

Managing and Maintaining Protection Through the Madrid System

Lucy Headington-Horton
Senior Legal Officer

(Lucy.headington-horton@wipo.int)

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The International Trademark Registration Process



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Role of a representative

- As a representative you may be instructed to:
 - Represent a holder (based in Guernsey) before WIPO
 - Represent holders of international registrations (based overseas) before the Guernsey IP Office

Representative before WIPO

- Advise clients of all options for protection
- Assist in registering the basic mark, and preparing the international application
- Receive all communications concerning the IR including notifications of refusal
- Advise the holder of all deadlines and instruct overseas representatives if required
- Request subsequent designations, record changes, and request renewal.

Representative before the Guernsey IP Office

- Receive instructions from holders that have designated Guernsey or holders that require “pre-designation” advice
 - Assist holders in overcoming/avoiding provisional refusals.
- Advise on the law and practice in Guernsey
- Monitor third party marks and advise of possible oppositions, invalidation actions etc

Appointment/change representative

- The holder may appoint a representative, or change (replace) an existing recorded representative in most Official forms or by using an MM12
- It is possible to change the name/address of the **recorded** representative by using Form MM10
- Use Contact Madrid to update email address/telephone number, or to remove a representative

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Effects of an international registration (IR)

- From the date of the IR, the protection of the mark in each of the designated Contracting Parties is the same as if the mark had been **filed and registered directly** with the Office of that Contracting Party, providing that **no refusal** is notified within the applicable time limit

The Office of the designated Contracting Party

- The Office examines the international mark in accordance with its domestic legislation and will issue:
 - Provisional refusal*
 - Statement of grant of protection*
 - Final decision
 - Further decision
 - Invalidation

**before the expiry of the refusal period (12-18 months)*

Principle of *Tacit Acceptance*

“If no refusal has been notified to the International Bureau in accordance with Article 5(1) and (2) ... the protection of the mark in the Contracting Party concerned shall, as from the said date, be the same as if the mark had been registered by the Office of that Contracting Party”

Statement of grant of protection

- **All** procedures before the Office are completed
- No grounds to refuse and **total** protection is granted to the mark
- The Office should send this as soon as possible (before the expiry of the refusal period)

– STATEMENT OF GRANT OF PROTECTION

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Rule 18ter(1)

I.	Sending OFFICE : NORWEGIAN INDUSTRIAL PROPERTY OFFICE Sandakerveien 64, 0484 Oslo PO Box 8160 Dep., 0033 Oslo Phone: +47 22 38 73 00 Fax: + 47 22 38 73 01
II.	International registration number : 0834601
III.	Holder: Husumer Mineralbrunnen HMB GmbH & Co. KG
IV.	Mark Reproduction : HIGH SPEED
V.	Protection is granted to the mark that is the subject of this international registration for all the goods and/or services requested.
VI.	Official sign or seal of sending office : <div style="display: flex; align-items: center; justify-content: center;"> <div style="text-align: center;"> <p>patent trademark design</p> <p>Norwegian Industrial</p> <p>Property Office</p> </div>  </div>
VII.	Date : 01.03.2019

Provisional refusal

- Fixed time limit for refusal: 12/18/18+ months
- Notification of provisional refusal must be sent to WIPO
- Can be partial or total refusal, following *ex officio* examination/opposition
- Based on grounds in domestic legislation
 - Must include a time limit and calculation of time limits
- The holder may contest the refusal in accordance with the law of the designated CP (use of attorney, language etc.)

Possible ways to overcome refusals

- Carefully read the provisional refusal (total or partial)
- The refusal will be in the language of the Office (E/F/S)
- Check the grounds, the time limit, can you contest it?
- Will the Office proceed with a limited scope if you do not reply?
- Can you limit the list of goods/services directly with WIPO (form MM6)?
- Is division (via Office of the dCP) possible?
 - Non-refused goods are granted protection (while the refused part is still being contested). Possibility of merger?

THE PROTOCOL RELATING TO THE MADRID AGREEMENT
CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

EX OFFICIO PROVISIONAL TOTAL REFUSAL

notified to the International Bureau of the World Intellectual Property Organization (WIPO) according to
Art. 5 of the Madrid Protocol

I. Office refusing protection:

Finnish Patent and Registration Office
Trademarks
FI-00091 PRH
Telephone: +358-29-509 5000
Telefax: +358-29-509 5328

II. Number of the international registration which is the subject of the refusal: 1487739

III. Other information concerning the international registration which is subject of the refusal:

glasssix

IV. The grounds for this refusal are the following:

The trademark is in respect of all of the goods in class 9 liable to be confused with the following EU trademark application, if it leads to registration: GLASSIX; application number 16993636, applied for identical and similar kinds of goods in class 9. (The enclosed information of the EU trademark application is a printout from eSearch plus (EUIPO's Database)).

V. Provisions of the Finnish Trademarks Act applicable on the subject (enclosed):

Art. 13

VI. Total refusal.

VII. The holder of the registration may request a review of the refusal. The request shall be received by the Finnish Patent and Registration Office no later than within 2 months from the date of the refusal. **The time limit expires 16.12.2019 (dd.mm.yyyy).**
Please use the following reference number when submitting the request: W201900929
The request can be submitted through our electronic service at <https://epalvelut.prh.fi/tmposti>.
The request is to be drawn up in Finnish or Swedish. If the holder of the international registration is not a

resident of the European Economic Area, the request has to be filed through the intermediary of a representative resident in the European Economic Area (Art. 28 paragraph 6).

If the holder of the registration has not within the time limit given above requested for the review, the registration shall not take effect in Finland for the goods/services which are affected by the refusal (Art. 92 paragraph 4).

If the holder of the international registration has failed to submit a response to the refusal by the time limit, the holder may ask for a continued processing of the registration. The request for continued processing has to be filed within two months from the time limit. Within those 2 months the holder must also pay a fee of 100 € and submit arguments for overcoming the obstacles reported in the refusal (Art. 22).

If the grounds for this refusal include EU trademarks, EU trademark applications or international registrations designating Finland or the European Union, they can remain as grounds for refusal also in cases where they are transformed into national applications or, specifically in the case of designations concerning the European Union, the designations are transformed either into designations concerning Finland or into EU trademark applications, and the said applications or designations are ultimately accepted.

Please note that if the designation is accepted subsequent to review or appeal an opposition may be filed against the mark within 2 months of the publication of the mark (Art. 32).

Oppositions may be filed after the end of the 18-month period (Art. 5(2)(c)(i) of the Madrid Protocol, Rule 16(1) of the Common Regulations).

VIII. Date on which the refusal was pronounced: 16.10.2019 (dd.mm.yyyy)

IX. Signature of the Office: 16.10.2019 Finnish Patent and Registration Office

Noora Laine
Legal Officer
+358295095535

This document has been electronically signed.

PROTOCOLO DE MADRID

**COMUNICACIÓN DE DENEGACIÓN PROVISIONAL
DE PROTECCIÓN BASADA EN UNA OPOSICIÓN**

Conforme al artículo 5 del Protocolo de Madrid y la Regla 17.1 del Reglamento Común del Arreglo De Madrid relativo al Registro Internacional de Marcas y del Protocolo Concerniente a ese Arreglo.

- I. Oficina que realiza la notificación:**
Colombia. Superintendencia de Industria y Comercio
Carrera 13 No. 27 - 00, Pisos. 3, 4, 5, 6, 7 y 10
Horario de Atención al Público: lunes a viernes de
8:00 a.m. a 4:30 p.m.
Conmutador: (57 1) 587 00 00 Fax: (57 1) 587 02 84
Contact center: (571) 592 04 00
- II. Número de registro internacional: 1487739**
Marca glasssix (Mixta)
Glasssix technology (Beijing) co., LTD No. 101, 1st
Floor, Building 21, No. 130, Liangjiadian, Haidian
District 100095 Beijing (CN)
- III. Denegación provisional basada en:**
Denegación provisional basada en oposición que
afecta la (s) siguiente (s) clase (s):
Cl. 9 : Chips (circuitos integrados); chips
electrónicos; dispositivos de control remoto;
reguladores (eléctricos); sensores; tableros de control
(electricidad); instrumentos estereoscópicos; circuitos
integrados; alarmas.
- IV. Disposiciones fundamentales de la legislación aplicable:**
Confundibilidad Marca
- V. Información de la marca en conflicto:**
Marca GLASSING (Nominativa)
Número de registro: SD2016/0039715
Fecha de presentación: 24/10/2016

Fecha de prioridad:

Vigencia: 02/05/2027

Productos/Servicios:

Cl. 9 : Artículos de óptica; bolsas para gafas; cadenas para gafas y gafas de sol; cadenas y cordones para gafas de sol; cordones para gafas; estuches para gafas y gafas de sol; estuches para lentes de contacto; filtros ópticos; gafas antideslumbrantes; gafas de deporte; gafas de sol; gafas inteligentes; gafas [óptica]; lentes de contacto; lentes ópticas; lentes para gafas; lentes para gafas de sol; monturas de gafas de sol; monturas de gafas y gafas de sol; monturas de metal y plástico combinados para gafas; partes y accesorios de gafas.

Titular:

WILLIAM DANIEL ZULUAGA GÓMEZ Calle 53
No. 50 B - 19 EL SANTUARIO (CO)

Apoderado:

MILENA MEJIA OSORIO CRA. 13A No. 28-38
Ofc. 230 Mz 2 Parque Bavaria BOGOTÁ (CO)

- VI. Plazo para solicitar la revisión de la denegación provisional:**
30 días laborales en Colombia desde el 20/11/2019
- VII. Fecha de notificación de la denegación provisional:**
20/11/2019
- VIII. Autoridad ante la cual se solicita la revisión de la denegación provisional:**
Superintendencia de Industria y Comercio
- IX. Firma de la oficina que realiza la notificación:**



DIRECTOR (A) DE SIGNOS DISTINTIVOS

Nota informativa: Todos los documentos que se presenten ante la Superintendencia de Industria y Comercio deberán ser redactados en

Protection after a notification of provisional refusal (final decision)

- If the Office has issued a provisional refusal, **after all** procedures are completed, it will need to send WIPO a final decision either:
 - Granting total or partial protection (clearly indicating the goods/services protected)
 - Confirming a total provisional refusal
- The Office may also notify WIPO of further decision and invalidation

Further decisions

- Where a further decision has been taken (after a grant of protection, final decision or tacit acceptance) that affects the scope of protection and the Office is aware of that decision, it will need to notify WIPO.
- The further decision must indicate the scope of protection (increase or decrease in protection)

Invalidations

- The effects of an IR are invalidated (goods and services are cancelled or revoked)
- The decision is final and **not** subject to appeal

Centralized management of rights

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Centralized management

- Subsequent Designations
- Recording Changes (holder's name, changes in ownership etc)
- Restrictions (limitation, renunciation and cancellation)
- Renewal

Subsequent designation

- Add territories to an existing IR
- Request can be made using Online Subsequent Designation or form MM4 (directly to WIPO)
- Goods and services must be within the scope of the IR
- Certain requirements for certain designated CPs
- The Office will issue decisions on the scope of protection (grant of protection/provisional refusal) within the applicable time limit (12 or 18 months)
- Same lifetime cycle (renewal) as the IR

Date of the subsequent designation

- Direct request to WIPO: the date it was received by WIPO
- Request presented through an Office: the date it was received by the Office, provided that WIPO received it within **two months** from that date
- Where the subsequent designation contains a request that it take effect immediately after some other event: the date of the recording of that other event (one day after)
- Irregularities may effect the date of subsequent designation

Recording Changes to the International Registration

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Recording of changes to the IR

- Main rule: the Office is to **take note** of the changes
 - Renewal and non-renewal, change in name, address, renunciation, cancellation etc.
- Exceptions:
 - The Office may issue a declaration that a change in ownership or limitation has no effect in their territory.

Changes in the holder's name etc.

- Changes concerning the holder:
 - Name and/or address
 - Legal nature where the holder is a legal entity
- Submit form MM9 directly to WIPO (150 CHF per form)
- WIPO will publish the change and notify all dCP's

Change in ownership (MM5)

- Total or partial change in ownership (Form MM5 177 CHF per IR)
- New owner must be entitled to own an international registration
- WIPO will only check formalities (no evidence should be submitted), record and notify the CPs concerned
- The effects of the recording – matter of domestic laws
- Designated CPs can declare that the change has no effect (WIPO will record the declaration)

Restrictions in the protection of the IR (limitations, renunciations and cancellations)

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Limitation of goods and services

- Reduce the list of goods/services for **all** or **some** of the designated CPs in the IR
- Goods and services are not «deleted» from the international registration
- Request (using form MM6 or Online Limitation) can be made directly with WIPO (fee of CHF 177CHF)
- The effects of the recording – matter of domestic laws
- Offices can issue a declaration that the limitation has no effect in their territory

Renunciation

- To abandon the effects of the IR for **one or some** of the designated CPs (**not all**)
- Request (using form MM7) can be made directly with WIPO (no fee)
- No impact on the goods and services

Cancellation

- To cancel the effects of an IR for all or some of the G&S in respect of all the designated CPs (partial or total)
- Request (using form MM8) can be made directly to WIPO (no fee)
- Goods and services **permanently** removed from IR

Limitation, renunciation and cancellation

	Limitation (MM6)	Renunciation (MM7)	Cancellation (MM8)
Goods & Services	Some	All	Some or All
Designated Offices	Some or All	Some	All
Subsequent Designations	✓	✓	✗
Fees	177 CHF	Free of charge	Free of charge

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Renewal of an international registration

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Term of protection of an IR and renewal

- An IR is effected for 10 years, from the date of the IR
- An IR may be renewed for a period of 10 years from the expiry of the preceding period, by the payment of the relevant fees (basic fee + complementary and supplementary and/or individual fees)
- Request for renewal (using form MM4 or Online Renewal) can be made directly to WIPO.

Renewal procedure

- **Unofficial** notice of expiry 6 months before expiry of the 10 year period
- Fees are due 3 months before the date of expiry at the earliest at the date of expiry at the latest, 6 months grace period (+ 50% basic fee)
- When the fees are paid, the renewal is recorded on the exact date on which the renewal of the IR is due

Renewal procedure

- The IR is renewed as it is recorded in the International Register
- No changes can be made as part of the renewal (name or address, goods or services, subsequent designations) except where the holder wishes to renew only some of the dCP's.
- The scope of protection is as indicated by the dCPs in a final or further decision
- If a dCP has issued a total refusal, the holder may still renew but they must renew all the classes for that CP concerned (may be useful if there are ongoing appeal proceedings)

Transformation and Replacement

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Transformation

- Where the IR is cancelled due to ceasing of effect of the basic mark, the holder can use transformation
- Holder must file a national/regional application before the concerned Office for continued protection
- Time limit: Within 3 months from the date of recording of cancellation in the International Register
- Preserves acquired rights
- No WIPO procedure
- Need to follow domestic requirements: Actual process subject to national laws, regulations and practices

Replacement

- Both registrations must be in the name of the same holder
- Protection of the IR extends to the said CP
- G&S in the national registration are listed in the IR
 - Partial replacement is possible
- Replacement will happen automatically
- Holder may request the designated CP to take note of the IR
- The Office shall notify WIPO where it has taken note
- WIPO will record the fact in the International Register



Photo: WIPO/Berrod

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