

MADRID GUIDE

Prepared by: MADRID UNIT

MADRID PROTOCOL

*use Ctrl + F to search for key words that will immediately take you to the section of information you need

WHAT IS THE MADRID PROTOCOL?

- International filing system for trademark protection
- Allows multiple country trademark applications to be filed via IOPHL
- 109 members covering 124 countries
- Administered by WIPO
- A centralized filing and management procedure

TRADEMARK PROTECTION OPTIONS

NATIONAL ROUTE

File trademark application with the Trademark Office of each country in which you want protection

REGIONAL ROUTE

Apply in countries which are members of a regional trademark registration system with effect in all member states (ARIPO, Benelux Trademark Office, EUIPO and OAPI)

REGIONAL ROUTE

File through Madrid Protocol

NATIONAL vs. MADRID

NATIONAL FILING	MADRID PROTOCOL
MANY offices, submission in each country	ONE office
MANY languages	ONE language
MANY forms	ONE form
MANY currency	ONE currency
NEED for local agents	NO NEED for local agent at the time of filing
NEED for translation	NO NEED for translation

PHILIPPINES

85th Member of Madrid Protocol
July 25, 2012

PH DECLARATIONS

1.) 18 months +

- possible notification of refusals based on an opposition after the 18-month time limit

ACRONYMS

PRP	- Provisional Refusal of Protection
IR	- International Registration
IB	- International Bureau
DCP	- Designated Contracting Party
OO	- Office of Origin
SGP	- Statement of Grant Protection

2.) No subsequent designations

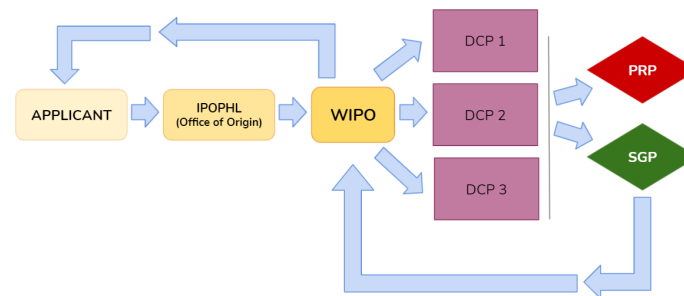
- for IRs effected under the Protocol prior to the date of accession of the Contracting Party concerned

3.) Individual Fees

IPOPHL ROLES

AS AN OFFICE OF ORIGIN (OUTBOUND)

OUTBOUND WORKFLOW



To be entitled to use the Madrid System, you must:

- have a real and effective industrial or commercial establishment in, or
- be domiciled in, or
- be a national of a member of the Madrid System

*You need to have a registration or application (basic mark) in your office of origin

*Submit the international application to IPOPHL. It will be certified and forwarded to WIPO

FORMALITY EXAMINATION BY WIPO

- WIPO conducts a formalities examination of the IA
- Once approved, the mark is recorded in the International Register
- WIPO sends a certificate of international registration and notifies the IP Offices of the designated Contracting Parties, in which protection is sought
- The scope of protection is not known at this stage. It is only determined after substantive examination and decision by the IP Offices

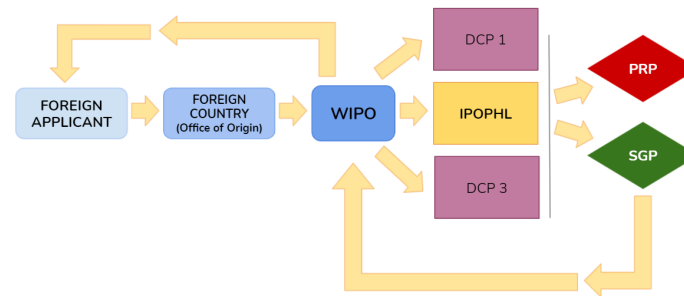
SUBSTANTIVE EXAMINATION BY DCP

- IP Offices make a decision within 12 or 18 months in accordance with their legislation. WIPO records the decisions and notifies the holder
- If an IP Office refuses to protect your mark, it will not affect the decisions of other offices. You can contest a refusal decision before the IP Office concerned
- If an IP Office accepts to protect your mark, it will issue statement of grant of protection

- The international registration is valid for 10 years. Renewal is made directly with WIPO with effect in the designated Contracting Parties

AS A DESIGNATED CONTRACTING PARTY (INBOUND)

INBOUND WORKFLOW



MADRID CONCEPTS

PROVISIONAL REFUSAL

- Article 5, Rules 16, 17 and 18
- Notification that protection cannot be granted in the contracting party
- Limit: 12, 18 or 18+ months from date of notification by IB to the office – beyond these periods, the office can no longer issue a Provisional Refusal

18+ MONTHS

- Refusal after 18 months – refusal may result from an opposition to the granting of protection

Requirements:

- Informed IB before expiration of the 18 months of the possibility of an opposition after the 18-month limit, AND
- Refusal based on opposition is made within 1 month from the end of the opposition period AND not later than 7 months from the beginning of the opposition period

GRANT OF PROTECTION

- Rule 18ter
- Statement that protection is granted to the mark
- No provisional refusal - No grounds for provisional refusal
- Following a provisional refusal: Provisional refusal is withdrawn and protection of the mark is granted
- No legal consequences if a statement of grant is not sent

Rule 18ter1: Statement of Grant of Protection Where No Notification of Provisional Refusal Has Been Communicated

"all procedures before an Office have been completed and there is no ground for that Office to refuse protection, that Office shall, as soon as possible and before the expiry of that period, send to the International Bureau a statement to the effect that protection is granted to the mark..."

Rule 18ter2: Statement of Grant of Protection Following a Provisional Refusal

Office which has communicated a notification of provisional refusal shall, once all procedures before the said Office relating to the protection of the mark have been completed, send to the International Bureau either:

- a. *statement to the effect that PRP is withdrawn, protection is for all G/S*
- b. *statement indicating protection is granted for some G/S*

SAMPLE DOCUMENTS:

GP Rule18ter1

**FINAL DISPOSITION ON STATUS OF A MARK
- STATEMENT OF GRANT OF PROTECTION -
Rule 18ter(1)**

International Registration No: 1594302	IR Date/Subsequent Designation Date: 8 April 2021
Holder: HEALTHTECH BIO ACTIVES S.L. [ES]	
Mark: WEANEX	

The International Registration Designating the Philippines was published in the IPOPPL e-Gazette and no opposition to the registration of the mark was filed. The mark is now GRANTED PROTECTION for all the goods and/or all the services requested.

Date of Publication of Mark in the TM e-Gazette: 10 June 2021

Date of Grant of Protection: 11 July 2021


Jesus Antonio Z. Ros
Director, Bureau of Trademarks

Additional Information:

The IPOPPL requires the submission of the Declaration of Actual Use (DAU) within three (3) years from the date of international registration or the date of subsequent designation, as the case may be; within one (1) year from the fifth anniversary of the date of grant of protection of the mark; within one (1) year from the renewal date; and within one (1) year from the fifth anniversary of each renewal. The provisions governing the filing of the DAU are contained in the Trademark Regulations of 2017.

GP Rule18ter2 all G/S

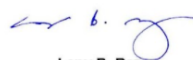
**FINAL DECISION ON STATUS OF A MARK
– STATEMENT OF GRANT OF PROTECTION
FOLLOWING A PROVISIONAL REFUSAL –
Rule 18ter(2)**

International Registration No: 1498322	IR Date/Subsequent Designation Date: 25 September 2019
Holder: FLAIRASIA TECHNOLOGIES PTE. LTD. [SG]	
Mark: flairme.	

The International Registration Designating the Philippines was published in the IPOPHL e-Gazette. All procedures before the Office have been completed. The mark is now GRANTED PROTECTION for all the goods and/or all the services requested. (Rule 18ter(2)(i)).

Date of Publication of Mark in the TM e-Gazette: 2 March 2020

Date of Grant of Protection: 2 April 2020



Leny B. Raz
Director IV, Bureau of Trademarks

Additional information:

The IPOPHL requires the submission of the Declaration of Actual Use (DAU) within three (3) years from the date of international registration or the date of subsequent designation, as the case may be; within one (1) year from the fifth anniversary of the date of grant of protection of the mark; within one (1) year from the renewal date; and within one (1) year from the fifth anniversary of each renewal. The provisions governing the filing of the DAU are contained in the Trademark Regulations of 2017.

GP Rule18ter2 some G/S

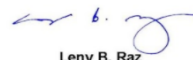
**FINAL DECISION ON STATUS OF A MARK
– STATEMENT OF GRANT OF PROTECTION
FOLLOWING A PROVISIONAL REFUSAL –
Rule 18ter(2)**

International Registration No: 1328461	IR Date/Subsequent Designation Date: 7 June 2019
Holder: PURATOS [BE]	
Mark: CREMFIL	

The International Registration Designating the Philippines was published in the IPOPHL e-Gazette. All procedures before the Office have been completed. The mark is now GRANTED PROTECTION for the goods and/or services listed in the attachment. (Rule 18ter(2)(ii))

Date of Publication of Mark in the TM e-Gazette: 16 June 2020

Date of Grant of Protection: 17 July 2020



Leny B. Raz
Director IV, Bureau of Trademarks

Additional information:

The IPOPHL requires the submission of the Declaration of Actual Use (DAU) within three (3) years from the date of international registration or the date of subsequent designation, as the case may be; within one (1) year from the fifth anniversary of the date of grant of protection of the mark; within one (1) year from the renewal date; and within one (1) year from the fifth anniversary of each renewal. The provisions governing the filing of the DAU are contained in the Trademark Regulations of 2017.

Mark: CREMIL

International Registration No.: 1328461

Goods and/or Services:

Class 29:

Preserved, dried and cooked fruits and vegetables; fruit jellies, jams; fruit fillings, fruit pastes and compotes; glazed fruits; eggs, milk and milk products; edible oils and fats, margarine, fruit-based spreads, dairy-based spreads; cream and whipped cream.

*****Nothing Follows*****

MODIFICATIONS/CHANGES

- Amendment of data or scope of protection
- **Change of name or address of the holder (MM9)**
 - Presented to IB by the holder or by the office of the contracting party of the holder
- **Change of name or address of the representative**
 - No required form, MM10 is optional

LIMITATION

- MM6
- Some or all of the DCPs
- G&S still remain the same in the international register but the international registration is no longer protected for the G&S in a particular DCP
- G&S which were limited can still be the subject of a subsequent designation
- Could have resulted from a provisional refusal
- Voluntary limitation of G/S is not allowed; Limitation must be sent to WIPO first (MM6)

RENUNCIATION

- MM7
- Some but not all DCPs, for all G&S
- DCPs which were renounced can be designated again
- Equivalent to the Voluntary Withdrawal/Abandonment for national applications
- Holder may redesignate PH through Subsequent Designation

CANCELLATION

- MM8
- All DCPs for some or all G&S
- G&S are permanently removed from the register
- No subsequent designation
- Filing of a new application

CHANGE IN OWNERSHIP

- MM5 or on a form having the same format & contents
- Contract (assignment), court decision or operation of law (bankruptcy, inheritance), merger of 2 companies
- All or some G&S, all or some DCPs
- Transferee should also have the entitlement to file the application

SUBSEQUENT DESIGNATION

- G&S – covered in the list in the international register but DCP was designated with a limitation of G&S
- DCPs - not covered by the original filing

- MM4 or e-subsequent designation
- Article 3ter- Territorial Extension
- Extension of protection

Reasons:

- Protection in the CP was not requested at the time of filing
- Mark is no longer protected in the CP
- At the time of filing the international application, the CP was not a party to the Agreement or the Protocol

CEASING OF EFFECT

- 5-year dependency on the basic mark
- No separate dependency for subsequent designation
- Protection from the international reg. may not be invoked: Basic application/registration is withdrawn, lapsed, renounced, subject of a final decision of rejection, revocation, cancellation, invalidation
- Office of origin notifies IB
- **Central Attack** – an international registration may be defeated in all DCPs by a single invalidation against the international registration

TRANSFORMATION

- Within 3 months from date of cancellation of the international registration
- All DCPs where registration had an effect
- Filed on the date of the international registration or the date of subsequent designation
- International registration is cancelled for the G&S, at the request of the office of origin, must be filed with the office of origin
- May take place in any of the DCPs where the international registration is not a subject of a total refusal, invalidation or renunciation

REPLACEMENT

- Article 4bis and Rule 21
- Mark is subject of both the national and international registrations the international registration is deemed to replace the national registration
- When a holder has made a direct request to the office of origin that a natl reg has been replaced by an international registration, the office must notify IB

Requirements:

- Registered national mark
- Same mark, same G&S, same owner/registrant

RENEWAL

- Article 6, Rule 30
- 10 years
- Renewed only for G&S that are protected in respect of the DCP
- May also state a non-renewal for particular DCPs
- MM11 including the indication of all the DCPs in which the international reg is renewed

SUMMARY

OUTBOUND	INBOUND
Madrid Applicant Basic Application Basic Registration Entitlement to File Office of Origin MM2 Ceasing of Effect Irregularity Notice Subsequent Designation	Holder International Registration PRP SGP Grant of Protection Replacement Transformation Confirmation of Total PRP Subsequent Designation

IPAP vs. OCHOA, GR 204605

- Madrid Protocol as an executive agreement is valid because it is only procedural, does not create substantive rights, and does not require amendment of the IP Code
- The president is merely implementing a policy previously approved by the Congress when he signed the Madrid Protocol as an agreement

Section 2. **Declaration of State Policy.** - The State recognizes that **an effective intellectual and industrial property system is vital to the development of domestic and creative activity, facilitates transfer of technology, attracts foreign investments, and ensures market access for our products. It shall protect and secure the exclusive rights of scientists, inventors, artists and other gifted citizens to their intellectual property and creations, particularly when beneficial to the people, for such periods as provided in this Act.**

The use of intellectual property bears a social function. To this end, the State shall promote the diffusion of knowledge and information for the promotion of national development and progress and the common good.

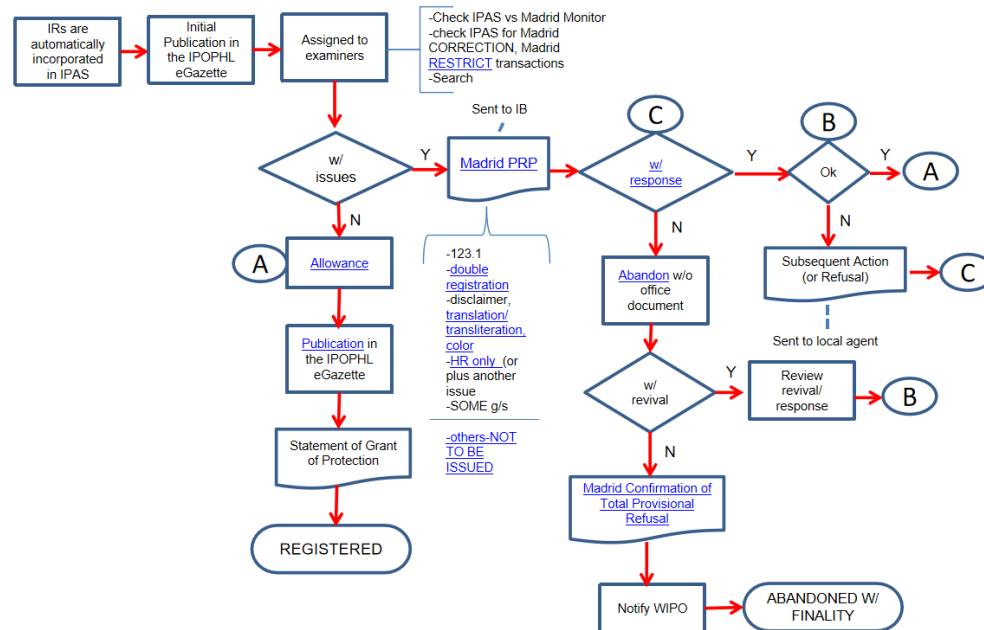
It is also the policy of the State to streamline administrative procedures of registering patents, trademarks and copyright, to liberalize the registration on the transfer of technology; and to enhance the enforcement of intellectual property rights in the Philippines.

The IPAP misapprehends the procedure for examination under the *Madrid Protocol*. The difficulty, which the IPAP illustrates, is minimal, if not altogether in-existent. The IPOPHL actually requires the designation of the resident agent when it refuses the registration of a mark. Local representation is further required in the submission of the Declaration of Actual Use, as well as in the submission of the license contract. *The Madrid Protocol* accords with the intent and spirit of the IP Code, particularly on the subject of the registration of trademarks. **The *Madrid Protocol* does not amend or modify the IP Code on the acquisition of trademark rights considering that the applications under the *Madrid Protocol* are still examined according to the relevant national law. In that regard, the IPOPHL will only grant protection to a mark that meets the local registration requirements.**

MADRID IR EXAMINATION

*use Ctrl + F to search for key words that will immediately take you to the section of information you need

IR EXAMINATION PROCESS WORKFLOW



BEFORE EXAMINATION, ALWAYS CHECK THE FOLLOWING DATA FROM IPAS:

- Image
- Holder's name and address
- Limitation
- Priority Claim
- IR date/Date of Subsequent Designation

*Please compare the information to the ones found in Madrid Monitor

ACRONYMS

PRP	- Provisional Refusal of Protection
IR	- International Registration
IB	- International Bureau
DCP	- Designated Contracting Party
OO	- Office of Origin
SGP	- Statement of Grant Protection

OFFICE ACTIONS

ISSUANCE OF MADRID PROVISIONAL REFUSAL OF PROTECTION (MADRID PRP)

- Within 18 months from the Date of Notification; if there are corrections in the PRP issued, we can issue another PRP as long as it is still within the 18-month period
- Date of Notification can be found in either IPAS through TM report pdf or Madrid Monitor, as exemplified below:

IPAS:

Close New action View mark Other process Set filter Other mark Tree mode Refresh Add manual sub process Edit Save changes						
Edit process data						
File:1571360 - SHOTO - Johnstech International Corporation - For further action by examiner						
Events	Status	Frozen By	Freezing			
Type	Date	Description	Notes	Action 1	Action 2	
User Doc.	09/12/2020	Userdoc:Madrid BIRTH transaction (Doc0/1416164401) File:1571360 - SHOTO - Johnstech International Corporation	Checking type of Madrid application (09/12/2020)		PDF	
e-doc	09/12/2020	Trademark (Madrid)	Content certified on 25/01/2021 by MARKS		PDF	

Registrations

Designated Contracting Party:
Philippines



WIPO | MADRID
The International
Trademark System

NOTIFICATION ENN/2021/1

Reproduction of the mark where the mark is represented in standard characters

Registration number

Registration date

Date next payment due

Name and address of holder

Legal nature of the holder (legal entity) and place of organization

Name and address of the representative

List of goods and services NCL(11-2020)

Basic application

Data relating to priority under the Paris Convention

Designations under the Madrid Protocol

Date of notification

Language of the international application

SHOTO

1 571 360

December 9, 2020

December 9, 2030

Johnstech International Corporation
1210 New Brighton Boulevard, Minneapolis MN 55413-1641
(United States of America)

CORPORATION, Minnesota, United States

Michael B. Lasky Hamre, Schumann, Mueller & Larson, P.C., 45
South Seventh Street, Suite 2700, Minneapolis MN 55402 (United States of America)

9 Probes for testing integrated circuits; test pins for testing printed circuit boards.

United States of America, 28.07.2020, 90077876

United States of America, 28.07.2020, 90077876

Philippines

21.01.2021

English

MADRID MONITOR:

← → ↺ ↻ https://www3.wipo.int/madrid/monitor/en/#

Most Visited Madrid - The Internati... Anneongl - Presentati... MOP Transformation Illustr... IPO Chinatrademakoffice s... The Division and Merg...

527 Indications regarding use requirements
SG

Transaction History

EXPAND
or, only those pertinent to selected countries
CA CN EM IL JP KR MX **PH** SG TH

HIGHLIGHT Contracting Parties above which have issued the document:

Registration : 2021/1 Gaz, 21.01.2021, CA, CN, EM, IL, JP, KR, MX, PH, SG, TH

450 Publication number and date
2021/1 Gaz, 21.01.2021

832 Designation(s) under the Madrid Protocol
CA - CN - EM - IL - JP - KR - MX - PH - SG - TH

527 Indications regarding use requirements
SG

581 Date of notification by the International Bureau to the designated Contracting Parties (from which the time limit to notify the refusal starts)
21.01.2021

Ex Officio examination completed but opposition or observations by third parties still possible, under Rule 18bis(1) : 2021/4 Gaz, 11.02.2021, EM

Total provisional refusal of protection : 2021/9 Gaz, 18.03.2021, PH

[PDF](#) PH

450 Publication number and date

DOUBLE REGISTRATION

SCENARIO	ACTION	TEMPLATE ACTION
Earlier filer: National 2nd filer: Madrid	NO double registration (Replacement principle)	TEMPLATE: Clarify if the holder is retaining the National application (registration), with application no. (registration no.). If the holder intends to replace the national application (registration) with the International Registration, kindly submit a Request for Replacement (form is downloadable from the IPOP HL website) and submit it via eDoc File for Trademarks and pay the corresponding fee of Php 730.00.
Earlier filer: Madrid 2nd filer: National	Double registration	The mark may not be registered because Philippines was designated on (date) for the same mark and goods. Giving due course to this will result to double registration.
Earlier filer: Madrid 2nd filer: Madrid	Double registration	The mark may not be registered because Philippines was designated on (date) for the same mark and goods. Giving due course to this will result to double registration.

GOODS AND SERVICES

1.) No issuance of actions, on:

- Specification of goods and services
- Reclassification, unless it's very obvious that the term falls under another class
 - Issue Madrid PRP but no requirement of addl. fees
- Amendment of G/S is allowed only by way of response to PRP or submission of limitation request to IB (MM6).

2.) "Terms too vague.."

- If the terms are clear and they correctly fall under that class, **DELETE THE PHRASE, "TERMS TOO VAGUE..."**

PRP FOR SOME G/S: Partial Provisional Refusal

- The goods and services affected must be specified in the provisional refusal.

PRP FOR SOME G/S: Partial Provisional Refusal

TEMPLATE:

Failure to respond to the provisional refusal, submission of an incomplete response, or failure to request an extension of time to respond within the two-month period will result in the **abandonment** of the application. In case of abandonment, the applicant has three (3) months from the abandonment date (counted from the lapse of the period to respond) to request the revival of the application.

Failure of the Applicant to request for the revival of the application within the three (3) month revival period will result in the **removal of the goods and/or services which are subject of this provisional refusal**. The international registration will then be recommended for **allowance and published for opposition** for the goods and/or services **not affected by this provisional refusal**. If no opposition to the registration of the mark is filed, the Office will issue a statement of grant of protection for the goods and services not affected by this provisional refusal.

LIMITATION

IPAS: MADRID RESTRICT transaction

Action	04/06/2021	(automatic) Date is due
User Doc.	07/06/2021	Userdoc:Madrid RESTRICT transaction (Doc1/1471097001) File:1361124 - In data validation of request (07/06/2021) . CLOUD - On Clouds GmbH

Madrid Monitor

Limitation : 2021/26 Gaz, 15.07.2021, PH	
450	Publication number and date 2021/26 Gaz, 15.07.2021
833	Interested Contracting Party(ies) PH
List limited to:	
25	Footwear, headgear for wear; shirts, neckties; trousers, bathing suits, coats, combinations-trousers (clothing), pelerines, cyclists' clothing, sashes for wear, aprons (clothing), headbands (clothing), tracksuits; anoraks (parkas); ski pants; waist belts (clothing); fur coats; mufflers (clothing); gloves (clothing); dressing gowns; slippers, shoes, sports shoes, esparto shoes or sandals, beach shoes, heels, bath slippers, boot liners, boots, socks and sandals; leather clothing, pockets for clothing, all the aforesaid goods not decorated with a cloud design and all afore-mentioned goods for sports and active living only.
28	Gymnastic and sporting articles included in this class, surf boards, sailboards, balls for games, inline skates, skis, starting blocks for sports; all afore-mentioned goods not for babies, infants and toddlers.
580	Date of recording 07.06.2021

COLOR CLAIM

- If the image is in color but no color is identified in IPAS, even in the Madrid Monitor:
 - issue PRP requiring the holder to specify the color and also include the suggested colors so we can input the colors just in case the holder fails to reply but there is **NO NEED TO REQUIRE COLOR CLAIM FEE**
 - Action Template:

The mark is represented with colors. Please clarify if these are material features of the mark. If yes, identify the colors forming part of the mark. If the holder fails to address this issue, this Office shall enter the colors "<Blue and pink>" in the records of this file.

TRANSLATION/TRANSLITERATION

- Action Template:

The applicant should provide the English translation of the mark. A search made on Google has shown that "XXXX" translates to "XXXX". If correct, the applicant is required to confirm said translation. Otherwise, submit the correct English translation of the mark.

If the applicant fails to address the issue above within the reglementary period, the given translation will be recorded as the correct translation and this international registration will proceed to publication for opposition purposes.

AMENDMENT OF TITLE OF THE MARK

- No action is needed in amending the title. Delete the elements not reflected in the mark to conform to the reproduction or representation of the mark
 - Ex. Red Cross – issue a Refusal.

JURIDICAL ENTITY/PERSONALITY

- No issuance of action is needed in clarifying the juridical personality of the holder.

REQUEST FOR DIVISIONAL

- Must be in MM22
- Transmitted to WIPO
- PH is notified when the new file is created

HOME REGISTRATION

ISSUES	ACTION
No Home Registration only	Madrid PRP (no Home Reg) - deadline to submit: 6 months
Home Registration + Disclaimer / Translation/transliteration / Color	Madrid PRP ALL GS - deadline to submit: 2 months
Home Registration + Cited mark/s	Madrid PRP ALL GS with cited mark - deadline to submit: 2 months

SAMPLES OF IRs with Priority Claim

822	Basic registration CH, 02.03.2021, 760232
300	Data relating to priority under the Paris Convention and other data relating to registration of the mark in the country of origin CH, 02.03.2021, 760232
821	Basic application CN, 23.12.2020, 52413450
300	Data relating to priority under the Paris Convention and other data relating to registration of the mark in the country of origin CN, 23.12.2020, 52413450
821	Basic application CZ, 08.10.2020, 567168
822	Basic registration CZ, 17.02.2021, 384192
300	Data relating to priority under the Paris Convention and other data relating to registration of the mark in the country of origin CZ, 08.10.2020, 567168

ALLOWANCE AND DEFERMENT

USER DOC FILED	INITIAL ACTION	ACTION AFTER 6 MONTHS
----------------	----------------	-----------------------

With response but HR is not yet registered	Allowance and Deferment (signatory: Supervisor)	If no Extension to File CC of HR was submitted, ALLOW WITHOUT PRIORITY CLAIM If an Extension was filed, GRANT THE EXTENSION (Template: Grant of request not published and signatory is the Examiner)
With response but HR is not yet registered AND an Extension to file CC of HR was filed	- Issue an Allowance and Deferment - After the mailing of the Allowance and Deferment, Grant the Extension to File CC of HR. Be sure to input the correct NEW DUE DATE in the system: Mailing date of Allowance and Deferment + 6 months + 1 year = NEW DUE DATE	

ABANDONMENT OF IRs

ISSUES	NO RESPONSE, ABANDON?	OFFICE ACTION (DOCUMENT)
If the ONLY issue is any of the ff: - Disclaimer - Translation/transliteration (except for foreign characters that cannot be translated) - Color	NO - the same with national apps, ALLOW WITH THE DISCLAIMER, TRANSLATION/TRANS-LITERATION, COLOR	Allowance Sheet
HR + Cited mark/s	YES	Madrid abandonment without any office doc
HR + Disclaimer / Translation/transliteration / Color	NO - Wait for another 6 months for the submission of HR	None
	- No reply after 6 months and the HR is still PENDING with the foreign country; OR - it has been REGISTERED BEYOND THE 6-MONTH PERIOD	Allowance Sheet but WITHOUT PRIORITY CLAIM

MADRID CONFIRMATION OF TOTAL PROVISIONAL REFUSAL

- Equivalent to the Notice of Final Abandonment for national applications
- Must be sent to IB
- Template: Name of the examiner is indicated but the Signatory is the Supervisor

WITH RESPONSE BUT SENT THRU EMAIL

ISSUES	CONSIDERED AS RESPONSE?	OFFICE ACTION
--------	-------------------------	---------------

Disclaimer, Translation/transliteration, Color	Yes, unless the holder disagrees with the findings of the examiner. In this case, the response must be filed thru a local agent	
Sec. 123.1	NO	The response is not accepted because it was not filed by a local representative or agent. Section 125 of Republic Act 8293 (IP Code), on Representation; Address for Services states, "If the applicant is not domiciled or has no real and effective commercial establishment in the Philippines, he shall designate by a written document filed in the Office, the name and address of a Philippine resident who may be served notices or process in proceedings affecting the mark..." WARNING: If no appointment of local agent is received together with the revival, the Notice of Madrid Provisional Refusal will be confirmed. - the office action should be transmitted to IB via the Madrid Office Portal (MOP).

PUBLICATION

- No Notice of Allowance is sent to the holder
- Publication fee is incorporated in the filing fees for Madrid.
- All records except local agents must be filed with IB.

RECORDAL OF CHANGE OF NAME

- PH is designated
- Deny the request and issue an action stating that the request must be done through the office of origin of the holder (MM9):
 - HOW TO SUBMIT MM9:
 - directly to WIPO by using Contact Madrid (under "My request concerns", select the topic "a form submission"), OR
 - through the Office of the Contracting Party of the holder

MADRID NEW NAME

- Check if it is a Change of Name of the Holder or just the representative

User Doc.	26/05/2021	Userdoc:Madrid NEWNAME transaction (Doc5/1467178501) File:1263948 - THE LEADER IN DIFFERENTIATED INSTRUCTION - Achieve3000 Inc.	In data validation of request (26/05/2021).	PDF	▼
-----------	------------	---	---	-----	---

Back | Edit | Workflow | Duplicate new owners | New userdoc | View changes log | [Save changes](#) | View POA

Userdoc data

Record 1/1

Filing | Related Documents | Other | POA | Poa Reference | **New owners** | Reprs | Affected files | Annuities | Persons | Old owners | Payments

Update highlighted

Name	Street	Residence
Achieve3000, Inc.	331 Newman Springs Road, Suite 304Red Bank NJ 07701	US

Details of highlighted owner

Person Name *
Nationality Country Code *
Is Company
Legal Nature
Address Street
Address Zone
City Code
City Name
State Code
State Name
Zip Code
Residence Country Code *

Achieve3000, Inc.
US United States of America
☐

331 Newman Springs Road, Suite 304Red Bank NJ 07701

US United States of America

- Edit
- Update highlighted
- Save changes
- (workflow) Madrid Grant of Recordal

DECLARATION OF ACTUAL USE (DAU) FOR INTERNATIONAL REGISTRATIONS (IR) DESIGNATING THE PH

	RECKONING DATE	EXAMPLE
<u>3rd DAU</u> (may file a 1-time request for extension for another 6 months to submit)	Within 3 years from IR date, if PH was designated on the IR date	IR date: June 1, 2016 and PH was designated on this same date DAU deadline: June 1, 2019 (or Dec. 1, 2019 if an extension was filed)
		OR
	Within 3 years from Date of subsequent designation if PH was subsequently designated	IR date: June 1, 2016But PH was designated on June 15, 2016 DAU deadline: June 15, 2019(or Dec. 15, 2019 if an extension was filed)
<u>5th DAU</u>	Within 1 year from the 5th Anniversary counted from the Registration Date, which is the Date of Grant of Protection	Registration date (Date of grant of protection): June 1, 2020 DAU deadline: June 1, 2026

<u>Renewal DAU</u>	Within 1 year from the Date of Renewal	IR date: June 1, 2020 Renewal date: June 1, 2030 DAU deadline: June 1, 2031
---------------------------	--	---

RESPONSES TO PRP

- From the template reminder:

"...The response must be filed by a **duly authorized representative with a local address in the Philippines** (the list of agents in the Philippines is available on the IPOPHL website). Within the two (2) month-period, the applicant may request an extension of time of another two (2) months to respond to this provisional refusal. The request for extension must be filed by the **applicant's local representative in the Philippines**..."

Section 125 of Republic Act 8293 (IP Code) on Representation: Address for Services

- "If the applicant is not domiciled or has no real and effective commercial establishment in the Philippines, he shall designate by a written document filed in the Office, the name and address of a Philippine resident who may be served notices or process in proceedings affecting the mark..."

CHECK BEFORE ALLOWANCE:

- ☐ Compare IPAS info with Madrid Monitor info
- ☐ BIBLIO DATA: mark type, holder info, G/S, local agent
- ☐ WORKFLOW: transfers/con, limitations, corrections
- ☐ Note whether IR is allowed for all or some G/S (if for some GS, better if deleted Class/goods is indicated)
- ☐ G/S for Rule 13 note from IB (terms too vague, incomprehensible, or linguistically incorrect)

MADRID DOCUMENTS

DOCUMENTS WHICH **MUST BE NOTIFIED TO IB:** (SHOULD NOT BE FORWARDED TO ADMIN)

- 1.) ALL Madrid Provisional Refusal of Protection
- 2.) Madrid Confirmation of Total Provisional Refusal
- 3.) Total Invalidation
- 4.) Partial Invalidation
- 5.) Ceasing of Effect
- 6.) Statement of Grant of Protection

DOCUMENTS WHICH MUST BE FILED WITH THE OFFICE OF ORIGIN OF THE OWNER OR DIRECTLY AT WIPO

—if these documents are in the **workflow of the IRs, the examiner or the persons in charge must issue an office action ON THE USER DOCUMENTS** informing the agents that the request is to be filed with the office of origin or at WIPO. These **must be forwarded to ADMIN (be sure the addressee is the LOCAL agent).**

- 1.) MM5 - Request for the Recording of a Change in Ownership
- 2.) MM7 - Renunciation (Voluntary Abandonment)
- 3.) MM9 - Request for the Recording of a Change in the Name or Address of the Holder or, where the Holder is a Legal Entity, for the Recording to Introduce or Change Indications Concerning its Legal Nature
- 4.) MM8 - Request for the Recording of a Cancellation of the International Registration
- 5.) Madrid Limitation NOT ARISING FROM AN OFFICE ACTION ISSUED BY IPOPHL

DOCUMENTS WHICH ARE **TRANSMITTED TO IB VIA MADRID OFFICE PORTAL (MOP)**

—PH is the Office of Origin-to be filed via eDoc File, affected Trademark is the PH application/registration

- 1.) MM2 - International Application (and MM18-Declaration of Intent to Use when US is designated)
- 2.) MM4 - Designation subsequent to the international registration (Subsequent Designation)
- 3.) MM5 - Request for the Recording of a Change in Ownership
- 4.) MM6 - Madrid Limitation
- 5.) MM9 - Request for the Recording of a Change in the Name or Address of the Holder or, where the Holder is a Legal Entity, for the Recording to Introduce or Change Indications Concerning its Legal Nature

DOCUMENT/S in IPAS. BUT MUST BE TRANSMITTED TO IB FOR PROCESSING

- 1.) MM22 - Divisional application/Registration
- 2.) Replacement (processed in PH; IB must be notified if request is granted)

MADRID ELECTRONIC TOOLS

<u>SEARCH</u>	<u>FILE</u>	<u>MONITOR</u>	<u>MANAGE</u>
GLOBAL BRAND DATABASE	MADRID GOODS & SERVICES MANAGER	MADRID MONITOR	MADRID REAL-TIME SEARCH (MADRID MONITOR)
	HARMONISED DATABASE		
	MADRID MEMBER PROFILES		
	FEE CALCULATOR		
	MADRID OFFICE PORTAL		

MADRID MONITOR

- Contains information regarding all IRs recorded under the Madrid System, that are currently in force in the International Register, as well as expired marks. It also includes data relating to pending international applications and subsequent designations at the International Bureau

GLOBAL BRAND DATABASE

- Lets users easily search multiple brand-related data sources, including image search

MADRID APPLICATION SIMULATOR

- Designed to show users how to use the Madrid System to seek the protection of their marks abroad. At the end of the simulation, it will also help users estimate the cost of registering their marks through the Madrid System

MADRID FEE CALCULATOR

- For calculating the cost of an application for IR, subsequent designation or renewal

MADRID E-PAYMENT

- A service used to pay fees as notified in irregularity letters or other WIPO communications with regard to international registration under the Madrid System

MADRID ELECTRONIC ALERTS

- A tool allowing users to register a list of IRs and to be informed by email when any of them change

MADRID REAL-TIME SEARCH

- A tool allowing users to determine the current status of their applications and other requests being processed at WIPO

MADRID GOODS & SERVICES MANAGER

- A tool assisting trademark applicants and their representatives in compiling the lists of goods and services that they need to submit when filing international applications

You may also use:

- [USPTO Trademark ID Manual](#)
- [TM Class \(which includes EUIPO Harmonised Database\)](#)





GRAMMARLY

a cross-platform writing assistant that uses AI to review spelling and grammar



SCRIBBR

a platform which can also improve grammar and it has a free and convenient citation generator



SNIPPING TOOL

a Microsoft Windows screenshot utility that can take still screenshots of an open window, rectangular areas, a free-form area, or the entire screen



GOOGLE TRANSLATE

a multilingual translation service developed by Google which can translate text, documents, and websites from one language into another

Google Workspace



*Gmail | Google Calendar | Google Drive | Google Meet
Google Docs | Google Sheets | Google Slides | Google Sites | Google Forms | Google Keep
Google Admin Panel | Google Chat | Google Voice*

a collection of cloud computing, productivity and collaboration tools, software and products developed and marketed by Google

LEGAL TEXTS AND USEFUL LINKS

LEGAL TEXTS RELEVANT TO MADRID

- [Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks \(as in force on February 1, 2021\)](#)
- [Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol](#)
- [Administrative Instructions for the Application of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks \(as in force on February 1, 2021\)](#)
- [Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks](#)

IPOPHL WEBSITE QUICK LINKS:

- [Attorneys with Madrid Protocol Training](#)
- [Rules on Madrid Protocol](#)
- [Office Orders & Notices](#)
- [Madrid Filing](#)

INTERNATIONAL TRADEMARK SEARCH

*clicking the text below the images will direct you to their respective webpages



TMView



ASEAN TMView



MADRID MONITOR
GLOBAL BRAND DATABASE
GLOBAL BRAND DATABASE (NEW)

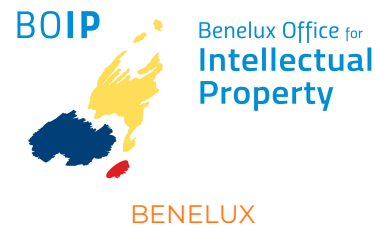


ARIPO



EUIPO

TRADEMARK OFFICES





JAPAN



KOREA



MALAYSIA



MEXICO



NEW ZEALAND



NORWAY



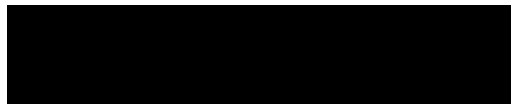
SINGAPORE



SWITZERLAND



THAILAND



UK

UNITED STATES
PATENT AND TRADEMARK OFFICE



US

FREQUENTLY ASKED QUESTIONS (FAQs)

MADRID TRANSACTIONS

What are the types of Madrid transactions found in IPAS?

- BIRTH: creation of a new IR in the system
- DEATH: removal of the mark from the international register by ceasing of effect, cancellation, or renunciation
- RESTRICT: a limitation has been filed by the holder concerning the G/S of the subject mark
- CORRECT: a correction has been made concerning the subject mark
- PROCESSED: an automatic notice that an office document has been sent to IB

TRANSLATION/TRANSLITERATION

What if a holder declares that there is no translation of the mark but you found a translation rendering the mark descriptive or generic relative to their goods and/or services?

- Issue a PRP so the holder may have the opportunity to address the matter.

What if the translated Copy of Home Registration provided by the agent shows different details (i.e. mark, goods, holder name and/or address, etc.) from the basic mark?

- Issue a Subsequent Action so the holder may have the opportunity to address the matter. Ask for the English translation of the Home Registration.
- In the case of a different translation from the covered G/S, if the translation is synonymous or within the scope of goods listed in the basic mark, it may be acceptable already. However, if the examiner deems it completely different, you may issue a Subsequent Action to address the matter.

Rule 614 states that “*The Examiner shall verify whether or not the mark has been registered from the online trademarks database.*”

What if the database is not in English?

- Most of the databases have the option where you may choose a language upon which said database will be translated. In the case where there is no such option available, you may try to right click your mouse and an option 'Translate to English' will appear. Select that option and check if the website can be translated. Sometimes, only some details will be translated (images cannot be translated) but it may be enough to get the information you need. Google Translate is also a viable option. (Please see TM Search Tools for more information)

COLOR CLAIM

Why does the Office not require a color claim fee from Madrid IRs?

- The holders have already paid for the color claim fee when they submit their International Applications to WIPO. The examiner only issues a PRP concerning color claim to verify if the holder would want their mark in black and white or if they would be amenable with the color specification suggested by the Examiner.

ALLOWANCE AND DEFERMENT

In the case where an Allowance and Deferment has already been previously issued and the following examiner has found another issue that needs to be addressed, can the examiner still issue a Subsequent Action following the Allowance and Deferment?

- There should be no subsequent action after an allowance and deferment because we issue an Allowance and Deferment if the only remaining issue is the submission of the Home Registration. However, in cases where there are newly discovered objections to the application and/or there are requirements that are unintentionally left out before the issuance of allowance and deferment, a subsequent action may be issued. Take note that this practice is applicable only in isolated and unavoidable cases.

HOME REG/CHECKING OF PRIORITY CLAIM

How can the examiner check the status of home registration?

- If the Basic Mark is a Basic Registration and the basis of the Priority Claim is the same as the Basic Registration number, no need to ask for a copy of the HR.
- In the GBD, when you select a mark, some marks have their Application/Registration numbers in hyperlink which you can select and it may direct you to the country's trademark database. It is located on the upper left corner of the mark page beside the name (if applicable).
- Direct search in the country's trademark database (See TM Offices tab for more information).

DOUBLE REG

Is it considered double registration if the holder which already has a national registration for a certain mark has applied for the same mark covering the same G/S through Madrid? What if it is the other way around and the holder already has a Madrid registration in the country for a certain mark and has applied for a national application of the exact mark?

- For a mark with a prior national registration and a following Madrid IR of the same mark, no it is not considered double registration due to the **Replacement Principle**. See [Rule 21: Replacement](#) and [Article 4bis](#).
 - *Replacement of a National or Regional Registration by an International Registration* (1) [Requests and Notification] From the date of the notification of the international registration or of the subsequent designation, as the case may be, the holder may present directly to the Office of a designated Contracting Party a request for that Office to take note of the international registration in its Register, in accordance with Article 4bis (2) of the Protocol. Where, following the said request, the Office has taken note in its Register that a national or a regional registration or registrations, as the case may be, have been replaced by the international registration, that Office shall notify the International Bureau accordingly.
- For a mark with a prior Madrid IR and a following national application or Madrid IR of the same mark, yes it is then considered a double registration.

ABANDONMENT

What will the examiner do if the reglementary period has passed and the only issues raised in the PRP are the submission for Home Registration and minor issues such as disclaimer, color claim, etc.?

- Enter/update the minor issues raised [e.g. disclaimer, color, or translation/transliteration (if there is already a suggested translation/transliteration by the previous examiner)] but wait for the 6-month period to lapse for the HR before you allow the application.

If the holder did not respond to a PRP citing the issue of confusing similarity on some G/S, will the examiner simply remove the affected class or G/S and then proceed to allow the mark or is there a need to issue a notice of abandonment?

- Issue an abandonment first. If the holder did not respond and file a revival after the 3-month reglementary period, the examiner may proceed to the deletion of the affected class or G/S.

SUBSEQUENT DESIGNATION

What is a Subsequent Designation?

- This is done to expand the geographical scope of an international registration by adding Contracting Parties to an existing international registration. See [Rule 24 \[Designation Subsequent to the International Registration\] of the Regulations of the Protocol](#).
- It extends the coverage of an existing designation that did not cover ALL G/S IN THE IR.

How many times can the holder file for Subsequent Designation and how does the examiner determine if the application is the original IR filed or its subsequent designation?

- There is no limit in the number of times a country can be designated as long as its original IR is still active in the international registry and the IR date is not earlier than July 25, 2012.

Where does the counting of the 6-month period for priority claim start in an international registration? How about the priority claim for a Subsequent Designation?

- For those where PH is originally designated, the 6-month period is counted from the IR date; for those where PH is subsequently designated, the priority claim must also be within 6 months from the date of subsequent designation.

TITLE

Is it possible to raise an issue for the amendment of the title of the mark in an IR?

- No action must be issued to amend the title. The title of the IR must not deviate from the basic mark and from what is published in the international register.

We cannot also raise the deletion of some parts of the mark due to the same reasons stated. If there are elements in the mark that are not registrable under our Law, for example the mark contains a Red Cross, then we issue a Refusal.

JURIDICAL ENTITY/PERSONALITY

Is there a need to raise an issue to clarify the juridical personality of the holder of the mark in a Madrid IR?

- No. There is no need to issue an action clarifying the juridical personality of the holder as WIPO has already undertaken the process of formality examination before sending the IRs to the DCPs.

BROAD TERMS

What if there is a broad term in the list of G/S and/or there is a need for reclassification of G/S with an additional filing fee?

- Same as national applications, the examiner may ask for the specific goods referred to by the broad G/S but never suggest G/S falling under a different class/es or ask for additional payments. If the holder responds with a specification outside of the classes covered by the IR, the same must not be accepted.

The examiner may suggest filing for the limitation of G/S through form MM6 which should be sent directly to IB. Please note that the amendment of G/S is only allowed by way of response to PRP or submission of limitation request to IB (MM6).

AGENT

When do we require payment for the agent recordal fee in Madrid?

- It is the same in the case of national applications, there is **no payment for pending marks** while **there is payment for marks post allowance**.

Is it possible for a Madrid IR holder to respond to notices without a local agent?

- If the issues raised are only minor [i.e. color, disclaimer (in which they accept said disclaimer)], then it is acceptable. The records will be updated reflecting the changes and the IR will be allowed. However, in the case where the holder disagrees with the suggested disclaimer or a proscription under Sec. 123.1 has been raised, the response must be filed through a local representative or agent. Please note that this is the same with the practice for national application.

What if a law firm which is not appointed as a local agent inquires about an issue on behalf of a Madrid IR holder? Should the examiner require an SPA before they answer?

- Require an SPA.

RECORDAL OF CHANGE OF NAME

What if a recordal of change of name has been filed by the agent? Is this acceptable?

- If PH is a DCP, the request should be denied and the examiner should issue an action stating that the request must be done through the Office of Origin of the holder (MM9).
 - HOW TO SUBMIT MM9:
 - directly to WIPO by using Contact Madrid (under "My request concerns", select the topic "a form submission"), or;
 - through the Office of the Contracting Party of the holder

eCORR

Can Madrid holders receive updates through eCorrespondence email?

- No., because eCorrespondence does not include following documents which are sent directly to IB:
 - 1.) ALL Madrid Provisional Refusal of Protection
 - 2.) Madrid Confirmation of Total Provisional Refusal
 - 3.) Total Invalidation

- 4.) Partial Invalidation
- 5.) Ceasing of Effect
- 6.) Statement of Grant of Protection

DAU

What if the 5th DAU, Renewal Application and the Renewal DAU are submitted almost at the same time?

- All the maintenance requirements must be complied with.

What are the reckoning dates of filing for the 3rd, 5th, and Renewal DAU as well as renewal application for Madrid IRs? Where can they be filed?

- Reckoning dates:
 - 3rd DAU should be submitted within 3 years from IR date, if PH was designated on the IR date/date of Subsequent Designation;
 - 5th DAU should be submitted within 1 year from the 5th Anniversary counted from the Registration Date, which is the Date of Grant of Protection;
 - Renewal DAU should be submitted within 1 year from the Date of Renewal
 - DAUs are filed in IPOPHL via eDoc File for Trademarks.
-