



**WIPO | MADRID**

The International  
Trademark System



# The Madrid System

## Key Elements and Recent Developments

Tokyo  
8 and 9 March  
2012

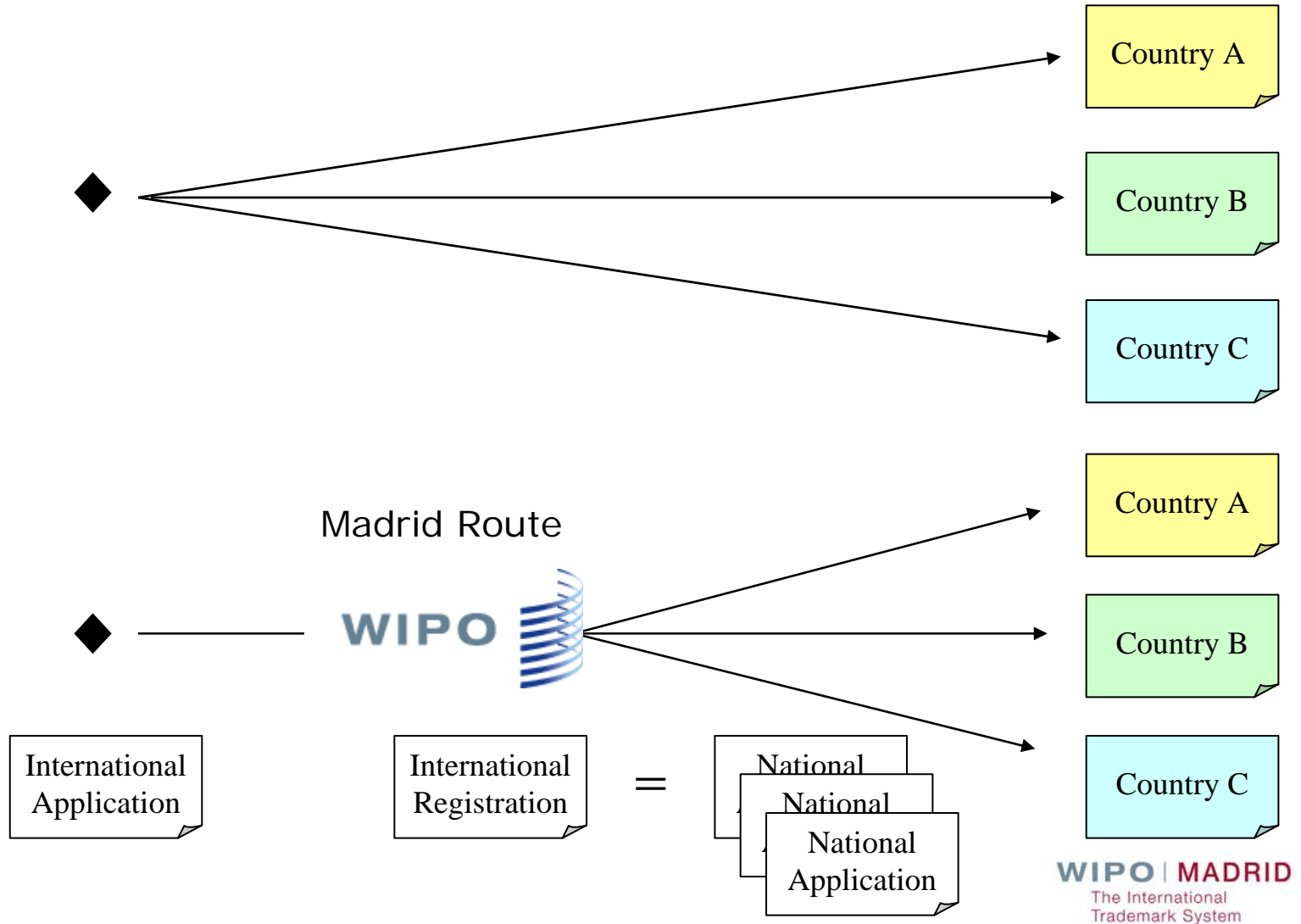
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# General Overview

# The Madrid System

- A global and centralized trademark filing mechanism
- It enables trademark owners to obtain and maintain trademark protection in foreign markets by means of a single international application form filed with WIPO
- It provides a simple, expeditious, easy to use, efficient and cost-effective procedure for the centralized filing of applications and the centralized management of registrations
- A closed system
- More than a 120 years of experience
- More than a million marks registered

# An Optional/Additional Route



Bundle of National Applications /Registrations

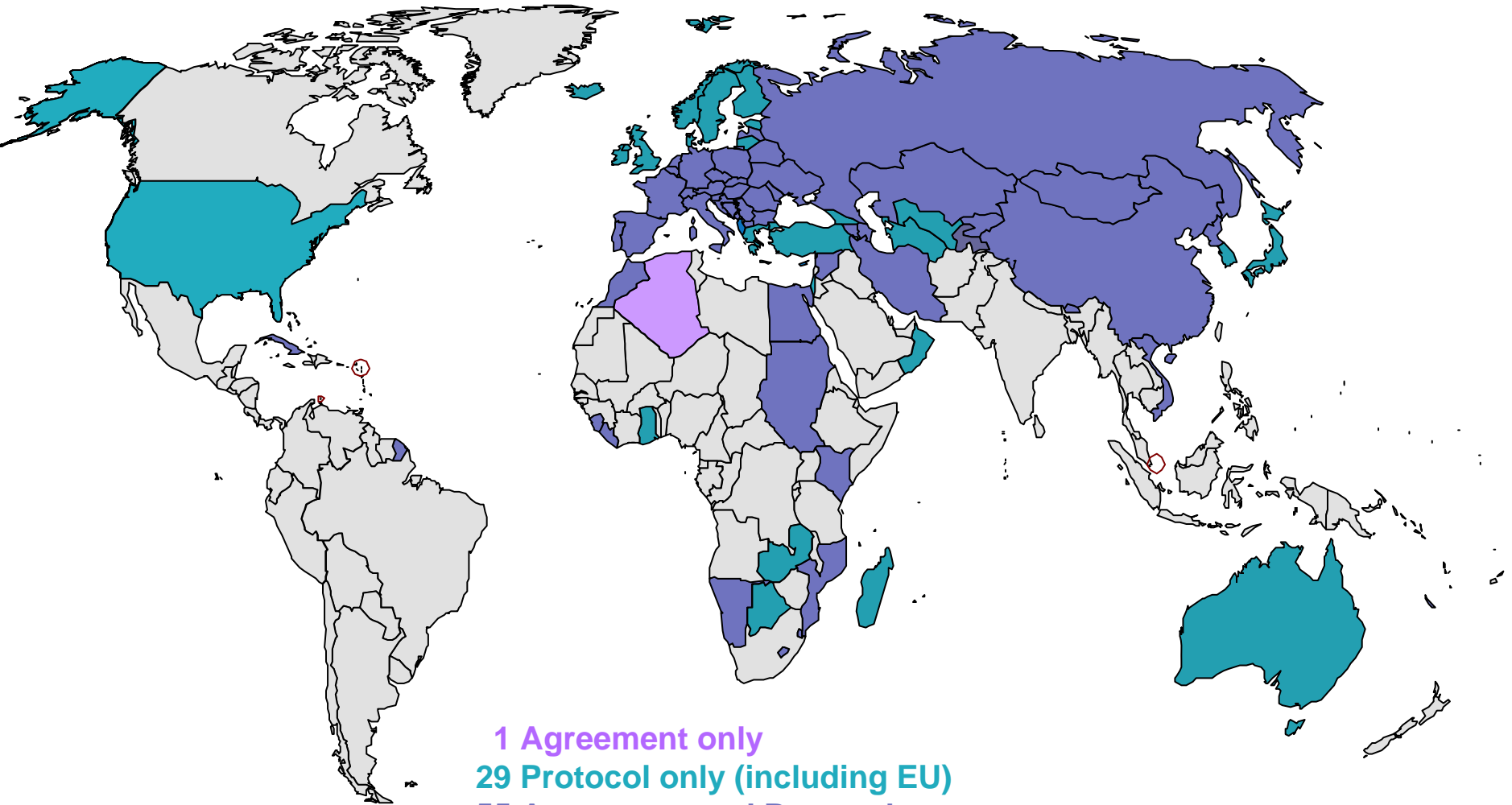
# National Route Vs. Madrid Route

- Many Offices for filing
  - Many application forms
  - Many languages
  - Many currencies
  - Many registrations
  - Many renewals
  - Many modifications
  - Foreign attorney needed from filing
- One Office for filing
  - One single application form
  - One language (E/F/S)
  - One currency (CHF)
  - One international registration
  - One renewal
  - One modification
  - Foreign attorney first needed in case of refusal/opposition

# Advantages of the Madrid system

- One international application based on a basic application/registration
- One language (English, French or Spanish)
- One set of fees in one currency (CHF)
- One registration number and one renewal date
- The registration can be further extended geographically
- All subsequent changes to the international registration may be recorded with the IB and have effect through one single procedure
- Offices do not need to examine for formal requirements
- Statement of grant of protection

# Geographical Coverage



**1 Agreement only**  
**29 Protocol only (including EU)**  
**55 Agreement and Protocol**  
**85 Members**

# Accessions

- Recent accessions to the Madrid Protocol
  - 2010: Sudan, Israel, Kazakhstan
  - 2011: Tajikistan (as of June 30, 2011)
- Future accessions?
  - Colombia, Costa Rica and Dominican Republic
  - ASEAN countries by 2015
  - India
  - South-Africa
  - Barbados, Jamaica and Trinidad & Tobago
  - Malta
  - New Zealand



# Legal Framework I

Madrid System  
Concerning the  
International  
Registration of Marks

Madrid Agreement (1891)

Madrid Protocol (1989)

(In force since 1996)

Regulations (1996)

Admin. Instructions (2002)

National Laws & Regulations

# Legal Framework II

Under the Madrid system

## ■ Treaties and Regulations

- provide the basic principles and mechanisms of the system; and govern the formal conditions for an international registration

## ■ Domestic Law and Regulations of a Contracting Party

- govern the substantive conditions for granting the protection in each relevant territory

# Scope of the Madrid System

- The system of international registration of marks is a purely procedural treaty which does **NOT**:
  - Determine the conditions for protecting a trademark
  - Determine the procedure to be applied in order to decide whether a mark may be protected
  - Determine the rights which result from protection
- All these questions are governed by the national legislation of each of the designated Contracting Parties

# Basic Features

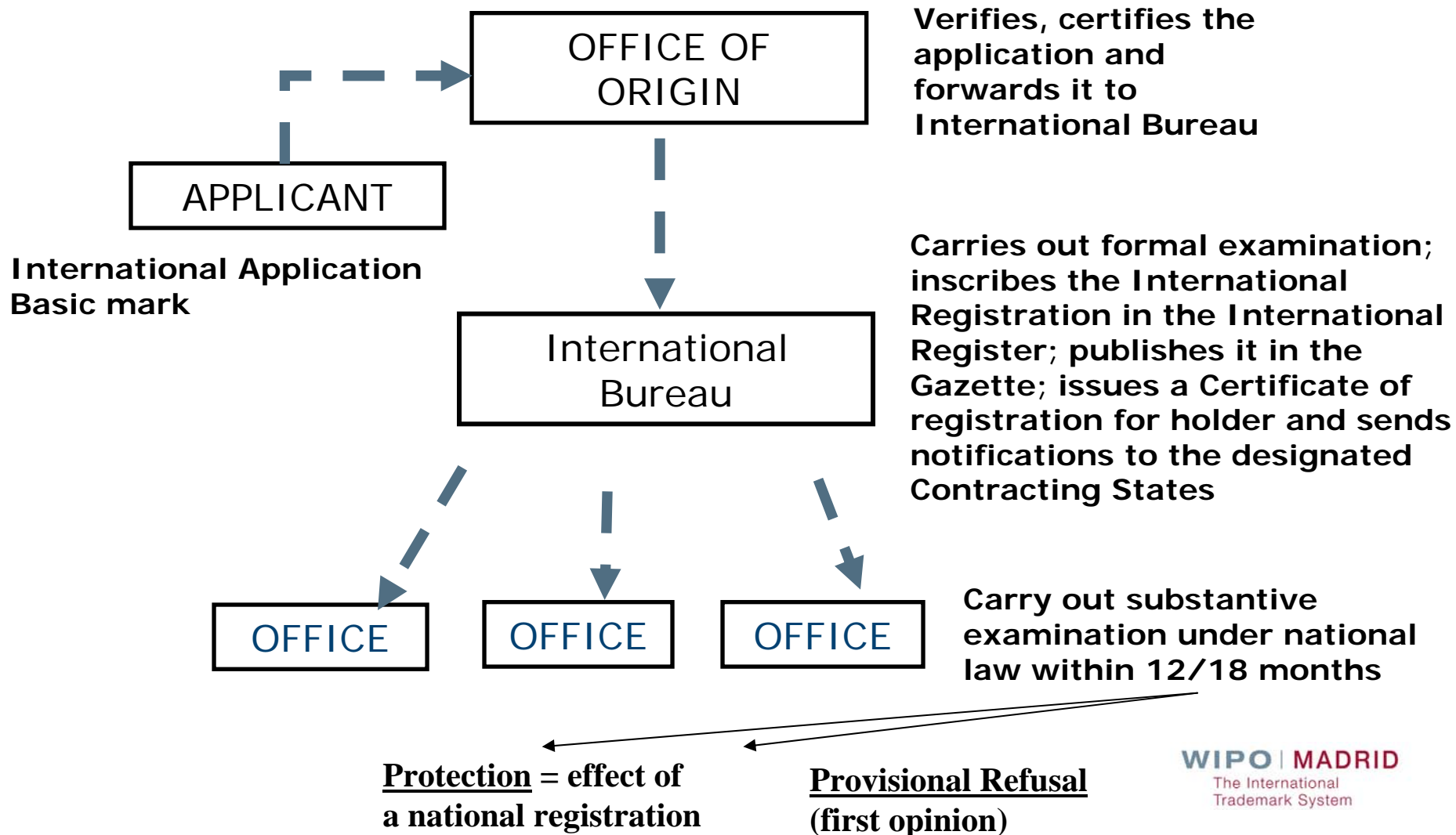
# Entitlement: Who can use the System?

- Someone (natural person or legal entity) that has a legal connection with a Contracting State through:
  - Real and effective industrial or commercial establishment
  - Domicile
  - Nationality
- Someone that has his basic mark registered or filed for registration in that Contracting State
- The International Application must be presented to the International Bureau of WIPO through the Office of origin of the applicant (indirect filing)

# International Registration Procedure I

- An international application may be based on one or more applications or registrations
- The fees payable in connection with the application
  - The basic fee (CHF 653 or 903)
  - A complementary fee for each designated Contracting State with supplementary fee OR individual fee
- Scope of protection – to be determined by the designated Contracting State
- The Contracting State may opt for 12/18 months refusal period

# International Registration Procedure II



# Centralized Management of the International Registration I

- Subsequent designation for territorial extension (expansion of trade, new Contracting States)
- The 5 years dependency period - IR is dependent on basic mark for 5 years
- Central attack – Ceasing of effects (withdrawal, lapse, renunciation, final decision of rejection, cancellation or invalidation)
- Transformation of the IR possible into national application which is treated as if filed on the date of the IR
- 10-year term of protection
- Renewal for further periods of 10 years



# Centralized Management of the International Registration I I

- Recording changes in the International Register
  - changes in name and address of holder/representative
  - assignments (change in ownership for all or some G&S and for all or some DCPs)
  - Recording of limitation of G&S for all or some DCPs
  - Recording of renunciation of all G&S for some DCPs
  - Recording of cancellation of all or some G&S for all DCPs
  - Recording of licenses
  - Recording of restriction of the holder's right of disposal

# Benefits for Trademark Owners

- Simple and economical procedure
  - A single set of simple formalities
  - A single filing Office
  - Low registration fees
  - No need to pay for foreign agents for filings
  - No need to pay translation into several languages
- Effective procedure
  - A single international application produces the same legal effect in various countries
  - A fixed deadline for the confirmation or refusal of the legal effects in each designated country

# Benefits for IP Offices and Government

- The Contracting Parties can focus on substantive examination
- The Madrid system has a positive effect on economic growth
- It generates income
- It empowers SMEs
- It promotes international trade by contributing to the opening of new markets and assisting in development of export
- It creates a more favorable climate for foreign investment in the internal market

# Benefits for Local Agents

- The Madrid Protocol is an optional/additional route which does not replace the direct filing route
- Applicants would need the services of local agents at filing stage or at post-registration stage
- Increased designations will create more business opportunities (substantive work), like searches, refusals, oppositions, request for cancellations, dispute settlements, license and assignments contracts, and enforcement
- Post-registration activity may compensate for any reduction in local filing activity

# Recent Developments

# The Madrid System in LDCs

- In order to improve the ability of trademark owners from LDCs to benefit from the Madrid System, WIPO offers applicants, originating from LDCs, a 90% reduction in the basic fee, since January 1, 2006 (65 CHF instead of 653 CHF)
  
- Current LDCs in the Madrid System:
  - Bhutan, Lesotho, Liberia, Mozambique, Sao Tomé and Príncipe, Sierra Leone, Sudan, Zambia
  
- Tomorrow?
  - Cambodia, Lao People's Democratic Republic, Myanmar, Ethiopia

# Recent Developments

- Mandatory Statements of grant of protection as of January 1, 2011
- Translation of certain documents upon request
  - Statement of grant of protection following a provisional refusal
  - Limitation of the list of goods and services

# International Registrations in Force as of December 31, 2010

- 526,674 international registrations were active in the International Register, equivalent to
- over 5.5 million active designations (national/regional registrations)
- 174,349 trademark holders (many of them SMEs)



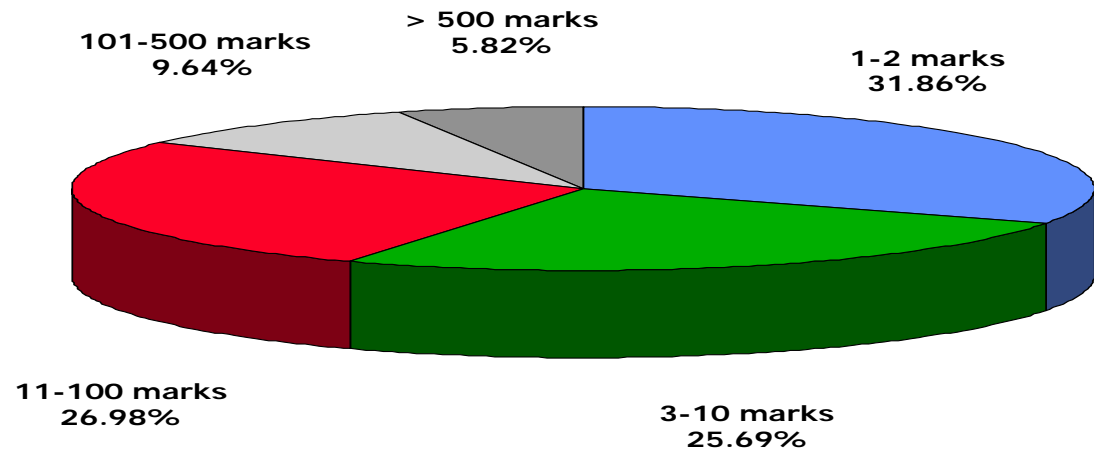
# Trademarks in Force (by Dec. 31, 2010)

**Right-holders  
(174,349)**



Trademarks by right-holder	Number of right-holders	
1-2 marks	138,788	79.60%
3-10 marks	29,307	16.80%
11-100 marks	5,932	3.40%
101-500 marks	288	0.17%
> 500 marks	34	0.03%
<b>All</b>	<b>174,349</b>	<b>100.00%</b>

**Registrations  
in force  
(526,674)**



Jan. to Dec.	2011	2010	Growth
Acquisition and Maintenance of Rights			
International Applications	42,270	39,687	6.5%
International Registrations	40,711	37,533	8.5%
Renewals	21,754	21,949	-0.9%
Subsequent Designations	13,668	12,112	12.8%
Individual designations			
Registrations	280,443	261,105	7.4%
Renewals	253,407	254,290	-0.3%
Subsequent Designations	43,516	38,371	13.4%
Decisions by Designated CP	347,816	267,995	29.8%
Modifications	86,776	83,310	4.2%
Documents received (Total)	515,134	409,683	25.7%

Madrid -TOP 10 Filers		Growth
European Union	5857	24.4%
Germany	4983	-0.5%
United States of America	4804	15.8%
France	3801	6.6%
Switzerland	2930	1.3%
Italy	2303	-11.3%
China	2149	11.5%
Benelux	1919	-0.2%
Russian Federation	1685	38.3%
Japan	1538	-2.5%

*Applications by office of origin*

Madrid -TOP 10 Designations		Growth
China	18724	16.0%
European Union	16341	11.9%
United States of America	15890	11.5%
Russian Federation	15691	10.1%
Switzerland	13695	9.8%
Japan	12211	9.8%
Australia	10453	13.3%
Republic of Korea	9821	17.8%
Turkey	9277	13.0%
Ukraine	8903	7.4%

*from registration and subsequent designation*

# Online Information Services

- Legal texts, Guide and Information Notices
- WIPO Gazette of International Marks
- E-Renewal Tool
- Fee Calculator: Costing service
- Madrid Simulator: On-line filing guide tool
- Goods & Services Manager: A WIPO-administered database of accepted indications of goods and services
- ROMARIN: On-line search database
- Dynamic Madrid Statistics

free access at <http://www.wipo.int/madrid/en/>

# New 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 IRs to view and modify their portfolio online.
- **Madrid Electronic Alerts** (<https://www3.wipo.int/mea/>)  
A tool to allow users to submit a list of IRs to monitor and to be informed by email when any of them change

Thank you

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