

LIST OF QUESTIONS RAISED DURING THE ONLINE TRAINING AND CAPACITY BUILDING PROGRAM FOR INTELLECTUAL PROPERTY OFFICES

This document contains all the questions and answers raised during the various sessions of the online training.

TRAINING SESSION 1 – OVERVIEW OF THE MADRID SYSTEM; HOW TO BECOME A MEMBER OF THE MADRID SYSTEM

Question 1: Following, the freezing of the Madrid Agreement, is Article 9*sexies* of the Protocol still applicable to the members of the Agreement/Protocol?

Answer: While the [Agreement](#) is no longer in operation (frozen as of 2016), the [Protocol](#) is the sole governing treaty and Article 9*sexies* applies because it is in the Protocol. This Article governs the relationship between members that are members of both treaties. Where this is the case, any declarations the members may have made concerning the extension of the time limit to 18 months (Article 5(2)(b) and (c)) or individual fees (Article 8(7)), will not apply.

For example, China and Switzerland are both members of both treaties; where Switzerland is designated in an international registration originating from China, any declaration for individual fees and extension of the time limit to 18 months will not apply. In this example, Switzerland will receive the standard fees only and will have to issue a provisional refusal within 12 months.

If you take the example of Switzerland being designated in an international registration originating from Norway, which is only a member of the Protocol, Switzerland will receive their individual fees, and they will have up to 18 months to issue a provisional refusal.

It is important for Offices that are members of both treaties to fully understand the consequences of Article 9*sexies*. They must check where their designations originate from, whether they come from members of both treaties or from members of the Protocol only. These Offices need to have processes in place to distinguish between these two types of members, because they must ensure they can issue a provisional refusal within the applicable time limit for that designation.

Question 2: What is the legal value of the international registration certificate? Some holders still believe they have obtained protection when receiving this document.

Answer: At the international level, the registration certificate has no legal value in terms of protection. The certificate means that the mark has been registered (recorded) in the International Register, which confirms that all formalities have been complied with and that it has been recorded with a date of the international registration. It is for the Office of the designated member to grant protection to a given international registration, and the Office must in such case issue a statement of grant of protection, which is the equivalent of the national or regional registration certificate.

Question: 3: Which article of the Protocol or its rules of procedures can be referred to before the court? For example, WIPO conducts only a formal examination of the international application and not the substantive one. Questions have been raised in this regard during the disputes.

Answer: Article 4 of the [Protocol](#) states the effect of an international registration. Articles 3 and 3ter set out the requirements for the international application, Article 5 sets out the provisions for refusal and invalidation of the effects of the International Registration in respect of certain members.

Article 4 states that from the date that the registration or recording is made according to Articles 3 and 3ter, the protection of the mark in each of the relevant members will be the same as if the mark had been directly filed with the Office of that member. If no refusal has been sent to WIPO under Article 5(1) and (2), or if a refusal is later withdrawn, the mark will be treated as if it had been registered directly by the Office of the member, starting from that same date.

Question 4: Since the Madrid Agreement is no longer in operation does this mean that the rules will no longer be reviewed/revised?

Answer: The answer is no. When the Agreement was frozen back in 2016, the name of the Regulations was also changed, from the Common Regulations to the [Regulations under the Protocol](#) only. The Regulations in place only concern the [Protocol](#) because the Protocol is the only governing treaty. The rules will be amended as necessary, following the formal adoption by the [Madrid Union Assembly](#) of recommendations made by the *Working Group on the Legal Development of the Madrid System for the International Registration of Marks* (the [Madrid Working Group](#)).

Question 5: What is the difference between invalidation at WIPO level and at the national level?

Answer: WIPO cannot comment on exactly what invalidation means at the national level because this is a matter for the national laws and practices of each Office concerned. For WIPO, the term “invalidation” (under Rule 19 of the [Regulations](#)) means that the scope of protection has been permanently removed – either totally or partially. This means that there is no way that the protection can be reinstated by way of a further decision (for example, an appeal). Protection has been lost forever. WIPO is aware that at the national level the term invalidation could have a different meaning, or other terms may be used such as “revocation” or “cancellation” and they can all have different meanings.

Where “invalidation” does have a different meaning to that under Rule 19 of the Regulations, Offices need to be very careful. For example, if an invalidation at the local level can be challenged or overturned, this is different to the meaning of invalidation under Rule 19, and in those cases the Office should send us a further decision under Rule 18ter(4) instead.

Question 6: What measures are you taking to encourage other members of WIPO to join the Madrid System?

Answer: WIPO is a member-driven organization, which means that it basically only goes where invited. WIPO can inform Offices of countries that are not yet members of the benefits of the [Madrid System](#) as well as other treaties of WIPO that they are not members of. Other countries may also encourage countries to join the Madrid System as part of their free trade negotiations.

Where an Office reaches out to WIPO stating an interest in joining the Madrid System, then of course, it interacts with the Office concerned.

Question 7: Why is it important to be a member of the [Paris Convention](#) to be a member of the Madrid Protocol?

Answer: It is necessary to be a member of the Paris Convention to join the [Madrid Protocol](#). The Paris Convention sets out the basic framework for protecting industrial property rights, the conditions for examination of trademark rights and the rights resulting from that. Therefore, being a member of the Paris Convention is the foundation required to join the Madrid Protocol.

Question 8: Can a trademark holder claim a priority date for marks registered in a country which is not member of the Madrid Protocol when they file an application through the Madrid System?

Answer: Yes, the trademark holder can claim priority from any country regardless of whether they are a member of the [Madrid System](#) or not, provided the earlier mark is the first filing and filed less than six months before the filing of the international application.

Question 9: What is the maximum local trademark officers delegated to work on Madrid designations in a local Intellectual Property Office?

Answer: WIPO emphasizes the importance of having, at least, two people in place responsible for handling Madrid matters when the country joins the [Madrid System](#). This is to make sure that the Office is not vulnerable if one of the officers is on leave or out of the Office. The Office needs to ensure that they manage, maintain and keep track of the time limits for forwarding international applications to WIPO within two months. They also need to make sure that if they need to issue a refusal, they can do so within the applicable time limit. Offices could have more people in place to handle Madrid matters, but it is recommended that they start with, at least, two people.

Question 10: Are there any discussions going on regarding the removal of the dependency requirement or reducing the number of years of dependency? What do you think about the possible abolishing of the dependency principle? It's kind of a hot topic in the Madrid Working Group.

Answer: The issue of dependency has been discussed for many years in the Madrid Working Group. Various aspects have been discussed and WIPO has received a range of opinions from members and users' groups. On one end of the spectrum, some members have expressed the desire to eliminate dependency entirely. On the opposite end, others have stressed a preference to maintain the current system as it is. Then between these two extremes, there are members agreeing to a reduction from five to three years, or a reduction of the grounds that could lead to the Office notifying WIPO of a ceasing of effect of the basic mark.

To learn more about this, please refer to the [Madrid Working Group website](#) and look at the documents published there. The main thing to be aware of concerning dependency is that it is listed in Article 6 of the [Protocol](#). So, to make any changes to Article 6, WIPO would need to convene a diplomatic conference – and that is a matter of considerable importance.

There are documents on the website regarding dependency, proposals and comments from different members, users' associations and a document on how to convene a diplomatic conference and the effects of that.

If the Working Group agrees on any change, and this requires a full consensus, meaning that all the members must agree to recommend a certain outcome to the Madrid Union Assembly, it will be up for formal adoption by the Madrid Union Assembly.

If a diplomatic conference is needed, the strong preference would be to have more things covered than simply just amending the dependency period from five to three years. What some members do not necessarily realize is that if having a diplomatic conference is agreed, to reduce the dependency period from five to three years, it basically means having another treaty, and countries/territories will have to accede to that new treaty before the change will be any effect in their jurisdiction.

WIPO encourages all Offices to look at the documents and register for the Working Group, to allow them to participate and make statements on dependency.

Question 11: What are the advantages of joining the Madrid System?

Answer: There are [advantages](#) for both Offices and for users. For users, it means that there is an easier way for them to access their export market. They can make use of a centralized filing and management system that allows them to come to one place, to designate as many members as they wish, rather than going to the individual national or regional Offices. For Offices, it means that they will receive designations from trademark owners, and most likely receive more filings than they would receive at the national or regional level. Where members are designated, WIPO has already completed the formality examination, so there would be less work for the Offices as they can now examine on substantive grounds only.

Question 12: What is the practicality of establishing an Application Programming Interface (API) for data transmission among member countries in collaboration with WIPO?

Answer: It will be easier for the Offices to transmit relevant data to WIPO and for WIPO to receive cleaner and better-quality data for internal processing.

Question 13: In the situation where a provisional refusal was issued and the holder did not respond within the stipulated time limit and the designated member proceeds to abandon the designation, should the Office send a communication to WPO that the designation was abandoned?

Answer: Yes, WIPO always needs to know the outcome of a provisional refusal, so the status of protection is up to date in the International Register, and that WIPO has the same information as the Office has in their national or regional register. If there has been a decision to abandon the mark, then the Office must issue a final decision and send this to WIPO.

Question 14: The greatest challenge for our country's accession to the Madrid System is the fear of the local practitioners that membership will take away their jobs and income.

Answer: It is important that the Office has legislation in place to comply with the [Protocol](#). This means that the local legislation must acknowledge the Madrid System, so trademark holders can enforce their rights under the Madrid System. The Office also needs to have [processes in place](#) to make sure they can make relevant decisions within the applicable time limit. There will be work for the attorneys in the Madrid System, but the Office needs to have legislation and procedures in place. It needs to be a fully functioning Office that is able to make decisions on the scope of protection within the applicable time limit of 12/18 months.

Question 15: Where can we find the individual fee charged by a member?

Answer: The individual fees can be found on the [website](#). There is a list of the fees applicable for all those members who declared for individual fees. The applicable amounts are also displayed when using the [Fee Calculator](#).

Question 16: When completing the [Madrid Application Assistant](#), are applicants allowed to type specific goods or services?

Answer: Yes, applicants can type specific goods and services. The goods and services listed must be within the scope of the goods and services listed in the basic mark, but the applicant can choose a more limited scope and different terms.

Question 17: How long does WIPO take to conduct the formalities process and is there a time limit in which to complete the formalities?

Answer: Information about the current pendency rates for how long WIPO takes to complete formalities can be found on WIPO's website under [Madrid System Statistics](#). Select "Madrid Pendency Rates" to access the statistics. These are updated regularly.

For information, as of the end of July 2024, it takes WIPO 34 days to complete the formalities for an international application that is regular (in order). That means that WIPO has gone through the data entry, looked at the application, made sure that the classification is correct, translated it into the other two working languages and checked that the fees have been received. Therefore, to currently record a regular application it takes WIPO about 34 days.

There is no time limit for WIPO to complete the formalities. It could take a few months in certain situations, for example, where there are irregularities, or there is missing information. In such case, WIPO will reach out to both the Office and the applicant, and will describe what the issue is, how to remedy it and the time limit for doing so. Generally, the time limit to remedy an irregular application is three months. So, it could take a few months to complete the examination.

TRAINING SESSION 2 – ROLE OF THE OFFICE OF ORIGIN AND WIPO

Question 1: Does the address of the representative have to be in the country of the Office of origin?

Answer: No, the address of the representative can be in any country. Remember, this is a representative before WIPO rather than the Office. WIPO has no specific requirements as to who can be a representative, so they can have any professional qualification, any nationality, residence or any domicile.

Question 2: Can you give an example of entitlement where the address of the applicant, given in item 2(b) of the [MM2 form](#), is not in the territory of the Contracting Party of the Office of origin mentioned in item 1?

Answer: This would usually be where the applicant is claiming entitlement based on their business interest in the territory of the Office of origin but their address, the actual applicant's address, is in a different territory. For example, the applicant has provided an address in South Africa and claimed entitlement based on their business operations in the country of the Office of origin. In this case, the applicant must provide a second address that must be in the country of the Office of origin. The applicant needs to show that the business establishment, their entitlement, is based in that country. The Office can ask them for additional evidence of this if they wish. For example, some Offices ask for a business certificate, but other Offices are happy to rely on the information that is provided – it is really up to the Office to decide on this. However, there must be two addresses in this situation.

Question 3: What is the best way to sign (certify) the international application (e.g. using //, name, signature etc.)?

Answer: The [Administrative Instructions](#) prescribe that the signature can be handwritten, printed, typed or stamped. As WIPO and Offices communicate only through electronic means, Section 7 of the Administrative Instructions further states that the signature may be replaced by a mode of identification agreed between WIPO and that Office.

For many cases, this mode of identification will be the official from the Office who has a WIPO account that logs into the [Madrid Office Portal](#) to send communications to WIPO. In such case, WIPO knows who sent the communication. Also, when the Office sends an electronic communication using XML (Extensible Markup Language) or other agreed modes of data exchange with WIPO, it is clear which Office sent the data and who sent it to WIPO.

It is flexible on how things can be signed as long as WIPO can identify which Office and who in the Office has sent the communication to WIPO.

Question 4: With regard to a mark submitted in color, the holder did not indicate the colors being claimed. Now, the designated member issued a provisional refusal requiring the holder to submit the list of colors being claimed. In the response, the holder replied that they are not claiming any color and would like to convert the mark to black and white. Is this correct or allowed? Or should the Office reject the response because changing the mark to black and white is a deviation to the mark in the basic mark or what was certified by the Office of origin?

Answer: The applicant does not need to add a color claim when filing an international application, even if the representation of the mark is in color, unless the Office of origin requires this. If the basic mark has a color claim, the international mark must have one. If it does not, then the applicant can file it without it.

Some Offices require marks in color to have a color claim, others do not have such requirement in their legislation. If an Office does require applicants to claim color where the mark is in color, the Office can issue a provisional refusal if such claim has not been made in the international application. If the Office raises a refusal on that basis that their legislation has such requirement, the holder needs to respond to the Office – to indicate a color claim.

What the holder cannot do is amend the international mark itself. WIPO cannot change the representation in the International Register from color to a black and white version.

Question 5: In which cases can the representative sign the MM2 form for an international application?

Answer: The [MM2 form](#) must be signed and certified by the Office of origin, then the Office can require that the applicant or their representative also signs the form, or they can allow them to sign the form if they want to. It is up to the Office to decide whether they allow or require the signature of the applicant and/or the representative.

Question 6: According to the designation under the Madrid System, can we choose both the European Union and the individual European Union member States separately?

Answer: Yes, the holder may select any member that they wish. So, the holder may choose to designate the European Union because it is a unitary right covering all member States as well as some individual members, this could be for protection strategy purposes.

Question 7: Please tell us how an applicant can amend the list of goods following a refusal by the national Office. One applicant registered a mark in class 3 and another can apply for the same mark in class 35 (import and export)?

Answer: The Office may issue a provisional refusal concerning the list of goods and services, for example, if the terms are too vague or they need to further be specified under their domestic laws. It is not possible for an Office to request the holder to contact WIPO to change the classification itself in the International Register.

Where a provisional refusal is issued, it would be helpful if the Office could provide some suggestions to the holder in the provisional refusal, so that they have some idea of what they need to do, for example, if the Office considers that the term “clothing is too broad”, it would

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be useful to give the holder an idea of what they need to do to overcome the refusal, for example, indicate specific items of clothing (pants, shirts, etc.). The holder must respond to that refusal, and the Office will then need to send us a decision with the amended scope of goods and services.

WIPO is aware that some Offices allow holders to respond to these types of refusals by requesting the recording of a limitation directly with WIPO. If that is the case, the Office needs to make that very clear in the provisional refusal. In many cases the Office will not accept a limitation filed directly with WIPO, so they need to make it clear that the holder needs to respond to the Office.

If the follow up question refers to changing something from class 3 to 35, following a clarification, that would not be possible. The Office cannot change the classification, the classes are decided by WIPO at the application stage, but an Office can raise a refusal based on clarifying certain terms as just mentioned. If the follow up question refers to one applicant applying for the mark in class 3 and a *different* applicant applying for the same mark in class 35 involving the sale and import and export of goods in class 3, this will be accepted by WIPO as WIPO does not determine whether protection should be granted or whether marks can co-exist for the same or overlapping goods and services, in the different names. This is a matter for the Office to determine.

Question 8: How does renewal of the mark relate to the five-year dependency period?

Answer: The five-year dependency period starts from the date of the international registration. If the renewal of your basic mark is within the first five years of the international registration, the holder must renew the basic mark. If the basic mark is not renewed within this period, the Office of origin must notify WIPO of the ceasing of effect, and the holder will lose the international registration. It is important for the holder to maintain and renew the basic mark during the dependency period.

Question 9: With regard to classification of goods and services, do you conduct training or disseminate information materials regarding the new terms in the [Nice Classification \(NCL\)](#), transfers, etc. Please do discuss the rationale of such addition or transfer, etc.

Answer: All changes to the Nice Classification list, transfers, additions, removals and those sorts of things, are discussed at the [Nice Committee of Experts](#), which meets each year. Offices can make suggestions to the Nice Committee of Experts.

Details of the outcomes of those discussions, including the reasons for transfers, additions, and any changes, are published by the Nice Committee of Experts following their meetings. To know why or what things have changed in the various editions of the Nice Classification each year, the Madrid Registry publishes an [Information Notice](#) alerting users and Offices of upcoming changes to the Nice Classification list.

WIPO also holds internal informal roundtables with various Offices to discuss new and emerging terms, this is where different Offices can feed into the discussions and share their approaches, which then gives an overall view that WIPO can then put to the Nice Committee of Experts for decisions.

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WIPO has recently launched the [Madrid Classification Helpdesk](#), which is another avenue for identifying new terms and how these are going to be classified by WIPO, and to try to get some consistency across different Offices.

There is also the option for member Offices to engage with the Madrid Classification Practice Team and the team who manages the [Madrid Goods & Services Manager](#).

WIPO is looking for member Offices to engage with and for such Offices to provide recommendations.

Question 10: Are there initiatives or programs for building talents for tomorrow?

Answer: The building talents for tomorrow is a helpful initiative. It is more internally aimed, to make sure that WIPO examiners are up to date with the latest developments, and to shape a new mindset on customer-orientation.

WIPO has recently had a session on artificial intelligence and trademark administration, and how they interact with each other. WIPO is still in the process of identifying interesting topics and potential speakers for our next session. This kind of approach is helpful to us dealing with stakeholders in the trademark ecosystem.

Question 11: The [MM2 form](#) allows the holder to apply for a sound mark with the representation of the mark in a MP3 file. How can the designated member receive the file? Or what happens if that Office is not able to receive or accept the MP3 file?

Answer: Not all Offices accept this kind of mark or such digital representation of the mark. Therefore, some Offices may issue a provisional refusal because their legislation does not accept sound marks, or they do accept sound marks, but the Office requires a graphical representation of the mark (not presented in a MP3 file).

If the Office accepts sound marks and the representation of the mark in a MP3 file, there are special requirements needed to receive them. The Office should [contact WIPO](#) regarding these requirements. The MP3 file is available in the [WIPO Gazette of International Marks](#) (the "Gazette") or in [Madrid Monitor](#). There is a special feature available in Madrid Monitor to check the sound of the mark.

Question 12: When someone applies for transformation, which date of registration will be used by the national Office?

Answer: The filing date of the transformed application will be the date of the international registration if that member was designated in the initial application. If they were subsequently designated, the filing date will be the date of the subsequent designation.

Question 13: Can you please explain the seniority feature of trademarks in the European Union?

Answer: The European Union (EU) trademark is a unitary right, which covers the members of the EU. The seniority feature means that if the holder has an earlier right in one of those members, e.g., if they have an earlier right in Italy, they can claim seniority of their right in Italy in their EU designation.

Seniority is a feature of the EU, similar to that of replacement in the Madrid System. Any questions on seniority, for example, what can be claimed and what the conditions are, need to be addressed directly with the [EUIPO](#).

Question 14: We receive most of the international applications in a simple PDF format (and not editable PDF), and we provide extra information, e.g., the date on which our Office received the application in the additional instructions field of the [Madrid Office Portal](#) platform. Unfortunately, we still receive many irregularity letters claiming that this date was missing in the application, which is time-consuming for both our Office and the applicants. Could you suggest something?

Answer: Offices should [contact WIPO](#) directly to discuss specific issues they are facing concerning the format of international applications, for example, how the [Madrid e-Filing](#) tool can be introduced to help relieve such issues raised in the question. In the meantime, Offices should instruct applicants to use the [Madrid Application Assistant](#), which makes it much easier for the applicant and for the Office. The [PDF form MM2](#) will be phased out soon, so it would be timely for Offices to discuss other options with WIPO.

Question 15: What is the process of amending an international mark? For example, there are now additional goods in the basic mark and the holder wants the same scope to be reflected in the international mark.

Answer: Unfortunately, it is not possible to broaden the scope of an international registration once it has been recorded by WIPO. Once the applicant has applied for the mark, the Office must certify it and send it to WIPO. If changes have been made to the basic mark after certification to broaden the scope, these cannot be reflected in the international registration. If the applicant wants to have more goods and services protected for the same mark, the applicant must file a new application for those goods and services.

If, on the contrary, the basic mark is cancelled or if the scope is reduced within the five-year dependency period, then the Office would need to notify WIPO of a total or partial ceasing of effect of the basic mark.

Question 16: If the list of goods and services is limited for the United States of America (US), is this limitation checked by the WIPO examiners?

Answer: If the list of goods and services has been limited for the US designation during the initial international application stage, it will be checked by the WIPO examiner to make sure that it complies with the current version of the [Nice Classification](#). An irregularity letter will be issued for any wrongly classified terms or for terms considered too vague in the limitation.

However, if a limited list has been indicated in the subsequent designation for the US, WIPO will only check for typographical errors, and that the class numbers in the limitation are included in the main list of the international registration. In this case, during the subsequent designation, the holder must be more careful with the limited list to avoid mistakes.

Question 17: Could you please explain again the partial cancellation example in your presentation? Does the holder request transformation directly to the Office only for the cancelled class 36? How about the other classes, are these protected in the Madrid System?

Answer: Where there has been a partial cancellation of an international registration following the partial ceasing of effect of the basic mark, the holder may request transformation for the cancelled goods or services only. The holder will need to request this within the applicable three-month time limit, by filing a new (transformation) application directly with the national/regional Office concerned. The status of the goods or services not cancelled remains unchanged under the international registration. It is not possible to transform goods or services that have not been cancelled.

Question 18: The international application is filed via [Madrid e-Filing](#) (but not yet sent to WIPO), the international fee is fully paid, but the applicant decides to limit the list of designations or add designations to the list, will the fee amounts be automatically recalculated?

Answer: No, the amount of fees will not be recalculated in this (rare) situation.

Question 19: The international registration was partially cancelled, can the holder request transformation directly to the Office concerned?

Answer: Where the partial cancellation is due to a partial ceasing of effect of the basic mark notified to WIPO by the Office of origin, the holder must request transformation directly with the Offices concerned (i.e., where the holder wants to secure continued protection) within the applicable time limit of three months from the date WIPO recorded the partial cancellation.

Question 20: If a mark was initially refused by the Office of a designated member, and the representative presents an amendment to the list of goods and services by deleting the two conflicting classes leaving only one class, what is the time limit for the Office to submit to WIPO a notification of *interim* status under Rule 18*bis* using [Model Form 8](#) (completion of *ex officio* examination)?

Answer: Where the Office has received a response from the holder (or its representative) to overcome the provisional refusal, the Office should then proceed immediately to the next step in their examination. If the next step is to publish the mark for opposition, the Office may notify WIPO under Rule 18*bis*, but this is for information purposes only and such notification has no legal effect. If the Office wishes to notify WIPO, it should upload in the [Madrid Office Portal](#) Model Form 8 as soon as possible. Following the expiry of the opposition period, the Office must then notify WIPO of its final decision.

Question 21: We were designated in an international registration for a color mark, and our Office issued a provisional refusal because no description was provided. However, the applicant has indicated that they wish to apply for it as traditional mark in the designated country, although their basic mark is registered as a color mark. Is it possible for the designated country to register as a traditional mark?

Answer: It is not possible to alter the international registration or in any way change the type of the mark in the International Register. If an Office has been notified by WIPO of a designation of a mark in color (the mark consists of only the color with no shape), that is what the Office must consider. If the holder wants a mark of a different kind, for example, a figurative mark in color, the holder must file a new international application – and perhaps also first a new national or regional mark to be the basic mark.

Question 22: Is it possible for the Office of origin to remedy or respond to an irregularity that is supposed to be remedied by the applicant (e.g., lack of e-mail address)?

Answer: Many irregularities issued by WIPO are related to the e-mail address requirement and normally those irregularities should be remedied by the applicant. However, in this case, WIPO will accept the response from the Office of origin, because the Office of origin have a close connection with the applicant and may be able to provide the e-mail address.

Question 23: Could you please confirm my understanding that the holder can request a transformation where only some of the goods and services in the international registration are cancelled (partial cancellation)?

Answer: Yes, the holder may request transformation for those goods and services that have been cancelled due to the ceasing of effect of the basic mark.

Question 24: Can you please explain the difference between the date of the international registration and the national date of registration?

Answer: The date of the international registration is generally considered the same as the filing date of a national application directly filed in a designated member. The date from which protection will apply if/when the designated member grants protection (or following *tacit acceptance*) will be the equivalent of a national registration date. This date is important as it could be linked with a time limit for the holder to document actual use in the designated member or mark the starting date of any use requirements.

Question 25: What will happen to an international registration if all designated countries refuse to accept the mark?

Answer: The international registration will remain in force in the International Register until it is not renewed. Where all the members have issued a final decision (total refusal) under Rule 18ter(3), the holder still has the option of renewing the international registration as the holder may still be involved in appeal proceedings in the Offices concerned. Where all the designated members have issued a total invalidation, or the designations have been renounced, the international registration cannot be renewed – unless the holder subsequently designates further members before the due date for renewal. It is not possible to renew an “empty shell”.

Question 26: What is the duration of the formal examination at the WIPO level?

Answer: On average, the examination by WIPO of a regular international application (one where no irregularities have been identified) takes about 34 days, covering data entry, examination, classification, translation, etc. The current pendency rates are available on WIPO's website under [Madrid System Statistics](#) (select “Madrid Pendency Rates”). These are updated regularly.

Question 27: Why does WIPO print and then scan the applications we have sent electronically in PDF format?

Answer: While this is possible, it should be very rare and for a very small number of documents. When WIPO has received a document for which no data and no reference was entered, it might be sent to the Data Entry Unit where it may then be processed as a paper document. If the Office uses the [Madrid Office Portal](#), it only happens if the “other document” option is used to upload a document. Please [contact WIPO](#) for further information on this issue.

Question 28: Can the representation of the mark which is the subject of a transformation be amended?

Answer: No, the representation of the mark, which is the subject of a transformation application, must be the same as the mark in the international registration. If the trademark owner wants a different mark, they can certainly apply for an amended mark before a given Office, but this will not be within the scope of transformation, and the trademark owner will in such case not benefit from the earlier filing date of the international registration (or the date of the subsequent designation).

Question 29: Are there any statistics on how many cancellations by the Offices of origin WIPO receive per year? Moreover, of these cancellations, how many are due to a central attack?

Answer: WIPO has a publication called [Madrid Yearly Review](#), which consists of two parts. The first part concerns a current topic, a special theme, for example, classification or issues that are important to provide some in-depth information and statistics on. The second part has a battery of statistics and one of the statistics included in the *Madrid Yearly Review* concerns cancellations due to the ceasing of effect of the basic mark.

Page 77 of the [current edition of 2024](#) contains the statistics on cancellation due to ceasing of effect. Note that in 2023, which is the most recent year for which WIPO has the full set of statistics, there were about 8,000 recordings of ceasing of effect of the basic mark, of which 37% of them were total and the rest were partial.

If more specific statistics are required concerning a given member or a time period, there is an advanced search feature available on [Madrid Monitor](#), where it is possible to search by looking for the notifications of ceasing of effect from a specific member, and set a time period for which those statistics would apply.

A central attack is the attack on the basic mark that results in the cancellation of the international registration, and it goes to the intention of the third party, trying to cause a failure of the basic mark. It is difficult to determine whether an action taken by the third party seeks to have an impact on the international registration. There are many cases in which third parties attack basic marks for reasons that have nothing to do with the international registrations. There are also international registrations that are cancelled without any third party attacking the basic mark, for example because the holder reduced the scope of the basic mark or did not renew the basic mark registration.

During the annual [Madrid Working Group](#) meeting, members discuss possible changes to the [Madrid System](#), legal framework etc., and dependency has been discussed for many years. One aspect is whether dependency and ceasing of effect should be limited, for example, to actions initiated by third parties where the intent is to attack the international registration as such.

WIPO has conducted two exercises in the past, where Offices of origin have been asked to identify for a set period in their notifications of ceasing of effect how many of these were due to a third-party action, and not the result of any action or non-action by the holder (not responding to Office actions or not renewing the basic mark). The findings of those exercises are available at the Madrid System webpage under the [Working Groups of the Madrid Union](#).

Question 30: If our Office does not accept color marks, will this be screened during the formality examination in WIPO? There is one color mark which we have been designated.

Answer: WIPO does not screen whether an Office accepts color marks or any types of mark during its formality examination. If an Office has received a color mark as a designated member and their legislation does not accept such marks, the Office should issue a provisional refusal.

Offices should ensure that their information in the [Madrid Member Profiles](#) is kept up to date. This is where the Office can give information on what types of marks can or cannot be accepted and details about Office procedures, etc. Users of the [Madrid System](#) will usually check here for specific information about members before they designate them.

Question 31: What does the Xmas (Christmas Tree) for classification look like? Can Offices have access to this tool?

Answer: The Xmas Tree is just the name that is given to WIPO's internal database that contains operationally acceptable terms. It is comprised of terms that are in the [Nice Classification](#) alphabetic list as determined by the [Committee of Experts of the Nice Union](#) each year. It also includes terms from the [Madrid Goods & Services Manager](#), which is a publicly available tool. On top of that, it has terms that are not the preferred wording but are still operationally acceptable (clear enough for classification purposes), which WIPO will allow without issuing an irregularity.

In terms of "can Offices have access to it", the idea behind it is to be an internal tool. However, we are working on various options, and one of them is to expand our tools, not only the Madrid Goods & Services Manager, but also other databases of goods and services to help others determine whether something is correctly classified, or even to help them build their lists from a customer point of view, to know that these are terms that are accepted by WIPO. So, whilst the Xmas Tree might not be broadly available, some variation of it is in the project stage of becoming available.

Question 32: If the cause of the cancellation is a renunciation by the holder, transformation cannot be available to the holder? And in this case, once we receive a "death transaction" notification we can immediately acknowledge the notification?

Answer: If the holder has requested a cancellation of the international registration or renounced a designation so that member is no longer covered in the international registration, the holder cannot request transformation.

In this case, the Office can immediately update their domestic register with the received information (death transaction).

TRAINING SESSION 3 – WIPO ONLINE SERVICES

Question 1: Based on our experience, letters to WIPO sent by the Office of origin do not always appear in the Madrid Office Portal (as if they have never existed). Why is that so?

Answer: If the Office has sent any document to WIPO via the [Madrid Office Portal](#), they should have received a confirmation e-mail, which should appear at the documents tab. If this is not the case, please [contact WIPO](#) to investigate the matter.

Question 2: Can you elaborate on uploading statements of grant of protection on the [Madrid Office Portal](#) – and is the limit of 200 for such statements per day – or for a month?

Answer: the Office can upload statements of grant of protection in the form of a list of international registration numbers (IRN). There is no limit, daily or monthly, there is just a limit per upload – the Office can add up to 200 IRNs at once, and then redo the operation as many times as needed.

When uploading the list, it is possible to separate the IRNs by a new line or by putting a comma, or a semicolon after each IRN. When “review” is clicked, the system will validate the international registrations and any errors will appear under the “information” tab. These international registration numbers can be deleted or edited. If a mistake is made when editing, the system will indicate that the format is wrong.

Once the list has been validated it may be submitted by clicking on “submit” and it will be sent to WIPO. The Office will receive an e-mail confirmation.

Question 3: Is there a plan to combine the functionalities of the Madrid e-Filing and the Madrid Office Portal in one app?

Answer: The [Madrid Office Portal](#) and the [Madrid e-Filing](#) are two different tools. Madrid e-Filing is a module for the applicant and the Office of origin, and the Madrid Office Portal is a tool for Offices to send documents to WIPO. The Office can also use the Madrid Office Portal to send to WIPO the international application when the applicant uses [Madrid Application Assistant](#) or other means to file an international application.

Question 4: As soon as the irregularity notice receives a full and satisfying reply from the Office of origin, it disappears from the worklist in the [Madrid Office Portal](#). Please, correct me if I am wrong.

Answer: This is correct, but it may take a few days because it is waiting for the examination of the reply from WIPO’s side, so it does not immediately disappear when the upload button is selected.

Question 5: Does WIPO intend to expand the list of headings in the drop-down list for uploading document types? For example, you can choose provisional refusal under Rule 17 from the drop down, but there is not an option for a refusal after a correction under Rule 28 or for a rectified refusal.

Answer: If the Office is sending a refusal after correction, it is still a refusal, so the same tab may be used. If the Office is correcting a previously notified refusal, they have to be mindful of their time limit to send the provisional refusal. Whether the Office can send a new refusal in that case, depends on whether they are still within the 12- or 18-months' time limit.

Question 6: How long does it take WIPO to process an application at the Finance Division stage?

Answer: It depends. WIPO examiners will check the application and normally clear everything before it is forwarded to the Finance Division. Once it gets there, it really depends on the matter of the payment. The application fees should be paid in advance. The applicant can indicate a WIPO current account, they can indicate that they have done a bank transfer to WIPO or maybe they have used the [Madrid e-Filing](#) and paid with a credit card or any other method. So, it may take from a few hours to a few days for the Finance Division to match that payment with the application concerned.

Question 7: How often do new irregularity notices appear in the worklist?

Answer: It depends on the examination process and the status of an application. For example, if the examination is at the irregularity step, it will appear under the worklist once an irregularity notice has been issued.

Question 8: Does the irregularity notice disappear when the Office uploads its response in the [Madrid Office Portal](#)?

Answer: No, it will not disappear. Once the Office has replied, it will take a few days until WIPO has examined the response. It will disappear from the worklist once the examination is complete.

Question 9: If the designation status in the [Madrid Monitor](#) says “complex”, what does it mean or which conditions will go for the status of “complex”?

Answer: A single registration may have many transactions over its lifetime that are recorded in its history. Where these transactions can be interpreted by WIPO's systems automatically, the user will receive the status, for example, whether the mark is protected or not. Some of these transactions can, however, interact with each other. For example, cancellations, corrections and refusals can all affect the scope of protection – that is not easy for the system to read.

When the status cannot be automatically and reliably interpreted, the “complex” status will be displayed. In these cases, the system will organize the information in a way that WIPO hopes make it easier for the users to identify and determine the status themselves. Users will see the list of transactions, the uploaded decisions, and they can open the decisions and can check the status.

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WIPO is working continuously on improving the designation status tab and what it can do. Hopefully, there will be less of the “complex” statuses in the future.

Question 10: Where can we find WIPO statistics, specifically the number of international registrations with “granted protection” status in Ukraine for 2023?

Answer: This type of information cannot be found by using the Madrid Statistics function on the Madrid webpage. However, it is possible to use [Madrid Monitor](#) and its advanced search option for this type of search. It is also possible to send a request via [Contact Madrid](#) and WIPO will provide the exact link to the information required.

Question 11: Is there a test environment for eMadrid?

Answer: A test environment is not available for external users or Intellectual Property Offices, but WIPO has launched the [Madrid System User Group](#) – a group where holders and representatives from different regions of the world are participating. This group is helping WIPO improve [eMadrid](#).

Each time there is a new service to be launched or a new feature that will be launched, WIPO invites this Madrid System User Group to participate and give feedback on the service that WIPO proposes to launch.

Question 12: Do we need to mention whether the statement of grant of protection is under Rule 18ter(1) or (2) when uploading this to the [Madrid Office Portal](#)?

Answer: If an Office wants to upload a list of statements of grant of protection, this can only be for statements under Rule 18ter(1).

Where an Office wants to upload statements of grant of protection under Rule 18ter(2), such statements cannot be part of a list and the Office will need to upload them in the standard way – one by one.

Question 13: Why can we not see any notices of irregularity of provisional refusal from WIPO in the Madrid Office Portal?

Answer: An Office should be able to see all kinds of irregularity notices in the [Madrid Office Portal](#). If an Office has a case where it is aware of an irregularity, but it does not show in the Madrid Office Portal, they should [contact WIPO](#) to look into the matter.

Question 14: Is the Madrid Goods and Services Manager harmonized with USPTO Trademark ID Manual or EUIPO Harmonized Database? Sometimes our applicants receive irregularities from WIPO, but in the ID Manual of the USPTO it is perfectly aligned when they designate the US.

Answer: The [Madrid Goods & Services Manager](#) is partially aligned with the [USPTO Trademark ID Manual](#) and the [EUIPO Harmonised Database](#). Madrid Goods & Services Manager has more than 60,000 terms from the EUIPO and more than 44,000 terms from the USPTO. Unfortunately, WIPO also has rejected terms from those two Offices. For the EUIPO, there are more than 700 terms that have been rejected by WIPO, and in

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case of the USPTO, there are around 600 terms that WIPO has rejected. WIPO is in close contact with these Offices to try to find a solution regarding these rejected terms. It is not possible to get to zero, but all parties concerned are trying to lessen the classification differences.

Question 15: Our country uses Kyrgyz and Russian languages for national applications. Can the Kyrgyz language be added to the Madrid Goods & Services Manager? The Russian version has some translation errors, for example, catering in class 43 is translated as food delivery, which should belong to class 39, so applicants often use this term in class 43. How can the translation errors in Russian be corrected?

Answer: Of course, the Kyrgyz language can be added to the [Madrid Goods & Services Manager](#). The Kyrgyz Office can send WIPO a request to the Madrid Goods & Services Manager team. Regarding errors in the Russian language, or any other language, the Office concerned should [contact WIPO](#) to discuss the issue.

Question 16: The [Madrid Goods & Services Manager](#) contains terms that have been deleted from the Nice Classification. Does it mean that WIPO accepts such deleted terms in the international application?

Answer: Yes and no. For the deleted [Nice Classification](#) terms, WIPO accepts some of them, if they fall in the correct class and if they are not too vague or linguistically incorrect. However, WIPO will not accept deleted terms where the [Nice Committee of Experts](#) have decided that terms are either too broad or not clear enough.

Question 17: Can the Madrid Office Portal be used by the Office of the designated member to notify WIPO about an opposition or a cancellation action directed against the international registration, in order to allow the holder of such international registration to submit evidence and observations in reply? Is there any document type available for this kind of notification?

Answer: Some years ago, Rule 23*bis* was introduced into the [Regulations](#) to allow Offices to send through WIPO communications to holders (or to their representatives before WIPO) that have no local representation at that time. The Office can send any document that is not covered under the Regulations to the holder of the international registration through WIPO. WIPO will simply forward this document to the e-mail address on record for the holder or the representative on the Office's behalf. WIPO will not check the content of the document, and the document will not be a part of the history of the international registration. Offices can use [Model Form 18](#) and use the option in the [Madrid Office Portal](#) to send such communication under Rule 23*bis*.

Offices must not use this mechanism under Rule 23*bis* to send refusals or to send other official communication on the scope of protection covered by the Regulations, which must be sent in the normal manner of communication with WIPO (Madrid Office Portal, XML data to the FTP server etc.).

Question 18: Where can I find the total classes designated to the member concerned in the statistics for a certain period?

Answer: This kind of information can be found in [Madrid Monitor](#) using the advanced search. It is also possible to contact WIPO via [Contact Madrid](#) for further information or assistance. This information can also be found on the [Madrid System Statistics](#) page on WIPO's website.

Question 19: Is it possible for us to see the original [MM2 form](#) for an international registration and not just the PDF notification?

Answer: More and more Offices are sending WIPO application forms in an electronic format, so there is no physical document. In addition, all the information in the application form, in the electronic format or in the paper form that WIPO receives, is recorded in the International Register and is notified to the designated members. Accordingly, all the information that an Office needs about the registration is notified to them. This notification and the information that is relevant to an Office is available in the [Madrid Office Portal](#).

Where an Office has a problem with the data of an application or believe that there is anything missing, it should [contact WIPO](#).

Question 20: If a duplicate statement of grant was uploaded again by mistake, what would be the implications of that? What should the Office of the designated member do?

Answer: If an Office uploads a duplicate grant of protection, the system should trigger a warning. If the Office manages to send a duplicate statement of grant of protection, there should be no real implication. The Office should just inform WIPO of the mistake. If the grant of protection has already been validated by WIPO and recorded in the International Register, then the second one will be disregarded.

TRAINING SESSION 4 – INTERNATIONAL APPLICATION AND DATA EXCHANGE FOR INTELLECTUAL PROPERTY OFFICES

Question 1: Is there a mandatory requirement for all Intellectual Property Offices that international fees in Swiss francs should be paid before certification in the [Madrid e-Filing](#) system? The reason for this question is that in Madrid e-Filing settings this is optional.

Answer: Yes, it is actually an advantage because most applicants want to pay for the application before it is sent to WIPO because having them pay beforehand speeds everything up.

Question 2: Where does the data on the basic mark come from?

Answer: Ideally, when Offices have been provided with the [Madrid e-Filing](#) tool, WIPO can get the data directly from the domestic register, using publicly available web services. In the absence of that, WIPO can get the data through the [Global Brand Database](#) if the Office has shared their trademark collection with the Global Brand Database. Alternatively, WIPO simply works with the Office to help them build a web service that WIPO can use to retrieve their domestic trademark data.

Question 3: How does an Office get access to the [Madrid e-Filing](#)?

Answer: An Office can simply send WIPO a request for access. Then WIPO will work with the Office to set this up.

Question 4: As for the mark representation section, if the trademark is a word but not in standard characters, shall the applicant choose combined type of mark instead of word type?

Answer: If the question refers to a mark that does not have any other elements (i.e., it does not have figurative elements or stylized aspects), this is often referred to as a word mark. In such case, there is a box that may be ticked to indicate that the mark is in standard characters. This is because some Offices require the applicant to tick this box if they want protection of a word mark. By default, in [Madrid e-Filing](#), if it is a word mark, the standard characters box is ticked.

If the mark consists of words but has some stylization, then the applicant should **not tick** the standard character claim box.

Question 5: If the list of goods and services in the international application is not correct and we (the Office) have to send an irregularity letter to the applicant – how does this work in [Madrid e-Filing](#)? How can our Office send an irregularity letter to the applicant with a time limit to answer? And how can we cancel/dismiss the application if the applicant does not respond to our irregularity letter?

Answer: In these types of cases, an Office should open the file in “Examination”, go to the goods and services part (i.e., where the applicant did something that they should not have). There are then two ways to address this. If it is just a minor issue, the Office can go to the

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application and make minor changes to the list. The nature of the change depends on the working practices of each Office. Alternatively, the Office can add an irregularity – one or more irregularities can be added and then sent to the applicant. The applicant will receive an e-mail informing them that there is an action required on their part. In the Office settings, the Office can go to “mail settings”, select the relevant e-mail and add a time limit. Each Office can specify the time limit that is required by the applicant to return the application to them.

The applicant will open the file which will display the irregularities. They can see where the Office has raised the irregularity, they can respond to it and take the necessary action.

The Office can always pull back the application if the applicant does not respond, or if the time limit has expired, and reject the application. The applicant will also receive an automatic e-mail concerning the rejection. The Office can also restore the application and bring it back to life.

Question 7: For the exchange of machine data, will grants of protection lead to sending the standardized documents for trademark holders by WIPO? If so, how can the need for holders to obtain an official document that is valid for searching their rights with the competent authorities be met?

Answer: Yes, standardized and structured data will lead to more documents that will be standardized across Offices. These documents will be made available in the new portal that is being created called [eMadrid](#). eMadrid was presented in the last Working Group meeting, and WIPO will present it again at this year’s Working Group. Essentially, eMadrid is a portal where holders and representatives can take any actions they need concerning their international registration. These standardized documents will be made available on eMadrid for them to access at their own leisure once they authenticate into the system.

With the API and XML, it will still be possible for Offices to also send their own PDF certificates of the decisions and those will be made available in eMadrid.

Question 8: How can our Office integrate Madrid eFiling?

Answer: There are two integration points, both are handled by WIPO. One is the user authentication. WIPO accounts can be used, so if an Office is already using the [Madrid Office Portal](#), then WIPO will simply extend the [Madrid e-Filing](#) to that. If users already have a WIPO account, they will use the same WIPO account to access Madrid e-Filing.

The second integration point is how WIPO receives the national trademark information. Ideally directly from Offices, but if not, then through the [Global Brand Database](#). In a worst-case scenario, an applicant can use the [Madrid Application Assistant](#) or, ideally, [Madrid e-Filing](#) just by typing in any information. There is nothing for any participating Office to do other than express their willingness to get started.

Question 9: Can we use eMadrid for all the options that we use, search and compare the result?

Answer: WIPO has talked about [eMadrid](#) to get users used to the concept. In its current form, it is just a website with links to different forms. The actual tool is still being built and is not yet available. In the future, holders and representatives will be able to get all the search functions that are currently in [Madrid Monitor](#), which will be integrated into eMadrid. From there, users will also be able to look at the status of any transaction they might have with WIPO and take actions on the registrations they have as part of their portfolio, like renewing, extending protection and all the different changes they may request to be recorded.

Question 10: About the migration to API and the new XML format: for the Offices that use IPAS (Industrial Property Administration System), will we need to perform any changes in our workflows to automatically receive and upload the new communications in our systems?

Answer: For now, there are no changes planned for IPAS. WIPO plans to pilot with some Offices that have shown an interest in the APIs and XML. These are Offices that do not have IPAS. Once this phase of piloting is complete and WIPO is comfortable with the results, then Offices that use IPAS will be addressed.

**TRAINING SESSION 5 – ROLE OF THE OFFICE OF THE DESIGNATED MEMBER:
EXAMINATION OF INTERNATIONAL REGISTRATIONS, GRANT OF PROTECTION,
PROVISIONAL REFUSAL**

Question 1: In case the international registration has been tacitly accepted, WIPO still encourages Offices to issue the final decision on the international registration. Will it not result in an irregularity on the decision?

Answer: Where there has been a tacit acceptance, WIPO accepts and indeed encourages Offices to issue a grant of protection, to provide the holder with a document on the scope of protection.

A final decision following a provisional refusal is not subject to any time limit. If an Office has grounds to refuse the mark but did not issue any provisional refusal and the mark has now been tacitly accepted, they would need to issue a further decision under Rule 18ter(4).

An Office can issue a final decision under Rule 18ter(2) or (3) after the expiry of the applicable time limit to issue a provisional refusal (12/18 months) only if the Office has issued a provisional refusal. But if the Office did not issue a provisional refusal, the Office cannot issue a final decision under Rule 18ter(2) or (3) but can only issue decisions under Rule 18ter(1) or (4).

Question 2: Our Office has been designated twice in a short time span for the same trademark for the same products and services, should we issue the same decision twice?

Answer: If an Office has been designated for the same mark, for the same goods and services, for the same holder twice in a short time span, they can [contact WIPO](#) to see if there is a technical glitch.

If an Office receives first a national application and later a Madrid designation for the same mark, same holder, same goods and services, they can make the same decision twice, if their first decision was a refusal, the Office can also refuse the second designation, if the grounds apply.

If an Office receives a national application which they register, and then receive a designation for the same mark goods etc., they can also grant protection to this one.

An Office cannot refuse a Madrid designation just because the same holder already has protection in their territory for the same mark and the same goods and services. These marks must be able to coexist – see Rule 21(3).

Question 3: After the Office issued the notification of provisional refusal, the Office found some errors in the grounds for refusal. Could the Office issue a rectified provisional refusal after the expiry of 18-month time limit?

Answer: If the Office has found an error in the grounds for refusal, the Office cannot issue a rectified refusal if the time limit of 12 or 18 months has expired.

WIPO's recommendation for this kind of situation will often depend on the nature of the error. For example, it may be possible for the Office to request a correction under Rule 28, but there are specific conditions for that type of correction. It may be more appropriate for the Office to deal with the error and then issue later a further decision (Rule 18^{ter}(4)) or an invalidation (Rule 19).

If an Office finds themselves in this situation, they should [contact WIPO](#) for advice on the best way forward.

Question 4: I agree that the Office cannot ask for goods or services to be moved into different classes. What if the basic mark claimed for “dietary supplements” in class 29, using Nice Classification version before 2016 (it was the correct class at that time), but an international application is filed via the Madrid System today, what class will this be for? How would the designated members record the class in the national register?

Answer: A trademark holder may have a national registration recorded 20 years ago with a certain classification. Today, the same holder may file an international application using that national registration as the basic mark. That international application must be classified according to the **current edition** and version of the [Nice Classification](#), which means that the basic mark and the international mark will be for the same goods but classified in different classes.

This does not impact the scope of protection. The Office needs to certify that the goods are the same, even though they are now placed in different classes.

WIPO is responsible for the classification and examiners at WIPO will examine and classify the goods and services concerned. If this international application is registered, for example, with “dietary supplements”, it will now be in the class indicated in the **current edition** and version of the Nice Classification (class 5), so that is how it will be recorded and notified to the Offices of the designated members. The designated members must accept the classification in the International Register. If the designated member does not agree with the classification by WIPO, they may find a way to note in their domestic register the preferred class for the international registration, so at least the Office may find this for search purposes, but they cannot change the class number as recorded in the International Register.

Keep in mind that the application is also classified according to the edition and version of the Nice Classification applicable at that time, and an Office may be subsequently designated several years later. This means that if WIPO notifies an Office years later of a subsequent designation, the notification has a note with a reference according to which edition and version of the Nice Classification that application was classified. WIPO does not reclassify, and an Office would need to examine the international registration with the classification set by WIPO.

Question 5: About corrections of the mark, can the Office refuse that correction as the details of the figurative mark is changed?

Answer: If the question is understood correctly, this is where WIPO has notified an Office of a correction because the mark has changed. In this situation, the Office concerned has a separate time limit to respond to that correction. That time limit is the same as the one the Office has for issuing provisional refusals (12/18 months).

If the Office cannot accept the new corrected version of the mark, then the Office must issue a provisional refusal stating that they cannot or can no longer protect the mark as corrected. This means that if the Office's initial time limit (12/18 months) has expired, they can only raise a refusal on the grounds of the correction. If the Office is still within their time limit, they may also raise additional grounds for refusal if this has been identified during their examination.

Question 6: Can an Office issue the final decision ([Model Form 5](#)) twice?

Answer: The Office cannot issue a final decision following a provisional refusal twice. Firstly, the Office will send a provisional refusal that must be followed by a final decision, indicating that the Office has granted total or partial protection, or confirmed the total provisional refusal. If an Office needs to send a new decision to WIPO because the scope of protection has been revised, this new decision must be a further decision.

It is important that the Office keeps that order of decisions: first a provisional refusal to be followed by a final decision, and if the scope of protection has been revised, next is the further decision. While there can only be one final decision per provisional refusal, there may be more than one further decision. Further decisions may, for example, be due to an outcome of an appeal decision, but there can also be a further decision due to a change in the scope following a cancellation action by a third party (non-use).

Question 7: Can an opposition of a mark designating a country, say Kenya, be put in abeyance at the request of the holder?

Answer: Yes, the provisional refusal will indicate that the holder has a time limit to respond. In the response to the Office, the holder might ask the Office to put this aside while waiting, for example, for the issue with the prior mark to be resolved. That is up to the Office to decide. Domestic legislation may already have provisions for this at the national level. If an Office takes this approach, at some point they must alert the holder and notify WIPO of their final decision.

Question 8: Can one request the consolidation of two oppositions where the two oppositions involve the same parties and related marks, which could otherwise have been filed in series (the two trademarks) but were not?

Answer: It is for Offices to decide. Some Offices already have provisions for consolidating such in their legislation. The Office just needs to make sure that once they are ready to make their final decision on the opposition that they notify WIPO of the final decision.

Question 9: I want to ask about the notice of provisional refusal based on opposition, when should we send this to WIPO – is there a limit time?

Answer: This will depend on whether the Office has signed a declaration to extend the time limit for provisional refusals based on opposition under Article 5(2)(c) of the [Protocol](#). For those Offices that have made such declaration, these will have +18 months. However, for the Office to take advantage of the extended time limit, the Office concerned needs to notify WIPO of the possibility of the opposition being filed later than the 18 months (notification under Rule 16). WIPO can only accept a late incoming provisional refusal based on opposition where a notification under Rule 16 has been previously received.

Where the Office has notified WIPO of such late possible opposition, there is no time limit for the Office to send the provisional refusal to WIPO. However, where an Office receives an opposition (after the 18-months' time limit), Article 5(2)(c)(ii) sets the final time limit – the Office must send to WIPO the provisional refusal within one month from the expiry of the opposition period and no later than seven months from the date on which the opposition period begins.

For all other Offices, any notification of a provisional refusal, whether it be based on opposition or *ex officio* grounds, must be sent to WIPO within the relevant time limit.

Question 10: Which day is considered as a day of registration for the designated member, the date of international registration or the date of the decision of designated member sent to WIPO?

Answer: The date of the international registration is generally considered to be the same as the filing date of a domestic application, in a designated member. If protection is granted, protection will be from this date. The date the Office concerned grants protection (which is generally considered the equivalent of a registration date for domestic registrations) is important for use purposes. For example, this date may be the starting date for any maintenance requirements – where the Office requires holders to provide evidence of use etc.

Question 11: If we receive a correction on an international registration (“a birth”) that widens the scope of the goods and services and results in the case being re-examined, would we need to rescind the statement of grant of protection (GOP), or do we simply send a new refusal letter under Rule 28(3), which would then override the previous GOP? Also, even if we did not raise an objection, we would still need to re-examine and publish the mark for opposition purposes – what would we do in that scenario?

Answer: If an Office has been notified of a correction, which in the Office's opinion broadens the scope, they would need to re-examine the mark for the corrected part. If the Office finds that they cannot or can no longer protect the mark as corrected, you need to send a refusal under Rule 28(3).

Question 12: You've mentioned that some designated members may refuse an international registration on the ground that goods or services covered are considered immoral according to national law. However, Article 15/4 of the TRIPS Agreement states that "The nature of the goods or services to which a trademark is to be applied shall in no case form an obstacle to registration of the trademark." I wonder if this kind of refusal is in accordance with this provision?"

Answer: The statement from the [TRIPS Agreement](#) (Trade-Related Aspects of Intellectual Property Rights) referred to in the question, suggests that the nature of the goods or services associated with a trademark should not, in itself, prevent the registration of that trademark. While TRIPS sets out general rules for the protection and registration of trademarks, national laws can impose restrictions on the registration of trademarks based on public policy considerations, including the legality of the goods in the country. The TRIPS Agreement allows countries to refuse the registration of trademarks if they are associated with goods or services that violate public order, morality, or national laws. Therefore, a country can refuse a trademark if it relates to illegal goods, such as prohibited substances, due to local legal or moral considerations.

Question 13: In the first designation, there was a limitation, but this designation was later invalidated. Then there was a subsequent designation after the invalidation – is it automatic that the subsequent designation will contain the same limitation?

Answer: No, just because there was a limitation in the first designation, does not mean that the subsequent designation will automatically contain the same limitation.

Whether a subsequent designation contains a limitation or not will be up to the holder. If a limitation is included, the Office will be notified of this. When an Office receives the notification of a subsequent designation, they will need to look at this carefully to see whether it includes a limitation or not, as they would with any subsequent designation. A limitation is not automatically included, even where it was included in an earlier designation.

Question 14: Could you please tell me whether the Office can request the holder to limit the scope of goods and services in the International Register to overcome a provisional refusal based on an earlier right?

Answer: It is possible for an Office to suggest to the holder that they request the recording of a limitation as a way of overcoming a refusal based on an earlier right. Bear in mind that this limitation will apply to the designation only, not the international registration *per se*. The notification of a provisional refusal must clearly state what the holder must do to overcome the refusal – whether it will be to limit directly before your Office or if the holder must request the recording of a limitation before WIPO. If the Office's preferred way to overcome a refusal is that the holder files the limitation before WIPO, the Office should also propose the wording of the limitation that the Office can accept.

Question 15: When a provisional refusal was issued by the designated member and the time limit has expired without any response from the holder so the mark was deemed abandoned, what is the next step? Is the designated member required to communicate this to WIPO and in what form?

Answer: If an Office has issued a total provisional refusal, and the holder did not respond directly to that Office as required – resulting in the designation being abandoned – the Office must communicate the final decision to WIPO, i.e., confirm a total refusal under Rule 18ter(3).

If the Office issued a partial provisional refusal and the lack of reply from the holder allowed that designation to proceed partially, then the Office will need to confirm the partial protection in the final decision under Rule 18ter(2). Whatever happens after the provisional refusal, the Office must always send to WIPO a final decision with the final status of protection; it can be to totally or partially protect, or to confirm the total refusal. If partial protection, the Office will need to indicate the goods and services protected. If the partial protection concerns a condition (for example, a disclaimer) this must be indicated. The final decision ensures that WIPO has the complete history of the mark in the International Register.

Question 16: If we issue a second provisional refusal to replace or to correct the first provisional refusal, will the first refusal be withdrawn in [Madrid Monitor](#) and replaced by the corrected refusal?

Answer: The provisional refusal must be sent to WIPO within 12 or 18 months, depending on the applicable time limit. If there is an error or the Office forgets something in the first notification, provided the Office is still within the time limit, they can send the second one to WIPO and it will be recorded. WIPO will not necessarily need to correct the first one. Both notifications will be recorded in the International Register. The Office needs to inform WIPO whether the second notification of provisional refusal is in addition to or will replace the first one. This needs to be clear so the holder knows what to do and how to respond to the refusal.

Question 17: What should the designated member do if there is any formality issue found by the Office? For example, the mark is a word mark (in black and white), but mark description states that the mark is in the color red. What should the Office do?

Answer: In such a case, the Office can [contact WIPO](#) to see if there is any mistake regarding the representation of the mark. If there is no mistake, the Office may issue a provisional refusal and ask the holder to clarify the mark.

Question 18: In the event that the Office of a designated member finds that the International Bureau has wrongly classified goods/services, how can this be communicated to WIPO?

Answer: If the Office considers that WIPO has made a classification error in an international registration, they should [contact WIPO](#). The matter will be passed to experts in classification who will review the matter and decide whether WIPO needs to do a correction for that international registration or not. The Office will be informed of the outcome of the review.

Question 19: If there is an element in the mark, like there is an ® (registered symbol), which we do not accept as part of the mark, can we issue a provisional refusal asking the holder to delete the ®?

Answer: There are some Offices that will issue a refusal when they see that the mark contains the ® symbol. The Office can issue the refusal and request the holder to send to the Office a clean representation of the mark. In that case, the Office may proceed with the clean representation and grant protection to that representation. However, WIPO will not change the mark as recorded in the International Register (that will still contain the ® symbol).

Question 20: If WIPO was informed by the designated member of a total grant of protection or confirmation of total refusal, does the Office still need to send an invalidation? The flow chart concerning the process has “invalidation” as the final process.

Answer: The flow chart referred to in the presentation, just shows what decisions may be taken by an Office for an international registration. An Office will only notify us of an invalidation if such decision has been taken by that Office.

TRAINING SESSION 6 – ROLE OF THE OFFICE OF THE DESIGNATED MEMBER: FINAL AND FURTHER DECISIONS, INVALIDATIONS, DIVISION AND MERGER OF INTERNATIONAL REGISTRATIONS

Question 1: What's the difference between invalidation and cancellation?

Answer: Cancellation and invalidation can have many different meanings at the domestic level. For WIPO, invalidation can only mean one thing, namely a decision has been made by the Office of a designated member that permanently reduces or removes protection of that designation in the international registration under Rule 19. There are no avenues for appeal for the holder, so the mark is no longer protected in that designation. The decision that has led to the invalidation could have various names, at the domestic level, for example, it could be called invalidation, cancellation, rectification, or revocation. However, for WIPO, it simply means that an Office has decided to permanently reduce the scope of protection of the mark and notified WIPO under Rule 19, which means that the decision is no longer subject to appeal.

A cancellation for WIPO has quite a different meaning. It can mean one of two things; it can mean that the holder has voluntarily requested the cancellation of the international registration, totally or partially; or it can be where the Office of origin has requested a cancellation of the international registration based on the ceasing of effect of the basic mark. In both cases the cancellation means that the goods and services have been permanently removed/lost from the international registration itself, affecting all the designated members and the main list of goods and services. This is different to an invalidation that affects only the designated member.

Question 2: Will Offices of designated members be notified of international registrations for which they have not yet issued a final decision?

Answer: No. WIPO does not notify Offices that a final decision is still pending. However, if Offices are interested in receiving a list of international registrations for which they have notified WIPO of a provisional refusal that has not yet been followed by a final decision, WIPO can provide them with such list. That way an Office can go through that list and check whether they have failed to send to WIPO a final decision. This would be very helpful for holders who are waiting for their final decision and for WIPO to ensure that the correct status of protection is reflected for a given member in the International Register.

WIPO can also provide a list to those Offices that have notified WIPO of a possible later opposition under Rule 16, but where they have not yet informed of the dates of the opposition period. With such list, the Offices can check in their domestic register to see whether they have already made a final decision which has not yet been notified to WIPO.

If an Office would like to receive such list, it should [contact WIPO](#).

Question 3: Can an Office use Model Form 18 to request the holder to remove a registered symbol from the mark?

Answer: No, this is not possible. [Model Form 18](#) concerns communications under Rule 23bis. These communications are meant for matters that fall outside the obligations of the [Protocol](#) and [Regulations](#), where the Office needs to communicate with the holder. A typical example of the type of communication received *via* Rule 23bis is a communication alerting the holder that a third party has initiated a cancellation action before the courts. The communication must also contain information on how the holder may respond or defend such a matter. An Office that requires the holder to remove a registered symbol from the mark – whether it be to accept a disclaimer for the symbol or to provide a clean representation of the mark – must be addressed in a provisional refusal.

If an Office is unsure of whether a specific communication can be sent under Rule 23bis, it may [contact WIPO](#) for clarification.

Question 4: Can the Office issue one standard form of statement of grant of protection for all scenarios without referencing any rule?

Answer: Every communication that an Office needs to send to WIPO, to inform about the status of protection, has certain requirements that are specific to that rule. While it is not a mandatory requirement to include a reference to the specific rule, the information required as set out in the rule must be included in the communication.

WIPO has [model forms for Offices](#) to use to help ensure that all the requirements are met under each rule, including statements of grant of protection under Rule 18ter(1) and statements of grant of protection following a provisional refusal under Rule 18ter(2) granting total or partial protection as a final decision.

Offices are highly recommended to use the applicable model form. Offices may tailor the forms as long as all the necessary information is still included, and the requirements are met. For a statement of total grant of protection, the Office should not list the goods and services – protection is for all of the goods and services for which the member was designated. However, if protection is only partial, the Office must list the goods and services that have been granted protection.

The model form completed correctly will contain all the required information and reduce the risk of irregularities. Using the model forms also makes it easier for users (to follow consistent formats) and the Madrid Registry to record the correct decisions.

Question 5: If a request for an Office to take note of replacement was submitted before the national filing was cancelled, but was not acted upon immediately by the Office and the national filing was since cancelled, can the Office still notify WIPO that it has taken note of the replacement?

Answer: Replacement is automatic regardless of whether the Office takes notes of it or not. Replacement happens at the date of the international registration, or the date of the subsequent designation, if all conditions have been met, e.g., concerns the same mark, owner, overlapping goods, etc. If those conditions were met at that time of the international registration, the Office can take note. WIPO advises holders to request the Office to take note because it makes it transparent for third parties and adds some degree of comfort to the

holder in that the conditions have been checked and met. This is very useful for the holders even if the national mark has lapsed, since replacement was automatic at the time of the international registration. In this particular case, the holder requested the Office to take note of replacement when the national mark was still in force. There is no reason why the Office should not take note of the replacement and notify WIPO.

Question 6: Could the partial replacement be that the international registration includes three classes and the domestic only one, and replace that one?

Answer: This is an example of partial replacement. As long as there is some overlap in the goods and services, the replacement will automatically occur. The obvious thing here would be for the holder to understand that they only get the earlier date for the one class covered by the domestic mark, they are not going to get the replacement for the other two classes that were not originally covered by the national mark.

Question 7: What happens if our Office issues a final decision within the deadline to notify it to WIPO (18 months), which is later amended or invalidated by a superior Court after the deadline? Can we still inform WIPO about the changes that have occurred? Is there still time to notify of change of the scope of protection of the international registration?

Answer: The 18-months' time limit refers to a provisional refusal, there is no time limit for a final decision. Once there is a final decision, if there is another later decision, like in this case that affects the scope of protection, the Office can issue a further decision and there is no limit for this. The scope of protection can flip either way; the holder could lose protection, gain protection, lose it again and then gain it again. This kind of thing happens following various court decisions. Any decision that is made after the Office has notified WIPO of a final decision should be notified to WIPO as a further decision if it affects the scope that has been recorded for that given member. Alternatively, the Office may notify WIPO of an invalidation (where the protection cannot be reinstated by any further decisions), provided it meets the requirements set out in Rule 19.

Question 8: The principle of replacement is somewhat complex. For replacement, does the international registration take the place of the local mark as at the date of the local mark? Is this correct?

Answer: The principle of replacement means that there are two rights, the domestic right and the international right. There is no physical replacement, the international right does not take the place of the domestic right on the domestic register. The international registration always has the same date, but the replacement means that the international right benefits from the earlier date of the mark being replaced (i.e., the date of the domestic registration). It is useful for the holder to ask the Office to take note of replacement, and the Office can then note in their register – next to the international registration number – that the holder has had protection for this mark dating back to the domestic right. As there are no physical changes to the dates in the domestic register for either rights, the note is simply information to the public that while this international registration may be of newer date, the holder has had protection for the mark from the date of the earlier registration, for the goods/services covered by the replacement.

TRAINING SESSION 7 – MANAGEMENT OF INTERNATIONAL REGISTRATIONS: ROLE OF THE OFFICE

Question 1: What is the Office procedure if a cancellation request for goods/services is broader than the list previously notified and registered with the Office?

Answer: If an Office receives a partial cancellation and finds that they cannot accept the wording because it is broader than the list in the designation, the Office cannot send a declaration that it has no effect. A declaration of no effect only applies to the recordings of limitations and changes in ownership. The only thing that the Office can do in this situation is to send WIPO a further decision indicating the accepted scope of protection or an invalidation if their legislation allows that.

Accordingly, in cases where an Office finds that a partial cancellation results in a broader scope than they are designated for, the most appropriate thing to do is to issue a further decision under Rule 18^{ter}(4) or a partial invalidation under Rule 19.

Question 2: If the applicant wants to amend the trademark in the basic mark, should we accept this if our legislation accepts minor changes?

Answer: This is a matter for the Office of origin and the certification of an international application. If the domestic legislation allows the applicant to make minor modifications to the basic mark at the domestic level, then the applicant may amend the mark. Any changes to the basic mark, however, cannot be replicated in the international registration. The Office must certify that both marks match at the time of the certification of the international application. If the Office later allows changes to be made to the basic mark, these changes will not be reflected in the International Register. If the holder wants to protect the amended version at the international level, they would need to file a new international application for that version.

Question 3: If the Office has notified the provisional refusal to WIPO and then the holder submits a limitation to WIPO that covers goods/services that were refused by the Office, should we send the notification based on Rule 27(5) in this case?

Answer: A notification under Rule 27(5) may be appropriate if the Office has already taken a final decision to not grant protection to these goods and services. If the holder files a limitation following such decision, the Office can send a declaration stating the limitation has no effect under Rule 27(5), as it is broader than the scope protected.

In the case of a pending provisional refusal, it would be useful for the Office to clearly state in that provisional refusal how the holder should respond. If the Office allows the holder to file a limitation with WIPO to overcome the refusal, the Office should suggest some appropriate wording or at least make sure that the holder would know what would be accepted or not accepted by the Office. Also, the Office needs to make it clear whether a limitation filed directly with WIPO is sufficient to fulfil their requirements for responding to the refusal, for example, in many cases a limitation filed directly with WIPO would not be considered a response to the refusal, which must be filed with the Office.

TRAINING SESSION 8 – MADRID PROMOTION AND MARKETING; FEES, DISTRIBUTION OF FEES AND FINANCIAL STATEMENTS

Question 1: Where an international application has been filed via [Madrid e-Filing](#), and a payment of international fees (and Office of origin's handling fees) has been made upfront, if the Office of origin refuses to submit the international application to WIPO, how can the applicant get reimbursement on the international fees (and Office of origin's handling fees)?

Answer: When WIPO collects the handling fee on behalf of the Office of origin, it is treated as a separate transaction to the international fees. It is processed within two/three days of the applicant making the payment and returned to the Office of origin in the subsequent month's distribution. Should the Office of origin reject or refuse to submit the international application to WIPO, it is up to the Office to return the handling fee to the applicant.

Where an applicant has paid fees directly to WIPO and the Office of origin rejects or refuses to submit the international application to WIPO, the applicant can request a refund of the paid fees through the "[Refund Request Form](#)" available on WIPO's website under "[Paying Madrid System Fees](#)". There is a lot of useful information there, including the [Current Account](#) for Offices and applicants. The applicant will need to indicate the bank information. If an applicant paid using PayPal or a credit card, WIPO can also refund on the credit card or on the PayPal account.

Question 2: About the fee transfer for our country for 2023 (received this year): the amount officially notified to our government is slightly different from the amount received by our bank. The bank statement shows that bank transfer charges have been debited from the official amount notified. The concern is not about the amount of fees transferred, but our Office has to explain this difference to auditors.

Answer: When transferring and receiving fees, there are two possible reasons for the different amounts: the exchange rate applied during the transfer, and the bank fees involved. If the transfer was converted from Swiss francs to another currency at WIPO, the details of the exchange rate used by the bank (used by WIPO) can be provided. If the exchange was made from Swiss francs into the local currency in the recipient's country, the recipient would need to contact their bank for the details of the exchange rate applied.

Bank fees consist of a local fee in Switzerland that WIPO pays to its bank to make the international transfer, and potential bank fees at the receiving bank for receiving an international transfer.

It is WIPO's policy that the fees are shared. That means WIPO pays its local bank fees and the recipient is responsible for their local bank fees. WIPO is not privy to the relationship between the local bank and the recipient. Therefore, the best thing to do in this situation is to contact the local bank for information that may help with the auditors.

Question 3: When payment is made into the Current Account at WIPO, is it made in local currency or in Swiss francs?

Answer: The [WIPO Current Account](#) operates exclusively in Swiss francs. A transfer to the Current Account as an opening balance would have to be made in Swiss francs if using a bank transfer. Some countries have chosen to use a small portion of their distributions to open their Current Account and WIPO can accommodate that.

The deductions from the Current Account are also in Swiss francs, matching the application fees and the fees that applicants and holders must pay.

It is possible to send WIPO a different currency to open the Current Account. However, the funds must be changed into Swiss francs. WIPO's local bank will handle the exchange, and the final amount may differ due to the exchange rate of the day.

Question 4: Is WIPO going to add more currencies to choose from aside from CHF?

Answer: If the question concerns whether fees can be paid to WIPO in currencies other than Swiss francs, the answer is "no". There are no ongoing discussions to include or add more currencies for fee payments. Fees are only payable in Swiss francs.

If the question concerns the [Current Account](#), at present the Current Account only operates in Swiss francs. However, WIPO is in the process of installing a new ERP system to replace the one used for the past 15 years. The new ERP system will be able to handle the current accounts in multiple currencies. This will make it easier for Offices or applicants to manage not only their Madrid fees in Swiss francs, but also potentially PCT fees in US Dollars and Euros.

Question 5: When the Office of origin sends the international application to WIPO, if an applicant does not pay or does not pay the correct amount to WIPO, why does not WIPO inform the applicant or agent directly to remedy the matter instead of the Office of origin?

Answer: WIPO sends the irregularity letter to both the applicant and the Office of origin. Rule 11 of the [Regulations](#) states that missing fees is an irregularity to be remedied by either the applicant or the Office. Some Offices have declared that they will collect the fees on behalf of the applicant and send them to WIPO. In such case, missing fees will be an irregularity for the Office of origin to remedy. On the other hand, if the Office has said that the applicant must pay the fees directly to WIPO, any missing fees will be the applicant's responsibility to remedy.

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