

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.

CONTRACTING PARTIES

ACCESSION OF MEXICO TO THE MADRID PROTOCOL

Mexico became the 89th member of the Madrid Union following the deposit with the Director General of WIPO of its instrument of accession to the Madrid Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, on November 19, 2012. The Madrid Protocol will enter into force, with respect to Mexico, on February 19, 2013.

The instrument of accession was accompanied by two declarations:

The first declaration refers 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.

The second declaration refers to Article 8(7)(a) of the Madrid Protocol, whereby Mexico wishes to receive an individual fee when it is designated in an international application, or in respect of the renewal of an international registration.

Furthermore, the said instrument of accession was also accompanied by the notification referred to in Rule 20*bis*(6)(b) of the Common Regulations, according to which the recording of trademark licenses in the International Register shall have no effect in Mexico.

For more information, see Information Notices [No. 24/2012](#) and [No. 25/2012](#).

DECLARATION THAT THE RECORDING OF LICENSES IN THE INTERNATIONAL REGISTER HAS NO EFFECT IN COLOMBIA

Colombia has notified the Director General of WIPO, under Rule 20*bis*(6)(b) of the Common Regulations, that the recording of licenses in the International Register shall have no effect in Colombia.

Consequently, a license relating to an international registration of a mark which has been granted with respect to Colombia shall, in order to have effect in that country, be recorded in the national Register of the Office of Colombia. The formalities required for such recording must be completed directly with the Office of Colombia and according to the conditions laid down by the legislation of that country.

For more information, see Information Notice [No. 22/2012](#).

DENUNCIATION OF THE MADRID AGREEMENT BY THE SYRIAN ARAB REPUBLIC

On June 29, 2012, the Government of the Syrian Arab Republic deposited with the Director General of WIPO its instrument of denunciation of the Madrid Agreement Concerning the International Registration of Marks, eight years after the deposit of its instrument of accession to the same treaty, on May 5, 2004.

Pursuant to Article 15(3) of the Madrid Agreement, this denunciation will take effect one year after the day on which the Director General received the notification of the denunciation, namely on June 29, 2013.

According to Article 15(5), international marks registered up to that date under the Madrid Agreement in respect of the Syrian Arab Republic, and not refused within the period of one year provided for in Article 5, will continue, throughout the period of international protection, to enjoy the same protection in the Syrian Arab Republic as if they had been deposited there directly.

Notwithstanding the above, the Syrian Arab Republic remains a member of the Madrid Union and the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks will continue to have effects in the Syrian Arab Republic (it is to be noted that the denunciation only concerned the Madrid Agreement).

For more information, see Information Notice [No. 14/2012](#) and http://www.wipo.int/treaties/en/notifications/madrid-gp/treaty_madrid_gp_196.html.

INDIVIDUAL FEE UNDER ARTICLE 8(7) OF THE MADRID PROTOCOL

Syrian Arab Republic

The new established amounts of individual fees that are payable when the Syrian Arab Republic is 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, took effect on November 15, 2012, and can be found in Information Notice [No. 20/2012](#).

New Zealand

The Government of New Zealand has made the declaration referred to in Article 8(7) of the Protocol whereby it wants to receive an individual fee when New Zealand 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 designating New Zealand. This declaration entered into force on December 10, 2012. More information can be found in Information Notice [No. 26/2012](#).

MODEL FORMS FOR THE USE OF OFFICES OF CONTRACTING PARTIES TO THE MADRID SYSTEM

It is reminded that the International Bureau of WIPO has on its web site Model Forms at the disposal of interested Offices of Contracting Parties to the Madrid system.

This Model Forms reflect the essential applicable requirements under the Common Regulations and are indented to standardize and facilitate the work of Offices of the Contracting Parties and of the International Bureau.

All Model Forms are available on the Madrid system web site at the following address: http://www.wipo.int/madrid/en/contracting_parties/model_forms.html

Revised Model Forms 5 and 9

The International Bureau of WIPO has recently made available for Offices of the Contracting Parties to the Madrid system revised versions of Model Forms 5 and 9.

The amendment to Model Form 5, in new item *IVbis*, offers the opportunity of informing of any specific information on disclaimers.

The amendments to Model Form 9 relate to items VI and VII, and are intended to obtain more comprehensive information from the Office of origin regarding the notifications of ceasing of effect made under Rule 22 of the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement (hereinafter referred to as “the Common Regulations”).

For more information, see Information Notice [No. 21/2012](#).

INDICATIONS THAT THE USE OF CLASS HEADINGS OF THE NICE CLASSIFICATION IN INTERNATIONAL APPLICATIONS IS INTENDED TO COVER ALL THE GOODS AND SERVICES INCLUDED IN THE ALPHABETICAL LISTS OF THE CLASSES CONCERNED

Rule 9 of the Common Regulations does not allow for international applications to include indications that the use of class headings of the International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Classification) is intended to cover all goods and services in the alphabetical lists of the classes concerned. Accordingly, and with respect to international applications including such indications, the International Bureau of WIPO will disregard any such indications.

Applicants wishing to cover all goods and services in the alphabetical list of a particular class may consider indicating in the international application all the terms contained in the alphabetical list of a particular class or classes (subject to the certification of the international application by the Office of origin).

For more information, see Information Notice [No. 23/2012](#).

MADRID UNION

MADRID SYSTEM LEGAL FORUM

How to become a Madrid system Legal Forum Watcher

The [Madrid System Legal Forum](#), offers its users the possibility of registering to watch the whole Forum or a specific page. The *Watch* function automatically sends notifications to registered e-mail addresses every time there is a change or an update in the Forum. This option is available to all Forum participants and can be found in the upper right-hand corner of the Forum page, under *Tools*.

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 e-mail to: madridlegal@wipo.int.

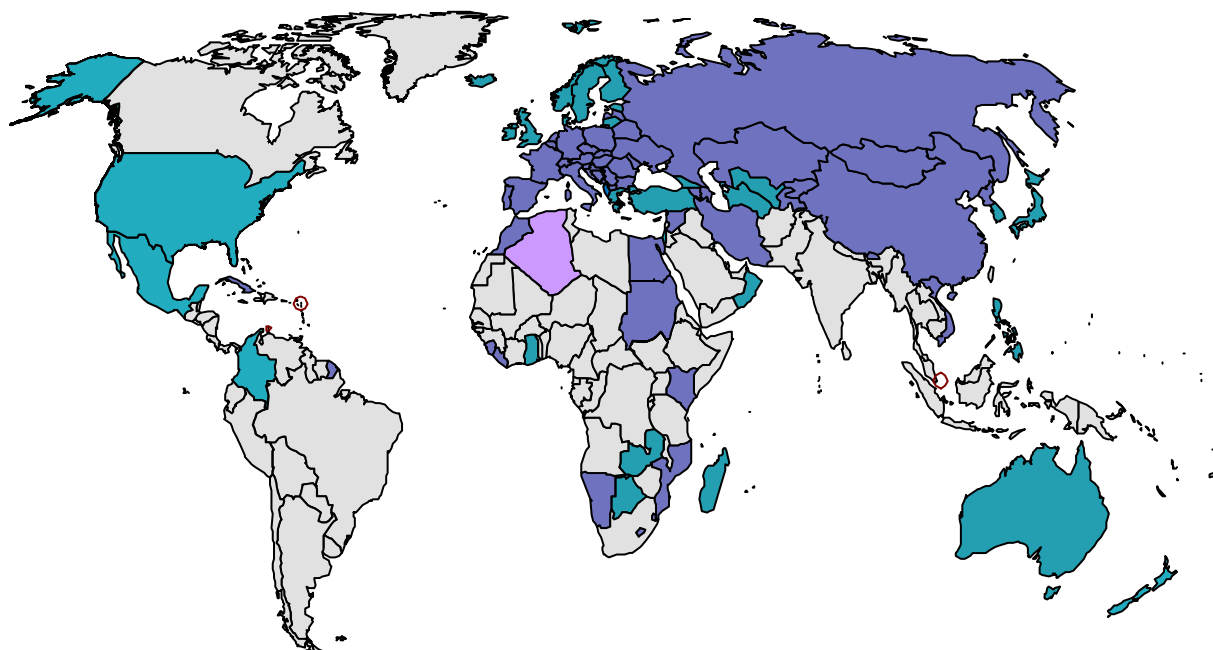
The [Madrid System Legal Forum](#) may be accessed through a direct link provided in the “*For Offices Only*” section of the Madrid website at: http://www.wipo.int/madrid/en/contracting_parties/

MADRID WORKING GROUP

The eleventh session of the Working Group on the Legal Development of the Madrid System for the International Registration of Marks will take place from October 30 to November 1, 2013, at the headquarters of WIPO in Geneva, Switzerland.

A Madrid Roundtable for Offices will be held in conjunction with the eleventh session of the Working Group.

MADRID UNION MAP



1 Agreement only
33 Protocol only (including EU)
55 Agreement and Protocol

89 Members

ONLINE SERVICES

Customer Satisfaction Survey

An Internet-based Customer Satisfaction Survey about online services was posted on the Madrid system web-pages, on December 3, 2012, at the following link: <http://www.wipo.int/madrid/en/services/>. The web-based survey concerns three Madrid system online services: the Madrid Real-time Status (MRS), the Madrid Electronic Alert (MEA) and the Madrid Portfolio Manager (MPM). The survey includes nine questions and aims at giving our customers the opportunity to express their opinions and at collecting ideas on desired improvements.

In case you want to participate, visit: <https://webaccess.wipo.int/opinio/s?s=5487>

Improvements to the Madrid Portfolio Manager (MPM) online tool

A new version of the Madrid Portfolio Manager (MPM) was released on December 7, 2012, featuring two additional functionalities so-called “**Applications**” and “**Notifications**”, aiming at:

- following the processing of **new applications** at the International Bureau, together with their related communications such as **irregularity letters**;
- viewing all **notifications** sent to MPM Users, as of December 1, 2012

MADRID OUTREACH

May 4 to 8, 2013: 135th INTA Annual Meeting, Dallas, Texas

- Madrid System Users Meeting (MSUM): The MSUM will take place on Sunday, May 5, 2013, from 11 a.m. to 2 p.m., at the Dallas Convention Center
- WIPO Booth in the Exhibition Hall: Sunday, May 5 to Wednesday, May 8, 2013: meet one-on-one with WIPO experts on the Madrid and Hague systems.

MADRID TIPS

Practical examples on the implementation of the Madrid system: Article 9*sexies* of the Madrid Protocol.

Article 9*sexies* of the Protocol is intended to regulate the mutual relations between States both party to both treaties, the Agreement and the Protocol. In the past, in such situations, it was the Agreement that prevailed. However, now subject to just two exceptions, it is the Protocol that prevails. The two exceptions concern the time limit to refuse and the payment of individual fees.

Q1: I am from Portugal and I am the holder of an international registration. I would like to renew my international registration for Madagascar, Oman and Viet Nam. I have used the fee calculator, available on your website, and it indicates that I have to pay individual fees for Oman but not for Viet Nam, even if Viet Nam has made a declaration stating that it requires individual fees. Is this correct?

A1: Yes, it is correct. Because Portugal and Viet Nam are both party to both treaties, the Agreement and the Protocol, it is the standard fee (complementary and supplementary fee) that prevails, as far as Viet Nam is concerned, even though Viet Nam has made a declaration that it requires individual fees. This is as a result of Article 9*sexies*(1)(b) of the Protocol. On the other hand, Oman is party only to the Protocol, and Article 9*sexies*(1)(b) of the Protocol is therefore not applicable. Consequently, individual fees apply with regard to the designation of Oman.

Q2: I'm from the United Kingdom and I'm the holder of an international registration. I have recently received a provisional refusal of protection from Switzerland after the 12 month time limit. It is my understanding that a refusal must be notified within 12 months. However, I have been told that Switzerland has made a declaration extending this period to 18 months. Which period applies in my case – 12 months or 18 months?

A2: The applicable period for Switzerland to notify a provisional refusal in your case is 18 months. If the United Kingdom were party to both treaties, as is Switzerland, the 12-month time limit would prevail. This is as a result of Article 9*sexies*(1)(b) of the Protocol. However, the United Kingdom is party only to the Protocol and for that reason, the exception under Article 9*sexies*(1)(b) of the Protocol does not apply and the Office of Switzerland is within its rights to notify a provisional refusal later than 12 months, although still, of course, not later than 18 months.

Q3: I am from Slovakia and I am the holder of an international registration. I want to subsequently designate Tajikistan. I have seen on the Madrid system website that Tajikistan has made a declaration under Article 8(7) of the Protocol, stating that Tajikistan requires the payment of individual fees. I would like to know which fee I will have to pay in this case, the standard fee or the individual fee.

A3: To subsequently designate Tajikistan in your international registration you only have to pay complementary and supplementary fees (standard fee), even though Tajikistan has made a declaration under Article 8(7) (individual fees) of the Protocol, stating that Tajikistan requires the payment of individual fees. This is as a result of Article 9*sexies*(1)(b) of the Protocol. This Article

renders inoperative a declaration made under Article 8(7) of the Protocol in the mutual relations between States both bound by both treaties, as is the situation between Slovakia and Tajikistan.

Q4: I'm from the Republic of Moldova and I registered an international trademark six months ago. I was wondering until when is it possible to receive a provisional refusal of protection. Particularly, I would like to know until when can San Marino and Spain notify a provisional refusal.

A4: The standard time-limit to notify a provisional refusal of protection under the Madrid system is 12 months. However, a Contracting Party may declare that the 12-month time limit is replaced by 18 months. San Marino is one of the Contracting Parties that has made a declaration to have an extended refusal period of 18 month. In this particular case, as the Republic of Moldova is a State party to both treaties, as is San Marino, the exception provided in Article 9*sexies*(1)(b) of the Protocol will be applicable, and the time limit for San Marino to notify a refusal will be 12 months.

When Spain is designated in an international registration, the time limit to notify a provisional refusal will also be 12 months, as Spain has not made a declaration to have an extended refusal period.

USEFUL INFORMATION

Entry into force of the 2013 version of the Tenth Edition of the Nice Classification

A new version of the tenth edition of the International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Classification) is ready to entry into force on January 1, 2013, and is available on the WIPO web site at the following address:
<http://www.wipo.int/classifications/en>

For more information, please see Information Notice [No. 27/2011](#).

Translation of the Madrid Highlights in Six Languages

As from the 3rd edition, the Madrid Highlights is available in six languages: Arabic, Chinese, English, French, Russian and Spanish.

For more information, visit: <http://www.wipo.int/madrid/en/highlights/>

WIPO NON-WORKING DAYS IN 2013

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 2013 on the following days:

Tuesday, January 1, 2013 (New Year)

Wednesday, January 2, 2013 (New Year)

Friday, March 29, 2013 (Easter)

Monday, April 1, 2013 (Easter)

Thursday, May 9, 2013 (Ascension)

Monday, May 20, 2013 (Whitsun)

Thursday, September 5, 2013 (Jeûne Genevois)

Monday, October 14, 2013 (Eid Al-Adha)

Wednesday, December 25, 2013 (Christmas)

Thursday, December 26, 2013 (Christmas)

For more information, see Information Notice [No. 15/2012 REV.](#)

CONTACT US

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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.

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