



— ARISE+ —

ASEAN Intellectual Property Rights



A practical guide on  
international trademark  
protection for Malaysian  
entrepreneurs

# THE MADRID PROTOCOL

A ROUTE TO  
GLOBAL BRANDING



Funded by the European Union



**EUIPO**  
EUROPEAN UNION  
INTELLECTUAL PROPERTY OFFICE





# ARISE+

ASEAN Intellectual Property Rights



## THE MADRID PROTOCOL



### Delegation of the European Union to Malaysia

Menara Tan & Tan, Suite 10.01,  
207 Jalan Tun Razak, 50400 Kuala Lumpur, Malaysia

+603 2723 7373

delegation-malaysia@eeas.europa.eu

facebook.com/EUinMalaysia

@EUinMalaysia



### Intellectual Property Corporation of Malaysia (MyIPO)

Unit 1-7, Aras Bawah, Tower B, Menara UOA Bangsar,  
No. 5 Jalan Bangsar Utama 1, 59000 Kuala Lumpur, Malaysia

www.myipo.gov.my

+603-2299 8400

ipmalaysia@myipo.gov.my

facebook.com/ipmalaysia

@myipo



### ARISE+ IPR

www.ariseplusipr.eu

Arise+IPR@euipo.europa.eu

facebook.com/EUIPcooperation

@EUIPcooperation

This guide has been elaborated by the ARISE+ IPR Project, in cooperation with the Intellectual Property Corporation of Malaysia (MyIPO) and with the assistance of International Consultant Mr Ernesto Rubio. The content of this guide is the sole responsibility of the ARISE+ IPR project and can in no way be taken to reflect the views of the European Union or the European Union Intellectual Property Office (EUIPO) – Kuala Lumpur, Malaysia, January 2021.

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## ■ ABOUT ARISE+ IPR

The ARISE Plus Intellectual Property Rights (ARISE+ IPR) programme is one of the components under the Enhanced ASEAN Regional Integration Support from the European Union (EU), or ARISE Plus. The five year, €5.5 million ARISE+ IPR programme supports regional integration through intellectual property (IP) cooperation and aims to upgrade the IP systems for creation, protection, utilisation, administration and enforcement, in line with international best practices and standards and the strategic objectives of the ASEAN IPR Action Plan 2016-2025.

ARISE+ IPR aims to:

- Enhance participation of ASEAN Member States in international IP treaties and global systems
- Contribute to institutional capacity building towards more efficient ASEAN IP offices
- Increase political and public awareness of the importance of IP protection and enforcement
- Reinforce the capacity of ASEAN businesses to commercialise and protect their IP rights
- Provide tailor-made support to Cambodia, Lao PDR and Myanmar

Working closely with the ASEAN Member States and the ASEAN Secretariat, the ARISE+ IPR programme further consolidates the benefits of strong IP protections in the region. A series of capacity building initiatives, development of information tools, exchange of best practices, adoption of international standards, and awareness-raising campaigns will be conducted to promote the use, protection and enforcement of IP rights. The target of these activities and initiatives are the EU and ASEAN IP administrations, enforcement agencies, local and international businesses, as well as the general public.

ARISE+ IPR works towards establishing a highly developed IP regime across ASEAN Member States that fosters innovation, trade and investment in the region.

## FOREWORD MESSAGE FROM DELEGATION OF THE EUROPEAN UNION TO MALAYSIA



One of the European Union (EU)'s top priorities in its relations with ASEAN Member States is strengthening EU-ASEAN cooperation on a country and regional level, especially in trade and economic development. The EU supports economic integration within ASEAN and, to fulfil this goal, practices in intellectual property rights (IPRs) must also be streamlined.

Protecting IPRs empowers creators, innovators, designers and right owners to create their works and operate their micro, small and medium enterprises (MSMEs) with utmost confidence. In turn, it ensures economic incentives, attracts investors, increases employment and enhances economic development.

To help achieve this, the EU, under the framework of the ASEAN Regional Integration Support from the EU (ARISE Plus), is funding the ARISE Plus IPR programme. This flagship programme is implemented by the European Union Intellectual Property Office (EUIPO). The ARISE Plus IPR programme aims to facilitate ASEAN countries, including Malaysia, in ensuring the quality, capacity and efficiency of its intellectual property landscape.

Trademarks and trademark-intensive industries, for example, play an essential role in EU-ASEAN bilateral trade, which was valued up to EUR 237.3 billion (MYR1.13 trillion) in 2018. According to a 2017-study commissioned by the International Trademark Association (INTA), the leading trademark-intensive industries in Malaysia, including computers, electronics, optical products, and refined petroleum products, contributed to 30% of Malaysia's GDP and 24% of employment in the country.

The recently launched EU IP Action Plan incentivises the use and deployment of IP, notably by SMEs and seeks to improve fair play at global level by offering IP technical assistance abroad and helping SMEs to make full use of the opportunities offered by IP protection.

The Madrid system for the international registration of trademarks offers a simple, convenient and cost-effective means to register and manage trademarks in up to 123 countries, using a single application in one language for multiple countries and paying one set of fees. Malaysia became the 106th member of the Madrid Protocol in 2019.

This booklet, "The Madrid Protocol: A Route to Global Branding" serves as a comprehensive guide for businesses in Malaysia wishing to operate on an international level while ensuring the protection of their trademarks. The booklet details the advantages of the Madrid system, procedures and fees, domestic requirements, tips for brand development and other useful information for trademark registration.

There is also a chapter focusing on trademark protection in the EU, highlighting the benefits of European Union trademark (EUTM) registration, which provides trademark protection in all EU Member States.

It is an honour for the EU, and in particular for the EU Delegation to Malaysia, to continue this fruitful cooperation with Malaysia to promote IPR protection, guaranteeing incentives for right owners and creating a development-friendly environment for the businesses in the country.

**H.E. Michalis Rokas**

Ambassador

Delegation of the European Union to Malaysia

## FOREWORD MESSAGE FROM THE INTELLECTUAL PROPERTY CORPORATION OF MALAYSIA



IP is an essential element in promoting economic development. Individuals and companies use IP rights strategically to develop, trade in, and secure income from their innovative products and services. These rights help the companies to gain and maintain a competitive advantage in markets at home and beyond.

IP in Malaysia is continuously evolving to meet various requirements and international standards as well as the needs of the industries. In the 2019 Global Competitiveness Report published by the World Economic Forum, Malaysia is ranked 27th most competitive nation in the world out of 141 countries. The Malaysian Government continues to ensure that the country remains an attractive business destination for investments. In our aspiration to achieve a

high-income economy, we are doubling our efforts to attract investments and drive productivity and innovation.

On 27th December 2019, Malaysia has introduced the Madrid System following the approval of the Trademarks Act 2019. The Madrid system allows individuals and companies established in other Contracting Parties of the Madrid System to have easier access to seek protection of the mark in any of the applicable Contracting Parties. By filing one international application through MyIPO in one language, and paying fees in one currency, applicants can obtain protection in multiple export markets. Subsequent management of trademark rights such as renewal is also centralized and easy. The Madrid System could serve as an engine of economic growth and development. It also supports the country's exports to the extent that it simplifies protecting trademarks abroad by merely designating the trademark protection in the international application.

To react and further utilize of the Madrid system, MyIPO in collaboration with European Union Intellectual Property Office (EUIPO) under the ARISE+ IPR Project funded by European Union has successfully introduce "The Madrid Protocol: A Route to Global Branding" booklet that provides the inputs and guidelines to protect trademarks internationally in all Madrid Protocol's member countries. This book elaborates the guide to protect branding in Malaysia and globally, benefits of the registration, procedure and requirements for filing the trademarks and best practices.

For Malaysia to compete in the global economy and manage through the business cycles, we have to be a step ahead. It is my fervent hope that our business community will make full use of the Madrid System to effectively protect and harness the value of their IP assets and thereby create opportunities for more wealth creation and economic growth. I also hope this booklet will be a good guidance and reference to the trademark owner in order to obtain protection in multiple export markets.

It is a great pleasure for MyIPO to cooperate with EUIPO and ARISE+ IPR in completing this activity and we are looking forward for more collaborations towards enhancing and prospering the IP regimes in the near future.

**Dato' Mohd Roslan Mahayudin**

Director General

Intellectual Property Corporation of Malaysia (MyIPO)



## 1. YOUR BRAND – YOUR STRONGEST ASSET

Your brand is the image that differentiates you from your competitors. It identifies your product, your service, your company. It may be represented by a sign, a symbol, a design, a word, a colour, or a combination thereof. It conveys a sense of quality, credibility, customer satisfaction. It plays a crucial role in your marketing strategy and is at the core of your business competitiveness. It generates customer loyalty and has a value. It may become your strongest asset.

### 1.1. BRANDING STRATEGIES AND BUSINESS SUCCESS

Branding aims at building a distinctive and attractive presence in the market that helps gain and retain loyal customers. Effective branding involves creating an image in the consumers' minds about the quality of a product or a service, mainly through advertising campaigns centred on the brand. It also requires ensuring the legal protection of the brand against competitors in the relevant markets. Branding strategies are at the core of sustained market competitiveness and business success.

### 1.2. BRAND CREATION, MANAGEMENT AND COMMERCIALISATION

Creating a brand implies choosing the signs that will distinguish your products or services from those of your competitors and getting them legally protected. The legal expression of your brand is a trademark. A trademark confers on you the exclusive right to prevent third parties from using the signs that distinguish your brand in the course of trade for identical or similar goods or services.



You can register your trademark in Malaysia by filing an application at the Intellectual Property Corporation of Malaysia (**MyIPO**). The registration of your trademark in Malaysia has a duration of 10 years and is renewable indefinitely for similar periods. Managing your brand implies regularly renewing your trademarks and enforcing your rights against infringers and counterfeiters. The assignment and licensing of trademark rights may play a significant role in brand commercialisation through partnership, merger and franchising initiatives.

### 1.3. PROTECTING YOUR BRAND IN EXPORT MARKETS

Protecting your brand outside Malaysia implies acquiring trademark rights in each of the export markets where you wish to commercialise your products or services. Trademark rights are territorial in nature and are only valid within the territory of a country (national trademark) or a group of countries having established a regional trademark system (e.g. the European Union). In principle, to acquire trademark rights abroad you need to file separate trademark applications at the trademark offices of the countries where you wish to have your brand protected. Once you get your rights in those countries you will need to follow separate procedures at those same offices to manage your rights (renew, license, or assign them). However, being a national of Malaysia, or a person domiciled or having an industrial or commercial establishment in Malaysia, you may take advantage of an alternative, more attractive, cost-effective and user-friendly route to acquire and manage your trademark rights abroad by making use of the Madrid Protocol, an international treaty that became effective in Malaysia on December 27, 2019.



## 2. THE MADRID PROTOCOL – A ONE-STOP SOLUTION TO PROTECT YOUR BRAND ABROAD

If you are a Malaysian company, society, firm, sole proprietor or any other entrepreneur, you can take advantage of the Madrid Protocol to protect your brand in more than 120 countries around the world, following a simple and cost-effective procedure for filing your trademark applications and managing your trademark registrations abroad.

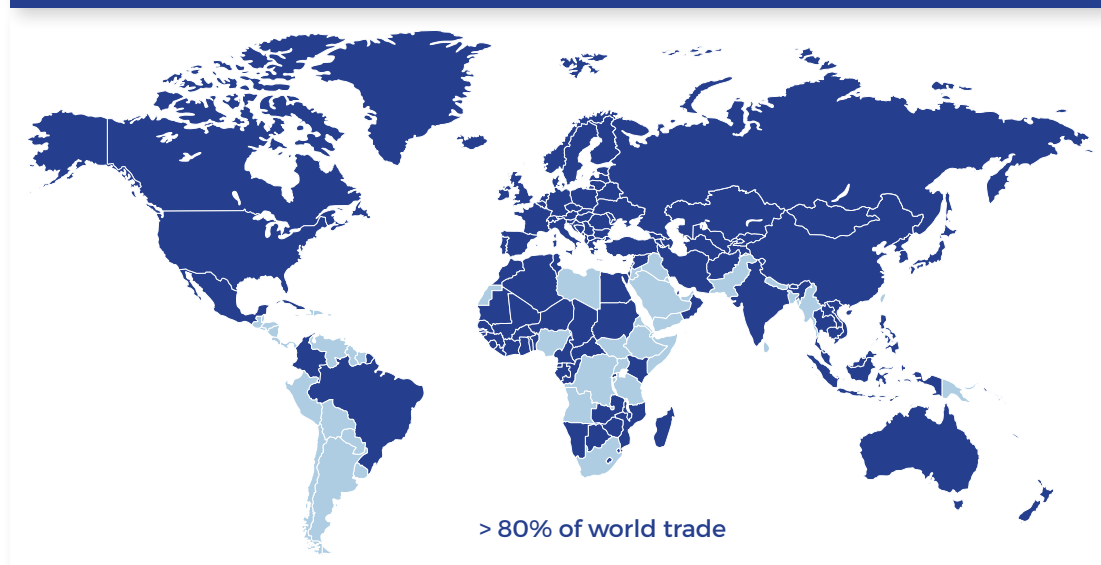
### 2.1. MADRID UNION MEMBERS – ATTRACTIVE MARKETS FOR MALAYSIAN EXPORTS

The Madrid Union, formed by the Contracting Parties to the Madrid Protocol, has 107 members (effective on January 12, 2021), including 105 States and two intergovernmental organisations (the European Union and the African Intellectual Property Organisation – OAPI), and covers the territories of 123 countries. The Madrid Union members represent more than 80 % of world trade flows and constitute very attractive markets for Malaysian exports.

Most of the top trading partners of Malaysia are Madrid Union members. The 15 top importers of Malaysian products in 2018, having accounted for more than 70% of the country's exports, included 13 Madrid Union members, namely (by descending order of export values): Singapore, China, United States of America, Japan, Thailand, India, Republic of Korea, Australia, Germany, Vietnam, Indonesia, Netherlands and the Philippines. Other Madrid Union members that also account for significant values of Malaysian exports include United Kingdom, France, Turkey, Italy, New Zealand, Brazil, Brunei Darussalam, and Cambodia.

### MADRID UNION MEMBERS

107 Members (including the European Union and OAPI) covering 123 countries as of January 12, 2021



## 2.2. MADRID PROTOCOL – USER-FRIENDLY PROCEDURES



The Madrid Protocol is administered by the World Intellectual Property Organization (**WIPO**), a specialised agency of the United Nations, based in Geneva, Switzerland. The Protocol allows you to obtain and maintain protection for your brand around the world by providing a user-friendly, expeditious and cost-effective set of procedures for the central filing of trademark applications and the central management of trademark registrations with effects in various countries.

### 2.2.1. CENTRAL FILING TO SEEK PROTECTION IN VARIOUS TERRITORIES

Based on your Malaysian trademark, you can file an **international application** at MyIPO designating all the members of the Madrid Union where you wish your mark to be protected. The application is forwarded to WIPO for examination, registration and publication. Once your mark has been recorded by WIPO in the International Register, it is notified to each of the designated Madrid Union members. Those members must decide whether they grant protection to your mark in their territories within very strict time limits. If a designated member does not communicate any objection within a given period from the date of notification (which may be 12 months, 18 months, or slightly longer than 18 months in case of opposition by a third party), the mark under international registration is deemed protected within the territory of that member as if the same had been registered directly with the IP office of that member.

### 2.2.2. CENTRAL MANAGEMENT OF YOUR TRADEMARKS

Once your **international registration** (IR) has been obtained and your mark is protected by one or more designated Madrid Union members, you will be able to manage your rights very easily by following online procedures at a single point (WIPO) to: (i) renew your trademark rights every 10 years; (ii) extend protection to new markets at any time; and (iii) request the central recording of various types of modifications to your registration (assignment of rights, change of name or address, limitations, renunciations).

## 2.3. ADVANTAGES – REDUCED COSTS, EFFECTIVE BRAND MANAGEMENT AND COMMERCIALISATION

**Central filing** of your trademark under the Madrid Protocol offers many advantages: you do not need to file separate trademark applications in many countries, drafted in different languages, pay fees in different currencies, hire the services of local representatives and follow different procedures in each of those countries. Instead, you can file a single international application at MyIPO, in a single language (English), pay fees in a single currency (Swiss francs) and your application will have effects in every Madrid Union member of interest to you. The procedure is very simple, user-friendly, expeditious and cost-effective. You make savings in translation costs and various types of fees (local representatives, currency exchanges). The strict time limits imposed on Madrid Union members to decide on the recognition of local rights, based on your international registration (IR), contribute to speed up protection procedures considerably.

The benefits of **central management** are even more important than those of central filing: once your IR has been obtained, you will need to monitor and manage just one renewal date and procedure in one place (WIPO), instead of many different dates and procedures at separate TM offices; you will always be able to extend protection of your mark to new markets very easily (through subsequent designations); and you will be able to make changes to your trademark registration (such as assignment of rights, change of name or address of holder or representative, limitations, renunciations) recorded in one single place (the International Register maintained by WIPO) at a very low cost.

Cost savings that result from using the Madrid System are particularly significant for small- and medium-sized enterprises (SMEs). Eighty per cent of Madrid System users have been categorised as SMEs, having a small portfolio of only one or two IRs.

However, the **advantages** of the Madrid Protocol are not only reduced costs and speedier procedures resulting from central filing and central management of IRs. The Protocol also offers you early brand presence abroad, as it is a means to acquire rapid international reputation and generate goodwill for your trademarks worldwide. From a company's strategic viewpoint, gaining early brand presence at a global scale offers additional economic benefits, including increased franchising opportunities and possibilities of partnering with international entrepreneurs to optimise life-cycle development and integrate global supply chains.

## WHY USE THE MADRID PROTOCOL?

### REDUCED COSTS AND SPEEDIER PROCEDURES TO PROTECT YOUR MARK

- Single application (at MyIPO)
- Single language (English)
- Single currency for fee payment (CHF)
- No need for multiple representatives upfront
- Single renewal date and request
- Single procedure for modifications
- Possibility to extend protection to new countries at any time

### YOU GAIN

- Early brand presence abroad
- International brand reputation and goodwill
- Franchising and partnership opportunities

### 3. CHOOSING YOUR TRADEMARK – BEST PRACTICES

Creating a brand implies choosing the sign (trademark) that will distinguish your products or services from those of your competitors.

In principle, any sign capable of distinguishing your goods or services from those of other undertakings in the market can constitute a trademark. Thus, your trademark may be constituted by a symbol, a design, a word, a colour, any other sign, or a combination thereof. However, when choosing your trademark, there are certain requirements or limitations that you need to consider.

- Your mark must be distinctive, meaning that it should consist of a sign that serves to identify your products or services and to distinguish them from those of other undertakings. Common geometrical designs (e.g. a rectangle, a circle, a square), common signs (e.g., simple letters or numerals up to two digits), common surnames and names of well-known places, are ordinarily regarded as non-distinctive signs.
- Your mark should not be laudatory (e.g., “best”, “excellent”) or descriptive of the specific goods or services that you wish to commercialise (e.g., “APPLE” for apples; or “PHARMA” for the sale of pharmaceutical products), as this may lead to refusal of registration.
- Your mark should be capable of being represented. Most trademark offices require graphical representation of the mark (i.e. it should be capable of being reproduced on paper). Some offices accept other means of representation for special types of marks (e.g. MP3 audio recordings for sound marks). However, the Madrid System still requires that your mark be graphically represented.
- Your mark should not be functional, which means that the sign that constitutes your trademark should not consist exclusively of a characteristic that results from the nature of the goods themselves or that is necessary to obtain a technical result. This is especially relevant in the case of three-dimensional marks.
- Your mark should not be deceptive. A sign conveying a false origin or false characteristics of a product can be refused protection on the grounds of being deceptive.
- Signs that are contrary to public order or morality (e.g. that hurt religious sentiments of a section of the public or contain obscene matters) may be excluded from protection as a trademark.
- State flags, State emblems and names and emblems of intergovernmental organizations are excluded from protection as trademarks in most countries around the world.
- Finally, and most importantly, you must make sure that the sign you wish to use as your trademark is still available in the market and is not the same or similar to a well-known mark or a trademark already registered or applied for registration by someone else for the same goods or services. Therefore, it is very important that you make an exhaustive search for the availability of your trademark in those markets where you would like to get it protected.

#### TIP

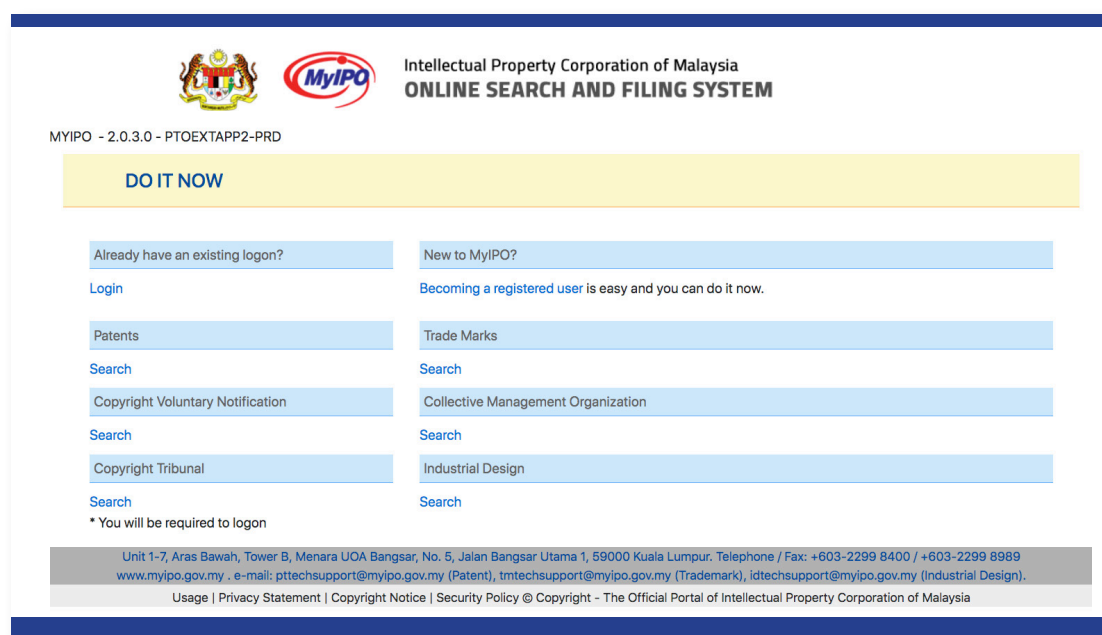
- ▶ *Choose your mark carefully*
- ▶ *Make sure it is not prohibited by law*
- ▶ *Check it does not belong to someone else (search at home and abroad)*



### 3.1. SEARCHING FOR A TRADEMARK IN MALAYSIA

Before filing a national application at MyIPO to obtain protection for your mark in Malaysia, you should make sure that the sign that you are planning to use as a mark in Malaysia is not excluded from protection by law. You may find the text of the Trademarks Act 2019 (Act 815) of Malaysia at <http://www.myipo.gov.my/wp-content/uploads/2019/12/ACT-815-TRADEMARKS-ACT-201.pdf>

You should also check whether the sign that you are planning to register at MyIPO has not already been applied for, or registered as a trademark, for the same goods or services by someone else. You can do so by consulting the MyIPO Online Search and Filing System available at: <https://iponlineext.myipo.gov.my/SPHI/Extra/Default.aspx?sid=637429484996415808>



Intellectual Property Corporation of Malaysia  
**ONLINE SEARCH AND FILING SYSTEM**

MYIPO - 2.0.3.0 - PTOEXTAPP2-PRD

**DO IT NOW**

Already have an existing logon? <a href="#">Login</a>	New to MyIPO? Becoming a registered user is easy and you can do it now.
Patents <a href="#">Search</a>	Trade Marks <a href="#">Search</a>
Copyright Voluntary Notification <a href="#">Search</a>	Collective Management Organization <a href="#">Search</a>
Copyright Tribunal <a href="#">Search</a>	Industrial Design <a href="#">Search</a>

\* You will be required to logon

Unit 1-7, Aras Bawah, Tower B, Menara UOA Bangsar, No. 5, Jalan Bangsar Utama 1, 59000 Kuala Lumpur. Telephone / Fax: +603-2299 8400 / +603-2299 8989  
www.myipo.gov.my . e-mail: pttechsupport@myipo.gov.my (Patent), tmtechsupport@myipo.gov.my (Trademark), idtechsupport@myipo.gov.my (Industrial Design).

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### 3.2. SEARCHING FOR A TRADEMARK ABROAD – ONLINE DATABASES (ASEAN TMVIEW, TMVIEW, GLOBAL BRAND)



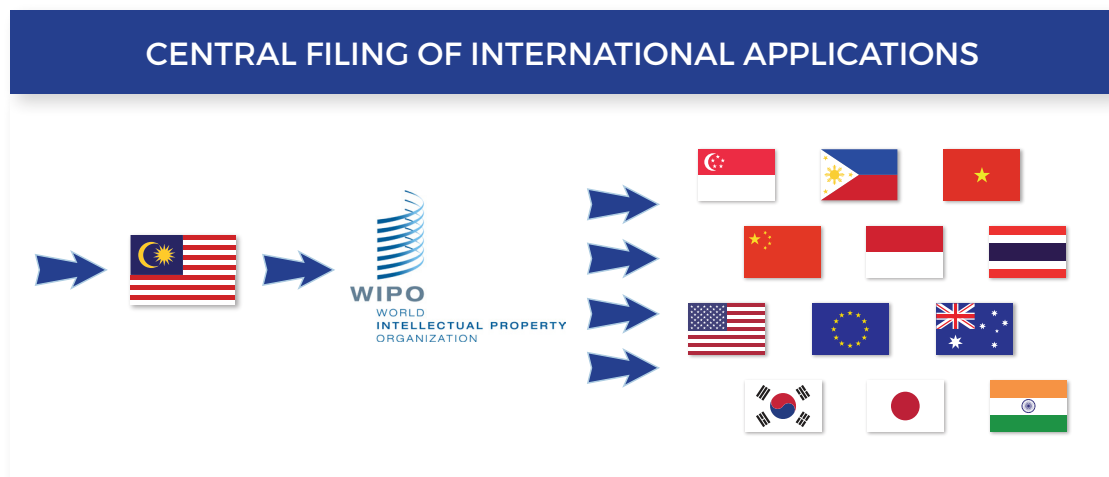
Before filing an international application to protect your mark abroad, you should check whether the sign you are planning to use as your trademark in export markets does not belong to someone else there. This implies making a search for identical or similar trademarks already protected in those markets for the same goods or services. Several trademark offices of Madrid Union members offer the possibility to search their trademark databases online at their own individual websites. However, the best way to start making your searches for similar trademarks is to consult TMview, ASEAN TMview and the WIPO Global Brand Database.

**TMview** (<https://www.tmdn.org/tmview/#/tmview>) is a trademark information platform built by 74 trademark offices from around the world (national, regional and international), aimed at making trademark data widely available and easily accessible to the public, free of charge. **ASEAN TMview** (<http://www.asean-tmview.org/tmview/welcome>) is a similar database built by nine ASEAN Member States with the collaboration of TMview. TMview and ASEAN TMview offer the possibility to explore the overall trademark landscape in more than 100 countries around the world (in Europe, Asia and the Pacific, Africa and the Americas). These platforms give access to information on more than 60 million trademark applications and registrations having effects in those countries, plus international registrations under the Madrid System, including data regarding trademark name, applicant's name, trademark type, graphic representation, legal status, list of goods and services, class codes, etc. TMview and ASEAN TMview allow you to carry out trademark searches 24 hours a day, 7 days a week, in a user-friendly way. The accuracy of the data shown in those databases is the sole responsibility of the participating trademark offices providing it. Since its introduction in April 2010, and up to April 2020, TMview has served more than 70 million searches from 169 different countries.

To explore the trademark landscape abroad you can also consult the **Global Brand Database** (<http://www.wipo.int/branddb/en/index.jsp>), an online gateway managed by WIPO that contains more than 44 million records from 67 national and international collections, including data on trademarks (including Malaysian trademarks), appellations of origin and armorial bearings, flags and other State emblems protected in various countries around the world, as well as the names, abbreviations and emblems of intergovernmental organizations.

## 4. PREPARING AND FILING YOUR INTERNATIONAL TRADEMARK APPLICATION – BEST PRACTICES

Once you have selected your trademark for protection abroad, and provided that you fulfil the necessary requirements, you are ready to prepare and file your international application.



### 4.1. REQUIREMENTS – ENTITLEMENT + BASIC MARK IN MALAYSIA



MyIPO processes the Madrid Protocol international applications originating in Malaysia. You are entitled to file an international application at MyIPO if: (i) you are a national of Malaysia, or you are a natural person or legal entity domiciled in Malaysia, or you have a real and effective industrial or commercial establishment in Malaysia, and (ii) you have a 'basic mark' in Malaysia, which means that your mark has already been registered or applied for national protection at MyIPO.

## 4.2. FILING YOUR INTERNATIONAL APPLICATION AT MYIPO

If you wish to file a Madrid Protocol international application, you must fill out a special form (**MM2**), in English, that you can download from the WIPO website (<http://www.wipo.int/madrid/en/forms/>). Once you have filled out the MM2 form, you must file it at MyIPO and pay to MyIPO a handling fee that currently amounts to Ringgit Malaysia 200 (RM 200) using MyIPO form TMMP1. For further details on the Madrid Protocol related information offered by MyIPO, please see <http://www.myipo.gov.my/en/madrid-system/>.



## 4.3. CONTENT OF YOUR INTERNATIONAL APPLICATION – MANDATORY, OPTIONAL

Your international application (MM2) must contain: (i) your name, address and electronic mail address; (ii) the reproduction of your mark, which must be identical to your basic mark in Malaysia; (iii) a list of goods and services for which protection is sought, which must be fully covered by those indicated in your basic mark; and (iv) a list of Madrid Union members in which protection for the mark is sought (designated Contracting Parties or DCPs). These requirements are mandatory and their absence affects the date of the international application.

The international application (MM2) must also contain: (i) an indication of your entitlement to file (establishment or domicile in Malaysia, or Malaysian nationality); (ii) a priority claim, if applicable; (iii) the name and address of a representative, if appointed; (iv) the number and date of your basic mark in Malaysia; (v) indications of the mark (kind of mark, colour claim if applicable); (vi) a description of the mark, if required by MyIPO; (vii) a transliteration of the mark, if applicable<sup>1</sup>; (viii) the amount of the fees being paid and the method of payment.

Some additional content (e.g. a declaration of the intention to use the mark) may be required when certain Madrid Union members are designated in the application (see section 4.5, below).

<sup>1</sup> If the mark consists of, or contains, matter in characters other than Latin characters or numerals other than Arabic numerals, a transliteration into Latin characters or Arabic numerals must be provided.



The international application may also contain (optional content): (i) an indication of your nationality or, if you are a legal entity, your legal nature and the State under the law of which you have been established as a legal entity; (ii) a translation of the mark; (iii) a voluntary description of the mark; (iv) an indication in words of the principal parts of the mark that are in colour, when colour is claimed; and (v) a disclaimer.

For more information on how to fill out your international application form (MM2), you may consult the “Notes for Filing for MM2 and MM4 to MM12” at <http://www.wipo.int/madrid/en/forms/> and the WIPO Guide to the International Registration of Marks, pages B.II.7 to B.II.20, at the following address: <http://www.wipo.int/madrid/en/guide/>

## TIP

*To help you fill out your IA, check “Notes for Filing MM2 and MM4 to MM12” at <http://www.wipo.int/madrid/en/forms/>*

### 4.4. DRAWING YOUR LIST OF GOODS AND SERVICES – USING CLASSIFICATION TOOLS (TMCLASS, ASEAN TMCLASS, MGS)



When filing a trademark application (either national or international), you must correctly indicate the goods and services for which trademark protection is sought (terms that are too vague, linguistically incorrect or incomprehensible are not accepted); and these goods and services must be correctly classified in accordance with the International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Classification).

To make sure that your list of goods and services complies with the necessary requirements to be accepted both at the national and international levels, it is highly recommended that you consult **TMclass** (<https://euipo.europa.eu/ec2/>) and **ASEAN TMclass** (<http://www.asean-tmclass.org/ec2/>). These are two free-of-charge online search and classification tools that allow you to choose terms for goods and services that are accepted as correctly formulated and classified by 84 trademark offices (national, regional, international) from around the world. The offices participating in TMclass include those of Malaysia, China, European Union, Japan, United States of America, and many others. All the ASEAN offices participate in ASEAN TMclass.

When preparing your international application, it is also useful to consult the Madrid Goods & Services Manager (**MGS**) (<https://webaccess.wipo.int/mgs/>), a free-of-charge online tool offered by WIPO that helps you compile the list of goods and services that you need to submit when filing an international application. MGS gives you access to some 52 thousand standard terms of goods and services in English correctly classified by WIPO according to the latest edition of the international classification (Nice Classification) and accepted by WIPO under the Madrid System procedures. Moreover, it allows you to check whether the terms you plan to indicate are also accepted by the Offices of 39 Madrid Union members, including those of China, United States, European Union, etc.

Even earlier, already when preparing a national trademark application in Malaysia that will serve you as the basis (basic mark) for your international application, you may wish to consult TMclass, ASEAN TMclass and MGS. These databases will help you draft your list of goods and services for both applications. You should consider that the goods and services in your international application should be fully covered by those indicated in your basic mark.

## 4.5. DESIGNATING THE TERRITORIES WHERE TO GET PROTECTION

In your international application, you must designate all the Madrid Union members (Madrid Protocol Contracting Parties) where you wish your mark to be protected. By simply checking the box next to each member's name in the application form (MM2) you can designate any Madrid Union member except Malaysia. Your trademark in Malaysia (basic mark) will continue to be protected under Malaysian law as registered by MyIPO.

At present (January 2021), you can designate up to 106 Contracting Parties to the Madrid Protocol, including 104 States and two intergovernmental organizations, namely the European Union and the African Intellectual Property Organization (OAPI). By designating the European Union, you may get protection for your trademark in its 27 Member States. By designating OAPI, you may get protection for your trademark in its 17 Member States.



Certain Contracting Parties have special requirements that you need to consider when designating them in your international application. If you designate the European Union (EM code in the MM2 form), you must indicate a second working language for procedures before the EUIPO in the application form (MM2), and you must attach an additional form (MM17) if you further wish to claim European Union seniority (for more details, please see section 6.2, on getting protection in the European Union, below).



If you designate the United States of America (US), you need to attach an additional form (MM18) to your international application (MM2) declaring your intention to use the mark in the US. Moreover, if you are a natural person, you should indicate your nationality in the international application form (MM2) and, if you are a legal entity, you should indicate your legal nature and the State under the law of which you have been organized as a legal entity.

### MADRID PROTOCOL

#### Top destinations of Malaysian filings (2020) (# designations in international applications + subsequent designations)

CONTRACTING PARTY	# DESIGNATIONS (IA+SD)	CONTRACTING PARTY	# DESIGNATIONS (IA+SD)
Philippines	40	Republic of Korea	18
Singapore	38	Japan	16
Vietnam	38	European Union	15
Indonesia	30	New Zealand	14
China	29	Russian Federation	12
Thailand	27	India	11
USA	22	Brazil	7
Canada	20	United Kingdom	6
Australia	19	Brunei Darussalam	5
Cambodia	19	Mexico	5

Source: WIPO Statistics database – January 2021

Finally, if you designate Brunei Darussalam, India, Ireland, Lesotho, Malawi, Mozambique, New Zealand, Singapore or the United Kingdom, by simply checking the boxes next to their country names in the international application form (MM2), you are declaring your intention to use the mark in those countries.

#### 4.6. ESTIMATING COSTS AND PAYING FEES—MADRID FEE CALCULATOR, PAYMENT METHODS

Your international application must be accompanied by the payment of a set of fees in Swiss francs (CHF) to WIPO, to include:

- (i) a basic fee of CHF 653, if no reproduction of your mark is in colour, or CHF 903, if any reproduction of your mark is in colour;
- (ii) an individual fee for each DCP having fixed individual fees (see below);
- (iii) a complementary fee of CHF 100 for each DCP not having fixed individual fees; and,
- (iv) a supplementary fee of CHF 100 for each class of goods and services beyond three classes, except if you only designate Contracting Parties having fixed individual fees.

So far, 63 trademark offices of Contracting Parties to the Madrid Protocol charge individual fees. You can check the list of these offices and the amounts to be paid with respect to each of them at the following address: [http://www.wipo.int/madrid/en/fees/ind\\_taxes.html](http://www.wipo.int/madrid/en/fees/ind_taxes.html).

To facilitate your calculation of the fees to be paid for your international application, WIPO offers a very practical online tool known as the Fee Calculator, which you can access at the following address: <http://www.wipo.int/madrid/en/fees/calculator.jsp>.

Regarding payment methods, you may pay your fees to WIPO either by: (i) bank transfer; or (ii) WIPO Current Account. For more details, please see: <http://www.wipo.int/about-wipo/en/finance/madrid.html>.

#### TIP

*Find out about procedures and practices in Madrid Union members in the Madrid Member Profiles Database at <http://www.wipo.int/madrid/memberprofiles/#/>.*

#### 4.7. CERTIFICATION BY MYIPO AND REMEDYING POSSIBLE IRREGULARITIES

Before forwarding your international application to WIPO, MyIPO will check that: (i) you are the same person as the applicant or holder of the basic mark in Malaysia; (ii) the mark in your international application is identical to the basic mark; and (iii) the goods and services in your international application are covered by those in the basic mark. If these three conditions are complied with, MyIPO will certify your international application and forward it to WIPO with an indication of the date on which the international application was received by MyIPO.

If you made a mistake in the classification of goods or services, or if the indication of any of the goods or services in your international application is considered by WIPO to be too vague, linguistically incorrect or incomprehensible, WIPO will issue an irregularity notice and give MyIPO a three-month time limit to make the necessary correction(s).

If there are some other deficiencies in your international application (e.g., you do not appear to be entitled to file your application through MyIPO as office of origin; or your application has not been presented in the MM2 form, or is not typed or not signed by MyIPO), WIPO will issue an irregularity notice and give MyIPO a three-month period to remedy those irregularities, failing which the international application will be considered abandoned.

Similarly, if one or more elements in the international application are missing (indications allowing WIPO to identify your identity and sufficient to contact you or your representative; your entitlement to file at MyIPO; the date and number of the basic mark; a reproduction of the mark; the list of goods and services; an indication of DCPs; MyIPO's certification), WIPO will give MyIPO a three-month period to remedy such irregularities, failing which the international application will be considered abandoned.

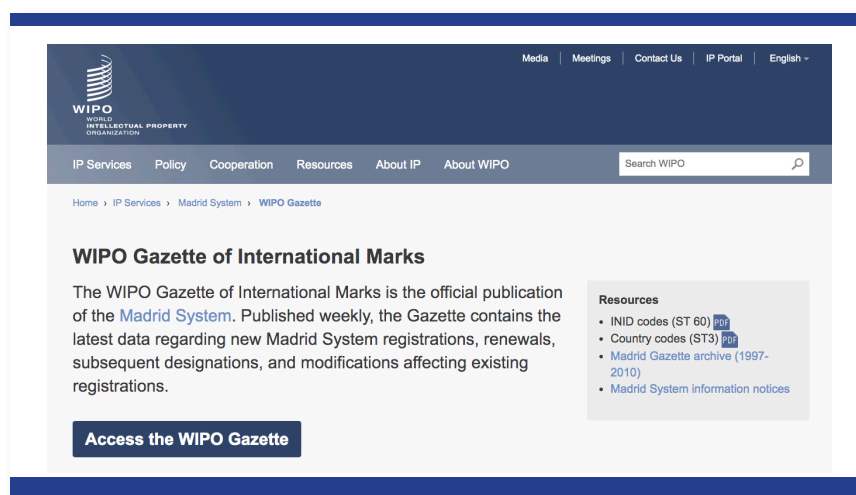
If there are other irregularities (e.g. your address is incomplete or your email address is missing; the reproduction of the mark is not sufficiently clear; no fees have been paid or their amount is insufficient), WIPO will notify any such irregularity directly to you and ask you to remedy it within three months. Failure to do so may result in your application being considered abandoned.

Finally, if you have designated the US and you have failed to attach the MM18 form containing a declaration of your intention to use the mark in the US, WIPO will invite you, through MyIPO, to attach that form within a two-month period from the date of receipt of the international application by MyIPO. If this is not done within that period, your US designation will be considered as withdrawn.



## 5. THE INTERNATIONAL TRADEMARK REGISTRATION (IR)

If your international application conforms to the applicable requirements, WIPO will register your mark in the International Register, publish the international registration (IR) in the WIPO Gazette of International Marks, and notify it to the Offices of the designated Contracting Parties (DCP). It will also inform MyIPO and send you an international registration certificate.



### 5.1. DATE AND EFFECTS

#### 5.1.1. DATE OF THE INTERNATIONAL REGISTRATION

As a rule, your IR will bear the date on which your international application was received by MyIPO, unless your application has reached WIPO more than two months after that date (in which case your IR will bear the date in which it was actually received by WIPO).

The date of your IR may be affected if any of the following elements is missing: your name or address, the designation of the Contracting Parties where protection is sought, a reproduction of the mark, the indication of the goods or services for which protection of the mark is sought. MyIPO will be notified of any such irregularity, which should be remedied within a maximum period of three months. The date of your IR will depend on the date on which the last missing element is received by WIPO.

#### 5.1.2. EFFECTS OF THE INTERNATIONAL REGISTRATION

From the date of your IR, your mark will enjoy the same protection in each designated Contracting Party (DCP) as if your mark had been filed or applied for directly in that DCP.

A DCP may refuse protection for your mark on the same grounds that would apply under its national law to marks filed directly with the Office of that DCP (e.g. because the mark already belongs to someone else in that DCP). Such a refusal would be subject to review or appeal in accordance with the laws and practice of the DCP concerned. You will find information on practices and procedures in Madrid Union members in the Madrid Member Profiles Database at <http://www.wipo.int/madrid/memberprofiles/#/>

Where a DCP does not refuse protection for your mark within a prescribed time limit (12 months, 18 months, or slightly longer than 18 months in case of opposition by a third party), or if such a refusal has been subsequently withdrawn, the protection of your mark in that DCP will be the same as if your mark had been registered by the Office of that DCP as from the date of your IR.

In all the DCPs not having refused protection your mark will be valid for a period of 10 years as from the date of its IR, with the possibility of indefinite renewal for further periods of 10 years.

## TIP

*Find out about procedures and practices in Madrid Union members in the Madrid Member Profiles Database at <http://www.wipo.int/madrid/memberprofiles/#/>*

## 5.2. MANAGING YOUR INTERNATIONAL REGISTRATION – BEST PRACTICES

While the Madrid System offers you many advantages to get your trademark protected in various markets, it offers you even more valuable advantages regarding the management of your mark after registration. Extending protection of your mark to new territories, renewing the protection of your mark for additional periods of 10 years, or having changes to your registration recorded in the International Register with effects extending to those Madrid Union members of interest to you, can be done through very simple, user-friendly and cost-effective procedures.

### 5.2.1. EXTENDING PROTECTION TO NEW TERRITORIES (SUBSEQUENT DESIGNATIONS)

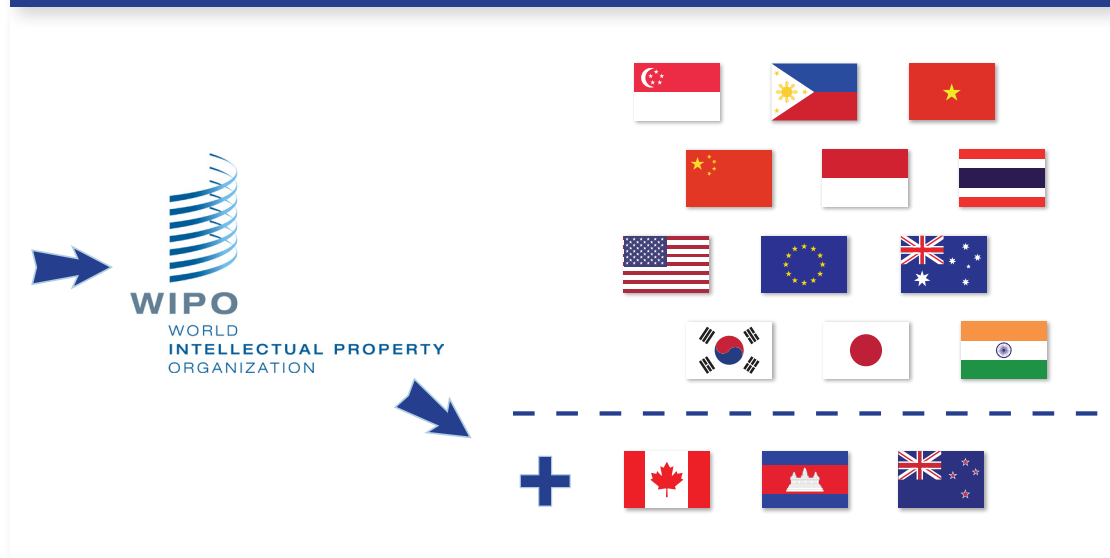
If you are the holder of an IR that extends its effects to only some Madrid Union members (Contracting Parties) you may, at any time, seek to extend the protection of your mark to other Madrid Union members that were not designated in your original international application. You simply need to present a **subsequent designation** directly to WIPO.

The subsequent designation must be presented in the official form (MM4), downloadable from <http://www.wipo.int/madrid/en/forms/>, and may be filled out and submitted electronically through the WIPO e-Subsequent Designation facility (<https://www3.wipo.int/osd/>). The subsequent designation will bear the date of receipt at WIPO. For any doubt, you may contact WIPO at the following address: <https://www3.wipo.int/contact/en/madrid/>

In the MM4 form, you must indicate the number of your IR, your name and address (as recorded in the International Register), the Contracting Party or Parties to which an extension of the protection is sought, and the goods and services for which the subsequent designation is made (which may be all or only some of those covered by the IR). With respect to some Contracting Parties (European Union, United States), you may need to include some additional information (as indicated in section 4.5, above).

The fees payable in respect of a subsequent designation include a basic fee (CHF 300), an individual fee for each DCP having fixed individual fees ([http://www.wipo.int/madrid/en/fees/ind\\_taxes.html](http://www.wipo.int/madrid/en/fees/ind_taxes.html)), and a complementary fee (CHF 100) for each DCP not having fixed individual fees. The Fee Calculator (<http://www.wipo.int/madrid/en/fees/calculator.jsp>) may be used to calculate the fees payable.

## SUBSEQUENT DESIGNATION OF ADDITIONAL CONTRACTING PARTIES



If the DCP does not refuse protection for your mark within the prescribed time limit (12 months, or 18 months, or slightly longer than 18 months in case of opposition by a third party), or if such a refusal has been subsequently withdrawn, the protection of your mark in that DCP will be the same as if your mark had been registered by the Office of that DCP as from the date of its subsequent designation.

In all the DCPs not having refused protection, your mark will be valid for the remaining duration of your IR, with the possibility of indefinite renewal for further periods of 10 years.

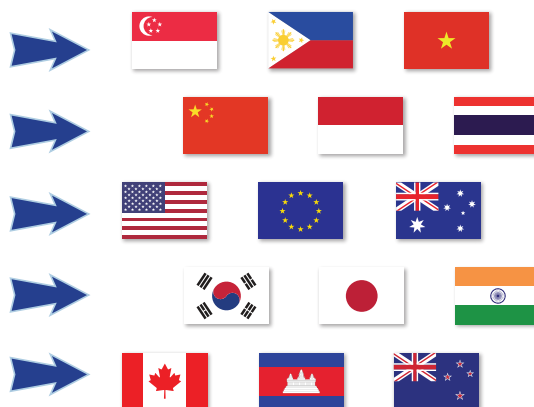
### TIP

*To extend protection to new Madrid Union Members, use the E-Subsequent Designation facility at <https://www3.wipo.int/osd/>.*

### 5.2.2. CENTRAL RECORDING OF MODIFICATIONS TO YOUR INTERNATIONAL REGISTRATION

During the lifetime of your IR you may, at any time, request WIPO to record in the International Register a change of your name or address or that of your representative, a voluntary restriction in the protection of your IR (limitation, renunciation, cancellation), a change in ownership of your mark, or a licence, having effects in all or some of the DCPs. To request the recording of any such modification, you must use the relevant official form, available at the WIPO website (<http://www.wipo.int/madrid/en/forms/>). The central recording of such modifications in the International Register relieves you from the need to request such action from the Office of each DCP, thus resulting in very significant savings.

## RENEWAL / MODIFICATION OF INTERNATIONAL REGISTRATIONS



To request the recording of a **change of name or address of the holder** of the international registration (without change in ownership), you must use form MM9. Your request may refer to several IRs. The fee payable to WIPO will amount to only CHF 150. If the only change to be recorded concerns your contact details (address for correspondence, email address, or phone number), no fee is payable. A change of name or address recorded in the International Register has immediate effects in all the DCPs concerned by the IR at no additional cost.

If you are the holder of an international registration and happen to transfer your mark to a new owner for all or some of the goods and services for which it is protected, in respect of all or some of the DCPs, you can request that the **change in ownership** be recorded in the International Register. Such recording can only take place if the new owner is a person entitled to use the Madrid System (either through nationality, or establishment or domicile in a Contracting Party). The request may refer to several IRs provided that the change in ownership applies to all or the same DCPs and concerns all or the same goods and services. The request must be submitted to WIPO in the official form MM5 and is subject to the payment of a fee (CHF 177). The change in ownership recorded in the International Register will have immediate effects in all the DCPs concerned at no additional cost.

To request the recording of a **change of name or address of representative**, you must use form MM10. The recording of such a change is free of charge.

To request a **limitation** of the list of goods and services, which may affect some or all the DCPs, you must use form MM6. This request is subject to the payment of a fee (CHF 177) to WIPO. No additional fee will be charged by the DCPs concerned.

If you wish to record a **renunciation** of the protection for all the goods and services in respect of some (not all) the DCPs, you must use form MM7. If your request concerns the **cancellation** of the IR for some or all the goods and services in respect of all the DCPs, you must use form MM8. These requests (renunciation and cancellation) are free of charge.



If you license your mark, you may request the **recording of the licence** in the International Register by indicating the name and address of the licensee, the DCPs with respect to where the licence is granted, and the goods and services for which the licence is granted. The request must be submitted in form MM13 and is subject to the payment of a fee amounting to CHF 177. The recording of the licence in the International Register will only have effects in those countries whose domestic laws provide for the recording of licenses and have not made a declaration stating that they do not recognize the effects of the recording of licences in the International Register.<sup>2</sup>

### 5.2.3. RENEWING YOUR INTERNATIONAL REGISTRATION

To ensure that after a period of 10 years from registration your mark continues to be protected for an additional period of 10 years in those territories where you so wish, you simply need to renew your IR by paying the necessary fees to WIPO. The fees due for renewal include: a basic fee (CHF 653), an individual fee for each DCP having fixed one ([http://www.wipo.int/madrid/en/fees/ind\\_taxes.html](http://www.wipo.int/madrid/en/fees/ind_taxes.html)), a complementary fee (CHF 100) for each DCP that has not adopted an individual fee system, and a supplementary fee (CHF 100) for each class of goods and services more than three, except if you only renew protection with respect to DCPs having fixed individual fees.

A system for the electronic renewal of IRs (**e-Renewal Service**) is available on the WIPO website and can be accessed through the WIPO IP Portal (<https://ipportal.wipo.int/>). You can calculate the exact amount you should pay for the renewal of your IR by using the Fee Calculator made available by WIPO (<http://www.wipo.int/madrid/en/fees/calculator.jsp>). You can pay your renewal fees using a credit card or a WIPO Current Account if you have one.

The renewal fees should be paid to WIPO at the latest on the date of expiry of the IR. The payment can still be made up to six months after that date (grace period) provided that a surcharge is paid at the same time. WIPO records the renewal with the date on which it was due, even if the fees required were paid within the grace period.

The effective date of renewal of your IR is the same for all DCPs. This is a clear advantage of the Madrid route as compared to the national route where you have separate marks at separate TM offices having to be renewed at different dates.

#### TIP

**To renew your IR use the Madrid e-Renewal Service at the WIPO IP Portal**  
<https://ipportal.wipo.int/>

<sup>2</sup> 23 Madrid Union members have declared that they do not recognize the effects of the recording of licences in the International Register: Afghanistan, African Intellectual Property Organization (OAPI), Brazil, Cambodia, Canada, China, Colombia, Gambia, Georgia, India, Indonesia, Japan, Kyrgyzstan, Lao PDR, Malawi, Malaysia, Mexico, Republic of Korea, Republic of Moldova, Russian Federation, Samoa, Singapore and Thailand. In those Contracting Parties, licences must be recorded directly with their own trademark offices, in accordance with their domestic laws. Australia and New Zealand have declared that they do not provide for the recording of licenses in their domestic law so that the recording of licences in the International Register has no effect in their territories.

### 5.3. FIVE-YEAR DEPENDENCY AND TRANSFORMATION – INDEPENDENCE THEREAFTER

It is important that you consider that, for a period of five years (dependency period) the fate of your IR will remain dependent on the fate of your basic mark (application or registration) in Malaysia. If, for whatever reason, your basic mark in Malaysia ceases to have effect in whole or in part (rejection or withdrawal of your basic application, or cancellation, renunciation, revocation, invalidation, or lapse of your basic registration) within that period (five years from the date of your IR), your IR will be cancelled in whole or in part (only for some goods or services) accordingly.

To soften the consequences of this dependency feature, the Madrid Protocol provides the possibility of 'transformation' of your IR into a national or regional application in each of the DCPs. Within three months of the cancellation of your IR, you may apply for the registration of that same mark in those DCPs and those applications (based on the 'transformation' of your IR) will be treated as if they had been filed on the date of the original IR (therefore maintaining the earlier rights that you enjoyed).

At the end of the five-year dependency period, your IR becomes completely independent of your basic mark and cannot be cancelled any longer if the latter happens to cease to have effect.

### 5.4. ONLINE TOOLS TO MONITOR AND MANAGE INTERNATIONAL REGISTRATIONS

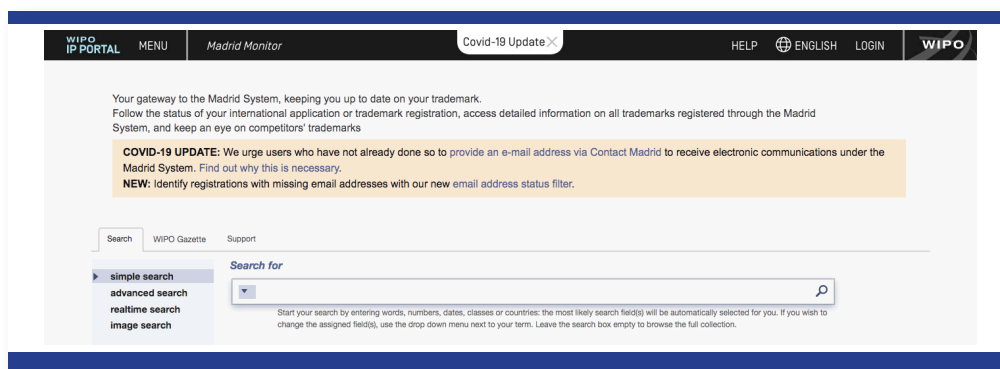
In addition to the abovementioned online services that make it easier for you to elaborate your lists of goods and services (MGS), file subsequent designations (e-Subsequent Designation), submit renewal requests (e-Renewal at the WIPO IP Portal), and calculate fees (Fee Calculator), WIPO offers another two online services that make it easier for you to monitor your IR and those of your competitors and to manage your IR portfolio. Below is a brief description of these two services.

#### 5.4.1. MADRID MONITOR

**Madrid Monitor** (<http://www.wipo.int/madrid/monitor/en/>) is a WIPO e-service that offers access to information on all trademarks registered under the Madrid System. It has an intuitive search interface offering several search options (simple search, advanced search, real-time search, image search).

Using the Madrid Monitor real-time search function you can track the status of your international application as it moves through WIPO's examination process, and you can monitor the progress of your IR in each DCP and find out whether protection for your mark has been granted or refused there.

The simple search and advanced search functions allow you to make searches in the whole Madrid system database by words (mark, good or service, name of holder or representative, office of origin, DCP, etc.), numbers (for registration, basic application, Nice class, Vienna class, etc.) or a combination thereof. The image search function allows you to make searches by picking an image, an image type or an image search strategy.

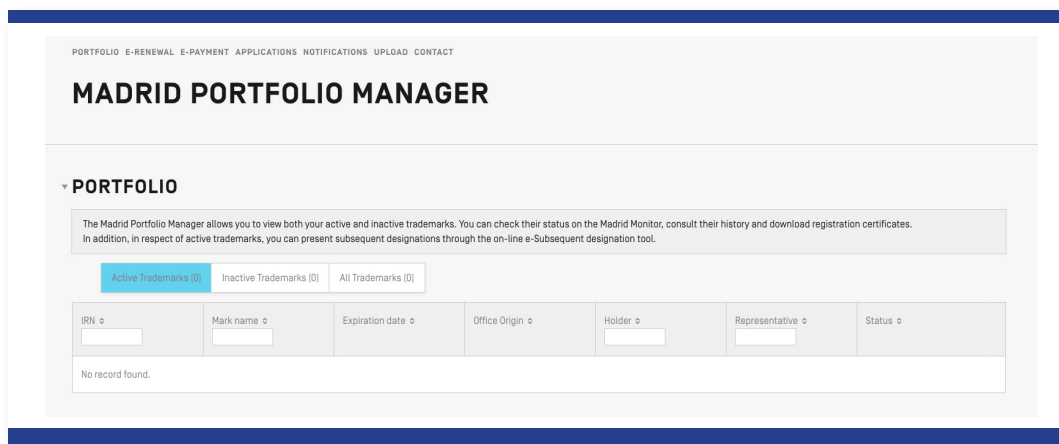


Madrid Monitor also allows you to consult the WIPO Gazette of International Marks, the official Madrid System weekly publication that contains the latest data regarding IRs, renewals, subsequent designations, and modifications affecting existing registrations.

To facilitate the monitoring of your own trademarks and/or those of your competitors, Madrid Monitor offers you the possibility to register to receive email alerts of any change related to the trademarks of your interest. To subscribe to the email alerts service you need a WIPO user account that you can create at <https://www3.wipo.int/wipoaccounts/generic/public/register.xhtml>.

#### 5.4.2. MADRID PORTFOLIO MANAGER (MPM)

**Madrid Portfolio Manager (MPM)** is an online service available at the WIPO IP Portal (<https://ipportal.wipo.int/>) that allows you to manage your portfolio of international trademark registrations with secure access from a single account. To access the WIPO IP Portal and use MPM you need a WIPO user account (<https://www3.wipo.int/wipoaccounts/generic/public/register.xhtml>) linked to an email address. You can establish your own portfolio by collecting all the IRs linked to the same email address. Using MPM you will be able to submit requests for changes, renewals and subsequent designations; track the status of your requests; pay fees; delegate management responsibility for all or part of your portfolio; view and securely download communications from trademark offices and WIPO concerning your registration; and request extracts from the International Register.



## 6. PROTECTING YOUR TRADEMARK IN THE EUROPEAN UNION



In the European Union (EU), there is a four-tier system for registering trademarks. What you choose depends on the needs of your business.



If you just want protection in one EU Member State, you can file a trademark application directly at the relevant national IP office. This is the national route available in 24 EU Member States (Austria, Bulgaria, Croatia, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Malta, Poland, Portugal, Romania, Slovakia, Slovenia, Spain, and Sweden).

If you want protection in Belgium, Luxembourg and the Netherlands, you can file a trademark application at the Benelux Office of Intellectual Property (BOIP), a regional-level IP office for trademark protection in those three Member States. This is the **Benelux regional route**.

If you want protection in more EU Member States, you can apply for a European Union trademark (EUTM) from the European Union Intellectual Property Office (EUIPO) — this is the **European route**. The EUTM is valid in the territories of all 27 EU Member States.

A fourth route to trademark protection in the EU is the **international route** or Madrid System route, which can be combined with any of the three mentioned above. A person filing an international application under the Madrid System can designate for protection any of the EU Member States that are Contracting Parties to the Madrid Protocol individually, or can designate the Benelux (for protection in Belgium, Luxembourg and the Netherlands), or can designate the European Union (for protection in the 27 EU Member States through one single designation).<sup>3</sup>

The following sections analyse the benefits of obtaining a trademark right valid in all 27 EU Member States either by following the European route (direct filing at the EUIPO) or the international route (Madrid filing designating the EU).

### 6.1. DIRECT FILING AT THE EUIPO (THE EUROPEAN ROUTE)



Applying for a European Union trademark (**EUTM**) directly at the EUIPO, instead of filing separate trademark applications and getting separate rights under each of the national + Benelux systems existing in the European Union (EU), is an attractive route if you wish to get a single trademark right that is valid in all 27 EU Member States.

You can file your application online at the EUIPO website (<https://euipo.europa.eu/ohimportal/en/apply-now>). The EUTM gives you an exclusive right valid in all the EU Member States (current and future)

<sup>3</sup> Following the withdrawal of the United Kingdom from the European Union (Brexit), and after the end of the transition period (December 31, 2020), Madrid international registrations (IR) having effect in the European Union no longer have effect in the United Kingdom. The United Kingdom (UK) has taken steps to deliver continued protection to marks in those IR by recording in its Register a comparable UK trademark for every IR granted protection in the EU before January 1, 2021. These newly created UK trademarks are independent from the IR and governed by the UK law. Holders whose IR were still pending before the European Union by the end of the transition period, are able to apply for trademark registration with the UK IPO in the nine months after January 1, 2021, and preserve the date of the designation of the European Union. For further details, please refer to guidance issued by the Government of the United Kingdom, which is available at the following address: <https://www.gov.uk/guidance/changes-to-international-trade-mark-registrations-after-the-transition-period>

at a reasonable cost (EUR 850 basic fee, in January 2021, for the online filing of an individual EUTM application covering one class; for up-to-date information on fees, including for additional classes, and EU collective or certification marks, please see <https://euipo.europa.eu/ohimportal/en/fees-payable-direct-to-euipo>). An EUTM is valid for 10 years and can be renewed indefinitely every 10 years. You will be able to enforce your EUTM rights in a market of almost 450 million consumers.

At the EUIPO website (<https://euipo.europa.eu/ohimportal/en/trade-marks>), you will find detailed explanations on how to apply for an EUTM, how to follow the registration procedure, and how to manage your EUTM once registered.

## 6.2. DESIGNATING THE EU VIA MADRID (THE INTERNATIONAL ROUTE) – BEST PRACTICES

Similar benefits to those offered by the European route, plus the additional benefits that are unique to the Madrid System, can be enjoyed by following the international route. As from 2004, when the European Union became a Contracting Party of the Madrid Protocol, it became possible for Madrid System users to get a trademark right having the same effects as an EUTM (valid in all the EU Member States) by designating the EU under the international procedure (either in an international application or as a subsequent designation).

An IR designating the EU and accepted by the EUIPO has the same effects as an EUTM registered by the EUIPO. This section describes the best practices to be followed to obtain and manage an IR that is valid in the European Union.

### 6.2.1. DESIGNATING THE EUROPEAN UNION – SPECIFIC REQUIREMENTS

You can designate the European Union for protection either:

- (i) when filing your international application at MyIPO, by checking the European Union (**EM code**) box in the application form (MM2); or
- (ii) once you have obtained an IR, by checking the European Union (EM code) box in the subsequent designation form (MM4) submitted to WIPO either online (<https://www3.wipo.int/osd/>) or by mail.

In addition to the general requirements for international applications and subsequent designations, when you designate the European Union you should consider the following.

- (a) The language of proceedings before the EUIPO will be the language of your international application (English). However, when designating the EU, you must also indicate a second language of the EUIPO (either French, German, Italian or Spanish), the use of which you accept as a possible language for opposition, revocation or invalidity proceedings.
- (b) Moreover, if you wish to claim seniority<sup>4</sup> of an earlier mark registered in, or for, a European Union Member State, you may do so at the time of filing your international application or subsequent designation by attaching the official form MM17 (you may also claim seniority directly before the EUIPO at a later date).

<sup>4</sup> A seniority claim is a system whereby the owner of an EUTM application/registration, or an EU designation in an international registration (IR), can claim the prior rights of existing national registrations in the European Union (or national designations of International registrations), even if the national registrations are allowed to lapse.

## 11. DESIGNATIONS<sup>14</sup>

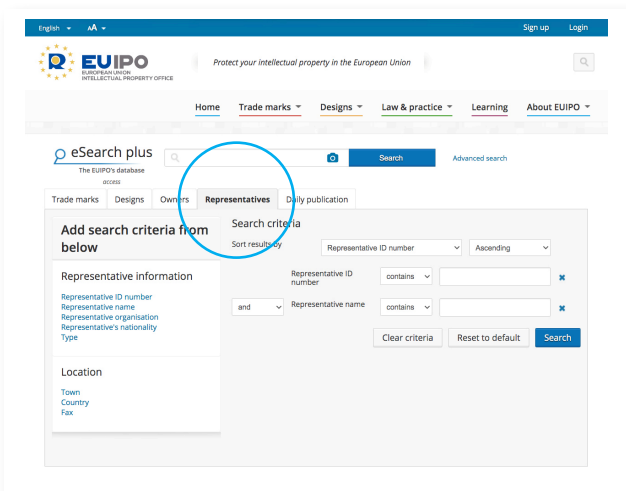
Check the corresponding boxes:

- |  |  |  |  |
|--|--|--|--|
| <input type="checkbox"/> AF Afghanistan                    | <input type="checkbox"/> DZ Algeria                                | <input type="checkbox"/> KZ Kazakhstan                       | <input type="checkbox"/> RO Romania                |
| <input type="checkbox"/> AG Antigua and Barbuda            | <input type="checkbox"/> EE Estonia                                | <input type="checkbox"/> LA Lao People's Democratic Republic | <input type="checkbox"/> RS Serbia                 |
| <input type="checkbox"/> AL Albania                        | <input type="checkbox"/> EG Egypt                                  | <input type="checkbox"/> LI Liechtenstein                    | <input type="checkbox"/> RU Russian Federation     |
| <input type="checkbox"/> AM Armenia                        | <input checked="" type="checkbox"/> EM European Union <sup>a</sup> | <input type="checkbox"/> LR Liberia                          | <input type="checkbox"/> RW Rwanda                 |
| <input type="checkbox"/> AT Austria                        | <input type="checkbox"/> ES Spain                                  | <input type="checkbox"/> LS Lesotho <sup>b</sup>             | <input type="checkbox"/> SD Sudan                  |
| <input type="checkbox"/> AU Australia                      | <input type="checkbox"/> FI Finland                                | <input type="checkbox"/> LT Lithuania                        | <input type="checkbox"/> SE Sweden                 |
| <input type="checkbox"/> AZ Azerbaijan                     | <input type="checkbox"/> FR France                                 | <input type="checkbox"/> LV Latvia                           | <input type="checkbox"/> SG Singapore <sup>b</sup> |
| <input type="checkbox"/> BA Bosnia and Herzegovina         | <input type="checkbox"/> GB United Kingdom <sup>b,j</sup>          | <input type="checkbox"/> MA Morocco                          | <input type="checkbox"/> SI Slovenia               |
| <input type="checkbox"/> BG Bulgaria                       | <input type="checkbox"/> GE Georgia                                | <input type="checkbox"/> MC Monaco                           | <input type="checkbox"/> SK Slovakia               |
| <input type="checkbox"/> BH Bahrain                        | <input type="checkbox"/> GG Guernsey <sup>b,k</sup>                | <input type="checkbox"/> MD Republic of Moldova              | <input type="checkbox"/> SL Sierra Leone           |
| <input type="checkbox"/> BN Brunei Darussalam <sup>b</sup> | <input type="checkbox"/> GH Ghana                                  | <input type="checkbox"/> ME Montenegro                       | <input type="checkbox"/> SM San Marino             |
|  | <input type="checkbox"/> GM Gambia                                 |  | <input type="checkbox"/> ST Sao Tome and Principe  |

The basic fee for an EU designation for one class of goods or services has been fixed by the EUIPO at CHF 897 (status in January 2021). For up-to-date information on the individual fees fixed by the EUIPO for designations and renewals regarding individual marks and collective or certification marks under the Madrid System, please see [http://www.wipo.int/madrid/en/fees/ind\\_taxes.html](http://www.wipo.int/madrid/en/fees/ind_taxes.html).

## 6.2.2. PROFESSIONAL REPRESENTATION BEFORE THE EUIPO

In principle, you do not need to appoint a representative before the EUIPO. However, being located outside the European Economic Area, you will need to appoint a representative (a) if the EUIPO issues a provisional refusal of your IR; (b) for filing seniority claims directly before the EUIPO; or (c) further to an EUIPO objection on a seniority claim. In such cases, your representative should be a person who appears in the database of representatives maintained by the EUIPO (<https://euipo.europa.eu/eSearch/#advanced/representatives>).

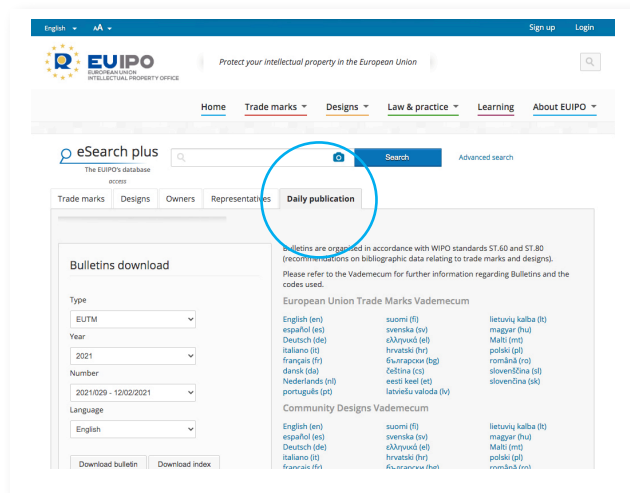


The screenshot shows the EUIPO eSearch plus interface. The 'Representatives' tab is selected under the 'eSearch plus' header. The search criteria section is highlighted with a blue circle. It includes a search bar, a 'Sort results by' dropdown set to 'Representative ID number', and a 'Search' button. Below the search bar, there are fields for 'Representative ID number' and 'Representative name', both with 'contains' operators and a search button. There are also links for 'Add search criteria from below' and 'Clear criteria'.



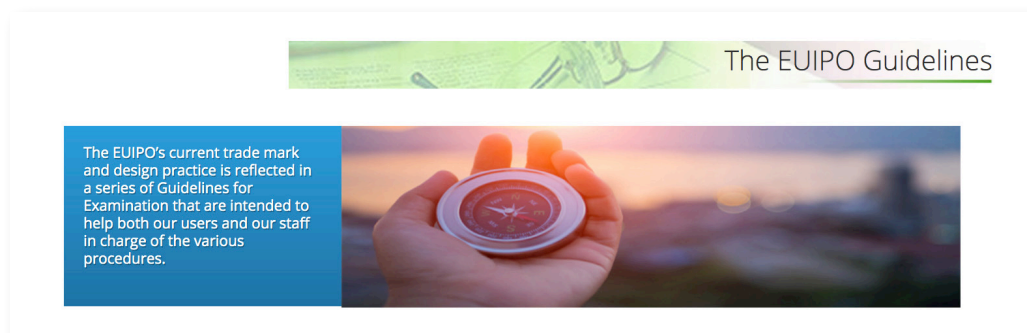
### 6.2.3. FIRST REPUBLICATION, SEARCHES AND FORMALITIES EXAMINATION

Upon receipt of WIPO's notification of the IR designating the EU, the EUIPO will immediately republish the IR in the EUTM Bulletin (Part M.1) (<https://euipo.europa.eu/eSearch/#advanced/bulletins>). Publication is limited to the bibliographic data, the reproduction of the mark, and the class numbers (not the actual list of goods and services). The IR has, from the date of that first republication, the same effect as a published EUTM application.



If you so wish, within one month of WIPO's notification you may ask the EUIPO to draw up an EU search report that will cite similar EUTMs and IRs designating the EU. You may also request the EUIPO to send the IR to the participating national offices of EU Member States to have national searches carried out for you (you will have to pay the corresponding fees).

The formalities examination carried out by the EUIPO on IRs is limited to (a) whether a second language of proceedings has been indicated; (b) whether the application is for a collective or certification mark; (c) whether there are any seniority claims; (d) whether the list of goods and/or services in the EU designation falls within the scope of the IR's main list; and (e) whether the terms used to indicate those goods/ services meet the requirements of clarity and precision as described in the EUIPO Trademark Guidelines, Part B, Section 3 (<https://euipo.europa.eu/ohimportal/en/trade-mark-guidelines>).



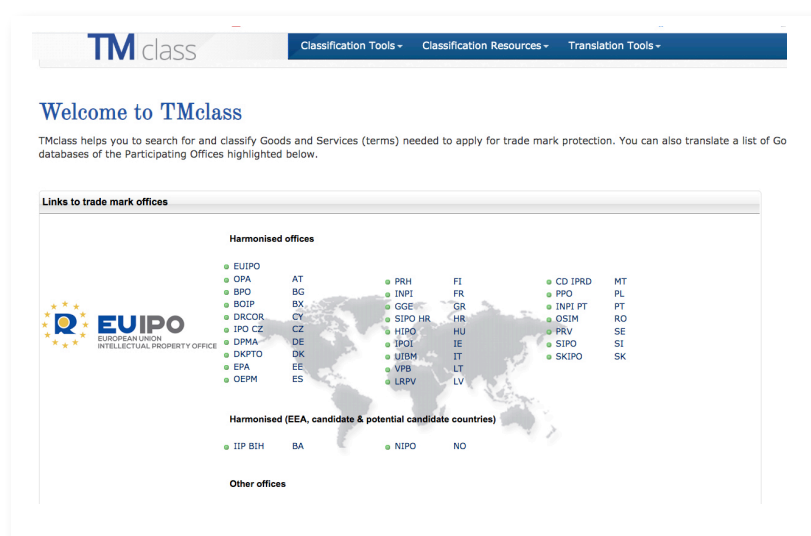
If you have failed to designate a second language of the EUIPO as a possible language for opposition, revocation or invalidity proceedings before the EUIPO, the EUIPO will issue a provisional refusal and give you two months to remedy the deficiency.

If your IR designating the EU is a collective mark or a certification mark based on such type of mark in Malaysia, it will be dealt with as an EU collective mark or an EU certification mark, whichever is applicable. In such cases, you will need to submit the regulations governing the use of the mark to the EUIPO within two months of the date in which WIPO notified the EUIPO of the designation.

If you have claimed seniority of an earlier mark registered in an EU Member State (in form MM17), the EUIPO will check that you have indicated the name of the EU Member State where the earlier right is registered, the registration number and the filing date of the relevant registration.

If you have introduced a limitation to the list of goods and services of the IR in your designation of the EU, the EUIPO will check whether the goods and services in your limited list for the EU are comprised within the scope of the main list of the IR. If they are not, it will issue a provisional refusal.

If your IR contains terms for goods or services that lack clarity or precision, the EUIPO will issue a provisional refusal and give you two months to remedy the deficiency. To avoid including in your list terms that will not be accepted by the EUIPO, it is recommended that you search the content of the EU Harmonised Database (HDB) before filing an IR designating the EU. This can be done online, free of charge, at the following address: <http://tmclass.tmdn.org/ec2/>. The HDB contains terms designating goods and services that are accepted by all TM offices in the EU. All HDB terms will be accepted by the EUIPO automatically. This will help make your registration process much smoother.



#### 6.2.4. EXAMINATION OF ABSOLUTE GROUNDS FOR REFUSAL

IRs designating the EU are subject to examination of absolute grounds for refusal in the same way as direct EUTM applications.

In particular, your mark will not be eligible for protection if it consists of a sign that: (a) does not conform to the EUTM definition (capable of distinguishing the goods or services of one undertaking from those of other undertakings, and being represented in a manner which enables to determine the clear and precise subject matter of the protection afforded); (b) is non-distinctive; (c) is descriptive; (d) consists exclusively of words or indications that have become customary in the current language or in the bona fide and established practices of the trade at the relevant point in time; (e) consists exclusively of the shape or other characteristics resulting from the nature of the goods, with an essentially technical function or substantial value; (f) is contrary to public policy or to accepted principles of morality; (g) is of such a nature as to deceive the public as to the nature, quality or geographical origin of the goods or services; (h) is in conflict with armorial bearings, flags, emblems, and other symbols of States and IGOs protected under Article 6ter of the Paris Convention; (i) is in conflict with other badges, emblems and escutcheons of particular public interest; (j) is in conflict with designations of origin and geographical indications protected under national (EU Member State) or EU legislation or international agreements to which the EU or the Member State concerned is party; (k) is in conflict with traditional terms for wines protected by either EU legislation or international agreements to which the EU is party; (l) is in conflict with traditional specialities guaranteed (TSGs) protected by either EU legislation or international agreements to which the EU is party; (m) is in conflict with earlier plant variety denominations protected within the EU in respect of plant varieties of the same or closely related species.

If the EUIPO finds that your mark is not eligible for protection, it will send a provisional refusal and give you two months to submit observations. Your reply must be addressed directly to the EUIPO, which, after re-examining the case, may decide to confirm the refusal or waive the objection.

If the EUIPO finds that your mark is eligible for protection, and provided that no other provisional refusal is pending, it will send an interim status of the mark to WIPO indicating that the ex officio examination has been completed but the IR is still open to opposition or third-party observations.



### **6.2.5. OPPOSITION**

Any person invoking earlier rights in conflict with your mark may file an opposition against your IR between the first and fourth months following the date of first republication.

If someone opposes your IR within that period, the EUIPO will send a notification to WIPO of provisional refusal (based on relative grounds) and will send you copy of the notice of opposition. It will also notify you of the time limit for commencement of the proceedings. In all communications with WIPO, the EUIPO will use the language of the IR (English in your case). In all communications sent directly to you, the EUIPO will use the language of the opposition proceedings chosen by the opponent (which will be English, or the second language chosen by you when designating the EU).

The provisional refusal may be partial or total. It will contain the earlier rights invoked, the relevant list of goods and services on which the opposition is based and, in the case of a partial refusal, the list of goods and services against which the opposition is directed. The list of goods and services will be in the language of the opposition proceedings.

### **6.2.6. FINAL DECISION**

Once all the procedures have been completed and all the EUIPO decisions are final, the EUIPO must either confirm the provisional refusal(s) to WIPO or send a statement of grant of protection to WIPO specifying for which goods and services your mark is accepted.

### **6.2.7. SECOND REPUBLICATION AND PROTECTION IN THE EU**

If the EUIPO decides that your mark is (at least in part) protected in the EU, the EUIPO will republish your IR for a second time in the EUTM Bulletin (this time in Part M.3). The EUIPO will not issue any registration certificate.

From the date of this second republication, the IR has the same effects as a registered EUTM and may be invoked against an infringer. The date of the second republication will also be the starting point for the five-year use period. If your mark is not put to genuine use in the European Union within that period, the effects of your IR in the EU may be declared invalid.

### **6.2.8. TRANSFORMATION INTO AN EUTM**

If your IR is cancelled in whole or in part because your basic mark in Malaysia has ceased to have effect within the five-year dependency period and your EU designation is still effective, you may file a direct EUTM application at the EUIPO for the same mark and the same goods and services as the cancelled mark. Based on the Madrid Protocol provision on 'transformation', this application will be treated by the EUIPO as if it had been filed on the date of the original designation of the EU and will enjoy the same priority, if any.

To invoke a transformation right your application should be filed within a period of three months from the date on which your IR was cancelled in whole or in part, and the goods and services of the ensuing application should be covered by the list of goods and services of the EU designation. When the application for transformation relates to an IR designating the EU that has already been accepted and published by the EUIPO, the examination and opposition steps are omitted. The EUTM will be published in all EU languages and an EUTM registration certificate will be issued.

### 6.2.9. CONVERSION

If, for whatever reason, your Madrid system EU designation is withdrawn, refused or ceases to have effect, you may request its conversion into either a national application filed directly with the Office of one or more EU Member States, or a subsequent designation of those Member States under the Madrid System. The effect of conversion is that the trademark application, or the subsequent designation, resulting from conversion, is allocated the same filing date as that of the EU designation as recorded in the International Register (and enjoys, if applicable the same priority date and/or seniority claimed).

A subsequent designation resulting from conversion must be forwarded to WIPO through the EUIPO in an official form (MM16), within three months from the date where the EU designation has been refused or withdrawn or has ceased to have effect. For full details on conversion, see the EUIPO Guidelines, Part E, Section 2, at <https://euipo.europa.eu/ohimportal/en/trade-mark-guidelines>

### 6.2.10. REPLACEMENT IN THE EU

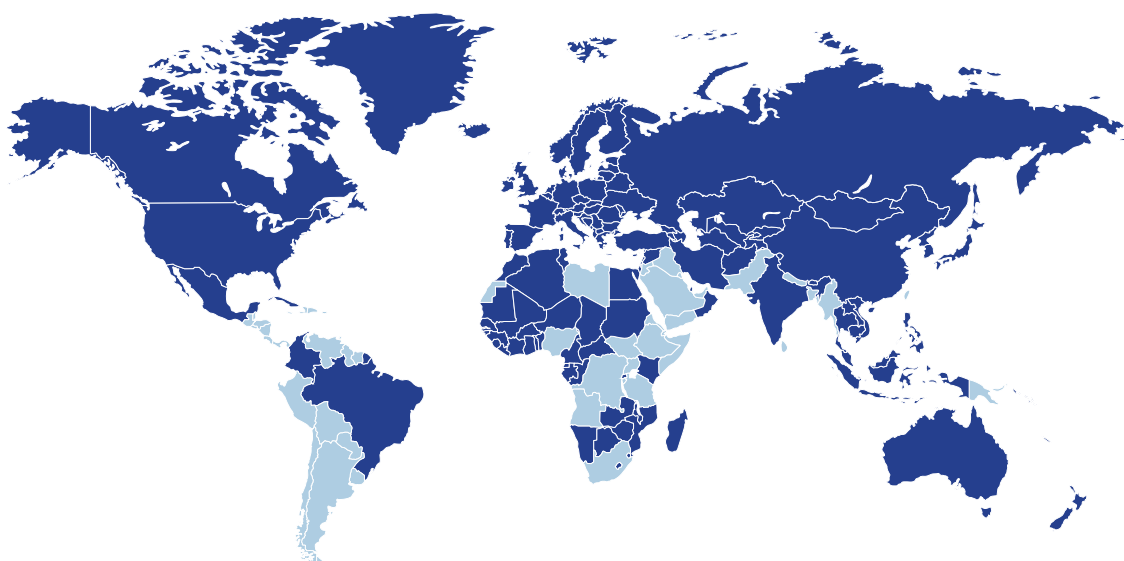
If you had your mark already registered at the EUIPO as an EUTM and you designate the EU under the Madrid System for the same mark, you will enjoy the Madrid Protocol benefit of replacement (your IR rights in the EU will be deemed to start from the date of the earlier EUTM registration). Replacement takes place automatically; there is no need to request any record. Nevertheless, you can ask the EUIPO to take note of the replacement in its Register. After replacement has taken place, the EUTM is maintained normally in its Register as long as you renew it. If you renew it, there will be coexistence between the 'replaced' EUTM and the IR designating the EU.

## 7. CONCLUSION

The Madrid Protocol offers you an attractive route to protect your brand in up to 122 countries around the world by making available cost-effective and user-friendly procedures to acquire and manage your trademark rights abroad. As a national of Malaysia, or a person domiciled or having an enterprise in Malaysia, you are entitled to use this treaty that Malaysia joined in 2019. Today, using the Madrid Protocol is an essential component of any successful branding strategy. The Protocol offers you early brand presence at a global level and helps you rapidly acquire international reputation and generate goodwill for your trademarks abroad. The Protocol ensures the legal protection of your brand against competitors in export markets, increases franchising opportunities, opens partnership possibilities and facilitates integration to global supply chains. In general, it provides a most effective support to your branding strategies and business success.

## MADRID UNION MEMBERS

107 members (including the European Union and OAPI) covering 123 countries as of January 12, 2021



Afghanistan, African Intellectual Property Organization (OAPI)<sup>5</sup>, Albania, Algeria, Antigua and Barbuda, Armenia, Australia, Austria, Azerbaijan, Bahrain, Belarus, Belgium, Bhutan, Bosnia and Herzegovina, Botswana, Brazil, Brunei Darussalam, Bulgaria, Cambodia, Canada, China, Colombia, Croatia, Cuba, Cyprus, Czech Republic, Democratic People's Republic of Korea, Denmark, Egypt, Estonia, Eswatini, European Union<sup>6</sup>, Finland, France, Gambia, Georgia, Germany, Ghana, Greece, Hungary, Iceland, India, Indonesia, Iran (Islamic Republic of), Ireland, Israel, Italy, Japan, Kazakhstan, Kenya, Kyrgyzstan, Lao People's Democratic Republic, Latvia, Lesotho, Liberia, Liechtenstein, Lithuania, Luxembourg, Madagascar, Malawi, Malaysia, Mexico, Monaco, Mongolia, Montenegro, Morocco, Mozambique, Namibia, Netherlands, New Zealand, North Macedonia, Norway, Oman, Philippines, Poland, Portugal, Republic of Korea, Republic of Moldova, Romania, Russian Federation, Rwanda, Samoa, San Marino, Sao Tome and Principe, Serbia, Sierra Leone, Singapore, Slovakia, Slovenia, Spain, Sudan, Sweden, Switzerland, Syrian Arab Republic, Tajikistan, Thailand, Trinidad and Tobago, Tunisia, Turkey, Turkmenistan, Ukraine, United Kingdom, United States of America, Uzbekistan, Viet Nam, Zambia, Zimbabwe (107)

<sup>5</sup> A Madrid designation of OAPI covers all its Member States, namely: Benin, Burkina Faso, Cameroon, Central African Republic, Chad, Comoros, Congo, Cote d'Ivoire, Equatorial Guinea, Gabon, Guinea-Bissau, Guinea, Mali, Mauritania, Niger, Senegal, Togo (17)

<sup>6</sup> A Madrid designation of the European Union covers all its Member States, namely: Austria, Belgium, Bulgaria, Croatia, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Luxembourg, Malta, Netherlands, Poland, Portugal, Romania, Slovakia, Slovenia, Spain, Sweden (27)



## ACRONYMS

<b>ASEAN</b>	Association of Southeast Asian Nations
<b>BOIP</b>	Benelux Office for Intellectual Property
<b>CHF</b>	Swiss Franc
<b>DCP</b>	Designated Contracting Party
<b>EM</b>	Two-letter code used to identify the European Union in Madrid Protocol forms
<b>EU</b>	European Union
<b>EUIPO</b>	European Union Intellectual Property Office
<b>EUTM</b>	European Union Trade Mark
<b>IA</b>	International Application under the Madrid Protocol procedures
<b>IR</b>	International Registration under the Madrid Protocol procedures
<b>MGS</b>	Madrid Goods & Services Manager
<b>MyIPO</b>	Intellectual Property Corporation of Malaysia
<b>OAPI</b>	African Intellectual Property Organization
<b>WIPO</b>	World Intellectual Property Organization

## GLOSSARY

<b>Basic mark</b>	Trademark application or registration in one of the Madrid Union Members that provides the basis for an international application
<b>Contracting Parties</b>	States and intergovernmental organizations that are Parties to the Madrid Protocol
<b>International application</b>	Application for the registration of a trademark under the Madrid Protocol procedures
<b>International registration</b>	International trademark registration under the Madrid Protocol procedures
<b>Madrid Union</b>	Union of States and intergovernmental organizations that are Parties to the Madrid Protocol
<b>Madrid Protocol</b>	Protocol of 1989 relating to the Madrid Agreement concerning the International Registration of Marks
<b>Madrid System</b>	System for the international registration of trademarks governed by the Madrid Protocol and managed by WIPO
<b>Madrid Union Members</b>	Contracting Parties to the Madrid Protocol
<b>Nice Classification</b>	International Classification of Goods and Services for the Purposes of the Registration of Marks, established by the Nice Agreement of 1957 amended in 1979
<b>Subsequent designation</b>	Request for extending the protection of an international registration to one or more additional Contracting Parties

## ONLINE TOOLS AND SERVICES FREELY AVAILABLE TO MADRID SYSTEM USERS

**ASEAN TMclass** – <http://www.asean-tmclass.org/ec2/>

Online tool that facilitates the identification and classification of goods and services for the registration of marks in all the ASEAN IP Offices

**ASEAN TMview** – <http://www.asean-tmview.org/tmview/welcome>

Information platform enabling searches in the trademark databases of nine ASEAN IP Offices

**E-Subsequent Designation** – <https://www3.wipo.int/osd/>

Online electronic facility for filing subsequent designations under the Madrid Protocol

**EUIPO Representatives Database** – <https://euipo.europa.eu/eSearch/#advanced/representatives>

Database of representatives maintained by the European Union Intellectual Property Office

**EUIPO Trade Mark Guidelines** – <https://euipo.europa.eu/ohimportal/en/trade-mark-guidelines>

Compendium of EUIPO practice regarding EUTM procedures

**EUIPO Trade Mark website** – <https://euipo.europa.eu/ohimportal/en/trade-marks>

Trademark website of the European Union Intellectual Property Office

**EUTM Bulletin** – <https://euipo.europa.eu/eSearch/#advanced/bulletins>

The official EUIPO publication containing latest data regarding EUTM registrations

**EUTM Fees** – <https://euipo.europa.eu/ohimportal/en/fees-payable-direct-to-euipo>

Fees payable for the filing of EUTM applications and other EUTM-related procedures

**EUTM online filing** – <https://euipo.europa.eu/ohimportal/en/apply-now>

Electronic facility for online filing of EUTM applications at the EUIPO website

**Fee Calculator** – <http://www.wipo.int/madrid/en/fees/calculator.jsp>

WIPO-managed online tool that facilitates the calculation of the fees to be paid for international applications, subsequent designations and renewals under the Madrid System

**Global Brand Database** – <http://www.wipo.int/branddb/en/index.jsp>

WIPO online gateway containing more than 44 million records from 67 national and international collections (trademarks, geographical indications, state emblems, etc.)

**Madrid Forms** – <http://www.wipo.int/madrid/en/forms/>

WIPO web address from where Madrid forms can be downloaded

**Madrid Goods & Services Manager (MGS)** – <https://webaccess.wipo.int/mgs/>

WIPO-managed online tool that helps compile the list of goods and services to be submitted when filing an international application

**Madrid Guide** – <http://www.wipo.int/madrid/en/guide/>

WIPO Guide to the International Registration of Marks

**Madrid Member Profiles Database** – <http://www.wipo.int/madrid/memberprofiles/#/>

WIPO-managed database that offers information on procedures and practices regarding the effects of international registrations in Madrid Union Members

**Madrid Monitor** – <http://www.wipo.int/madrid/monitor/en/>

A WIPO e-service that offers access to information on all trademarks registered under the Madrid System

**Malaysia's Trade Marks Act** – <https://wipolex.wipo.int/en/legislation/details/19564>

Trade Marks Act 2019 (Act 815)

**MyIPO Online Search and Filing System** –

<https://iponlineext.myipo.gov.my/SPHI/Extra/IP/TM/Qbe.aspx?sid=637401255261692722>

Online service giving access to a searchable database of trademarks from MyIPO

**MyIPO Madrid Protocol webpage** – <http://www.myipo.gov.my/en/madrid-system/>

Madrid Protocol related information offered by MYIPO

**TMclass** – <http://euipo.europa.eu/ec2/>

Online tool facilitating the identification and classification of goods and services for the registration of marks in 79 trademark offices

**TMview** – <https://www.tmdn.org/tmview/welcome>

Information platform offering access to data of some 60 million trademarks from over 100 countries

**WIPO Gazette of International Marks** – <https://www3.wipo.int/madrid/monitor/en/>

The official Madrid System weekly publication that contains the latest data regarding International registrations, renewals, subsequent designations and modifications affecting existing registrations

**WIPO IP Portal** – <https://ipportal.wipo.int/>

Online portal offering access to various WIPO services, including the Madrid E-Renewal Service and the Madrid Portfolio Manager that allows you to manage your portfolio of international trademark registrations

**WIPO Lex** – <https://www.wipo.int/wipolex/en/index.html>

Global database providing access to Intellectual Property legal information (treaties, laws, regulations)

**WIPO User Account** – <https://www3.wipo.int/wipoaccounts/generic/public/register.xhtml>

User account offering secured access to the WIPO IP Portal and several WIPO services such as the Madrid Portfolio Manager (MPM)



— ARISE+ —

ASEAN Intellectual Property Rights



# THE MADRID PROTOCOL

SURIA KLCC