Role of the International Bureau
Regional Meeting of Intellectual Property Office Officials Responsible for the Madrid System

Juan Rodriguez
Senior Legal Officer
Legal Division
Madrid Registry

Tokyo, December 2016
Agenda

- Depositary functions
- International applications
  - Irregularities in international applications
- International registrations
  - The International Register
  - The Gazette
- Administrative duties
Depositary functions
Duties of the Director General of WIPO: depository functions

Receive instruments of accession, as well as declarations under the protocol and notifications of denunciation and notify Contracting Parties (Art. 14):

- refusal period (Art. 5(2))
- individual fee (Art. 8(7))
- common office (Art. 9quater)
Brunei Darussalam joined the Madrid Protocol – October 6, 2016

MADRID (MARKS) Notification No. 212

PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

Accession by Brunei Darussalam

The Director General of the World Intellectual Property Organization (WIPO) presents his compliments and has the honor to notify the deposit by the Government of Brunei Darussalam, on October 6, 2016, of its instrument of accession to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted at Madrid on June 27, 1989 (“Madrid Protocol (1989)”), as amended on October 3, 2008, and on November 12, 2007. The said instrument contained the following declaration:

− in accordance with Article 5(2)(c) of the Madrid Protocol (1989), under Article 5(2)(b) of the Protocol, the time limit of one year to exercise the right to notify a refusal of protection referred to in Article 5(2)(a) thereof is replaced by 18 months and under Article 5(2)(c) of the said Protocol, when a refusal of protection may result from an opposition to the granting of protection, such refusal may be notified to the International Bureau after the expiry of the 18-month time limit.

The Madrid Protocol (1989) will enter into force, with respect to Brunei Darussalam, on January 6, 2017.

The list of the States and the intergovernmental organizations party to the Madrid Protocol (1989) (status on October 6, 2016) is attached to this Notification.
International applications
Duties of the International Bureau for international applications – Art. 3

- Receive applications for international registration, filed through the Office of origin (OO)
- Control the classification of goods and services, in association with the OO
- Register the marks filed in accordance with the Protocol
- Notify the international registration to the Offices of the designated Contracting Parties (dCPs)
- Publish registered marks in a periodical gazette
- Record, notify and publish subsequent designations
Irregularities in international applications
Irregular international application

- **Formalities**
  no certification, using wrong form, no indication of entitlement, missing form MM18, no payment, etc. (Rule 11)

- **Classification of goods and services**
  no indication of class or terms wrongly classified (Rule 12)

- **Indications of goods and services**
  linguistically incorrect, incomprehensible or too vague for the purposes of classification (Rule 13)
Remedying an irregular application

Office of origin:
- using wrong form
- defective application (missing applicant, mark, goods and services or designations)
- missing or defective entitlement
- missing number or date of basic mark
- irregular certification
- goods and services (Rules 12 y 13)

Applicant:
- address not sufficient for postal communication
- unclear reproduction of the mark
- missing transliteration
- description of the mark not in a working language
- insufficient fees
- missing form MM18
Time-limit to remedy irregularities

- An extemporaneous priority claim will be disregarded.

- Where form MM18 is not received by WIPO within two months from date on which international application was received by the Office of origin, designation of the US is disregarded.

- Other irregularities must be remedied within three months from their notification.
Consequences

- **Formal (Rule 11)**
  where not remedied, application is declared abandoned

- **Classification of goods and services (Rule 12)**
  recorded with the classification considered to be correct by the International Bureau; applicant has a new deadline to pay any additional fees

- **Indications of goods and services (Rule 13)**
  without a satisfactory proposal from Office of origin, original term is recorded with a note from the International Bureau
Irregular international applications

- With errors; 19,207; 39%
- With no errors; 30,085; 61%
Types of irregularities

- Rule 13 (Indications of G&S): 51%
- Rule 12 (Classification): 10%
- Other Errors related to Rule 11(4) (Administrative errors): 11%
- Rule 11(3) (Fees): 28%
NOTICE CONCERNING AN INTERNATIONAL APPLICATION

ATTENTION:

The irregularity(ies) indicated in this notice is/are to be remedied by the office of origin.

The response to this notice should be received by the International Bureau no later than 15 November 2016. Please indicate the WIPO Reference number 992050301 in all your communications with the International Bureau.

Re.: International application based on application № 015453384
for the mark PSA World
in the name of Professional Squash Association

Date of receipt of the international application
by the Office of origin: 23 June 2016
by the International Bureau: 4 July 2016

Our ref. : EN-I/992050301/OB
Office ref. : 015453384_01
Applicant ref.: Examiner: Oyuntsetsen BADARCH
Telephone №: 0041223387501
E-mail: intreg.mail@wipo.int
The examination of this application has revealed the irregularities which are listed hereafter:

1. The International Bureau considers that the following term(s) of the list of goods and/or services is/are incomprehensible (Rule 13):
   (1) "lonone (perfumery)" (class 3)
   (2) "ail polish" (class 3)

The International Bureau suggests therefore the following:

(1) Please verify/reword this product in this class. (class 3)
(2) "nail polish". (class 3)
A proposal as to different term(s) may be communicated to the International Bureau. Any such proposal must be communicated THROUGH THE OFFICE OF ORIGIN, within three months from the date of the present notification, that is by 15 November 2016. If no proposal acceptable to the International Bureau is made within this period, the International Bureau will include in the international registration the term(s) as appearing in the international application, with an indication to the effect that, in the opinion of the International Bureau, the specified term(s) is/are too vague for the purposes of classification.
Annex to the irregularity notice concerning the international application based on the national application or the national registration No 015453384

Our ref.: EN-I/992050301/0B
Office ref.: 015453384_01
Applicant ref.: 

Basic fee where no reproduction of the mark is in color (Protocol application): 653.00
Complementary fee (Protocol application): 100.00
Individual fee (international application): IN 62.00

Total due: 815.00

To date, your payment is:
- payment 16/0036176 on 24/06/2016 815.00
<PAYMENT-INFO>
Kyiv, November 21, 2011

WORLD INTELLECTUAL PROPERTY ORGANIZATION
34, chemin des Colombettes,
P.O.Box 18,
CH-1211 GENEVA 20
Switzerland

Sector of Trademarks, Industrial Designs and Geographical Indications
International Registrations Administration Department
Examination and Registration Section
Madrid Team I (International Applications)

Jin-Ou YOO

Your ref.: EN-I/602541501/JY
Office ref.: 59967/1559
Re: International application based on application № m 2010 14056

for the mark D.GRASE
in the name of Zamchij Inna Oleksandrivna

Date of receipt of the international application
by the Office of origin: 12 March 2011
by the International Bureau: 10 May 2011

Dear Madame,

We acknowledge receipt of your letter.
The applicant Zamchij Inna Oleksandrivna totally agrees on your suggestion to change the incomprehensible name of the good “ail polish” into “nail polish” (class 3), and she has also clarified that the good “ionone (perfumery)” was miswritten and meant to be “ionone (perfumery)” (class 3).

Thank you very much for your attention to the matter.

Yours faithfully,

HEAD
Department of International Trademarks

Svitlana Sukhinova
CERTIFICATE OF REGISTRATION

The International Bureau of the World Intellectual Property Organization (WIPO) certifies that the indications appearing in the present certificate conform to the recording made in the International Register of Marks maintained under the Madrid Agreement and Protocol.

**Reproduction of the mark where the mark is represented in standard characters**

Manzoni

**Registration number**

1 319 721

**Registration date**

June 3, 2016

**Date next payment due**

June 3, 2026

**Name and address of holder**

TRADING & INDUSTRIAL ALEF CORPORATION
Sobinova Str., 1, Dnepropetrovsk 49083 (Ukraine)

corporation, Ukraine

Tamara Egorova LLC Patent legal bureau "CKT", T.P. Egorova, P.O. Box 7347, Dnepropetrovsk 49068 (Ukraine)

33 Anisette (liqueur); anise [liqueur]; cocktails; curacao; liqueurs.

Ukraine, 10.01.2014, 180368

**Legal nature of the holder (legal entity) and place of organization**

European Community, United States of America

China

**Designations under the Madrid Protocol**

Designations under the Madrid Protocol by virtue of Article 69

**Designations under the Madrid Protocol by virtue of Article 65**

**Declaration of intention to use the mark**

24.11.2016

**Language of the international application**

English

---

**NOTIFICATION**

ENN/2015/46

**Reproduction of the mark where the mark is represented in standard characters**

Manzoni

**Registration number**

1 319 721

**Registration date**

June 3, 2016

**Date next payment due**

June 3, 2026

**Name and address of holder**

TRADING & INDUSTRIAL ALEF CORPORATION
Sobinova Str., 1, Dnepropetrovsk 49083 (Ukraine)

corporation, Ukraine

Tamara Egorova LLC Patent legal bureau "CKT", T.P. Egorova, P.O. Box 7347, Dnepropetrovsk 49068 (Ukraine)

33 Anisette (liqueur); anise [liqueur]; cocktails; curacao; liqueurs.

Ukraine, 10.01.2014, 180368

**Legal nature of the holder (legal entity) and place of organization**

European Community, United States of America

China

**Designations under the Madrid Protocol**

Designations under the Madrid Protocol by virtue of Article 69

**Designations under the Madrid Protocol by virtue of Article 65**

**Declaration of intention to use the mark**

24.11.2016

**Language of the international application**

English

---

Geneva, <date>

Aðsta Valdmarsdóttir
Director, Operations Service
Madrid Registry
Brands and Designs Sector
International registrations
Duties of the International Bureau concerning the International Register

- Record, notify to Offices of the dCPs and publish in the gazette subsequent designations (Art. 3ter)
- Transmit a copy of the notification of refusal to the holder (Art. 5)
- Issue copies of entries in the International Register (Art. 5ter)
- Record, notify the holder and the Offices of the dCPs and publish in the gazette cancellations due to ceasing of effect (Art. 3ter)
- Process the renewal of international registrations (Art. 7)
- Record the change in the ownership (Art. 9) and other matters concerning an international registration (Art. 9bis)
Recordings in the International Register

Cancellation and changes
- Cancellation of the international registration
- Renunciation with respect to a designated Contracting Party
- Limitation of the scope of protection in one or more designated Contracting Parties
- Change in name, address or legal nature of the holder
- Change in ownership
- Merger
- Division & Merger

Other recordings
- Licenses
- Restriction of the holder’s right of disposal
- Appointment of a representative before the International Bureau
- Change in the name or address of the representative
- Final decision, further decisions, invalidations, declarations
International Register
The original International Register
The current International Register

<table>
<thead>
<tr>
<th>IRN</th>
<th>Regn Date</th>
<th>Office</th>
<th>Text</th>
</tr>
</thead>
<tbody>
<tr>
<td>0129204</td>
<td>21/12/1946</td>
<td>CH</td>
<td>EICHHORN</td>
</tr>
<tr>
<td>0129205</td>
<td>21/12/1946</td>
<td>CH</td>
<td>PRIMULUS</td>
</tr>
<tr>
<td>0129243</td>
<td>23/12/1946</td>
<td>FR</td>
<td>STENOPAN</td>
</tr>
<tr>
<td>0129244</td>
<td>23/12/1946</td>
<td>FR</td>
<td>VIOSTEN</td>
</tr>
<tr>
<td>0129280</td>
<td>26/12/1946</td>
<td>CH</td>
<td>MULTITEC</td>
</tr>
<tr>
<td>0129342</td>
<td>31/12/1946</td>
<td>CH</td>
<td>David Borloz</td>
</tr>
<tr>
<td>0129346</td>
<td>31/12/1946</td>
<td>CH</td>
<td>BILIVISIN</td>
</tr>
<tr>
<td>0129348</td>
<td>31/12/1946</td>
<td>CH</td>
<td>METHIOCIL</td>
</tr>
<tr>
<td>0129377</td>
<td>08/01/1947</td>
<td>CH</td>
<td>RAVX</td>
</tr>
<tr>
<td>0129399</td>
<td>10/01/1947</td>
<td>BX</td>
<td>STANLEY</td>
</tr>
<tr>
<td>0129400</td>
<td>10/01/1947</td>
<td>BX</td>
<td>RUBLIN</td>
</tr>
<tr>
<td>0129440</td>
<td>13/01/1947</td>
<td>FR</td>
<td>FEMME</td>
</tr>
<tr>
<td>0129611</td>
<td>27/01/1947</td>
<td>FR</td>
<td>EPILOGUE</td>
</tr>
<tr>
<td>0129645</td>
<td>31/01/1947</td>
<td>ES</td>
<td>TENTACION</td>
</tr>
<tr>
<td>0129660</td>
<td>03/02/1947</td>
<td>IT</td>
<td>VICISIN MILANO</td>
</tr>
<tr>
<td>IRN</td>
<td>Regn Date</td>
<td>Office</td>
<td>Text</td>
</tr>
<tr>
<td>--------</td>
<td>-----------</td>
<td>--------</td>
<td>------------</td>
</tr>
<tr>
<td>0129204</td>
<td>21/12/1946</td>
<td>CH</td>
<td>EICHHORN</td>
</tr>
<tr>
<td>0129205</td>
<td>21/12/1946</td>
<td>CH</td>
<td>PRIMULUS</td>
</tr>
<tr>
<td>0129243</td>
<td>23/12/1946</td>
<td>FR</td>
<td>STENOPAN</td>
</tr>
<tr>
<td>0129244</td>
<td>23/12/1946</td>
<td>FR</td>
<td>VIOSTEN</td>
</tr>
<tr>
<td>0129280</td>
<td>25/12/1946</td>
<td>CH</td>
<td>MULTITEC</td>
</tr>
<tr>
<td>0129342</td>
<td>31/12/1946</td>
<td>CH</td>
<td>David Borloz</td>
</tr>
<tr>
<td>0129346</td>
<td>31/12/1946</td>
<td>CH</td>
<td>BILIVISIN</td>
</tr>
<tr>
<td>0129348</td>
<td>31/12/1946</td>
<td>CH</td>
<td>METHIOCIL</td>
</tr>
<tr>
<td>0129377</td>
<td>08/01/1947</td>
<td>CH</td>
<td>RAVX</td>
</tr>
<tr>
<td>0129399</td>
<td>10/01/1947</td>
<td>BX</td>
<td>STANLEY</td>
</tr>
<tr>
<td>0129400</td>
<td>10/01/1947</td>
<td>BX</td>
<td>RUBLIN</td>
</tr>
<tr>
<td>0129440</td>
<td>13/01/1947</td>
<td>FR</td>
<td>FEMME</td>
</tr>
<tr>
<td>0129611</td>
<td>27/01/1947</td>
<td>FR</td>
<td>EPILOGUE</td>
</tr>
<tr>
<td>0129645</td>
<td>31/01/1947</td>
<td>ES</td>
<td>TENTACION</td>
</tr>
<tr>
<td>0129660</td>
<td>03/02/1947</td>
<td>IT</td>
<td>VICISIN MILANO</td>
</tr>
</tbody>
</table>
International registrations

WIPO MADRID
The International Trademark System

Request: 60500001
IRN: 0605000 as at ≤ 28/11/2016 ≥ Actual
Origin: CH Registration Date: 16/08/1993 Priority: 01/04/1993
Duration: 10 years
Mark Text: ROMARIN

Holder: 1 of 1
Name: ORGANISATION MONDIALE
Representative:
Nice Classes: 09 35 38
Designations: AG AL AM AT AU AZ BA BG BH BG
DE DK DZ EE EG ES FI FR GB GE
GH GI HR HU IE IL IN IT JP
KE KG KP KR KZ LI LR LS LT LV
MA MC MD ME MG MK MN MX MZ NO
History of the registration

<table>
<thead>
<tr>
<th>IRN</th>
<th>Request</th>
<th>Inscribed</th>
<th>Published</th>
</tr>
</thead>
<tbody>
<tr>
<td>80800001</td>
<td>03/08/1993</td>
<td>1993</td>
<td>8</td>
</tr>
<tr>
<td>71447260</td>
<td>27/05/1994</td>
<td>1994</td>
<td>5</td>
</tr>
<tr>
<td>71463432</td>
<td>15/07/1994</td>
<td>1994</td>
<td>7</td>
</tr>
<tr>
<td>71471977</td>
<td>09/08/1994</td>
<td>1994</td>
<td>8</td>
</tr>
<tr>
<td>71474007</td>
<td>19/08/1994</td>
<td>1994</td>
<td>8</td>
</tr>
<tr>
<td>71869928</td>
<td>05/07/1995</td>
<td>1995</td>
<td>6</td>
</tr>
<tr>
<td>71869929</td>
<td>05/07/1995</td>
<td>1995</td>
<td>6</td>
</tr>
<tr>
<td>87886401</td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td>97294801</td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td>108870901</td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td>109984201</td>
<td>08/10/1997</td>
<td>1997</td>
<td>20</td>
</tr>
<tr>
<td>110766001</td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td>111713501</td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td>114187601</td>
<td>21/01/1996</td>
<td>1996</td>
<td>1</td>
</tr>
<tr>
<td>133441101</td>
<td></td>
<td></td>
<td></td>
</tr>
</tbody>
</table>
The Gazette
The original Gazette
The current WIPO Gazette

WIPO Gazette of International Marks

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

Registrations

<table>
<thead>
<tr>
<th>Mark</th>
<th>IRN</th>
<th>Holder</th>
<th>Origin</th>
<th>Transaction</th>
<th>Gazette</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>33188715</td>
<td>Thomas A. Hill Limited</td>
<td>GB</td>
<td>Registration</td>
<td>2016 / 46</td>
</tr>
<tr>
<td></td>
<td>13187816</td>
<td>Interims UK Limited</td>
<td>GB</td>
<td>Registration</td>
<td>2016 / 46</td>
</tr>
<tr>
<td></td>
<td>13187817</td>
<td>Masquerade Technologies, Inc.</td>
<td>US</td>
<td>Registration</td>
<td>2016 / 46</td>
</tr>
</tbody>
</table>
Administrative duties
Administrative duties of the International Bureau

- Collect fees on behalf of the dCPs and distribute them accordingly (Art. 8)
- Undertake related duties and administrative tasks concerning the Protocol (Art. 11)
- Make preparations for and be Secretariat of assemblies, conferences and other meetings, as well as undertake other tasks, as assigned (Art. 11)
The Working Group on the Legal Development of the Madrid System

- Meeting of technical delegations from Contracting Parties and observers
- Discuss ways to improve the practice of Offices and the International Bureau
- Request that the International Bureau draft proposals and documents
- Discuss proposals to change the Common Regulations
- Make recommendations to the Assembly of the Madrid Union
- Documents and report available for review on WIPO Website
The Madrid Union Assembly – Art. 10

- Meeting of delegations from Contracting Parties during the WIPO General Assemblies
- Deal with all matters concerning the maintenance and development of the Madrid Union
- Formally adopt or change the Common Regulations and the amounts of the fees under the Protocol
- Review and approve reports, activities, programs and budget of the Union (in the GA)
- Documents and report available for review on WIPO Website
Technical assistance and cooperation

- For prospective members:
  Accession toolkit; review of legal framework; fact-finding and assessment missions; capacity building; stakeholder outreach

- For current members:
  Legal and operational support; capacity building; outreach activities
Thank you for your attention

juan.rodriguez@wipo.int