

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.

MADRID UNION

THE MADRID WORKING GROUP

The tenth 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 July 2 to 6, 2012

The International Bureau of WIPO will submit the following documents to the Working Group for discussion:

1. Proposed Amendments to the Common Regulations, as contained in document [MM/LD/WG/10/2](#). This documents contains three main proposals:

(a) Amendment of Rule 7(3)(b), related to the fact that the only country (Sweden) with a standing notification under former Rule 7(1) has withdrawn it with effect from July 1, 2011. Therefore, it is proposed to delete the words “*paragraph (1), as in force before October 4, 2001, or*” in Rule 7(3) (b), as well as the accompanying footnote 1.

(b) Proposal for deletion of Rule 24(2)(a)(i), which contemplates the presentation of a subsequent designation by the Office of origin in the case where Rule 7(1) applied. As a declaration under Rule 7(1) is no longer applicable for any Contracting Party, Rule 24(2)(a)(i) is also no longer applicable and therefore it is proposed to delete it.

(c) Proposal for deletion of Rule 40(5), now obsolete insofar as the period during which the sending of statements of grant of protection was not mandatory (until January 1, 2011) has expired.

The Working Group is invited to consider the proposals made in this document and to indicate any further course of action, including whether it would recommend to the Madrid Union Assembly some or all of the proposed amendments to Rules 7, 24 and 40 of the Common Regulations.

2. Information Relating to the Review of the Application of Article 9*sexies*(1)(b) of the Madrid Protocol, as contained in document [MM/LD/WG/10/3](#).

This document provides updated information concerning the issue of the application of Article 9*sexies*(1)(b) of the Madrid Protocol, in particular, with respect to the inoperativeness of two types of declarations, namely: (i) declarations concerning the time limit for notification of a provisional refusal made under Article 5(2)(b) and (c), and; (ii) declarations requiring payment of individual fees made under Article 8(7) in the mutual relations between States party to both the Madrid Agreement and the Madrid Protocol.

The Working Group is invited to consider the information presented in this document, as well as to indicate any further course of action concerning the review of the application of paragraph (1)(b) of Article 9*sexies* of the Madrid Protocol.

3. Proposal for the Introduction of the Recordal of Division or Merger Concerning an International Registration Before the Office of a Designated Contracting Party, as contained in document [MM/LD/WG/10/4](#).

The matter of division of international registrations has been further studied by the International Bureau, as a result of the deliberations at the last Working Group (ninth session). The International Bureau benefited from the contributions of interested Offices and Organizations. These contributions can be found on the [Madrid System Legal Forum](#).

The document contains a proposal on division of designations made in international registrations before the Offices of the designated Contracting Parties concerned. This proposal requires the introduction of two new Rules and amendments to two other provisions in the Common Regulations:

(a) New Rule 23*bis*, concerns itself with notification to and recording by the International Bureau of a division of a designation made in an international registration. The International Bureau will record the fact that a notification has been received from the Office of a designated Contracting Party, to the effect that division, at the level of the designated Contracting Party, has occurred with respect to an international registration. It is also proposed to allow for the notification of a merger concerning an international registration which has already been the subject of a division. New Rule 40(6), which establishes a transitional provision specifying a date as from which the concerned Offices will be in a position to effect notifications under proposed new Rule 23*bis*).

(b) Further amendments to Rule 32(1)(a)(xi) (information to be recorded by the International Bureau under Rule 23*bis* and the data to be published in the Gazette) and Rule 36(xi) (information notified under Rule 23*bis* is exempted of any international fees).

4. Review of the Proposal on Translations Requested by the Madrid Union Assembly, as contained in document [MM/LD/WG/10/5](#).

In 2011, the Madrid Union Assembly requested that the issue dealt with in this document be further reviewed at the upcoming session of the Madrid Working Group (the outcome of the forty-fourth (19th Ordinary) session of the Madrid Union Assembly can be found in the first issue of [Madrid Highlights](#)).

The Working Group is invited to consider the information provided in the document and to indicate any further course of action, including whether it recommends to the Madrid Union Assembly the proposed amendments to Rules 6 and 40 of the Common Regulations.

The purpose of the document is: to provide a conceptual framework on the scope of the trilingual regime under the Madrid system; to present background information on the overall translation tasks undertaken by the International Bureau under the Madrid system; to focus on the tasks related to the translation practices under review; and to reintroduce a financially sustainable proposal in line with the language regime of the Madrid system.

The Madrid Union Assembly took note of the practice of the International Bureau concerning the translation upon request of statements of grant of protection following a provisional refusal made under Rule 18*ter*(2)(ii), and further took note of the recommendation by the Working Group that the International Bureau implement a practice concerning the translation of the list of goods and services affected by a limitation in an international application, a subsequent designation or a request for limitation, with the inclusion of the option of translation upon request.

In order to bring this practice into line with the legal framework of the Madrid system, the International Bureau proposes to amend Rules 6 and 40 of the Common Regulations accordingly.

The document states that the proposed amendments apply equally to operations in any of the three working languages and produce the same effects in the three languages, while respecting the Madrid system trilingual regime. It further argues that translations upon request of certain types of operations merely restrict the principle of automatic translation in the three working languages in some cases, not the trilingual regime of the system as such.

MADRID SYSTEM LEGAL FORUM

We wish to remind readers of the existence of the [Madrid System Legal Forum](#), set up to facilitate the free exchange of ideas concerning the present and future of the Madrid system.

This online [Forum](#) consists of two sections. The first section, access to which is limited to participants in the Working Group, is called "*The Madrid System Tomorrow, Moving Forward*". The second section, called "*Implementing the Madrid System, Peer Office to Office Discussion*", was designed to facilitate exchange between the Offices of the Contracting Parties concerning practices and experiences with regard to the implementation of the Madrid system. Access to this section of the [Forum](#) is limited to staff of Offices of the Contracting Parties of the Madrid system.

Participants in the Working Group on the Legal Development of the Madrid System for the International Registration of Marks are reminded that, through this [Forum](#), they may post comments or upload concrete proposal for changes to the legal framework of the Madrid system.

Any suggestions concerning the layout or content of the Forum, or queries regarding technical issues encountered when accessing or using this [Forum](#), should be sent by email to: madridlegal@wipo.int.

The [Madrid System Legal Forum](#) may be accessed through a direct link provided in the "*For Offices Only*" section of the Madrid website at: http://www.wipo.int/madrid/en/contracting_parties/

CONTRACTING PARTIES

ACCESSION OF THE PHILIPPINES TO THE MADRID PROTOCOL

On April 25, 2012, the Government of the Philippines deposited its instrument of accession to the Madrid Protocol with Director General Francis Gurry of the World Intellectual Property Organization (WIPO), thereby becoming the 86th member of the Madrid Union. The Protocol will enter into force with respect to the Philippines on July 25, 2012.

The instrument of accession was accompanied by three declarations.

The first declaration refers to Article 5(2)(b) and (c) 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 provisional refusal resulting from an opposition may be notified after the expiry of the 18-month time limit.

The second declaration refers to Article 8(7)(a) of the Madrid Protocol, whereby the Philippines will receive an individual fee where it is designated in an international application, in a designation subsequent to an international registration.

The third declaration refers to Article 14(5) of the Madrid Protocol, whereby the protection resulting from any international registration effected under the Madrid Protocol before the date of entry into force of the Madrid Protocol, with respect to the Philippines, cannot be extended to it.

For more information, see Information Notice [No. 9/2012](#) and www.wipo.int/madrid/en/members.

With the adoption of the ASEAN IPR Strategic Plan 2011-2015, the eight remaining ASEAN member States not yet party to the Madrid Protocol committed themselves to joining by 2015. The Philippines, as the lead country in that initiative, is the first of those remaining to deposit its

instrument of accession. The others, now seven in number, are Brunei Darussalam, Cambodia, Indonesia, Lao People's Democratic Republic, Malaysia, Myanmar, Thailand. The Madrid Protocol entered into force in Singapore on October 31, 2000, and in Viet Nam on July 11, 2006.

ACCESSION OF COLOMBIA TO THE MADRID PROTOCOL

On May 29, 2012, Vice President Angelino Garzon of Colombia presented his country's instrument of accession to the Madrid Protocol to Director General Francis Gurry of WIPO thereby becoming the 87th member of the Madrid Union. The Madrid Protocol will enter into force with respect to Colombia on August 29, 2012.

The instrument of accession was accompanied by two declarations.

The first declaration refers to Article 5(2)(b) and (c) 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 provisional refusal resulting from an opposition may be notified after the expiry of the 18-month time limit.

The second declaration refers to Article 8(7)(a) of the Madrid Protocol, whereby Colombia 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 see Information Notice [No. 10/2012](#) and www.wipo.int/madrid/en/members.

The first Latin American country to join the Madrid system was Cuba, where the Madrid Agreement entered into force on December 6, 1989, and the Madrid Protocol on December 26, 1995. Colombia is the second Latin American Country to join the Madrid system, but the first to do so since the adoption of Spanish as a working language of the Madrid system in 2004.

Given the similarity of the issues raised throughout the region regarding the Madrid Protocol, the decision of Colombia to accede is a milestone in bringing the benefits of the Madrid system to the region as a whole. Less than a month later, on April 25, 2012, the Mexican Senate approved the adherence of Mexico to the Madrid Protocol.

It is believed that this momentum, together with an increase in international trade, the growing need for SMEs to protect branded goods and services in export markets and a greater awareness of the relevance of intellectual property rights (IPR) to economic development will pave the way for further geographic expansion in the region.

CHANGE IN THE AMOUNTS OF THE INDIVIDUAL FEE

Japan and the Syrian Arab Republic

The new established amounts of individual fees that are payable when Japan (April 15, 2012) or the Syrian Arab Republic (June 24, 2012) are designated in an international application, in a designation subsequent to an international registration or in respect of the renewal of an international registration under the Madrid system, can be found in Information Notices [No. 5/2012](#) and [No. 8/2012](#), respectively.

Philippines

The Government of the Philippines has made a declaration referred to in Article 8(7) of the Madrid Protocol whereby it wants to receive an individual fee when the Philippines is designated, either in an international application or in a designation subsequent to an international registration or in respect of the renewal of an international registration. This declaration will enter into force on July 25, 2012. More information can be found in Information Notices [No. 11/2012](#).

ONLINE SERVICES

NEW MADRID SYSTEM WEB-BASED COMMUNICATION SERVICES

Three new Web-based communication services for the Madrid system were launched at the INTA Annual Meeting in Washington, D.C., on May 5 to 9, 2012, and introduced at the 31st Annual Conference of the European Communities Trade Mark Association (ECTA), in Palermo, on June 20 to 22, 2012.

[Madrid Real-Time Status \(MRS\):](#)



A stand-alone tool that provides the status in real time of trademark documents being processed by WIPO.

[Madrid Electronic Alert \(MEA\)](#)



A “watch service” designed to inform anyone interested in monitoring the status of certain international trademark registrations. Subscribers receive daily e-mail alerts concerning changes recorded in the International Trademark Register.

[Madrid Portfolio Manager \(MPM\)](#)



A web service which allows holders of international registrations and their representatives to access their international trademark portfolios and which is especially helpful when submitting new requests for recordal in the WIPO International Trademark Registry.

Tutorials for these three Web-based communication services are also available at: <http://www.wipo.int/madrid/en/services/>

ROMARIN: CUSTOMER SATISFACTION SURVEY RESULTS

Based on the responses to the customer satisfaction survey on the ROMARIN database, work is currently being carried out in certain areas to improve the service. A summary of the results is available at: http://www.wipo.int/madrid/en/romarin/pdf/romarin_survey_results.pdf.

MADRID OUTREACH

Over the last three months, various divisions and services within WIPO's Brands and Designs Sector (the Information and Promotion Division, the Legal Division, the Operations Service and the Functional Support Division) have been involved in the promotion of the Madrid system.

Missions, study visits, workshops, seminars and video conferences were organized for a large and influential audience of IP practitioners in the public and private sectors across Africa, Asia, Eastern Europe and Latin America.

The two main goals of these outreach activities were to raise awareness of the Madrid Protocol and to promote better use of the Madrid system.

The Legal Division demonstrated the feasibility of providing distance learning using real-time video conferencing to discuss the advantages of and challenges involved in the implementation of the Madrid Protocol to national IP offices. Participants were able to analyze specific legal issues, share their experiences, and clear up outstanding questions within the context of a potentially unlimited time frame. The success of the initiative will undoubtedly lead to the use of video conferencing, webcasting and e-conferences as the primary vehicles for providing technical assistance to the Offices of the Contracting Parties of the Madrid system.

WIPO PARTICIPATES IN INTA 134TH ANNUAL MEETING IN WASHINGTON, D. C.

From May 5 to 9, 2012, Washington, D.C. played host to the 134th Annual Meeting of the International Trademark Association (INTA). The event attracted 9,377 registered participants from 146 countries, as well as 119 exhibitors.

WIPO activities included the Madrid System Users' Meeting (MSUM) and the WIPO booth in the Exhibition Hall. WIPO staff also took part in various events in the regular program, including two main sessions, three table topic discussions and several INTA committee meetings, as well as innumerable side meetings with existing and potential users of the Madrid and Hague systems.

The MSUM welcomed special guest Director General Ricardo R. Blancaflor of the Intellectual Property Office of the Philippines (IPOPPL), who discussed the importance of the recent accession of the Philippines to the Madrid Protocol, on April 25, 2012.

The regular MSUM program featured updates from WIPO on the Madrid and Hague systems, presentations by officials from the trademark offices of the European Union (EU) and Switzerland, as well as a lively questions and answers session.

The Annual Meeting also saw the launch of three new **web-based communication services**: Madrid Portfolio Manager (MPM), Madrid Real-Time Status (MRS) and Madrid Electronic Alert (MEA). See "New Madrid System Web-Based Communication Services" on page 6, for more information.

MADRID SEMINAR

Seminar on the Madrid System of International Registration of Marks

The forty-sixth session of the Seminar on the Madrid system took place in Geneva, on June 21 and 22, 2012, with 50 participants from the private sector and Industrial Property Offices of both members and non-members of the Madrid system.

From 1996 to present, approximately 2,500 participants have attended these Seminars to learn about the Madrid system for the first time or to build upon their existing knowledge.

The Madrid Seminar is a training platform where all aspects of the Madrid system are covered in depth. In addition to listening to presentations on a wide variety of topics over two days from experts at the International Bureau, officials from invited national or regional offices and private and in-house practitioners, attendees at the forty-sixth session were able to discuss the issues with these experts and share their experiences with other attendees.

There were also many opportunities for networking before and after the sessions, during the coffee breaks and at the two lunches included in the program.

The next Seminar is scheduled to take place at WIPO headquarters in November 2012 and the relevant details will soon be posted on the Madrid web site at:

http://www.wipo.int/meetings/en/topic.jsp?group_id=239

WHAT USERS SAY ABOUT THE MADRID SYSTEM



A new series of video interviews with users of the Madrid system has recently been produced by WIPO. Six different companies from various parts of the world participated to this program, sharing their opinions and experiences concerning the Madrid system. IP professionals and decision-makers talk about how they use the international registration system to protect their trademarks abroad. You can hear from ETI, Orka Group, Microsoft, Treasury Wine Estates, Sony and Shiseido at: <http://www.wipo.int/multimedia/en/madrid/madrid-videos/index.html>.

EXTERNAL PROMOTION PROGRAM

External consultants program for promoting the Madrid system in China, Europe, Japan, Russia and the United States of America

Promotion of the Madrid system is a priority issue for WIPO. In 2011, we launched a program of activities implemented by locally-recognized IP experts in a number of territories within the Madrid Union. The aim of this initiative was to ensure the effective promotion of the Madrid system and improve knowledge regarding its users. This new approach has already produced tangible results with regard to international registration filings, user satisfaction and the improvement of WIPO-administrated services.

We now have a network of external consultants actively informing on and promoting better use of the Madrid system for Contracting Parties in China, Europe, Japan, Russia and the United States of America. We are seeking to understand and relate better to our users' situations and needs by meeting with them and improving our service in terms of the operation and promotion of the international trademark system.

A more proactive approach has also been adopted concerning participation in local workshops and seminars on the Madrid system organized by third parties. Our consultants are helping the International Bureau to foster relationships with the Madrid stakeholders and to understand better how they use the Madrid system in practice. If you are interested in this external program and wish to arrange a meeting or propose an activity with one of our external consultants, please do not hesitate to contact us at madrid.highlights@wipo.int.

MADRID TIPS

THE "SECOND PART" OF THE INDIVIDUAL FEE

What the so-called "second part" of an individual fee actually is and why its non-payment might lead to the cancellation of a Designated Contracting State

The usual schedule of fees payable in connection with the filing of an international application or a subsequent designation consists of the **basic fee** (for reproduction of the mark), the **complementary fee** (fee for each Contracting Party designated), the **supplementary fee** (fee for each class of goods and services beyond three classes) and the **individual fee** (fee depending on the Contracting Parties designated).

What is it?

A Contracting Party requiring an *individual fee* may also require that the fee be comprised of two parts:

- A first part: to be paid at the time of filing the international application or the subsequent designation
- A second part: due at a later date (to be determined by the Contracting Party concerned).

So far, only **Cuba**, **Ghana** and **Japan** have adopted a two-part individual fee. The second part of the fee is only due once the designated Contracting Party (Cuba, Ghana or Japan) has granted the registration. The International Bureau is then notified of the amount (typically through a text added to the Grant of Protection or the Final Decision), with the applicant paying the second part directly to the International Bureau.

When is the deadline?

The deadline for payment of the second part of the individual fee varies from country to country:

- **Cuba** should be paid **within one month** from the date on which the notice was notified by the International Bureau.
- **Ghana** and **Japan** should be paid **within three months** from the date on which the notification was declared by the Contracting Party.

What happens if I miss the payment?

In accordance with [Rule 34 \(3\) \(d\)](#) of the Common Regulations, where the second part of the individual fee is not paid within the applicable period, the international registration will be **cancelled** with respect to the Contracting Party **with immediate effect**. Please also note that the International Bureau does not issue irregularity notices in cases of insufficient payment.

Therefore, it is vital that detailed payment information, including **author of payment**, **purpose of payment** (for example, “Second part of the individual fee for Cuba/Ghana/Japan”), **name of the holder**, **international registration number** and/or **WIPO reference number** (if applicable) be clearly indicated and identifiable in order for the International Bureau to proceed with money allocation.

How to be sure all is in order?

Always double-check Grants of Protection or Final Decisions from Cuba, Ghana and Japan to ensure when you have to pay the second part fee. If you are unsure, you can go online at <http://wipo.int/mrs>, and check if there is an item “**New tax - 2nd part fee**”: If there is no inscription or notification date mentioned, it means that the new tax has not been processed yet.

USEFUL INFORMATION

CERTIFIED EXTRACTS FROM THE INTERNATIONAL REGISTER

Pursuant to Article 5^{ter} (1) of the Madrid Agreement and of the Madrid Protocol, the International Bureau issues to any person applying therefore, a certified copy of the entries in the International Register concerning a given international registration (either in force or having expired). Two types of extracts are available: the detailed certified extract and the simple certified extract.

(a) The detailed certified extract consists of an analysis of the situation of an international registration. It contains a photocopy of the international registration as originally published in the *WIPO Gazette of International Marks*, with details of any subsequent changes, refusals, invalidations, corrections or renewals recorded in the International Register at the time the extract is prepared;

(b) The simple certified extract consists of certified copies of the entries that have been published in the WIPO Gazette with regard to a given international registration and of any notification of refusal of protection or invalidation received by the International Bureau at the time the extract is prepared.

This service is subject to the payment of the fee prescribed by the Common Regulations (<http://www.wipo.int/madrid/en/fees/sched.html>). Extracts are established in the language of the application for international registration.

Extracts from the International Register may be produced in legal proceedings. In that context, attention is drawn to the fact that, pursuant to Article 5ter(3) of the Madrid Agreement and of the Madrid Protocol, extracts from the International Register requested with a view to their production in one of the Contracting Parties shall be exempt from any legalization.

Requests for extracts must be made in writing, either by post (FAO: Madrid Customer Service Team), fax (+41 22 740 14 29) or e-mail (intreg.mail@wipo.int). Requests must clearly indicate the number of the international registration concerned and the trademark name; the type of extract needed; the full postal address of the applicant; the current account number, if the applicant wishes to pay by debit from his current account opened with WIPO. No advance payment is required. Payment is to be made upon receipt of the invoice by transfer to the WIPO bank or postal account if no current account has been opened with WIPO. Payment is to be made in Swiss francs (http://www.wipo.int/madrid/en/fees/about_fees.html).

CHANGES IN THE COMMUNICATION OF NOTIFICATIONS TO APPLICANTS AND HOLDERS OF INTERNATIONAL REGISTRATIONS

As from April 30, 2012, notifications relating to irregularities in international registrations shall be sent by registered mail, whereas notifications of certain refusal documents shall be sent by standard mail (see [Information Notice No. 7/2012](#))

Concerning Madrid system communications in general, the International Bureau once again encourages holders of international registrations and their representatives to opt for electronic communication by sending a message to the following address: e-marks@wipo.int.

WIPO NON-WORKING DAYS IN 2012

Pursuant to Rule 32(2)(v) of the Common Regulations, 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)
- 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)

CONTACT US

General queries: Madrid Customer Service +41 22 338 8686. Email: intreg.mail@wipo.int

Telephone opening hours: 9.00 a.m. to 5.00 p.m. Central European time (3.00 a.m. to 11.00 a.m. US Eastern time zone).

Specific queries: Contact our Teams, specialized by your Office of origin/residence.

Team 1:
madrid.team1@wipo.int
 Phone +41 22 338 750 1

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Team 2:
madrid.team2@wipo.int
 Phone +41 22 338 750 2

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Team 3:
madrid.team3@wipo.int
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