

## NOTE FOR FILING FORM MM4: DESIGNATION SUBSEQUENT TO THE INTERNATIONAL REGISTRATION

**Form MM4 (Mandatory):** Designation subsequent to the international registration (Rule 24 of the Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks).

Please refer to our [Guide to the International Registration of Marks](#) for further detailed information concerning the application, registration and management of international marks.

### IMPORTANT INFORMATION

#### PURPOSE OF THE FORM

Use this form to add designations to an existing international registration.

You may wish to add a designation to extend the geographical scope of your existing international registration for example, because your business has expanded into a new territory, or you may wish to add a territory that was not a member of the Madrid Protocol at the time of filing your application. You may also wish to extend the coverage of an existing designation that did not cover all the goods and services in the international registration.

However, the simplest way to add Contracting Parties to your international registration is to use the [Online Subsequent Designation](#). Once you have entered your international registration number in the online form, you will see a list of the Contracting Parties available for subsequent designation. You may then easily select those that you wish to designate and for which goods and services (including a limitation of the list of goods and services). Further, the fees will be automatically calculated for you, which you can then pay by using a credit card or by debiting them from a Current Account at WIPO.

However, if you would like WIPO to process your request for subsequent designation after the recording of a specific change in the international registration concerned, or if you wish to add a translation or voluntary description of the mark in your request, you will need to use this form (please see items 6 and 7 below).

#### ADDITIONAL FORMS TO BE ATTACHED FOR CERTAIN CONTRACTING PARTIES

Please ensure that you have attached the additional form(s) required for the designations of [the United States of America](#) (MM18) and [the European Union](#) (MM17 – if applicable).

#### THE DATE OF A SUBSEQUENT DESIGNATION

If you submit your request directly to WIPO, the date of the subsequent designation will be the date on which WIPO received the request. If you submit the request through the Office of the Contracting Party of the holder, the date of the subsequent designation will be the date of receipt by the Office provided that WIPO receives the request within two months from that date of receipt.

Please note that certain irregularities in your request may affect the date of the subsequent designation (for example, an incorrect international registration number), and in those cases, the date of the subsequent designation will be the date on which the irregularities have been remedied.

You may instruct WIPO that the subsequent designation take effect after the recording of another event. For example, if you have instructed WIPO to record the renewal of the international registration before recording the subsequent designation, then the date of the subsequent designation will be the day after the recording of the renewal (see item 7 below for further information).

Any priority claim that is recorded for the international registration will automatically apply to the subsequent designation, provided that the request is in order and is presented within the applicable six months period.

Please, note that the international registration has only one renewal date, which applies to all the Contracting Parties designated in the international registration at the time of renewal (including any subsequent designations). Your subsequent designation does therefore not have an independent ten-year period, but expires on the same date as the international registration to which it relates. You need to bear this in mind before requesting a subsequent designation close to the renewal date.

It is not possible to pay the required fees with a credit card when using this form. However, payment by credit card is possible if you use the online subsequent designation form.

## HOW TO SUBMIT THIS FORM

You can submit this request directly to WIPO by using [Contact Madrid](#) (under “My request concerns”, select the topic “a form submission”). Alternatively, you may submit this form through the Office of the Contracting Party of the holder. However, before doing so, you will need to check with the Office on how to submit the form – on paper or by electronic means, and whether any handling fee is charged for the transmission to WIPO.

## FEE INFORMATION

Please use the [Fee Calculator](#) to help you estimate your fees.

The fees for requesting a subsequent designation depend on the number of Contracting Parties subsequently designated, their applicable fees and the number of classes of goods and services that you wish to protect your mark for.

Please see the [Schedule of Fees](#) for further information concerning the applicable fees.

## HOW TO PAY THE FEES

You can pay the fees:

- by debiting the required amount from a [Current Account at WIPO](#), or
- from funds that you have already transferred to WIPO, or
- by transferring the required fees into WIPO’s postal account (within Europe only) or bank account.

It is not possible to pay the required fees by credit card when using this form. However, payment by credit card is possible if you use the online subsequent designation form.

## E-MAIL ADDRESS AND WIPO'S ONLINE SERVICES

Where you have not already done so, for example, in the international application, you must provide an e-mail address. This is the fastest, most efficient and secure means for WIPO to transmit information effectively to its users. You will receive time-sensitive electronic communications from Offices of designated Contracting Parties without delay. If you have already provided an e-mail address, please ensure it is up to date.

Please use [Contact Madrid](#) to provide (or update) your e-mail address (under “My request concerns” select the topic “a change in contact details of the holder”).

Where a representative has been appointed WIPO will send all communications electronically to the e-mail address recorded for the representative **only**<sup>1</sup>. Where the holder has not appointed a representative, WIPO will send all communications electronically to the e-mail address provided for the holder unless an alternative e-mail address for correspondence has also been provided.

WIPO has developed a number of useful online tools and services. To have access to these tools and services you will need a WIPO Account. The WIPO Account will give you access to WIPO's online tools and services that have been designed to help you manage in one place your entire portfolio of internationally registered trademarks that are recorded with the same e-mail address.

### Monitoring your request

[Madrid Monitor](#) provides real-time monitoring of requests as they are being processed by WIPO. To monitor the status of your request, click the “Real-time Status” tab when viewing a specific record, or enter your international registration number in the “Real-time Search” tab in Madrid Monitor.

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<sup>1</sup> Where a representative has been appointed, WIPO will not normally send communications directly to the applicant or holder. There are a few exceptions to this rule:

- where the appointment of a representative is irregular, WIPO will inform both the applicant or holder and the purported representative;
- six months before the expiry of the term of protection, WIPO will send an unofficial notice to both the holder and the representative;
- where insufficient fees are paid for the purpose of renewal, WIPO will notify both the holder and the representative;
- where an international registration is not renewed or is not renewed in respect of a designated Contracting Party, WIPO will send a notification to the holder and the representative;
- where cancellation of the appointment is requested by the representative, WIPO will, until such time as the cancellation becomes effective, send communications to both the applicant or holder and the representative.

## HOW TO FILL IN FORM MM4

The form must be typed. WIPO cannot accept handwritten forms.

### NUMBER OF CONTINUATION SHEETS

If the space available in any part of the form is not sufficient, please use a “Continuation Sheet” at the last page of the form and indicate the number of continuation sheets attached here.

Where there is more than one holder please complete the dedicated “Continuation Sheet for Several Holders”.

### MM17 FORM(S)

If you have subsequently designated the European Union and wish to claim seniority, you must attach form [MM17](#) for each Member State for which seniority is claimed and indicate here the number of forms attached. Please refer to [Information Notice No. 20/2004](#) and to [EUIPO's Trade mark guidelines](#) for further information concerning seniority claims.

### MM18 FORM

If you are subsequently designating the United States of America, you must complete and attach [form MM18](#) (declaration of intention to use the mark).

### REFERENCE NUMBERS

The holder (and the Office, if the holder submits the form through an Office) may indicate their own internal file reference number. WIPO will include these reference numbers in any further communication concerning this form.

### ITEM 1: INTERNATIONAL REGISTRATION NUMBER

Indicate the full international registration number, for example 123456 or 123456A.

You can only indicate one international registration number per form MM4.

### ITEM 2: HOLDER OF THE INTERNATIONAL REGISTRATION

If there is more than one holder, indicate the total number of holders and then the name and address for the first holder only. Please provide the name(s) and address(es) of the additional holder(s) in the “Continuation Sheet for Several Holders” attached.

#### Item 2(a): Name

Indicate the holder's name exactly as recorded in the International Register.

#### Item 2(b): Address

Indicate the holder's address exactly as recorded in the International Register.

If you wish to add, update or delete your e-mail address, phone number or your address for correspondence, you must submit a request to WIPO using [Contact Madrid](#) (under “My request concerns”, select the topic “a change in contact details of the holder”) for this purpose.

### **ITEM 3: APPOINTMENT OF A (NEW) REPRESENTATIVE**

Complete this item only if you are appointing a representative for the first time, or if you wish to replace your previously appointed representative (the one currently recorded in the International Register).

Do not complete this section if you wish to:

- update the name or address of a representative already recorded in the International Register. Use form [MM10](#) for this purpose; or
- amend or cancel an e-mail address or phone number of a representative already recorded in the International Register. Submit a request to WIPO using [Contact Madrid](#) (under “My request concerns”, select the topic “something else”) for this purpose.

#### **Item 3(a): Name**

If the representative is a natural person, indicate their full name. Their family (or last) name and given (or first) name should be indicated in the order they are used. If the representative is a legal entity or a law firm, the full official designation must be indicated.

#### **Item 3(b): Address**

Indicate the address in a form that will ensure prompt postal delivery. The address must include the postal code (if applicable) and name of country/region.

#### **Item 3(c): E-mail address**

You **must** provide an e-mail address. All communications from WIPO concerning the request for subsequent designation and the international registration it concerns will be sent only electronically to the e-mail address indicated here. The holder and the representative must ensure that the e-mail address indicated here is accurate and kept up to date.

#### **Item 3(d): Telephone number**

Indicate the telephone number with the country and area codes (e.g., +41 22 338 86 86). A telephone number is not required, but it will allow WIPO to reach your representative if needed.

### *Signature of the holder appointing the new representative*

The holder **must** sign this item. The signature should be handwritten, printed, typed or stamped. If there is no signature, WIPO will process your request but the appointment of the representative will not be recorded. Neither the recorded representative nor the new representative may sign this item on behalf of the holder.

A representative may only record a single e-mail address to communicate with WIPO. All communications from WIPO will be sent to the representative by e-mail only.

## **ITEM 4: DESIGNATIONS**

You must indicate the designations (territories) for which protection for the mark is now sought, by checking the corresponding boxes.

It is not possible to subsequently designate the Contracting Party whose Office is the Office of origin (prohibition of “*self-designation*”).

A number of specific requirements apply for certain Contracting Parties. Check the various footnotes in the form for more details. If you are designating the European Union (EM) or the United States of America (US), please note that they require specific information that you must provide at the time of filing the subsequent designation. Most of the footnotes are self-explanatory. However, some further information is highlighted below:

### **FOOTNOTE A: DESIGNATION OF THE EUROPEAN UNION (EM)**

#### **A second language**

You must select one of the five official languages of the European Union Intellectual Property Office (EUIPO), namely, English, French, German, Italian and Spanish. The second language must be different from the language of the international application. Please note that protection in the EU may be challenged by a third party opposition filed with the EUIPO in the second language that you indicate here.

If you do not indicate a second language, the designation of the European Union (subject to everything else being in order) will be recorded. However, the EUIPO will issue a provisional refusal and you will need to contact the EUIPO directly to overcome it.

#### **A claim of seniority**

The seniority claim is a feature of the European Union Trade Mark System, therefore, its status and impact can only be determined by the EUIPO and the European Union Member State(s) of the earlier mark(s).

The holder can claim seniority in the request for subsequent designation by attaching a form [MM17](#) for each European Union Member State for which seniority is claimed. If the form MM17 is in order, WIPO will record the seniority claim in the International Register and forward all the information given to the EUIPO. The EUIPO will then examine the seniority claim and accept or refuse it in accordance with its applicable legislation.

Seniority must be claimed at the time of designating the European Union in the international application (or subsequent designation). If you do not claim seniority at the time of filing the international application or subsequent designation, you may submit the claim of seniority directly to the EUIPO. Since claiming seniority is subject to strict requirements and time limits set by the EUIPO, we strongly advise you to contact the EUIPO directly, if you have any questions.

#### **FOOTNOTE B: INTENTION TO USE THE MARK**

There are a number of Contracting Parties (as listed in footnote 2) that require the holder to declare that they have an intention to use the mark (or the intention to allow someone else to use the mark with their consent) in their territory, in connection with the goods and services applied for. The applicable Contracting Parties are listed in footnote 2.

#### **FOOTNOTE D: DESIGNATION OF THE UNITED STATES OF AMERICA (US)**

##### **A declaration of intention to use the mark**

If you designate the United States of America, you **must** complete and attach form [MM18](#) (declaration of intention to use the mark).

If the form MM18 is missing or defective, WIPO will issue an irregularity. The effective date of the subsequent designation will be the date on which the irregularity is remedied. If the irregularity is not remedied within the given time-limit, the designation of the United States of America will be disregarded. WIPO will record the request for subsequent designation where other Contracting Parties are indicated.

#### **FOOTNOTE E: DESIGNATIONS OF BRAZIL (BR), CUBA (CU) AND JAPAN (JP)**

##### **Individual fee payable in two parts**

If you designate Brazil, Cuba or Japan, you are required to pay the individual fee in two parts. The first part is payable at the time of filing the subsequent designation, and the second part will be payable once the Office concerned is satisfied that the mark qualifies for protection. Therefore, you will receive the notification of the second part of the individual fee together with the statement of grant of protection.

#### **FOOTNOTE I: DESIGNATION OF BRAZIL (BR)**

If you designate Brazil, you declare that the holder, or a company controlled by the holder, effectively and lawfully conducts business in connection with the goods and services covered in the subsequent designation of Brazil.

**ADDITIONAL INFORMATION CONCERNING THE DESIGNATIONS OF CAMBODIA (KH), MEXICO (MX), MOZAMBIQUE (MZ), THE PHILIPPINES (PH) AND THE UNITED STATES OF AMERICA (US)**

In addition to the declarations of *intention to use* the mark (referred to in footnotes b and d), please note that you will need to submit declarations of *actual use* of the mark directly to the Offices in Cambodia, Mexico, Mozambique, the Philippines, and the United States of America, in line with their national legislation. Since such *actual use* of the mark has to be declared before the respective Offices, taking into account different requirements, procedures and time limits in each country, we recommend that you consult the [Madrid Member Profiles database](#) or the Offices concerned for their specific requirements.

You may also refer to the following Information Notices:

- Cambodia (Information Notice [No. 11/2016](#))
- Mexico (Information Notice [No. 13/2018](#))
- Mozambique (Information Notice [No. 37/2016](#))
- Philippines (Information Notice [No. 18/2013](#))
- United States of America (Information Notices [No. 16/2010](#) and [No. 09/2016](#))

**ITEM 5: GOODS AND SERVICES CONCERNED BY THE SUBSEQUENT DESIGNATION**

Please check only one box.

**Item 5(a)**

Check this box, if all the goods and services of the international registration apply to all the Contracting Parties indicated in this form.

**Item 5(b)**

Check this box, if you wish to limit the goods and services for all Contracting Parties indicated in this form. Any goods and services not listed will not be applicable for the Contracting Parties concerned. If the space is not sufficient, you may use the continuation sheet.

**Item 5(c)**

Check this box, if you wish to limit the goods and services for only some of the Contracting Parties indicated in this form. You may use the continuation sheet to identify the Contracting Parties and to name the goods and services of the limitation.

*When requesting a limitation...*

... you must expressly indicate in item 5(b) all the goods and services for which you seek protection of your mark in the designated Contracting Parties concerned. If you only indicate goods and services in a particular class, WIPO will consider that you do not seek protection for the other classes set out in the international registration.



### *Version and Edition of the Nice Classification*

When requesting a limitation, you must not reclassify the limited list in accordance with the edition and version of the Nice Classification in force on the date of the subsequent designation. Instead, the limited list must follow the classification with which the mark was registered.

For example, the list of goods and services in an international registration effected in the year 2000 would have been classified according to the edition of the Nice Classification in force that year (i.e., the seventh edition). Any subsequent designation for a limited list of goods and services would have to follow that classification, regardless of the date on which that subsequent designation is made.

WIPO will not reclassify the list of goods and services of a subsequent designation to match the latest version and edition of the Nice Classification.

## **ITEM 6: MISCELLANEOUS INDICATIONS**

All indications below are **optional**, but some or all may be required by certain Contracting Parties when they are designated. However, where these indications have already been given in the international application or in a previous subsequent designation, they do **not** need to be repeated here, since they will be included automatically.

Be careful when completing this item. It is not possible to change or remove such indications from the International Register once they are recorded; in other words, such indications will remain on the International Register for the lifetime of the international registration.

### **Item 6(a) Indications concerning the holder**

It is not necessary to provide this information. However, by doing so, you may prevent provisional refusals from Offices of certain designated Contracting Parties that require such information. Please check the [Madrid Member Profiles Database](#) with regard to the Contracting Parties concerned. Only provide information in item 6(a)(i) **or** 6(a)(ii) as applicable. Do **not** complete both items.

#### **Item (6)(a)(i): If the holder is a natural person, nationality of the holder**

Where the holder is a natural person, you may indicate nationality or citizenship.

#### **Item (6)(a)(ii): If the holder is a legal entity you may provide both the following indications**

##### *Legal nature of the legal entity*

If the applicant is a legal entity, indicate the legal nature (e.g., “proprietary limited company (Pty Ltd)” or “a limited liability company (LLC)”).

*State (country) and, where applicable, territorial unit within that State (canton, province, state, etc.), under the law of which the said legal entity has been organized*

If the applicant is a legal entity, indicate the name of the country and where applicable, territory within that country, in which it was organized (e.g., “NSW, Australia”).

**Item 6(b): Indication, for each color, of the principal parts of the mark that are in that color**

If color(s) was (were) claimed in the international application as a distinctive feature of the mark, but you did not indicate which colors would apply to the principal parts of the mark, you may provide such information here (e.g., “a red bird sitting on a green leaf”).

Please note that you cannot add a color claim in a subsequent designation (this can only be added in the application). Where the mark is produced in color, certain Contracting Parties will automatically require that color be claimed (please see [Madrid Member Profiles Database](#)). Therefore, if your mark is produced in color and you have not claimed color in your international application you may wish to check with the Office of the subsequent designation concerned, to see whether a provisional refusal will be issued in this regard, and if so whether such refusal could be overcome.

**Item 6(c): Translation of the mark**

The Offices of some Contracting Parties may issue provisional refusals where such translation is not provided, please see the [Madrid Member Profiles Database](#).

You may indicate the translation of a word or words that can be translated into English and/or French and/or Spanish, irrespective of the language of the international application.

**Item 6(d): Where the words appearing in the mark have no meaning**

Check the box, if words appearing in the mark have no meaning (are invented) and a translation in item 9(b) above cannot be provided.

This could avoid provisional refusals by the Offices of designated Contracting Parties, requesting translation of the mark.

**Item 6(e): Voluntary description of the mark**

Certain Contracting Parties require a description of the mark. Therefore, including a description may prevent a provisional refusal. WIPO will not check or question the accuracy of the description of the mark. Please note that once a description of the mark is recorded in the International Register, it **cannot** be changed or removed.

If you wish to add a description of the mark, you can do so here **providing** that this is not already recorded in your international registration (i.e., you did not include this in your international application or in a previously recorded subsequent designation).

## **ITEM 7: DATE OF THE SUBSEQUENT DESIGNATION**

Complete this item only if you wish to “delay” the date of subsequent designation following any special instructions:

### **Item 7(a): After the renewal of the international registration**

Check this box if the subsequent designation is to take effect only after the recording of the renewal.

You may wish to consider the timing of a subsequent designation when the international registration is close to its renewal date. An example: The renewal date for an international registration is December 1, 2020. Should the holder subsequently designate one or more Contracting Parties in October 2020, the holder would need to pay renewal fees on December 1, 2020, for all the designated Contracting Parties (including those added in the subsequent designation two months earlier). If the date of the subsequent designation is not important and renewal of the international registration is imminent, the holder may wish to wait until after the international registration has been renewed before recording the subsequent designation. In such case, there will be financial savings, particularly where the subsequent designation concerns Contracting Parties charging individual fees.

### **Item 7(b): Following a change or cancellation of the international registration**

Check this box and specify the change or cancellation.

This may be useful, for example, where the holder has changed their name or address and they wish the new name to be reflected in the request for subsequent designation, or where the holder has requested a partial cancellation for some goods and services.

## **ITEM 8: SIGNATURE OF THE HOLDER AND/OR THEIR REPRESENTATIVE**

The holder or the holder’s representative must sign the form before presenting this directly to WIPO. If the form is not signed, the request for subsequent designation will not be recorded.

If the request is presented through, and signed by, an Office, the signature of the holder or the holder’s representative is not required and this item may be left blank. However, the Office may require or allow the holder (or the holder’s representative) to sign this item.

The person signing the form declares that they are entitled to do so under the applicable law.

### **Name (holder)**

Indicate the name of the holder (including joint holders) exactly as recorded in the International Register.

### **Name (representative)**

Where the representative signs the form, indicate the name of the representative exactly as recorded in the International Register or as indicated in the appointment of the (new) representative in item 3 of this form. If the recorded holder signs the form, there is no need for the representative to sign it as well.

Where the holder (or the holder's representative) is a legal entity, indicate the name as recorded in the International Register (not the name of the person signing the form on behalf of that legal entity).

### **Signature (holder/representative)**

The signature must be handwritten, printed, typed or stamped. Alternatively, a seal may be affixed to the form.

### **ITEM 9: DATE OF RECEIPT AND DECLARATION BY THE OFFICE OF THE CONTRACTING PARTY OF THE HOLDER PRESENTING THE SUBSEQUENT DESIGNATION**

This item should only be filled out by the Office presenting the form.

The date of receipt is very important because it will become the date of the subsequent designation, provided this request meets the minimum formal requirements, and it is received by WIPO within two months from the date it was received by the Office of the Contracting Party of the holder. If the subsequent designation is not received by WIPO within this two months period, it will bear the date the subsequent designation was actually received by WIPO.

### **ITEM 10: OFFICE PRESENTING THE SUBSEQUENT DESIGNATION**

This item should only be filled out by the Office presenting the form.

### **FEE CALCULATION SHEET**

You must complete the "Fee Calculation Sheet" annexed to the form. You will need to calculate and indicate the amount of fees (unless the fee is to be debited from a Current Account at WIPO) and provide details of your chosen method of payment.

Where no payment or insufficient payment has been received by WIPO, the holder and the holder's representative (where applicable) will be notified of an irregularity.

#### **(a) Instructions to Debit from a Current Account**

Where the fee is to be debited from a Current Account at WIPO, please check the box and indicate the following:

##### *Holder of the account*

Indicate the name of the holder of the Current Account,

##### *Account number*

Insert the five digit account number, and

### *Identity of the party giving the instructions*

Indicate the name of the party giving the payment instructions, this could be the holder, representative, or third party.

There is no need to calculate and indicate the amount of fees to be debited from a Current Account at WIPO.

If you choose this method of payment, WIPO will debit the required amount, subject to the availability of sufficient funds. This method of payment avoids the risk of making an insufficient payment.

To know how to open a Current Account at WIPO, please, use the following link: [Current Account at WIPO](#).

### **(b) Amount of Fees**

If you have not provided any instructions above to debit the required fee from a Current Account at WIPO, please use the [Fee Calculator](#) to help you estimate the amount of fees to pay.

The amount of fees payable will depend on the number of Contracting Parties subsequently designated, their applicable fees and the number of classes of goods and services.

### *Applicable fees*

When requesting a subsequent designation, you must pay a basic fee of 300 Swiss francs.

In addition to the basic fee, you will need to pay the fees for each of the designated Contracting Parties you wish to add to your international registration, which can be either complementary fees, or individual fees.

### *Complementary fees*

A complementary fee of 100 Swiss francs for each designated Contracting Party) is payable where the Contracting Parties designated have not declared for individual fees.

### *Individual fees*

Some Contracting Parties charge an individual fee. Where an individual fee has been declared, you will pay that fee instead of the complementary fee, except where the designated Contracting Party and the Contracting Party of the holder are both States bound by the Protocol and the Agreement, in which case, a complementary fee is payable. Please check the amount of the individual fee here: [Individual Fees](#).

Do not forget to indicate the Grand Total in the form (in Swiss francs).

### **(c) Method of Payment**

#### *Identity of the party effecting the payment*

It is important to identify the party who is making the payment (name of the holder, the representative, or a third party).

#### *Payment received and acknowledged by WIPO*

Check this box where funds were previously received and acknowledged by WIPO. You need to provide the identity of the party who made the payment and the WIPO receipt number (issued when WIPO acknowledged your transfer).

#### *Payment made to WIPO Bank Account or Postal Account (within Europe only)*

Where the fee is transferred to a WIPO bank or postal account, please check the respective box and indicate the following:

#### *Payment identification*

When transferring funds to WIPO (bank or postal transfers), please provide your bank or post office with the following details, and enter this information in the “Payment identification” field in the form:

- ✓ Name of the party making the payment and complete address;
- ✓ [Transaction code](#): enter the code (EX) for subsequent designations;
- ✓ The mark or verbal elements of mark (if available);
- ✓ Name of the holder (if different than the name of the party making the payment).

#### *dd/mm/yyyy*

Indicate the date of the payment, in day, month and year.

[End of Note for Filing Form MM4]