

# HIGHLIGHTS

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

## CONTRACTING PARTIES

### DECLARATION MADE UNDER ARTICLE 8(7)(a) OF THE MADRID PROTOCOL

#### Kenya

The Government of Kenya has made the declaration referred to in Article 8(7)(a) of the Madrid Protocol with a view to receiving an individual fee where Kenya is designated in an international application, in a designation subsequent to an international registration or in respect of the renewal of an international registration designating Kenya. For Kenya, the following fees entered into force on June 12, 2014:

ITEMS		Amounts (in Swiss francs)
Application or Subsequent Designation	– for one class of goods or services	312
	– for each additional class	223
	<i>Where the mark is a collective or certification mark:</i>	
	– for one class of goods or services	312
Renewal	– for each additional class	223
	– for one class of goods or services	178
	– for each additional class	134
	<i>Where the mark is a collective or certification mark:</i>	
Renewal	– for one class of goods or services	178
	– for each additional class	134

For more information, please refer to Information Notice [No. 8/2014](#).

### CHANGES IN THE AMOUNTS OF THE INDIVIDUAL FEE

There are changes to the amounts of the individual fee payable for Japan, Norway, Turkey and the Philippines, where they are designated in an international application, in a designation subsequent to an international registration or in respect of the renewal of an international registration designating the countries in question.

#### Japan

For Japan, the following fees entered into force on May 10, 2014:

ITEMS		Amounts (in Swiss francs)
Application or Subsequent Designation	<u>First Part:</u>	
	– for one class of goods or services	99
	– for each additional class	75
	<u>Second Part:</u>	
Renewal	– for each class of goods or services	328
	– for each class of goods or services	423

For more information, please refer to Information Notice [No. 5/2014](#).

**Norway**

For Norway, the following fees will enter into force on July 1, 2014:

ITEMS		Amounts (in Swiss francs)	
Application or Subsequent Designation	– for three classes of goods or services	340	
	– for each additional class	96	
<i>Where the mark is a collective mark:</i>			
	– for three classes of goods or services	340	
	– for each additional class	96	
Renewal	– for three classes of goods or services	385	
	– for each additional class	148	
	<i>Where the mark is a collective mark:</i>		
	– for three classes of goods or services	385	
	– for each additional class	148	

For more information, please refer to Information Notice [No. 09/2014](#).

**Turkey**

For Turkey, the following fees entered into force on June 15, 2014:

ITEMS		Amounts (in Swiss francs)
Application or Subsequent Designation	– for one class of goods or services	207
	– for each additional class	40
Renewal	– independent of the number of classes	202

For more information, please refer to Information Notice [No. 10/2014](#).

**Philippines**

For the Philippines, the following fees will enter into force on July 12, 2014:

ITEMS		Amounts (in Swiss francs)
Application or Subsequent Designation	– for each class of goods or services	95
Renewal	– for each class of goods or services	146

For more information, please refer to Information Notice [No.11/2014](#).

## ONLINE SERVICES

### MADRID PORTFOLIO MANAGER (MPM)

Did you know that by using the MPM, you can:

- **View** the status of any of your requests as they are being processed by the International Bureau in **real time**;
- Have **access** to all written communications that you send to and receive from the International Bureau;
- **Make** a payment and renew your marks **electronically**;
- **Add more** international trademark registrations to your watch list in the Madrid Electronic Alert (MEA) service and receive an email each time a change concerning one of your international registrations has been recorded in the International Register;
- **Expand** the protection of any of your marks electronically using our online subsequent designation service (more options will be made available through this service soon);
- **Upload** any official forms or written communications related to your mark;
- **Contact** our support team for any questions you may have concerning your Portfolio.

All you need is a **WIPO User Account** and a **unique email address** for all your international trademark registrations. For more details, please contact [e-marks@wipo.int](mailto:e-marks@wipo.int).

### WIPO GLOBAL BRAND DATABASE

As a Madrid System user, you are probably familiar with WIPO's [Global Brand Database \(http://www.wipo.int/branddb/en/\)](http://www.wipo.int/branddb/en/), our IT tool where you can search brand information from multiple national and international sources, including trademarks, appellations of origin and official emblems.

The icing on the cake is the new feature: *a unique image-search function*. This allows users to upload an image to search for visually similar trademarks and other brand-information records from among the millions of images in the collection.

More information and a video on our Press Release are available at: [http://www.wipo.int/pressroom/en/articles/2014/article\\_0007.html](http://www.wipo.int/pressroom/en/articles/2014/article_0007.html).

The image-search functionality, which is the first of such applications among free, public intellectual property databases, supplements the database's other querying criteria, including Vienna Classification codes, brand-holder names, country of origin and others. With this new addition, for example, a user can simply upload a proposed logo and quickly return records – browsing through more than 4 million images from 15 national and international collections – of other protected images that may bear a resemblance.

We encourage you to use it, and if you have any suggestions, we would be delighted to hear from you.

## **MADRID GOODS AND SERVICES MANAGER (MGS)**

On June 1, 2014, the Korean interface of MGS, developed in cooperation with the Korean Intellectual Property Office (KIPO), was launched on the World Intellectual Property Organization (WIPO) public web site, bringing the number of language interfaces available to 16, in addition to Arabic, Chinese, Dutch, English, French, German, Hebrew, Italian, Japanese, Norwegian, Portuguese, Russian, Serbian, Spanish and Turkish.

The International Bureau of WIPO is also pleased to announce that MGS now features:

- an improved search function on single characters in the Asian languages;
- over 53,000 English terms, grouped in some 34,000 concepts, each of these concepts describing a unique good or service;
- the acceptance status by MGS participating countries of the class headings of the Nice Classification;
- an improved menu of display options;
- an optional display of basic numbers for indications of the Nice Classification; and
- a direct link to the Nice Classification web site.

For more information, please refer to Information Notice [No.12/2014](#).

## **MADRID OUTREACH**

### **INTERNATIONAL TRADEMARK ASSOCIATION (INTA) 2014**

The INTA Annual Meeting is the largest gathering of trademark professionals in the world. This year there were 8,606 registered attendees made up of in-house counsels (789), private practitioners (6,652), service providers (755), academics (90) and government officials (200 from 35 countries). There were 137 booths in the Exhibition Hall.

WIPO's annual Madrid System Users' Meeting (MSUM) was held from 11 a.m. to 2 p.m. on Sunday, May 11, 2014, as part of the main program of the INTA Annual Meeting. The MSUM featured updates of the Madrid and Hague Systems, including new IT tools, statements by the Heads of Offices of new Contracting Parties (India, Mexico and Tunisia), as well as presentations on how to avoid notifications of refusal under the Madrid System by representatives from various Offices (China, European Union, Republic of Korea, Singapore, United States of America). OAPI, a potential Contracting Party of the Madrid System, also featured on the program. Those speakers who did not have national or regional booths of their own were available for private consultations at the WIPO booth in the Exhibition Hall on Sunday afternoon from 3 p.m. to 5 p.m.

In addition to the MSUM, members of the WIPO Delegation participated in three Table Topic Sessions, one concurrent session on the Madrid System in the main program and in numerous formal and informal meetings with Officials and Officers of INTA, other NGOs and the many Government Officials in attendance. WIPO experts on the Madrid and Hague Systems and the WIPO Arbitration and Mediation Center were available for private consultations with users and potential users at the WIPO Booth in the Exhibition Hall from May 11 to 14, 2014.

More detailed information on WIPO's activities at the 136<sup>th</sup> INTA Annual Meeting may be accessed from the Madrid pages of the WIPO web site at: [www.wipo.int/madrid/en/meetings/2014/inta](http://www.wipo.int/madrid/en/meetings/2014/inta). Information on WIPO's activities at the 137<sup>th</sup> INTA Annual Meeting from May 2 to May 6, 2015, in San Diego, California, will be posted several months prior thereto.

## **SEMINAR ON THE MADRID SYSTEM FOR THE INTERNATIONAL REGISTRATION OF MARKS**

WIPO continues to see training as the best initiative to promote the better use of the Madrid System among users. These training programs are conducted through a series of Seminars on the Madrid System for the International Registration of Marks.

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

The event takes place twice a year at the headquarters of WIPO in Geneva; one in the spring and another one in the fall.

Hence, the 50<sup>th</sup> edition of the Seminar took place at WIPO's headquarters in Geneva, on June 19 and 20, 2014.

This Seminar was attended by over 44 participants from 20 countries, mainly comprising Representatives from industry, independent and in-house trademark agents (paralegals as well as attorneys) most of whom file applications for international registration and/or who administer such registrations. Representatives of some national Intellectual Property Offices also participated in the Seminar.

To stay updated in this respect, users may wish to subscribe to the Madrid E-Newsletter (<http://www.wipo.int/madrid/en/subscribe.html>). This subscription will allow them to receive automated e-mail notices on the Madrid System, including the forthcoming meetings and seminars.

## **MADRID TIPS**

### **PRACTICAL EXAMPLES ON THE IMPLEMENTATION OF THE MADRID SYSTEM: RULE 12 OF THE COMMON REGULATIONS UNDER THE MADRID AGREEMENT AND PROTOCOL**

According to Rule 12 of the Common Regulations under the Madrid Agreement and Protocol, if an international application contains any of the irregularities mentioned below, the International Bureau will make its own proposal through an irregularity letter to the Office of origin with a copy to the applicant/representative, inviting them to make corrections or clarify that irregularity.

An irregularity notice will be sent to the applicant under Rule 12 if the goods and/or services:

- Are not grouped in the appropriate class or classes;
- Could be grouped in more classes than indicated on the form;
- Are not preceded by the number of the class or classes of the International Classification;
- Are preceded by a number, but that number is not the right number.

The proposal of the International Bureau will contain supporting references such as the class headings of any of the 45 classes of the Nice Classification, quote at least one position from the alphabetical list of goods and services, make an analogy to any good/service from the alphabetical list of goods and/or services or suggest a rewording of the list within the same class.

Although the Office of origin is responsible for communicating the Official response to the International Bureau within three months from the notification in the form of a proposal, the International Bureau has the final responsibility of the classification and grouping of goods and/or services in the international application.

The International Bureau must take into consideration any disagreement expressed by the Office of origin on the classification and grouping. It will also supply sufficient information to the applicant, leaving him/her the possibility to interact with that Office before it communicates its response to the International Bureau.

**Q1. Can the Office of origin send a response without consulting me?**

R1. Yes, the Office of origin can send a response without consulting you. However, the information sent to you by the International Bureau will enable you to interact with your Office of origin for an appropriate response in a timely manner. You may therefore contact your Office as early as possible and give your opinion on the classification of goods/services before it sends its response to the International Bureau.

**Q2. If it happens that the Office of origin does not respond to the irregularity notice or its response did not reach the International Bureau on time, but I sent a response directly to the International Bureau within the time limit, can the International Bureau take my request into consideration?**

R2. No. You should send your response through your Office of origin ahead of time and make sure it also reaches the International Bureau on time.

Furthermore, the International Bureau will issue a reminder two months after the first irregularity notice.

If the Office of origin's response does not reach the International Bureau on time and your fees have been paid, your mark will be recorded in the International Register according to the International Bureau's proposal.

**Q3. How will the International Bureau deal with the response from the Office of origin?**

R3. When the International Bureau receives a response from the Office of origin, it will review the response and consider three options:

- Withdraw its initial proposal if the Office of origin disagrees with the International Bureau and provides more clarification and justification;
- Modify it;
- Confirm it.

In all cases, it will notify the Office of origin and inform you accordingly.

In case the International Bureau **withdraws** its opinion, it will disregard any amount it had claimed for extra classes resulting from its proposal, and if you had already paid those fees, the International Bureau will reimburse you. You could also decide to drop the extra classes suggested by the International Bureau. In this case, you should inform the International Bureau of such decision. If the fees are paid and all of the formalities have been concluded, the mark will be registered as it was initially filed by you or the Office of origin.

If the International Bureau **modifies** its proposal, the modification will be reflected in the fees; if the fees are paid, the mark will be registered.

If the International Bureau **confirms** its proposal, upon payment of the fees, the mark will be registered according to the International Bureau's proposal.

If the International Bureau does not receive any response from the Office of origin and no additional fees have been paid, the international application will be abandoned. The International Bureau will reimburse any fees paid, but will deduct one half of the amount corresponding to fees for a black and white reproduction.

#### Q4. How will I know about the outcome of the procedure?

R4. After the irregularity is settled between all parties, the International Bureau will record the mark in the International Register. It will also notify the Offices of the designated Contracting Parties of the international registration, inform the Office of origin and send a certificate to you. The international registration will also be published in the *WIPO Gazette of International Marks*.

You are strongly encouraged to use our classification online tools which will help you correctly classify your goods/services according to the Nice Classification of goods and services:

NICEPub: [http://web2.wipo.int/nicepub/edition-20140101/taxonomy/?pagination=no&lang=en&mode=flat&explanatory\\_notes=hide&basic\\_numbers=show](http://web2.wipo.int/nicepub/edition-20140101/taxonomy/?pagination=no&lang=en&mode=flat&explanatory_notes=hide&basic_numbers=show).

Madrid Goods and Services Manager (MGS): <http://www.wipo.int/gsmmanager>.

## LEGAL ISSUES

### RECORDING A CHANGE IN THE LEGAL NATURE OF THE HOLDER

The International Bureau frequently is asked whether to request the recording of a change in ownership (form MM5) or a change in name of the holder (form MM9) when the holder also wants to change the indication concerning its legal nature. According to the Common Regulations under the Madrid Agreement and the Protocol (the "Common Regulations"), the indication concerning the legal nature of the holder cannot be changed when recording a change in name only.

#### Request for the recording of a change in name or a change in ownership:

If you are the holder of an international registration and your name has changed, you can request the recording of a change in name, by using form MM9 and paying a fee of 150 Swiss francs per request.

When a new person (natural person or legal entity) becomes the holder of an international registration, you can request the recording of a change in ownership, by using form MM5 and paying a fee of 177 Swiss francs per international registration.

Before filing a request, you must carefully consider whether it would be appropriate to request the mere recording of a change in name or, instead, request the recording of a change in ownership to ensure that the recording has the desired legal effects in the designated Contracting Parties.

**Indicating the legal nature of the holder in a request for the recording of a change in name:**

In accordance with Rule 25 of the Common Regulations, the official form to request a change in name of the holder (form MM9) does not provide for an option to indicate the new legal nature of the holder. However, Rule 25(2)(b)(ii) of the Common Regulations indicates that, in a request for a change in ownership (form MM5), where the new holder is a legal entity it may indicate its legal nature.

The official forms have been designed in accordance with the Common Regulations and users of the Madrid System cannot change them. Indications concerning the legal nature of the holder improperly inserted in the official form to request a change in name of the holder (form MM9) cannot be recorded by the International Bureau.

Frequently, an abbreviation or initials are added to a legal entity's name (e.g. "*Stella S.p.A*") and, in some cases, they refer to the entity's legal nature (e.g. "*Società per azioni*", in Italian). Users must carefully consider whether requesting the mere recording of a change in name would have the desired legal effects in the designated Contracting Parties when these abbreviations or initials are changed.

**Indicating the legal nature of the holder in a subsequent designation:**

While indicating the nature of a legal entity in the international application is optional, the holder may not change this indication whenever the holder wishes to do so after the mark has been registered. The prescribed official subsequent designation form (MM4) provides for an option to indicate the legal nature of the holder but it may be used only when the holder did not provide that indication in the international application.

When the holder has provided an indication concerning its legal nature in the international application, this indication cannot be changed later in a subsequent designation.

**USEFUL INFORMATION****MADRID STATISTICS**

If you would like to find out which countries filed the most applications, what the top 5 classes or who the top 15 Madrid applicants are, you can access the graphic highlighting the latest international IP filing figures through the following link:

[http://www.wipo.int/pressroom/en/articles/2014/article\\_0002.html](http://www.wipo.int/pressroom/en/articles/2014/article_0002.html).

For detailed, searchable statistics on the Madrid System, please visit:

<http://www.wipo.int/madrid/en/statistics/index.jsp?type=2>.

**IP STATISTICS**

WIPO cooperates with Intellectual Property (IP) Offices from around the world to provide interested parties with up-to-date IP statistics, reports on worldwide IP activities as well as on the use of WIPO-administered treaties in relation to the protection of IP rights internationally.

The **IP Statistics Data Center** is an online service enabling access to WIPO's statistical data. Users can select from a wide range of indicators and view or download data according to their needs. This service is intended for IP professionals, researchers and policymakers worldwide. (<http://ipstatsdb.wipo.org/ipstatv2/ipstats/patentsSearch>)

The **IP Statistical Country Profiles** provide information on patents, utility models, trademarks and industrial designs. They cover different dimensions of IP activities, including incoming and outgoing filings, the share of filings in different technological fields, total patents in force, and the use of international IP systems by applicants.

([http://www.wipo.int/ipstats/en/statistics/country\\_profile/](http://www.wipo.int/ipstats/en/statistics/country_profile/))

## **ENTRY INTO FORCE OF THE 2014 VERSION OF THE TENTH EDITION OF THE NICE CLASSIFICATION**

A new version of the tenth edition of the Nice Classification “NCL(10-2014)” entered into force on January 1, 2014. The new version is available on WIPO’s website through the following address: [www.wipo.int/classifications/en/](http://www.wipo.int/classifications/en/).

For more information, please see Information Notice [No. 6/2014](#).

## **AMENDED OFFICIAL FORMS (MM FORMS)**

New official forms for the filing and managing of international registrations were introduced in March this year ([http://www.wipo.int/edocs/madrdocs/en/2014/madrid\\_2014\\_4.pdf](http://www.wipo.int/edocs/madrdocs/en/2014/madrid_2014_4.pdf)). One of the amended features of the MM forms gives users of the Madrid System the possibility to choose an e-mail notification service.

When filling in an MM form, the applicant or holder of a trademark can indicate an e-mail address in the space provided for contact details (name/address/address for correspondence/telephone/fax and e-mail address). Applicants, holders and/or their representatives are reminded that by providing this e-mail address, they choose to automatically receive all notifications from the IB only by email.

Notifications by e-mail will then apply to all international registrations previously recorded in the International Register with the same e-mail address.

In the case of a portfolio containing a considerable number of international registrations, attention is drawn to the fact that any change in the e-mail address of a specific international registration will affect all other marks in that entire portfolio. This information is particularly important for users of the Madrid Portfolio Manager (MPM).

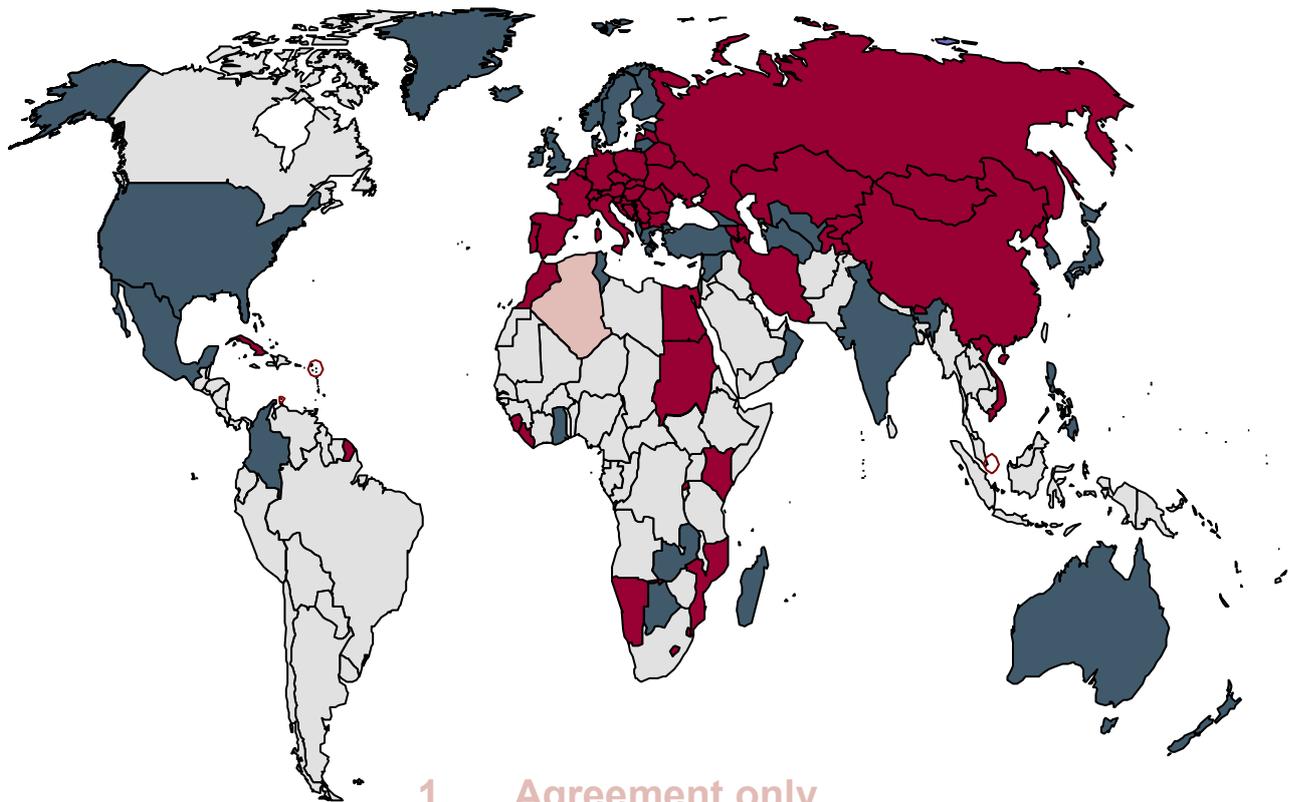
## **INFORMATION CONCERNING NATIONAL OR REGIONAL PROCEDURES BEFORE IP OFFICES UNDER THE MADRID SYSTEM**

Intellectual Property Offices of Contracting Parties of the Madrid System provide specific practical and legal information on their procedures concerning international applications and registrations at: [http://www.wipo.int/madrid/en/members/ipoffices\\_info.html](http://www.wipo.int/madrid/en/members/ipoffices_info.html).

This information was initially available in English only. The French version was made available in June 2013.

The International Bureau is pleased to announce the launching of the Spanish version, making the information available now in all three languages of the Madrid System: English, French and Spanish.

MADRID UNION MAP



- 1 Agreement only
- 37 Protocol only (including EU)
- 54 Agreement and Protocol
- 92 Members

**HOW TO CONTACT US:**

**General Queries:** Madrid Customer Service +41 22 338 8686. Email: [intreg.mail@wipo.int](mailto:intreg.mail@wipo.int)

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

**Extracts Queries:** Clients Records Unit +41 22 338 8484. E-mail: [madrid.records@wipo.int](mailto:madrid.records@wipo.int)

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

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Phone +41 22 338 750 2

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Phone +41 22 338 750 3

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

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

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

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