FICPI 17th Open Forum
5.2: International IP Rights: Tips and tricks for international trade mark applications
5.2: International IP Rights

As the world economy becomes ever more interconnected, trade mark owners need to protect their intellectual property on a global scale. Practitioners therefore need to be aware of issues involved in protecting their clients’ IP on an international scale. IP rights traditionally have been bound by national borders, but international treaties such as the Madrid Protocol have made protecting IP rights in multiple jurisdictions much easier.
5.2: International IP Rights

This session will examine the tools available to practitioners for protecting their clients’ IP globally and will offer some practical tips and tricks for navigating the international trade mark application landscape.
Àsta Valdimarsdóttir

Director – Madrid Registry, Brands & Designs
WIPO
Switzerland
Shunji Sato

Partner
TMI Associate
Japan
Leigh A. Walters

Partner
Sim & McBurney
Canada
Example

- I am filing an international application through the Finnish Patent and Registration Office as follows:
  
  - Mark:

  - Classes: 3, 11, 21, 41 and 44
  - Countries: China, Japan and the United States of America
  - For now I do not want protection in classes 5 and 9 in Japan. Then, I would like to limit the protection of class 3 to “beauty masks” for all countries and “online retail store services featuring cosmetics and dietary supplements” in class 35 in USA.
“Tips and tricks”
International Trademark Applications

FICPI, Venice, October 2017
Support for applicants

The Madrid System website and customized E-services are available to help you:

- Search before filing
- File an application
- Monitor your progress
- Manage your registration
Search

Access 28+ million records from 35 national and international collections

Check if similar marks already exist in your target markets

Start with the Global Brand Database
Global Brand Database

Perform a trademark search by text or image in brand data from multiple national and international sources, including trademarks, appellations of origin and official emblems. V: 2016-10-12 12:50

Data from Spain available
Over 740,000 records added

Data from Mongolia available
Over 15,000 records added

Data from Malaysia available
Over 456,000 records added

Data from Jordan available
Over 58,000 records added

Data from Georgia available
Over 26,000 records added

SEARCH BY

Brand
Names
Numbers
Dates
Class
Country

Text
- e.g. wipo OR omni; "intel", "omni-

Image Class
- e.g. 05,07,13, apple AND tree

Goods (All)
- e.g. footwear, comput

FILTER BY

Source
Image
Status
Origin
App. Year
Expiration

OE TM
39,540
42,436
1,541,149
42,436
1,541,149

CH TM
375,662
284,267
1,884,199
284,267
1,884,199

EE TM
65,636
1,989,638
108,441
1,989,638

GE TM
27,733
254,167
611,878
254,167
611,878

JO TM
61,490
72,468
1,926,320
72,468
1,926,320

MT TM
135,386
15,917
37,219
15,917
37,219

Display:
List
Sort
Value - asc

1 - 30 / 27,438,567
TMNew

1

Table columns: Source, Status, Origin, Holder, Number, App. Date, Image Class, Nice Cl.,
File

Member Profiles Database

- Classification Guidelines
- Madrid Goods & Services Manager

Fee Calculator
Compare trademark rules & examination procedures in the IP Offices of Madrid System members

- General information
- Filing rules and procedures
- Domestic rules and procedures
Information Is Key

Users benefit from access to comprehensive information on how the Madrid System is implemented in Member states

- Does the Office accept application fees on behalf of WIPO?
- Special requirements, i.e. declaration of intention to use the mark in that Member state, Seniority claim or Second part fees? (MM18, MM17)
- What is the provisional refusal period for a given Member state?
Madrid Member Profiles

Access a wide range of information on the practices and procedures of Madrid System members. Simply select the member(s) of interest to you, and choose the type of information you want to see.

Step 1: Which member(s) are you interested in?
- All members
- African Intellectual Property Organization (OAPI)
- Albania
- Algeria
- Antigua and Barbuda
- Armenia
- Australia
- Austria
- Azerbaijan
- Bahrain
- Belarus
- Benelux

Step 2: What type(s) of information are you looking for?
- All available information
- General information and contact details
- Information about your Office of Origin
- Information about members you are designating

Resources
- FAQs
- News
<table>
<thead>
<tr>
<th>Step 1: Which member(s) are you interested in?</th>
</tr>
</thead>
</table>
| ☐ China
| ☐ People's Republic of Korea
| ☐ Denmark
| ☐ Egypt
| ☐ Estonia
| ☐ European Union
| ☐ Finland
| ☐ France
| ☐ Gambia
| ☐ Georgia
| ☐ Germany
| ☐ Ghana
| ☐ Greece
| ☐ Hungary
| ☐ Iceland
| ☐ India |

<table>
<thead>
<tr>
<th>Step 2: What type(s) of information are you looking for?</th>
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<tbody>
<tr>
<td>☐ All available information</td>
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<tr>
<td>☐ General information and contact details ↑</td>
</tr>
<tr>
<td>☐ Contact information</td>
</tr>
<tr>
<td>☐ Membership in Madrid Union, date of entry into force</td>
</tr>
<tr>
<td>☐ Declarations and notifications made by Contracting Party</td>
</tr>
<tr>
<td>☐ Laws on trademarks</td>
</tr>
<tr>
<td>☐ Requests for cancellation of registration due to non-use of mark</td>
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<tr>
<th>Information about your Office of Origin ↑</th>
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<tbody>
<tr>
<td>☐ Methods of filing international application</td>
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<tr>
<td>☐ Filing language</td>
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<tr>
<td>☐ Handling fee. Option to pay Madrid System fees through Office</td>
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<tr>
<th>Information about members you are designating ↑</th>
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<tr>
<td>☐ When Designating ↑</td>
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<tr>
<td>☐ Examination before the Office ↓</td>
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<td>☐ Provisional Refusals (ex officio) ↓</td>
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<td>☐ Oppositions ↓</td>
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<td>☐ Third Party Observations ↓</td>
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<td>☐ Interim Status ↓</td>
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<tr>
<td>☐ Types of trademarks that can be protected</td>
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<tr>
<td>☐ Requirements for representation of mark</td>
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<tr>
<td>☐ Additional requirements for protection of collective, certification and guarantee marks</td>
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<td>☐ Information on classification practices</td>
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<tr>
<td>☐ Information on databases of acceptable terms for classification of goods &amp; services</td>
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<td>☐ Requirement of intention to use, and form in which such intention must be submitted (where applicable)</td>
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<tr>
<td>☐ Requirement to provide description of mark containing non-standard characters</td>
</tr>
<tr>
<td>☐ Specific requirements to protect mark via the Madrid System</td>
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</table>
Madrid Member Profiles

Results

Summary

- Finland
  - General information and contact details
  - Information about your Office of Origin
    - Information about members you are designating
    - When Designating

Finland

General information and contact details

Contact Information

Name of Office: Finnish Patent and Registration Office
Address: P.O. Box 1140, FI-00101 Helsinki, Finland
Phone number: +358 29 509 5000
e-mail: registry@ph.fi
Fax: +358 29 509 6328
Website: www.ph.fi
Opening hours: Monday – Friday, 9.00 am to 4.15 pm.

Contract for questions related to international registrations: Patricia Nyberg
Email: tmi.intreg@ph.fi
Phone number: +358 9 6939 5257

Membership in Madrid Union, date of entry into force

Treaty: Madrid Agreement
Entry into force: 1 April 1996

Declarations and notifications made by Contracting Party

- Extension of refusal period to 18 months (Article 5(2)(b) of the Protocol)
- Possible notification of refusal based on opposition, after 18-month time limit (Article 5(2)(c) of the Protocol)
Classification Guidelines

- Purpose - to decrease the number of irregular international applications
- Describes the classification practices in the International Bureau
- Practical information on the acceptable format to list indications of goods and services
Madrid Goods & Services Manager

- Database with a collection of acceptable terms for goods and services
- Over 93,500 acceptable terms in English
- French, Spanish and 15 additional languages
- Fully aligned with the Nice 11th edition
- “Check acceptance features” for 28 Member states and Canada
- Coding system to facilitate searches “similar groups codes” for Japan and Republic of Korea
Compile and verify your list of goods and services
Functions

- **BROWSE** per class to select goods and services from a “pick-list” of terms pre-accepted by WIPO

- **SEARCH** acceptable terms using keywords

- **CHECK ACCEPTANCE** of terms:
  - by WIPO (free-text)
  - by a designated Contracting Party/Member state
Display of **Acceptance / Rejection**

Check acceptance by designated Contracting Party (dCP)

- AT Austria
- BX Benelux
- BY Belarus
- CH Switzerland
- CN China
- CO Colombia
- DE Germany
- DK Denmark
- EE Estonia
- EM European Union
- FI Finland
- GB United Kingdom
- IL Israel
- IT Italy

Select all
Remove all

- JP Japan
- KR Republic of Korea
- MN Mongolia
- MX Mexico
- NO Norway
- NZ New Zealand
- PT Portugal
- RS Republic of Serbia
- RU Russian Federation
- SE Sweden
- SG Singapore
- TR Turkey
- UA Ukraine
- US United States of America

Under USPTO policy, square brackets should not be used in the identifications of goods or services. If square brackets are used in a listing of basic goods/services or a limitation thereof, a provisional refusal will be issued by USPTO examining attorneys.

For terms as rejected by the USA in M3, please consult the USPTO ID Manual for acceptable wording: [https://tmidm.uspto.gov](https://tmidm.uspto.gov)
Display of **Acceptance** / **Rejection**

**Specificity of terms**

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<td>knives [parts of machines]</td>
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<td>070226</td>
<td>saw blades [parts of machines]</td>
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<td>sifting installations</td>
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<td>disintegrators</td>
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<td>070026</td>
<td>mixing machines</td>
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<td>070150</td>
<td>machines and machine tools</td>
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<td>070450</td>
<td>heat exchangers [parts of machines]</td>
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<td></td>
<td></td>
<td></td>
<td></td>
<td>070480</td>
<td>rotary steam presses, portable, for fabrics</td>
</tr>
</tbody>
</table>
You may limit the list of G&S in respect of one or more Member states

10 GOODS AND SERVICES

You can find indications that are pre-accepted by the International Bureau in the Madrid Goods & Services Manager (MGS) at www.wipo.int/mgs/. By using these indications you can avoid possible irregularities concerning the classification of goods and services and a delay in the recording of the international registration.

Please make consistent use of a semicolon (;) to clearly specify the goods and services indications in your list, e.g.: 09 Scientific, optical and electronic apparatus and instruments; screens for photoengraving; computers. 35 Advertising; compilation of statistics; commercial information agencies.

Please use font “Courier New” or “Times New Roman”, size 12 pt, or above.

(a) Indicate below the goods and services for which the international registration is sought:

<table>
<thead>
<tr>
<th>Class</th>
<th>Goods and services</th>
</tr>
</thead>
<tbody>
<tr>
<td>Class 7:</td>
<td>Knives [parts of machines]; saw blades [parts of machines]; machines and machine tools; sifting installations; disintegrators; mixing machines; heat exchangers [parts of machines]; rotary steam presses, portable, for fabrics.</td>
</tr>
</tbody>
</table>

(b) ☒ The applicant wishes to limit the list of goods and services in respect of one or more designated Contracting Parties, as follows:

<table>
<thead>
<tr>
<th>Contracting Party</th>
<th>Class(es) or list of goods and services for which protection is sought in this Contracting Party</th>
</tr>
</thead>
<tbody>
<tr>
<td>United States of America</td>
<td>Class 7: Disintegrators; mixing machines; rotary steam presses, portable, for fabrics.</td>
</tr>
<tr>
<td>Republic of Korea</td>
<td>Class 7: Knives [parts of machines]; saw blades [parts of machines]; sifting installations; mixing machines; heat exchangers [parts of machines]; rotary steam presses, portable, for fabrics.</td>
</tr>
</tbody>
</table>
Fee Calculation

- Structure of fee (Swiss francs):
  - Basic fee of 653 Swiss francs or 903 Swiss francs (reproduction of the mark in color)
  - Supplementary fee for classes beyond 3 = 100 Swiss francs per class
  - Complementary fee for each designated states
    - Standard 100 Swiss francs
    - Individual fees
Madrid Fee Calculator

- Before filing an application, the Fee Calculator should be used to obtain an estimate of the amount of fees payable.

- Users should be reminded of the disclaimer.

**Disclaimer:** Fee Calculator results are based on information you have provided and the Schedule of Fees in effect at the time the estimate is generated. The estimate is provided for information purposes only. For the most accurate estimate, consult the Fee Calculator immediately before you submit a request or your payment order.
Example

- I am filing an international application through the Finnish Patent and Registration Office as follows:

  - Mark:

  - Classes: 3, 11, 21, 41 and 44
  - Countries: China, Japan and the United States of America
  - For now I do not want protection in classes 5 and 9 in Japan. Then, I would like to limit the protection of class 3 to “beauty masks” for all countries and “online retail store services featuring cosmetics and dietary supplements” in class 35 in USA.
Select the date on which you will submit the application to the Finnish Patent and Registration Office.

Select the total number of classes of the new application.

Tick the designated Contracting Parties.

Tick: Colour
<table>
<thead>
<tr>
<th>Country</th>
<th>Individual Fee (International Application)</th>
<th>Individual Fee Per Additional Class (International Application)</th>
</tr>
</thead>
<tbody>
<tr>
<td>Japan</td>
<td>$108 (First Part)</td>
<td>$164 (Number of classes beyond the first)</td>
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<td>This may be subject to the payment of a second part of the individual fee which can be estimated separately by clicking here</td>
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<td>Please note that the designation of Japan may be subject of the payment of a second part of the individual fee</td>
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<td>Total: Swiss francs (CHF)</td>
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</table>
Learn more about fees in the Madrid System

- Estimate your fees: Fee Calculator
  (http://www.wipo.int/madrid/en/fees/calculator.jsp)

- Payment methods, where to submit fees and payment
  follow-up (http://www.wipo.int/about-wipo/en/finance/madrid.html)
Applications and other forms submitted through National Offices

- MM2 “Application for international registration” and ;
- MM17 “Claim of Seniority (European Union)”
- MM18 “Declaration of intention to use the mark (United States of America)”
- MM16: “Subsequent Designation resulting from Conversion”

through the EUIPO
Certification by the Office of Origin

13 CERTIFICATION AND SIGNATURE OF THE INTERNATIONAL APPLICATION BY THE OFFICE OF ORIGIN

(a) Certification
The Office of origin certifies

(i) that the request to present this application was received on ___________________________ (dd/mm/yyyy).

(ii) that the applicant named in item 2 is the same as the applicant named in the basic application or the holder named in the basic registration mentioned in item 5, as the case may be.

(iii) that any indication given in item 7(d), 9(d) or 9(e) appears also in the basic application or the basic registration, as the case may be.

(iv) that the mark in item 7(a) is the same as in the basic application or the basic registration, as the case may be.

(v) that, if color is claimed as a distinctive feature of the mark in the basic application or the basic registration, the same claim is included in item 8 or that, if color is claimed in item 8 without having being claimed in the basic application or basic registration, the mark in the basic application or basic registration is in fact in the color or combination of colors claimed, and

(vi) that the goods and services listed in item 10 are covered by the list of goods and services appearing in the basic application or basic registration, as the case may be.

Where the international application is based on two or more basic applications or basic registrations, the above declaration shall be deemed to apply to all those basic applications or basic registrations.

(b) Name of the Office: ________________________________________________________________

(c) Name and signature of the official signing on behalf of the Office:

By signing this form, I declare that I am entitled to sign it under the applicable law:

__________________________________________________________________________________

(d) Name and e-mail address of the contact person in the Office: ________________________________
Date of the International Registration *

- Receipt of the international application by the OO
  - 2 months
  - Receipt of the international application by the IB
  - Receipt by the IB of the last missing element
  - *
Forms or questions from users

- Starting **November 1** the Contact Madrid online service will replace intreg.mail@wipo.int

- Madrid Operational Team email accounts will be discontinued as of December 15

- The new Contact Madrid service is accessible under the “**Contacts** section of the Madrid homepage or visit [www.wipo.int/madrid/en/contact](http://www.wipo.int/madrid/en/contact) to access the form directly
Contact Madrid

WIPO

Home | IP Services | Madrid System

Madrid System – Contact Us

Use this form to make an enquiry or to submit a form/response to WIPO. To get started, choose the relevant answer below.

Please note: Before selecting “Submit”, you must provide an answer for all fields (except for “optional” fields).

I am:
- a trademark holder or representative
- from an IP office
- any other interested party

I’m contacting you to:
- ask a question
- submit a form (e.g. MMO2 - application for an international registration
- submit a response to an irregularity letter
- submit a decision (refusal, interim status, final decision, opposition, grant of protection, further decision, invalidation)

Please enter a reference number (International Registration Number, WIPO reference, basic application or registration number):

Please select the form you would like to submit:
- MMO2 - Application for international registration

Please upload the completed form here:

Choose File No file chosen
Thank you for your attention