

HIGHLIGHTS

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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.

CONTRACTING PARTIES

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

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

The newly established amounts of individual fees payable when Australia, Israel and Finland are designated in an international application, 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 Information Notices [No. 34/2013](#), [No. 2/2014](#) and [No. 3/2014](#), respectively.

ONLINE SERVICES

LATEST NEWS ON THE MADRID GOODS AND SERVICES MANAGER (MGS)

What did 2013 mean for the Madrid Goods and Services Manager and what will 2014 bring?

MGS is moving ahead with many achievements in 2013 including the addition of new languages such as Chinese, Japanese, Norwegian and Turkish to the 10 previously available languages, the introduction of multi-directional translation and the new WIPO-exclusive function “Check acceptance by designated Contracting Party”, with the participation of 16 Offices from all around the world.

The number of visits to MGS’s web site has more than tripled since 2011. The reason for such a significant growth is associated, in particular, with the jump, in January 2012, to 10 languages, most of which are non-European.

Moreover, MGS is very popular among users from Colombia, India and Mexico. Although these countries recently joined the Madrid system, they already feature among the top 10 of the 155 visiting countries in 2013, further boosting the popularity of MGS.

The year 2014 promises to be an excellent year too, with the hope of attracting the interest of many more users. The current version of MGS already provides the acceptance status for all MGS participating countries in respect of the segments of the Class Headings of the Nice Classification, the acceptance status as designated Contracting Party for three new participating countries (Republic of Korea, Serbia and Ukraine), two new language interfaces (Korean and Serbian), and a new display to aid color-blind people.

Further developments regarding MGS will be the subject of a new article in the next issue of the Madrid Highlights.

FEE CALCULATOR

Based on users’ recommendations, we have revisited the Madrid [fee calculator](#). Some improvements regarding the text displayed, such as the Contracting Party’s full name have been implemented and the design has been aligned with that of the new WIPO web site.

We hope these improvements will assist in estimating the cost of an international application, a subsequent designation, the second part of the individual fee for Cuba, Ghana and Japan, and/or the renewal of an international registration in a more effective manner.

The [fee calculator](http://www.wipo.int/madrid/en/fees/calculator.jsp) is available at: <http://www.wipo.int/madrid/en/fees/calculator.jsp>.

E-SUBSEQUENT DESIGNATION IS NOW AVAILABLE

As announced in previous editions of the Madrid Highlights, we are pleased to launch the new Madrid electronic forms for [subsequent designations](#).

It is easy to use [e-subsequent designation](#) by entering an international registration number, selecting the Contracting Party/Parties to which protection of an international registration is to be extended, indicating the goods and services, and paying online by credit card or through a [WIPO current account](#). An acknowledgement will immediately be issued of the fact that the request has been correctly submitted through a confirmation screen followed by an e-mail.

[E-subsequent designation](#) is a simple tool that responds to the needs of the users of the Madrid system. However, for some particular cases, it is still recommended to use the paper form [MM4](#). More details on [e-subsequent designation](#) can be found through this link: <https://www3.wipo.int/osd/index.xhtml>.

Like [e-renewal](#), [e-subsequent designation](#) is also incorporated into the Madrid Portfolio Manager ([MPM](#)).

MADRID TIPS

PRACTICAL EXAMPLES ON THE IMPLEMENTATION OF THE MADRID SYSTEM: QUESTIONS ON THE CLASSIFICATION OF GOODS AND SERVICES

Q1. Do I need to classify the goods and services in my international application?

R1. Yes, you need to classify them according to the Nice Classification.

Q2. What is the Nice Classification?

R2. The Nice Classification is a system used to classify goods and services for the purpose of registering trademarks. It groups related goods and services under categories or classes. Each class has a heading. Goods or services are listed alphabetically under each class. For instance, the heading of class 12 is “*vehicles; apparatus for locomotion by land, air or water*”. Among the goods listed alphabetically under this class are “*air balloons, aircraft, automobiles, barges and bicycles*”¹.

Q3. Would the International Bureau always register the goods and services in the classes that I have indicated in my international application?

R3. Not in all cases. The International Bureau must make sure that the goods and services are classified according to the edition and version of the Nice Classification that is in effect on the date the mark is registered (which normally is the date on which the international application was filed).

¹ More information is available at: http://www.wipo.int/classifications/nice/en/about_the_ncl/faq.html.

Q4. What do you mean by edition and version of the Nice Classification?

R4. The Nice Classification is continuously revised by a Committee of Experts. A new edition is published every five years and a new version is published annually. The 2014 version of the tenth edition of the Nice Classification (NCL 10-2014) entered into force on January 1, 2014. So, as from that date, international registrations must have goods and services classified according to this version.

Q5. What can I do if the product or service I want to protect is not in the Nice Classification?

R5. You can search the Madrid Goods and Services Manager's (MGS) database which contains some 40,000 classified terms, including the terms in the Nice Classification. You can confirm their acceptance by the International Bureau and by some national and regional trademark Offices. MGS is available in 14 languages and has several useful features².

Q6. What if the product or service I want to protect is not in MGS?

R6. The Nice Classification has general remarks with criteria that should be applied to classify terms. If you are not certain, you should always ask an expert.

Q7. What happens if the International Bureau disagrees with the classification I made in my international application?

R7. The International Bureau will send a notice to the national or regional trademark Office where you filed your international application (the Office of origin) and it will also send you a copy. In the notice, the International Bureau will propose a classification. The Office of origin has three months to reply. In the event of disagreement between the Office and the International Bureau, the opinion of the International Bureau shall prevail.

Q8. Can I reply to the notice sent by the International Bureau?

R8. You cannot send your reply directly to the International Bureau. You can send your opinion to the Office of origin and that Office will communicate it to the International Bureau.

Q9. What happens after the International Bureau has made a decision?

R9. If the decision results in new classes, the International Bureau will calculate the new amount of the fees. Once you have paid all the fees, the mark will be registered with the term(s) in the class selected by the International Bureau.

Q10. What can I do if the International Bureau has made a mistake in the classification of the goods and services in my international registration?

R10. You can request that the International Bureau correct the mistake. The mistake needs to be clear and not just a disagreement with how the International Bureau has classified a term.

Q11. What legal effect has the Nice Classification in the national or regional Offices where I seek protection (the designated Offices)?

R11. The Nice Classification is a technical system and each designated Office assigns it the effect that is determined in its national or regional legislation or according to its practices.

² MGS is available at: <http://www.wipo.int/mgs/>.

Q12. Can I indicate the heading of a class in my international application?

R12. Yes. However, some designated Offices do not accept class headings. Other Offices only accept headings for certain classes. Finally, Offices that accept class headings may attribute different meanings to them. For example, an Office may consider that the heading covers all goods or services in the alphabetical list of the class while another Office may consider that it simply covers the goods or services that appear in the heading.

Q13. Will the goods and services in my international registration be reclassified when a new edition or version of the Nice Classification enters into force?

R13. No, they will not be reclassified.

Q14. Will the goods and services be reclassified if the Office of origin reclassifies them in the application or registration that I used to file my international application (the basic mark)?

R14. No, the reclassification of a term in the basic mark has no impact on the international registration.

Q15. What can I do if a designated Office requires that I specify goods and services in more detail?

R15. When filing an international application, you may request that a limitation of the list of goods and services has effect with respect to one or more designated Offices. In the limitation, goods and services may be expressed in a way that is accepted by the designated Office.

The terms used in the limitation must fall within the scope of the terms used in your application. For example, if in your application you have “*coffee*”, you could limit it to “*ground coffee*.”

MADRID OUTREACH

INTERNATIONAL TRADEMARK ASSOCIATION (INTA) 2014

This year, the 136th Annual Meeting of the International Trademark Association (INTA), the world’s largest trademark event, is scheduled to take place in Hong Kong, China, from May 10 to 14, 2014, at the Hong Kong Convention Exhibition Center (HKCEC).

INTA is well known to attract at least 9000 attendees from around the globe amongst who are IP practitioners, trademark owners, paralegals and lawyers from both the public and private sector. There is no better place for these specialists to network.

WIPO will, as usual, seize this occasion to promote its trademark-related services through two popular events: the Madrid System User’s Meeting (MSUM) and a WIPO booth.

MSUM is designed to bring together users of the Madrid system, a panel of experts from WIPO and the most designated Offices and is slated to take place on May 11, 2014, from 11 a.m. to 2 p.m. This year MSUM will feature discussions such as practices and procedures before IP Offices of selected Contracting Parties as well as latest developments and updates on the system.

A WIPO booth will also exhibit products and services of the Madrid and the Hague systems as well as the Arbitration and Mediation Center in the Exhibition Hall, from May 11 to 14, 2014.

SEMINAR ON THE MADRID SYSTEM FOR THE INTERNATIONAL REGISTRATION OF MARKS

The 50th session of the Seminar on the Madrid System is scheduled for June 19 and 20, 2014, at WIPO's headquarters in Geneva. The Madrid Seminar offers a unique training platform where all aspects of the system are covered in-depth by experts from WIPO, officials from national or regional Offices and trademark practitioners.

The Seminar also offers an excellent opportunity for the participants to network and share their common interests and experiences.

Detailed information regarding this Seminar, including the program and the online registration facilities will soon be posted on the Madrid web site at: <http://www.wipo.int/madrid/en/news/>.

USEFUL INFORMATION

INTERNATIONAL REGISTRATIONS HAVE GROWN FOR THE THIRD CONSECUTIVE YEAR

Since the global downturn in 2009, 2013 marked a fourth year of continued growth in international registrations via the WIPO-administered Madrid system, as reflected in the table below. The system reported an increase of 6.4% when it hit a new record of 44,414 international registrations. Additionally, the International Bureau processed 456,877 decisions notified by designated Contracting Parties, representing an increase of 4.5% as well as more than 23,000 renewals, equivalent to a growth of 5.3%.

Transactions	2013	2012	% growth
Applications	46,829	43,998	6,4%
Registrations	44,414	41,954	5,9%
Renewals	23,014	21,859	5,3%

The total number of active international registrations, as of December 31, 2013, is 578,320, which represents a growth of +3.34% compared to 2012 (559,826 active international registrations).

The International Bureau also decreased its average processing time by -29.2%. The average processing time in the absence of any irregularity is now 34 days instead of 48 in 2012.

NEW PUBLICATION: MAKING THE MOST OF THE MADRID SYSTEM: INFORMATION AND PRACTICAL TIPS ON HOW TO USE SPECIFIC FORMS

A new Madrid system handbook is now available online. The first section of the handbook briefly describes the main features of the Madrid system. The second section has information on how to complete the most commonly used forms to request a registration or a recording.

The English version of the handbook may be viewed and downloaded at: <http://www.wipo.int/madrid/en/forms/>.

The Arabic, Chinese, French, Russian and Spanish versions of the handbook will be made available soon.

REVISION OF THE GUIDE TO THE INTERNATIONAL REGISTRATION OF MARKS UNDER THE MADRID AGREEMENT AND THE MADRID PROTOCOL (THE GUIDE)

A revised version of the Guide is now available online. The Guide has been revised to reflect amendments to the Common Regulations.

The English, French and Spanish versions of the revised Guide are available at: (<http://www.wipo.int/madrid/en/guide/>, <http://www.wipo.int/madrid/fr/guide/>, and <http://www.wipo.int/madrid/es/guide/>).

The Arabic, Chinese and Russian versions of the revised Guide will be made available soon.

AMENDED OFFICIAL MADRID FORMS (MM6 FORMS)

The official Madrid forms (MM forms) have been revised to provide more information and make them easier to complete.

Two substantive changes have been implemented along with the new forms:

1. Where the applicant/holder or the representative provides an email address in any of the forms, any further communication from the International Bureau related to the particular international application, the international registration or request for the recording of a change in the international registration will from there on be sent only electronically.
2. There is a substantive change concerning the form used to request the recording of a limitation (form MM6). Previously, where the limitation, for example, only concerned one out of several classes of goods and services, the holder had to specifically tick a box to inform the International Bureau that the other classes not affected by the limitation would remain as they were. If he/she forgot to tick the box, the result would be that the International Bureau would delete those classes. The new revised form is more user-friendly. Where the limitation now only concerns one or a few out of several classes, it is assumed that the other classes would remain as they are, and that he/she would not need to tick any box.

WIPO GAZETTE OF INTERNATIONAL MARKS: REDUCING DELAY OF PUBLICATION

The *WIPO Gazette of International Marks*, which is the official publication of the Madrid system, is published once a week on Thursdays. It contains all relevant data concerning new international registrations, renewals, subsequent designations, changes and other entries affecting international registrations, as well as information of general interest related to the Madrid system.

From the first issue of the Gazette in 2014 ([No. 1/2014](#)), the International Bureau is reducing the delay of publication by seven days. A consequence of this will be that, from the above issue, which was published on January 16, 2014, and for all subsequent issues of the Gazette, the date of publication will be identical to the date of notification to designated Contracting Parties.

You may access the electronic version of the Gazette through the following link: <http://www.wipo.int/madrid/en/gazette/>.

WIPO ALTERNATIVE DISPUTE RESOLUTION SERVICES FOR MADRID SYSTEM USERS

WIPO offers a wide range of global IP services, notably under the Madrid system and through the WIPO Arbitration and Mediation Center. Their purpose is to offer time and cost-effective assistance to innovators and their counsel in protecting their inventions and resolving any related disputes.

To optimize the synergies between these WIPO services for their users, the Madrid system and the WIPO Center have arranged for Madrid system users to benefit from WIPO's dispute resolution services at special discounted rates.

A 25% reduction on the WIPO Center's registration and administration fees applies in proceedings commenced under the WIPO Mediation, Arbitration, Expedited Arbitration and Expert Determination Rules, where either party or both parties is/are named as holder(s) after publication under the Madrid system. The same reduction applies to users of other WIPO services, including the Hague system and the PCT.

The WIPO Center's reduced fee schedules for Madrid users are available at: <http://www.wipo.int/amc/en/arbitration/fees/amended.html>.

WIPO Alternative Dispute Resolution enables users of the Madrid system and other IP stakeholders to resolve their disputes without recourse to court litigation. In addition to offering WIPO Rules, and corresponding model contract clauses, the WIPO Center makes available to parties in cases under the WIPO Rules mediators, arbitrators and experts with specialized knowledge in patents and other areas of IP disputes. To date, 15% of mediations and arbitrations filed under WIPO Rules relate to trademarks. Some 68% of WIPO cases are international in scope, with the remainder involving parties based under the same jurisdiction. 69% of WIPO mediation cases and 40% of WIPO arbitration cases have resulted in party settlement.

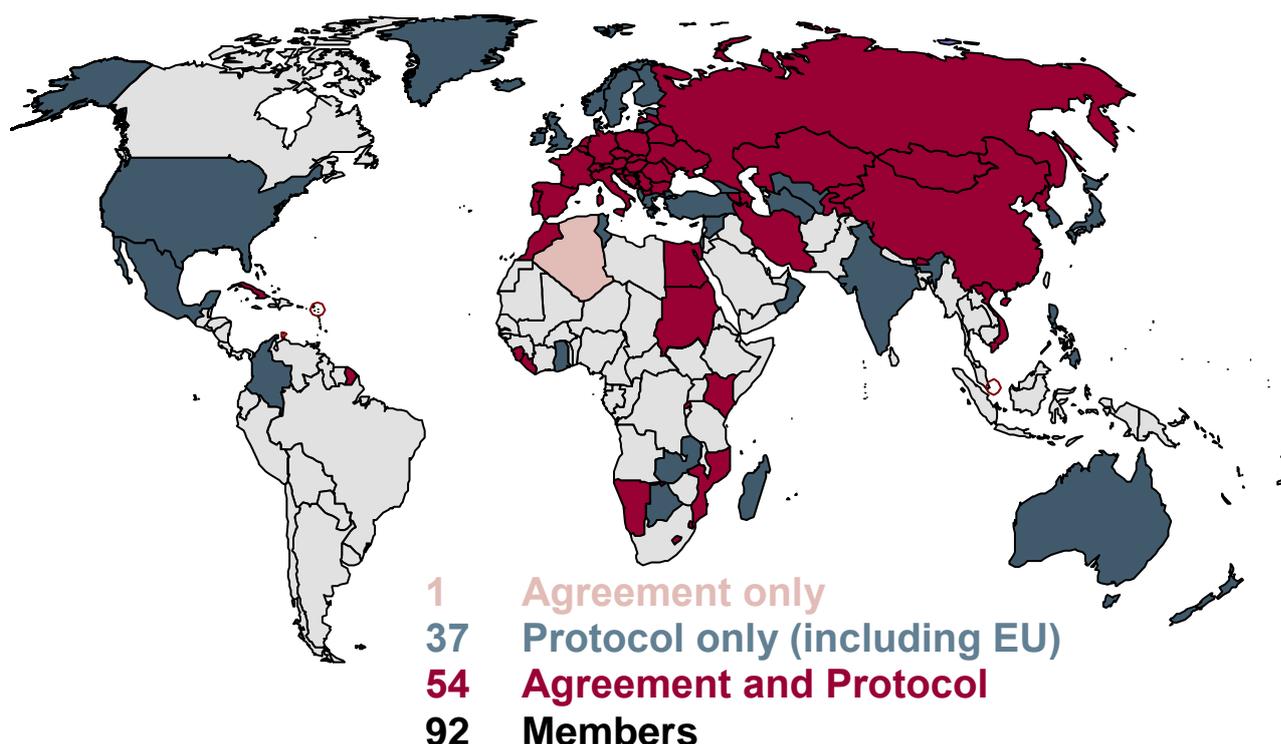
Detailed information about WIPO dispute resolution services is available at: <http://www.wipo.int/amc/en/>.

Recommended WIPO Contract Clauses and Submission Agreements: <http://www.wipo.int/amc/en/clauses/index.html>.

The legal staff of the WIPO Center is pleased to respond to queries as follows:

E-mail: arbiter.mail@wipo.int
Tel: +41 22 338 8247

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 Madrid Operations Teams organized in order of Office of Origin/residence.

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