

How Future Offices can Prepare for the Madrid System



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Introduction

- Being a Member of the Madrid System
- Preparing for accession
- WIPO's support during accession
- Beyond accession

Being a member of the Madrid Protocol

- Two main roles as a member of the Madrid Protocol
 - Role of the **Office of origin**
 - Role of the Office of the **designated Contracting Party**

Role of the Office of origin (OO)

- Provide advice to local business and industry on how to obtain protection of trademarks in its own territory and options for protection abroad
- **Certify** the international application and send it to WIPO
- Remedy irregularities with the international application
- **Keep track** of basic mark in a 5 year period and notify to WIPO any **ceasing of effect** of the basic mark
- Forward official forms to the IB on behalf of the holder

Role of the Office of a dCP

- The role of the Office will follow from the domestic legislation, which set the conditions for protecting a trademark
- Offices may communicate the status of protection of a mark through various statements in the course of their examination
 - Statement of grant of protection
 - Provisional refusal (fixed time limit of 12 or 18 months)
 - Final decisions – following a provisional refusal
 - Further decision
 - Invalidation
- Replacement, Article 4*bis* and Rule 21
- Transformation, Article 9*quinquies*

The Office and Government

- Where it is the Office of origin:
 - It empowers local industry, in particular the SMEs
 - Provides easier access to export markets
 - Promotes international trade and further development of export
- Where the Contracting Party is designated:
 - Simplified examination in the Office; it can focus on substantive examination as WIPO examines for formalities
 - Opening of «new» markets for foreign trademark holders
 - Easier access to your markets means more filings and economic growth
 - Provides more favorable climate for foreign investment

Role of WIPO (the International Bureau)

- The Madrid system is a procedural system
- WIPO examines the formalities, such as
 - Information in the international application
 - Classification of goods and services (Nice)
 - Classification of figurative elements (Vienna)
 - Fees
- WIPO will
 - Register the mark in the International Register
 - Publish the mark in the WIPO Gazette of International Marks (e-Gazette)
 - Notify the Offices of DCPs, inform the OO and send a certificate to the holder/representative

Overview of procedure and roles

The International Trademark Registration Process



Impact on community

- Being a member of the Madrid Protocol can have an impact on the following:
 - Local businesses/industries in the countries concerned
 - The local attorneys

Local businesses and industries

- Trademark protection in the country concerned
 - Important to ensure protection in the home market
- Trademark protection options abroad
 - Various routes for protecting trademark overseas
 - The Madrid System facilitates easy access to potential export markets
 - It is possible to expand the geographical coverage later on
 - Centralized management of trademark portfolio

The local attorneys and agents

- The Madrid Protocol is optional and it does not replace the direct filing route
- The role of local attorneys and trademark agents would be to:
 - Ensure that local business interests have proper protection in the country concerned (home market)
 - Advise local businesses on possibilities of protecting their trademarks outside the country
 - Assist clients with enforcing rights in the country concerned
 - Assist clients with drafting IR applications/responding to provisional refusals
 - File oppositions, cancellation actions
 - Develop trademark strategies for the local businesses

Formal pre-conditions for accession

- Any State that is a party to the Paris Convention may become a party to the Madrid Protocol
- Any intergovernmental organization may become party to the Madrid Protocol where the following conditions are fulfilled:
 - at least one of the member States is a party to the Paris Convention, and
 - that organization has a regional Office for the purposes of registering marks with effect in the territory of the organization
- The main substantive obligation is to give effect to Article 4(1) of the Madrid Protocol

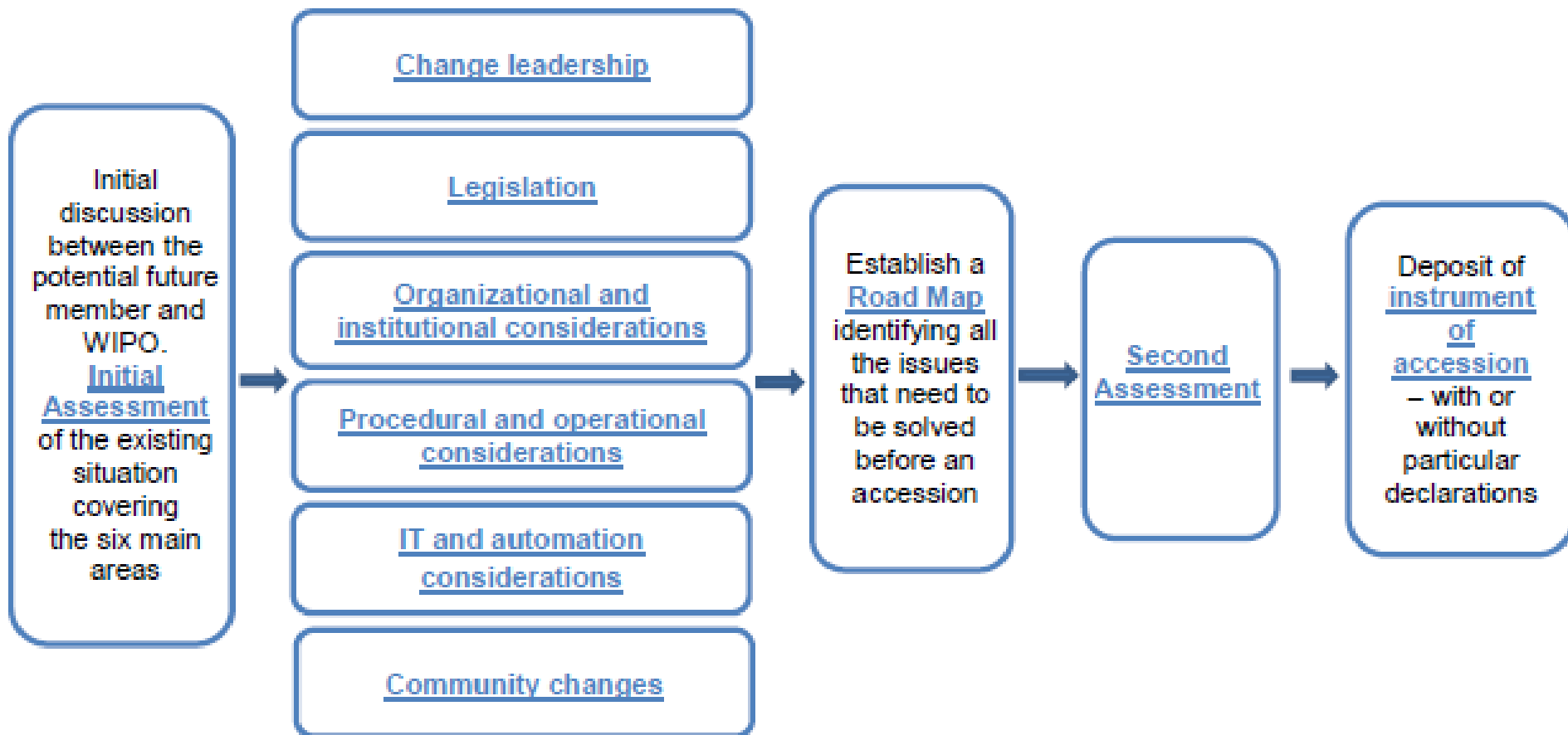
Practical pre-conditions...

- Amended Madrid-compatible legislation needs to be in place, approved and ready for implementation
- Must have necessary institutional organization in place for handling the Madrid Protocol
- Must have operational procedures in place for handling international applications and designations of the future Contracting Party
- Must have discussed communication with the IB, how to receive communications and how to send notifications to the IB
- Staff has received sufficient training

Support from WIPO

- WIPO is prepared to work with local authorities and stakeholders to identify and address some of the challenges that must be overcome before the Madrid Protocol is implemented
- WIPO will provide advice and technical assistance this potential member may require for that purpose
- WIPO provides legal assistance to potential and existing members, like providing legal analysis of national legislation (Model Provisions)

Local preparations



Legislation

- Any country wishing to join the Madrid Protocol must have Madrid-compatible legislation in place before an accession may happen
- We would need to know whether it is necessary to change the legislation or whether the provisions of an international treaty automatically will have effect in the country
- Bill of Accession with details in the Regulations or all details in the Trademarks Act
- The Legal Division can provide comments to the domestic legislation and the Model Provisions
 - **The Model Provisions** are the minimum requirements needed to be included in the domestic legislation

Organization of the Office

- What areas are the Office covering (all or limited IP rights)?
- How is the Office organized?
- Organized under which Ministry?
- Financial autonomy?
- Number of staff and their profile
- The working language(s) of the Office
- Statistics – number of trademark filings per year with breakdown of domestic and foreign filing (from which countries)

Procedures

- General information about the examination system, its main features and the operational and legislative time-limits
 - The contents of an *ex officio* examination, grounds for refusal, an opposition system or cancellation procedure
- A workflow of the trademark processes
- The Office needs to understand the roles of the Office in the Madrid System and how Madrid will fit with domestic processes
- Discuss possible declarations to make in the Madrid Protocol
 - Extending time limits for provisional refusal to 18 months
 - Individual fees
 - Other?

IT and automation

- What kind of IT system is currently used in the Office?
 - IPAS or bespoke system
- Level of automation in the Office
 - Future planned automation
- Means of communication between Office and WIPO in the Madrid System
 - IPAS, HTML, Madrid Office Portal (MOP), PDF?

Outcome of the assessment

- WIPO should have a clear understanding of the framework the future member is working within; when an accession may, at the earliest, take place, the status of its legislative framework, the structure of the Office and all its procedures, the IT system, necessary technical assistance to provide to the Office, etc.
- There should be a common understanding, between WIPO and the Office, of the issues the Office would need to address prior to an accession
 - The Office should establish a **Road Map**

Road Map

- Functions as plan for the future member on issues and/or activities that need to be addressed and solved before an accession can take place.
- Detailed, identifying all relevant issues, persons responsible for carrying out various tasks, as well as a realistic timetable.
- Example can be found on WIPO website

Model Provisions (I)

- The provisions relate to the principal obligations imposed by the Madrid Protocol
- WIPO strongly encourages the minimum provisions to be included in the domestic legislation
- The Madrid Legal Division may, upon request, provide its comments on the compatibility of the domestic law with the Madrid Protocol

Model Provisions (II)

- Definitions on specific terminology used in the context of the international procedure, such as Madrid Protocol, Common Regulations, international application, international registration, the International Bureau, the International Register, basic application and basic registration, etc.
- Two different parts; regulating 1) the role of the Office of origin and 2) the role of the Office of the designated Contracting Party

Model Provisions (III)

- Miscellaneous provisions:
 - Collective, certification and/or guarantee marks
 - Further details concerning IRs to be included in the implementing regulations or instructions issued by the Registrar (delegation of power - provision)
 - Conflict between the Law and the Madrid Protocol
 - The provisions of the Madrid Protocol and the Common Regulations shall prevail
 - Replacement
 - Transformation
- Madrid Legal Division can provide comments on the legislation and its compatibility with the Madrid Protocol

Model forms for Offices

- WIPO has prepared various model forms which Offices can use when they have to notify to WIPO of various decisions on the scope of protection of the mark
- You can find the forms here
http://www.wipo.int/madrid/en/contracting_parties/
- For Offices where designated but also as Office of origin
 - Statements of grant of protection, provisional refusal, final decisions, further decisions, ceasing of effect, and more
- You can make the forms your own, add logo, signature etc
- We are working with IPAS colleagues to incorporate these into your workflows

Official Madrid Forms

- 21 Official Madrid forms on WIPO's website <http://www.wipo.int/madrid/en/forms/>
 - Some are mandatory (MM2, MM4 to MM9, etc.)
 - Some are optional (MM10, MM12, MM21)
 - Some must be attached to other forms (MM17 and MM18 must be attached to MM2 and MM4)
 - One form must be sent directly to an Office (MM16)
- Forms which must be submitted to the IB by an Office – as OO or Office of the CP of the holder:
 - MM2 and in some cases MM5 (where there is no signature by recorded holder)
- Some forms may be sent to the IB or through the Office at the choice of the holder (MM4)

Useful Resources – Accession Kit

- General overview of the Madrid System, its objectives and main features,
- Procedures, domestic implications and effects of accession to the Madrid System,
- Main actions to be undertaken by an intellectual property office as party to the Madrid System,
- Model instrument of accession to the Madrid Protocol,
- Model provisions for implementation of the Madrid Protocol and information concerning declarations made further to the Protocol,
- Principal declarations that may be made in connection with accession to the Madrid Protocol, an Model forms.

Instrument of accession

- Instrument of accession signed by the Head of State or Government or by Minister of Foreign Affairs (follows internal legislation requirements)
- Instrument of accession deposited with the DG of WIPO
- The Madrid Protocol enters into force three months after the accession has been notified by the DG of WIPO
- The instrument of accession may contain declarations

Possible declarations

- Extending the refusal period to 18 months - Article 5(2)
- Extending the refusal period for oppositions to 18 months+ - Article 5(2)
- Individual fees - Article 8(7)
 - Specifying the amount for designations and renewal in local currency
- Intention to use the mark - Rule 7(2)
- Recording of licenses in the International Register has no effect in the Contracting Party - Rule 20*bis*(6)
 - Two different declarations (a) and (b)

Beyond accession

- The second mission to the Office will take place after the country has deposited the instrument of accession
- The purpose is to review the accession:
 - Taking stock of the situation, taking into account any issues addressed in the assessment mission
 - Working with IPAS, where relevant, to ensure that the Model Forms are implemented in the workflows
 - Going through the checklist
 - Provide further training of staff
 - Organize a seminar for the stakeholders (industry and agents), introducing the Madrid Protocol

Thank you
for your attention

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