

HIGHLIGHTS

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THE INTERNATIONAL REGISTRIES OF MADRID AND LISBON HAVE MOVED TO A NEW ADMINISTRATIVE BUILDING

The International Registries of Madrid and Lisbon have moved to the new WIPO administrative building, which looks onto Geneva's Place des Nations and is the work of the award-winning Behnisch Architekten, Stuttgart, Germany.

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MADRID UNION ASSEMBLY

OUTCOME OF THE FORTY-FOURTH (19TH ORDINARY) SESSION OF THE SPECIAL UNION FOR THE INTERNATIONAL REGISTRATION OF MARKS

The Madrid Union Assembly was held in Geneva, from September 26 to October 5, 2011, as part of the meetings of the Assemblies of the Member States of WIPO.

The documents from the Madrid Union Assembly are available in the WIPO website at the following address: http://www.wipo.int/meetings/en/details.jsp?meeting_id=23140

Three proposals were made in the framework of the simplification of the Madrid system, as recommended by the Madrid Working Group in July 2011. Two of these proposals related to translations of certain documents to allow a more rational allocation of the existing resources within the International Bureau of WIPO, while preserving the trilingual regime, and the third proposal related to the efficient publication of the *WIPO Gazette of International Marks* (hereinafter referred to as “the Gazette”).

The Assembly adopted an amendment to Rule 32(3) of the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and to the Protocol Relating to that Agreement, as contained in Information Notice [No. 1/2012](#). The provision was amended to indicate that the Gazette will be published only on the web site of WIPO and it entered into force on January 1, 2012.

The Assembly took note of the two other proposals concerning translation practices of the International Bureau of WIPO, as contained in document [MM/A/44/1](#). Those proposals related to the current practice concerning the translation of statements of grant of protection following a provisional refusal made under Rule 18ter(2)(ii), and a new practice to be implemented by the International Bureau of WIPO regarding translations of the list of goods and services affected by a limitation in an international application, subsequent designation or request for limitation.

The proposal related to statements of grant of protection provided for the recording and publishing of the statement in the received language and an automatic translation into the language of the international application, if that is different. This practice preserves the linguistic unity of the recordings in the International Register and ensures that the holder will have all documents related to his right in his preferred language. Translations to other working languages will still be available to interested third parties upon request.

The proposal related to the translation of the list of goods and services affected by a limitation provided that where the language used in a request for the recording of a limitation is the same as the language of communication chosen by the Office concerned with the said limitation, recording and publication of the indications affected by the limitation would be effected in this language. In order to preserve the linguistic unity of all the recordings in the international registration concerned with a limitation, the International Bureau of WIPO will automatically translate the limitation into the language of the international application as well, ensuring that the holder would have all documents concerning his right in the preferred language.

See the [“MADRID TIPS”](#) for examples of the implementation of these policies.

CHANGES IN THE LEGAL FRAMEWORK

NOTIFICATION OF DOCUMENTS OF GRANT OF PROTECTION BY OFFICES

As of January 1, 2011, the requirement to issue a statement of grant of protection, in accordance with Rule 18ter(1) of the Common Regulations, became mandatory. This means that when all procedures before an Office have been completed before the expiry of the applicable time limit for refusals and there is no ground for that Office to refuse protection, the Office is now required to send a statement of grant of protection to the International Bureau of WIPO, who will forward it to the concerned holder.

For further information, please see Information Notice [No. 27/2008](#).

During the year 2011, WIPO has received more than 173,000 such statements. To render a better service to holders, the International Bureau of WIPO now encourages the Offices to send their communications on an individual basis, preferably using the corresponding [model form](#).

AMENDMENT OF RULE 32 OF THE COMMON REGULATIONS UNDER THE MADRID AGREEMENT AND PROTOCOL

As from January 1, 2011, with the discontinuation of the versions on CD-ROM and in PDF of the Gazette, the electronic version, free of charge, became the only version. Rule 32(3) was amended to indicate that the Gazette shall be published on the website of WIPO.

For further information, please see Information Notice [No. 1/2012](#).

CONTRACTING PARTIES

CHANGES IN THE AMOUNTS OF INDIVIDUAL FEES:

In accordance with Rule 35(2)(d) of the Common Regulations, the Director General of WIPO has established new amounts, in Swiss francs, of the individual fees that are payable when the respective Contracting Parties, listed below, are designated in an international application, in a designation subsequent to an international registration or in respect of the renewal of an international registration.

The Contracting Parties and the date on which the changes took or will take effect are: [Japan](#) (October 1, 2011), [The territorial entity of Curaçao](#) (October 1, 2011), [China](#) (November 6, 2011), [San Marino](#) (December 3, 2011), [Singapore](#) (December 20, 2011), [Bulgaria](#) (December 28, 2011), [Israel](#) (January 1, 2012), [Turkey](#) (January 1, 2012), [Tajikistan](#) (January 15, 2012), [Georgia](#) (January 19, 2012), [Turkmenistan](#) (January 20, 2012), [Sweden](#) (February 21, 2012) and [Israel](#) (March 5, 2012).

ACCESSIONS

On March 31, 2011, the Government of Tajikistan deposited its instrument of accession to the Madrid Protocol with the Director General of WIPO. The Madrid Protocol entered into force in Tajikistan on June 30, 2011.

The instrument of accession was accompanied by a declaration referring to Article 5(2)(b) of the Madrid Protocol, whereby the time limit of one year to notify a provisional refusal of protection is replaced by 18 months, and a declaration referring to Article 8(7)(a) of the Madrid Protocol, whereby Tajikistan wishes to receive an individual fee where it is designated in an international application, in a designation subsequent to an international registration or in respect of the renewal of an international registration. For more information, please see Information Notice [No. 10/2011](#) and [No. 43/2011](#).

THE NETHERLANDS: CONSTITUTIONAL CHANGES

The territorial entity within the Kingdom of the Netherlands, the Netherlands Antilles, ceased to exist as from October 10, 2010, and it was divided into three territorial entities (Curaçao, Saint Martin and the Caribbean Part of the Netherlands Antilles, comprised of the islands of Bonaire, Saint Eustatius and Saba), each having a distinctive trademark legislation and administration within the Kingdom of the Netherlands. For more information on the implications of this administrative change concerning the Madrid Protocol, please see Information Notice [No. 14/2010](#).

TRADEMARK PROTECTION IN THE CARIBBEAN PART OF THE NETHERLANDS

On August 19, 2011, the International Bureau of WIPO published the Information Notice [No. 27/2011](#) which refers to a statement of the Kingdom of the Netherlands concerning the status of protection of marks subject to international registration, for which a request for territorial extension to the Caribbean part of the Netherlands has been recorded and notified to the Office concerned.

This statement indicates that protection in the territorial entity of the Caribbean part of the Netherlands is granted automatically with the designation. The notification from the International Bureau of WIPO would be equated to a statement of grant of protection under Rule 18*ter*(1) of the Common Regulations.

WITHDRAWAL OF THE NOTIFICATION MADE BY SWEDEN UNDER RULE 7(1) OF THE COMMON REGULATIONS

With effect from July 1, 2011, it is no longer obligatory for the holder of an international registration for which the Swedish Patent and Registration Office was the Office of origin, and whose address is in Sweden, to present a subsequent designation under the Madrid Protocol to the International Bureau of WIPO through the said Office. Such a subsequent designation may be presented to the International Bureau of WIPO either directly by the holder or through the said Office (Information Notice [No. 37/2011](#)).

This was the last standing notification under Rule 7(1), as in force before October 4, 2011.

ONLINE SERVICES

ROMARIN (International Trademark Information Database)

Discontinuation of DVD version

As of the end of 2011, the last issue of the DVD version on the ROMARIN database has been discontinued. For more information, please see Information Notice [No. 20/2011](#).

A Web Customer Satisfaction Survey regarding ROMARIN was carried out from July 29 to September 13, 2011. The purpose of the survey was to invite all interested users, and especially users of the Madrid system, to give their opinion on the use of the ROMARIN database. During this period, nearly 500 users participated, with the great majority acting as applicants or holders of trademarks, representatives of national Offices or law firms, by responding to six questions and making comments and/or proposals on the user-friendliness of the web service. The results are now being analyzed and further information will be communicated later.

ROMARIN can be found at <http://www.wipo.int/romarin>

THE MADRID GOODS & SERVICES MANAGER (G&S MANAGER)

On December 22, 2010, WIPO launched the G&S Manager, which is an on-line tool designed to help trademark applicants in compiling the list of goods and services that must be submitted when filing an international application under the Madrid system.

The G&S Manager can be found at <http://www.wipo.int/gsmmanager>

This new application offers several functionalities, including the possibility to:

- Browse through thousands of terms accepted by the International Bureau of WIPO under the Madrid system procedures;
- Check the acceptance by WIPO for terms entered by trademark users;
- Search accepted and classified terms that best match an unclassified input description;
- Translate a list of accepted terms into any of the three Madrid system working languages (English, French and Spanish)

On January 1, 2012, the Goods & Services Manager (G&S Manager) was made available on-line in a new version reflecting the 10th edition of the International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Classification) that came into force on the same day. This new version also features additional language interfaces that bring the total of available languages to 10, including the three working languages of the Madrid system, namely English, French and Spanish. The additional languages are: Arabic, Dutch, German, Hebrew, Italian, Portuguese and Russian.

Other language versions of the G&S Manager are currently under preparation in cooperation with the Trademark Offices of Madrid Union members and some of these languages should be available on-line in the course of 2012, in particular the Chinese and Japanese interfaces.

NEW WEB-BASED COMMUNICATION SERVICES FOR THE MADRID SYSTEM

The Madrid Electronic Alert (MEA) is a free “Watch Service” designed to provide information to users interested in monitoring the status of certain International Trademark Registrations. Subscribers to the MEA will receive real-time email alerts when changes are inscribed in the International Trademark Register.

A WIPO User account holder may establish a list of International Registration numbers in which they are interested, and each time an inscription concerning an International Registration is recorded in the International Register, the account holder will receive an e-mail consisting in a hyperlink to the ROMARIN database where changes can be analyzed.

The service will be available in May 2012.

The Madrid Real-time Status (MRS) is a stand-alone tool that presents the real-time status of documents being prosecuted before the International Bureau of the World Intellectual Property Organization.

The search carried out through the MRS tool results in a list of all the events concerning an international registration that have been recorded, or are in the process of being recorded in the International Trademark Register.

The service will be available in May 2012.

The Madrid Portfolio Manager (MPM) is a Web service designed for holders and representatives of International Trademark Registrations wishing to access their international trademark portfolios with a view to submitting new requests for recordal in the WIPO International Trademark Register.

To access the Madrid Portfolio Manager a Holder or Representative must have a WIPO User account linked to an email address. A portfolio of international trademark registrations for that WIPO User Center account is established by compiling all the international registrations having the same email address.

The service will be available in May 2012.

STATISTICS

WIPO INTERNATIONAL TRADEMARK WEB STATISTICS

On the Madrid website there is now a new dynamic and interactive application for the Madrid system providing users with annual statistics, to dynamically prepare their own custom tables and/or graphs, and with the possibility of downloading the data into an excel format. The statistics are updated on a monthly basis. For more information, please see Information Notice [No. 20/2011](#).

USEFUL INFORMATION

ENTRY INTO FORCE OF THE TENTH EDITION OF THE NICE CLASSIFICATION

A new edition of the International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Classification) entered into force on January 1, 2012, and is available on the WIPO web site at the following address: <http://www.wipo.int/classifications/nice/en/>

For more information, please see Information Notice [No. 46/2011](#).

EXPLANATORY NOTES ON THE OFFICIAL APPLICATION FORM MM2

Explanatory Notes on the Official Application for International Registration Governed Exclusively by the Madrid Protocol (MM2.inf (E)) have been made available by the International Bureau of the WIPO on its web site.

The Explanatory Notes are meant to be a practical tool for users of the Madrid system, as they provide extensive information and further explanations concerning the various items in Form MM2.

The Explanatory Notes will be regularly updated by the International Bureau of WIPO and will be made available at the following address: <http://www.wipo.int/madrid/en/forms>.

MADRID TIPS

Practical examples on the implementation of the Madrid System

Q1: I am a holder of an international registration and I would like to know what would happen if WIPO receives a statement of grant of protection under Rule 18ter(1) from one of the Offices that I designated in my international registration and the said statement is in English while my registration is in Spanish. Would WIPO provide a translation into Spanish? Do I have to request the translation? Do I have to pay any fees?

A1: The International Bureau of WIPO will automatically translate the statement into Spanish since this is the language of the international application, ensuring that you, the holder, will have all documents in your preferred language and preserving the linguistic unity of all the recordings in an international registration. However, the translation into French will only be upon request. Please note that International Bureau of WIPO does not charge any fees for those translations.

Q2: I have an international registration and I would like to know what would happen if WIPO receives a statement of grant of protection, following a provisional refusal, made under Rule 18ter(2)(ii) from one of the Offices that was designated in the international registration and the said statement is in Spanish, while my registration is in French. Would WIPO provide a translation into English? Do I have to request the translation? Do I have to pay any fees?

A2: The International Bureau of WIPO will automatically translate the statement into French since this is the language of the international application, ensuring that you, the holder, will have all documents in your preferred language and preserving the linguistic unity of all the recordings in an international registration. However, if you wish to have a translation into English, which is not the language of your international registration, you have to request it. The International Bureau of WIPO will immediately translate it into English, and no fees will be charged.

Q3: I am the holder of an international registration in Spanish and I want to submit a limitation for one of the designated Contracting Parties of my registration. Can I submit the said limitation to the International Bureau of WIPO in Spanish, even if the official language of the designated country is English? Is WIPO going to translate this limitation into English and French automatically or do I have to request the translation? Do I have to pay any fees?

A3: If the limitation received from the holder is in Spanish, the International Bureau of WIPO will translate it automatically into English or French, depending on the language for which the designated Contracting Party has opted as the language of communication with the International Bureau of WIPO. A translation into the other language will be upon request. Please note that International Bureau of WIPO does not charge any fees for those translations.

Q4: I am interested in knowing the scope of protection of a certain international registration. I am specifically interested in having information on the limitations of the list of goods and services of the international registration recorded for the designated Contracting Party for which I intend to apply for a mark that might be in conflict with the international mark. I have already consulted the ROMARIN database and the list of goods and services is only displayed in Spanish. I would like to know whether there is a way to obtain information on the limitations in French.

A4: You, as a third party, can request that the International Bureau of WIPO make available a translation of the limitation of the list of goods and services of a certain international registration into the official languages of the Madrid system. The International Bureau of WIPO will immediately translate it and no fees will be charged.

WIPO NON-WORKING DAYS IN 2012

Pursuant to Rule 32(2)(v) of the Common Regulations under the Madrid Agreement and Protocol, users are hereby informed that, in addition to Saturdays and Sundays, the International Bureau of WIPO is not scheduled to be open to the public during 2012 on the following days:

- Monday, January 2, 2012 (New Year's Day)
- Friday, April 6, 2012 (Easter)
- Monday, April 9, 2012 (Easter)
- Thursday, May 17, 2012 (Ascension)
- Monday, May 28, 2012 (Whitsun)
- Thursday, September 6, 2012 (Jeûne Genevois)
- Thursday, October 25, 2012 (Eid Al-Adha)
- Tuesday, December 25, 2012 (Christmas)
- Wednesday, December 26, 2012 (Christmas)
- Monday, December 31, 2012 (New Year)

HOW TO CONTACT US

Madrid Customer Service Team

Opening hours: 9.00 a.m. to 5.00 p.m. Monday to Friday

Tel.: (41-22) 338 86 86

Fax.: (41-22) 740 1429

E-mail: intreg.mail@wipo.int



MadridCustomerServiceTeam.vcf

- [For Filing Application of International Registration of Mark](#)
- [For Extracts from the International Register](#)
- [Romarin Database](#)

Operations Teams

For any query concerning an International Registration Number (IRN), please contact the relevant Team from the list below according to your Office of origin/Residence:

Team 1:

madrid.team1@wipo.int
phone +41 22 338 750 1

AM [Armenia](#)
AG [Antigua and Barbuda](#)
BG [Bulgaria](#)
BQ [Bonaire, Saint Eustatius and Saba](#)
CH [Switzerland](#)
CU [Cuba](#)
CW [Curaçao](#)
CZ [Czech Republic](#)
DZ [Algeria](#)
EG [Egypt](#)
EM [European Union](#)
ES [Spain](#)
FR [France](#)
HU [Hungary](#)
KP [Democratic People's Republic of Korea](#)
LI [Liechtenstein](#)
MA [Morocco](#)
MC [Monaco](#)
MD [Republic of Moldova](#)
MG [Madagascar](#)
MK [The former Yugoslav Republic of Macedonia](#)
MN [Mongolia](#)
MZ [Mozambique](#)
PL [Poland](#)
PT [Portugal](#)
RO [Romania](#)
SX [Saint-Martin](#)
SY [Syrian Arab Republic](#)
ST [Sao Tome and Principe](#)

Team 2:

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BY [Belarus](#)
DE [Germany](#)
EE [Estonia](#)
GE [Georgia](#)
GH [Ghana](#)
HR [Croatia](#)
IR [Iran \(Islamic Republic of\)](#)
IT [Italy](#)
KG [Kyrgyzstan](#)
KZ [Kazakhstan](#)
LR [Liberia](#)
LS [Lesotho](#)
LT [Lithuania](#)
LV [Latvia](#)
ME [Montenegro](#)
NA [Namibia](#)
RS [Serbia](#)
RU [Russian Federation](#)
SD [Sudan](#)
SI [Slovenia](#)
SK [Slovakia](#)
SL [Sierra Leone](#)
SM [San Marino](#)
SZ [Swaziland](#)
TJ [Tajikistan](#)
TM [Turkmenistan](#)
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UZ [Uzbekistan](#)
ZM [Zambia](#)

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GR [Greece](#)
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IL [Israel](#)
IS [Iceland](#)
JP [Japan](#)
KE [Kenya](#)
KR [Republic of Korea](#)
NO [Norway](#)
OM [Oman](#)
SE [Sweden](#)
SG [Singapore](#)
TR [Turkey](#)
US [United States of America](#)
VN [Viet Nam](#)

LINKS OF INTEREST

WIPO LEX

WIPO Lex is a recently launched one-stop search facility for national laws and treaties on the intellectual property issues of WIPO, WTO and UN Members, featuring related information which elaborates, analyzes and interprets these laws and treaties. It provides streamlined access to key reference materials on optimal information regarding the global IP system.

For more information, please refer to: <http://www.wipo.int/wipolex/en/>

WIPO GOLD

WIPO Gold is a free public resource which provides a one-stop gateway to WIPO's global collections of searchable IP data. It aims to facilitate universal access to IP information.

For more information, please refer to: <http://www.wipo.int/wipogold/en/>

GLOBAL BRAND DATABASE

The Global Brand Database is a new on-line tool that will allow costumers to explore the brand landscape in a new and powerful way. The database contains over 660,000 records relating to internationally protected trademarks, appellations of origin and armorial bearings, flags and other state emblems as well as the names, abbreviations and emblems of intergovernmental organizations. The Global Brand Database allows free-of-charge, simultaneous brand-related searches across multiple collections.

For more information, please refer to: <http://www.wipo.int/branddb/en/>

ELECTRONIC COMMUNICATION

New electronic means of communication have been developed and new programs have recently been implemented to absorb the flow of ever larger volumes of documents. National Offices interested in opting for electronic communication may contact our Madrid System technical team at e-marks@wipo.int.

Moreover, following Information Notice [No. 36/2011](#), electronic communication between the International Bureau of WIPO and holders of international registrations is possible for a larger number of documents (see [Electronic Notification Service](#)). To be able to benefit from the electronic notification service, holders of international registrations and their representatives are invited to send a message to e-marks@wipo.int, indicating the email address which they would like the International Bureau of WIPO to use for this purpose, as well as the list of all international registrations concerned.

Madrid Highlights is brought to you by the Brands and Designs Sector. We encourage you to send us comments on how you find this Madrid Highlights and any suggestions you may have on topics to be covered in future issues by e-mail at madrid.highlights@wipo.int with the indication "Highlights" in the heading.