

## Trademark Information Tools: How to Make the Most of Madrid E-Services

Regional Meeting of Intellectual Property Office Officials Responsible for the Madrid System

Sara Amini Project Officer Madrid Registry Tokyo, December 13 and 14, 2016

## Madrid E-Services: Supporting User throughout the Lifecycle of the Mark

Online services accessible through Madrid System website, with functions organized according to trademark life cycle:

- Search
- File
- Monitor
- Manage



#### SEARCH

You want to know whether a mark similar to yours exists in the markets where you want to obtain protection for mark

Search the Global Brand Database

You have registered your mark with WIPO and want to search for information and updates on your mark

Use Madrid Monitor



#### GLOBAL BRAND DATABASE

- The applicant searches the Global Brand Database before filing a trademark application, or to simply browse marks in markets of interest to them
  - ☐ It is the first step in researching whether a mark similar or identical to theirs already exists
- Global Brand Database is the gateway to more than 27,630,000 records from 35 national and international collections, and growing
  - □ Includes Madrid Members (such as Japan, Singapore and Republic of Korea), but also countries that are not yet party to the Madrid System (such as Canada)

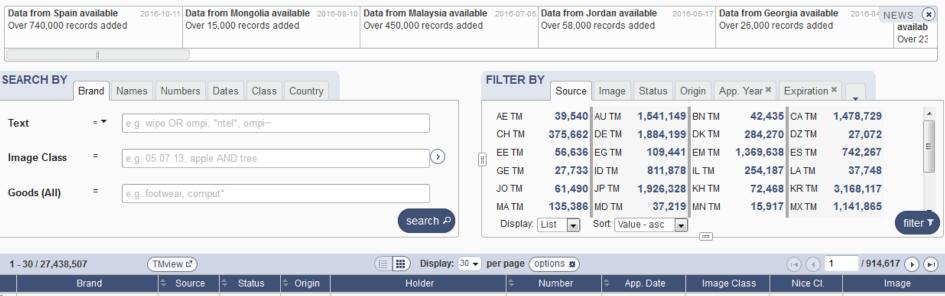


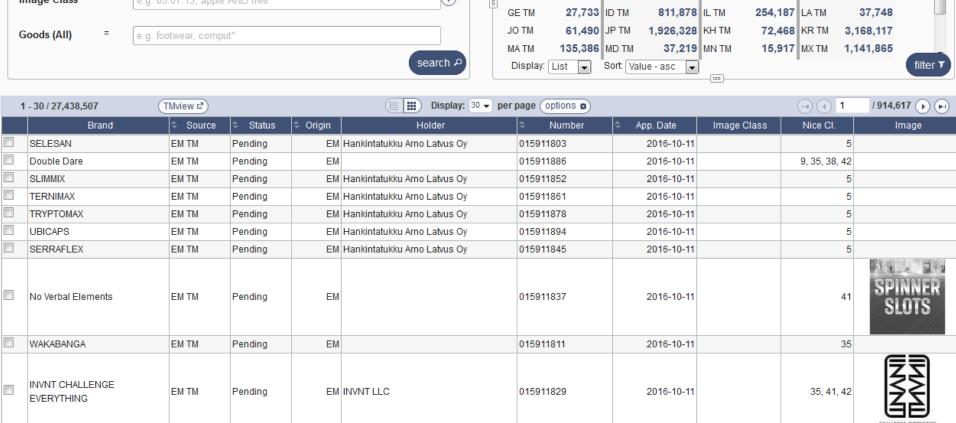
Home Reference

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





#### HOW OFFICES GET INVOLVED

- WIPO is committed to providing assistance to member states to integrate their data into the Global Brand Database
  - ☐ Provide data, and WIPO does the rest
- Continuing improvement in cutting-edge search technologies – at no cost
  - Dedicated, customized individual search interface, if requested



#### FILE

#### Use Madrid Goods and Services Manager

to compile the classes for which you will seek protection for your mark

#### Use the Fee Calculator

to get an estimate of your application fees

#### Prepare your Form MM2

to submit for filing to your Office of Origin



#### What is MGS?



- On-line tool for compiling lists of goods and services
- Includes:
  - The Nice Classification Alphabetical List
  - ☐ Frequent terms from the Madrid International Register
  - □ Terms from other databases (e.g. TM5 ID-list, USPTO Manual, TMclass ...)
- Over 86,000 English terms acceptable by the IB (Sept.2016)



## MGS - Languages



#### ■ 18 languages available as of April 2016:

Arabic,	Hebrew,	Portuguese,
Chinese,	Italian,	Russian,
Dutch,	Japanese,	Serbian,
English,	Korean,	Spanish,
French,	Mongolian,	Turkish,
German,	Norwegian,	Ukrainian.



#### MGS 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 (dCP)





#### MGS Functions

- TRANSLATE into any of various available languages
  - □ National filing: when an applicant does not speak the national language, e.g. French → Russian
  - □ International filing: when the national language is not a Madrid-filing language, e.g. Korean → English

Trademark System

- PRINT lists in any chosen language
- EXPORT / IMPORT lists of terms to save and re-use later, in any chosen language

#### MGS - Exclusive features

#### **User-friendliness**

- NICE indications are clearly identified Name 20 pillows
- One-click to
  - ☐ limitation of results to NICE indications ☐ NICE only
  - □ a selected class
  - translation
- Clear identification of all classes containing results 13 results in class(es)
- Print or translate lists in a format directly usable for filing



## MGS – Exclusive features Display of Acceptance / Rejection

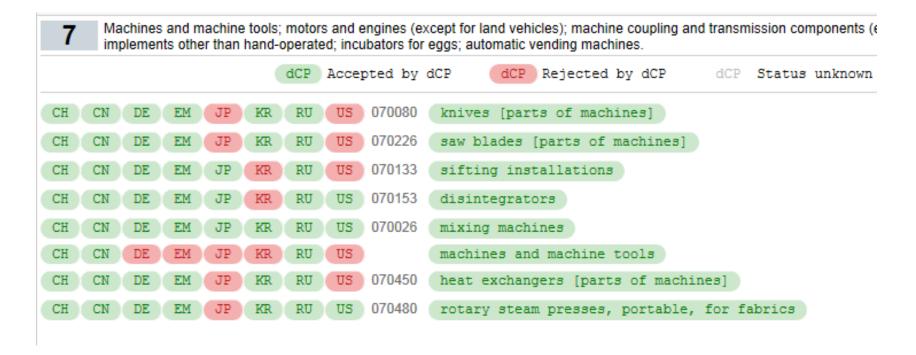
<u>Select all</u> Remove all	
AT Austria BX Benelux	<ul><li>✓ JP Japan</li><li>✓ KR Republic of Korea</li></ul>
BY Belarus	MN Mongolia
CH Switzerland	MX Mexico
CN China	NO Norway
CO Colombia	■ NZ New Zealand
✓ DE Germany	☐ PT Portugal
DK Denmark	RS Republic of Serbia
<b>EE</b> Estonia	RU Russian Federation
✓ EM European Union	SE Sweden
FI Finland	SG Singapore
GB United Kingdom	TR Turkey
IL Israel	UA Ukraine
dentifications of goods or ser	brackets should not be used in the vices. If square brackets are used in a s or a limitation thereof, a provisional TO examining attorneys.
	by the USA in MGS, please consult the able wording: https://tmidm.uspto.gov
	OK



#### MGS – Exclusive features

#### **Display of Acceptance / Rejection**

#### Specificity of terms





### MGS - Advantages for applicants

#### Saving time and money

- ■User-friendly tool
- ■Helps reduce delays and costs associated with irregularity notices issued by WIPO
- ■Helps reduce delays and costs associated with provisional refusals issued by designated Contracting Parties



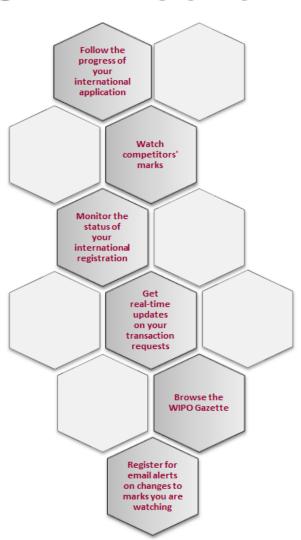
#### MGS - Benefits for National Offices

- As Office of Origin:
  - □ Possibility to use MGS as a national database of acceptable goods and services
  - □ Reduction in workload to process irregularity notices from WIPO
- As Office of a designated Contracting Party:
  - ☐ Fewer provisional refusals to issue



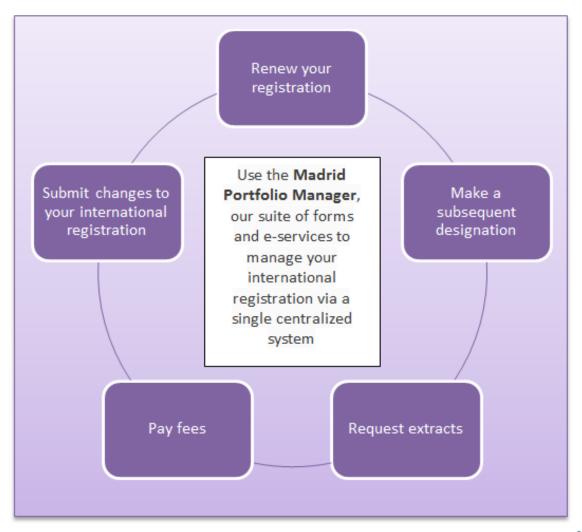
#### **MONITOR** – Madrid Monitor

Use Madrid
Monitor to
stay informed
on the status
of your
international
registration
and Madrid
System
trademark
portfolio





### MANAGE





### Recent Developments

- New or improved E-Services
  - Madrid E-Filing
  - Madrid Monitor (Beta)
  - New Madrid Member Profiles Database
- E-Forms in test



## Madrid E-Filing

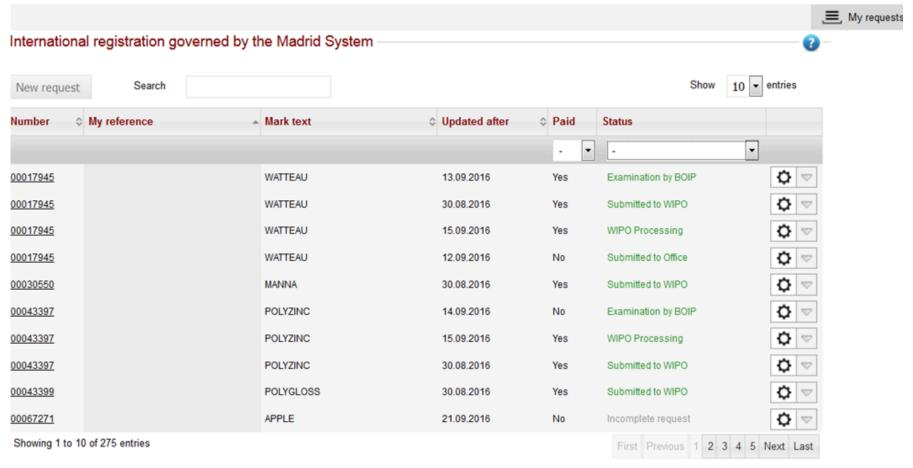


## Madrid E-Filing Service

- International Registration Process Integration (IRPI)
  Project
- Electronic filing of New Application
- Web-based
- Two modules (Applicant and Office)
- Synchronous filing with the International Bureau

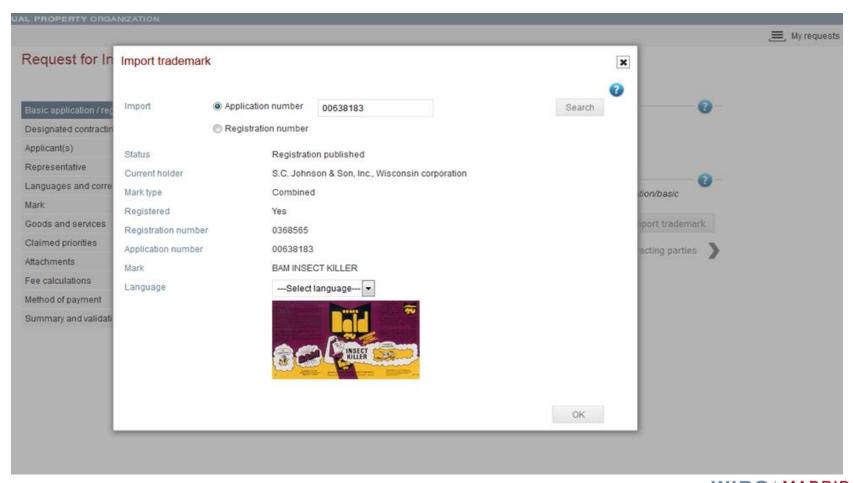


## Madrid E-Filing Applicant Module – Application Dashboard



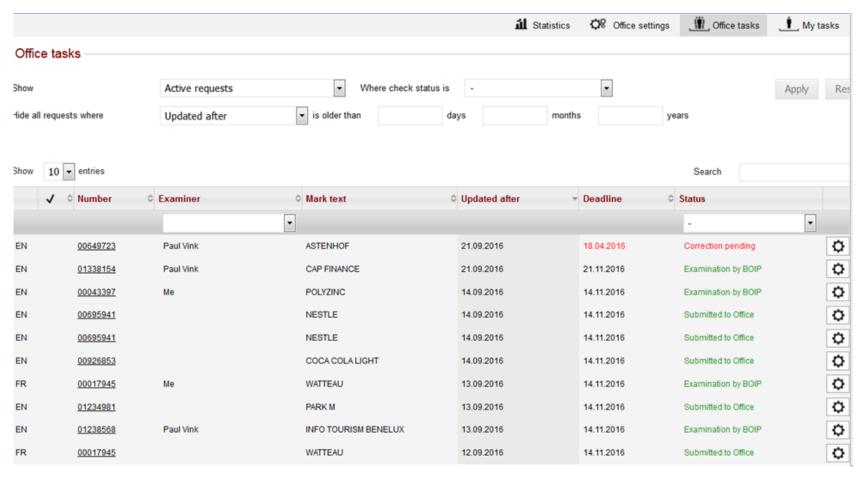


## Madrid E-Filing Applicant Module – Electronic MM2 form



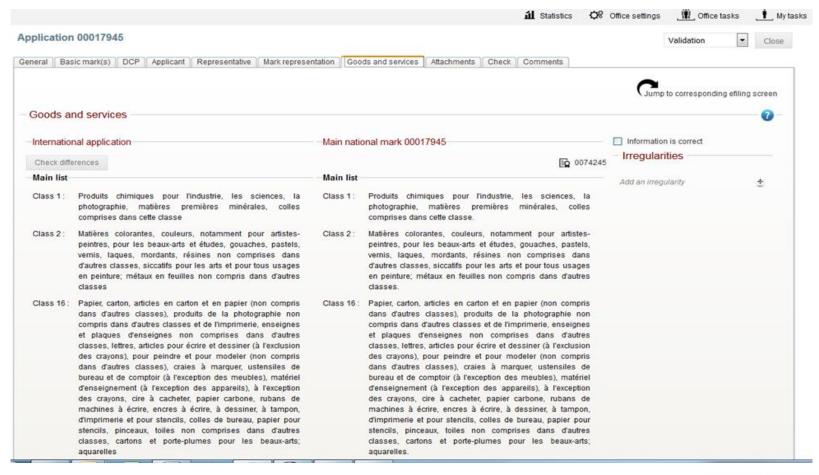


## Madrid E-Filing Office Module – Application Dashboard





## Madrid E-Filing Office Module – MM2 Form Validation





### Madrid E-Filing Service

- Currently being used by IP Australia and Benelux Office for Intellectual Property (BOIP)
- More Offices are welcome to join
- General requirements for IP Offices
  - ☐ national registry database from which the domestic trademark information can be imported
  - possibility to authenticate their users
- For more information, please contact: e-marks@wipo.int



### **Madrid Monitor**

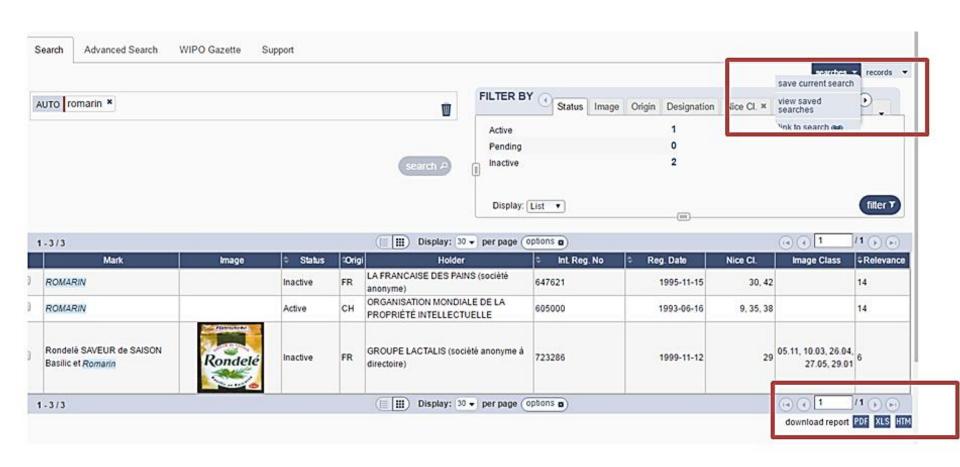


#### **Madrid Monitor**

- The new Madrid Monitor search tool integrates in one application functionalities and information currently accessible through ROMARIN, the WIPO Gazette of International Marks, Madrid E-Alert and Real-Time Status
- Madrid Monitor's intuitive search interface provides at a unique access to all information available in the register
- Beta version of Madrid Monitor is currently made available in parallel with other monitoring E-Services



#### **Madrid Monitor**





### **Engagement with Users**



- We invite you to test <u>Madrid Monitor Beta</u>
- Your <u>feedback</u> will help us tailor *Madrid Monitor* to your needs, before it is deployed as the single monitoring tool for all Madrid System-related inquiries
- Deployment of Madrid Monitor is the first in a broader Madrid Registry initiative focused on the delivery of an enhanced, customer-driven online experience for Madrid users throughout the lifecycle of their mark



## E-Forms



#### E-Forms in test

- ■Change in name/address of the holder and representative
- Limitation
- Renunciation
- Partial or total cancellation
- Partial or total change in ownership



# Thank you for your attention



intreg.mail@wipo.int