

HIGHLIGHTS

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CONTENTS

MADRID UNION	2
Amendments to the Common Regulations The Madrid Working Group	
CONTRACTING PARTIES	6
Accession of OAPI and Zimbabwe to the Madrid Protocol Withdrawal of Notification Made under Rule 20 <i>bis</i> (6)(b) of the Common Regulations by Lithuania Declaration Made under Article 8(7)(a) of the Madrid Protocol by the Government of the Kingdom of the Netherlands Changes in Individual Fee Amounts – Iceland and Colombia	
MADRID TIPS	8
E-Renewal, New Form MM11, Partial Invalidation, Madrid System Statistics	
USEFUL INFORMATION	10
Entry into Force of the 2015 Version of the Tenth Edition of the Nice Classification, Madrid Customer Service during the Holiday Period, Transaction Codes, Madrid Union Map	
CONTACT US	12

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

AMENDMENTS TO THE COMMON REGULATIONS

The Madrid Union Assembly approved amendments to the [Common Regulations](#) at its forty-eighth (28th extraordinary) session, held in Geneva from September 22 to 30, 2014. The amendments will enter into force on January 1, 2015.

Continued Processing: Rules 5bis (new), 20bis(3) and 27(1)

New Rule 5bis introduces a relief measure, which will allow the International Bureau (IB) to continue processing an application or request when the applicant or holder has failed to meet a time limit for an action in a procedure before the IB.

Continued processing can be requested in the following situations:

- Rule 11(2) and (3) – irregularities that can be remedied by the applicant. (*Remedying irregularities under Rules 12 and 13 falls outside this provision, as these remedies can only be addressed by the Office of origin*);
- Rule 20bis(2) – irregularities in relation to a request for the recording of a license;
- Rule 24(5)(b) – irregularities in relation to a request for subsequent designation;
- Rule 26(2) – irregularities in requests for recording of a change or a cancellation;
- Rule 34(3)(c)(iii) – the time limit for the payment of the second part of the individual fee; and
- Rule 39(1) – the time limit in relation to a request that an international registration continue its effect in a successor State.

In the case of Rules 34(3) and 39(1), requests need to be received by the IB no later than two months after the expiry of the original time limit. In all other cases, requests need to be received no later than two months after the expiry of the irregularity time limit.

Please note that continued processing can only be requested if the relevant time limit (original or irregularity time limit) for the action expires on or after January 1, 2015.

Frequently Asked Questions on Continued Processing

Question: What is required by the IB to request continued processing under Rule 5bis?

Answer: A request for continued processing presented on form MM20 (new), signed by the applicant or holder, must be received by the IB within the two-month time limit (see above). The relevant irregularity must also be remedied and a fee of CHF200 paid within the two-month time limit.

Question: When continued processing has been granted, which dates apply to the international application and any recording of subsequent designation?

Answer: The grant of continued processing means that the international application or the request for subsequent designation is still alive and not abandoned. The international registration (resulting from the application) and the subsequent designation will be recorded with the same date as if they had been properly filed or remedied by the original respective time limits.

Question: Which date will apply to recording of licenses, changes and cancellations where continued processing has been granted?

Answer: The date of recording in these situations will be the last day the holder could have remedied the irregularity (i.e., the last day of the three-month time limit provided for remedying the irregularity).

Partial Renewal: Rule 30

Amendments to Rule 30 change the manner in which international registrations are renewed. Until the end of 2014, when a designated Contracting Party only grants protection for a limited number of classes of goods and services, renewal fees have to be paid for all goods and services on the main list, unless the holder has requested the recording of a limitation in the international registration prior to the due date of renewal. From January 1, 2015, decisions from a designated Contracting Party granting partial protection (Rule 18ter(2)) will be reflected in the International Register as the default option for renewal. The renewal of the international registration will be for the protected classes, without the need to request a limitation prior to the renewal due date. The holder can still opt to renew the international registration for the goods and services, which are not protected, should he or she wish to do so. This option may be pursued when there are ongoing appeal proceedings concerning the possible scope of protection.

The amendments to Rule 30 apply only to international registrations for which renewal is requested on or after January 1, 2015, and where the renewal is due on or after January 1, 2015.

Frequently Asked Questions: Rule 30

The question “how are renewal fees calculated in accordance with Rule 30?” was previously addressed in the Madrid Highlights [No. 2/2013](#). Following amendments to Rule 30, the way in which fees will be calculated for Contracting Parties, where individual fees apply, will change from the beginning of 2015. The following cases are provided to explain the new way fees will be calculated where individual fees apply:

Case 1

I am from Estonia and I have just received an unofficial notice reminding me that my international registration is due for renewal on July 13, 2015. Uzbekistan, designated for goods in classes 5, 7 and 34, has granted me partial protection for classes 5 and 7 (in a statement under Rule 18ter(2)(ii)).

Question: What will happen with respect to the classes that have been refused by Uzbekistan when I renew my registration?

Answer: If you would like to take advantage of the new default option, the international registration will be renewed only for the goods protected, that is, for those in classes 5 and 7, when you pay the corresponding individual fees in respect of those two classes.

If you also wish to renew the registration for Uzbekistan in respect of class 34, you can indicate this in sections 3 and 4 of the form [MM11](#) and pay the corresponding individual fees.

Case 2

I am from Singapore and the renewal of my international registration is due on February 15, 2015. My registration currently designates Norway for services in classes 38, 40, 41 and 42.

Norway sent a total provisional refusal that was followed by a statement under Rule 18ter(2)(ii), indicating that protection was granted for classes 38 and 41.

I am planning to send my request for renewal next week and I have the following question:

Question: How will the renewal fees be calculated if I want to renew my international registration?

Answer: If you hold off sending the renewal request until January 1, 2015, or later, you can take advantage of the new renewal option. If you do that, only classes 38 and 41 will be taken into account when calculating the renewal fees. You will have to pay individual fees in respect of those two classes. However, you may choose to also renew for classes 40 and 42. This should be indicated in sections 3 and 4 of form MM11 and the corresponding individual fees should be paid.

Case 3

I am from Slovakia and I am the holder of an international registration designating Tajikistan and San Marino for classes 4, 6, 8 and 11. My international registration is due for renewal on August 6, 2015.

Tajikistan sent a total provisional refusal that was followed by a statement under Rule 18ter(2)(ii), indicating that protection was granted for class 4. San Marino sent a partial provisional refusal for classes 4 and 8. This was finally followed by a statement under Rule 18ter(2)(ii), indicating that protection was granted for class 8.

Question: How will the renewal fees be calculated if I want to renew my international registrations for all the designated Contracting Parties?

Answer: For the renewal of this international registration, as Slovakia, Tajikistan and San Marino are all party to both treaties, the Agreement and the Protocol, the standard fee regime will prevail (complementary and supplementary fee), even though Tajikistan and San Marino have made a declaration to receive individual fees (this is a result of Article 9sexies (1)(b) of the Protocol). The statements under Rule 18ter(2)(ii) will have no effect on the supplementary fees (for classes) due at the renewal.

In addition to the basic fee for renewal, you will need to pay complementary fees of a 100 Swiss francs for each designated Contracting Party (in this case 2) and a supplementary fee of a 100 Swiss francs for each class of goods and services beyond the third (in this case you have four classes).

Notification in case of the Non-Renewal: Rule 31

Under amended Rule 31, the holder, his/her representative and the designated Contracting Parties will be notified when an international registration is cancelled because it has not been renewed.

The amended Rule 31 applies to international registrations for which renewal is due on or after January 1, 2015.

For more information, see [Information Notice No. 23/2014](#).

THE MADRID WORKING GROUP

The twelfth session of the Working Group on the Legal Development of the Madrid System for the International Registration of Marks was held in Geneva, from October 20 to 24, 2014. 43 Contracting Parties to the Madrid Union, 14 States with observer status, three intergovernmental organizations and nine international non-governmental organizations were represented.

The Working Group documents are available on the WIPO web site at http://www.wipo.int/meetings/en/details.jsp?meeting_id=32427.

The following conclusions were reached:

1. Proposed Amendments to the Common Regulations ([MM/LD/WG/12/2](#))

The Working Group proposed amendments to the Common Regulations for adoption by the Madrid Union Assembly in 2015:

- (a) *Failure in Communications sent electronically (Rule 5)*

- A relief measure is proposed to assist an interested party (applicant/holder/Office), which has failed, due to extraordinary circumstances, to meet a time limit to submit a communication to the IB using electronic means.

(b) Voluntary Description of the Mark (Rule 9)

- Voluntary description of the mark in the international application is proposed, to prevent a potential refusal from designated Contracting Parties.

(c) Subsequent Designations (Rule 24)

- Limiting the consequences resulting from an irregularity, which has not been remedied, involving a missing or defective declaration of intention to use the mark ([MM18 form](#)), is proposed.

2. Proposal for the Introduction of the Recordal of Division or Merger Concerning an International Registration ([MM/LD/WG/12/3](#))

The Working Group discussed the possible introduction of division of an international registration. The IB was asked to present a new document for the next meeting, taking into account information received during the meeting (revised information from the Delegation of Switzerland), to provide for a simpler division procedure, to be managed by the designated Contracting Party.

3. Proposal to Freeze the Operation of Articles 6(2), (3) and (4) of the Madrid Agreement and the Protocol ([MM/LD/WG/12/4](#))

The Working Group requested that the IB conduct a user survey to obtain a better understanding of the practical advantages and disadvantages of dependency. The Working Group also asked the IB to consider, for the next meeting, possible simplification of the transformation procedure. Consideration of problems with the basic mark resulting from linguistic diversity was also requested. To deepen understanding on this issue, testimonials from users from countries with non-Latin scripts, will be sought.

4. Replacement ([MM/LD/WG/12/5](#))

The Working Group requested that the IB prepare a proposal for a revised provision on replacement (Rule 21), which would incorporate a set of harmonized principles governing the procedure.

FOURTH MADRID WORKING GROUP ROUNDTABLE

The fourth Madrid Working Group Roundtable was held on October 23 and 24, 2014, during the twelfth session of the Working Group.

The Roundtable provided a platform for networking and sharing experiences between the IB, representatives from Offices, and organizations representing trademark holders and agents. 81 registered participants attended the event, including observers, international intergovernmental organizations and international non-governmental organizations.

Participants discussed Madrid System developments, possible ways to reduce the number of irregularities in international applications, IP Office practice regarding issuing provisional refusals, and communication between WIPO and the Offices of Contracting Parties. Presentations made during the Madrid Working Group Roundtable are available on the WIPO website at http://www.wipo.int/meetings/en/details.jsp?meeting_id=33964.

CONTRACTING PARTIES

ACCESSION OF THE AFRICAN INTELLECTUAL PROPERTY ORGANIZATION (OAPI) TO THE MADRID PROTOCOL

The African Intellectual Property Organization (OAPI*) became the 93rd member of the Madrid System on December 5, 2014, 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. The Madrid Protocol will enter into force in respect of OAPI, on March 5, 2015.

OAPI made the following two declarations:

1. The first declaration refers to Article 5(2)(b) and (c) of the Madrid Protocol. It extends the time limit of one year to notify a provisional refusal of protection to 18 months with the possibility to notify a provisional refusal resulting from an opposition after the expiry of the 18-month time limit.
2. The second declaration refers to Article 8(7)(a) of the Madrid Protocol. OAPI wishes to receive an individual fee where it is designated in an international application and in a designation subsequent to an international registration.

For more information, see [Information Notice No. 22/2014](#).

** OAPI is the main organization that ensures the protection of intellectual property rights in most French-speaking African countries. OAPI comprises 17 member States: Benin, Burkina Faso, Cameroon, Central African Republic, Chad, Comoros, Congo, Côte d'Ivoire, Gabon, Guinea, Equatorial Guinea, Mali, Mauritania, Niger, Guinea Bissau, Senegal and Togo.*

ACCESSION OF ZIMBABWE TO THE MADRID PROTOCOL

Zimbabwe became the 94th member of the Madrid System on December 11, 2014, 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. The Madrid Protocol will enter into force in respect of Zimbabwe, on March 11, 2015.

For more information, see [Madrid \(Marks\) Notification No. 204](#).

WITHDRAWAL OF THE NOTIFICATION MADE UNDER RULE 20bis(6)(b) OF THE COMMON REGULATIONS: LITHUANIA

The State Patent Bureau of the Republic of Lithuania notified the Director General of WIPO of the withdrawal of the notification made under Rule 20bis(6)(b) of the Common Regulations. From September 2, 2014, the recording in the International Register of a license relating to an international registration of a mark has effect in Lithuania.

For more information, see [Information Notice No. 15/2014](#).

DECLARATION MADE UNDER ARTICLE 8(7)(a) OF THE MADRID PROTOCOL**The territorial entity of Sint Maarten (Dutch Part)**

The Government of the Kingdom of the Netherlands made a declaration under Article 8(7)(a) of the Madrid Protocol that it wishes to receive an individual fee when the territorial entity of Sint Maarten (Dutch Part) 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 the territorial entity of Sint Maarten (Dutch Part). From December 1, 2014, the following amounts are applicable for the territorial entity of Sint Maarten (Dutch Part):

ITEMS		Amounts (in Swiss francs)
Application or Subsequent Designation	– for three classes of goods or services	298
	– for each additional class	31
	<i>Where the mark is a collective mark:</i>	
	– for three classes of goods or services	593
	– for each additional class	61
Renewal	– for three classes of goods or services	298
	– for each additional class	31
	<i>Where the mark is a collective mark:</i>	
	– for three classes of goods or services	593
	– for each additional class	61

For more information, see [Information Notice No. 16/2014](#).

CHANGES IN THE AMOUNTS OF THE INDIVIDUAL FEES

There are changes to the amounts of individual fees payable when Iceland and Colombia 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.

Iceland

For Iceland, the following amounts entered into force on December 1, 2014:

ITEMS		Amounts (in Swiss francs)
Application or Subsequent Designation	– for one class of goods or services	221
	– for each additional class	47
	<i>Where the mark is a collective mark:</i>	
	– for one class of goods or services	221
	– for each additional class	47
Renewal	– for one class of goods or services	221
	– for each additional class	47
	<i>Where the mark is a collective mark:</i>	
	– for one class of goods or services	221
	– for each additional class	47

For more information, see [Information Notice No. 14/2014](#).

Colombia

For Colombia, the following amounts will enter into force on January 1, 2015:

ITEMS		Amounts (in Swiss francs)
Application or Subsequent Designation	– for one class of goods or services	373
	– for each additional class	187
	<i>Where the mark is a collective or certification mark:</i>	
	– for one class of goods or services	497
Renewal	– for each additional class	248
	– for one class of goods or services	204
	– for each additional class	99
	<i>Where payment is received within the period of grace:</i>	
	– for each additional class	278

For more information, see [Information Notice No. 18/2014](#).

MADRID TIPS

E-Renewal

The payment of renewal fees can be made via a WIPO Current Account or by credit card (Visa or MasterCard) using E-Renewal. However, in cases of international registrations, which have been the subject of a partial invalidation or limitation, or have refused protection under Rule 18~~ter~~ of the Common Regulations, form MM11 needs to be used.

New Form MM11

When using form MM11, a partial invalidation, limitation, or final decision with respect to a designated Contracting Party for which an individual fee is payable, will be taken into account in calculating the amount of that fee.

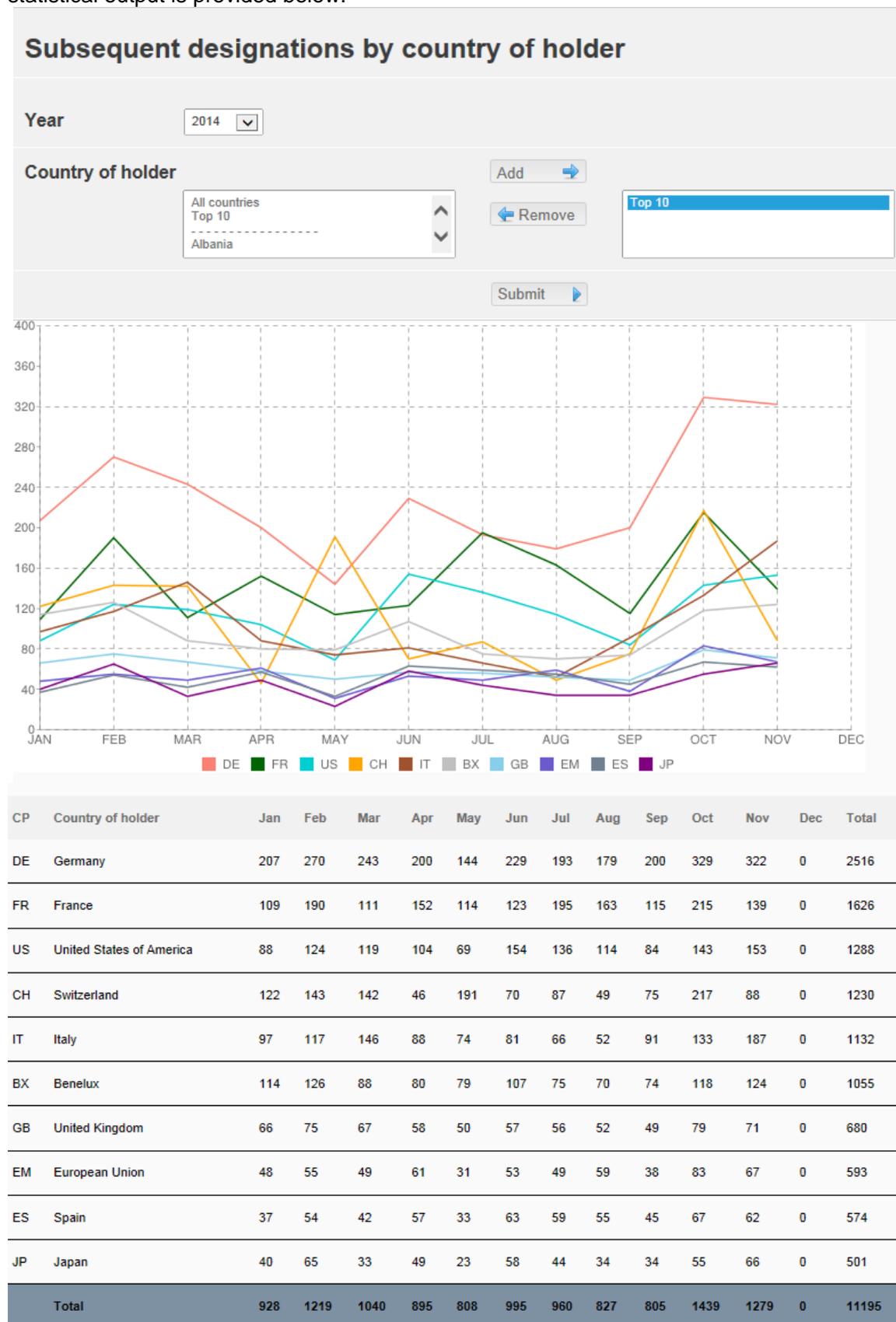
The international registration can be renewed in respect to any designated Contracting Party that has refused protection, under Rule 18~~ter~~ of the Common Regulations, but this must be indicated in items 3 and, where applicable, 4, of the MM11 form. The corresponding fees also need to be paid.

Partial Invalidation

Regardless of the effective date of the partial invalidation, the renewal fee will be determined by the date of recordal of the invalidation in the International Register. When the partial invalidation is not received by the IB before the renewal date, the invalidation will not affect the number of individual fees to be paid.

Madrid System Statistics

Dynamic, customizable statistics are available on the WIPO web site at <http://www.wipo.int/madrid/en/statistics> to assist interested parties compile information about use of the Madrid System. Daily, monthly and annual information is available. An example of the statistical output is provided below:



USEFUL INFORMATION

2015 VERSION OF THE TENTH EDITION OF THE NICE CLASSIFICATION

A new version of the tenth edition of the International Classification “NCL(10-2015)” will enter into force on January 1, 2015. It is available on the WIPO web site at <http://www.wipo.int/classifications/nice/en/>.

For more information, see [Information Notice No. 20/2014](#).

TRANSACTION CODES

Whenever a fee is paid to the IB, the purpose of the payment must be indicated, together with information identifying the application or registration concerned. Please use the following transaction codes for a bank transfer.

CPR	Continued processing
EN	International application
EX	Subsequent designation
LI	Limitation
LLC	Amendment of a license
MT	Change in name and/or address of the holder
NLC	New license
NT	New Tax – 2 nd part fee
OB	Opting back – subsequent designation resulting from conversion
RC	Complementary Renewal
RE	Renewal
TR	Transfer of an international registration

MADRID CUSTOMER SERVICE DURING THE HOLIDAY PERIOD

The IB will be closed on December 25 and 26, 2014, and on January 1 and 2, 2015.

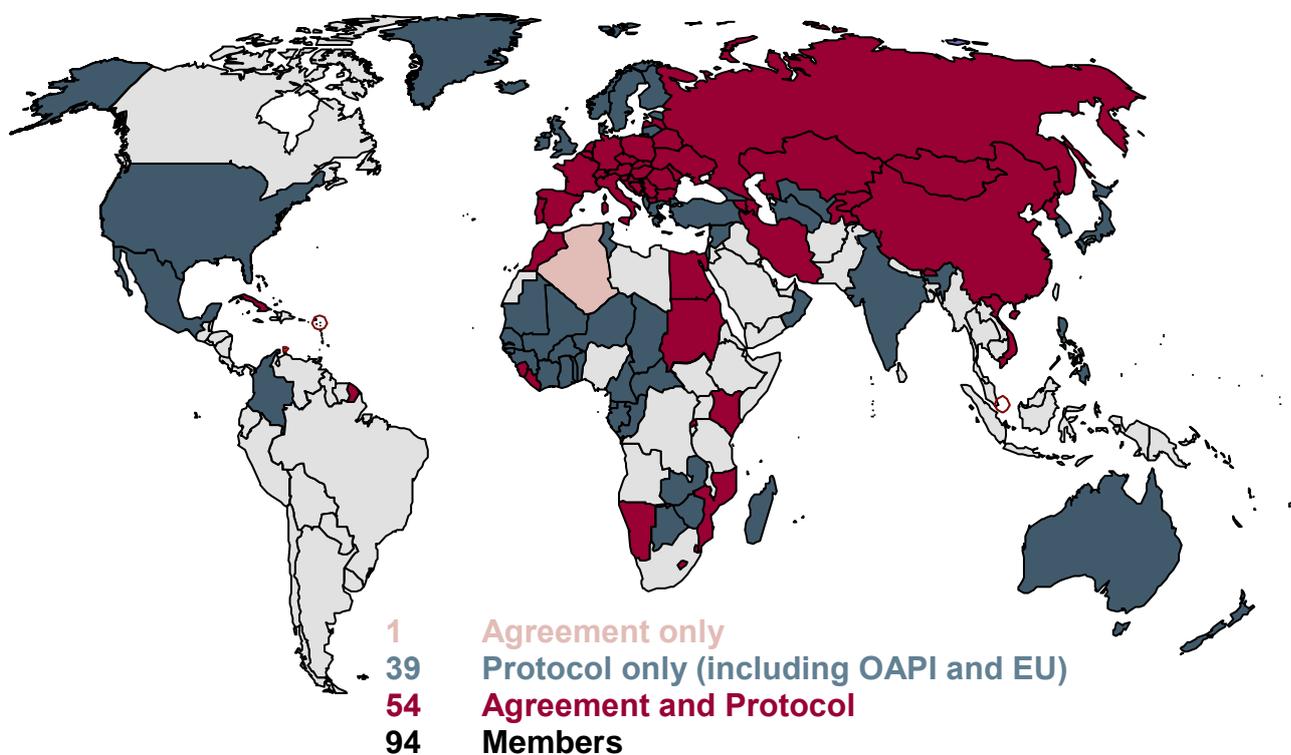
The Madrid Customer Service Unit will not be contactable by phone on December 24, 29, 30 and 31, 2014. For urgent queries during this period, please contact the Madrid Operations Teams or send an e-mail to intreg.mail@wipo.int.

OFFICIAL HOLIDAYS IN 2015

The days on which the International Bureau of the World Intellectual Property Organization (WIPO) is not scheduled to be open to the public during 2015, are the following:

NEW YEAR	Thursday, January 1, 2015 Friday, January 2, 2015
EASTER	Friday, April 3, 2015 Monday, April 6, 2015
WHITSUN	Monday, May 25, 2015
JEÛNE GENEVOIS	Thursday, September 10, 2015
EID AL-ADHA (observed)	Thursday, September 24, 2015 ¹
CHRISTMAS	Thursday, December 24, 2015 Friday, December 25, 2015
NEW YEAR 2016	Thursday, December 31, 2015 Friday, January 1, 2016

MADRID UNION MAP



¹

May eventually change

HOW TO CONTACT US:

Telephone Opening hours: 9:00 a.m. to 6:00 p.m. Geneva time
(3.00 a.m. to 11.00 a.m. US Eastern time zone).

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

Extracts Queries: Madrid Clients Records Unit, +41 22 338 8484, madrid.records@wipo.int

Specific Queries: Madrid Processing Teams, specialized by your Office of Origin/residence.

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

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

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

AG	Antigua and Barbuda
AM	Armenia
BG	Bulgaria
BQ	Bonaire, Saint Eustatius and Saba
CH	Switzerland
CO	Colombia
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
MX	Mexico
OA	Organisation africaine de la propriété intellectuelle*
MZ	Mozambique
PL	Poland
PT	Portugal
RO	Romania
ST	Sao Tome and Principe
SX	Saint Maarten
SY	Syrian Arab Republic
TN	Tunisia

AL	Albania
AT	Austria
AZ	Azerbaijan
BA	Bosnia and Herzegovina
BX	Benelux
BY	Belarus
DE	Germany
EE	Estonia
GE	Georgia
GH	Ghana
HR	Croatia
IN	India
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
UA	Ukraine
UZ	Uzbekistan
ZM	Zambia

AU	Australia
BH	Bahrain
BT	Bhutan
BW	Botswana
CN	China
CY	Cyprus
DK	Denmark
FI	Finland
GB	United Kingdom
GR	Greece
IE	Ireland
IL	Israel
IS	Iceland
JP	Japan
KE	Kenya
KR	Republic of Korea
NZ	New Zealand
NO	Norway
OM	Oman
PH	Philippines
RW	Rwanda
SE	Sweden
SG	Singapore
TR	Turkey
US	United States of America
VN	Viet Nam
ZW	Zimbabwe

* OAPI comprises: Benin, Burkina Faso, Cameroon, Central African Republic, Chad, Comoros, Congo, Côte d'Ivoire, Gabon, Guinea, Equatorial Guinea, Mali, Mauritania, Niger, Guinea Bissau, Senegal and Togo.

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