

HIGHLIGHTS

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September 2012 | No. 3/2012

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Madrid Highlights is a quarterly publication of the World Intellectual Property Organization (WIPO) for the users of the Madrid System for the International Registration of Marks (Madrid system). Comments, suggestions, questions and inquiries regarding subscriptions may be sent to: madrid.highlights@wipo.int.

MADRID UNION

THE MADRID WORKING GROUP

Outcome of the tenth session of the Working Group on the Legal Development of the Madrid System for the International Registration of Marks, held in Geneva, from July 2 to July 6, 2012

The documents discussed by the Madrid Working Group were referred to in the second [issue of the Madrid Highlights](#) and are available on the WIPO website at the following address: http://www.wipo.int/meetings/en/details.jsp?meeting_id=25007

During the tenth session of the Working Group, 49 Contracting Parties to the Madrid Union, eight States with observer status, one International Intergovernmental Organization and 11 international non-governmental organizations were represented. The following documents were discussed:

- document [MM/LD/WG/10/2](#), entitled *Proposed Amendments to the Common Regulations Under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement*. [This text](#) contains proposed amendments to Rules 7, 24 and 40 of the Common Regulations. The Working Group agreed to recommend to the Assembly of the Madrid Union the proposed amendments, as set out in the Annex to the document;
- document [MM/LD/WG/10/3](#), entitled *Information Relating to the Review of the Application of Article 9sexies(1)(b) of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks*. The delegations agreed that Article 9sexies(1)(b) should remain unchanged, pending further review in the future. It was determined that Article 9sexies(1)(b) would be reviewed by the Working Group after a period of three years. However, it was further agreed that any member of the Madrid Union or the International Bureau (IB) might propose an earlier review in the interim;
- document [MM/LD/WG/10/5](#), entitled *Review of the Proposal on Translations Requested by the Madrid Union Assembly*. It was agreed to recommend to the Assembly that it continue to take note of the practices in place concerning translations. It was further agreed to recommend to the Assembly that it should mandate the International Bureau, after a period of three years, or earlier at the request of the Working Group, to undertake a review of those practices;
- document [MM/LD/WG/10/4](#), entitled *Proposal for the Introduction of the Recordal of Division or Merger Concerning an International Registration Before the Office of a Designated Contracting Party*. The *Proposal by Switzerland* contained in document [MM/LD/WG/10/6](#) was also discussed. No consensus was reached among delegates with regard to either of those issues. The Working Group agreed that the International Bureau should prepare a document for further consideration by the Working Group at its next session, which would contain a new proposal on the possible introduction of a mechanism that would allow for the division and merger of international registrations and/or designations under the Madrid system.

Finally, the Working Group approved the *Summary by the Chair*, as contained in document [MM/LD/WG/10/7](#).

OUTCOME OF THE MADRID WORKING GROUP ROUNDTABLE

The second Madrid Working Group Roundtable was held in Geneva, on July 5, 2012.

The event was a success and is fast becoming a regular fixture for the Madrid Working Group, attracting 65 Representatives of Offices of the Madrid Contracting Parties, users' organizations and future or potential members.

The Roundtable provided the perfect opportunity for the International Bureau and Representatives of Offices, intergovernmental organizations and organizations representing trademark holders and agents to share experiences.

The main topics discussed during the Roundtable were the Role of the Office of Origin *Versus* the International Bureau of WIPO (Irregularities and Indications in the List of Goods and Services (Appellations of Origin and Trademarks)), the Role of the Designated Office *Versus* the International Bureau of WIPO (Limitations of the List of Goods and Services and Statements of Grant of Protection) and Licenses. During the session, a large number of participants shared information concerning their national experiences.

The presentations made during the Madrid Working Group Roundtable are available on the [Madrid System Legal Forum](#).

THE MADRID UNION ASSEMBLY

Outcome of the Forty-Fifth (26th Extraordinary) Session of the Madrid Union Assembly, held in Geneva, from October 1 to 9, 2012.

As instructed by the Working Group, the International Bureau of WIPO submitted the following documents to the Assembly of the Madrid Union:

1. *Proposed Amendments to the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement*, as contained in document [MM/A/45/1](#). This document contains three main proposals:

(a) Rule 7: Notification of Certain Special Requirements. Amendment of Rule 7(3)(b), entitled “[*Notification*]”. The Working Group agreed to recommend to the Assembly of the Madrid Union the deletion of the words: “*paragraph (1), as in force before October 4, 2001¹, or*”, as well as the accompanying footnote 1.

(b) Rule 24: Designation Subsequent to the International Registration. Proposal for deletion of Rule 24(2)(a)(i), entitled “[*Presentation; Form and Signature*]”. The Working Group agreed to recommend to the Assembly of the Madrid Union the deletion of this provision of the Common Regulations.

(c) Rule 40: Entry into Force: Transitional Provisions. Proposal for deletion of Rule 40(5), entitled “[*Transitional Provision Relating to Statements of Grant of Protection*]”. The Working Group also agreed to recommend to the Assembly of the Madrid Union the deletion of this provision of the Common Regulations.

The Assembly adopted the amendment of Rules 7(3)(b), 24(2)(a)(i) and 40(5) of the Common Regulations, with a date of entry into force of January 1, 2013, as set out in the Annexes to document [MM/A/45/1](#);

2. *Review of the Proposal on Translations Requested by the Madrid Union Assembly*, as contained in document [MM/A/45/4](#).

The Assembly: (i) continued to take note of the practice of the International Bureau concerning translation upon request of statements of grant of protection, following a provisional refusal, as well as the translation of the list of goods and services affected by a limitation, as hereinbefore described; and (ii) mandated the International Bureau, after a period of three years, or earlier at the request of the Working Group, to undertake a review of said practices in light of the views expressed by delegations and user-organizations in the Working Group, and in light of ongoing developments, including information technology and automated translations.

Finally, the Assembly adopted the Draft Report, as contained in document [MM/A/45/5](#).

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/

CONTRACTING PARTIES

ACCESSION OF NEW ZEALAND TO THE MADRID PROTOCOL

New Zealand became the 88th member of the Madrid Union following the deposit with WIPO of its instrument of accession to the Madrid Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, on September 10, 2012. The Madrid Protocol will enter into force, with respect to New Zealand, on December 10, 2012.

The instrument of accession was accompanied by three declarations:

The first declaration refers to Article 5(2)(b) and (c) of the Madrid Protocol, whereby the time limit of one year for the notification of a provisional refusal of protection is replaced by 18 months, and notification of a provisional refusal resulting from an opposition may be made after the expiry of the 18-month time limit.

The second declaration refers to Article 8(7)(a) of the Madrid Protocol, whereby New Zealand will receive an individual fee where it is mentioned in an international application, or in respect of the renewal of an international registration.

The third declaration refers to the constitutional status of Tokelau. The Government of New Zealand declares that this accession shall not extend to Tokelau unless and until a declaration to this effect is lodged by the Government of New Zealand with the depositary on the basis of appropriate consultation with that territory.

Furthermore, the said instrument of accession was also accompanied by two notifications.

The first notification refers to Rule 7(2) of the Common Regulations, according to which the Government of New Zealand requires a declaration of intent to use the mark. The second notification relates to Rule 20*bis* (6)(a) of the Common Regulations, according to which the recording of trademark licenses in the International Register has no effect in New Zealand.

For more information, see Information Notices [No. 17/2012](#), [No. 18/2012](#) and [No. 19/2012](#).

CHANGE IN THE AMOUNTS OF THE INDIVIDUAL FEE

Colombia

The Government of Colombia has made the declaration referred to in Article 8(7) of the Protocol whereby it wishes to receive an individual fee when Colombia 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 Colombia. This declaration entered into force on August 29, 2012. More information can be found in Information Notice [No. 12/2012](#).

Tajikistan and Australia

The new established amounts of individual fees payable when Tajikistan (September 29, 2012) and/or Australia (October 23, 2012) are designated in an international application, in a designation subsequent to an international registration or in respect of the renewal of an international registration under the Madrid system, can be found in Information Notices [No. 13/2012](#) and [No. 16/2012](#), respectively.

ONLINE SERVICES

CHANGES CONCERNING ROMARIN SEARCH DATABASE

The following two changes have been implemented concerning the ROMARIN database:

- Addition of a search example for each search criteria of the simple search (please see [Simple search](#));
- Addition of an indication of the protection of the international registration in each designated Contracting Party. Get more details by clicking on “All”, “Granted”, “Refusal”, “Final Decision”, or “No Longer Designated” (see [Simple search](#)).

MADRID SYSTEM WEB-BASED SERVICES

The tutorials for Madrid Portfolio Manager (MPM), Madrid Electronic Alert (MEA) and Madrid Real-time Status (MRS) are now available in French and Spanish at <http://www.wipo.int/madrid/fr/services/> and <http://www.wipo.int/madrid/es/services/>, respectively.

MADRID OUTREACH

Regional Seminar on the Madrid System organized by WIPO and ARIPO

A Regional Seminar on the Madrid system was jointly organized by WIPO and the African Regional Intellectual Property Organization (ARIPO) from August 27 to 29, 2012. The Seminar was a great opportunity to reinforce cooperation with ARIPO on trademark related issues, and in

particular, to provide with legal advice on establishing and implementing an adequate legal framework that facilitates ARIPO's possible future accession to the Madrid Protocol.

The 2012 China Trademark Annual Meeting

The Eighth China Trademark Annual Meeting (CTAM 12'), sponsored by the Chinese Trademark Association (CTA) was held in Kunming, the capital city of Yunnan Province of China, from September 3 to 5, 2012. CTAM 12' was convened on the 30th anniversary of the promulgation of the Trademark Law of the People's Republic of China.

The CTAM 12' organized, for the second time, a Roundtable discussion focused on the Madrid system. The objectives of this Roundtable discussion included important issues and challenges related to the further promotion of the Madrid system in China. Excluding the organizers, the Roundtable discussion attendance, included Representatives of WIPO, IP practitioners and IP lawyers and Representatives from national agencies.

26th Annual Conference of MARQUES (Association of European Trade Mark Owners)

The 26th Annual Conference of MARQUES was held in Athens, Greece, September 18 to 21, 2012. The theme of the conference was **Trade Marks: Sign of the Times** and main topics covered from brand ownership to the impact of social media and domain name expansion.

It was a great opportunity for Madrid Representatives to update more than 600 delegates who attended the event, on the latest developments of WIPO services and programs, affecting trademark owners with a focus on THE Madrid International Registration System. Information and documentation on WIPO activities were available during the conference at the WIPO booth located in the exhibition area of the conference.

MADRID TIPS

Goods & Services Manager (G&SM)



From Brand Strategy to Trademark Filing Best Practices

The Madrid System Goods & Services Manager (GSM) has begun its long-anticipated second stage of development with the inclusion of a new function: "Check acceptance by designated Contracting Party (dCP)". When implemented, this function will allow an international applicant to avoid provisional refusals by Contracting Parties designated in the resulting international registration that are related to the indication of goods and services.

As an on-line service designed specifically for use with the Madrid System for the International Registration of Marks, the GSM and the database it accesses must accommodate differences in practice among the Offices of the members of the Madrid Union, as well as meet the needs of trademark owners in filing international applications.

By providing access to a database of goods and services in a number of languages in addition to English, French and Spanish, the working languages of the Madrid system, the GSM allows filers to reduce costs and increase legal certainty with respect to the acceptability and translation of an indication of goods and services in an international application. There are now seven additional languages: Arabic, Dutch, German, Hebrew, Italian, Portuguese and Russian. The International Bureau (IB) is working with interested Contracting Parties to translate the database into even more languages.

At present, the GSM helps applicants avoid irregularity letters issued by the IB that are related to the indication of goods and services. The enhanced version of the GSM will indicate which goods and services are acceptable to a given designated Contracting Party and which are not, thereby allowing an international applicant to draft a limitation with respect to a designated Contracting Party that might otherwise issue a provisional refusal related to the indication of goods and services.

When the “Check Acceptance by dCP” function is selected, those terms in the list of goods and services that are acceptable to a selected Contracting Party will appear in green, those that are not acceptable will appear in red and those for which acceptability is not known, i.e., those for which the selected Contracting Party has not yet checked its acceptance of the good or service, will appear in orange. These differences in acceptability are due, for the most part, to the differing degrees of specificity that the Offices of Contracting Parties require of a description of particular goods and services.

Cost conscious users are encouraged to seriously consider the benefits of using the enhanced GSM as opposed to drafting an indication of goods and services on their own.

USEFUL INFORMATION

NEW EXTENDED CUSTOMER SERVICE HOURS

In order to further improve response times for all our stakeholders, WIPO is now providing a round-the-clock customer service.

From August 14, 2012, onwards, all calls made to the WIPO switchboard (+41 22 338 9111) outside our Geneva working hours (Monday to Friday; 08.00 – 18.00 Central European Time) will automatically be redirected to one of the WIPO external offices in New York, Rio de Janeiro, Singapore and Tokyo. Multilingual staff in those offices will provide first line assistance and will ensure that the inquiry is followed up by the relevant division at our Geneva headquarters.

This round-the-clock service complements the work carried out in Geneva by the dedicated team working for the Customer Service Center, which was launched in October 2010. The Center responds to general questions by telephone or email, receives customer feedback and channels specific enquiries to the most appropriate specialized WIPO information service or individual expert.

A number of other specialized information lines complementing this service are available via the [contact us](#) page on the WIPO website.

Our drive to increase responsiveness to all our customers – including Member States, users of WIPO services and the general public - is among the objectives of the [Strategic Realignment Program](#), which highlights service orientation as one of WIPO's four Core Values.

NEW MADRID MISLEADING INVOICE INTERFACE

Readers should be aware that what would appear to be private business establishments are sending letters to the holders of international registrations, inviting them to pay fees for publishing their marks in publications which seem to be of an official nature, recording them in business directories or similar activities. Some of these establishments use signs similar to the WIPO logo or name, thereby misleading the public as to their source.

Such activities have no legal effect under the Madrid system. All international trademark registrations and related records are published in the [WIPO Gazette of International Marks](#), the only official publication of the Madrid system. All [fees](#) payable under the Madrid system should be paid to the IB directly in Swiss francs or through the Office of Origin. Information on international

applications, international registrations and subsequent designations can be found on the WIPO [ROMARIN](#) international trademark information database, which can be searched free of charge.

If you have any questions about correspondence you have received, please check with your representative or [contact us](#).

Link: <http://www.wipo.int/madrid/en/fees/warning.html>

COOPERATION WITH IP OFFICES

Turkey

The Turkish Patent Institute (TPI) has published a useful document about common irregularities it faces when applying under the Madrid system. The document provides information on how to avoid irregularities and how to use WIPO current accounts to pay fees for Madrid-related operations and the G&S Manager.

Link: http://www.tpe.gov.tr/dosyalar/haber/marka_agustos_2012.pdf.

FORTHCOMING EVENTS

Seminar on the Madrid System for the International Registration of Marks

The forty-seventh session of the Seminar on the Madrid system will take place in Geneva, on November 6 and 7, 2012, with participants from the private sector and Industrial Property Offices of both members and non-members of the Madrid system.

The Madrid Seminar is a training platform where all aspects of the Madrid system are covered in depth. Relevant details will soon be posted on the Madrid web site:

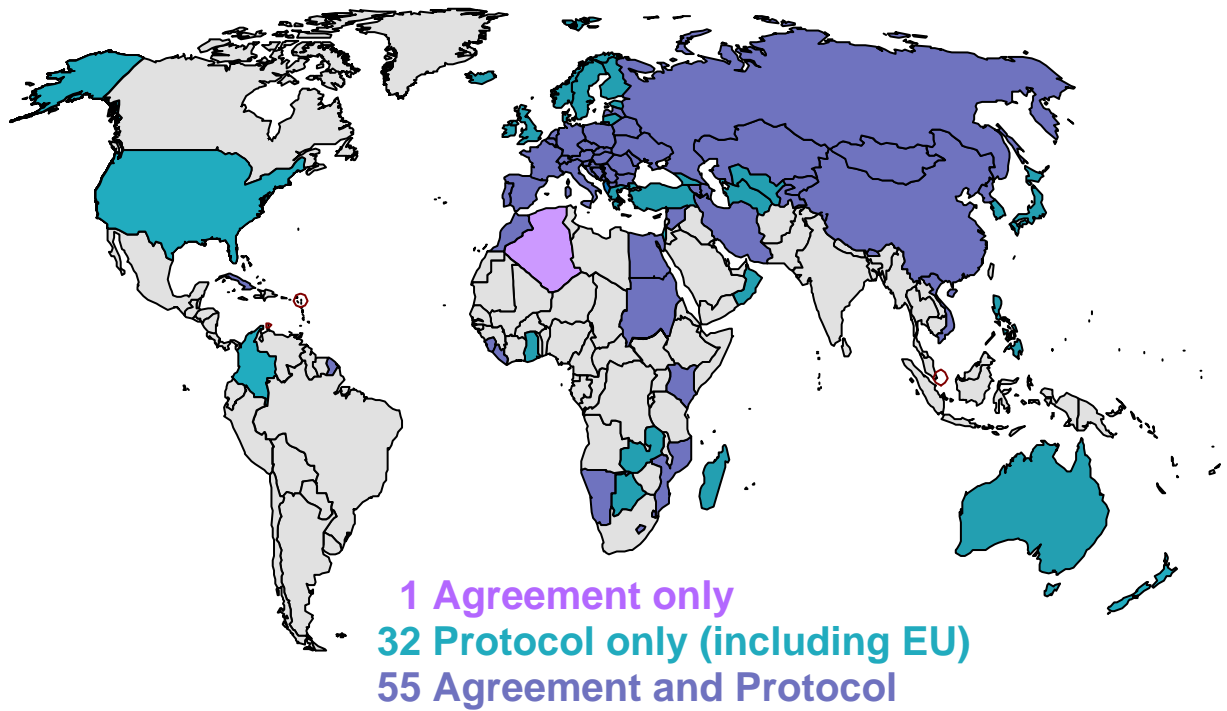
http://www.wipo.int/meetings/en/topic.jsp?group_id=239

WIPO NON-WORKING DAYS IN 2012

Pursuant to Rule 32(2)(v) of the Common Regulations, users are hereby informed that, in addition to Saturdays and Sundays, the days on which the International Bureau of WIPO is not scheduled to be open to the public during 2012 are the following:

- Monday, January 2, 2012 (New Year)
- Friday, April 6, 2012 (Easter)
- Monday, April 9, 2012 (Easter)
- Thursday, May 17, 2012 (Ascension)
- Monday, May 28, 2012 (Whitsun)
- Thursday, September 6, 2012 (Jeûne Genevois)
- Thursday, October 25, 2012 (Eid Al-Adha)
- Tuesday, December 25, 2012 (Christmas)
- Wednesday, December 26, 2012 (Christmas)
- Monday, December 31, 2012 (New Year)

Madrid Union map



88 Members

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