



**WIPO | MADRID**

The International  
Trademark System

# Learning from Common Mistakes by Madrid Users

## Madrid System Webinar

**Geneva  
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2020**

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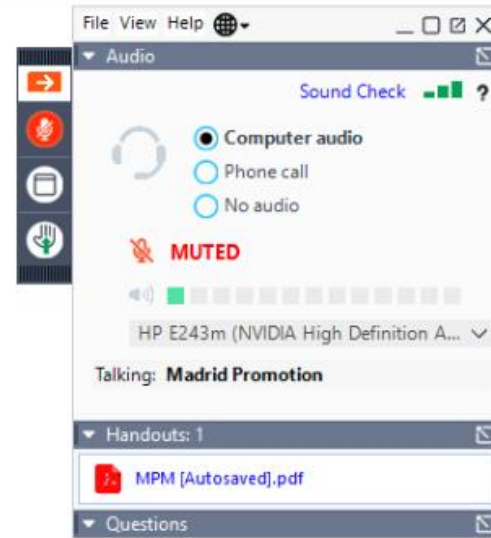
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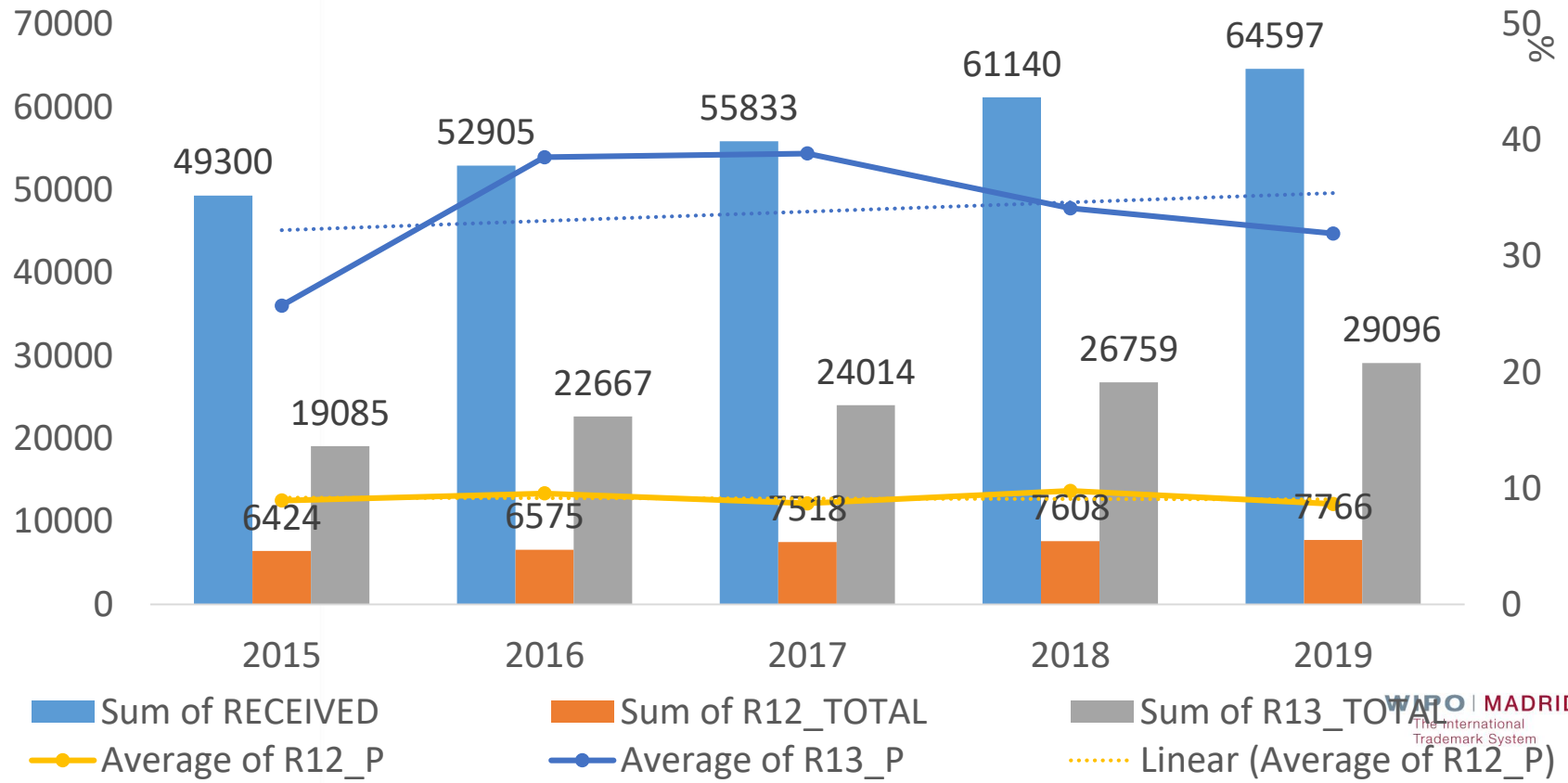
# Structure of the Webinar

- Introduction
- Interactive questions during the webinar
- 3 Types of Irregularities
- More tips
- Questions and answers session at the end
- Presentation slides available for download
- Recording will be uploaded on the Madrid Webinar page
- Short survey to provide feedback

# How to use GoToWebinar

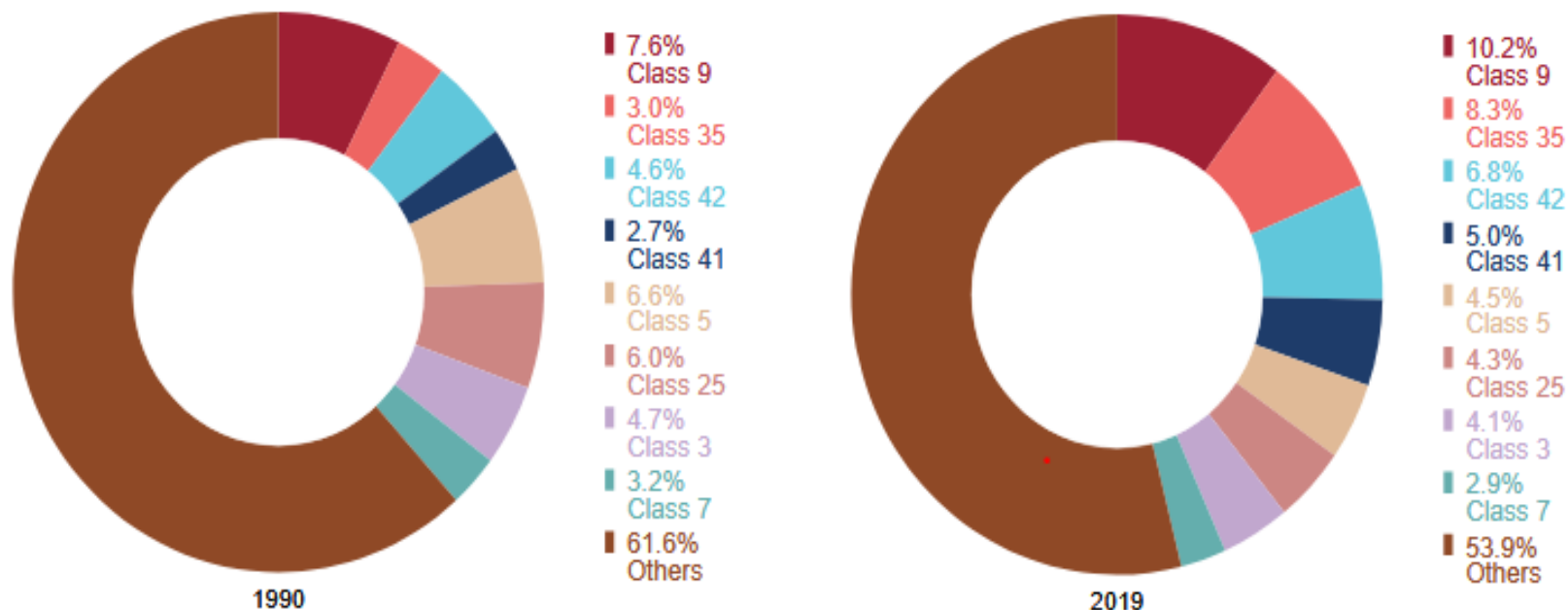


# Overview of Rule 12 and 13



# Introduction

## 4. Top eight Nice classes specified in 2019 Madrid applications, 1990 and 2019



Source: WIPO Statistics Database, March 2020.

<b>Class covers/includes</b>	<b>2019</b>	<b>Growth (%), 2018–2019</b>	<b>Share of total (%), 2019</b>
Class 9: Computer hardware and software and other electrical or electronic apparatus of a scientific nature	15,923	3.5	10.2
Class 35: Services such as office functions, advertising and business management	13,064	7.5	8.3
Class 42: Services provided by, for example, scientific, industrial or technological engineers and computer specialists	10,633	5.7	6.8

Research and technology



# Irregularities

Rule 12

Classification

Rule 13

Indication

Rule 11

Other irregularities



of goods and  
services



# Rule 11

- Irregularities other than those concerning the Classification of Goods and Services or their indication.

# Irregularities (Rule 11) - Procedure

## To be remedied by OO:

- Official form is not used;
- Application is defective;
- Entitlement issues found;
- Date or number of basic application/registration is missing;
- Certification is irregular;
- Signature of the Office is missing;
- Insufficient fees, where Office collects and forwards fees;
- Form MM18 missing.

## To be remedied by the applicant:

- Address is not sufficient for postal delivery;
- Reproduction of the mark is not clear;
- Transliteration of the mark is missing;
- Description of the mark is in a non-working language;
- Insufficient fees, where paid directly by applicant;
- Form MM18 is missing.

# Rule 11 – Common Issues

MM18

DIU

Signature

Date of execution (dd/mm/yyyy)

Signatory's Name (Printed)

Signatory's Title

**INSTRUCTION**

This declaration must be signed by:

- (1) the applicant/holder or a person with legal authority to bind the applicant/holder; or
- (2) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the applicant/holder; or
- (3) an attorney who is authorized to practice before the United States Patent and Trademark Office under 37 C.F.R. §10.1(c), who has an actual written or verbal power of attorney or an implied power of attorney from the applicant/holder.

**INFORMATION REQUIRED BY THE INTERNATIONAL BUREAU**

- (a) Where the present declaration refers to an international application based on a basic application, indicate:  
Basic application number: ..... Date of the basic application: ..... (dd/mm/yyyy), or
  - (b) Where the present declaration refers to an international application based on a basic registration, indicate:  
Basic registration number: ..... Date of the basic registration: ..... (dd/mm/yyyy), or
  - (c) Where the present declaration refers to a subsequent designation of an international registration, indicate:  
International registration number: .....
- International Bureau's reference (where applicable): .....
- Name of applicant/holder: .....

# Rule 11 – Common Issues

## Fees



<https://www.wipo.int/madrid/payment/>

# Proof of Payment

[income.mail@wipo.int](mailto:income.mail@wipo.int)

With the WIPO reference number or basic application or registration number in your e-mail.

# Mandatory payment details

- Payer's name
- \*Payer's complete address
- Application type (EN, EX, RE, etc...)
- Trademark number (Basic registration or Basic Application number for registrations and international registration number for other purpose)
- Trademark name
- Name of the trademark's holder (if different than the payer)

# Rule 11 – Common Issues

## Priority Claim



# Item 6: Priority Claimed

6

## PRIORITY CLAIMED

The applicant claims the priority of the earlier filing mentioned below:

Office of earlier filing: .....

Number of earlier filing (if available): .....

Date of earlier filing: ..... (dd/mm/yyyy)

If the earlier filing does not relate to all the goods and services listed in item 10 of this form, indicate in the space provided below the goods and services to which it does relate:

.....  
.....

If several priorities are claimed, check the box and use a continuation sheet giving the above required information for each priority claimed.

# Second language for the EU

<sup>1</sup> The designation of the **European Union** covers its Member States (Austria, Belgium, Bulgaria, Croatia, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Luxembourg, Malta, The Netherlands, Poland, Portugal, Romania, Slovakia, Slovenia, Spain, Sweden) and, during a transition period, the United Kingdom (for further information, see [Information Notice No. 2/2020](#)).

If the **European Union** is designated, it is compulsory to indicate a second language before the Office of the European Union, among the following (check one box only):  French  German  Italian  Spanish

Moreover, if the applicant wishes to claim the seniority of an earlier mark registered in, or for, a Member State of the European Union, the official form MM17 ~~must be annexed~~ to the present international application.

<sup>2</sup> By designating **Brunei Darussalam, India, Ireland, Lesotho, Malawi, Malaysia, Mozambique, New Zealand, Singapore** or the **United Kingdom**, the applicant declares that he has the intention that the mark ~~will be used~~ by him or with his consent in that country in connection with the goods and services identified in this application.

<sup>3</sup> The designation of the African Intellectual Property Organization (OAPI) covers the following Member States: Benin, Burkina Faso, Cameroon, Central African Republic, Chad, Comoros, Congo, Côte d'Ivoire, Equatorial Guinea, Gabon, Guinea, Guinea-Bissau, Mali, Mauritania, Niger, Senegal, ~~Togo~~.

<sup>4</sup> If the **United States of America** is designated, it is compulsory to annex to the present international application the official form (MM18) containing the declaration of intention to use the mark required by this Contracting Party. Item 2(f) of the present form ~~should also be completed~~.

<sup>5</sup> **Brazil, Cuba** and **Japan** have made a notification under Rule 34(3)(a) of the Regulations under the Protocol. Their respective **individual fees are payable in two parts**. Therefore, if **Brazil, Cuba** or **Japan** is designated, only the first part of the applicable individual fee is payable at the time of filing the present international application. The second part will have to be paid only if the Office of the Contracting Party concerned is satisfied that the mark ~~which is the subject of the international registration~~ qualifies for protection. The date by which the second part ~~must be paid~~, and the amount due, will be notified to the holder of the international registration at a later stage.

<sup>6</sup> Territorial entity previously part of the former Netherlands Antilles.

<sup>7</sup> Protection in BQ (Bonaire, Saint Eustatius and Saba) ~~is granted~~ automatically with the designation (see [Information Notice No. 27/2011](#)).

<sup>8</sup> By designating **Brazil**, the applicant declares that the applicant, or a company controlled by the applicant, effectively and lawfully conducts business in connection with the goods and services for which **Brazil** ~~is being designated~~.

<sup>9</sup> The designation of **Benelux** covers the following States: Belgium, Luxembourg and the Netherlands.

# Second Language missing irregularity

*Provided that the other irregularities raised in this notice are remedied within the applicable time limit, the mark will be registered and the international registration will be notified to EUIPO without the indication of a second language. EUIPO will then issue a provisional refusal of protection based on the ground that this indication is missing.*

*The applicant may however provide the International Bureau with the indication of a second language before EUIPO, **at the latest by the time the other irregularities raised in this notice have been remedied.** In this event, the indication of a second language will be communicated to EUIPO in the notification of the international registration.*

*The second language should, by definition, be **among the following:** French, German, Italian or Spanish.*

# Transliteration

Item 9(a): Transliteration of  
the Mark

D.I.N.Д.И.Н.

Transliterate : DIN.

# Item 9(b): Translation of the Mark



MISCELLANEOUS INDICATIONS



(b) Translation of the mark (as may be required by certain designated Contracting Parties):

(i) into English: "NICOLINE SMALL ITALIAN TAILOR SHOP" .....

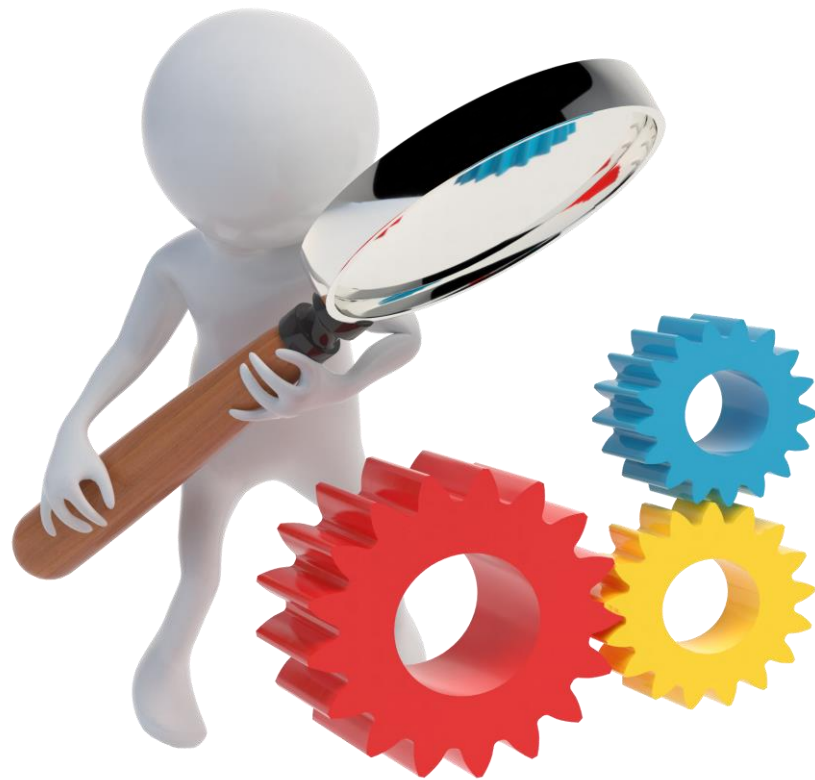
.....

(ii) into French: "NICOLINE PETITE BOUTIQUE DU TAILLEUR ITALIENNE" .....

.....

(iii) into Spanish: "NICOLINE PEQUEÑA SASTRERÍA ITALIANA" .....

.....





# Rule 9

- Rule 9(4)(a)(Xiii) – the goods and services for which international registration of the mark is sought must be grouped in the appropriate classes, with each group being preceded by a class number in the IA



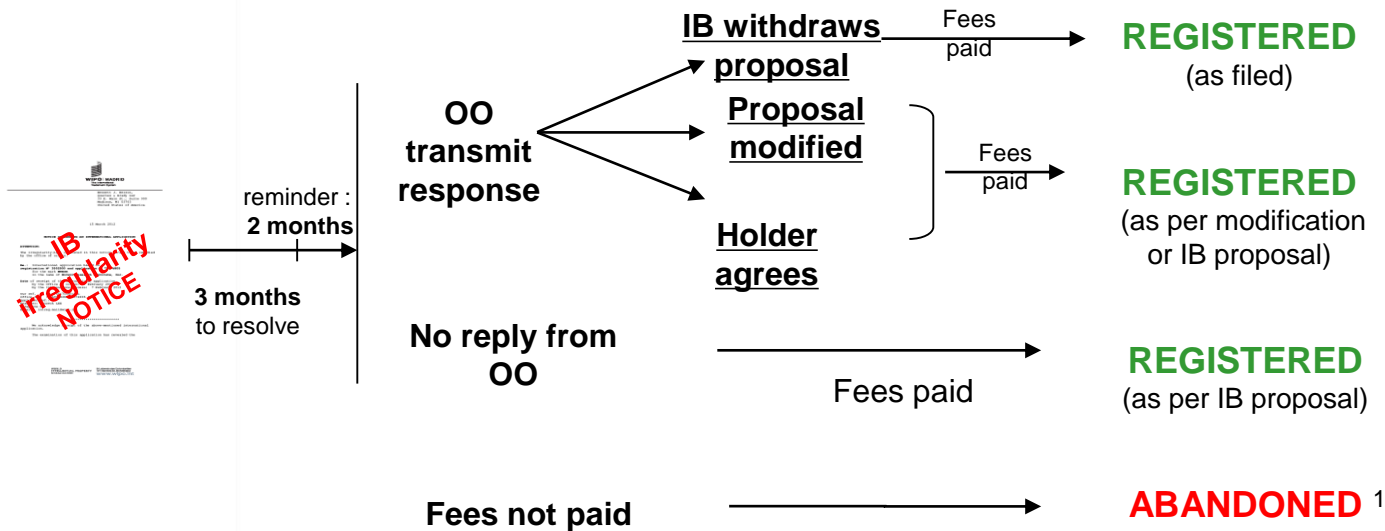
# Rule 12 : Classification of Goods and Services

The IB considers that the G&S should be classified in a different class or have not been classified

■ The IB has the **“last word”**



# Rule 12 : Procedure



<sup>1</sup> Refund: fees paid minus 1/2 basic fee for a b& registration.

# The IB principles – Classification of G&S

- Alphabetical list of the NICE classification
- Explanatory notes to the NICE classification
- The “General remarks” for G&S in the NICE classification
- The class number defines the scope of the product/service (with exceptions)
- Internal guidelines -

[https://www.wipo.int/export/sites/www/madrid/en/docs/2018\\_examination\\_guidelines.pdf](https://www.wipo.int/export/sites/www/madrid/en/docs/2018_examination_guidelines.pdf)

# Rule 12 – reasons you might have received an irregularity

- Goods or services are misclassified in your basic application or registration
- The IA is based on an application not yet examined
- WIPO has different practices to your national office
- Terms are not classified by the most recent NICE edition

# Terms not classified by the most recent NICE edition

- The IB shall register the international applications “with the classifications and grouping that the IB considers to be correct” based on the NICE classification edition and version in force at the time of filing the application.
- For example “inflatable lifeboats” were classified in Class 12 until in the 2019 edition of NICE it was moved to class 9.
- Vending machines – 9<sup>th</sup> edition moved from class 9 to class 7

# Common irregularities

- “cameras for medical purposes” from class 9 to class 10
- "mobile telephone accessory charms" from class 9 to class 26 - see position 260133 "charms, other than for jewelry, key rings or key chains" in Class 26 of the alphabetical list of the International Classification of Goods and Services.



# Common irregularities

- “key rings” from classes 6 and 20 to class 14
- “video games apparatus” from class 9 to class 28
- “low alcohol wine” from class 32 to class 33
- “data storage” from class 35 to class 42

# Common irregularities

- “providing business conferences” from class 35 to 41
- “technical consultancy relating to telecommunication equipment” from 42 to class 38
- “installation and repair of computer hardware” from 42 to 37

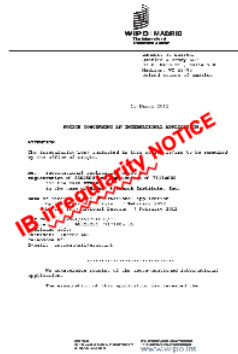
# How to avoid a Rule 12 Irregularity?

- Use MGS to check your terms
- Keep up to date with NICE changes – new edition every 5 years
- Pay attention to irregularities raised to your previous applications
- Know what WIPOs practices are – read our examination guidelines
- Ask us for more information or check with us if a suggestion is acceptable

# Irregularities concerning the Indication of G/S

- Rule 13(1) - where the IB considers that the indication used in the list of G/S is too vague for classification purposes, is incomprehensible, or is linguistically incorrect, the IB will notify the OO and at the same time inform the applicant.

# Rule 13 : Procedure



3 months  
to resolve

OO transmit  
response

IB accepts

**REGISTERED**  
(as per proposal)

IB rejects

**REGISTERED**  
(as filed but with notation)

No reply from OO

**REGISTERED**  
(as filed but with notation)

# Rule 13 – reasons you might receive an irregularity

- WIPO considers the term “too vague” for the purposes of classification
- Terms are incomprehensible or linguistically incorrect
- Your term was approved in a different database but not MGS
- WIPO has different practices to your national office
- The punctuation in your list is unclear

# The punctuation is unclear

- Separate terms with a semi-colon
- Within the same term, use commas

Examples -

Class 35 – Retail and wholesale of shoes; clothes; hats.

Class 35 – Retail and wholesale of shoes, clothes, hats.

Class 16 – Envelopes; scissors: paper.

Class 16 – Envelopes; scissors; paper.

# Class 9

- “artificial intelligence apparatus” – TV
- “semiconductor memory cartridges being computer programmes” – TV
- “hand-held electronic devices”; “e-book devices” – TV
- “electronic automatic ticket examination machines” – TV
- “coin-operated gates for cark parking facilities” – TV



# Class 9

- Classes 29 and 30 - “prepared foods”; “snack foods”; “foods containing sugar” - TV
- Class 35 – “design of advertising materials” – TV
- Class 40 – “manufacturing services” – TV
- Class 41 – “providing of downloadable publications” – TV
- Class 43 – “providing a database in the field of recipes and cooking information” - TV

# Class 42

- “computer consultancy” - TV
- “computer services” – TV
- “IT services” - TV
- “technical consultancy” – TV
- “research and development services” - TV

# Class 42

- providing a web site that gives users the ability to upload photographs“ – TV
- “online non-downloadable cloud computing software” – TV
- “providing software for financial purposes” – TV

# Terms are incomprehensible or linguistically incorrect

- Term is in a language other than the language of the application
- The term does not make sense linguistically
- Examiners cannot make changes to your list

- Class 9 - “recorded compact disc of music” – TC
- “electric pocket translators” – TC
- “the computer” – TC
- “meter characteristics of electric” – TI
- Class 4 - “lubricating oils being hydraulic oils” – TI

# Ways to avoid R13 irregularities

- Check your terms in MGS
- Learn from your previous applications
- Check your list carefully
- Be familiar with the WIPO examination guidelines
- Ask us if you have questions

# More Classification Tips

# Kits – acceptable specifications

## ■ According to purpose:

- “cosmetic kits” in Class 3
- “first-aid kits” in Class 5
- hands free kits for cell phones in Class 9
- “craft kits for painting” in Class 16

## ■ By their composition:

- “kits comprised of fabrics for making quilts” in Class 24
- “dental care kits comprising toothbrushes and floss” in Class 21



“emergency auto kits comprised of a hand-held spotlight and battery charger” in class 9

# Specifications containing “sold as a unit”

- Specifications containing “sold as a unit”
- Actual claim:
  - “computer software and instruction manuals sold as a unit” (class 9)
- Acceptable:
  - «computer game software and manuals in electronic format sold as a unit” (class 9)

- The term “accessories” is not acceptable in class 12 and 25 without specification as the scope is broad and the associated G&S could belong to other classes
- “parts and fittings” in lists should be qualified with the goods they are intended for e.g. “parts and fittings for vehicles” in a given class.

How about this?

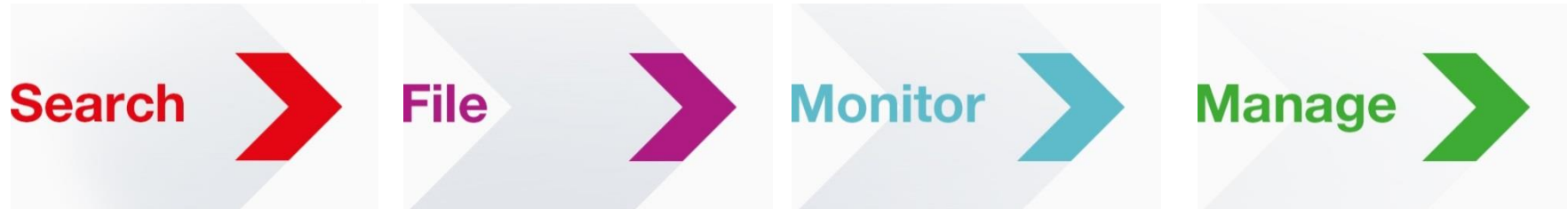
«Parts and fittings all included in this class» in class 12

# Face masks?

9	Protective industrial face masks	10	Reusable sanitary masks for protection against viral infection	25	Fashion masks being ski masks
9	Protective industrial face shields	10	Sanitary masks for dental use	25	Knit face masks being headwear
9	Protective industrial respirators	10	Sanitary masks for fungus isolation purposes		
9	Protective industrial respiratory masks	10	Sanitary masks for pollen isolation purposes		
9	Respirators for the prevention of accident or injury	10	Sanitary masks for protection against viral infection		
9	Respiratory masks for the prevention of accident or injury	10	Sanitary masks for virus isolation purposes		
9	Respiratory masks for the prevention of accident or injury	10	Sanitary masks made of cloth for protection against viral infection		

# Online Resources and E-Services

- Madrid e-services are available to assist you at each stage of your mark's lifecycle



# File



## Madrid Goods & Services Manager

Compile the list of goods and services you want covered by your registration



## Member Profiles Database

Learn about trademark rules and procedures of Madrid System members



## Fee Calculator

Estimate the cost of your international trademark registration



## Q&A Session about the Webinar



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# COVID-19: Communications with WIPO

- Resumption of postal communications from WIPO
  - For more efficient communication, please provide an email address via [Contact Madrid](#).
- For more information, visit:
  - the [Madrid Member Profiles Database](#)
  - [WIPO's COVID-19 IP Policy Tracker](#)
  - our [dedicated Madrid webpage](#)



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