictions, a color, as such, or a combination of colors may, in itself or themselves, function as a trademark, to differentiate goods and services of one enterprise from those of another. It is important to distinguish between marks that consist of a color, or colors, as such, and marks that may, for example, be word marks or stylised marks, or other non-traditional marks, that happen to *be* in color, as against being in black and white.

64. If an applicant wishes to file for the international protection of a mark that is a color, or combination of colors, as such, then he should place in box 7(a) a visual representation of the color and check box 7(d). An indication, in words, of the color(s) should also be given, in item 8(a). It will generally be required that the color or colors be indicated in a way that is clear, understandable, durable and easily accessible, and this is usually attained by the applicant indicating, by words, the color or colors in question, followed by a reference to an international color classification system, such as Pantone.

65. If the applicant wishes also to provide a description in words for the color(s) applied to the goods or used in relation to the services that are the subject of the application for protection of a mark that is a mark in color, as such, this should be done in item 9(e), which provides for a description of the mark.

Color Claimed

66. NOTE: the indication that the applicant claims color as a distinctive feature of the mark is not to be confused with a mark that *consists* of color, or of a combination of colors, *as such* (see above).

67. Item 8 provides for an indication, in box (a), that the applicant claims color as a distinctive feature of the mark. A color claim means that the applicant considers the color or colors to be an integral or essential part of the mark. If color is claimed, the box in item 8(a) should be checked by the applicant to indicate that he is claiming color as a distinctive feature of the mark, and the applicant should also indicate, in words, the color or colors claimed. In item 8(b), the applicant can further indicate, for each color, the principal parts of the mark that are in the color or colors concerned. In fact, this is a requirement in certain designated Contracting Parties, where the international application includes a color claim.

68. NOTE: in certain designated Contracting Parties, the very fact that the reproduction of the mark is *in* color will *require automatically* that color is claimed expressly, giving an indication, in words, of the color(s) concerned. In order to avoid receiving a notification of provisional refusal from such Contracting Parties, it may be advisable for applicants who are seeking protection for a mark that is in color(s), to include also in the international application a color claim by checking the box in item 8 and completing the remainder of item 8(a). Reference is made, for example, to Information Notice No. 4/2009, issued by the International Bureau (see paragraph 109 below) concerning designations of the United States of America (entitled *Tips for Holders of International Registrations Seeking Extension of Protection to the United States of America: Avoiding Provisional Refusals*) where a suggestion made by the USPTO was noted as follows:

“[...] The USPTO encourages the inclusion of a color claim whenever the mark is in color, along with an indication by words of the color(s) claimed and a description of where the color(s) appear(s) in the mark.”

69. Please refer to paragraph 54, above regarding the inclusion in box 7(b) of a reproduction of the mark, in color, where the reproduction of the mark in box 7(a) is in black and white and the applicant intends to make a color claim.

70. NOTE: if the mark contained in the international application is a color mark and the applicant does not claim color as a distinctive feature of the mark, that does not mean that the International Bureau will or may publish a black and white reproduction of the mark. The mark as published by the International Bureau will correspond to the mark that is in the international application, which in turn will correspond to the basic mark – that is to say, a reproduction in color.

Item 9: Miscellaneous IndicationsItem 9(a): Transliteration

71. Transliteration is not to be confused with translation. Where the mark consists of, or contains, matter in characters other than Latin characters, or numerals other than Arabic or Roman numerals, a transliteration into Latin characters or Arabic numerals must be provided. Transliteration is a phonetic representation of the mark in Latin characters, following the phonetics of the language of the international application. In simple terms, the mark, as it sounds, is reproduced in Latin characters. Transliteration is provided for in item 9(a) of the form.

Item 9(b): Translation

72. Where the mark consists of or contains words which may be translated, it is advisable, where possible, to provide such a translation. Provision for translation is made in item 9(b) of the form. The translation may be into English and/or French and/or Spanish, irrespective of the language of the international application. The provision of a translation, at the option of the applicant, may forestall requests for a translation by the Office of a designated Contracting Party. The International Bureau will not check the accuracy of any translation of the mark, nor will it question the absence of a translation or provide a translation of its own.

Item 9(c): Mark that Cannot be Translated

73. Where the applicant is aware that the word or words appearing in the mark cannot be translated (that is, they are merely invented or made-up words), this may be indicated by checking the box in item 9(c) of the form. This is intended to forestall a request by the Offices of designated Contracting Parties for translation. Obviously, it will be possible to complete either item 9(b) or 9(c), but not both in the same international application form.

Item 9(d): Special Type of Mark

74. Where the mark is a three-dimensional mark, a sound mark or a collective, certification or guarantee mark, this should be indicated by checking the appropriate box in item 9(d) of the form. Note that such an indication may be given only if it appears in the basic registration or basic application.

75. In the case of a collective, certification or guarantee mark, regulations governing the use of the mark are not required as part of the international application, and should *not* be sent to the International Bureau with the international application. A designated Contracting Party may, however, ask for such regulations to be filed. In order to forestall a refusal by such a Contracting Party, an applicant may wish to send the required documents directly to the Office of that Contracting Party as soon as he receives from the International Bureau the certificate of international registration.

Item 9 (e): Description of the Mark

76. Where there is a description included in the basic mark, the applicant may decide to include, or not, the same description in the international application. It may happen also that where there is a description in the basic mark, the Office of origin will *require* that the same description is contained in the international application form.

77. If the mark is not of one of the types of other marks provided for in the international application form (three-dimensional, sound mark or collective, certification or guarantee mark), then the space for a description may be utilized to elaborate on the nature of the mark – for example, it may indicate that the mark is a hologram or a motion mark. However, in such case, the description must still correspond with the description that is contained in the basic mark.

78. If the description of the basic mark is in a language which is not the language used in the international application, then it should be translated accordingly. The International Bureau will not concern itself with the accuracy of the description. Furthermore, if the description, as given, is not entirely in conformity with the mark as reproduced, in principle, the International Bureau will not question or query this either. The formulation of the description is dependent upon the description attributed to the basic mark, and is a matter for the applicant.

79. The International Bureau will not concern itself with the scope of the description, and will record and publish it as it is presented.

Item 9(f): Verbal Elements of the Mark

80. This item is not compulsory. The International Bureau captures (from the reproduction in item 7) what appears to it to be the essential verbal elements of the mark and this is used for internal administrative purposes. Primarily, it is used in notifications and correspondence in order to confirm the identity of the resulting international registration. However, where the mark is in special characters or in handwriting, there is a risk that the words or letters may be misinterpreted by the International Bureau. Moreover, where the mark contains a great deal of verbal matter (for example, where the mark consists of a label), it may not be apparent what should be captured. The applicant may therefore wish to indicate, in item 9(f) what *he* considers to be the essential verbal elements of the mark. Any such indication is, however, entirely for information and is not intended to have any legal effect.

81. This item should not be completed where the box in item 7, for standard characters, has been checked.

Item 9(g): Disclaimer

82. Where the applicant wishes to disclaim protection for any element of the mark, it should be done in this item of the international application form. The element or elements for which protection is disclaimed should be indicated.

83. The purpose of including this item is to forestall requests from designated Contracting Parties for such a disclaimer (for example, a disclaimer in respect of non-distinctive elements of a mark) to be included in the International Register. If however a disclaimer is included in the international application, it must be in respect of the international registration as a whole. A disclaimer cannot be made for only some of the designated Contracting Parties.

84. It does not matter if there was no corresponding disclaimer in the basic registration or basic application. Conversely, if there was a disclaimer in the basic registration or basic application, this does not make it obligatory to include it in the international application.

85. If a disclaimer is intended to concern some elements of a mark that are in characters or numerals that are non-Latin or non-Arabic, the applicant may indicate, for example, as follows:

“The first/second/third [...] verbal element appearing in the mark is disclaimed” or “the protection for the verbal elements appearing in the mark in the form of [...] is disclaimed”.

Item 10: Goods and Services

Item 10(a): Indication of Goods and Services

86. The goods and services for which the international registration of the mark is sought must be indicated in item 10. These must be grouped in the appropriate classes of the International Classification of Goods and Services for the Purposes of the Registration of Marks (the Nice Classification), each group being preceded by the number of the class, and presented in the order of the classes of that Classification. The goods and services must be indicated in precise terms, preferably using words appearing in the Alphabetical List of the Nice Classification. If necessary, a continuation sheet should be used and the appropriate box should be checked.

87. Class headings will be accepted by the International Bureau (although, not necessarily by the Contracting Parties that have been designated). The indication *All goods in class 9*, for example, will not be accepted by the International Bureau.

88. The list of goods and services in the international application may be narrower than the list in the basic registration or application. However, it may not be broader, or contain different goods and services. This does not mean that exactly the same terms must be used; the terms used in the international application must however be equivalent to, or fall within the scope of, those used in the basic registration or application.

89. Information concerning the Nice Classification can be found on the WIPO website at the following address: <http://www.wipo.int/classifications/nice/en/>.

Item 10(b): Limitation of the List of Goods and Services

90. A limitation is, effectively, a reduction in the scope of the protection, in terms of the list of goods and services, which the applicant is seeking in the international application. A limitation may take different formats and may be prompted for different considerations.

Example 1

91. For example, the main list of goods and services in the international application may include, say, classes 1 to 7 and the designation of ten Contracting Parties. The applicant may not wish to incur the expense of including all of the goods and services for all ten of the designated Contracting Parties. In item 10(b) he may therefore accordingly reduce the scope of coverage, for example in the following manner:

<i>Contracting Party</i>	<i>Class(es) of goods and services for which protection is sought</i>
<i>Australia</i>	<i>Classes 1, 4 and 5</i>
<i>Japan</i>	<i>Classes 1 and 5</i>

This will mean that for the remaining eight designated Contracting Parties, protection is being sought in all seven classes, and paid for accordingly, and for Australia and Japan, protection is being sought only for the goods and services indicated in item 10(b), i.e., classes 1, 4 and 5 and classes 1 and 5, respectively, and fees will be payable only for those classes.

Example 2

92. The example above concerns a limitation relating to entire classes of goods and services as requested under item 10(b). However, it may also be that the applicant wishes to retain the class, *per se*, but wishes to reduce, within the class, the scope of protection that he is seeking. He may, for example, have already ascertained that a third party has already obtained protection for a similar mark in respect of goods that are similar to those now intended to be included in the international application, and the applicant may wish to eliminate or reduce the risk of that third party opposing the new international application.

93. To take a simple example – assume that the applicant designates ten Contracting Parties and wishes to apply for registration in class 25 in respect of the following items of clothing:

Clothing of leather, clothing for gymnastics, clothing of imitations of leather, coats, cyclists' clothing and sports jerseys.

In item 10 of the international application form the applicant may limit the scope of the goods or services as follows:

In respect of the designation of China, protection is not sought in class 25 for the following:

Clothing for gymnastics.

94. The result will be that the international application will include the full scope of the goods in class 25 for the remaining nine designated Contracting Parties and will be reduced in accordance with the limitation, as far as the designation of China is concerned.

95. NOTE: when seeking a limitation which intends to exclude an entire class or certain indications from within a class, it is imperative that the applicant indicate with clarity and precision the goods and services that are affected by the limitation, in the sense that the International Bureau should be in a position to ascertain exactly the goods and/or services that are intended to be protected and the goods and/or services that are intended to be excluded.

Example 3

96. A third type of limitation is also possible. To take an example, assume that the applicant intends to apply for the protection of his mark in respect of “Clothing” in Class 25, and designates ten Contracting Parties, including, for example, the United States of America.

97. Users of the Madrid system will be aware that the Office of the United States of America has particular requirements in terms of the precision with which goods and services are indicated and that Office will not accept an indication such as “Clothing”. The Office will therefore notify a provisional refusal and will require that the items of clothing be indicated more particularly.

98. However, the applicant may wish to preserve the possibility of obtaining the widest possible coverage of goods in those other Contracting Parties where an indication such as “Clothing” is acceptable. In order to achieve this end, the applicant may simply limit the goods with respect to the designation of the United States of America by restricting or narrowing the indication in question, in the following manner:

In respect of the designation of the United States of America, protection is sought in class 25 for the following goods: shirts, coats and socks.

99. In this manner, the applicant will reduce the possibility of receiving a notification of provisional refusal from the United States of America, and at the same time will be in a position to obtain protection for the widest possible coverage of goods and services in the other designated Contracting Parties.

Item 11: Designated Contracting Parties

100. All that is required is to check the box corresponding to the Contracting Party or Parties in which it is intended to seek protection for the mark.

101. However, an applicant should pay particular attention to designations of Contracting Parties like the European Union, the United States of America, Ireland, Singapore, United Kingdom, Cuba, Ghana and Japan.

Designation of the European Union

102. Where the European Union is designated in an international application, the applicant should note footnote 1 in item 11 of the form. In this footnote, it is provided that the applicant must, in addition to the language of the international application itself, indicate what is known as a second working language before the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM). The indication of this second language must be chosen among one of the five official languages of OHIM, namely, English, French, German, Italian or Spanish. This second language serves exclusively as a language in which third parties may lodge opposition or cancellation proceedings before OHIM and it is not concerned in any way with the Madrid procedures, as such.

103. NOTE: if the indication of a second language has not been given by the applicant when there has been a designation of the European Union, the International Bureau will nevertheless proceed with the registration (everything else being in order) and in that case, a provisional refusal will be notified by OHIM and will have to be overcome directly before OHIM by the holder.

104. The second part of footnote 1 is also concerned with designations of the European Union and relates to claims of seniority. The concept of seniority is particular to the Community Trademark system and has been provided for also in the international application form, in relation to designations of the European Union. A claim of seniority should not be confused with a claim of priority under the Paris Convention – see item 6, above.

105. Under the Community Trademark system, the holder of a mark which has already been registered in a Member State of the European Union and who later applies for the registration of an identical mark as a Community Trademark, may claim what is called the seniority of that earlier mark in respect of the member State concerned. The effect of such a claim is that where the holder of the Community Trademark subsequently surrenders the earlier mark, or allows it to lapse, he is deemed to continue to have the same rights, in the member State concerned, as he would have had if the earlier mark had continued to be registered.

106. If an applicant wishes to claim seniority, he must file a separate official form, which is MM17, and this must be annexed to the international application form. Seniority claims on form MM17 received by the International Bureau after the receipt of the international application will be disregarded.

Designation of the United States of America

107. Footnote 3 of item 11 of the international application form is concerned with designations of the United States of America.

108. When the United States has been designated in an international application, the applicant is required by that Contracting Party to file also a declaration of intention to use the mark. A form (MM18) has been provided for this purpose and the declaration must follow exactly the wording of that form. The declaration is required to be in English, regardless of the language in which the international application is filed. Form MM18 should be annexed to the international application form.

109. If the United States of America has been designated in an international application and form MM18 has not been annexed to the international application form, this will constitute an irregularity, of which the applicant and the Office of origin will be informed by the International Bureau.

NOTE: the International Bureau has made available for users of the Madrid system two information notices concerning designations of the United States of America.

The first, entitled *Indications of Goods and Services: United States of America* (Information Notice No. 24/2003) may be found on the Madrid system website at the following address: http://www.wipo.int/edocs/madrdocs/en/2003/madrid_2003_24.doc.

The second, entitled *Tips for Holders of International Registrations Seeking Extension of Protection to the United States of America: Avoiding Provisional Refusals* (Information Notice No. 4/2009) is available at the following address: http://www.wipo.int/edocs/madrdocs/en/2009/madrid_2009_4.doc.

Designations of Ireland, Singapore and the United Kingdom

110. Ireland, Singapore and the United Kingdom also, in principle, require a declaration of intention to use the mark. However, it is not necessary to annex to the international application form a separate declaration for that purpose. As is made clear in footnote 2 of item 11 of the application form, the mere fact of designating any of those Contracting Parties is taken, *per se*, as comprising the required declaration of intention to use.

Designations of Cuba, Ghana and Japan

111. A fourth footnote to item 11 of the international application form is concerned with the three Contracting Parties, Cuba, Ghana and Japan. Each of these Contracting Parties, which all charge individual fees, has made a declaration to the effect that the individual fee is payable in two parts. Upon the designation of any of these Contracting Parties, only the first part of the individual fee will be payable at the filing stage and the remainder of the fee will be required to be paid only if the Office concerned is satisfied that the mark qualifies for protection. The Office will notify accordingly.

112. An applicant who takes advantage of the electronic fee calculator will be informed by the calculator that the fees indicated in respect of those three Contracting Parties consist only of the first part. The electronic fee calculator may be found at the following address on the Madrid system website: <http://www.wipo.int/madrid/en/fees/calculator.jsp>.

Item 12: Signature by the Applicant or his Representative

113. An applicant is not required to sign the international application form. However, the Office of origin may require or permit the applicant to do so. A signature may take the form of a seal, or may otherwise be handwritten, printed or stamped.

Item 13: Certification and Signature by the Office of Origin

114. The Office of origin must sign and date the international application form and must indicate the date on which it received the request to present the application to the International Bureau. The indication of the date of receipt is important because, as a rule, this will or may become the date of the international registration – provided that the international application is received by the International Bureau within the period of two months from its receipt by the Office of origin.

115. Item 13 of the application form takes the format of a certification of certain elements by the Office of origin. These elements should therefore be verified by the Office of origin, and are as follows:

- the date of receipt by the Office of origin;
- identity between the basic mark and the mark that is the subject of the international application;
- correspondence between the applicant in the international application and the holder of the basic mark;
 - that if it is asserted that the mark consists of a color, or combination of colors, as such (item 7(d) of the form), the same assertion has been made in respect of the basic mark;
 - that if the international application form contains an indication that the mark is three-dimensional, a sound mark, or a collective, certification or guarantee mark (item 9(d) of the form), the same indication appears with respect to the basic mark;
 - that if the international application form contains a description (item 9(e) of the form) the same description appears in the basic mark;
 - that if color has been claimed as a distinctive feature of the basic mark, the same claim is included in the international application form (item 8 of the form);
 - that if color has not been claimed in the basic mark and the applicant wishes to include such claim in the international application, the basic mark is in fact in the color or colors in question;
 - that the goods and services indicated in the international application form (item 10 of the form) are covered by the goods and services in the basic mark.

Fee Calculation Sheet

116. It only remains then to complete the Fee Calculation Sheet on page 7 of the international application form.

117. It is recommended that the applicant use the electronic Fee Calculator, which is available on the Madrid system website at the following address: <http://www.wipo.int/madrid/en/fees/calculator.jsp>.

118. The fees will always include what is known as the basic fee, which consists of either 653 Swiss francs for a mark in black and white, or 903 Swiss francs for a mark in color. This fee is for payment to the International Bureau. For applicants from Least Developed Countries there is a 90% reduction of this fee. For the list of those countries in question, applicants may refer to the official list maintained by the United Nations at the following address: www.wipo.int/ldcs/en/country.

119. In addition, the applicant will pay a standard fee of 100 Swiss francs for each designated Contracting Party (this is known as the complementary fee) and a further 100 Swiss francs for each class of goods and services after the first three (this is the supplementary fee).

120. A number of Contracting Parties have declared that, instead of the standard fee, they wish to receive what is called an individual fee. The amount of this fee, also expressed in Swiss francs, will vary from Contracting Party to Contracting Party and the details of those amounts are available on the Madrid system website at the following address: http://www.wipo.int/export/sites/www/madridgazette/en/remarks/ind_taxes.html.

121. Part (a) of the Fee Calculation Sheet contains a box which should be checked when the applicant wishes that the amount of the fees be debited from a current account with the International Bureau. In that case, the holder of the account, the account number, and the party giving instructions should also be indicated. It is not necessary to indicate the amount to be debited. This method of payment avoids the risk of a fees irregularity. If the applicant wishes, nevertheless, to indicate the amount, he should then proceed to complete also part (b) of the Fee Calculation Sheet, showing how the total amount was arrived at.

122. Apart from the possibility of debiting an account held by the International Bureau, part (c) of the Fee Calculation Sheet provides for a number of additional methods of making payment.

123. In such case, it is imperative that the applicant also complete part (b) and indicate the total amount arrived at.