Making the Most of the Madrid System

Information and Practical Tips on How to Use Specific Forms

WIPO | MADRID
The International Trademark System

MAKING THE MOST OF THE MADRID SYSTEM

INFORMATION AND PRACTICAL TIPS ON HOW TO USE SPECIFIC FORMS

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INTRODUCTION

This handbook is intended to provide current or future users of the Madrid System for the International Registration of Marks with information and practical tips on how to make the most of the Madrid system.

Part I provides general information on the Madrid system and some of its main features, and the benefits of using the system. Part II provides information and practical tips on how to fill in the most commonly used forms, such as the international application form, a request for subsequent designation, a request for recording of changes (for example, a change in ownership, a change in the name and/or address of holder and representative, limitations) and renewal.

To learn more about the Madrid system or for more detailed and in-depth information on selected topics, please see the *Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol* (the Guide) or visit the website of the World Intellectual Property Organization (WIPO) (http://www.wipo.int/madrid/en/).

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For general questions about the Madrid system, please contact Madrid Customer Service (+41 22 338 8686) or send an e-mail to intreg.mail@wipo.int.

For questions regarding specific international applications, international registrations or any pending requests, please contact the relevant *Madrid Team* specializing in particular Offices of origin:

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AM	Armenia	AL	Albania	AU	Australia
AG	Antigua and Barbuda	AT	Austria	BH	Bahrain
BG	Bulgaria	AZ	Azerbaijan	BT	Bhutan
BQ	Bonaire, Saint Eustatius and Saba	BA	Bosnia and Herzegovina	BW	Botswana
		BX	Benelux	CN	China
CH	Switzerland	BY	Belarus	CY	Cyprus
CO	Colombia	DE	Germany	DK	Denmark
CU	Cuba	EE	Estonia	FI	Finland
CW	Curaçao	GE	Georgia	GB	United Kingdom
CZ	Czech Republic	GH	Ghana	GR	Greece
DZ	Algeria	HR	Croatia	IE	Ireland
EG	Egypt	IN	India	IL	Israel
EM	European Union	IR	Iran (Islamic Republic of)	IS	Iceland
ES	Spain	IT	Italy	JP	Japan
FR	France	KG	Kyrgyzstan	KE	Kenya
HU	Hungary	KZ	Kazakhstan	KR	Republic of Korea
KP	Democratic People's Republic of Korea	LR	Liberia	NZ	New Zealand
		LS	Lesotho	NO	Norway
LI	Liechtenstein	LT	Lithuania	OM	Oman
MA	Morocco	LV	Latvia	PH	Philippines
MC	Monaco	ME	Montenegro	RW	Rwanda
MD	Republic of Moldova	NA	Namibia	SE	Sweden
MG	Madagascar	RS	Serbia	SG	Singapore
MK	The former Yugoslav Republic of Macedonia	RU	Russian Federation	TR	Turkey
		SD	Sudan	US	United States of America
MN	Mongolia	SI	Slovenia	VN	Viet Nam
MX	Mexico	SK	Slovakia		
MZ	Mozambique	SL	Sierra Leone		
PL	Poland	SM	San Marino		
PT	Portugal	SZ	Swaziland		
RO	Romania	TJ	Tajikistan		
SX	Sint Maarten	TM	Turkmenistan		
SY	Syrian Arab Republic	UA	Ukraine		
ST	Sao Tome and Principe	UZ	Uzbekistan		
TN	Tunisia	ZM	Zambia		

PART I – PRESENTATION OF THE MADRID SYSTEM

WHAT IS THE MADRID SYSTEM?

The Madrid system offers individuals and businesses a unique opportunity to obtain and maintain protection for their marks in more than 90 countries, including the European Union as such[1], by means of a simple and economical procedure, using a single language and paying one set of fees in one currency.

To obtain such protection, all that is required is a single application ("international application") indicating goods and services and designating territories of interest ("designated Contracting Parties").

It is up to the designated Contracting Parties to determine the scope of protection of a mark, and decide whether it will be granted or refused, in accordance with their domestic legislation.

Once a mark has been registered ("international registration"), it is easy to manage it through the Madrid system. Indeed, there is only one registration to renew, and changes such as a change in ownership or in the name or address of the holder can be recorded in the International Register in a single straightforward procedure.

In addition, a particular advantage of the Madrid system is that the geographical protection of an international mark can be extended at any time after it has been registered, by including additional Contracting Parties[2] ("subsequent designation"). A mark may therefore, for example, be protected initially in five countries and ultimately in 80 or more countries, all under the same international registration number.

Last but not least, the Madrid system is very flexible and accommodates tailor-made changes, such as the transfer of an international registration for some only of the designated Contracting Parties or for some only of the goods or services covered by the registration.

The simpler and less time-consuming nature of the Madrid system, and the financial savings that can be achieved (no translation or legalization expenses, and no local representatives' fees as there is no mandatory requirement to appoint a local representative), make the Madrid system very attractive, as confirmed by the increase in international applications filed as well as feedback on user satisfaction.

A few words regarding the legal background: the Madrid system is governed by two treaties, the Madrid Agreement Concerning the International Registration of Marks ("the Agreement") and the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks ("the Protocol"). It is administered by WIPO in its capacity as the International Bureau in Geneva, Switzerland.

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[1] For an updated list of the territories members of the Madrid system ("Contracting Parties"), see http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/madrid_marks.pdf.

[2] Available for any Contracting Party unless it has made a specific declaration under Article 14(5) of the Protocol stating that it cannot be subsequently designated in international registrations effected prior to its date of accession to the Protocol. For a list of such declarations, see f) at http://www.wipo.int/madrid/en/madridgazette/remarks/declarations.html.

INTERNATIONAL APPLICATION

Requirements for filing an international application

Any natural person or legal entity (e.g., a business) may file an international application provided that the following two requirements are met: entitlement and basic mark.

1. Entitlement

To be entitled to use the Madrid system, the applicant must:

– have a real and effective industrial or commercial establishment in, or

– be domiciled in, or

– be a national of

a country which is a party to the Agreement and/or the Protocol. Applicants who have such an establishment or are domiciled in the territory of the European Union, or are nationals of a member State of the European Union, are also entitled to file an international application.

The Trademark Office of the Contracting Party with which an applicant has the necessary connection is called the *Office of origin*.

To check entitlement to file an international application under the Madrid system, please use WIPO's International Application Simulator. The Simulator also gives an idea of the concrete information to be provided at the time of filing of the international application, as well as an estimate of the fees to be paid through WIPO's Fee Calculator tool.

2. Basic mark

In addition to the entitlement requirement, a mark must have already been applied for or registered with the relevant Office of origin. This application or registration is often referred to as the "basic mark".

In order to ensure that a mark will not infringe the rights of others, applicants are advised, before filing the basic mark, to search for possible conflicting prior marks using WIPO's free search tools ROMARIN[3] and Global Brand Database[4].

Applicants should also check that their proposed mark has no misleading cognates or negative meanings or connotations in the language and culture of both current and future markets. For example, an applicant wishing to sell cars or motorcycles in the European Union under the trademark BURRO should be aware that BURRO is the Italian word for "butter". The same word in Spanish means "donkey". This may not result in a refusal by a designated Contracting Party, but it may hinder marketing of the goods in question.

[3] ROMARIN contains all the relevant information regarding international marks.

[4] The Global Brand Database is a portal allowing you to search multiple brand-related data from 14 sources, including registers of many trademark Offices.

Finally, since the international mark will be dependent on the basic mark for five years – meaning that if the basic mark is cancelled, either totally or partially, the international mark will be cancelled to the same extent – consider the option of filing an international application on the basis of a basic registration rather than a basic application. This is due to the fact that once a basic mark is registered and the opposition deadline (if any) has expired, it is less vulnerable than when the mark is still a pending application.

HOW TO FILE AN INTERNATIONAL APPLICATION

Once the Office of origin has been determined and either an application has been filed or a registration has been obtained for the mark before that Office, an international application can be filed.

The MM2 form[5] should be used for this purpose. It is available in the three working languages of the Madrid system (English, French and Spanish) at http://www.wipo.int/madrid/en/forms/. However, Contracting Parties may restrict the choice to one only or to two languages, so the language(s) accepted by each Office of origin should first be checked.

To facilitate filling of the MM2 form, see Part II of this publication, which provides a short, user-friendly but nevertheless detailed summary of the information needed for the successful completion of an international application. For even more detailed information, consult the Explanatory Notes for MM2 (MM2.INF).

Basically, an international application must contain the following information:

1. A reproduction of the mark, which must be identical to the one in the basic application or registration;

2. The designation of the Contracting Parties – as many as desired – in which the mark is to be protected. Note that designating the Contracting Party of which the Office is the applicant's Office of origin is not permitted.

The list of designated Contracting Parties should be prepared with care, to make it ambitious but nevertheless realistic in the light of current markets of interest and their neighboring countries, as well as potential export markets within the following three to five years.

Being too ambitious may lead to future cancellation actions if Contracting Parties have been designated but the mark is not being used there. Conversely, being too restrained may lead competitors or "pirates" to register the mark in a country where it has not yet been protected.

A major advantage of the Madrid system is that an extension of geographical protection may be requested at any time after international registration by subsequently designating additional countries where the mark is to be protected. Geographical protection can thus keep up with business needs.

[5] The MM1 form should be used by applicants whose Office of origin is the Office of a Contracting State bound by the Agreement only. The MM3 form should be used where the Office of origin is the Office of a Contracting Party bound by both the Agreement and the Protocol, and where the international application designates at least one Contracting State party to the Agreement but not to the Protocol and at least one Contracting Party to the Protocol, irrespective of whether or not that Contracting Party is also party to the Agreement.

3. A list of the goods and services for which the mark is to be protected, taking into consideration the fact that the list must be covered by or narrower than the list in the basic application or registration.

To avoid irregularities in the international application, the list of goods and services should be classified in accordance with the latest *International Classification of Goods and Services for the Purposes of the Registration of Marks* (Nice Classification). Try to make sure that the list will be accepted in the designated Contracting Parties. For this purpose, the use of the Madrid Goods and Services Manager (MGS) is recommended. This free tool indicates the goods and services accepted by the International Bureau and also by several Offices of Contracting Parties. In addition, the MGS provides translations of terms in more than 15 languages, including the three official Madrid languages.

In compiling the list of goods and services, be ambitious but nevertheless realistic. A well-balanced list should take into account the goods and services currently being offered, but also those due to be offered in the near future (within the following three to five years).

Note that some Contracting Parties require a declaration of intention to use the mark at the time of filing of the application (either on the application form or separately[6]). An excessively ambitious list of goods and services may trigger future refusals and/or non-use cancellation actions.

Note also that the list of goods and services cannot subsequently be expanded or broadened to cover additional goods and services, not even ones mentioned in the basic mark.

4. The fees to be paid to obtain an international registration consist of[7]:

- A basic fee (653 Swiss francs where reproduction of the mark is in black/white or 903 Swiss francs where reproduction of the mark is in color);
- A supplementary fee depending on the number of classes of goods and services to be protected (100 Swiss francs for each class of goods and services beyond three classes); and
- Complementary (100 Swiss francs per Contracting Party) or individual fees depending on the designated Contracting Parties.

The basic fee for international applications filed by applicants whose country of origin is a Least Developed Country (LDC) is reduced to 10 per cent of the prescribed amount. Countries considered LDCs are designated by the United Nations.

[6] See footnotes of item 11 of MM2 and MM18.

[7] For further information, see the Schedule of Fees and the Individual Fees under the Madrid Protocol documents or use the Fee Calculator.

FROM APPLICATION TO REGISTRATION

When an international application is received by the International Bureau via an Office of origin (no direct filing is possible), it is examined for compliance with formal requirements, such as the classification of the goods and services and the payment of fees.

If the application contains an irregularity, the International Bureau will inform the Office of origin and the applicant accordingly, and indicate how it may be remedied within a time limit of three months.

If the application is in order (i.e., no irregularity is found), the mark is recorded in the International Register, thereby becoming an international registration. The International Bureau will send the holder a certificate of registration and notify the designated Contracting Parties. Finally, the mark will be published in the *WIPO Gazette of International Marks*[8].

A certificate of registration does not mean that the mark is granted protection in all the designated Contracting Parties. Upon notification of the registration of the mark, the Offices of the designated Contracting Parties will undertake substantive examination in order to decide whether to grant or refuse protection of the mark, in accordance with their national or regional legislation.

Where the Office of a designated Contracting Party does not issue a refusal within the prescribed time limit (usually within 12 to 18 months), the mark is protected in that territory as if the mark had been filed and registered directly with the Office in question.

Where an Office issues a refusal, the refusal will be communicated by the International Bureau to the holder, who will, in principle, be granted a time limit for overcoming the refusal. The procedures to be followed depend on the legislation of the particular Contracting Party. Consequently, any procedure such as a review or appeal against a refusal, or later a response to an opposition, should be carried out directly with the Office concerned, with no involvement of the International Bureau.

To enable applicants and holders to be proactive and track the procedures through, in particular, the receipt of e-mail notifications and real-time status information on applications and registrations, the International Bureau invites applicants and holders to use the free online tools Madrid Portfolio Manager (MPM) and Madrid Real-time Status (MRS).

MANAGING AN INTERNATIONAL REGISTRATION

Once an international mark is registered, it is valid for 10 years and can be renewed every 10 years. Six months before the date on which renewal is due, the International Bureau will send out an unofficial notice informing holders of the possibility of renewal.

[8] The *WIPO Gazette of International Marks* is the official publication of the Madrid System. Every week the International Bureau publishes data regarding new international registrations, renewals, subsequent designations and modifications affecting existing international registrations.

There are three possible scenarios:

1. The owner wishes to renew the international registration as it is, for all the designated Contracting Parties and all the goods and services. The simplest way to do this is to use the E-Renewal platform where, in particular, credit card payments can be made.

2. The owner wishes to renew the international registration, but is no longer interested in all the Contracting Parties designated 10 years previously. The E-Renewal platform also enables the mark to be renewed only for those Contracting Parties that are still of interest, thereby reducing the fees to be paid.

3. The owner wishes to renew the international registration for all the designated Contracting Parties, but is no longer interested in some of the goods or services originally indicated. This facility is also extended by the International Bureau, but not on the E-Renewal platform. In this case, a request for limitation or cancellation of the goods and services that are no longer of interest should be filed, using the MM6 or MM8 forms, which can be filed anytime before the date of renewal. Once the limitation or cancellation is recorded, the international registration can be renewed.

These unique flexibility features of the Madrid system stem from the fact that an international registration is equivalent to a bundle of national registrations. A holder may voluntarily restrict or renounce an international registration with respect to one or more of the designated Contracting Parties and/or with respect to some or all of the goods or services. This is not possible with a unitary regional right, such as the Community Trade Mark (CTM).

This flexibility also extends to changes in ownership, since an international registration may be assigned or transferred with respect to some only of the designated Contracting Parties and/or some only of the goods and services.

Another of the leading advantages of the Madrid system is that the filing of a single request for a change is usually sufficient for the change to have effect in all the affected designated Contracting Parties.

This generally applies to:

- a change in ownership (MM5): note that a natural person or legal entity may be recorded as the new owner of an international registration in respect of a given Contracting Party only if he/it would be entitled (in accordance with the principles of entitlement set out above) to designate that Contracting Party in an international application;

- a change in the name or address of the holder (MM9);

- a change in the name or address of a representative (MM10);

- a limitation of the list of goods and services in respect of all or some of the designated Contracting Parties (MM6);

- a renunciation in respect of one or more, but not all, of the designated Contracting Parties, for all the goods and services (MM7);

– a cancellation of the international registration in respect of all the designated Contracting Parties for all or some of the goods and services (MM8); and

– a license in respect of all or some of the designated Contracting Parties and for all or some of the goods and services (MM13).

To monitor the status of requests and stay informed of the real-time status of documents being processed by the International Bureau, use the free online Madrid Real-time Status (MRS) tool.

Additionally, to monitor competitors' new marks or events affecting a specific registration, use the ROMARIN tool and the Madrid Electronic Alert (MEA) service.

Finally, once holders have acquired more experience, they may also consider taking advantage of the "replacement" feature offered by the Madrid system. Where, for example, there exists a national or regional registration in a country or territory that has later become a Contracting Party of the Madrid system, it is possible to gather all the trademark protection under one number, namely the international registration number. To benefit from this feature, the Madrid system should be used to designate the territory of the relevant national or regional registration.

Certain requirements need to be met. For example, the mark and the goods and services must be the same. When the requirements have been met, national or regional protection is replaced by international registration. Once confirmation that protection has been obtained through the Madrid system is received from the designated Contracting Party, there is no longer any need to maintain the national or regional registration. Although such replacement is deemed to take place automatically, it is advisable, for the information of third parties, to ask the national or regional Office to take note of the international registration and notify the International Bureau accordingly. For more detailed information on replacement, see the Guide[9].

[9] Paragraphs B.II.100.01 to 07.

PART II – EXPLANATORY NOTES ON FORMS

This part of the handbook provides information and practical tips on how to fill in the most commonly used forms, namely:

MM2	International application
MM4	Designation subsequent to the international registration
MM5	Request for the recording of a change in ownership
MM6	Request for the recording of a limitation of the list of goods and services
MM7	Request for the recording of a renunciation
MM8	Request for the recording of a cancellation of the international registration
MM9	Request for the recording of a change in name and/or address of the holder
MM10 (optional)	Request for the recording of a change in name and/or address of the representative
MM11 (optional)	Renewal of the international registration
MM12 (optional)	Appointment of a representative

The forms are available at http://www.wipo.int/madrid/en/forms/.

When filling in forms, please note the following instructions:

- The form must be on one-sided A4 sheets;
- The form must be filled in legibly using a typewriter or other machine. Handwritten forms are not acceptable.
- Where the space available in any part of a form is insufficient, one or more continuation sheets should be used. On the continuation sheet, it is necessary to indicate “Continuation of item number ....”, and the information must be presented in the same format as on the form itself. The number of continuation sheets used should be indicated in the box at the top of the form.

All the forms are available in the three working languages of the Madrid system (English, French and Spanish). However, where the form must be submitted through an Office, the filing language(s) acceptable to each Office should be checked first.

APPLICATION FOR INTERNATIONAL REGISTRATION GOVERNED EXCLUSIVELY BY THE MADRID PROTOCOL

INTRODUCTION

To file an application for international registration, the application form should be submitted via an Office of origin since direct filing with the International Bureau is not possible. Consult the Office of origin on how to submit the application form: on paper or via e-mail or other electronic means.

Depending on the treaty (the Agreement or the Protocol) that governs the application, one of the following forms should be used to apply for an international registration:

Application for international registration governed:	
MM1	exclusively by the Madrid Agreement
MM2	exclusively by the Madrid Protocol
MM3	by both the Madrid Agreement and the Madrid Protocol

Even though this handbook provides specific information only on the MM2 application form (Protocol only), the other two forms (MM1 and MM3) are similar and the recommendations given for MM2 are also applicable to them.

OFFICIAL FORM MM2 – EXPLANATORY NOTES

HOW TO FILL IN THE MM2 FORM

ITEM 1: CONTRACTING PARTY WHOSE OFFICE IS THE OFFICE OF ORIGIN

Indicate the Contracting Party whose Office is to be considered the Office of origin, i.e., the Contracting Party through which the applicant has the required entitlement – through nationality, domicile and/or a real and effective industrial or commercial establishment – and before whose Office the applicant has applied for or registered his basic mark.

ITEM 2: APPLICANT

(a) Name: Natural persons should indicate their family (or last) name and given (or first) name in the order in which they are customarily used. Legal entities (businesses) should indicate their full official designation.

If the applicant's name is in non-Latin characters, transliterate it into Latin characters, following the phonetics of the language of the international application. Legal entities should replace the transliteration with a translation into the language of the international application.

If there are multiple applicants, indicate the name of each of them, using a continuation sheet if necessary.

(b) Address: Provide the address in a form that will ensure prompt postal delivery.

If there are multiple applicants, indicate the address of each of them, using a continuation sheet if necessary.

Note that if there are several applicants with different addresses and no representative or address for correspondence is indicated, all communications will be sent to the address of the applicant named first in the application.

(c) Address for correspondence: If communications should be sent to an address other than the one indicated in item 2(b), enter that address in this space. For example, indicate an address for correspondence when multiple applicants have different addresses or the application is being filed by the in-house counsel of a company, and the address of the in-house counsel is different from the main address of the company. Otherwise, this field should be left blank.

Note: To appoint a representative, fill in item 4, not this paragraph (c).

(d) Telephone or facsimile numbers and an e-mail address may be given. They should be those of the person that the International Bureau should contact if it needs to get in touch. Telephone or facsimile numbers should include country and city codes, such as, for example, in +41 22 338 8686. The full e-mail address should be given, such as intreg.mail@wipo.int.

When an e-mail address is provided, any further correspondence from the International Bureau related to the international application and the resulting international registration will be sent only electronically and, therefore, you will no longer receive any paper correspondence. Likewise, any further correspondence from the International Bureau relating to other international applications or international registrations for which the same e-mail address has been, or will be, provided will also be sent only electronically. Please note that, for the purpose of electronic communication, there can be only one e-mail address recorded for each international registration.

(e) Preferred language for correspondence: To receive communications from the International Bureau in the language of the international application, no box needs to be checked. Otherwise, select English, French or Spanish.

(f) Other indications: These are required by a number of Contracting Parties whose Office may issue a refusal against a mark if they are omitted. Therefore, although it is not compulsory to fill in this part of an international application, it is advisable to do so.

(i) Natural persons should indicate the State of which they are nationals.

(ii) Legal entities, such as an incorporated body, should indicate their legal nature (for example, “limited liability company”), along with the name of the State and, where applicable, territorial unit, under the law of which they are incorporated or organized.

ITEM 3: ENTITLEMENT TO FILE

(a) Check a box to indicate the nature of the applicant's entitlement. 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 one single box may be checked accordingly by the applicant. If box (ii) is checked, enter the name of the State in question.

(b) Provide the address in a form that will ensure prompt postal delivery.

ITEM 4: APPOINTMENT OF A REPRESENTATIVE (IF ANY)

To appoint a person or company to be a representative before the International Bureau, enter the relevant information under this item.

For the purposes of the international procedure, a representative may be domiciled anywhere, meaning that he does not need to be domiciled in a Madrid system member State.

Please indicate the name and address of the representative and provide sufficient contact information to enable the International Bureau to correspond with him. It is advisable to include telephone and fax numbers, and an e-mail address, following the instructions given in item 2(a), (b) and (d) above.

When an e-mail address is provided, any further correspondence from the International Bureau related to the international application and the resulting international registration will be sent only electronically and, therefore, you will no longer receive any paper correspondence. Likewise, any further correspondence from the International Bureau relating to other international applications or international registrations for which the same e-mail address has been, or will be, provided will also be sent only electronically. Please note that, for the purpose of electronic communication, there can be only one e-mail address recorded for each international registration.

ITEM 5: BASIC APPLICATION OR BASIC REGISTRATION

When the basic mark is an application pending before the Office of origin, enter the application number and date.

When the basic mark is registered in the Office of origin, enter the registration number and date.

ITEM 6: PRIORITY CLAIMED

To claim priority from an earlier filing (application or registration), check the first box and enter the name of the Office in question, along with the application date (no more than six months earlier) and number (if available).

If the earlier filing does not cover all the goods and services for which the international mark is to be protected, indicate the goods and services covered by the earlier filing.

You may, for example, simply enter “class number 25”, which would mean that all the goods in class 25 in item 10 are covered by the earlier filing. However, if “class 25: Hats” is entered, this would mean that any other goods in class 25 in item 10 are not covered by the priority claim.

If the earlier filing covers all the goods or services in item 10, it is not necessary to repeat all the goods or services in item 6.

To claim priority from more than one earlier filing, check the second box and enter all required information on a continuation sheet.

ITEM 7: THE MARK

(a) Place the reproduction of the mark, exactly as it appears in the basic application or basic registration, in the square.

Therefore, if the mark in the basic application or basic registration is in black and white, so must be the reproduction in this box. Likewise, if the basic mark is in color, the reproduction in this box must be in color as well.

Where the mark is a non-traditional mark (e.g., a sound mark or a three-dimensional mark), the reproduction of the mark in item 7 should match the reproduction of the mark in the basic application or the basic registration. Thus, when the reproduction in the basic application or registration consists of, for example, a perspective view of a three-dimensional mark, a musical notation or a description in words of a sound mark, then this is what should appear in box (a). The reproductions of non-traditional marks may require a supplementary description in item 9(e).

Note: Non-graphical reproductions – for example, a sound recording of a sound mark – may not be included in the international application.

The reproduction must be sufficiently clear for the purposes of recording, publication and notification. If it is not, the International Bureau will consider it irregular and inform the applicant and Office of origin accordingly. Therefore, if several views have been used to reproduce the basic mark, those reproductions should also be included, in a number sufficient for the reproduction to be clear.

It is not possible to modify the reproduction of the mark after the mark has been registered by the International Bureau.

The reproduction should be two-dimensional and graphical or photographic, and should fit within the box, which is 8 cm x 8 cm.

Finally, the reproduction may be typed, printed, pasted or reproduced by any other means, but note that the mark will ultimately be published in the Gazette in exactly the same format as it was presented.

(b) This box need only be used when color is claimed as a distinctive feature of the basic mark (meaning that it must also be claimed in the international application), but the reproduction of the basic mark in box (a) is in black and white because the Office of origin does not provide for publication in color. In such cases, the mark must be reproduced in color in box (b). The Gazette will then include reproductions of the mark, both in black and white and in color.

(c) Check this box if the mark is to be considered a mark in standard characters.

Generally, a mark in standard characters is equivalent to a mark consisting of a word or words, or letters or numerals, or a combination of those elements, as opposed to a stylized or figurative mark, or a mark depicted in a special style, font or color, rather than in a uniform style. It is not possible to add a claim that the mark is in standard characters after the mark has been registered by the International Bureau.

A word mark in a stylized script would not normally be considered as a mark in standard characters. Also, a mark containing special characters or stylized elements should not be claimed as a mark in standard characters.

The International Bureau will not on its own initiative consider that a mark consisting of, or containing, non-Latin characters or non-Arabic numerals is a mark in standard characters. It will not, in principle, question a claim that a mark is in standard characters.

The International Bureau 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.

(d) In many jurisdictions, a color, as such, or a combination of colors may be registered as a mark. A color mark as such is, for example, where the applicant wishes the color itself (for example a specific shade of red) or a combination of colors, to be the mark. This is different from cases where the mark to be protected consists of figurative elements or stylized characters that happen to be colored. In such cases, the correct name for the mark is a mark in color, not a color mark *per se*.

To protect a mark that consists entirely of a color – as a color mark *per se* – provide a description in words of the color(s) in question in item 8(a).

Enter a description in words of the color(s) in item 9(e).

ITEM 8: COLOR(S) CLAIMED

(a) When one or more colors are considered to be an essential part of a mark and colors are claimed as a distinctive feature check the box and describe in words the color(s) claimed. It is advisable to include a reference to an international color classification system, such as RGB or Pantone.

Note: A color claim is not a mandatory requirement in the international procedure. However, it may be a requirement in certain designated Contracting Parties. Therefore, to avoid any future refusals, it is advisable to check box (a) and provide the requested information.

(b) Use item 8(b) to further indicate the principal parts of the mark that are in the color(s) in question.

If the mark consists of elements like a car, a flower and a cat, specify that “the car is green, the flower is red and the cat is brown”.

ITEM 9: MISCELLANEOUS INDICATIONS

(a) Transliteration: When the mark consists of non-Latin characters or numerals other than Arabic or Roman numerals, a transliteration of the mark in Latin characters and/or Arabic or Roman numerals is required. This means, in simple terms, a phonetic reproduction of the mark as it sounds reproduced in Latin characters, following the language of the international application. It must not be confused with translation.

(b) Translation: If the mark consists of or contains translatable words, it is advisable to provide a translation into all three languages in item 9(b). Although this is not a mandatory requirement in the international procedure, it may be a requirement in certain designated Contracting Parties. The International Bureau will not check the accuracy of a translation, nor will it question its absence or provide any on its own initiative.

(c) If the word(s) in the mark have no meaning and cannot therefore be translated, check this box.

(d) When the mark is a three-dimensional mark, a sound mark or a collective, certification or guarantee mark, and it appears as such in the basic application or registration, check the corresponding box.

Note: Do not send the regulations governing the use of a collective, certification or guarantee mark to the International Bureau. However, many Contracting Parties do require such regulations, so it is better to send them directly to the designated Contracting Parties so as to avoid a possible future refusal.

(e) Description of the mark: If a description is included in the basic mark, you may decide to include it in, or omit it from, the international application. In some cases, the Office of origin may require the same description to be included in the international application.

If the mark is not among the types listed under item 9(d), use this space to elaborate on the nature of the mark (e.g., hologram or motion mark). However, the description must still match the description in the basic mark.

Where the description of the basic mark is in a language other than the language used in the international application, a description should be provided in the language of the international application.

The International Bureau will not check or question the accuracy of the description, or any translation thereof.

(f) Verbal elements of the mark: Providing this information is not a mandatory requirement. The International Bureau captures (from the reproduction in item 7) what appear to be the essential verbal elements of the mark and uses them for administrative purposes (primarily in notifications and correspondence). However, if the mark is in special characters or hand-written or contains verbal matter, the words or letters could be misinterpreted or it may not be apparent what should be captured. Therefore, it may be preferable for the *applicant* to indicate what he considers to be the essential verbal elements of the mark. Nevertheless, any such indication is entirely for information purposes and not intended to have any legal effect.

Note: If the box for standard characters in item 7(c) is checked, this item should not be filled in.

(g) To disclaim protection for any element of the mark, the element(s) in question should be indicated here.

This item is intended to avoid requests from designated Contracting Parties for any such disclaimer (for example, a disclaimer in respect of non-distinctive elements of the mark, such as "30 ml" or "Made in …"). Note that if a disclaimer is included in the application, it must be in respect of the international registration as a whole, not just some of the designated Contracting Parties. It is not possible to include a disclaimer of elements of the mark after it has been registered by the International Bureau.

ITEM 10: GOODS AND SERVICES

(a) Indicate the goods and services for which the mark is to be protected.

The goods and services must be grouped in the corresponding 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 should be indicated with precision, preferably using terms found in the Alphabetical List of the Nice Classification. If necessary, use a continuation sheet and check the appropriate box.

On the continuation sheet(s), please use font "Courier New" or "Times New Roman", size 12 pt, lower case only and make consistent use of commas, colons and semi-colons.

The wording "All goods in class 9" will not be accepted, but the class headings will be accepted by the International Bureau as indications of the goods and services for which the international registration of a mark is sought. However, the class headings might not be accepted by certain designated Contracting Parties so, to avoid any future refusals, it is advisable to indicate the specific goods and services for which protection is sought.

Consider also using the Madrid Goods and Services Manager (MGS). This on-line tool is useful for compiling lists of goods and services in the international application. It provides indications of goods and services in different languages and terms pre-accepted by the International Bureau and by certain participating Offices. Using this tool may reduce delays and costs stemming from irregularity notices issued by the International Bureau, and provisional refusals.

Note that the list of goods and services in the international application can be narrower than the list in the basic application or registration, but it can never be broader or contain completely different goods and services. This does not mean that exactly the same terms must be used, but the terms used in the international application must be equivalent to, or fall within the scope of, those used in the basic registration or application.

(b) To limit the list of goods and services in respect of one or more of the designated Contracting Parties, check this box. The limited list of goods and services for each concerned Contracting Party must then be indicated.

The list of goods and services can be limited to entire classes and/or to specific goods and services in a particular class.

Example 1

The main list of goods and services in the international application includes classes 1, 3, 5, 7, 9, 16 and 25 and ten Contracting Parties are designated. To avoid the expense of including all of the goods for all ten of the designated Contracting Parties, the scope of protection can be narrowed, as follows:

Contracting Parties	***Class(es) of goods and services for which protection is sought***
Australia	*Classes 1, 5 and 25*
Japan	*Classes 1 and 25*

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 indicated in item 10(b), i.e., classes 1, 5 and 25 and classes 1 and 25, respectively, and fees will be payable only for those classes.

Example 2

The main list of goods and services in the international application includes classes 1, 3, 5, 7, 9, 16 and 25 and ten Contracting Parties are designated.

You have ascertained that a third party has already obtained protection in a designated Contracting Party, namely China, for a similar mark in respect of goods that are similar to those covered in the international application (e.g., clothing for gymnastics). To eliminate or reduce the risk of a possible opposition in China, the scope of protection for China can be reduced within that class by not applying for protection for certain specific goods.

The application for registration in class 25 can be 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".

However, as far as China is concerned, "clothing for gymnastics" should be deleted in item 10(b) of the international application form, thereby limiting the scope of the goods in class 25 as follows:

Class 25 (China):
"Clothing of leather, clothing of imitations of leather, coats, cyclists' clothing and sports jerseys".

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.

ITEM 11: DESIGNATED CONTRACTING PARTIES

Indicate the Contracting Parties for which protection for the mark is sought by checking the corresponding boxes.

The list of designated Contracting Parties should be prepared with care, to make it ambitious but nevertheless realistic in the light of current markets of interest and their neighboring countries, as well as potential export markets within the following three to five years.

Remember that an extension of geographical protection can always be requested later, by subsequently designating additional countries where protection for the mark is sought, thereby allowing geographical protection to keep up with business needs.

Being too ambitious may lead to future cancellation actions if Contracting Parties have been designated but the mark is not being used there. Conversely, being too restrained may lead competitors or "pirates" to register the mark in a country where it has not yet been protected.

Some Contracting Parties have certain requirements, for which specific information may need to be provided on the MM2 form or on a separate form. Specifically:

1. If the **European Union** is designated, a second language before the Office of the European Union must be indicated by checking the corresponding box. The second language must be different from the language of the international application itself. Furthermore, when claiming seniority from earlier registrations (for more information on seniority claims, see Information Notice No. 20/2004), the MM17 form will need to be filled in and attached to the international application.

2. Designating **India, Ireland**, **New Zealand**, **Singapore** and/or the **United Kingdom** constitutes a declaration of intention to use the mark in those countries for the goods and services identified in the international application.

3. If the **United States of America** is designated, the MM18 form (declaration of intention to use the mark) will need to be filled in and attached to the international application. For information on why and how this form should be filled in, see Information Notice No. 23/2003.

ITEM 12: SIGNATURE BY THE APPLICANT AND/OR HIS REPRESENTATIVE

Sign the form, if required or allowed by the Office of origin.

Alternatively, if required or allowed by the Office of origin, the representative may sign the form on the applicant's behalf.

The signature should be handwritten, printed or stamped. It may also be replaced by the affixing of a seal.

ITEM 13: CERTIFICATION AND SIGNATURE OF THE INTERNATIONAL APPLICATION BY THE OFFICE OF ORIGIN

Leave this space blank as this item will be filled in by the Office of origin.

FEE CALCULATION SHEET

The fees to be paid for an international application consist of:

- A basic fee (653 Swiss francs where reproduction of the mark is in black/white or 903 Swiss francs where reproduction of the mark is in color);
- A supplementary fee depending on the number of classes of goods and services to be protected (100 Swiss francs for each class of goods and services beyond three classes); and
- Complementary (100 Swiss francs per designated Contracting Party) or individual fees depending on the designated Contracting Parties.

The basic fee for international applications filed by applicants whose country of origin is a Least Developed Country (LDC) is reduced to 10 per cent of the prescribed amount. Countries considered LDCs are designated by the United Nations.

(a) Instructions to debit from a current account: to debit the fees from a current account with the International Bureau, check this box.

The conditions for opening, using and closing a current account with WIPO can be viewed by clicking on the following link:
http://www.wipo.int/export/sites/www/madrid/en/guide/part_d/pdf/wipo_account.pdf.

The account holder, the account number and the party giving the instructions should be indicated. The amount of fees to be debited does not need to be calculated and entered here.

(b) Amount of fees: If the payment has already been made or if the payment is to be made into the WIPO bank account (worldwide) or postal account (Europe only), the relevant information should be entered here.

To calculate and enter the amount of fees due, use WIPO's Fee Calculator tool and select "New application" in the "Type" pick list. Alternatively, all this information can be found in WIPO's "Schedule of Fees" and "Individual Fees under the Madrid Protocol" documents.

Do not forget to indicate the grand total (in Swiss francs).

(c) Method of payment: Identify the party effecting the payment, check the corresponding box and provide the required information.

DESIGNATION SUBSEQUENT TO THE INTERNATIONAL REGISTRATION

OFFICIAL FORM MM4 – EXPLANATORY NOTES

INTRODUCTION

To extend the geographical scope of protection of an international registration to additional Contracting Parties, these Contracting Parties must be the subject of a subsequent designation using official form MM4.

The MM4 form can be presented directly to the International Bureau (by regular post to the address indicated in Part I or by sending a PDF version of the form by e-mail to intreg.mail@wipo.int) or through an Office (Office of origin or Office of the Contracting Party of the holder when a change in ownership has been recorded for an international registration). However, if the subsequent designation relates to a country which is a party only to the Agreement, the form must be presented through an Office (Office of the Contracting Party of the holder). In this case, consult the Office on how the form should be submitted: on paper or via e-mail or other electronic means.

Note that any recording of changes should take place before the form is submitted to the International Bureau. If, for example, the name or address, as indicated on the MM4 form, has changed but the relevant official form has not yet been submitted to the International Bureau to request the recording of that change (MM9), recording of the change must be requested before the MM4 form is presented.

The period of protection of a subsequent designation does not have a separate lifetime of 10 years since it expires on the same date as the international registration to which it relates. The date of renewal of the international registration should be taken into consideration when subsequently designating new Contracting Parties, because renewal fees for all designated Contracting Parties will have to be paid at the time of renewal. See also item 7, below, where it is possible to indicate that recording of the subsequent designation should take effect after recording of, for example, the renewal of the international registration.

HOW TO FILL IN THE MM4 FORM

ITEM 1: INTERNATIONAL REGISTRATION NUMBER

Indicate the full international registration number, for example 123456 or 123456A.

Note that there can be only one international registration number per form.

ITEM 2: HOLDER OF THE INTERNATIONAL REGISTRATION (AS RECORDED IN THE INTERNATIONAL REGISTER)

Indicate your name and address exactly as recorded in the International Register.

Indicate your e-mail address exactly as recorded in the International Register or as it should be recorded in the International Register.

When an e-mail address is provided, any further correspondence from the International Bureau related to this international registration will be sent only electronically and, therefore, you will no longer receive any paper correspondence. Likewise, any further correspondence from the International Bureau relating to other international applications or international registrations for which the same e-mail address has been, or will be, provided will also be sent only electronically. Please note that, for the purpose of electronic communication, there can be only one e-mail address recorded for each international registration.

ITEM 3: APPOINTMENT OF A (NEW) REPRESENTATIVE (IF ANY)

To appoint a representative for the first time or to appoint a new one, enter the corresponding information in item 3 or attach a power of attorney or the MM12 form to this MM4 form.

To update the contact details of a representative already recorded in the International Register, use form MM10.

Name: Natural persons should indicate their family (or last) name and given (or first) name in the order in which they are customarily used. Legal entities (businesses) should indicate their full official designation.

If the name of the representative is in non-Latin characters, it should be transliterated into Latin characters, following the phonetics of the language of the international registration. If the representative is a legal entity, the transliteration may be replaced by a translation into the language of the international registration.

Address: Provide the address in a form that will ensure prompt postal delivery.

Telephone or facsimile numbers and an e-mail address may be given so that the International Bureau can contact the representative. Telephone or facsimile numbers should include country and city codes, such as, for example +41 22 338 8686. The full e-mail address should be given, such as intreg.mail@wipo.int.

When an e-mail address is provided, any further correspondence from the International Bureau related to this international registration will be sent only electronically and, therefore, you will no longer receive any paper correspondence. Likewise, any further correspondence from the International Bureau relating to other international applications or international registrations for which the same e-mail address has been, or will be, provided will also be sent only electronically. Please note that, for the purpose of electronic communication, there can be only one e-mail address recorded for each international registration.

Remember to sign this item. Otherwise the representative will not be recorded and all communications from the International Bureau will be sent directly to the holder of the international registration.

ITEM 4: CONTRACTING PARTIES DESIGNATED SUBSEQUENTLY

Indicate the Contracting Parties for which protection for the mark is sought by checking the corresponding boxes.

Note that the Contracting Party whose Office is the Office of Origin cannot be subsequently designated (the basic mark is already protected there).

To ensure that the Contracting Parties of interest can all be subsequently designated, check the list of Contracting Parties that have made a declaration under Article 14(5) of the Protocol (see item (f)), and in which no subsequent designation may be possible.

Some Contracting Parties have certain requirements for which specific information may need to be provided on the MM4 form or on a separate form. For example:

1. If the **European Union** is subsequently designated, a second language before the Office of the European Union must be indicated by checking the corresponding box. The second language must be different from the language of the international registration. Furthermore, to claim seniority from earlier registrations in some or all European Union countries (for more information on seniority claims, see Information Notice No. 20/2004), the MM17 form will need to be filled in and attached to the MM4 form.

2. Subsequently designating **India, Ireland, New Zealand, Singapore** and/or the **United Kingdom** constitutes a declaration of intention to use the mark in those countries for the goods and services in item 5.

3. Subsequently designating the **United States of America** requires filling in the MM18 form (declaration of intention to use the mark) and attaching it to the MM4 form. For more information on why and how this form should be filled in, see Information Notice No. 23/2003.

Documentation of actual use of the mark in the territory concerned:

Note also that certain Contracting Parties may require a statement of actual use of the mark.
If the Philippines and/or the United States of America are designated, actual use of the mark will need to be documented, after a specific time period, before the Office in question. For more detailed information, see Information Notice No. 16/2010 (United States of America) and Information Notice No. 18/2013 (Philippines).

ITEM 5: GOODS AND SERVICES CONCERNED BY THE SUBSEQUENT DESIGNATION

Please check only one box, depending on whether:

(a) the subsequent designation is made in respect of **all** the Contracting Parties designated in item 4, for **all** the goods and services listed in the international registration indicated in item 1; or

(b) the subsequent designation is made in respect of **all** the Contracting Parties designated in item 4, but only for those goods and services listed in the continuation sheet (which must be grouped in the appropriate class(es)); or

(c) the subsequent designation is only for those goods and services listed in the continuation sheet in respect of the Contracting Parties identified in the said continuation sheet; in respect of the other Contracting Parties designated in item 4, the subsequent designation is for all the goods and services listed in the international registration identified in item 1.

On the continuation sheet(s), please use font "Courier New" or "Times New Roman", size 12 pt, lower case only and make consistent use of commas, colons and semi-colons.

ITEM 6: MISCELLANEOUS INDICATIONS

The indications requested in this item are required by a number of designated Contracting Parties. If the indications are omitted, an Office may issue a refusal of the mark. Therefore, it is advisable to provide this information even though it is not compulsory.

The following information may be provided:

(a) Indications concerning the holder

(i) If the holder is a natural person, the nationality of the holder.

(ii) If the holder is a legal entity such as an incorporated body, the nature of the legal entity (for example, "limited liability company"), along with the name of the State and, where applicable, territorial unit, under the law of which the legal entity is incorporated or organized.

(b) Indications concerning color: If the mark is in color, indicate the principal parts of the mark that are in colors. Example: "The car is green and the flower is red".

(c) and (d) Indications regarding the translation: If the mark consists of or contains translatable words, it is advisable to provide a translation into all three languages (English/French/Spanish). The International Bureau will not check the accuracy of the translation, nor will it question its absence or provide any on its own initiative. If the word(s) in the mark have no meaning, and therefore cannot be translated, check box (d).

When filling in items (b), (c) and (d), check that the information indicated matches the information provided at the time the international application was filed or later.

ITEM 7: DATE OF EFFECT OF THE SUBSEQUENT DESIGNATION

If neither of the boxes is checked, the date of the subsequent designation will be the date of its receipt by the International Bureau, or if the MM4 form has been presented through an Office, the date of receipt by that Office.

Otherwise, under this item a request can be made for the subsequent designation to take effect later than another transaction. This may be useful if, for example, the subsequent designation is to take effect after the recording of another event (e.g., recording of a change or after the renewal of the international registration), thereby reducing the fees to be paid.

Please note that the International Bureau cannot put subsequent designations on hold for more than six months.

If box (a) is checked, stating that the subsequent designation is to take effect only after the recording of the renewal, please ensure that the international registration is renewed by using the E-Renewal platform or attaching form MM11 to this form MM4.

If box (b) is checked, stating that the subsequent designation is to take effect only after the recording of a change, specify the change in question and attach the corresponding form.

ITEM 8: SIGNATURE BY THE HOLDER AND/OR HIS REPRESENTATIVE

The MM4 form may be signed by the holder or representative. The signature should be handwritten, printed or stamped. It may also be replaced by the affixing of a seal.

Holder: Indicate the holder's name as recorded in the International Register. Legal entities should indicate the name as recorded in the International Register (but not the name of the person signing the form).

Sign the form.

Representative: If the representative signs the form, indicate the name of the representative as recorded in the International Register or indicated in the appointment of the representative in item 3, or as attached to this MM4 form (see item 3, above).

ITEMS 9 AND 10: DATE OF RECEIPT AND DECLARATION BY THE OFFICE OF THE CONTRACTING PARTY OF THE HOLDER PRESENTING THE SUBSEQUENT DESIGNATION (WHERE THE SUBSEQUENT DESIGNATION IS PRESENTED THROUGH AN OFFICE)

Leave this space blank. If the form is presented via an Office, the Office will fill in the relevant information.

FEE CALCULATION SHEET

The fees to be paid for a request for subsequent designation consist of:

– a basic fee (300 Swiss francs);

– a complementary fee (100 Swiss francs) for each designated Contracting Party indicated where an individual fee is not payable.

(a) Instructions to debit from a current account: To debit the fees from a current account with the International Bureau, check this box.

The account holder, the account number and the party giving the instructions should be indicated. There is no need to calculate and indicate the amount of fees to be debited.

(b) Amount of fees: If the payment has already been made or if the payment is to be made into the WIPO bank account (worldwide) or postal account (Europe only), the relevant information should be entered here.

To calculate and indicate the amount of fees due, use WIPO's Fee Calculator tool and select the type "Subsequent designation". Alternatively, all information can be found in WIPO's "Schedule of Fees" and "Individual Fees under the Madrid Protocol" documents.

Do not forget to indicate the grand total (in Swiss francs).

(c) Method of payment: Identify the party effecting the payment, check the corresponding box and provide the required information.

REQUEST FOR THE RECORDING OF A CHANGE IN OWNERSHIP

OFFICIAL FORM MM5 – EXPLANATORY NOTES

INTRODUCTION

To record a change in ownership, submit the official MM5 form to the International Bureau. The change in ownership can be total or partial.

A *total* change in ownership relates to all the designated Contracting Parties and to all the goods and services covered by the international registration.

A *partial* change in ownership relates to some only of the designated Contracting Parties and/or some only of the goods and services covered by the international registration.

A change of ownership may only be recorded if the new owner (the transferee) is entitled to use the Madrid system (see more on entitlement in Part I), and only if the entitlement extends to all the Contracting Parties for which the new holder is to be recorded.

The recording of a change in ownership can be requested for multiple registrations in a single MM5 form, provided that:

- the registrations are being transferred from the same holder (transferor) to the same transferee (new owner), and that
- for each of the registrations, the change applies to all the designated Contracting Parties (or to the same designated Contracting Party) and that it concerns all the goods and services (or the same goods and services).

Otherwise, multiple MM5 forms will be needed.

If the form is signed by the recorded holder, it can be sent directly to the International Bureau, by regular post to the address indicated in Part I or by sending a PDF version of the form by e-mail to intreg.mail@wipo.int. Do not attach any documentation such as the contract of assignment.

If the form is not signed by the recorded holder, the form must be sent through an Office, either the Office of the Contracting Party of the recorded holder or that of the new owner. In this case, consult the Office on how the form should be submitted: on paper or via e-mail or other electronic means. The Office may request to see documentation, such as a contract of assignment.

HOW TO FILL IN THE MM5 FORM

ITEM 1: INTERNATIONAL REGISTRATION NUMBER(S)

Indicate the full international registration number(s), for example 123456 or 123456A.

ITEM 2: NAME OF THE HOLDER (TRANSFEROR)

Indicate the name of the holder exactly as it is recorded in the International Register.

ITEM 3: NEW OWNER (TRANSFEREE)

Indicate the name and address exactly as they are recorded in the International Register.

(a) Name: Natural persons should indicate their family (or last) name and given (or first) name in the order in which they are customarily used. Legal entities should indicate their full official designation.

If the name of the new owner is in non-Latin characters, transliterate it into Latin characters, following the phonetics of the language of the international registration. Legal entities should replace the transliteration with a translation into the language of the international registration.

If there are multiple new owners, indicate the name of each of them, using a continuation sheet if necessary.

(b) Address: Provide the address in a form that will ensure prompt postal delivery.

If there are multiple new owners, indicate the address of each of them, using a continuation sheet if necessary. Note that if there are multiple new owners with different addresses and no representative or address for correspondence is indicated, all communications will be sent to the address of the new owner named first in the application.

(c) Address for correspondence: Where the new owner wishes that communications should be sent to an address other than the one indicated in item 3(b), enter that address in this space. An address for correspondence may be useful when multiple new owners have different addresses or the request for recording of a change in ownership is being filed by the in-house counsel of a company, and the company's address is different from the address used by the in-house counsel. Otherwise, this field should be left blank.

Note: To appoint a representative, fill in item 5, below, not 3(c).

(d) Telephone or facsimile numbers and an e-mail address may be given so that the International Bureau can contact the new owner. Telephone or facsimile numbers should include country and city codes, such as, for example +41 22 338 8686. The full e-mail address should be given, such as intreg.mail@wipo.int.

When an e-mail address is provided, any further correspondence from the International Bureau related to this/these international registration(s) will be sent only electronically and, therefore, you will no longer receive any paper correspondence. Likewise, any further correspondence from the International Bureau relating to other international applications or international registrations for which the same e-mail address has been, or will be, provided will also be sent only electronically. Please note that, for the purpose of electronic communication, there can be only one e-mail address recorded for each international registration.

ITEM 4: ENTITLEMENT OF THE NEW OWNER (TRANSFEREE) TO BE THE HOLDER OF THE INTERNATIONAL REGISTRATION

(a) Please indicate the Contracting Party(ies) through which the new owner is entitled to use the Madrid system – through nationality, domicile and/or a real and effective industrial or commercial establishment – and to be recorded as the holder of an international registration.

Where entitlement is derived from a connection with a member State of the European Union, the new owner may indicate, in (iii) or (iv) either the State, if it is also a Contracting Party to the Madrid system (e.g., France), or the European Union.

Where entitlement is derived from a connection with a member State of the European Union that is not itself a Contracting Party (e.g., Malta), the European Union should be indicated.

Where the international registration, that is the subject of the request for the recording of a change in ownership, includes the designation of a State party to the Agreement only, the new owner that has entitlement through a Contracting Party to the Protocol only and another entitlement through a Contracting Party to both the Agreement and the Protocol, should indicate either both entitlements or the second (larger) one, to ensure that the International Bureau records the requested change for all the designated Contracting Parties. For example, a new owner who is a national of Singapore and domiciled in Switzerland should indicate Switzerland, at least, if he wants to be recorded as the new holder in respect of the State party to the Agreement only.

If there are multiple new owners, provide information on the entitlement of each one. Note that it is not necessary for the Contracting Party and the nature of the particular connection to be the same for each of them. For example, new co-owner 1 may be a national of France and new co-owner 2 may be domiciled in the United States of America.

If there are no such connections (e.g., no connection through domicile in any of the Contracting Parties), simply write “None” or leave the space blank.

(b) Where the new owner is not a national of a Contracting Party or of a member State of the European Union, and the address given under item 3(b) is not in the territory of any Contracting Party where the new owner claims the entitlement, then the new owner must indicate an address in a Contracting Party where he is domiciled or where the industrial or commercial establishment is located. Provide the address in a form that will ensure prompt postal delivery.

ITEM 5: APPOINTMENT OF A REPRESENTATIVE BY THE NEW OWNER (TRANSFEREE)

Where the new owner wishes to appoint a representative for the first time or appoint a new one, the corresponding information should be entered in item 5 or a power of attorney or the MM12 form should be attached to the MM5 form.

The representative may be the recorded representative of the recorded holder or a new representative.

Name: Natural persons should indicate their family (or last) name and the given (or first) name in the order in which they are customarily used. Legal entities should indicate their full official designation.

If the name of the representative is in non-Latin characters, transliterate it into Latin characters, following the phonetics of the language of the international registration. Legal entities should replace the transliteration with a translation into the language of the international registration.

Address: Provide the address in a form that will ensure prompt postal delivery.

Telephone or facsimile numbers and an e-mail address may be given, so that the International Bureau can contact the representative. Telephone or facsimile numbers should include country and city codes, such as, for example +41 22 338 8686. The full e-mail address should be given, such as intreg.mail@wipo.int.

When an e-mail address is provided, any further correspondence from the International Bureau relating to this/these international registration(s) will be sent only electronically and, therefore, you will no longer receive any paper correspondence. Likewise, any further correspondence from the International Bureau relating to other international applications or international registrations for which the same e-mail address has been, or will be, provided will also be sent only electronically. Please note that, for the purpose of electronic communication, there can be only one e-mail address recorded for each international registration.

Remember to sign the form, otherwise the representative will not be recorded and all communications from the International Bureau will be sent directly to the holder of the international registration.

ITEM 6: SCOPE OF THE CHANGE IN OWNERSHIP

(a) Total change in ownership: Check this box if the change in ownership is total, that is if it relates to all the designated Contracting Parties and all the goods and services covered by the registration.

(b) Partial change in ownership: Check this box if the change in ownership is partial, that is if it relates to some only of the designated Contracting Parties and/or some only of the goods and services covered by the registration. Furthermore:

(i) indicate the specific Contracting Parties which are the subject of the change in ownership, and/or

(ii) indicate the specific goods and services which are the subject of the change in ownership.

The list of specific goods and/or services cannot be broader than the main list in the international registration, and semicolons (;) should be used. For example, if the international registration is for “shoes”, then “shoes” or “sandals” may be specified as the subject of the change in ownership, but “pants” or “hats” cannot be indicated since those goods are not included in the main list of the international registration.

(Box) If more space is needed to indicate the Contracting Parties or the goods and/or services, check this box to indicate the use of a continuation sheet.

ITEM 7: MISCELLANEOUS INDICATIONS

The indications requested in this item are required by a number of Contracting Parties. If such indications are omitted, an Office may declare that the change in ownership has no effect in its territory. Therefore, it is advisable to provide this information even though it is not compulsory.

The following information may be provided:

(a) Indications concerning the new owner (transferee)

(i) If the new owner (transferee) is a natural person, indicate the nationality.

(ii) If the new owner (transferee) is a legal entity, such as an incorporated body, the legal nature of the legal entity (for example, “limited liability company”), along with the name of the State and, where applicable, territorial unit, under the law of which the legal entity is incorporated or organized.

(b) If the new owner (transferee) wishes to receive communications from the International Bureau in the language in which the international application was filed, it is not necessary to check a box. Otherwise, a preferred language for correspondence should be selected, choosing between English, French and Spanish.

ITEM 8: SIGNATURE BY THE HOLDER (TRANSFEROR) AND/OR HIS REPRESENTATIVE

The MM5 form may be signed by the recorded holder or by the representative of the recorded holder. The signature should be handwritten, printed or stamped. It may also be replaced by the affixing of a seal.

Holder: Indicate the holder’s name as recorded in the International Register. Legal entities should indicate their name as recorded in the International Register (but not the name of the person signing the form).

Sign the form.

Representative: If the recorded holder is signing the form, there is no need for the representative to sign it as well. If the representative of the recorded holder is signing the form, indicate the name of the representative as recorded in the International Register.

ITEM 9: OFFICE OF THE CONTRACTING PARTY (OF THE RECORDED HOLDER OR THAT OF THE NEW OWNER) PRESENTING THE REQUEST (WHERE THE REQUEST IS PRESENTED THROUGH AN OFFICE)

This space should be left blank. If the form is presented through an Office, either the Office of the Contracting Party of the recorded holder or that of the new owner, the Office will fill in the relevant information.

FEE CALCULATION SHEET

The recording of a change in ownership is subject to the following fees payable to the International Bureau:

– for the total transfer of an international registration, the fee is 177 Swiss francs; and

– for a partial transfer (for some only of the goods and services or some only Contracting Parties) of an international registration, the fee is also 177 Swiss francs

(a) Instructions to debit from a current account: To debit the fees from a current account with the International Bureau, check this box.

The account holder, the account number and the party giving the instructions should be indicated. There is no need to calculate and indicate the amount of fees to be debited.

(b) Amount of fees: If the payment has already been made or if the payment is to be made into the WIPO bank account (worldwide) or postal account (Europe only), the relevant information should be entered here.

All necessary information on the amount of fees to be paid can be found in WIPO's "Schedule of Fees" document.

Do not forget to indicate the grand total (in Swiss francs).

(c) Method of payment: Identify the party effecting the payment, check the corresponding box and provide the required information.

REQUEST FOR THE RECORDING OF A LIMITATION OF THE LIST OF GOODS AND SERVICES

OFFICIAL FORM MM6 – EXPLANATORY NOTES

INTRODUCTION

To restrict the list of goods and services in respect of all or some of the designated Contracting Parties in an international registration, request a recording of a limitation using the official MM6 form.

Limitation can, for example, be used as an option to overcome an *ex officio* refusal or an opposition issued by a designated Contracting Party.

A single MM6 form can be used to request the recording of a limitation for multiple international registrations, provided that the holder is the same and the same limitation applies to all designated Contracting Parties or to the same designated Contracting Party for each of the international registrations.

With a limitation, the goods and services will remain in the main list of the international registration, but the goods and services which are the subject of the limitation will no longer have any effect in the designated Contracting Party in question. The recording of a subsequent designation (MM4) may be requested later for the goods and services which are the subject of the limitation.

The MM6 form can be presented to the International Bureau directly, by regular post to the address indicated in Part I or by sending a PDF version of the form by e-mail to intreg.mail@wipo.int. The form can also be presented through an Office (the Office of the Contracting Party of the holder). In this case, consult the Office on how the form should be submitted: on paper or via e-mail or other electronic means.

WHEN SHOULD THE MM6 FORM NOT BE USED?

To abandon **all** the goods and services in respect of **one or more but not all** of the designated Contracting Parties, use form MM7 instead (renunciation).

To remove goods and services permanently from the International Register, you should use form MM8 instead (partial cancellation).

HOW TO FILL IN THE MM6 FORM

ITEM 1: INTERNATIONAL REGISTRATION NUMBER(S)

Indicate the full international registration number(s), for example: 123456 or 123456A.

One MM6 form may contain a limitation for multiple international registrations provided that the holder is the same and the same limitation applies to all the designated Contracting Parties or to the same designated Contracting Party for each of the international registrations.

ITEM 2: NAME OF THE HOLDER (AS RECORDED IN THE INTERNATIONAL REGISTER)

Indicate the holder's name exactly as recorded in the International Register.

ITEM 3: APPOINTMENT OF A (NEW) REPRESENTATIVE (IF ANY)

To appoint a representative for the first time or appoint a new one, either enter the corresponding information in item 3 or attach a power of attorney or the MM12 form to the MM6 form.

To update the contact details of a representative already recorded in the International Register, use the MM10 form.

Name: Natural persons should indicate their family (or last) name and given (or first) name in the order in which they are customarily used. Legal entities should indicate their full official designation.

If the name of the representative is in non-Latin characters, it should be transliterated into Latin characters, following the phonetics of the language of the international registration. If the representative is a legal entity, the transliteration may be replaced by a translation into the language of the international registration.

Address: Provide the address in a form that will ensure prompt postal delivery.

Telephone or facsimile numbers and an e-mail address may be given, so that the International Bureau may contact the representative. Telephone or facsimile numbers should include country and city codes, such as, for example +41 22 338 8686. A full e-mail address should be given, such as intreg.mail@wipo.int.

When an e-mail address is provided, any further correspondence from the International Bureau relating to this/these international registration(s) will be sent only electronically and, therefore, you will no longer receive any paper correspondence. Likewise, any further correspondence from the International Bureau relating to other international applications or international registrations for which the same e-mail address has been, or will be, provided will also be sent only electronically. Please note that, for the purpose of electronic communication, there can be only one e-mail address recorded for each international registration.

Remember to sign the form, otherwise the representative will not be recorded and all communications from the International Bureau will be sent directly to the holder of the international registration.

ITEM 4: CONTRACTING PARTIES

Check box (a) if the limitation of the list of goods and services relates to all the designated Contracting Parties in the international registration(s).

Check box (b) if the limitation of the list of goods and services relates to some only of the designated Contracting Parties and indicate which ones are affected by the limitation.

ITEM 5: GOODS AND SERVICES

Use a font and font size large enough for easy reading and comprehension, such as the font "Courier New" or "Times New Roman", size 12 pt, and make consistent use of commas and semicolons.

If more space is needed, use a continuation sheet and check the corresponding box.

One or more entire classes may be limited or some only of the goods and services may be limited from a given class.

(a) If the limitation concerns some only of the goods and services in a given class, please provide the relevant class number and the complete list of the goods and services as it should appear, following the limitation. In other words, do not indicate the goods or services that you wish to limit from the currently recorded list.

The designation of the Contracting Parties indicated in item 4 will be limited to the goods and services appearing in this new list.

For example, if the international registration contains, in class 25, "clothing; footwear; headgear" and you want to limit certain designations to clothing and headgear, you could indicate that the new list in respect of those designations is "clothing; headgear".

If you want to keep certain footwear, you should clearly indicate the remaining scope, including the kind of footwear you want to keep in the designation; for instance "clothing; leather shoes, leather boots, leather sandals; headgear".

As a further example, if you want to limit footwear to sandals only, you could indicate that the new list is "clothing; sandals; headgear."

Finally, if you want to exclude sandals from footwear, you could indicate that the new list is "clothing; footwear, except sandals; headgear".

(b) To limit one or more entire classes, please indicate the class number(s) here.

If a class number is indicated here, it will be understood that the designation of the Contracting Parties indicated in item 4 no longer contains this class.

It shall be understood that the list of goods and services, as limited, may not be broader than the list contained in the international registration(s) mentioned in item 1.

Any class that is covered by the international registration(s) indicated in item 1, which is not mentioned in item 5(a) or (b), remains as recorded in the International Register.

ITEM 6: SIGNATURE BY THE HOLDER AND/OR HIS REPRESENTATIVE

The MM6 form may be signed by the holder or his representative. The signature should be handwritten, printed or stamped. It may also be replaced by the affixing of a seal.

Holder: Indicate the holder's name as recorded in the International Register. Legal entities should indicate the name as recorded in the International Register (but not the name of the person signing the form).

Sign the form.

Representative: If the representative signs the form, indicate the name of the representative as recorded in the International Register or indicated in the appointment of the representative in item 3, or as attached to this MM6 form (see item 3, above).

ITEM 7: OFFICE OF THE CONTRACTING PARTY PRESENTING THE REQUEST (WHERE THIS REQUEST IS PRESENTED THROUGH AN OFFICE)

This space should be left blank. If the form is presented through an Office (the Office of the Contracting Party of the holder), the Office will fill in the relevant information here.

FEE CALCULATION SHEET

For the recording of a limitation, the fee payable to the International Bureau is 177 Swiss francs per limitation, provided that, if the limitation affects more than one Contracting Party, it is the same for all of them.

(a) Instructions to debit from a current account: To debit the fees from a current account with the International Bureau, check this box.

The account holder, the account number and the party giving the instructions should be indicated. There is no need to calculate and indicate the amount of fees to be debited.

(b) Amount of fees: If the payment has already been made or if the payment is to be made into the WIPO bank account (worldwide) or postal account (Europe only), the relevant information should be entered here.

All necessary information on the amount of fees to be paid can be found in WIPO's "Schedule of Fees" document.

Do not forget to indicate the grand total (in Swiss francs).

(c) Method of payment: Identify the party effecting the payment, check the corresponding box and provide the required information.

REQUEST FOR THE RECORDING OF A RENUNCIATION

OFFICIAL FORM MM7 – EXPLANATORY NOTES

INTRODUCTION

To abandon the effects of an international registration for all the goods and services in respect of some (but not all) of the designated Contracting Parties, the recording of a renunciation should be requested using the official MM7 form.

Renunciation can, for example, be used when a refusal (including an opposition) has been issued by a designated Contracting Party and cannot, for the time being, be overcome.

A single MM7 form may be used to request the recording of a renunciation in respect of multiple international registrations with the same holder, provided that the designated Contracting Parties in respect of which the international registration is renounced are the same for each of the international registrations concerned.

With renunciation, the goods and services will remain in the main list of the international registration, but the mark will have no effect or enjoy no protection for the goods and services concerned in the designated Contracting Parties which are the subject of the renunciation. You may later request the recording of a subsequent designation (MM4) for the goods and services and the designated Contracting Parties which are the subject of the renunciation.

The MM7 form can be presented directly to the International Bureau, by sending the form by regular post (paper) to the address indicated in Part I, or by sending a PDF version of the form by e-mail to intreg.mail@wipo.int. However, where a renunciation concerns a country designated under the Agreement, the form must be presented through an Office (the Office of the Contracting Party of the holder). In this case, consult the Office on how the form should be submitted: on paper or via e-mail or other electronic means.

WHEN SHOULD THE MM7 FORM NOT BE USED?

To restrict the list of goods and services in respect of all or some of the designated Contracting Parties in an international registration, use the MM6 form (limitation) instead.

To remove the goods and services permanently from the International Register, use the MM8 form (partial cancellation) instead.

HOW TO FILL IN THE MM7 FORM

ITEM 1: INTERNATIONAL REGISTRATION NUMBER(S)

Indicate the full international registration number, for example 123456 or 123456A.

A single MM7 form may be used to request the recording of a renunciation in respect of multiple international registrations with the same holder, provided that the designated Contracting Parties in respect of which the international registration is renounced are the same for each of the international registrations.

ITEM 2: NAME OF THE HOLDER (AS RECORDED IN THE INTERNATIONAL REGISTER)

Indicate the holder's name exactly as recorded in the International Register.

ITEM 3: APPOINTMENT OF A (NEW) REPRESENTATIVE (IF ANY)

To appoint a representative for the first time or appoint a new one, enter the corresponding information in item 3 or attach a power of attorney or the MM12 form to this MM7 form.

To update the contact details of a representative already recorded in the International Register, use the MM10 form.

Name: Natural persons should indicate their family (or last) name and given (or first) name in the order in which they are customarily used. Legal entities should indicate their full official designation.

If the name of the representative is in non-Latin characters, it should be transliterated into Latin characters, following the phonetics of the language of the international registration. If the representative is a legal entity, the transliteration may be replaced by a translation into the language of the international registration.

Address: Provide the address in a form that will ensure prompt postal delivery.

Telephone or facsimile numbers and an e-mail address may be given, so that the International Bureau may contact the representative. Telephone or facsimile numbers should include country and city codes, such as, for example +41 22 338 8686. The full e-mail address should be given, such as intreg.mail@wipo.int.

When an e-mail address is provided, any further correspondence from the International Bureau relating to this/these international registration(s) will be sent only electronically and, therefore, you will no longer receive any paper correspondence. Likewise, any further correspondence from the International Bureau relating to other international applications or international registrations for which the same e-mail address has been, or will be, provided will also be sent only electronically. Please note that, for the purpose of electronic communication, there can be only one e-mail address recorded for each international registration.

Remember to sign the form, otherwise the representative will not be recorded and all communications from the International Bureau will be sent directly to the holder of the international registration.

ITEM 4: CONTRACTING PARTIES

Indicate the designated Contracting Parties for which the international registration is to be renounced.

ITEM 5: SIGNATURE BY THE HOLDER AND/OR HIS REPRESENTATIVE

The MM7 form may be signed by the holder or his representative. The signature should be handwritten, printed or stamped. It may also be replaced by the affixing of a seal.

Holder: Indicate the holder's name as recorded in the International Register. Legal entities should indicate the name as recorded in the International Register (but not the name of the person signing the form).

Sign the form.

Representative: If the representative signs the form, indicate the name of the representative as recorded in the International Register or indicated in the appointment of the representative in item 3, or as attached to this MM7 form (see item 3, above).

ITEM 6: OFFICE OF THE CONTRACTING PARTY OF THE HOLDER PRESENTING THE REQUEST (WHERE THIS REQUEST IS PRESENTED THROUGH AN OFFICE)

This space should be left blank. If the form is presented through an Office (the Office of the Contracting Party of the holder), the Office will enter the relevant information.

REQUEST FOR THE RECORDING OF A CANCELLATION OF THE INTERNATIONAL REGISTRATION

OFFICIAL FORM MM8 – EXPLANATORY NOTES

INTRODUCTION

To remove some or all of the goods and services in respect of all the designated Contracting Parties in an international registration, the recording of a cancellation can be requested using the official MM8 form. The cancellation can be total or partial.

A *total* cancellation relates to all the designated Contracting Parties and all the goods and services covered by the international registration. This means that an international registration is no longer wanted.

A *partial* cancellation relates to all the designated Contracting Parties and to some only of the goods and/or services covered by the international registration. This may be an option if specific goods or services are no longer of interest, the holder no longer sells certain goods or the holder wishes to avoid conflicts or cancellation actions in Contracting Parties where the mark is protected.

Note that, unlike with limitations (MM6), a cancellation causes the goods and services to be permanently removed from the International Register. To obtain protection again for the goods and services that were the subject of a cancellation, a new international application would need to be filed, since subsequent designation is not possible following a cancellation.

A single MM8 form may be used to request a total cancellation for multiple international registrations, provided that they are all in the name of the same holder.

If the request is for a partial cancellation, a separate MM8 form must be filled in for each international registration.

The MM8 form can be presented directly to the International Bureau, by regular post to the address indicated in Part I or by sending a PDF version of the form by e-mail to intreg.mail@wipo.int. However, where the cancellation affects a country designated under the Agreement, the form must be presented through an Office (the Office of the Contracting Party of the holder). In this case, consult the Office on how the form should be submitted: on paper or via e-mail or other electronic means.

WHEN SHOULD THE MM8 FORM NOT BE USED?

To restrict the list of goods and services in respect of all or some of the designated Contracting Parties in an international registration, use the MM6 form (limitation) instead.

To abandon the effects of an international registration for all the goods and services in respect of some (but not all) of the designated Contracting Parties, use the MM7 form (renunciation) instead.

HOW TO FILL IN THE MM8 FORM

ITEM 1: INTERNATIONAL REGISTRATION NUMBER(S)

Indicate the full international registration number(s), for example 123456 or 123456A.

ITEM 2: NAME OF THE HOLDER (AS RECORDED IN THE INTERNATIONAL REGISTER)

Indicate the holder's name exactly as recorded in the International Register.

ITEM 3: APPOINTMENT OF A (NEW) REPRESENTATIVE (IF ANY)

To appoint a representative for the first time or appoint a new one, enter the corresponding information in item 3 or attach a power of attorney or the MM12 form to this MM8 form.

To update the contact details of a representative already recorded in the International Register, use the MM10 form.

Name: Natural persons should indicate their family (or last) name and given (or first) name in the order in which they are customarily used. Legal entities should indicate their full official designation.

If the name of the representative is in non-Latin characters, it should be transliterated into Latin characters, following the phonetics of the language of the international registration. If the representative is a legal entity, the transliteration may be replaced by a translation into the language of the international registration.

Address: Please provide the address in a form that will ensure prompt postal delivery.

Telephone or facsimile numbers and an e-mail address may be given, so that the International Bureau can contact the representative. Telephone or facsimile numbers should include country and city codes, such as, for example +41 22 338 8686. The full e-mail address should be given, such as intreg.mail@wipo.int.

When an e-mail address is provided, any further correspondence from the International Bureau relating to this/these international registration(s) will be sent only electronically and, therefore, you will no longer receive any paper correspondence. Likewise, any further correspondence from the International Bureau relating to other international applications or international registrations for which the same e-mail address has been, or will be, provided will also be sent only electronically. Please note that, for the purpose of electronic communication, there can be only one e-mail address recorded for each international registration.

Please remember to sign the form. Otherwise the representative will not be recorded and all communications from the International Bureau will be sent directly to the holder of the international registration.

ITEM 4: GOODS AND SERVICES

Check box (a) if the cancellation relates to all of the goods and services covered by the international registration(s).

Check box (b) if the cancellation relates to some of the goods and services covered by the international registration(s).

A partial cancellation can involve, for example, canceling one or more entire classes or only some of the goods and services in (a) given class(es).

(i) To cancel one or more entire classes, please indicate the class number(s) here.

(ii) If the cancellation affects only some of the goods and services in a class, please indicate the remaining scope of that class following the cancellation.

For instance, if the list in class 25 is "clothing; footwear; headgear" and you want to cancel "footwear", you could indicate that the remaining scope is "clothing; headgear."

If you want to keep certain footwear, you should clearly indicate the remaining scope, including the kind of footwear you want to keep in the list; for instance "clothing; leather shoes, leather boots, leather sandals; headgear".

As a further example, if you want to cancel sandals only, you could indicate that the remaining scope is "clothing; footwear, except sandals; headgear".

Finally, if you want to cancel all footwear and keep sandals only, you could indicate that the remaining scope is "clothing; sandals; headgear".

Use a font and font size large enough for easy reading and comprehension, such as the font "Courier New" or "Times New Roman", size 12 pt, and make consistent use of commas and semicolons.

If more space is needed, use a continuation sheet and check the corresponding box.

Any class that is covered by the international registration(s) indicated in item 1, which is not mentioned in item 4(b)(i) or (ii), remains as recorded in the International Register.

ITEM 5: SIGNATURE BY THE HOLDER AND/OR HIS REPRESENTATIVE

The MM8 form may be signed by the holder or representative. The signature should be handwritten, printed or stamped. It may also be replaced by the affixing of a seal.

Holder: Indicate the holder's name as recorded in the International Register. Legal entities should indicate the name as recorded in the International Register (but not the name of the person signing the form).

Sign the form.

Representative: If the representative signs the form, indicate the name of the representative as recorded in the International Register or indicated in the appointment of the representative in item 3, or as attached to this MM8 form (see item 3, above).

ITEM 6: OFFICE OF THE CONTRACTING PARTY OF THE HOLDER PRESENTING THE REQUEST (WHERE THIS REQUEST IS PRESENTED THROUGH AN OFFICE)

This space should be left blank. If the form is presented through an Office (the Office of the Contracting Party of the holder), the Office will enter the relevant information.

LIMITATION, RENUNCIATION AND CANCELLATION

This illustration captures the main differences between limitation, renunciation and cancellation.

	Limitation (MM6 form)	Renunciation (MM7 form)	Cancellation (MM8 form)
Goods & Services	Some	All	Some or All
Designated Offices	Some or All	Some	All
Subsequent Designations	✓	✓	✗
Fees	177 CHF	Free of charge	Free of charge

REQUEST FOR THE RECORDING OF A CHANGE IN NAME AND/OR ADDRESS OF THE HOLDER

OFFICIAL FORM MM9 – EXPLANATORY NOTES

INTRODUCTION

Use the MM9 form to request the recording of a change in the holder's name and/or address (including the address for correspondence) for an international registration.

A single MM9 form can be used for multiple international registrations, provided that they are all recorded in the name of the same person or legal entity and at the same address.

To record a change in ownership, meaning a transfer from one legal entity to another or a change in the nature of a legal entity, use the MM5 form.

The MM9 form can be presented directly to the International Bureau, by regular post to the address indicated in Part I or by sending a PDF version of the form by e-mail to intreg.mail@wipo.int. The form can also be presented through the Office of the Contracting Party of the holder. In this case, consult the Office on how the form should be submitted: on paper or via e-mail or other electronic means.

HOW TO FILL IN THE MM9 FORM

ITEM 1: INTERNATIONAL REGISTRATION NUMBER(S)

Indicate the full international registration number, for example 123456 or 123456A.

ITEM 2: NAME OF THE HOLDER

Indicate the holder's name exactly as recorded in the International Register.

ITEM 3: CHANGE IN NAME AND/OR ADDRESS OF THE HOLDER

Check the first box to record a change in the holder's name and indicate the new name as follows:

Natural persons should indicate their family (or last) name and given (or first) name in the order in which they are customarily used.

Legal entities should indicate their full official designation.

If the holder's name is in non-Latin characters, it should be transliterated into Latin characters, following the phonetics of the language of the international registration. For a legal entity, the transliteration may be replaced by a translation into the language of the international registration.

If there are multiple recorded holders, indicate clearly which name is affected by the change.

Check the second box to record a change in the holder's address, telephone or facsimile numbers or e-mail address.

To record a change in address, indicate the new address in a form that will ensure prompt postal delivery.

If there are multiple recorded holders, indicate clearly which address is affected by the change.

Note that if there are multiple holders with different addresses and no representative or address for correspondence is indicated, all communications will be sent to the address of the holder named first in the registration certificate.

Telephone or facsimile numbers and an e-mail address should be indicated only if they have changed. They should be those of the person that the International Bureau should contact if it needs to get in touch. New telephone and facsimile numbers should include country and city codes, such as, for example +41 22 338 8686. The full e-mail address should be given, such as intreg.mail@wipo.int.

When an e-mail address is provided, any further correspondence from the International Bureau relating to this/these international registration(s) will be sent only electronically and, therefore, you will no longer receive any paper correspondence. Likewise, any further correspondence from the International Bureau relating to other international applications or international registrations for which the same e-mail address has been, or will be, provided will also be sent only electronically. Please note that, for the purpose of electronic communication, there can be only one e-mail address recorded for each international registration.

ITEM 4: ADDRESS FOR CORRESPONDENCE

Please fill this item in only if the recorded address for correspondence has changed or if you wish to record one.

The address should be given in a form that will ensure prompt postal delivery.

Note: To appoint a representative, fill in item 5, below, not item 4.

ITEM 5: APPOINTMENT OF A (NEW) REPRESENTATIVE (IF ANY)

To appoint a representative for the first time or appoint a new one, enter the corresponding information in item 5 or attach a power of attorney or the MM12 form to this MM9 form.

To update the contact details of a representative already recorded in the International Register, use the MM10 form.

Name: Natural persons should indicate their family (or last) name and given (or first) name in the order in which they are customarily used. Legal entities should indicate their full official designation.

If the name of the representative is in non-Latin characters, it should be transliterated into Latin characters, following the phonetics of the language of the international registration. If the representative is a legal entity, the transliteration may be replaced by a translation into the language of the international registration.

Address: Provide the address in a form that will ensure prompt postal delivery.

Telephone or facsimile numbers and an e-mail address may be given, so that the International Bureau can contact the representative. Telephone or facsimile numbers should include country and city codes, such as, for example +41 22 338 8686. The full e-mail address should be given, such as intreg.mail@wipo.int.

When an e-mail address is provided, any further correspondence from the International Bureau relating to this/these international registration(s) will be sent only electronically and, therefore, you will no longer receive any paper correspondence. Likewise, any further correspondence from the International Bureau relating to other international applications or international registrations for which the same e-mail address has been, or will be, provided will also be sent only electronically. Please note that, for the purpose of electronic communication, there can be only one e-mail address recorded for each international registration.

Remember to sign the form, otherwise the representative will not be recorded and all communications from the International Bureau will be sent directly to the holder.

ITEM 6: SIGNATURE BY THE HOLDER AND/OR HIS REPRESENTATIVE

The MM9 form may be signed by the holder or representative. The signature should be handwritten, printed or stamped. It may also be replaced by the affixing of a seal.

Holder: Indicate the holder's name as recorded in the International Register. Legal entities should indicate the name as recorded in the International Register (but not the name of the person signing the form).

Sign the form.

Representative: If the representative signs the form, indicate the name of the representative as recorded in the International Register or indicated in the appointment of the representative in item 5, or as attached to this MM9 form (see item 5, above).

ITEM 7: OFFICE OF THE CONTRACTING PARTY OF THE HOLDER PRESENTING THE REQUEST (WHERE THIS REQUEST IS PRESENTED BY OR THROUGH AN OFFICE)

This space should be left blank. If the form is presented through an Office (the Office of the Contracting Party of the holder), the Office will enter the relevant information.

FEE CALCULATION SHEET

The recording of a change in the name/address of the holder is subject to a fee, payable to the International Bureau, of 150 Swiss francs per form (one form may cover multiple international registrations).

(a) Instructions to debit from a current account: To debit the fees from a current account with the International Bureau, check this box.

The account holder, the account number and the party giving the instructions should be indicated. There is no need to calculate and indicate the amount of fees to be debited.

(b) Amount of fees: If the payment has already been made or if the payment is to be made into the WIPO bank account (worldwide) or postal account (Europe only), the relevant information should be entered here.

Information on the amount of fees to be paid can be found in WIPO's "Schedule of Fees" and "Individual Fees under the Madrid Protocol" documents.

Do not forget to indicate the grand total (in Swiss francs).

(c) Method of payment: Identify the party effecting the payment, check the corresponding box and provide the required information.

REQUEST FOR THE RECORDING OF A CHANGE IN NAME AND/OR ADDRESS OF THE REPRESENTATIVE

OFFICIAL FORM MM10 – EXPLANATORY NOTES

INTRODUCTION

Use the MM10 form to request the recording of a change in the name and/or address of a representative.

A single MM10 form can be used to request such recording for multiple international registrations, provided that the representative is recorded in the International Register for all of them and that the international registrations are specified.

To request the recording of a new representative, use the MM12 form instead.

The MM10 form can be presented directly to the International Bureau, by regular post to the address indicated in Part I or by sending a PDF version of the form by e-mail to intreg.mail@wipo.int. The form may be presented through the Office of the Contracting Party of the holder. In this case, consult the Office on how the form should be submitted: on paper or by e-mail or other electronic means.

HOW TO FILL IN THE MM10 FORM

ITEM 1: INTERNATIONAL REGISTRATION NUMBER(S)

Indicate the full international registration number(s), for example 123456 or 123456A.

ITEM 2: NAME OF THE REPRESENTATIVE

Indicate the name and address of the representative exactly as recorded in the International Register.

ITEM 3: CHANGE IN NAME AND/OR ADDRESS OF THE REPRESENTATIVE

Indicate only the contact details that have changed, otherwise leave this item blank.

New name: Natural persons should indicate their family (or last) name and given (or first) name in the order in which they are customarily used. Legal entities should indicate their full official designation.

If the name of the representative is in non-Latin characters, it should be transliterated into Latin characters, following the phonetics of the language of the international registration. If the representative is a legal entity, the transliteration may be replaced by a translation into the language of the international registration.

New address: Provide the address in a form that will ensure prompt postal delivery.

New telephone or facsimile numbers and e-mail address: They should be those of the person that the International Bureau should contact if it needs to get in touch with the representative. New telephone and facsimile numbers should include country and city codes, such as, for example +41 22 338 8686. The full e-mail address should be given, such as intreg.mail@wipo.int.

When an e-mail address is provided, any further correspondence from the International Bureau relating to this/these international registration(s) will be sent only electronically and, therefore, you will no longer receive any paper correspondence. Likewise, any further correspondence from the International Bureau relating to other international applications or international registrations for which the same e-mail address has been, or will be, provided will also be sent only electronically. Please note that, for the purpose of electronic communication, there can be only one e-mail address recorded for each international registration.

ITEM 4: SIGNATURE BY THE HOLDER AND/OR HIS REPRESENTATIVE

The MM10 form may be signed by the holder or representative. The signature should be handwritten, printed or stamped. It may also be replaced by the affixing of a seal.

Holder: Indicate the holder's name as recorded in the International Register. Legal entities should indicate the name as recorded in the International Register (but not the name of the person signing the form).

Sign the form.

Representative: If the representative signs the form, indicate the name of the representative as recorded in the International Register or indicated in item 3.

ITEM 5: OFFICE OF THE CONTRACTING PARTY OF THE HOLDER PRESENTING THE REQUEST (WHERE THIS REQUEST IS PRESENTED THROUGH AN OFFICE)

This space should be left blank. If the form is presented through an Office (the Office of the Contracting Party of the holder), the Office will enter the relevant information.

RENEWAL OF THE INTERNATIONAL REGISTRATION

OFFICIAL FORM MM11 – EXPLANATORY NOTES

INTRODUCTION

An international mark is valid for 10 years from the date of the international registration and it can be renewed every 10 years. Renewal is considered as a simple prolongation of the period of protection of an international registration.

Six months before the date of renewal, the International Bureau will send the holder an unofficial notice informing him of the renewal option.

To renew an international registration, use the optional form MM11. However, to renew an international registration as it is recorded, for all the designated Contracting Parties and all the designated goods and services, the simplest way is to use the E-Renewal platform, which accepts credit card payments.

An international registration can also be renewed via the E-Renewal platform when some only of the designated Contracting Parties are concerned by the renewal.

The advantages of using this platform instead of a paper form include the following:

- when the number of an international registration is entered, the platform will automatically indicate the Contracting Parties which may or may not be renewed;
- it will also indicate the Contracting Parties for which a total refusal of protection has been recorded in the International Register; and
- payments can be made by credit card.

In exceptional cases, it may not be possible to renew an international registration via the E-Renewal platform because it has been the subject of a limitation or other change which prevents e-renewal, in which case the MM11 form should be used or instructions given in a simple instruction letter to the International Bureau.

Since an international registration can only be renewed as it is recorded in the International Register, any changes should be recorded by submitting the relevant form to the International Bureau before the international registration is renewed.

Such changes may, for example, involve a change in name/address, a change in ownership or a limitation or a partial cancellation of the goods and services. By recording the relevant changes prior to the renewal, the fees to be paid (in case of limitation) may be reduced, and the Renewal Certificate will include the updated information.

Note that one MM11 form can be used to renew one international registration only.

The MM11 form must be presented directly to the International Bureau, by sending the form by regular post (paper) to the address indicated in Part I of this handbook, or by sending a PDF version of the form by e-mail to intreg.mail@wipo.int.

Example 1

An international registration can be renewed during the six months before the expiry of the period of protection. It is sufficient to pay renewal fees three months before the expiry date.

Example 2

An international registration can also be renewed during the first six months following the expiry of the current period of protection (the grace period), against payment of a surcharge fee for late renewal. It is not possible to renew an international registration after the expiry of the six-month grace period.

HOW TO FILL IN THE MM11 FORM

ITEM 1: INTERNATIONAL REGISTRATION NUMBER

Indicate the full international registration number, for example 123456 or 123456A.

There can only be one international registration number per MM11 form.

ITEM 2: NAME OF THE HOLDER

Indicate the holder's name exactly as recorded in the International Register.

ITEM 3: CONTRACTING PARTIES FOR WHICH RENEWAL IS REQUESTED

Indicate the Contracting Parties for which the international registration is to be renewed by checking the corresponding boxes.

ITEM 4: SIGNATURE

The signature should be handwritten, printed or stamped. It may also be replaced by the affixing of a seal.

Indicate the family (or last) name and the given (or first) name of the person signing the form (these names do not necessarily have to match the name of the recorded holder or his representative).

Sign the form.

FEE CALCULATION SHEET

The fees to be paid to obtain an international registration consist of:

- a basic fee (653 Swiss francs);
- a supplementary fee (100 Swiss francs for each class of goods and services beyond three classes); and
- a complementary fee (100 Swiss francs) for each designated Contracting Party which has not declared individual fee.

(a) Instructions to debit from a current account: To debit the fees from a current account with the International Bureau, check this box.

The account holder, the account number and the party giving the instructions should be indicated. There is no need to calculate and indicate the amount of fees to be debited.

(b) Amount of fees: If the payment has already been made or if the payment is to be made into the WIPO bank account (worldwide) or postal account (Europe only), the relevant information should be entered here.

To calculate and indicate the amount of fees due, use WIPO's Fee Calculator tool and select "Renewal" in the "Type" pick list. Information on the fees to be paid can be found in WIPO's "Schedule of Fees" and "Individual Fees under the Madrid Protocol" documents.

Do not forget to indicate the grand total (in Swiss francs).

(c) Method of payment: Identify the party effecting the payment, check the corresponding box and provide the required information.

APPOINTMENT OF A REPRESENTATIVE

OFFICIAL FORM MM12 – EXPLANATORY NOTES

INTRODUCTION

To appoint a person or a company to be a holder's representative before the International Bureau for one or more international applications or registrations, use the optional form MM12, send in a power of attorney, or appoint a representative using one of the official forms such as the MM4 (subsequent designation), MM5 (change in ownership) or MM6 (limitation) forms.

As far as the international procedure is concerned, the representative does not have to be domiciled in a member State of the Madrid system.

To appoint a representative before a specific designated Contracting Party, contact the Office of that Contracting Party for information on any specific requirements it may have.

A single MM12 form can be used to request the appointment of a representative for multiple international applications or registrations, provided that all applications and registrations are in the name of the same holder.

To update the contact details of a representative already recorded in the International Register, use the MM10 form.

The MM12 form may be presented directly to the International Bureau by the holder or his appointed representative, by regular post to the address indicated in Part I or by sending a PDF version of the form by e-mail to intreg.mail@wipo.int. The form can also be presented through an Office (Office of the Contracting Party of the holder). In this case, consult the Office on how the form should be submitted: on paper or via e-mail or other electronic means.

HOW TO FILL IN THE MM12 FORM

ITEM 1: NAME OF THE APPLICANT AND/OR HOLDER

Indicate the holder's name exactly as in the international application(s) or as recorded in the International Register.

ITEM 2: INTERNATIONAL APPLICATION(S)' REFERENCE(S) AND/OR INTERNATIONAL REGISTRATION NUMBER(S)

For international applications of which the registration number is not yet available, provide the following information: the mark, the Office of origin of the basic mark, the basic mark application/registration number(s) and date(s), the filing date of the international application before the Office of origin.

For international registrations, indicate the full registration number(s), for example 123456 or 123456A.

ITEM 3: REPRESENTATIVE

Name: Natural persons should indicate their family (or last) name and given (or first) name in the order in which they are customarily used. Legal entities should indicate their full official designation.

If the name of the representative is in non-Latin characters, transliterate it into Latin characters, following the phonetics of the language of the international registration. Legal entities should replace the transliteration with a translation into the language of the international registration.

Address: Provide the address in a form that will ensure prompt postal delivery.

Telephone or facsimile numbers and an e-mail address may be given, so that the International Bureau may contact the representative. Telephone or facsimile numbers should include country and city codes, such as, for example +41 22 338 8686. The full e-mail address should be given, such as, intreg.mail@wipo.int.

When an e-mail address is provided, any further correspondence from the International Bureau relating to this/these international application(s) and its/their resulting international registration(s) and/or this/these international registration(s) will be sent only electronically and, therefore, you will no longer receive any paper correspondence. Likewise, any further correspondence from the International Bureau relating to other international applications or international registrations for which the same e-mail address has been, or will be, provided will also be sent only electronically. Please note that, for the purpose of electronic communication, there can be only one e-mail address recorded for each international registration.

ITEM 4: SIGNATURE BY THE APPLICANT AND/OR HOLDER

The signature should be handwritten, printed or stamped. It may also be replaced by the affixing of a seal.

Indicate the applicant's name exactly as given in the international application(s) or the holder's name exactly as recorded in the International Register.

Legal entities should indicate their name as recorded in the International Register (but not the name of the person signing).

Remember to sign this item otherwise the representative will not be recorded and all communications from the International Bureau will be sent directly to the holder of the international registration.

ITEM 5: OFFICE OF THE CONTRACTING PARTY OF THE APPLICANT AND/OR HOLDER PRESENTING THE REQUEST (WHERE THIS REQUEST IS PRESENTED THROUGH AN OFFICE)

This space should be left blank. If the form is presented through an Office (the Office of the Contracting Party of the holder), the Office will enter the relevant information.