

# Instructions to the International Registration Form

Correctly completing the form rapid examination and is a precondition to successfully registering your trade mark internationally.

The items below correspond to the numbered items on the application form (here based on the French form) and are mainly based on Articles 9.4 and 9.5 of the Common Regulations under the Madrid Agreement and Protocol (hereafter referred to as the Regulations).

## 1 Basic trademark registration/application (Enregistrement de base)

Enter the date of filing for the basic Swiss trademark as well as the number of the registration or, if you haven't yet received a number, the number on the application. If you file your international application at the same time as the Swiss application, it is not necessary to indicate a number.

## 2 Priority claims (Revendication de priorité)

Priority under the Paris Convention allows you to benefit from protection beginning from the date you first file your application at an office of a Paris Convention Contracting State or a Member State of the World Trade Organization (WTO), under the condition that it is the first filing of the trademark in question and that no more than six months have passed between the first application and the official date of receipt for the international application.

Thus, for an international registration, the owner can claim priority based on the basic Swiss application or another previous application in one of the above-mentioned contracting countries providing that, in each case, it is the first application for the trademark.

For calculating the six month time period for so-called premature international applications (that is to say international applications based on a Swiss registration for which the Swiss examination procedure is still in progress), be aware that the date of the official filing of such applications will correspond to the date of the Swiss registration (Rule 11.1 in the Regulations). In other words, to permit applicants of such requests to benefit from priority, the Institute guarantees registration of the basic application for a Swiss trademark within six months, to the extent that it knows early enough that an international application claiming Swiss priority is pending (ideally, the international application should be filed at the same time as the Swiss application).

For "premature" international applications claiming priority based on an application earlier than the Swiss trademark: the priority period begins at the date of the earlier application and not the date of the Swiss application.

If no priority whatsoever can be claimed, international registration protection begins in principle on the date of the receipt of your application at the Institute, or, for so-called premature applications, on the date of registration of the basic Swiss trademark (Art. 3.4, Madrid Agreement and Madrid Protocol).

Note: This item does not apply to seniority claims of older marks in an European Union designation (see item 9). For this, you must annex form MM17 from WIPO to the application.



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### 3 Color claim (Couleur(s) revendiquée(s))

If you have made a color claim for the basic registration, enter the colors claimed here. It is not possible to claim colors other than those which have been claimed in the basic application.

### 4 and 5 Miscellaneous indications (Indications diverses)

#### 4 Transliteration of the mark

If the mark includes elements which are not Latin characters or numerals other than Arabic or Roman, it is necessary to indicate a transliteration here using a Latin alphabet or Arabic or Roman numerals which correspond to each character in the trademark. Neither the Institute nor WIPO examine the exactness of the transliteration.

#### 5 Translation of the trademark

This is optional in some countries and required in others, such as Singapore and the U.S. Neither the Institute nor WIPO checks the translation for correctness (Rule 6.4)b) of the Regulation).

### 6 Applicant (Déposant)

Line 1a) is for the name of the natural person and/or legal entity as it appears in the commercial register and the address of the desired owner of the trademark. This information must be identical to what is given on the basic Swiss registration or application.

If there is more than one applicant, the complete address for each person must be given. If no common representative has been appointed to act on behalf of all the applicants, all subsequent documents will have to be signed by all applicants. (See Art. 4, Ordinance of the Protection of Trademarks).

Depending on the answer given under b), the Institute will decide if it is competent to forward the request to the WIPO. For a detailed explanation on this requirement, see "Protecting Your Trademark Abroad" under Trademark/Foreign Countries on our website.

Line d) allows you to indicate information regarding the nature of the applicant. This supplementary information is sometimes required by the designated contracting parties (in particular, the United States of America).

Line e) ("Adresse pour la correspondance") should be completed if correspondence regarding the international registration should be sent to an address other than the one indicated under item a) or 7(representative). If the address should be used only for correspondence with the Institute regarding the international application, please indicate this by checking the box provided. Otherwise, the information given under 1b) will be entered in the International Register and WIPO will use it for all communication.

### 7 Representative (Mandataire)

Enter the name and address of your Trade mark consultant, if applicable. Whoever does not reside or have a principle place of business in Switzerland, must specify in the request a correspondence address in Switzerland or designate a representative with a correspondence address in Switzerland.

A representative domiciled in another Madrid system country can be listed in the International Register. However, because the Institute cannot correspond with foreign addresses (Art. 42, Trade Mark Act), it will send



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mail directly to the owner, or if this person is not resident in Switzerland, to another correspondence address in Switzerland.

For international applications, it is no longer necessary to submit authorisation. However, if there are changes in the international registration later on, the Institute can require such authorisation if there is not yet one on file.

## 8 Contact person - Reference number (Personne à contacter)

You may enter the name of the person who is in charge of your file and a file number. These will be noted on all of our correspondence relating to your application.

("Langue souhaitée pour la correspondance") allows the applicant or his representative to choose the preferred language, if it is other than French, for correspondence with WIPO by checking the appropriate box (Rule 6 of the Regulations).

However, if the application only concerns Parties under the agreement (i.e., countries designated only under no. 9a) an alternative language is not possible.

## 9 Goods and services (Liste des produits et/ou services)

a) The goods and services must be listed in French whether or not the basic registration is in another national language. They may be more restricted than for the basic registration, but they may not be more extensive. We recommend using the "International Classification of Goods and Services" available at the Institute's website, as well as the online database (in F, G, and I). If you need to add a sheet for the list, check the box at the bottom of 8a.

Note: It is possible to add to your international application an English translation of the list of goods and services (Rule 6.4a) of the Regulations). However, the reference list must be in the same language as the international application, which means that in Switzerland it must be in French.

b) This item allows you to restrict the list of goods and services listed under 8a) in regards to one or more Contracting Parties, as designated under item 10. The restriction must be made in French, even if the Contracting Parties use English or Spanish as their working language (i.e., the U.S.).

This option is particularly interesting when dealing with designated Contracting Parties which use more restrictive wording for the indication of goods and services. In this matter the position of the United States Patent and Trademark Office (USPTO) is sometimes at variance with the approach adopted by the Offices of other Contracting Parties to the Madrid Protocol. To determine the approach of the USPTO, consult the "Trademark Acceptable Identification of Goods and Services Manual" ); the wording of the international application may then be limited if it is too broad. (For more details, see the WIPO Madrid Information Notice 24/2003.

## 10 Extension of protection (Parties contractantes désignées)

By designating Ireland, India, New Zealand, United Kingdom or Singapore, the applicant commits to using the trademark in that or those countries without other formalities, according to U.K., India, Irish, N.Z. or Singapore law.



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If the U.S.A. is designated, WIPO form number MM18 (pdf, 101 KB) "Declaration of intention to use the mark" (DIU) must be completed and the original attached to the application form sent to the Institute by mail. It is important that the DIU is valid and the four fields "Signature", "Signatory's Name", "Signatory's Title" and "Date of Execution" must be filled in.

If the European Union is designated, the applicant must indicate a second language for correspondence for the procedures which could be made by third parties at the European Union Intellectual Property Office (EUIPO). The second language must be one of the five official languages of EUIPO (namely: English, French, Spanish, German or Italian). The first language corresponds to the language used by the office which filed the international application; in the case of the Institute, it is French. In such a case, the applicant would then choose the second language from the four remaining languages.

A last note concerning the European Union: the legislation of that Contracting Party permits seniority claims within its territory of one or more trademarks previously registered in a Member State of the EC. If the applicant wishes to claim seniority, he must use the official WIPO form MM17 (pdf 167 KB) and attach it to the international application.

## Regarding item 10c:

The extension of protection to Madrid Agreement countries (10a) can only be based on a valid trademark registration whereas the extension of protection to Madrid Protocol (10b) Contracting Parties can be based on an application for registration or on a valid trademark registration. Thus, international applications designating both Madrid Agreement and Madrid Protocol Contracting Parties can only be based on a nationally registered trademark.

When checking box 10c) on the form, you may inform the Institute if you wish your international application designating only Contracting Parties to the Protocol to be transmitted to WIPO without waiting for the Swiss registration of the trademark. This possibility, which has the advantage of maintaining the priority of an earlier first application because registration of the basic trademark is not possible during the priority period (see item 2 above), carries some risk. Since the Institute proceeds with a formal and material examination of Swiss trademark applications, it is possible that the international registration would be cancelled without the already paid international fees being reimbursed if the application were to be rejected. In fact, international registration based on an international application is dependant on the basic national filing for a period of five years (Art. 6 MA/MP), so the rejection of a national filing leads to the cancellation of the international registration.

An international application based on a national trademark (registration) is an application based on a sign which has already been examined (examination may possibly result in the rejection of a sign already in use). The base for the international application is thus more reliable.

## 14 Date and Signature (Date et Signature)

The application form no longer needs to be signed in original (Article 6 of the Ordinance of the Protection of Trademarks). However, the designation of certain countries requires the signature (see the remarks under item 9 "Extension of Protection under the Madrid Agreement/Madrid Protocol").