

HIGHLIGHTS

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September 2013 | No. 3/2013

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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 TUNISIA TO THE MADRID PROTOCOL

Tunisia became the 92nd 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 July 16, 2013. The Madrid Protocol will enter into force, with respect to Tunisia, on October 16, 2013.

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 Tunisia wishes to receive an individual fee where it is designated in an international application, in a designation subsequent to an international registration subject to Article 14(5) of the Protocol or in respect of the renewal of an international registration.

For more information, see Information Notice [No. 26/2013](#).

DENUNCIATION OF THE MADRID AGREEMENT: SYRIAN ARAB REPUBLIC

The Government of the Syrian Arab Republic notified the Director General of WIPO its denunciation of the Madrid Agreement. This denunciation took effect on June 29, 2013. However, the Syrian Arab Republic continues to be a party to the Madrid Protocol.

For more information regarding the effects of the denunciation of the Madrid Agreement by the Government of the Syrian Arab Republic, see Information Notice [No. 24/2013](#).

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

Tunisia

The Government of Tunisia has made the declaration referred to in Article 8(7) of the Protocol whereby it wishes to receive an individual fee when Tunisia is designated in an international application, in a designation subsequent to an international registration or in respect of the renewal of an international registration designating Tunisia. This declaration will enter into force on October 16, 2013. More information can be found in the Information Notice [No. 27/2013](#).

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

The new established amounts of individual fees 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, can be found in Information Notice [No. 28/2013](#). This change will take effect on October 12, 2013.

MADRID UNION

THE 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 in Geneva, from October 30 to November 1, 2013

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

1. Proposed Amendments to 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”), as contained in document [MM/LD/WG/11/2](#). This document contains mainly three proposals:

(a) New Rule 5*bis* [Continued Processing], concerns the possibility for an applicant or holder, where he has failed to comply with a time limit for an action in a procedure before the International Bureau, related to an international application or registration, to request continued processing before the International Bureau.

(b) Amendment of Rule 30(2) [Details Concerning Renewal], which is proposed to include the possibility of renewing international registrations only in respect of the goods or services effectively protected as a consequence of the recording of a statement of grant of protection sent under Rule 18*ter*(2)(ii) or a further statement sent in accordance with Rule 18*ter*(4).

(c) Amendment of Rule 31(4) [Notification in Case of Non-Renewal], which is proposed to make it obligatory to notify the holder of any non-renewal of an international registration.

The Working Group is invited to consider the proposals made in document [MM/LD/WG/11/2](#); and indicate any further course of action, including whether it would recommend to the Madrid Union Assembly some or all of the proposed amendments to the Common Regulations, as presented in the Annexes to document [MM/LD/WG/11/2](#) or in amended form.

2. 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/11/3](#).

The matter of the division of international registrations was discussed by the Working Group at its tenth session, based upon documents prepared by the Delegation of Switzerland ([MM/LD/WG/10/6](#)) and the International Bureau ([MM/LD/WG/10/4](#)).

Following the tenth session of the Working Group, the International Bureau issued an invitation to the Offices of Contracting Parties and to user-organizations to provide comments on the matter, to be submitted to the Madrid Forum.

At the time of preparation of the present document, eleven contributions had been submitted to the Forum. Of those, only eight were from the Offices of Contracting Parties and the remaining three came from user-organizations.

This document sets out:

(a) Comparative Analysis and Review of the International Bureau document and the Swiss document;

- (b) Summary Review of the Discussion of the International Bureau document and the Swiss document;
- (c) Contributions to the Madrid Forum;
- (d) Suggested Elaboration and Clarifications;
- (e) Conclusion – Possible Ways Forward.

The Working Group is invited to provide guidance to the International Bureau with respect to the further direction, if any, which should be taken with regard to the issue of the division of international registrations.

3. Information Concerning Ceasing of Effect, Central Attack and Transformation, as contained in document [MM/LD/WG/11/4](#).

This document provides updated information on ceasing of effect, specifically on central attack and transformation.

The document offers detailed information on the following:

- (a) International Applications, Notifications of Ceasing of Effect, Ceasing of Effect Which Appear to Have Resulted from Central Attack and Transformations;
- (b) Notifications of Ceasing of Effect Which Appear to Have Resulted from Central Attack;
- (c) Comparison Between the Current Exercises of Collection of Information on Ceasing of Effect, Central Attack and Transformation.

The document elaborates on the freezing of dependency.

The Working Group is invited to consider the information contained in this document; and provide guidance to the International Bureau on possible further actions concerning ceasing of effect and transformation.

The Madrid Working Group Roundtable

The Madrid Working Group Roundtable will take place the day before the start of the eleventh session of the Working Group on the Legal Development of the Madrid System for the International Registration of Marks (October 30 to November 1, 2013). It is meant to provide an opportunity for the Offices of Contracting Parties, intergovernmental and non-governmental organizations and the International Bureau of WIPO, to share experiences and informally discuss issues of legal, operational and information technology character related to the Madrid system.

ONLINE SERVICES

FUTURE LAUNCHING OF A NEW MADRID ONLINE SERVICE FOR FILING OF SUBSEQUENT DESIGNATIONS

In an effort to continue responding to the needs of Madrid Users, the International Bureau will launch a new Madrid online service for the filing of subsequent designations to an international trademark registration in the mid autumn.

The service will be available at <http://www.wipo.int/madrid/en/services/>.

All Madrid system users will have access to the online service by the simple entry of an international trademark registration number. Filing, including online payment, of any subsequent designation for one or more Contracting Parties to the Madrid system, whether total or partial, will be possible in a few clicks.

This new service will be incorporated into the Madrid Portfolio Manager (MPM) as the first of several online forms.

MADRID TIPS

HOW ARE THE RENEWAL FEES CALCULATED IN ACCORDANCE WITH RULE 30 OF THE COMMON REGULATIONS (PARTICULARLY WHERE A REFUSAL FOR SOME OF THE CLASSES HAS BEEN RECORDED IN THE INTERNATIONAL REGISTER IN RESPECT OF A DESIGNATED CONTRACTING PARTY)

The amount of the fees due at renewal is calculated, under Rule 30, as follows:

As a general principle, **all the classes** in an international registration with respect to **all designated Contracting Parties** are taken into account. The classes which have been the subject of a cancellation are not taken into account with respect to all designated Contracting Parties. Moreover, **classes** in respect of which an **invalidation** or a **limitation** has been recorded are **not** taken into account with respect to the **Contracting Party concerned**.

A holder may wish to renew its international registration in respect of designated Contracting Parties which have been the subject of a **total or partial refusal** (i.e., for all or some of the classes in respect of which they were designated). However, please note that **renewal is always due in respect of all the classes** requested in the designation concerned.

In consequence, where a total or partial refusal has been recorded in respect of a designated Contracting Party and the holder of the international registration wishes to renew it, renewal will, nevertheless, be due in respect of all the classes where protection was requested. If the holder does not wish to renew its international registration for classes that have been refused in a designated Contracting Party, he may request, before renewal is due, the recordal of a limitation of the list of goods and services in respect of the said Contracting Party (Official Form [MM6](#) "Request for the Recordal of a Limitation of the List of Goods and Services"). Only then, the International Bureau will, when calculating the renewal fee, not take into account some of the classes for which a Contracting Party was designated.

A holder may also decide not to renew its international registration in respect of some of the designated Contracting Parties, even if no refusals were recorded.

Finally, please note that an international registration cannot be renewed in respect of designated Contracting Parties which have been the subject of a **renunciation** or **total invalidation** (i.e., for all the classes in respect of which they were designated).

- As a general principle, Article 7(2) of the Madrid Protocol does not allow any change to the international registration during renewal, and Rule 30(1)(a) of the Common Regulations establishes that an international registration shall be renewed in respect of *all* the goods and services. The exception to the aforesaid general principle is introduced by Rule 30(2), which affords the holder the option not to renew the international registration for one or more of the designated Contracting Parties.

- Additionally, the reason for allowing a renewal with respect to a Contracting Party that has pronounced a refusal is that, at the time of renewal, there may still be pending a judicial or administrative procedure in respect of such refusal. The rights of the holder need to be preserved where the refusal was the subject of an appeal and no final decision had been taken by the date on which the renewal was due.

Case 1

I am from Morocco and I have just received an unofficial notice to remind me the exact date of expiry of my international registration, which is due for renewal on April 2, 2014.

When I registered my mark through the Madrid system, I requested protection for classes 5, 7 and 36 in China and, in 2008, I subsequently designated Oman for the same classes.

However, China only granted protection for classes 5 and 7 and Oman refused protection for class 5.

Q1. What will happen at the renewal with the classes that have been refused by China and Oman?

R1. Even if a refusal for some of the classes is recorded in the International Register, renewal is due in respect of all the classes requested in the designation concerned. In consequence and, if you decide to renew your registration for all the designated Contracting Parties, the fees (basic fee plus complementary and/or individual fees, as the case may be) due at renewal will comprise all the designated Contracting Parties for all the classes originally designated.

More precisely, in respect of the renewal of your international registration, you will need to pay individual fees, even for the classes that have been refused in a designated Contracting Party, for instance class 36 in respect of China and classes 7 and 36 in respect of Oman.

Q2. What can I do to only renew my international registration for the classes for which no refusals have been recorded?

R2. Where a refusal is recorded with respect to a designated Contracting Party for some of the classes, and you do not want to renew your international registration for these classes, a limitation of the list of goods and services with respect to the said Contracting Party (Official Form [MM6](#) "Request for the Recordal of a Limitation of the List of Goods and Services") should be requested before renewal is due. Only then, the International Bureau will, when calculating the renewal fee, not take into account the classes limited.

Q3. What are the effects of a limitation?

The recording of a limitation does not entail the removal of the classes concerned from the international registration as recorded in the International Register. The sole effect is that the international registration is no longer protected for the classes concerned in the Contracting Parties covered by the limitation. The classes which have been the subject of a limitation may be the subject of a subsequent designation in the future.

Case 2

I am from Georgia and I renewed my international registration on July 15, 2013. I have just received a notification stating that the fees I paid for renewal were insufficient and that I need to pay the amount still due before the end of the grace period or my international registration will not be renewed.

From the attached payment statement I can see that the International Bureau is charging me for 11 classes with respect to the designation of Denmark. However, on March 15, 2009, I received a partial refusal and now I only have protection for five classes in Denmark.

Q1. Why is the International Bureau charging classes for which I do not have protection?

R1. Even if a refusal for *some* of the classes is recorded in the International Register, renewal is due in respect of *all* the classes requested in the designation concerned. There are no provisions under the Madrid system that would allow the International Bureau not to take into account the classes which have been the subject of a refusal when calculating the fees due at renewal.

Q2. What can I do now not to renew the protection of my international registration for the classes that have been refused?

R2. According to Article 7(2) of the Madrid Protocol renewal may not bring any change in the international registration in its latest form. Therefore, unfortunately at this stage, if you want to renew your international registration, you have to pay the amount still due as indicated in the notification you received.

In order to have avoided the payment of such fees you should have requested a limitation before renewal was due (Official Form [MM6](#) "Request for the Recordal of a Limitation of the List of Goods and Services"). Only then, the International Bureau could, when calculating the renewal fee, not have taken into account *some* of the classes for which Denmark was designated.

Q3. What are the consequence if I decide not to pay the amount of fees still due?

R3. If you decide not to pay the amount of fees still due before the end of the grace period, your international registration will not be renewed. Therefore, the international registration will lapse for all the designated Contracting Parties with effect from the date of expiry of the previous period of protection.

USEFUL INFORMATION

NEW SPECIAL SERVICES OF THE CLIENT RECORDS UNIT

As from August 1, 2013, users have been able to request the following new special services:

(a) Issuance of a certified copy of a certificate of an international registration recorded on or after January 1, 2006, and of the renewal certificate. The certified copies will be issued against the payment of a fee of 50 Swiss francs per certified copy.

(b) Expedited establishment of a certified extract from the International Register. Along with a request for the establishment of a simple or detailed certified extract from the International Register, users may also request expedited establishment. In such cases, the International Bureau will produce the extracts within five working days, following the receipt of the request, upon the payment of a surcharge of 100 Swiss francs per extract.

(c) Legalization of a certified extract from the International Register. Along with a request for the establishment of a simple or detailed certified extract from the International Register, users may also request legalization of extracts with a view to their production in non-Contracting Parties of the Madrid system. Users will have to pay the corresponding new special service fee (75 Swiss francs per extract), in addition to the fees charged by the competent authorities effecting the legalization as well as the fee corresponding to the establishment of the extract.

Users of the Madrid system can address their requests for these new special services to the Client Records Unit of the Madrid Operations Service by sending a detailed communication to the following address: madrid.records@wipo.int.

For further information, users may call the Client Records Unit at + 41 22 338 84 84.

Additional information is available also in the Information Notice [No. 25/2013](#).

WIPO AT THE 27TH ANNUAL CONFERENCE OF MARQUES (ASSOCIATION OF EUROPEAN TRADEMARK OWNERS), MONACO, SEPTEMBER 17 TO 20, 2013.

This year, a WIPO Delegation attended once again the MARQUES Annual Conference.

The session on the Madrid System for International Registration of Marks reported on the status and updates, as well as on recent and expected accessions to the Madrid Protocol. Information has been provided on the use of the Madrid system, current developments and future challenges. New services and tools offered by the International Bureau have been explained and topics for discussion at the upcoming Working Group on the Legal Development of the Madrid System presented.

MARQUES delegates had the opportunity to visit the WIPO Information Desk, set up in the exhibition area of the Fairmont Monte Carlo Hotel. Information and documentation on WIPO services and activities concerning trademark and design owners were made available. Visitors had the opportunity to get acquainted with a demonstration of the new online tools and services provided by WIPO.

Additionally, they were given the possibility to register for one-on-one meeting with a WIPO expert, for a 15 minute discussion on Madrid and Hague system highlights.

INFORMATION CONCERNING NATIONAL OR REGIONAL PROCEDURES BEFORE IP OFFICES UNDER THE MADRID SYSTEM

Intellectual Property Offices of Contracting Parties of the Madrid System provide specific information on national procedure and legal data relating to applications and registrations under the Madrid system at: http://www.wipo.int/madrid/en/members/ipoffices_info.html.

The International Bureau updates on a regular basis this information. Recently this information has been provided at the above link besides in English, in French also.

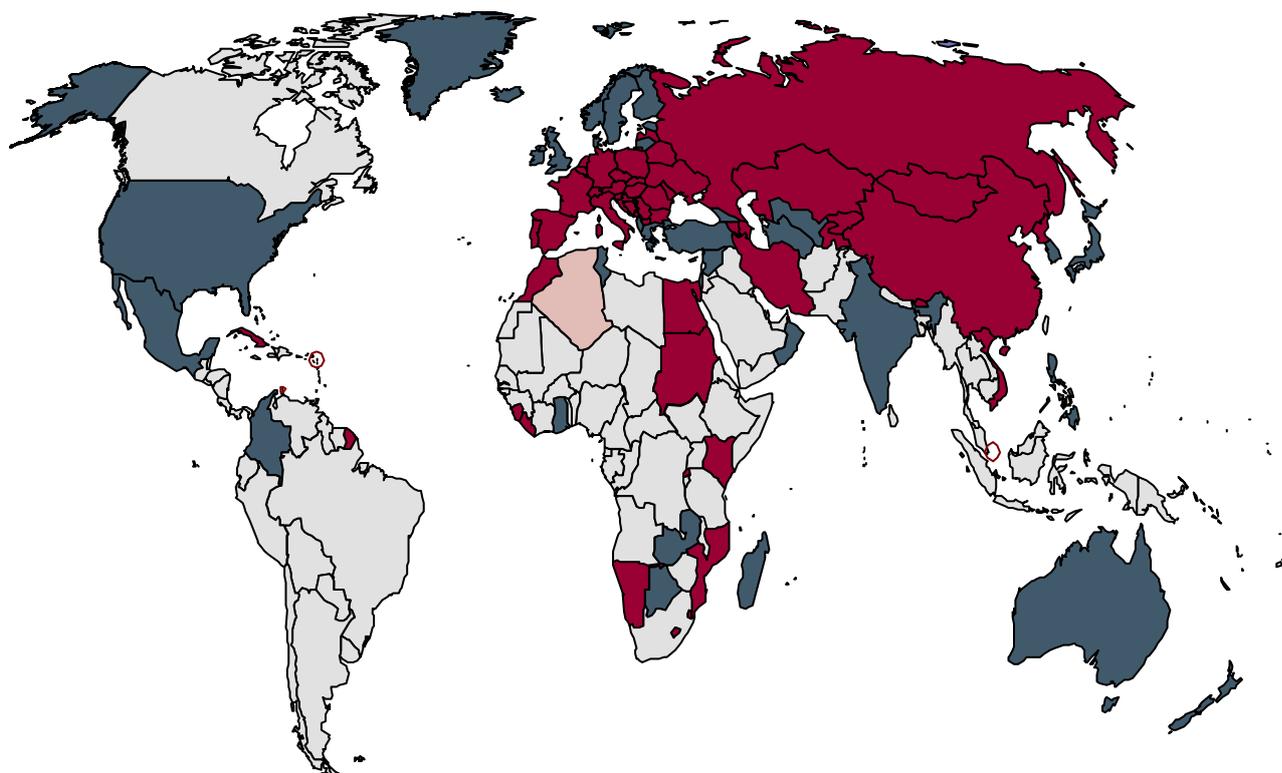
In the future, it will also be made available in Spanish, as the third official language of the Madrid system.

SEMINAR ON THE MADRID SYSTEM FOR THE INTERNATIONAL REGISTRATION OF MARKS

The 49th edition of the Seminar on the Madrid System for the International Registration of Marks organized by the International Bureau of WIPO will take place on November 28 and 29, 2013, at the headquarters of WIPO, in Geneva. These Seminars already traditional since 1996 aim at responding to the wishes of users for guidance on the potential of the Madrid system, the need to address their daily legal and operational concerns and to provide with the necessary updates on the recent developments and trends.

To remain updated in this respect, users may wish to subscribe to the Madrid E-Newsletter (<http://www.wipo.int/madrid/en/subscribe.html>) to receive the automated e-mail notices on the Madrid system matters, including the forthcoming meetings and seminars.

MADRID UNION MAP



1	Agreement only
37	Protocol only (including EU)
54	Agreement and Protocol
92	Members

HOW TO CONTACT US:

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

Telephone opening hours: 9.00 a.m. to 6.00 p.m. Central European time (3.00 a.m. to 11.00 a.m. US Eastern time zone).

Extracts Queries: Clients Records Unit +41 22 338 8484. E-mail: madrid.records@wipo.int

Specific Queries: Contact our Teams, specialized by your Office of Origin/residence.

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

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

Team 3:
madrid.team3@wipo.int
Phone +41 22 338 750 3

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