

HIGHLIGHTS

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CONTENTS

| | |
|--|-----------|
| CONTRACTING PARTIES | 2 |
| Accession of India | |
| Accession of Rwanda | |
| International Registrations Containing a Designation of the Philippines: Requirement to File Declarations of Actual Use of the Mark | |
| Changes in the Amounts of the Individual Fee under Article 8(7) of the Madrid Protocol | |
| New Layout of Certificates of International Registrations | |
| New Statistical Information Available Online | |
| New Services of the Client Records Unit | |
| MADRID UNION | 4 |
| Inadmissibility of Requests to Change an International Registration to Include a Standard Character Claim Where such Claim Was not Made in the Corresponding International Application | |
| ONLINE SERVICES | 5 |
| New Version of the Madrid Goods & Services Manager (MGS) | |
| Improvement of the Madrid Real-Time Status (MRS) | |
| MADRID TIPS | 6 |
| Practical Examples on the Implementation of the Madrid System: Article 14(5) of the Madrid Protocol | |
| Tips to Avoid Format Mistakes on the Lists of Goods and Services | |
| USEFUL INFORMATION | 9 |
| International Trademark Association (INTA) 2013 | |
| Seminar on the Madrid System for the International Registration of Marks | |
| WIPO Publication: "Protecting Your Marks Abroad: the Madrid System": New Edition in English and Chinese | |
| What Users Say About the Madrid System: Two New Video Interviews under Production | |
| 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.

CONTRACTING PARTIES

ACCESSION OF INDIA TO THE MADRID PROTOCOL

India became the 90th 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 April 8, 2013. The Madrid Protocol will enter into force, with respect to India, on July 8, 2013.

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 India 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.

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

The instrument of accession was also accompanied by two notifications:

The first notification refers to Rule 7(2) of the Common Regulations, according to which India requires, as a Contracting Party designated under the Madrid Protocol, a declaration of intention to use the mark.

The second notification refers to Rule 20bis(6)(b) of the Common Regulations, according to which India declares that the Recording of Licenses in the International Register has no effect in India.

For more information, see Information Notices [No. 14/2013](#), [No. 15/2013](#) and [No. 16/2013](#).

ACCESSION OF RWANDA TO THE MADRID PROTOCOL

Rwanda became the 91st 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 May 17, 2013. The Madrid Protocol will enter into force, with respect to Rwanda, on August 17, 2013.

No declarations accompanied the instrument of accession.

For more information, see Information Notice [No. 17/2013](#).

INTERNATIONAL REGISTRATIONS CONTAINING A DESIGNATION OF THE PHILIPPINES: REQUIREMENT TO FILE DECLARATIONS OF ACTUAL USE OF THE MARK

The Office of the Philippines has provided to the International Bureau of WIPO information related to the requirement to file declarations of actual use of a mark which is the subject of an international registration containing a designation of the Philippines and has requested that this information be made available to users of the Madrid system.

Declarations of actual use of the mark, with evidence to that effect, must be filed, within the applicable periods, directly with the Office of the Philippines, as prescribed by the applicable laws and regulations and upon the payment of a fee.

Alternately, holders of international registrations containing a designation of the Philippines may file, under the same conditions, a declaration of non-use of the mark, stating the valid grounds, under the laws of the Philippines, for such non-use.

The declaration of actual use or non-use of the mark must be submitted by the holder's authorized representative with a local address or by a legal representative in the Philippines. A local address is required for purposes of notification.

Failure to file declarations of either actual use or non-use of the mark, within the applicable periods, will prompt the Office of the Philippines to declare, *ex officio*, that protection to the mark which is the subject of an international registration containing a designation of the Philippines cannot or can no longer be granted.

Users of the Madrid system may contact the Office of the Philippines for further information concerning this matter and see Information Notice [No. 18/2013](#)

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 Colombia (May 7, 2013), Cuba (May 26, 2013), Japan (July 20, 2013) and/or Syria (July 20, 2013) 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. 9/2013](#), [No. 10/2013](#), [No. 19/2013](#) and [No. 20/2013](#), respectively.

India

The Government of India has made the declaration referred to in Article 8(7) of the Madrid Protocol whereby it wants to receive an individual fee when India 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 India. This declaration entered into force on July 8, 2013. More information can be found in Information Notice [No. 21/2013](#).

NEW LAYOUT OF CERTIFICATES OF INTERNATIONAL REGISTRATIONS

As from July 4, 2013, the layout of certificates of international registrations will significantly improve.

Holders of international registrations will find the reproduction of the mark prominently displayed as the first item on the certificate. Moreover, the bibliographical data will be presented in a single column. The certificate will feature a new font and introduce other formatting changes which will align it with the corporate identity of the organization while making it easier to read.

For more information, please, see Information Notice [No. 23/2013](#).

NEW STATISTICAL INFORMATION AVAILABLE ONLINE

As from June 21, 2013, new statistical information concerning the Madrid system is available on the Madrid system's web site at the following address: <http://www.wipo.int/madrid/en/statistics/>.

A new tab entitled “*In Progress*” provides options to display information concerning international applications and subsequent designations that have been received and are still being processed by the International Bureau of WIPO. This information may be in one of three main processing stages, namely, data entry, examination or translation. They may also be irregular but still be remedied within the applicable time-limit. In addition, the new statistical feature presents information concerning the date on which recently recorded international registrations and subsequent designations will be notified to the Offices of the designated Contracting Parties.

The new statistical information may be useful in a number of ways. For instance, Offices of designated Contracting Parties may determine the number of notifications, following designations made in international registrations, that said Offices will receive in the next weeks.

The status of a particular international application or subsequent designation may be ascertained through the Madrid Portfolio Manager or the Madrid Real Time Status, online services available at the following address: <http://www.wipo.int/madrid/en/services/>.

For more information, see Information Notice [No. 22/2013](#).

NEW SERVICES OF THE CLIENT RECORDS UNIT

As of August 1, 2013, users will be able to request fast-track delivery of certified extracts from the International Register concerning a given international registration, and the legalization of such extracts. They will also be able to obtain certified copies of international registration certificates. These services will be provided upon request and against the payment of a fee.

For detailed information, you may contact directly the Client Records Unit of the Madrid Operations Service, by telephone at +41 22 338 8484, or by e-mail at madrid.records@wipo.int.

MADRID UNION

INADMISSIBILITY OF REQUESTS TO CHANGE AN INTERNATIONAL REGISTRATION TO INCLUDE A STANDARD CHARACTER CLAIM WHERE SUCH CLAIM WAS NOT MADE IN THE CORRESPONDING INTERNATIONAL APPLICATION

As of April 1, 1996, the Common Regulations introduced, as an optional feature, the possibility to make a standard character claim while filing an international application. Only international applications submitted from that date may include a standard character claim and once the international registration is effected such claim cannot be included.

International registrations resulting from applications presented according to the Common Regulations in force before April 1, 1996, do not include a standard character claim and cannot be changed or amended to include such claim.

Users are strongly encouraged to contact Offices of Contracting Parties designated in an international registration to ascertain the possibility that a standard character claim may be presented directly before such Offices.

For more information, see Information Notice [No. 11/2013](#).

ONLINE SERVICES



NEW VERSION OF THE MADRID GOODS & SERVICES MANAGER (MGS)

The Goods & Services Manager (GSM) is renamed the Madrid Goods & Services Manager (MGS). A new version of MGS was implemented on May 1, 2013, and is available at: www.wipo.int/mgs/.

This new version features five additional language interfaces: Chinese (simplified), Chinese (traditional), Japanese, Norwegian and Turkish, bringing the number of languages available in MGS to 15. Moreover, users may now translate from any one language into any of the other 14 languages, in so far as translations have been provided in the target language.

The new MGS also features the ability to “Check acceptance by designated Contracting Party (dCP)”. For each term accepted by the Madrid Registry, MGS can now display the status of acceptance/rejection by 16 participating Offices from the Madrid system (namely the Offices of Austria, Benelux, China, Israel, Italy, Japan, Norway, Portugal, the Republic of Korea, the Russian Federation, Singapore, Switzerland, the Syrian Arab Republic, Turkey and the United States of America).

These Offices, in their capacity as Contracting Parties designated in international applications, have worked closely with the International Bureau to provide their acceptance/rejection status for at least a part of the terms in MGS and more acceptance data will be integrated in the future through continued cooperation.

These new features aim to reduce both irregularity notices issued by the International Bureau and refusal notifications issued by Offices of designated Contracting Parties, hence benefiting Madrid system users by impacting the cost and speed of the international registration process.

For more details, see Information Notice [No. 12/2013](#) dated May 6, 2013 “Communication regarding the Madrid Goods and Services Manager (MGS)” at: <http://www.wipo.int/madrid/en/notices/>.

A tutorial, a promotional video and a flyer have also been produced and can be found at: www.wipo.int/madrid/en/services.



IMPROVEMENT OF THE MADRID REAL-TIME STATUS (MRS)

Additional features in MRS for the retrieval of information regarding an international registration recorded in the International Registry have been implemented.

Users have access, with one click, to the full details of all transactions, pending or completed, of any international registration recorded in the International Registry.

Moreover, access to all other online services is now possible from the MRS application, permitting a swifter navigation from one service to the other.

MADRID TIPS

PRACTICAL EXAMPLES ON THE IMPLEMENTATION OF THE MADRID SYSTEM: ARTICLE 14(5) OF THE MADRID PROTOCOL

Under the Madrid system, once a mark has been registered, the holder of the international registration may extend its geographical protection anytime by filing a request for a subsequent designation (Official Form MM4) provided that the international registration is bound by the same treaty (Agreement or Protocol) as the Contracting Party where protection is sought.

The only exception to this principle is the declaration referred to in Article 14(5) of the Madrid Protocol under which a Contracting Party may, when acceding to the Madrid Protocol, declare that the protection resulting from an international registration effected before the date of entry into force of the Protocol with respect to the concerned Contracting Party cannot be extended to it.

The Contracting Parties that have made the referred declaration and the date on which the Protocol entered into force in their corresponding territories are:

- Estonia (November 18, 1998)
- India (July 8, 2013)
- Namibia (June 30, 2004)
- Philippines (July 25, 2012)
- Turkey (January 1, 1999)

Q1. I am the holder of an international registration which was effected in 2006. I have seen that the Philippines is now a member of the Madrid system. How can I extend the protection of my trademark to the Philippines?

R1. You cannot extend the protection resulting from your international registration by subsequently designating the Philippines, as your international registration was effected prior to July 25, 2012, which is the date of entry into force of the Protocol in the Philippines. When acceding to the Madrid Protocol, the Philippines made the declaration under Article 14(5) of the Protocol; therefore, international registrations effected prior to July 25, 2012, cannot subsequently designate the Philippines.

Q2. My company owns an international registration, which was effected on October 1999. As a part of our strategic business plan, we would like to extend the protection of our trademark to India, Japan, the Philippines and Turkey but we are not sure if that is possible through the Madrid system. Could you clarify, please?

R2. You can extend the protection resulting from your international registration to Japan, as Japan has not made a declaration under Article 14(5), and to Turkey because, even if Turkey has made the referred declaration, your international trademark was effected after the entry into force of the Protocol in Turkey.

However, you cannot subsequently designate India and the Philippines as both countries have made a declaration under Article 14(5) and your international trademark was effected before the entry into force of the Protocol in these countries (July 25, 2012 for the Philippines and July 8, 2013, for India).

Q3. I am the holder of an international registration. I presented a form MM4 “Designation Subsequent to the International Registration” to the International Bureau of WIPO a month ago. Now I have received a letter from the International Bureau stating that I cannot have protection for Estonia. The letter says that my international registration is dated prior to the accession of Estonia to the Protocol. I don’t understand why I’m not allowed to subsequently designate Estonia and there is no problem to subsequently designate Lithuania, where the Protocol also entered into force after the registration of my international trademark was effected.



R3. You are not allowed to subsequently designate Estonia because Estonia is one of the Contracting Parties that made the declaration referred to in Article 14(5) of the Protocol when acceding and your international trademark was effected before the date of entry into force of the Protocol in Estonia. Lithuania has not made the referred declaration and therefore it can be subsequently designated in any international registration.

Q4. I am the representative of an international registration which was effected on July, 1992. My client wants to extend the protection to some countries in Africa. I would like to know if it's possible to subsequently designate Namibia even if Namibia has made a declaration under Article 14(5) of the Protocol.

R4. Your client cannot request that the protection resulting from the international registration be extended to Namibia. Namibia is one of the Contracting Parties that has made the declaration under Article 14(5) of the Protocol and your international registration was effected prior to the entry into force of the Protocol in Namibia.

TIPS TO AVOID FORMAT MISTAKES ON THE LIST OF GOODS AND SERVICES

The following are some tips to avoid format mistakes on the list of Goods and Services. The International Bureau encourages the use of the Madrid Goods and Service Manager (www.wipo.int/mgs/) but sometimes the International Bureau encounters format mistakes which slow down the examining of applications. Here is how to avoid such mistakes, guaranteeing a smooth and quick examining of your applications:

| |  |  |
|--|--|---|
| Use the MGS | Not recommended: your own list; online translations from your Basic list, old lists of G&S | Recommended: Go online and pick from the list available at www.wipo.int/mgs/ |
| Always use plural forms except only if not applicable for some uncountable (e.g. bread) | Not recommended: Class 25: Shirt; shoe; hat Class 12: Traction engine | Recommended: Class 25: shirt <u>s</u> ; shoe <u>s</u> ; hat <u>s</u> Class 12: Traction engine <u>s</u> |
| Clearly differentiate between goods and services through the use of a “ qualifier” | | Goods: photographies Goods: photography apparatus, devices, tools, etc Services: photography services. |
| Always check accents, grammar: | Not recommended: “Pate (pastries)”, rejected in cl. 30 Temporary accom <u>o</u> modation” | Recommended: “Pât <u>e</u> (pastries)” Temporary accom <u>mo</u> modation |
| When to use SEMICOLONS: Always use semi-colons “;” after a NEW product/services and/or new class heading | Not recommended: Shirts, shoes, hats. | Recommended: Shirts; shoes; hats. |

| | | |
|--|--|---|
| <p>When to use COMMAS: Use commas to separate elements in a series of goods or services</p> | <p>Wrong punctuation: “Retail services or wholesale services for clocks; watches; spectacles; eyeglasses; goggles”</p> | <p>Correct punctuation: “Retail services or wholesale services for clocks, watches, spectacles, eyeglasses, goggles.”</p> |
| <p>Do not use too vague definitions</p> | <p>Not recommended:</p> <p>Class 11: Bathtubs and the like</p> <p>“All included in this class”</p> <p>Class 9: “Cables”</p> <p>Class 30: “Desserts”</p> <p>Class 35: Retailing of goods;</p> <p>Class 35 “Statistical information”;</p> <p>Class 39: Travel agency services</p> <p>Class 18: “Belts”</p> | <p>Recommended: Please ensure to be specific regarding the nature of the goods:</p> <p>Class 11: Bathtubs; bathtubs enclosures; bathtubs jets.</p> <p>Specify the good/service.</p> <p>Class 9 “Electric cables.</p> <p>Class 30: Chocolate desserts; dessert mousses [confectionery].</p> <p>Class 35: Retail sales services of goods</p> <p>Class 35: Compilation of statistical information</p> <p>Class 39: travel agency services, namely travel reservation and travel arrangement</p> <p>Class 43: travel agency services, namely hotel reservations</p> <p>Class 18: Saddle belts; leather shoulder belts; shoulder belts; shoulder belts [straps] of leather.</p> |
| <p>The following indications are rejected by the IB:</p> | <p>Not recommended:</p> <p>“franchising services”</p> | <p>Recommended:</p> <p>Specify the franchising service, for example:</p> <p>“business advice relating to franchising” (class 35)</p> <p>“financing services relating to franchising” (class 36)</p> <p>“legal services relating to franchising” (class 45)</p> |

ADDITIONAL RECOMMENDATIONS:

Round brackets:

An expression between round brackets () may constitute a different indication of the product or service in question, which in that case also is listed (a so-called cross-reference) in its appropriate place in the Alphabetical List. In other cases, an expression between round brackets may begin with a general term (e.g., apparatus, conducting, machines) under which the product or service cannot be listed in the Alphabetical List. The text preceding the round brackets is considered the most important part of the indication of the product or service in question, and is replaced within the brackets by "-".

Square brackets:

In the Alphabetical List, an expression between square brackets [] is in most cases intended to define more precisely the text preceding the brackets, since the said text is ambiguous or too vague for classification purposes. Sometimes, the square brackets embrace the corresponding American expression of the text preceding the brackets, in most cases of which the expression is followed by "(Am.)".

Additional Information in this regard can be found at: **Guidance for the user** at: ([NicePub](#)), and

“WIPO Recommendations” at:

<http://www.wipo.int/classifications/nice/en/recommendations/index.html>

USEFUL INFORMATION

INTERNATIONAL TRADEMARK ASSOCIATION (INTA) 2013

From May 4 to 8, 2013, the International Trademark Association (INTA) held its 135th Annual Meeting in Dallas, Texas. WIPO ran its 6th Annual Madrid System Users' Meeting (MSUM), answered the questions of users and potential users of the Madrid system at the WIPO booth in the Exhibition Hall, participated in events organized by the INTA as well as held numerous side meetings with holders, representatives, NGOs and government officials.

Madrid System Users' Meeting (MSUM)

The MSUM broke prior records by drawing a crowd of approximately 180 people. WIPO personnel gave updates on the Madrid and Hague systems as well as on a new version of the Madrid Goods and Services Manager (MGS). Three special guests from the Offices of countries that had recently acceded to the Madrid Protocol talked about what users should expect when designating their respective countries: Mr. José Luís Londoño Fernández, Deputy Superintendent, Superintendency of Industry and Commerce (SIC), Ministry of Industry, Commerce and Tourism, Bogotá, Colombia; Mr. Miguel Ángel Margáin González, Director General, Mexican Institute of Industrial Property (IMPI), Mexico City, Mexico and Ms. Ingrid Bayliss, National Manager, Intellectual Property Office of New Zealand (IPONZ), Ministry of Economic Development, Wellington, New Zealand. A panel of speakers from the trademark Offices of the European Union, Japan Patent Office, the Russian Federation and the United States of America spoke on how to avoid refusals when designating their countries and took questions directly from the audience.

WIPO Booth in the Exhibition Hall

Throughout the entire Annual Meeting, the various members of the WIPO Delegation were on hand at the WIPO booth in the Exhibition Hall to answer the questions of existing and potential holders of international registration and their representatives. Thousands of publications were distributed for free, and visitors to the booth were given individual demonstrations of how to use the on-line services and tools of the Madrid and Hague systems, including, in particular, the Madrid System Goods & Services Manager ([MGS](#)).

Other Activities

The members of the WIPO Delegation otherwise acted as facilitators in Table Topic discussions, served on panels in sessions of the main program, attended INTA subcommittee meetings on the Madrid system and International Classification, met with representatives of various NGOs, including the executive staff and officers of the INTA, and had side meetings with the many of the 141 government officials from 35 countries in attendance.

Media Coverage

The Madrid Protocol and the activities of the Brands and Designs Sector featured prominently in world IP media, including the [INTA Daily News](#), [Managing Intellectual Property Magazine](#), the [World Trademark Review](#) and [INTA TV](#). The articles, videos and blog postings of those organizations on the Madrid Protocol may be found on their respective websites.

SEMINAR ON THE MADRID SYSTEM FOR THE INTERNATIONAL REGISTRATION OF MARKS

The 48th edition of the Seminar on the Madrid System for the International Registration of Marks organized by the International Bureau of WIPO took place in Geneva, on June 3 and 4, 2013.

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.

This Seminar has been attended by 41 participants from mainly industry, independent and in-house trademark agents (paralegals as well as attorneys) most of whom file applications for international registration of trademarks and/or who administer such registrations. Representatives of some national Intellectual Property Offices also participated in the Seminar.

The next session of the Seminar is scheduled to be held, on November 28 and 29, 2013, at the headquarters of WIPO, in Geneva. To stay 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.

WIPO PUBLICATION: “PROTECTING YOUR MARKS ABROAD: THE MADRID SYSTEM”: NEW EDITION IN ENGLISH AND CHINESE

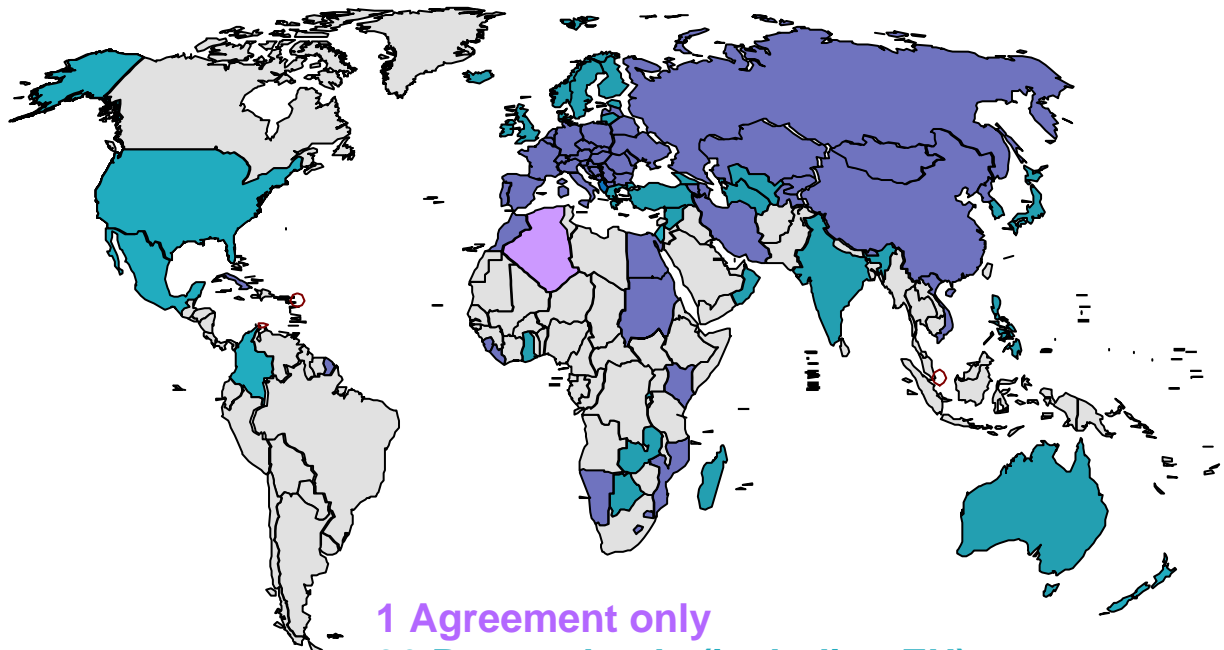
An updated edition of the WIPO publication “*Protecting your Marks Abroad: the Madrid System*” (N° 1039) was published in June 2013. This brochure specially designed for SMEs and entrepreneurs community with minimum awareness of the Madrid system and trademark laws is now available in English and Chinese and will soon be accessible in Arabic, Chinese, French, Russian and Spanish.

Readers can download a free PDF copy in the language of your choice at:
<http://www.wipo.int/freepublications/en/archive.jsp?cat=marks>

WHAT USERS SAY ABOUT THE MADRID SYSTEM: TWO NEW VIDEO INTERVIEWS UNDER PRODUCTION

Two new videos filmed in the island of Madagascar are currently under preparation to present valuable experiences of using the Madrid system and managing portfolio of trademarks by Madagascan companies. These projects are conducted in close cooperation with the Malagasy Industrial Property Office (OMAPI) and are part of WIPO efforts to better reflect IP users' opinion worldwide and provide local institutions with adequate IP promotional materials targeting their business communities.

MADRID UNION MAP



1 Agreement only
36 Protocol only (including EU)
54 Agreement and Protocol

91 Members

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CU [Cuba](#)
CW [Curaçao](#)
CZ [Czech Republic](#)
DZ [Algeria](#)
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EM [European Union](#)
ES [Spain](#)
FR [France](#)
HU [Hungary](#)
KP [Democratic People's Republic of Korea](#)
LI [Liechtenstein](#)
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MG [Madagascar](#)
MK [The former Yugoslav Republic of Macedonia](#)
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MZ [Mozambique](#)
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RO [Romania](#)
ST [Sao Tome and Principe](#)
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SY [Syrian Arab Republic](#)

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GH [Ghana](#)
HR [Croatia](#)
IN [India](#)
IR [Iran \(Islamic Republic of\)](#)
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KG [Kyrgyzstan](#)
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LR [Liberia](#)
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