

# HIGHLIGHTS

[www.wipo.int/madrid/en](http://www.wipo.int/madrid/en)

September 2014 | No. 3/2014

## CONTENTS

<b>MADRID UNION</b> .....	<b>2</b>
The Madrid Working Group	
<b>MADRID OUTREACH</b> .....	<b>4</b>
Training Workshop for National Offices on the Operations of the Madrid System for the International Registration of Marks	
Seminar on the Madrid System for the International Registration of Marks	
<b>MADRID TIPS</b> .....	<b>4</b>
Unsolicited Communications Received by Users of the Madrid System Requesting Payment of Fees: Tips and Samples of Misleading Invoices	
<b>USEFUL INFORMATION</b> .....	<b>7</b>
New Practice in Examination Before the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Where the European Union (EU) is a Designated Contracting Party	
Madrid Union Map	
<b>CONTACT US</b> .....	<b>9</b>

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).

## MADRID UNION

### THE MADRID WORKING GROUP

The twelfth session of the Working Group on the Legal Development of the Madrid System for the International Registration of Marks will take place in Geneva, from October 20 to 24, 2014.

The World Intellectual Property Organization (WIPO) has prepared four documents for discussion in the Working Group intended to support the ongoing process of making the Madrid System more user-friendly. These documents are available on the WIPO web site at: [http://www.wipo.int/meetings/en/details.jsp?meeting\\_id=32427](http://www.wipo.int/meetings/en/details.jsp?meeting_id=32427).

#### 1. Proposed Amendments to the Common Regulations ([MM/LD/WG/12/2](#)).

This document presents proposed amendments to various rules of the Common Regulations concerning issues such as failure in communications sent electronically, voluntary description of the mark, replacement and subsequent designations.

##### *(a) Failure in Communications Sent Electronically*

Rule 5 provides for remedies where the holder or an Office fails to meet a time limit for a communication addressed to WIPO sent through a postal or delivery service resulting from a *force majeure* circumstance (war, strike, natural calamity etc.).

Amendments to Rule 5 are proposed to provide for remedies where the applicant, the holder, the representative or an Office fails to meet a time limit for a communication addressed to WIPO and sent by electronic means (e.g., e-mail, fax, electronic forms).

##### *(b) Voluntary Description of the Mark*

Rule 9 does not allow an applicant to include a description of the mark (such as “*the mark consists of a design of a horseshoe*”) in the international application if the basic application or registration does not contain such description.

It is proposed to amend Rule 9 to allow the inclusion of a description of the mark in the international application regardless of whether such description is contained in the basic mark or registration. By providing such voluntary description, the applicant may avoid possible provisional refusals from designated Contracting Parties that require description of marks considered to be in non-standard characters.

##### *(c) Replacement*

Replacement is a mechanism geared toward making the use of the Madrid System and the centralized management of trademark portfolios more efficient. Under certain conditions, international registrations are deemed to have replaced national or regional registrations in designated Contracting Parties. The request to an Office under Rule 21 to take note of the replacement must be addressed to each Office concerned directly.

It is proposed to amend Rule 21 to allow such requests to be submitted to the Offices concerned through the intermediary of WIPO. The proposed change would introduce a streamlined procedure and increase the information available in the International Register resulting in a more user-friendly Madrid System.

(d) *Subsequent Designations*

Two amendments to Rule 24 are proposed:

- (i) clarifying that the examination of subsequent designations undertaken by the International Bureau includes examination of the list of goods and services; and
- (ii) limiting the abandonment of the subsequent designation to the designated Contracting Party concerned, where an irregularity related to a declaration of intention to use is not remedied.

2. Proposal for the Introduction of the Recording of Division or Merger Concerning an International Registration ([MM/LD/WG/12/3](#)).

This document presents detailed proposals for the introduction of the recording in the International Register of the division or merger of international registrations. It provides information on the process for the recording of division in the International Register and concerning the costs and workload implications for WIPO and the Offices concerned.

3. Proposal to Freeze the Operation of Articles 6(2), (3) and (4) of the Madrid Agreement and the Protocol ([MM/LD/WG/12/4](#)).

This document analyzes all aspects of freezing the dependence of international registrations on the basic mark. More specifically it provides information on the effects of dependency of the international registration on the basic mark and the constitutional considerations regarding the possibility to freeze the operation of a provision in a treaty.

4. Replacement ([MM/LD/WG/12/5](#)).

This document is based on information received from Contracting Parties in response to a questionnaire, dated December 2013, concerning replacement and the way in which Contracting Parties have implemented and apply the related provisions of the treaties of the Madrid System (see Annexes I and II to this document).

The findings show that divergent interpretations, procedures and practices continue to exist in respect of the implementation of replacement under Articles 4*bis* of the treaties and of Rule 21 of the Common Regulations. The findings show that there are different interpretations of key elements of replacement, such as:

- (a) the effective date of replacement,
- (b) the time at which a request under Articles 4*bis*(2) may be filed with the Office,
- (c) the goods and services listed in the national or regional registration, and
- (d) the effects of replacement on the national or regional registration.

### **The Madrid Working Group Roundtable**

The Madrid Working Group Roundtable will take place during the twelfth session of the Working Group (October 23 and 24, 2014). This event provides an opportunity for the Offices of Contracting Parties, intergovernmental and non-governmental organizations and WIPO to share experiences and informally discuss issues of a legal, operational and information technology nature related to the Madrid System.

## MADRID OUTREACH

### TRAINING WORKSHOP FOR NATIONAL OFFICES ON THE OPERATIONS OF THE MADRID SYSTEM FOR THE INTERNATIONAL REGISTRATION OF MARKS

Since 2012, WIPO has been organizing on a regular basis a special Training Workshop on the Madrid System for National Offices.

The workshop is mainly designed for new Contracting Parties to the Madrid Protocol, Developing Countries and Least Developed Countries (LDCs).

The objective of this workshop is to provide specific training for Offices focusing on their role in the system and providing an in-depth knowledge on the communications to and from WIPO, including our newest IT tools and databases.

The next training workshop, which will be announced in due course, will take place in Geneva from November 5 to 7, 2014.

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

Since 1996, WIPO has been organizing, at its headquarters, between two to three intensive training seminars per year for users seeking to reinforce their knowledge of the procedural and operational aspects of the Madrid System. The program of each seminar is designed to provide updates on the System's developments and allow a pool of experts from WIPO, Offices of Contracting Parties and private trademark practitioners to share their knowledge and own experience with participants. Users' special cases requiring private consultations with the experts are also considered.

The second seminar of this year is scheduled for November 20 and 21, 2014. Detailed information regarding the event, including the program and the online registration facilities will soon be posted on the Madrid web site at: <http://www.wipo.int/madrid/en/news/>.

Subscribers to the Madrid e-Newsletter <http://www.wipo.int/lists/subscribe/madrid-en> will receive an automatic notification regarding the event.

## MADRID TIPS

### UNSOLICITED COMMUNICATIONS RECEIVED BY USERS OF THE MADRID SYSTEM REQUESTING PAYMENT OF FEES: TIPS AND SAMPLES OF MISLEADING INVOICES

As already mentioned in the first edition of the Madrid Highlights of 2013, [Madrid Highlights, Issue No. 1 of 2013](#), it has come to the attention of WIPO that some entities that appear to be private business establishments are sending letters to the holders of international registrations recorded under the Madrid System, inviting them to pay fees in order to renew their international registrations, to record them in business directories and other publications which seem to be of an official nature, or offering services similar to those already provided by WIPO.

All international trademark registrations and related recordings are published in the [WIPO Gazette of International Marks](#), one of the official publications of the Madrid System. All [fees](#) payable under the Madrid System are to be paid to WIPO directly in Swiss francs (CHF) or through the Office of origin. The WIPO [ROMARIN](#) international trademark information database contains more information regarding international applications, international registrations and subsequent designations. This *database* is updated daily and is available *free-of-charge*.

WIPO notified holders of international registrations of this fraudulent practice through Information Notice [No. 6/2010](#).

This warning, together with a non-exhaustive list of samples ([samples of misleading invoices page](#)) of such misleading invoice documents collected by WIPO, are available on the Madrid System's main page under "key resources/fees":

<http://www.wipo.int/madrid/en/fees/warning.html>. The samples are listed by order of "name of issuing institutions", "country and city of origin" as well as "date of receipt/issuance".

Furthermore, WIPO, in collaboration with some trademark Offices have provided more information and samples of such misleading invoices to prevent trademark holders from being swindled. These can be accessed on our web site:

[http://www.wipo.int/madrid/en/fees/ip\\_position.html](http://www.wipo.int/madrid/en/fees/ip_position.html).

For example, concerning community trademark registrations, users may also find it convenient to visit the webpage of the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM): <https://oami.europa.eu/ohimportal/en/misleading-invoices>.

Samples are also available on OHIM's web site through the following link:

[https://oami.europa.eu/tunnel/web/secure/webdav/guest/document\\_library/contentPdfs/trade\\_marks/fees\\_and\\_payment/misleading\\_invoices/misleading-invoices\\_en.pdf](https://oami.europa.eu/tunnel/web/secure/webdav/guest/document_library/contentPdfs/trade_marks/fees_and_payment/misleading_invoices/misleading-invoices_en.pdf)).

If you have questions about any such invoices you may have received or about any samples not mentioned in the referenced list, please check with your representative, your trademark Office, or contact us at: [intreg.mail@wipo.int](mailto:intreg.mail@wipo.int), attaching a copy of the suspicious document.

Below are some tips on how to spot these fraudulent or misleading communications illustrating concrete examples sent by users of the Madrid System.

## Language

The three official/working languages of the Madrid System are English, French and Spanish. If the "notification" is written in a language other than any of the three mentioned above, this means that **the services offered have no connection with WIPO**.

## Method of Payment

These misleading communications often invite international registration holders to make payment in Euros or US dollars, by cheque and/or money/wire transfer, principally in locations other than Switzerland.

All WIPO's invoices are issued in Swiss francs and are to be paid either through **the following means**:

- by debiting from a **current account** opened with WIPO:

If you carry out many financial transactions with the International Bureau for the international registration of marks, industrial designs or PCT Patent filings, it is advisable to open such a current account. Please refer to conditions for opening, using and closing a current account at WIPO [[PDF](#)].

- by transfer to the **WIPO bank account**:

IBAN No: CH51 0483 5048 7080 8100 0  
Credit Suisse, CH-1211 Geneva 70  
Swift/BIC: CRESCHZZ80A

- by payment into the **WIPO postal account** (within Europe only):

WIPO postal account  
 IBAN No: CH03 0900 0000 1200 5000 8  
 Swift/BIC: POFICHBE

- by **credit card** using WIPO electronic payment services:

[E-Renewal](#) can be used to renew your international mark on-line.  
[E-Payment](#) **can only be used to pay fees as notified in irregularity letters or other WIPO communications with regard to international applications or registrations.**

More information on the payment of fees under the Madrid System is available at:  
<http://www.wipo.int/about-wipo/en/finance/madrid.html>

If the “notification” invites the holder of the international registration to pay in a currency other than Swiss francs, this also means that **the services offered have no connection with WIPO.**

### Contact Details

WIPO Headquarters: 34, chemin des Colombettes, CH-1211 Geneva 20, Switzerland.  
 (WIPO also has external offices in Brazil, China, Japan, New York and Singapore, but all payment is to be made into WIPO’s accounts in Switzerland – refer to information above).

Web site: <http://www.wipo.int/>.

### Logo

Some of these establishments use signs similar to the WIPO logo or name, thereby misleading the public as to their origin.

For example, the following logos are not related to WIPO and the Madrid System.



EINGEGANGEN (



Imagine Creativity and Innovation

BUREAU MONDIAL  
 PROPRIETE INTELLECTUELLE



WORLD BUREAU  
 INTELLECTUAL PROPERTY

WIPO's official logos are the following:



Should you receive any correspondence with other misleading logos, please do not hesitate to contact us at: [intreg.mail@wipo.int](mailto:intreg.mail@wipo.int).

## USEFUL INFORMATION

### NEW PRACTICE IN EXAMINATION BEFORE THE OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET (TRADE MARKS AND DESIGNS) (OHIM) WHERE THE EUROPEAN UNION (EU) IS A DESIGNATED CONTRACTING PARTY

As of October 1, 2014, OHIM will begin examining the indication of goods and services for vague terms. This new practice will apply to international registrations in which the EU has been designated (either in an international application or a subsequent designation) and that are notified to OHIM on or after that date.

This change brings OHIM's practice in line with that of the EU's national and regional IP Offices, as previously outlined in OHIM's Common Communication on the implementation of "IP Translator" dated February 20, 2014, available on OHIM's web site, at the following address: [https://oami.europa.eu/tunnel-web/secure/webdav/guest/document\\_library/contentPdfs/about\\_ohim/who\\_we\\_are/common\\_communication/common\\_communication1\\_en.pdf](https://oami.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/about_ohim/who_we_are/common_communication/common_communication1_en.pdf)).

As a result, if a term is considered by OHIM as being too broad or too vague, and lacking clarity and precision, OHIM may issue a notification of provisional refusal with respect to the said international registration.

OHIM considers that the following 11 indications of the class headings are too broad or too vague:

- Class 6: Goods of common metal not included in other classes
- Class 7: Machines and machine tools
- Class 14: Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes
- Class 16: Paper, cardboard and goods made from these materials [paper and cardboard], not included in other classes
- Class 17: Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials [rubber, gutta-percha, gum, asbestos and mica] and not included in other classes
- Class 18: Leather and imitations of leather, and goods made of these materials [leather and imitations of leather] and not included in other classes
- Class 20: Goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics
- Class 37: Repair
- Class 37: Installation services
- Class 40: Treatment of materials
- Class 45: Personal and social services rendered by others to meet the needs of individuals

This change does not affect WIPO's practice as it accepts all the terms listed in all class headings.

To avoid provisional refusal of protection of your international registration from OHIM, you should ensure that the list of goods and services in your international application, for the designation of the EU, does not contain any of the above-mentioned indications. For example, this can be done by requesting a limitation of the list of goods and services for the EU in the international application or in the subsequent designation, when designating the EU. The holder, after having received a provisional refusal from OHIM, may also file a request for limitation (MM6 form) directly to WIPO.

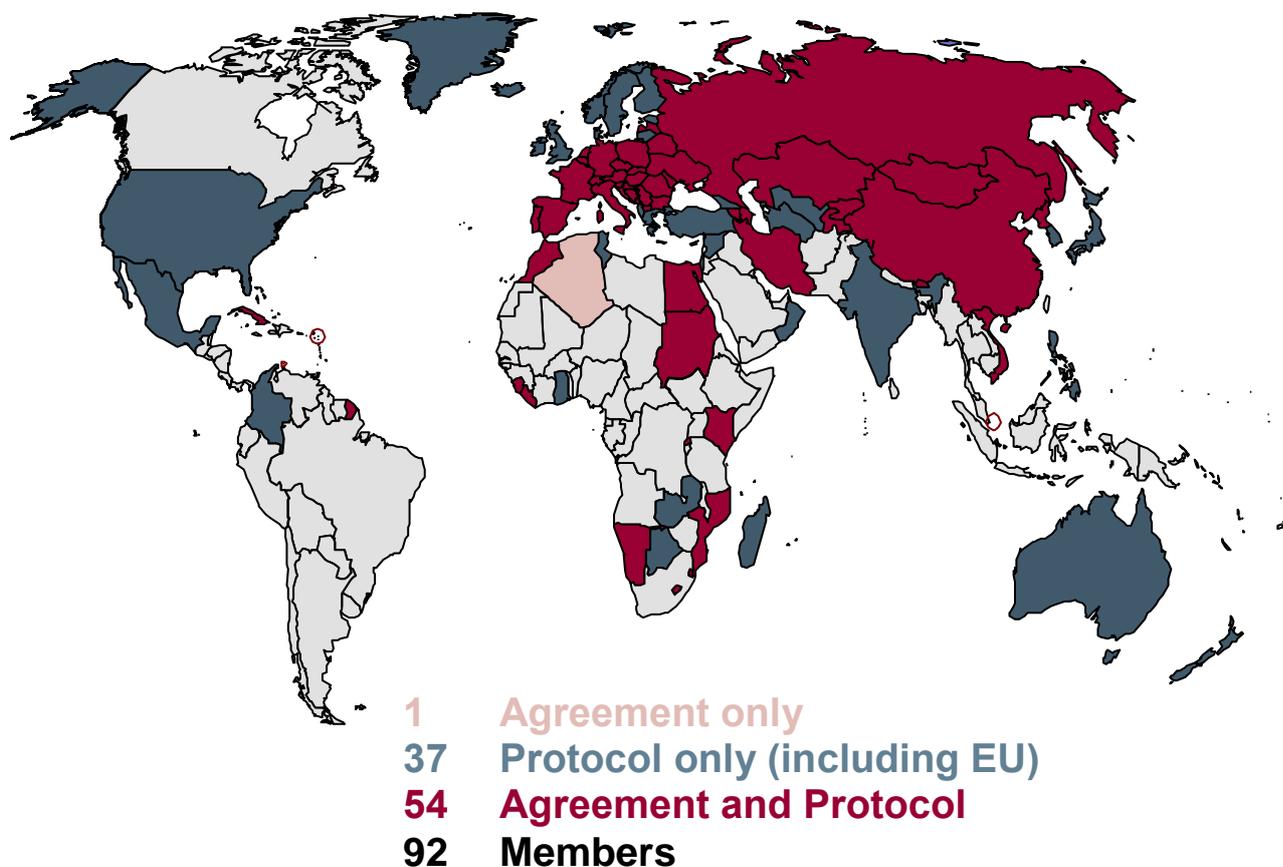
Further information about this change in practice, also where OHIM is suggesting alternatives to all or some of these 11 indications, is available on OHIM's web site at the following url:

<https://oami.europa.eu/ohimportal/en/change-in-examination-of-international-registrations-designated-in-the-eu>.

This information is also available on the Madrid System's web site:

[http://www.wipo.int/madrid/en/members/ipoffices\\_info.html](http://www.wipo.int/madrid/en/members/ipoffices_info.html).

#### MADRID UNION MAP



**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, specialized by your Office of Origin/residence.

**Team 1:**  
[madrid.team1@wipo.int](mailto:madrid.team1@wipo.int)  
Phone +41 22 338 750 1

**Team 2:**  
[madrid.team2@wipo.int](mailto:madrid.team2@wipo.int)  
Phone +41 22 338 750 2

**Team 3:**  
[madrid.team3@wipo.int](mailto:madrid.team3@wipo.int)  
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>

**DISCLAIMER:** This material can be copied, reprinted, distributed and adapted for non-commercial purposes. Corresponding copyright notice should be made under the following terms: Copyright © 2013 by WIPO. For additional special permission requests regarding excluded uses, please contact: [intreg.mail@wipo.int](mailto:intreg.mail@wipo.int)