

HIGHLIGHTS

www.wipo.int/madrid/en

December 2013 | No. 4/2013

CONTENTS

| | |
|---|-----------|
| MADRID UNION | 2 |
| The Madrid Working Group | |
| Outcome of the Madrid Working Group Roundtable | |
| CONTRACTING PARTIES | 4 |
| Individual Fee Under Article 8(7) of the Madrid Protocol | |
| ONLINE SERVICES | 4 |
| Large Firms Subscribe to the Madrid Portfolio Manager (MPM) Service | |
| Online Services on the New WIPO Web Site | |
| Update on the Filing of Subsequent Designations | |
| MADRID TIPS | 5 |
| Practical Examples on the Implementation of the Madrid System: Transformation | |
| USEFUL INFORMATION | 6 |
| World Intellectual Property Report 2013 | |
| 2013 Edition of the Madrid Yearly Review | |
| World Intellectual Property Indicators – 2013 | |
| Madrid System Users Testimonial: Madagascan Trademark “DZAMA” | |
| Outcome of the Seminar on the Madrid System for the International Registration of Marks | |
| WIPO Non-Working Days 2014 | |
| The Madrid Customer Service – Opening Days During the Christmas Holidays | |
| Madrid Union Map | |
| CONTACT US | 10 |

Madrid Highlights is a quarterly publication of the World Intellectual Property Organization (WIPO) for the users of the Madrid System for the International Registration of Marks (Madrid system). Comments, suggestions, questions and inquiries regarding subscriptions may be sent to: madrid.highlights@wipo.int.

MADRID UNION

THE MADRID WORKING GROUP

Outcome of the eleventh session of the Working Group on the Legal Development of the Madrid System for the International Registration of Marks, held in Geneva, from October 30 to November 1, 2013

The documents discussed by the Madrid Working Group were referred to in the third issue of the Madrid Highlights and are available on the Madrid system's web site at the following address: www.wipo.int/meetings/en/details.jsp?meeting_id=29762.

During the eleventh session of the Working Group, 46 Contracting Parties to the Madrid Union, 13 States with observer status, one intergovernmental organization and eight international non-governmental organizations were represented. The following documents were discussed and the following conclusions reached:

I. Proposed Amendments to the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement (document [MM/LD/WG/11/2](#)).

The Working Group agreed to recommend the following three proposed amendments of the Common Regulations to the Madrid Union Assembly, for their adoption during its meeting in 2014:

(1) Introduction of a relief measure where the applicant or holder fails to meet specific time limits:

Where the applicant or holder fails to meet specific time limits, he may in the future be able to request continued processing of his application/subsequent designation/request for recording of a change or a license. This proposed new Rule 5*bis* will allow the International Bureau to revive and continue the processing of the received application or the particular request, for a proposed fee of 200 Swiss francs.

(2) Partial renewal of an international registration:

Where a designated Contracting Party only grants protection for a limited number of classes of goods and services, this decision will in the future be reflected in the renewal process, so the holder can renew his international registration only for these protected classes, without having to request a limitation prior to the due date of the renewal. This may have great impact on the total amount of fees to be paid where the designated Contracting Parties require individual fees.

(3) Notification to the holder and his representative where an international registration is not renewed:

Where an international registration is to be cancelled because it has not been renewed, the holder and his representative will in the future also be notified of this fact, and not just the designated Contracting Parties.

II. Proposal for the Introduction of the Recordal of Division or Merger Concerning an International Registration (document [MM/LD/WG/11/3](#)).

The Working Group continued its discussion on the possible introduction of the division of an international registration, and it requested that the International Bureau prepare, for the next session, a document that would provide detailed information on the operational implementation of division and merger concerning an international registration, at the level of the International Bureau as well as at the level of a designated Contracting Party. The document would also indicate how such implementation would affect the Contracting Parties, in particular their workload, as well as analyze the impacts on costs and workload of the International Bureau, and, finally, also propose a timeframe for such implementation.

III. Information Concerning Ceasing of Effect, Central Attack and Transformation (document [MM/LD/WG/11/4](#)).

This topic was a follow-up from the ninth session of the Working Group and stems from previous discussions on the possible deletion of the requirement of a basic mark (Proposal by Norway), during which the issue of central attack was raised with reference to lack of statistics of such use. The Working Group requested that the International Bureau prepare a document that would analyze all aspects of the freezing of the principle of dependency and make reference to the various concerns that had been raised during its discussion, in particular, central attack and bad-faith international applications.

IV. Proposal to Freeze the Application of Article 14(1) and (2)(a) of the Madrid Agreement Concerning the International Registration of Marks (document [MM/LD/WG/11/5](#)).

This document raised the possibility of freezing the application of Article 14(1) and (2)(a) of the Agreement and referred to two precedents in the history of WIPO concerning freezing whole treaties. The Working Group requested that the International Bureau prepare, for its thirteenth session a document that would, in the context of public international law, review the legal framework for the freezing, either totally or partially, of international treaties, and its possible consequences. The document would also consider other options that might achieve the objective of what had been proposed in document [MM/LD/WG/11/5](#) without the need to resort to the freezing of the application of Article 14(1) and (2)(a) of the Madrid Agreement Concerning the International Registration of Marks.

OUTCOME OF THE MADRID WORKING GROUP ROUNDTABLE

The third Madrid Working Group Roundtable was held on October 29, 2013, during the week of the eleventh session of the Working Group.

The Roundtable provides a good opportunity to create a platform for networking and sharing of experiences between the International Bureau and the representatives from Offices, intergovernmental organizations and organizations representing trademark holders and agents. It was a huge success, with 60 participants from the Working Group attending, both representatives from Contracting Parties and from organizations.

The main topics of the Roundtable were the latest developments of the Madrid system, irregularities and how to reduce the number of irregularities in international applications, limitations of goods and services, and communication in the Madrid system.

The presentations made during the Madrid Working Group Roundtable are available on the Madrid system's web site at the following address:

www.wipo.int/meetings/en/details.jsp?meeting_id=31426.

CONTRACTING PARTIES

INDIVIDUAL FEE UNDER ARTICLE 8(7) OF THE MADRID PROTOCOL

Changes in the Amount of the Individual Fee under Article 8(7) of the Madrid Protocol

The newly established amounts of individual fees payable when Switzerland, India and Colombia are designated in an international application, in a designation subsequent to an international registration or in respect of the renewal of an international registration under the Madrid system, can be found in the Information Notices [No. 30/2013](#), [No. 31/2013](#) and [No. 32/2013](#), respectively.

ONLINE SERVICES

LARGE FIRMS SUBSCRIBE TO THE MADRID PORTFOLIO MANAGER (MPM) SERVICE

Two very important trademark holders of international registrations under the Madrid system have recently subscribed to the service of the Madrid Portfolio Manager (MPM): the Swiss giant, Novartis Pharma AG, one of the world's largest pharmaceutical companies, with a portfolio of more than 1250 international trademark registrations and Red Bull AG, the well-known Austrian food and beverages firm, that owns more than 500 international trademark registrations.

Holders of international registrations increasingly recognize the advantages of using the MPM to manage their files.

This service is available at: <https://www3.wipo.int/login/en/mpm/index.jsp>.

For more information and assistance, please contact e-marks@wipo.int.

ONLINE SERVICES ON THE NEW WIPO WEB SITE

The online services are located under “**Key Resources**” in the middle of the Madrid system Home page, featuring the most frequently used online services: <http://www.wipo.int/madrid/en/>. To access the complete set of services, please select “All resources”.

UPDATE ON THE FILING OF SUBSEQUENT DESIGNATIONS

In the last issue of the Madrid Highlights we announced the launch of a new Madrid online service for the filing of subsequent designations.

A pilot group of our most frequent users with access to this service have successfully processed a considerable number of transactions. Based on their feedback, some improvements have been implemented and the new version is being tested. We expect to launch this service early next year. It will also be made available on our website under “**Key resources – All resources**” (see the web address above).

MADRID TIPS**PRACTICAL EXAMPLES ON THE IMPLEMENTATION OF THE MADRID SYSTEM: TRANSFORMATION**

- Where the Office of origin requests the cancellation (total or partial) of an international registration due to the ceasing of effect of the basic mark, the holder may transform his right by filing a national/regional application for the same mark with the Office of a designated Contracting Party.
- Transformation is only provided for by the Protocol.
- Transformation may only follow a cancellation of the international registration as a result of a total or partial “ceasing of effect” of the basic application or registration within the 5 years dependency period.
- Transformation limits the effects of dependency.
- Transformation offers the possibility for the holder of an international registration to keep his rights intact, by transforming the international registration into a national/regional application filed directly with the Office of the designated Contracting Party.
- Transformation must be filed within three months from the date on which the cancellation of the international registration at the request of an Office of origin was recorded in the International Register.
- An application for transformation shall be treated, by the Office of the designated Contracting Party, as if it had been filed on the date of the international registration or on the date of the subsequent designation.
- Actual process is subject to national laws, regulations and practices (there is no WIPO procedure).

Q1. Is it possible to “transform” several designations under an international registration into different national registrations, without the basic application or registration being cancelled?

R1. Transformation can only follow a cancellation of the international registration requested by the Office of origin in accordance with Article 6(4) of the Protocol. Thus, if the holder voluntarily limits or renounces the protection of his international registration, or asks for its cancellation, he cannot then make use of the possibility provided for in Article 9*quinquies* of the Protocol to ask for transformation of the international registration into national applications while keeping the date of the international registration.

Q2. Although my basic application was cancelled more than a year ago, the International Bureau has not yet recorded the cancellation in the International Register. In order to apply for the transformation, the International Bureau must notify me as the holder and the designated Offices as soon as possible.

R2. The International Bureau cannot record the cancellation of an international registration under Article 6(4) unless it is notified by the Office of origin that the basic application or registration has ceased to have effect. The Office of origin is only obliged to notify the International Bureau where the ceasing of effect of the basic application or registration takes place in the five year dependency period. However, keep in mind that the three-month time limit to request a transformation starts from the date of the recording of the cancellation in the International Register, not from the date of the ceasing of effect of the basic application or registration. Furthermore, the application for transformation shall be treated, by the Office of the designated Contracting Party, as if it had been filed on the date of the international registration or on the date of the subsequent designation.

Q3. We have received the notification of cancellation of our international registration at the request of the Office of origin in accordance with Article 6(4) of the Protocol. However, there is no date on which the international registration was cancelled in the notification sent by the International Bureau. Which date is the date of cancellation, the date of recordal in the International Register or the effective date of cancellation of the basic application?

R3. The date of recordal in International Register is the date of cancellation of the international registration. Therefore, the national application must be filed within three months of that date of recordal in the International Register.

Q4. Is there a form that can be used for filing an application for transformation?

R4. This filing is not governed by the Protocol or the Regulations, nor is the International Bureau involved in any way. It is up to each Contracting Party to determine the modalities for giving effect to such transformation into a national or regional application. Since this is a matter entirely between the holder of the cancelled international registration and the Offices of the Contracting Parties designated in said registration, the International Bureau does not have any form for filing an application for transformation.

You may find a brief reference to the procedures in place regarding transformation in various Contracting Parties at the following address:

http://www.wipo.int/madrid/en/members/ipoffices_info.html. The information concerning transformation procedures for each Party, as reported by the Offices concerned, is under the "Miscellaneous" tab.

USEFUL INFORMATION

WORLD INTELLECTUAL PROPERTY REPORT 2013

Brands – Reputation and Image in the Global Marketplace

Brands are an important aspect of everyday life. For companies, the reputation and image that brands convey can be an important source of competitive advantage. Yet, evidence on the economy-wide implications of branding is still limited.

The World Intellectual Property Report 2013, published by the World Intellectual Property Organization (WIPO), explores the role that brands play in today's global marketplace. The Report looks at how branding behavior and trademark use have evolved in recent history, how they differ across countries, what is behind markets for brands, what lessons economic research holds for trademark policy, and how branding strategies influence companies' innovation activities.

You can find out more by visiting the following web page:

http://www.wipo.int/econ_stat/en/economics/wipr, which also contains a link to the report's press release and, in the near future, will host the video of the launch event.

2013 EDITION OF THE MADRID YEARLY REVIEW

Prepared by WIPO with the support of many intellectual property offices, the 2013 edition of the Madrid Yearly Review contains comprehensive statistical and other information on the use of the Madrid system, its administration (including revenues and fees), and the latest developments regarding its geographical scope and legal framework.

The 2013 Madrid Yearly Review is available at:

http://www.wipo.int/export/sites/www/freepublications/en/marks/940/wipo_pub_940_2012.pdf.

Paper copies (free of charge) can be ordered by sending an e-mail to: publications.mail@wipo.int.

WORLD INTELLECTUAL PROPERTY INDICATORS – 2013

WIPO's World Intellectual Property Indicators 2013 provides a wide range of indicators covering the following areas of intellectual property: patents, utility models, trademarks, industrial designs, microorganisms and plant varieties protection. It draws on data from national and regional IP offices, WIPO, the World Bank and the United Nations Educational, Scientific and Cultural Organization (UNESCO).

The World Intellectual Property Indicators 2013 is available at:

http://www.wipo.int/export/sites/www/freepublications/en/intproperty/941/wipo_pub_941_2013.pdf.

Paper copies (free of charge) can be ordered by sending an e-mail to: publications.mail@wipo.int.

MADRID SYSTEM USERS TESTIMONIAL: MADAGASCAN TRADEMARK “DZAMA”

VIDZAR, a Madagascan producer of rum and liqueurs for over 30 years, was interviewed last July in order to find out what the Madrid system represents to one of its recent users. They found the Madrid system to be a reliable and quality partnership for their export development strategy.

We invite you to find out why the system has become an extraordinary tool for LDC businesses like VIDZAR and how the scope of protection of a trademark like DZAMA can expand internationally. In this regard, you may wish to watch our new video interview from the series “What Users Say About the Madrid System” which can be found at:

<http://www.wipo.int/multimedia/en/madrid/madrid-videos/index.html>.

OUTCOME OF THE SEMINAR ON THE MADRID SYSTEM FOR THE INTERNATIONAL REGISTRATION OF MARKS

WIPO continues to see training as the best initiative to promote the better use of the Madrid system among users.

These Seminars, already traditional since 1996, aim at responding to the wishes of users for guidance on the potential of the Madrid system, the need to address their daily legal and operational concerns and to provide them with the necessary updates on the recent developments and trends.

Hence, the 49th session of the Seminar on the Madrid System for the International Registration of Marks has just taken place at the International Bureau of WIPO in Geneva, on November 28 and 29, 2013.

This Seminar was attended by over 45 participants of 25 countries, from mainly industry, independent and in-house trademark agents (paralegals as well as attorneys) most of whom file applications for international registration of trademarks and/or who administer such registrations. Representatives of some national Intellectual Property Offices also participated in the Seminar.

The event takes place twice a year at the headquarters of WIPO in Geneva; one in spring and another in autumn, respectively. To stay updated in this respect, users may wish to subscribe to the Madrid E-Newsletter (<http://www.wipo.int/madrid/en/subscribe.html>) to receive automated e-mail notices on Madrid system matters, including forthcoming meetings and seminars.

WIPO NON-WORKING DAYS IN 2014

Pursuant to Rule 32(2)(v) of the Common Regulations, users are hereby informed that, in addition to Saturdays and Sundays, the International Bureau of the World Intellectual Property Organization (WIPO) is not scheduled to be open to the public on the following days in 2014:

Wednesday, January 1, 2014 (New Year)
 Thursday, January 2, 2014 (New Year)
 Friday, April 18, 2014 (Easter)
 Monday, April 21, 2014 (Easter)
 Thursday, May 29, 2014 (Ascension)
 Monday, June 9, 2014 (Whitsun)
 Thursday, September 11, 2014 (Jeûne Genevois)
 Monday, October 6, 2014 (Eid Al-Adha)
 Thursday, December 25, 2014 (Christmas)
 Friday, December 26, 2014 (Christmas)

For more information, see Information Notice [No. 33/2013](#).

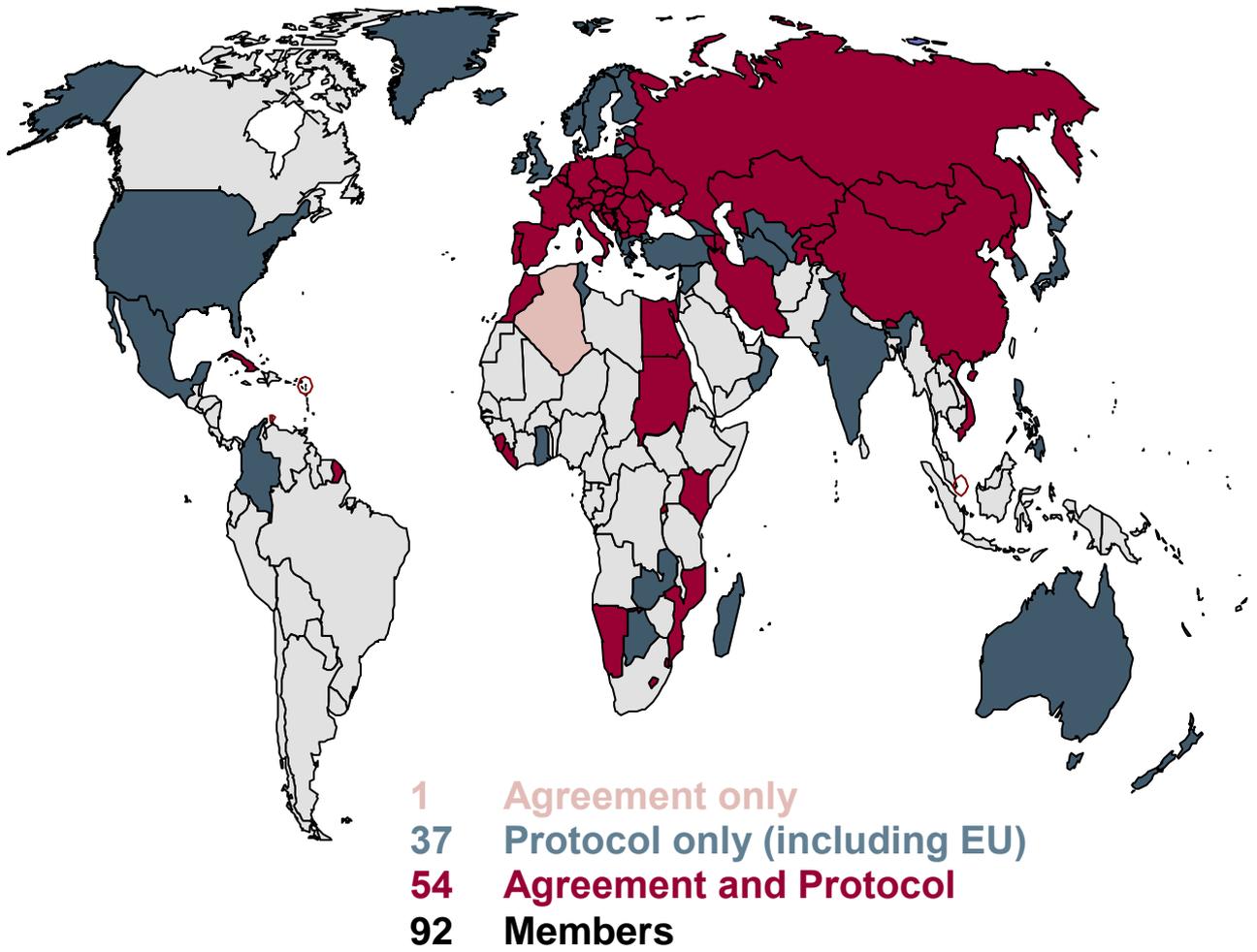
THE MADRID CUSTOMER SERVICE – OPENING DAYS DURING THE CHRISTMAS HOLIDAYS

Please note that during the Christmas holidays, in addition to the official WIPO non-working days (see information above), the Madrid Customer Service will not be reachable by phone on December 24, 2013.

| | |
|------------------------------|--|
| Monday, December 23, 2013 | Normal opening hours |
| Tuesday, December 24, 2013 | IB is open, but Customer Service closed. |
| Wednesday, December 25, 2013 | IB is closed. |
| Thursday, December 26, 2013 | IB is closed. |
| Friday, December 27, 2013 | Normal opening hours |
| Monday, December 30, 2013 | Normal opening hours |
| Tuesday, December 31, 2013 | Normal opening hours |
| Wednesday, January 1, 2014 | IB is closed. |
| Thursday, January 2, 2014 | IB is closed. |
| Friday, January 3, 2014 | Normal opening hours |

If you have any queries, you can always contact your Madrid Team or send an e-mail to intreg.mail@wipo.int.

MADRID UNION MAP



HOW TO CONTACT US:

General Queries: Madrid Customer Service +41 22 338 8686. Email: intreg.mail@wipo.int

Telephone Opening Hours: 9.00 a.m. to 6.00 p.m. Central European time (3.00 a.m. to 11.00 a.m. US Eastern time zone).

Extracts Queries: Clients Records Unit +41 22 338 8484. E-mail: madrid.records@wipo.int

Specific Queries: Contact our Teams, organized according to your Office of Origin/residence.

Team 1:
madrid.team1@wipo.int
Phone +41 22 338 750 1

Team 2:
madrid.team2@wipo.int
Phone +41 22 338 750 2

Team 3:
madrid.team3@wipo.int
Phone +41 22 338 750 3

AG [Antigua and Barbuda](#)
AM [Armenia](#)
BG [Bulgaria](#)
BQ [Bonaire, Saint Eustatius and Saba](#)
CH [Switzerland](#)
CO [Colombia](#)
CU [Cuba](#)
CW [Curaçao](#)
CZ [Czech Republic](#)
DZ [Algeria](#)
EG [Egypt](#)
EM [European Union](#)
ES [Spain](#)
FR [France](#)
HU [Hungary](#)
KP [Democratic People's Republic of Korea](#)
LI [Liechtenstein](#)
MA [Morocco](#)
MC [Monaco](#)
MD [Republic of Moldova](#)
MG [Madagascar](#)
MK [The former Yugoslav Republic of Macedonia](#)
MN [Mongolia](#)
MX [Mexico](#)
MZ [Mozambique](#)
PL [Poland](#)
PT [Portugal](#)
RO [Romania](#)
ST [Sao Tome and Principe](#)
SX [Saint Maarten](#)
SY [Syrian Arab Republic](#)
TN [Tunisia](#)

AL [Albania](#)
AT [Austria](#)
AZ [Azerbaijan](#)
BA [Bosnia and Herzegovina](#)
BX [Benelux](#)
BY [Belarus](#)
DE [Germany](#)
EE [Estonia](#)
GE [Georgia](#)
GH [Ghana](#)
HR [Croatia](#)
IN [India](#)
IR [Iran \(Islamic Republic of\)](#)
IT [Italy](#)
KG [Kyrgyzstan](#)
KZ [Kazakhstan](#)
LR [Liberia](#)
LS [Lesotho](#)
LT [Lithuania](#)
LV [Latvia](#)
ME [Montenegro](#)
NA [Namibia](#)
RS [Serbia](#)
RU [Russian Federation](#)
SD [Sudan](#)
SI [Slovenia](#)
SK [Slovakia](#)
SL [Sierra Leone](#)
SM [San Marino](#)
SZ [Swaziland](#)
TJ [Tajikistan](#)
TM [Turkmenistan](#)
UA [Ukraine](#)
UZ [Uzbekistan](#)
ZM [Zambia](#)

AU [Australia](#)
BH [Bahrain](#)
BT [Bhutan](#)
BW [Botswana](#)
CN [China](#)
CY [Cyprus](#)
DK [Denmark](#)
FI [Finland](#)
GB [United Kingdom](#)
GR [Greece](#)
IE [Ireland](#)
IL [Israel](#)
IS [Iceland](#)
JP [Japan](#)
KE [Kenya](#)
KR [Republic of Korea](#)
NZ [New Zealand](#)
NO [Norway](#)
OM [Oman](#)
PH [Philippines](#)
RW [Rwanda](#)
SE [Sweden](#)
SG [Singapore](#)
TR [Turkey](#)
US [United States of America](#)
VN [Viet Nam](#)

DISCLAIMER: This material can be copied, reprinted, distributed and adapted for non-commercial purposes. Corresponding copyright notice should be made under the following terms: Copyright © 2013 by WIPO. For additional special permission requests regarding excluded uses, please contact: intreg.mail@wipo.int