

# MADRID PROTOCOL



by: **Valerie Laura V. Marquina**  
**Bureau of Trademarks, Division IV, Madrid Unit**

# ROAD TO ACCESSION

- 2004: 1<sup>st</sup> considered accession
- 7 years until the submission of the Recommendation for Accession to the Department of Foreign Affairs
- September 2011: Submission to the Department of Foreign Affairs
- April 25, 2012: Deposit the Instrument of Accession to WIPO
- July 25, 2012: Entry into force
- 85<sup>th</sup> Contracting Party of the Madrid Protocol
- 3<sup>rd</sup> ASEAN member after SG and VN

The will to succeed is important, but  
what's more important is the will to  
prepare.

— *Bobby Knight* —

# PREPARATION FOR ACCESSION

- WIPO-organized missions
- Consultations:
  - May 2006
  - December 2007
  - March 2011
  - Forum for the In-house Counsel, Consulting Firms, and Government Institutions
  - Forum for Trademark Owners
  - Forum for Trademark Practitioners
  - Business groups

- Improvement in the Operations of IPOPHL's Bureau of Trademarks
  - 2005: Average first action dependency or Turn-around-time (TAT):
    - Filing of the application to issuance of first (1<sup>st</sup>) action: 20 months
    - Filing of the application to registration: 47 months
    - Use of the automated system (TEAMS or Trademark Electronic Application Management System), close monitoring of applications, revised work standards, rationalization of assignment of workloads to examiners

- 2010: Average first action dependency or Turn-around-time (TAT):
  - Filing of the application to issuance of first (1<sup>st</sup>) action: 4 months
  - Filing of the application to registration: 10 months
- Clean-up of trademarks database, reengineering of business processes and implementation of Industrial Property Automation System (IPAS)

- Revision of Trademark Regulations and the Rules and Regulations Implementing Madrid Protocol
- Set up the Madrid Desk
- Training of at least three (3) examiners
- Information dissemination campaigns and training of users of the Madrid System



# MADRID OPERATIONS

## MADRID UNIT

- Reconstitution: December 2013
- All processes relating to International Applications (IAs) and International Registrations (IRs)
- 8 members and 1 Madrid Unit Head
- Examination of IRs is concentrated on the Madrid Unit
- Set-up a matrix of responsibilities and a work schedule



# RESPONSIBILITIES

- Processing of International Applications (IAs)
- Downloading of IRs from WIPO server
- Printing of PDF notifications downloaded from the FTP server
- Addressing irregularity notices
- Issuance of ceasing of effect
- Scanning of documents for transmittal
- Coordination with the Bureau of Legal Affairs
- Electronic transmittal
- Preparation of Statement of Grant of Protection (SGP)
- Issuance of Statement of Account
- Initial Publication of IRs received
- Publication of allowed IRs
- Preparation of statistical information

# WORK SCHEDULE

Monday	Tuesday	Wednesday	Thursday	Friday
Publication of Allowed IRs for opposition purposes	Publication of new IRs (not for opposition)	Certification of IAs;	Scanning of documents	Downloading of IRs from WIPO Portal
		Preparation of responses to irregularities;	Transmittal Day	
		PRP based on opposition	(1 <sup>st</sup> day of the month): <ul style="list-style-type: none"><li>•Meetings</li><li>•Preparation of statistics</li><li>•Issuance of Statement of Accounts</li></ul>	

# PROCESSING OF IAs

- MM2 form is filed with the Duty Officer of the Bureau of Trademarks and is forwarded to the Madrid Unit (MU).
- MU officer checks all entries of MM2 before forwarding to MU Head for certification
  - If there are items to be corrected or amended, an email is sent to the applicant/agent for the submission of an amended form.
- MU Head does a final check before certifying
- Certified application is scanned and transmitted to WIPO via ftp

# IRREGULARITIES

## MOST COMMON REASONS:

- Fees:
  - Deficiency in fees due to exchange/conversion rates and bank service charges
- Classification and description of goods and services



**CLASSIFICATION**  
**GOODS &  
SERVICES**

# EXAMINATION OF IRs

2012-2013:

- All examiners

2014:

- Madrid Unit only

2015:

- Madrid Unit + 4 additional examiners outside the Madrid Unit

# STATISTICS: OUTBOUND

Year	No. Of Applications	No. of Designations
2012	22	35
2013	43	243
2014	49	273
2015	34	406
2016 (as of November 29)	32	193
<b>TOTAL</b>	<b>180</b>	<b>1150</b>

# STATISTICS: INBOUND

Year	No. of International registrations	TAT from Notification to Issuance of PRP (in months)	TAT from Notification to Registration (in months)
2012	298	N/A	2
2013	3264	5.5	4
2014	3910	7.5	10
2015	5423	1.67	6.47
2016 (as of June 30)	1983	<b>1.76</b>	<b>5.47</b>

# STATUS OF IRs

Year	Pending (%)	No. Of Applications Pending	No. of Applications Received
December 1, 2013	72	2321	3235
May 15, 2015	5	471	9397
November 30, 2016	2	291	16800



# MADRID UNIT: WHERE WE ARE NOW

- IPOPHL as venue for attachment trainings
- Examiners of the MU are now trainers in these trainings
- Extensively using IPAS for Madrid processes, from downloading of IRs (Madrid Module) to the issuance of SGPs.

# MADRID UNIT: FUTURE PLANS

A. MADRID UNIT (Policy matters, Quality Control, Monitoring, Training, Point of Contact, Examination)



1. Examination – ALL Examiners
2. Processing group – Admin Division (scanning, transmittals, queries etc.)

# MADRID UNIT: FUTURE PLANS

B. Possible lifting of the “No subsequent designation” for the PH in respect of international registrations prior to the date of accession – this will result to more IRs for the PH and an improvement in the economy

# ADVICE TO FUTURE MEMBERS OF MADRID

- from the experiences of other IP offices



- Continue to



or

**STREAMLINE**

current processes

- Know your Madrid Processing Team in WIPO and don't hesitate to  them questions and clarifications regarding Madrid issues and concerns

“ Experience  
is the  
teacher  
of all  
things. ”

Julius Caesar



Thank you.