

HIGHLIGHTS

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CONTENTS

MADRID SYSTEM.....	2
Landmark International Trademark Registration	
CONTRACTING PARTIES.....	2
Practical Consequences of the Accession of Algeria to the Madrid Protocol Concerning the International Registration of Marks	
Questions and Answers Concerning the Accession of Algeria	
Accession of The Gambia to the Madrid Protocol	
Changes in the Amounts of the Individual Fees	
USEFUL INFORMATION.....	7
Information Concerning the United Kingdom, British Overseas Territories and British Crown Dependencies	
Madrid Union Map	
CONTACT US.....	9

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

MADRID SYSTEM

LANDMARK INTERNATIONAL TRADEMARK REGISTRATION

Indian firm Micromax presented with Certificate of Registration for the 1.25 millionth trademark registered under WIPO's Madrid System

On July 20, 2015, Micromax Informatics Limited was presented with milestone International Registration Number 1.25 million for the trademark protecting its brand name, Micromax. The certificate was presented to this leading Indian consumer electronics company [during the ceremony and associated seminar](#) organized by WIPO and the Indian Department of Industrial Policy and Promotion (DIPP), in cooperation with the Federation of Indian Chambers of Commerce and Industry (FICCI) in New Delhi.

Mr. Vineet Taneja, the Chief Executive Officer for Micromax, highlighted during this event the importance of “international trademark registration as the first step in developing brands in global markets” lauding the Madrid System as a cost-effective tool for supporting introduction of their innovative products in markets beyond India. In the same vein, Mr. Naresh Prasad, Assistant Director General and Chief of Staff, Office of the Director General, WIPO, lauded the achievement by Micromax as a noteworthy milestone for a company focused on affordable innovation and encouraged more Indian companies to use the Madrid System.

Indeed, the rapid expansion and uptake of the Madrid System is a testament to the proven benefits it provides to companies of all sizes and industry sectors. It took 95 years from when the Madrid Agreement was first concluded in 1891 to reach half a million registrations, and only another 23 years to get to the one million mark in 2009. It is projected that the two-million registration milestone will be reached even more quickly, likely within the next 15 years. Since joining the Madrid System in 2013, India has for its part rapidly garnered the interest of trademark owners and is well on its way to becoming one of the top 10 designated Contracting Parties for 2015.

CONTRACTING PARTIES

PRACTICAL CONSEQUENCES OF THE ACCESSION OF ALGERIA TO THE MADRID PROTOCOL CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

On July 31, 2015, the Government of Algeria deposited with the Director General of the World Intellectual Property Organization (WIPO) its instrument of accession to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (“the Protocol” and “the Agreement”). The Protocol will enter into force, with respect to Algeria, on October 31, 2015 (see Information Notice [No. 35/2015](#)). The instrument of accession was accompanied by the declaration referred to in Article 5(2)(b) and (c) of the Protocol, whereby Algeria availed itself of the flexibility to replace the time limit of one year to notify provisional refusal of protection by 18 months, and to provide notification of a provisional refusal resulting from an opposition after the expiry of the 18-month time limit.

Algeria was the last remaining member of the Madrid Union to be a Contracting Party of the Agreement only; all members of the Madrid Union will be either Contracting Parties to the Protocol only or to both the Agreement and the Protocol.

Following Algeria's accession, the Madrid System has thus become for practical purposes a single Treaty System, whereby only one treaty – the Protocol – will govern all transactions effected by or in respect of Contracting Parties and users. The Protocol will apply in all cases because it will be the only common treaty between Contracting Parties or pursuant to

Article 9*sexies*(1)(a) of the Protocol, which provides for the prevalence of the Protocol in the mutual relations of States that are party to both the Agreement and the Protocol.

The Madrid System is already recognized by individual entrepreneurs and businesses of all sizes, representing a broad cross-section of industries, as a convenient and cost-effective way of obtaining trademark protection in all corners of the globe. Following Algeria's accession to the Protocol, not only will holders from Contracting Parties bound by the Protocol be able to designate, or subsequently designate, Algeria in their international applications, the prevalence of the Protocol will also bolster the Madrid System's benefits by providing for the general application of features and flexibilities of the Protocol, including:

- filing of all international applications based on national or regional applications or registrations using the MM2 International Application form;
- free choice of Office of origin on the basis of a real and effective industrial or commercial establishment, domicile or nationality ("cascade" entitlement principle no longer applies);
- transformation of international registrations cancelled due to the ceasing of effect of the basic mark;
- choice of presenting subsequent designations and requests for the recording of cancellations and renunciations to WIPO or through the Office of the Contracting Party of the holder;
- renewal of international registrations for periods of 10 years;
- possibility of a Contracting Party declaring an extended refusal period under Article 5(2)(b) and (c) of the Protocol; and,
- possibility of a Contracting Party declaring individual fees under Article 8(7)(a) of the Protocol.

While the Protocol will now govern all international applications and registrations, the Agreement will remain in force. For their part, provisions in the Common Regulations under the Madrid Agreement and Protocol (the "Common Regulations") implying the application of the Agreement will not be operational, even if they are not formally derogated.

QUESTIONS AND ANSWERS CONCERNING THE ACCESSION OF ALGERIA

Forms MM1 and MM3

Question: Can I continue to use the form MM1 or MM3?

Answer: No, these forms will no longer be applicable nor available on the Madrid website; you can only use the form MM2. If an international application is filed using the form MM1 or MM3 on or after October 31, 2015, the application will be considered irregular under Rule 11(4)(a)(i) of the Common Regulations. If the irregularity is not remedied by the Office of origin within three months from the date of the notification of the irregularity, the international application will be considered abandoned under Rule 11(4)(b).

Cascade

Question: I am French and live in Algeria. Can I file an international application through the Office of France before October 31, 2015?

Answer: No, you would be required to file your international application through the Office of Algeria. Under the Agreement, the country of origin is determined according to a hierarchy of the applicant's 1) establishment, 2) domicile and 3) nationality. The applicant must follow this so-called "cascade" rule and therefore does not have a free choice of country of origin.

Question: Will this situation change with the accession to the Protocol by Algeria?

Answer: Yes, the “cascade” principle will no longer apply. All applicants may freely choose their Office of origin as of October 31, 2015.

Presentation of requests

Question: I am the holder of an international registration designating Algeria. Can I present the forms for subsequent designation (MM4), renunciation (MM7) or cancellation (MM8) directly to WIPO before October 31, 2015?

Answer: No, you must present these forms to your Office, which would be either the Office of origin or the Office of the Contracting Party of the holder (in case of a previous change in ownership), according to Rule 24(2)(a)(ii) and Rule 25(1)(c) of the Common Regulations.

Question: Will this situation change with the accession to the Protocol by Algeria?

Answer: Yes, from October 31, 2015, you can choose to present the request either directly to WIPO or through your Office.

Entitlement to be recorded as the new owner (the transferee) of an international registration

Question: I work for a German company that has several international registrations designating Algeria. Can we record in the International Register before October 31, 2015, that there has been a change in ownership and that the new owner is a US company?

Answer: No, this fact cannot be recorded in the International Register before October 31, 2015, since there is no common treaty between Algeria (Agreement only) and the United States of America (Protocol only). Before October 31, 2015, you can only request the recording of a change in ownership for a company that has a place of business (having real and effective industrial or commercial establishment) or a domicile in a Contracting Party that is bound by both the Agreement and the Protocol under Rule 25(3) of the Common Regulations.

Question: Will this situation change with the accession to the Protocol by Algeria?

Answer: Yes, since all the members of the Madrid System will be members of the Protocol by October 31, 2015, you can record a change in ownership to any company that has its place of business or is domiciled in a Contracting Party bound by the Protocol.

Time limit for refusal and individual fee

Question: If a Contracting Party has made a declaration under Article 5(2)(b) or under Article 8(7)(a) of the Protocol, will the 18 month-time limit for refusal and the individual fee be applicable to all members of the Madrid Union on or after October 31, 2015?

Answer: No, the accession to the Protocol by Algeria does not have any impact on any designation governed by the Protocol by virtue of Article 9*sexies*. For the Contracting Parties bound by both treaties, the standard time limit of one year for the notification of a provisional refusal and the payment of standard fees will continue to apply.

ACCESSION OF THE GAMBIA TO THE MADRID PROTOCOL

The Gambia became the 96th member of the Madrid System on September 18, 2015, following deposit with the Director General of WIPO of its instrument of accession to the Madrid Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks. The Madrid Protocol will enter into force with respect to The Gambia, on December 18, 2015.

CHANGES IN THE AMOUNTS OF THE INDIVIDUAL FEES

There are changes to the amounts of individual fee payable when Ghana, Mexico, San Marino, Tajikistan, Tunisia, Turkey and Turkmenistan are designated in an international application, in a designation subsequent to an international registration or in respect of the renewal of an international registration under the Madrid System.

Ghana

The Director General of WIPO received a communication from the Government of Ghana withdrawing the notification that its individual fee is payable in two parts, made under Rule 34(3)(a) of the Common Regulations. This communication also modified the amounts of that individual fee.

For Ghana, the following amounts entered into force on August 10, 2015:

ITEMS		Amounts (in Swiss francs)
Application or Subsequent Designation	– for each class of goods or services	379
Renewal	– for each class of goods or services	370

For more information, see Information Notice [No. 29/2015](#).

Mexico

For Mexico, the following amounts entered into force on September 13, 2015:

ITEMS		Amounts (in Swiss francs)
Application or Subsequent Designation	– for each class of goods or services	160
Renewal	– for each class of goods or services	169

For more information, see Information Notice [No. 31/2015](#).

San Marino

For San Marino, the following amounts entered into force on August 16, 2015:

ITEMS		Amounts (in Swiss francs)
Application or Subsequent Designation	– for three classes of goods or services	155
	– for each additional class	41
	<i>Where the mark is a collective mark:</i>	
	– for three classes of goods or services	279
Renewal	– for each additional class	72
	– for three classes of goods or services	155
	– for each additional class	41
	<i>Where the mark is a collective mark:</i>	
Renewal	– for three classes of goods or services	279
	– for each additional class	72

For more information, see Information Notice [No. 30/2015](#).

Tajikistan

For Tajikistan, the following amounts will enter into force on October 30, 2015:

ITEMS		Amounts (in Swiss francs)
Application or Subsequent Designation	– for one class of goods or services	428
	– for each additional class	33
Renewal	– for one class of goods or services	428
	– for each additional class	33

For more information, see Information Notice [No. 37/2015](#).

Tunisia

For Tunisia, the following amounts entered into force on September 13, 2015:

ITEMS		Amounts (in Swiss francs)
Application or Subsequent Designation	– for one class of goods or services	131
	– for each additional class	17
Renewal	– for one class of goods or services	187
	– for each additional class	40

For more information, see Information Notice [No. 32/2015](#).

Turkey

For Turkey, the following amounts will enter into force on October 3, 2015:

ITEMS		Amounts (in Swiss francs)
Application or Subsequent Designation	– for one class of goods or services	178
	– for each additional class	35
Renewal	– independent of the number of classes	174

For more information, see Information Notice [No. 36/2015](#).

Turkmenistan

For Turkmenistan, the following amounts entered into force on September 13, 2015:

ITEMS		Amounts (in Swiss francs)
Application or Subsequent Designation	– for one class of goods or services	151
	– for each additional class	76
Renewal	– independent of the number of classes	380

For more information, see Information Notice [No. 33/2015](#).

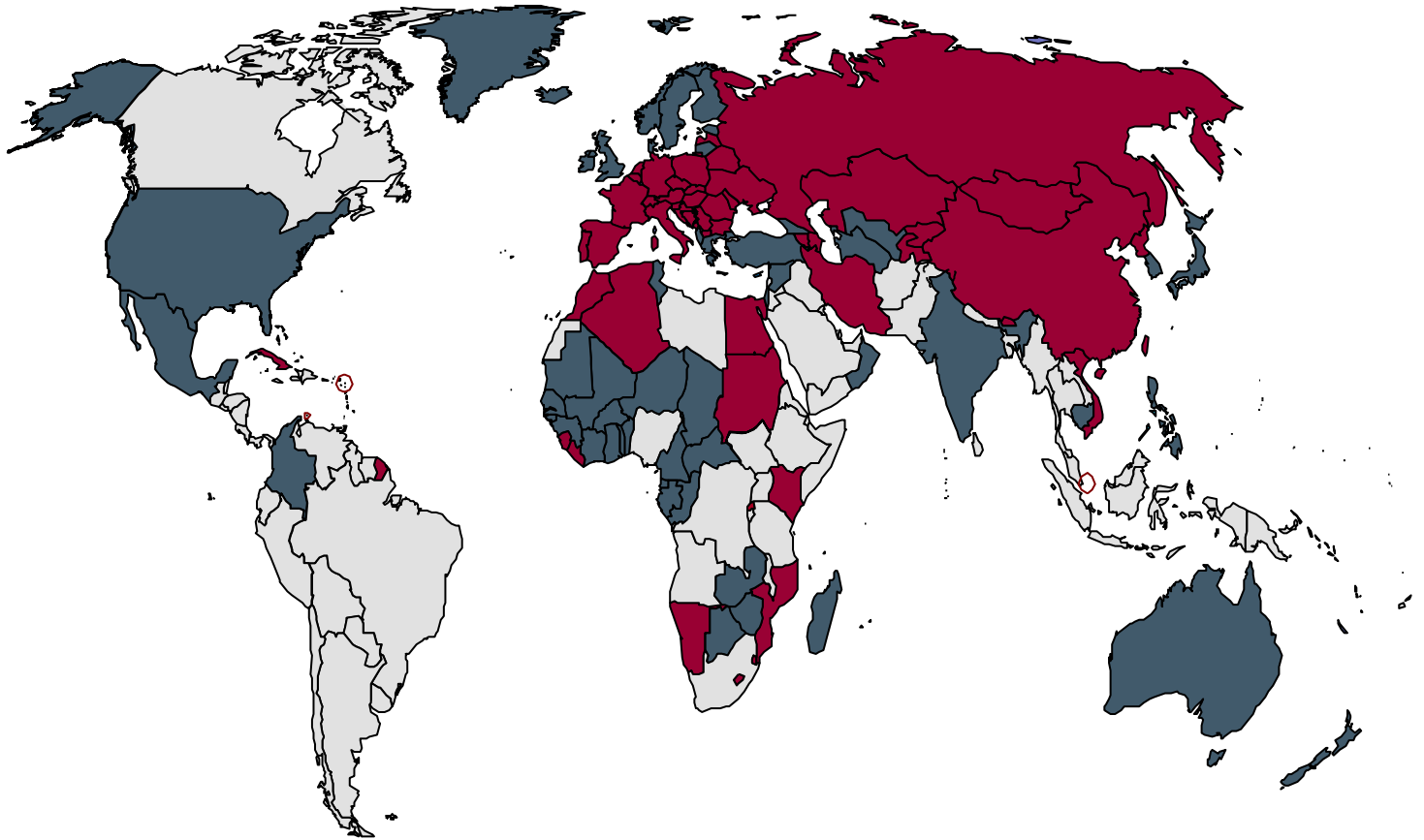
USEFUL INFORMATION**INFORMATION CONCERNING THE UNITED KINGDOM, BRITISH OVERSEAS TERRITORIES AND BRITISH CROWN DEPENDENCIES**

The Intellectual Property Office of the United Kingdom (IPO) has provided information to the International Bureau of the World Intellectual Property Organization (WIPO) on the:

- British Overseas Territories and British Crown Dependencies, which are covered by a designation of the United Kingdom in an application for international registration and in a designation subsequent to the international registration;
- Applicant's entitlement to file an international application when the address of the applicant is in any of the territories or dependencies; and
- Entitlement of the new holder ("transferee") to be the holder of an international registration when the address of the transferee is in any of the territories or dependencies.

You will find further details in Information Notice [No. 38/2015](#).

MADRID UNION MAP



- 41 Protocol only (including EU and OAPI)
- 55 Agreement and Protocol
- 96 Members covering 112 countries

HOW TO CONTACT US:

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

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

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