Madrid System for the International Registration of Marks

International Registration of Marks under the Madrid System: Basic Features and Latest Developments

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Acting Coordinator, Processing Team 1, Operations Division, Madrid Registry

Prague, April 27, 2015
Content of the presentation

- Madrid System: Objectives and Basic Features
- Legal Framework and Geographical Scope
- International Registration Procedure
- Facts and Figures
- Recent Developments
- Useful Links and Contacts
Abbreviations

- OO – Office of Origin
- IB – International Bureau
- CP – Contracting Party
- DCP – Designated Contracting Party
- G&S – Goods and Services
- IR – International Registration
- A – Madrid Agreement Concerning the International Registration of Marks
- P – Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks
Madrid System: Objectives and Basic Features
Objectives of the Madrid System

- A **simple, low-cost and effective** system to facilitate trademark protection in export markets through:
  - one **central filing and registration** procedure producing effects in one or more territories bound by the system
  - one **central procedure to maintain and manage** an IR with effects in all territories concerned
Main Actors in the Madrid System

- Applicant filing an international application / holder of an IR
- Office of Origin
- International Bureau
- Office of designated Contracting Party
Madrid System - Basic Features (1)

- Madrid System is a closed system

- Madrid System can
  - only be used by an applicant (natural person or legal entity)
  - from a member of the Madrid System
  - for designating other members of the Madrid System
  - bound by the same treaty, the Madrid Agreement or the Madrid Protocol
Madrid System - Basic Features (2)

■ **Basic mark** (application or registration) in a CP of the Madrid System

and

■ **Connection** between an applicant or holder of the basic mark and that CP (establishment, domicile, or nationality) are needed

■ **Filing through an OO**

■ **Designation of one or more CPs bound by the same treaty** (self designation is not possible)
Filing Basis Under the Madrid System

Madrid Agreement and Madrid Protocol

Applicant

Establishment
Domicile
Nationality

Basic Registration
Basic Application
Madrid System - Basic Features (3)

- Fixed time limits for granting or refusing protection by DCPs
- 10 year term of protection with the possibility of renewal
- Possibility to add other CPs to IR (subsequent designation)
- Centralized maintenance and management of IRs
Basic Features of Madrid System (4)

- Dependence on the basic mark for the first 5 years
- Ceasing of effect of the basic mark and cancellation of IR
- Possibility of transformation of IR into national or regional applications under the Madrid Protocol
Legal Framework and Geographical Scope
Legal Framework (1)

Madrid System Concerning the International Registration of Marks

- Madrid Agreement (1891)
- Common Regulations (1996)
- Administrative Instructions (2002)
- National Laws & Regulations
Legal Framework (2)

- Madrid Treaties and Regulations
  provide the basic principles and mechanism of the system; governing the formal conditions for an IR

- Domestic Law and Regulations of a CP
  govern the substantive conditions for granting protection in each relevant territory
Legal Framework (3)

- **Madrid Agreement:**
  - States
  - Basic Registration
  - Cascade entitlement
  - Standard fee
  - 12 months refusal period
  - 5 year dependency period

- **Madrid Protocol**
  - States and intergovernmental organizations
  - Basic registration or application
  - No cascade of entitlement
  - Standard fee or individual fee
  - 12, 18 or even 18+ months refusal period
  - 5 year dependency period with possible transformation
1 Agreement only
40 Protocol only (including EU and OAPI)
54 Agreement and Protocol
95 Members
Geographical expansion

2012 - 2015

- Philippines (July 25, 2012)
- Colombia (August 29, 2012)
- New Zealand (December 10, 2012)
- Mexico (February 19, 2013)
- India (July 8, 2013)
- Rwanda (August 17, 2013)
- Tunisia (October 16, 2013)
- African Intellectual Property Organization (OAPI) (March 5, 2015)
- Zimbabwe (March 11, 2015)
- Cambodia (June 5, 2015)

Possible future accessions to the Madrid Protocol

- ASEAN countries
- Barbados, Jamaica, Trinidad and Tobago
- Dominican Republic
- South-Africa
International Registration Procedure
Role of the International Bureau (IB)

- The Madrid System is a procedural system

- The IB undertakes formalities examination
  - International application: classification, fees, etc.
  - Various requests for recording of information

- The IB will:
  - Inscribe information in the International Register, notify the Offices of DCPs, inform the OO and send a certificate to the holder/representative
  - Publish relevant information in the Gazette
International registration procedure (1)

- **APPLICANT**
  - Entitlement
  - Basic Mark

- **OFFICE OF ORIGIN**
  - Certifies the application and forwards it to WIPO

- **WIPO**
  - Conducts the formal examination; records the mark in the International Registry and publishes the IR in the Gazette. Issues a certificate of registration and notifies the designated Contracting Parties
  - Scope of protection or the IR, determined by the substantive examination under domestic law, within 12/18 months

- **DESIGNATED CONTRACTING PARTY**
  - DESIGNATED CONTRACTING PARTY
  - DESIGNATED CONTRACTING PARTY
Role of the Office of the DCP

- The role of the Office of a DCP will follow from the domestic legislation.

- The domestic legislations of the DCPs set the conditions for protecting a trademark and determine the rights which result from protection.

- The Madrid System offers the possibility for a DCP to issue decisions on the status of protection, like:
  - Provisional refusals, statements of grant of protection, final decisions, further decisions and invalidations.
  - Replacement, Article 4bis and Rule 21.
  - Transformation, Article 9quinquies.
Provisional Refusals and/or Statements of Grants of Protection are sent to WIPO.

WIPO notifies the Holder/representative.

Substantial examination under the domestic law within 12/18 months.
This procedure is governed by the domestic law. The holder has to interact directly with the Office of the designated Contracting Party.

The Offices send WIPO the final decisions (Statement of Grant of Protection Following a Provisional Refusal (Total or Partial) or a Confirmation of a Total Provisional Refusal).

WIPO notifies the Holder/representative.

Each Office has its own deadlines to respond to provisional refusal (from 15 days to 18 months).

Limitation to overcome the Provisional Refusal
Facts and Figures
Madrid System - Facts and figures

- Madrid System filings
  - + 3.97% in 2012
  - + 6% in 2013
  - + 2.3% in 2014 (47,885)

- Madrid System indicators (2014)
  - 594,950 international registrations in force
  - 5.61 million designations in force
  - 198,027 holders of international registrations
**General profile 2014**

<table>
<thead>
<tr>
<th>Description</th>
<th>Value</th>
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<td><strong>42,430 International Registrations</strong></td>
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<td>Average Number of Designations</td>
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<tr>
<td>Average Number of Classes</td>
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<td>Average Fee</td>
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# Top Offices of origin

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### Top designated Contracting Parties

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<td>20,309</td>
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<td>10,753</td>
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<td>Republic of Korea</td>
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<td>10,402</td>
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<td>Turkey</td>
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<td>Mexico</td>
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<td>8,533</td>
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### Contracting Parties with the highest number of provisional refusals

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<td><strong>75,798</strong></td>
<td><strong>73,051</strong></td>
<td><strong>77,725</strong></td>
<td><strong>84,757</strong></td>
<td><strong>97,953</strong></td>
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### Designations & subsequent designations in new Contracting Parties

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Source: WIPO Trademark System
Recent Developments
Recent Developments (1)

- E-filing of international applications
  - Benelux Office
  - Australia

- Web forms
  - E-Renewal re-launched
  - E-Subsequent designation updated
  - More to come this year
E-Renewal

Marks E-Renewal System

Please enter your International Registration Number

IRN 846590
(for example: 123456, 123456A)

WARNING: E-renewal is an online service that allows you to renew an international registration by paying the due fees, including during the grace period. However, this service is not yet available for some international registrations in which the number of classes concerned cannot be determined automatically. In such cases, please submit paper Form M11.

PAYMENT OPTIONS: You can use a WIPO Current Account or a credit card (Visa or MasterCard) to pay the due fees through E-renewal. In order to use a WIPO Current Account, you need to provide the USERID and PASSWORD generated by WIPO for current account holders (your finance department may have this information.) If you do not have a WIPO Current Account, send an e-mail to income.accounts@wipo.int, mentioning “Request for Internet Access” in the subject line. You can find further information on the conditions for opening, using and closing a WIPO Current Account by clicking here.

Submit  Reset
E-Subsequent Designation

Online Subsequent Designation

Please enter your International Registration Number

IRN

Submit  Reset
Recent Developments (2)

Legal Developments

- Amendments to Common Regulations effective as from January 1, 2015
  - Continued processing (Rule 5bis)
  - Partial renewal (Rule 30)

Information services

- New version of the *Gazette*
- Global Brand Database
- MGS – Madrid Goods & Services
- MPM, MRS and MEA
Web Based Client Services

- Madrid Real-Time Status (http://www.wipo.int/mrs/): A tool to inform of the status of an international application/registration

- Madrid Portfolio Manager (https://www3.wipo.int/mpm/): A tool to allow the holders and representatives of international registrations to view and modify their portfolio online

- Madrid Electronic Alert (https://www3.wipo.int/mea/): A tool to allow users to submit a list of international registrations to monitor and to be informed by email when any of them change
Useful Information

- Legal texts, treaties, regulations, administrative instructions: http://www.wipo.int/madrid/en/legal_texts/
- Forms: http://www.wipo.int/madrid/en/forms/
- Fee calculator: http://www.wipo.int/madrid/en/fees/calculator.jsp
- ROMARIN: http://www.wipo.int/romarin
- The WIPO Gazette of International Marks: http://www.wipo.int/madrid/en/madridgazette/
Contact Us

- General queries on the Madrid System
  
  Madrid Customer Service:  +41 22 338 8686
  intreg.mail@wipo.int

- Specific queries on IA or IR
  
  madrid.team1@wipo.int  +41 22 338 750 1 (Czech Republic)
  madrid.team2@wipo.int  +41 22 338 750 2
  madrid.team3@wipo.int  +41 22 338 750 3

  http://www.wipo.int/madrid/en/contact.html

- For the electronic communication with IB
  
  e-marks@wipo.int
  http://www.wipo.int/madrid/en/services/electronic_notification.html
Thank you