

FICPI 17th Open Forum

17TH OPEN FORUM | VENICE 25-28 October 2017

ACTING FOR THE IP PROFESSION WORLDWIDE WWW.FICPI.ORG



5.2: International IP Rights: Tips and tricks for international trade mark applications

17TH OPEN FORUM | VENICE 25-28 October 2017



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



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.



Paula Sailas

Moderator



Partner Berggren OY Finland

5



Àsta Valdimarsdóttir



Director – Madrid Registry, Brands & Designs WIPO Switzerland

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Sandra Epp Ryan



Partner Hamre, Schumann, Mueller & Larson, P.C. USA

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Shunji Sato



Partner TMI Associate Japan

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Lena Shen



Partner Beijing Sanyou Intellectual Property Agency Ltd. China

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Leigh A. Walters



Partner Sim & McBurney Canada

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- 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

Ásta Valdimarsdóttir Director, Operations Division Madrid Registry WIPO

Support for applicants

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





Search



Access 28+ million records from 35 national and international collections

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

from Spain available 740,000 records added	2016-10-11	Data from Mongolia available Over 15,000 records added	2016-08-10	Data from Malaysia available Over 450,000 records added	Data from Jordan available Over 58,000 records added	Data from Georgia available Over 26,000 records added	2016-04 NEWS (availa Over 2	

SEARCH BY	Brand	Names Numbers Dates Class Country	_	FILTER BY	Y Source Im	age Status O	rigin Ap	op. Year × Ex	piration ×	
Text	= 🔻	e.g. wipo OR ompi, *ntel*, ompi~		AE TM	39,540 AU	TM 1,541,149	BN TM	42,435 C	A TM 1,478,729	· ·
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				MA TM	135,386 MD	TM 37,219	MN TM	15,917 M	IX TM 1,141,868	
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1 - 30 / 27,438,507	TMview 🖉		Display: 30 - per page options 🗰				I (1	/ 914,617 🕟 🕞		
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SLIMMIX	EM TM	Pending	EM	Hankintatukku Arno Latvus Oy	015911852	2016-10-11		5		
TERNIMAX	EM TM	Pending	EM	Hankintatukku Arno Latvus Oy	015911861	2016-10-11		5		
TRYPTOMAX	EM TM	Pending	EM	Hankintatukku Arno Latvus Oy	015911878	2016-10-11		5		
UBICAPS	EM TM	Pending	EM	Hankintatukku Arno Latvus Oy	015911894	2016-10-11		5		
SERRAFLEX	EM TM	Pending	EM	Hankintatukku Arno Latvus Oy	015911845	2016-10-11		5		
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WAKABANGA	EM TM	Pending	EM		015911811	2016-10-11		35		NA
INVNT CHALLENGE EVERYTHING	ЕМ ТМ	Pending	EM	INVNT LLC	015911829	2016-10-11		35, 41, 42	(₽₹	tion Sys





Member Profiles Database

- Classification Guidelines
- Madrid Goods & Services
 Manager



Fee Calculator



Member Profiles Database

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

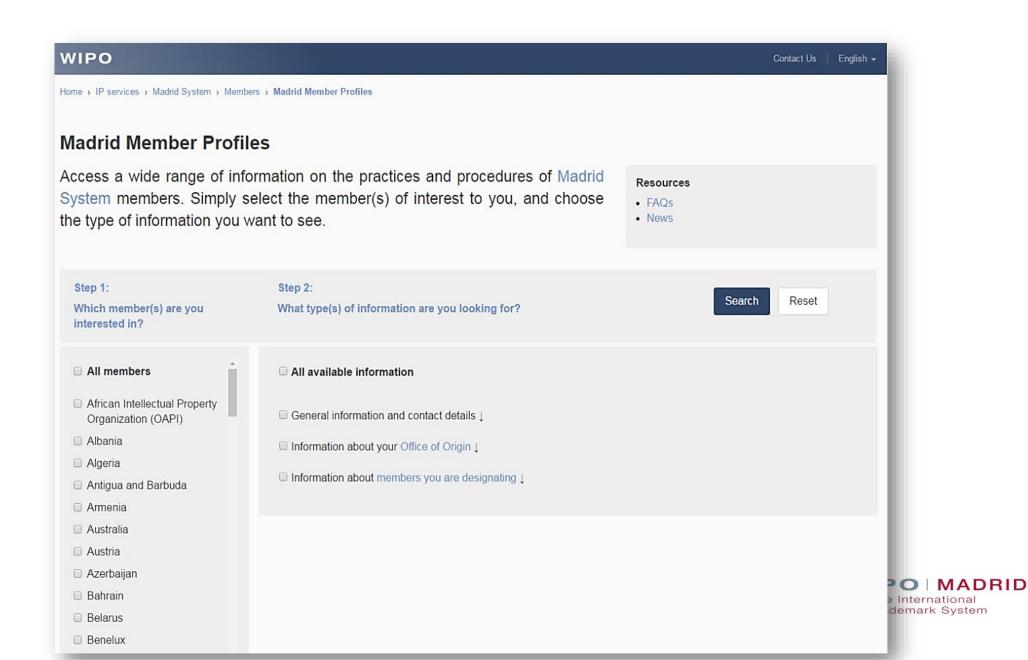
General information

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?



Step 1:

Which member(s) are you interested in?

Republic of Korea	~	All available information					
🔲 Denmark							
Egypt		General information and contact	details	↑			
🔲 Estonia		Contact information					
European Union		Membership in Madrid Union,	date of	f entry into force			
Finland	=	Declarations and notifications		-			
France		Laws on trademarks					
🔲 Gambia		Requests for cancellation of response of the second sec	egistrat	ion due to non-use of mark			
🔲 Georgia		Information about your Office of C	rigin *				
Cermany							
🔲 Ghana		Methods of filing international application					
Greece		Filing language Handling fee . Option to pay M	Andrid !	System fees through Office			
Hungary			iaunu v	System lees through Olice			
Iceland		Information about members you a	ire desi	ignating ↑			
🔲 India		When Designating	î	Types of trademarks that can be protected			
	*			Requirements for representation of mark			
		Examination before the	Ļ	Additional requirements for protection of collective, certification and			
		Office		guarantee marks			
		Provisional Refusals (ex	4	 Information on classification practices Information on databases of acceptable terms for classification of goods & 			
		officio)		services			
		Oppositions	Ļ	Requirement of intention to use, and form in which such intention must be submitted (where applicable)	A		
		Third Party Observations	Ļ	Requirement to provide description of mark containing non-standard characters	ona vst		
		Interim Status	Ļ	Specific requirements to protect mark via the Madrid System			

Madrid Member Profiles

Results

New search Edit search Summary Finland General information and contact details Information about your Office of Origin Information about members you are designating When Designating force

Save as PDF Finland Last update on : May 18, 2017 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 email: registry@prh.fi Fax: +358 29 509 5328 Website: www.prh.fi Opening hours: Monday - Friday, 9.00 am. to 4:15 pm. Contact for questions related to international registrations: Patricia Nyberg Email: tml.intreg@prh.fi Phone number: +358 9 6939 5257 Membership in Madrid Treaty: Madrid Agreement Union, date of entry into Entry into force: 1 April 1996 Declarations and Declarations and notifications: notifications made by Contracting Party . Extension of refusal period to 18 months (Article 5(2)(b) of the Protocol) **1ADRID** · Possible notification of refusal based on opposition, after system 18-month time limit (Article 5(2)(c) of the Protocol)

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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

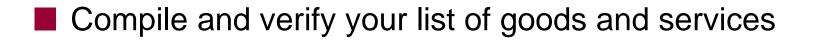
MADRID

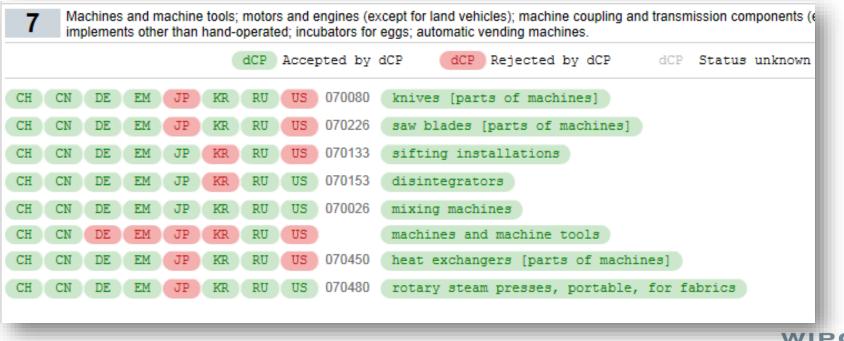
Madrid Goods & Services Manager

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I	✓ ===
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- 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

Madrid Goods & Services Manager







WIPO | MADRID The International Trademark System

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





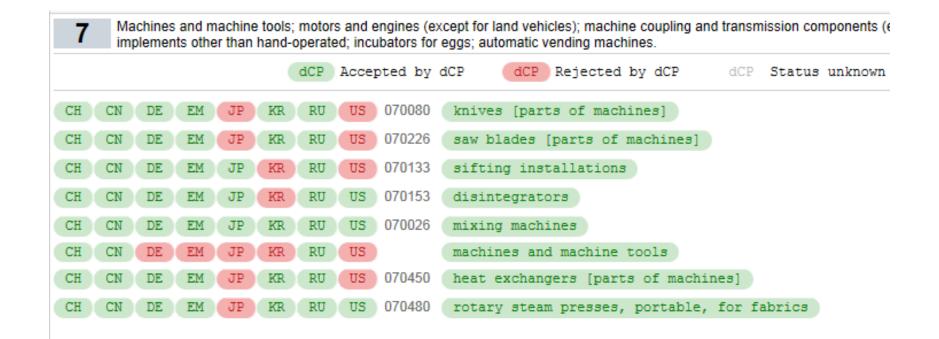


Display of Acceptance / Rejection

AT Austria JP Japan BX Benelux KR Republic of Korea BY Belarus MN Mongolia CH Switzerland MX Mexico CN China NO Norway CO Colombia NZ New Zealand DE Germany PT Portugal DK Denmark RS Republic of Serbia EE Estonia V RU Russian Federation FI Finland SG Singapore GB United Kingdom TR Turkey IL Israel UA Ukraine IT Italy V US United States of America	emove all	
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GB United Kingdom TR Turkey IL Israel UA Ukraine	EM European Union	SE Sweden
IL Israel UA Ukraine	FI Finland	SG Singapore
	GB United Kingdom	TR Turkey
IT Italy US United States of Ame	IL Israel	UA Ukraine
	IT Italy	US United States of America
nder USPTO policy, square brackets should not be used in the entifications of goods or services. If square brackets are used ting of basic goods/services or a limitation thereof, a provision fusal will be issued by USPTO examining attorneys.	entifications of goods or servi ting of basic goods/services of	ces. If square brackets are used in a or a limitation thereof, a provisional
or terms shown as rejected by the USA in MGS, please consult SPTO ID Manual for acceptable wording: <u>https://tmidm.uspto.g</u>		

Display of Acceptance / Rejection

Specificity of terms



WIPO | MADRID The International Trademark System

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 <u>www.wipo.int/mgs/</u>. 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:

Class		Goods and services
Class 7:	and machine to	of machines]; saw blades [parts of machines]; machines ools; sifting installations; disintegrators; mixing t exchangers [parts of machines]; rotary steam presses, abrics.
(b) 🔀 The applicar	nt wishes to limit t he list of go	oods and services in respect of one or more designated Contracting Parties, as follows:
Contracting	Party	Class(es) or list of goods and services for which protection is sought in this Contracting Party
Unites States	ofAmerica	Class 7: Disintegrators; mixing machines; rotary steam presses, portable, for fabrics.
Republic of K	orea	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.

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
 <u>http://www.wipo.int/madrid/en/madridgazette/remarks/ind_taxes.</u>
 <u>html</u>)

Madrid Fee Calculator

Before filing an application, the <u>Fee Calculator</u> 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:



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.

	International Re	gistration of Mark	ks - Fee Calculati	on	
Select the date o	For date: 31.	10.2017 Cffice of origin:	Finland	•	
which you will sub					
the application to	Number of classes: 5	туре:	New applicat	ion 💌	
Finnish Patent an					
Register the tota	AG Antigua and Barbuda	EE Estonia	LA Lao People's Democratic Republic	RU Russian Federation	ion
classes of the	AL Albania	EG Egypt	LI Liechtenstein	RVV Rwanda	
	AM Armenia	EM European Union		SD Sudan	
artie	AT Austria	E \$ Spain	LR Liberia	SE Sweden	
a	AU Australia	FR France	L S Lesotho	SG Singapore	
L	AZ Azerbaijan	GB United Kingdom	LT Lithuania	si Siovenia	
D	-	-	LV Latvia		
	BA Bosnia and Herzegovina	GE Georgia	MA Morocco	SK Slovakla	
THE REAL PROPERTY AND A DECEMBER OF A DECEMBER	BG Bulgaria	GH Ghana	MC Monaco	SL Sierra Leone	
go	BH Bahrain	GM Gambia	MD Republic of Moldova	SM San Marino	
	BN Brunel Darussalam	GR Greece	-	ST Sao Tome and Principe	
5		HR Croatia	ME Montenegro	SX Sint Maarten (Dutch	
Contracting	BQ Bonaire, Sint Eustatius and Saba	HU Hungary	MG Madagascar	part)	
Ğ	BT Bhutan	IE Ireland	MK The former Yugoslav Republic of Macedonia	SY Syrian Arab Republic	
	BVV Botswana	IL Israel	MN Mongolia	SZ Swaziland	
<u>S</u>		IN India		TJ Tajikistan	
Ite	BX Benelux		MX Mexico	TM Turkmenistan	
Ja	BY Belarus	IR Islamic Republic of Iran	MZ Mozambique	TN Tunisia	
	CH Switzerland	IS Iceland	NA Namibia	TR Turkey	
	CN China	IT Italy	NO Norway	UA Ukraine	
S	CD Colombia	JP Japan	NZ New Zealand	U S United States of	
designated	CU Cuba	KE Kenya	OA African Intellectual	America	
	CVV Curaçao	KG Kyrgyzstan	Property Organization (OAPI)	UZ Uzbekistan	
ck the	CY Cyprus	KH Cambodia	OM Oman	VN Viet Nam	
t -	CZ Czech Republic	KP Democratic People's	PH Philippines	ZM Zambla	
	DE Germany	Republic of Korea	PL Poland	ZVV Zimbabwe	
U		KR Republic of Korea	PT Portugal	L ZVV ZINUSOWE	
i -	DK Denmark	KZ Kazakhstan	RO Romania		
	DZ Algeria		R\$ Serbla		
	Colour	Collective mark, certification	mark, or guarantee mark		
	Tick: Colour				
	Select All	Clear All	Contin	we	

WIPO | MADRID The International Trademark System

Basic fee where any reproduction of the mark is in color :	903	
China		
Individual fee (international application):	249	
Individual fee per additional class (international application): 4 💌 x 125.00 (Number of classes beyond first)	the 500	
Japan		
Individual fee (first part):	108	
Individual fee / supplementary fee (first part): 2 🔹 🗙 x 82.00 (Number of classes beyond the first)	164	
This may be subject of the payment of a second part of the individual fee which can be estimated separately by clicking here	t	
Unit Please note that the designation of Japan may be subject of the payment of a second part of the individual fee		
Individual fee (international application):	388	
Individual fee per additional class (international application): 4 💌 x 388.00 (Number of classes beyond first)	the 1552	
TOTAL: Swiss francs (CHF)	Total amount in 3864 MAD national k System	
	francs (CHF)	

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 (<u>http://www.wipo.int/about-</u>

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)"

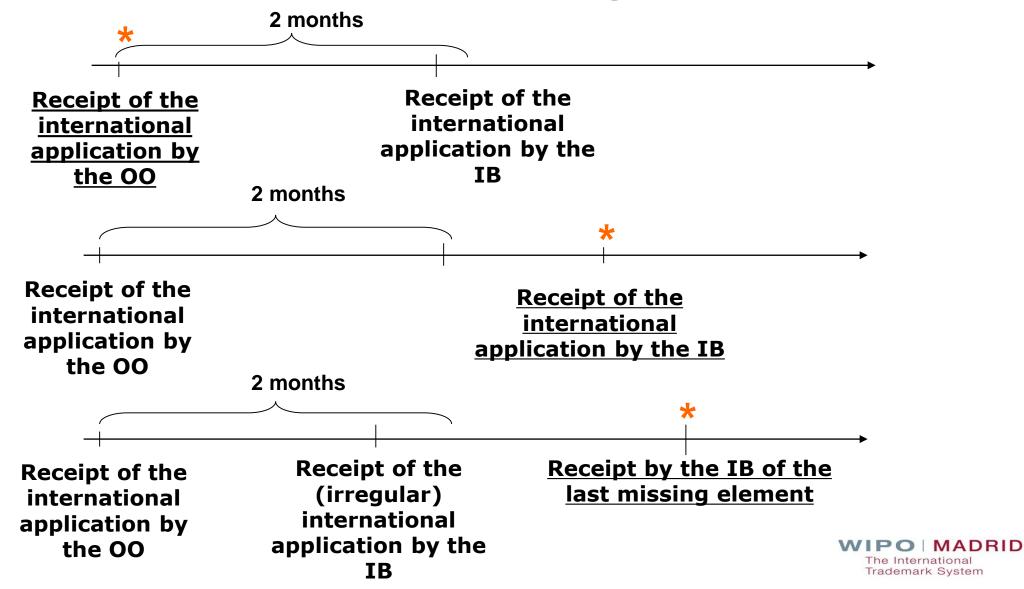
MM16: "Subsequent Designation resulting from Conversion"

through the EUIPO

Certification by the Office of Origin

ERTIFICATION AND SIGNATURE OF THE INTERNATIONAL APPLICATION BY THE OFFICE OF ORIGIN
) 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, 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, that the mark in item 7(a) is the same as in the basic application or the basic registration, as the case may be, that, if color is claimed as a distinctive feature of the mark in the basic application or the basic registration, the same claim is include 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, the mark in the basic application of colors claimed, and 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 or basic registration or basic application or basic applicat
Where the international application is based on two or more basic applications or basic registrations, the above declaration shall be deeme to apply to all those basic applications or basic registrations.
) Name of the Office:
) Name of the Office.
) 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:
Name and a mail address of the contact person in the Office:
l) Name and e-mail address of the contact person in the Office:

Date of the International Registration *



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 "<u>Contacts</u>" section of the Madrid homepage or visit <u>www.wipo.int/madrid/en/contact</u> to access the form directly

Contact Madrid

WIPO	
lome > IP Services > Ma	drid 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: o a trademark holder or representative of from an IP office of any other Interested party
	i'm contacting you to:
	 submit a form (e.g. MIM2 - 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)
	Ex. IRN: 0577545, WIPO Reference: 1102300301, East application/registration: UK00001234567
	Please select the form you would like to submit:
	MM2 - Application for international registration
	Madrid forms are available at: http://www.wpp.intimadridien/formalindes.jap For Renewals and Subsequent designations, we encourage you to use our e-renewal and e-subsequent designations tools.
	Please upload the completed form here:
	Choose File No file chosen

Thank you for your attention

