

Trademark Attorney Perspective: Making the Most of the Madrid System

07.12.2023

International Registration Systems

- a. International Registration under the Madrid Protocol (WIPO)
- b. National Registration
- c. Community Registration
 - i) EUIPO
 - ii) Benelux
 - iii) OAPI
 - iv) ARIPO

Considerations When Selecting Methods for Foreign Trademark Applications

Economic reasons

The Strength of the Basic Mark

Examination/Registration Process

Different Use of the Trademark

Advantages of Filing an Application through the Madrid Protocol via WIPO

- Single authority, Single Language, Single Application
- No Obligation to Work with Foreign Representatives
- Cost Efficiency
- Simplified Filing Requirement & Registration Process
- Centralized Management of Updates
(*address changes, company name changes, renewals, etc.*)
- Additional Countries Can Be Included
- Transformation into national filings

Considerations When Selecting Methods for Foreign Trademark Applications

The Protocol came into effect in Türkiye on **January 1, 1999**
(Approval date: 1997).





Since that date, Türkiye has been accepting international
trademark registration applications **under the Madrid Protocol**
and acting as the Office of Origin by submitting applications

International Trademark Applications to be filed from Turkey **DERIS**^{TR}

Madrid e-filing
System to WIPO

Filing to
TURKPATENT (by
submitting MM2
form)

Examination Conducted by TURKPATENT

-  Substantive Registration or Eligibility for Application (Trademark Sample, Applicant Information, Product/Service)
-  Entitlement Examination
-  Official Fee of TURKPATENT
-  MM18 Form for applications designated to USA

The International Trademark Registration Process Scheme Obtained From WIPO



International Registration Certificate

It does not imply the trademark has been registered; it means the formal examination has been completed, and notifications will be sent to the designated countries.

Recordal of Changes That Can Be Made through WIPO

- Changes occurring in international registration/application are filed to WIPO (*changes in owner information, transfer, etc.*)
- WIPO e-renewal
- After making the necessary adjustments in the WIPO register, notifications regarding the changes are sent to national offices.

The Dependency and Transformation

- An internationally registered trademark remains dependent on the basic mark, which has been applied for or registered in the Office of Origin, for a period of **five years from the date of international registration**.
- In cases of complete or partial refusal/cancellation of the international registration in the Office of Origin, the international registration may be transformed into national or regional applications in all or some of the designated Contracting Parties

The Key Points of a WIPO Application

- "Examine Country Restrictions and Profiles of Member Countries

<https://www.wipo.int/madrid/en/members/declarations.html>

<https://www.wipo.int/madrid/memberprofiles/selectmember>

- Classification (MGS)

<https://webaccess.wipo.int/mgs/>

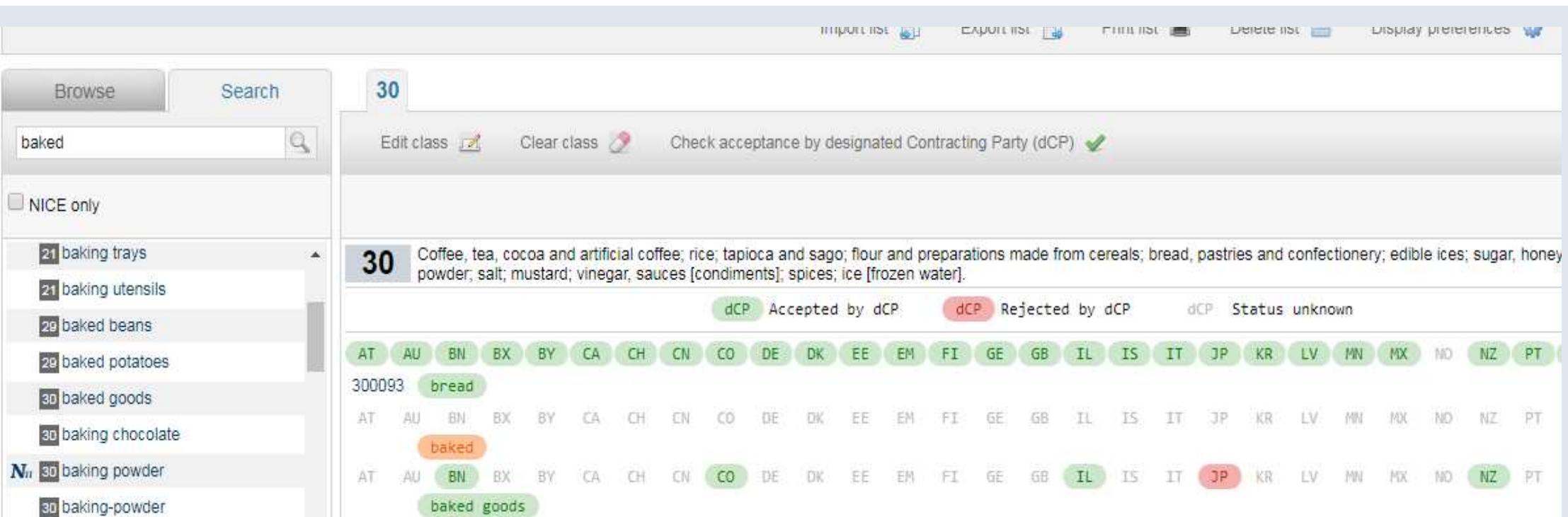
- Research Databases (Global Brand Database, Madrid Monitor)"

Madrid Member Profile

The screenshot shows the 'Madrid Member Profiles' web application. At the top left, the title 'Madrid Member Profiles' is displayed. To the right of the title are four buttons: 'Back', 'Save as PDF', 'Save as Excel', and 'Restart'. Below these buttons is a dropdown menu labeled '-----Select Translation-----' with a downward arrow. A progress bar below the dropdown shows three steps: '1 Select members', '2 Select details', and '3 Member information'. The third step is currently active and highlighted in blue. Below the progress bar, the text 'Türkiye' is displayed with a downward arrow to its left. Underneath 'Türkiye' is a grey box containing the text 'Last update on : Sep 5, 2022'. At the bottom of the page, the text 'Information on procedures as a designated Contracting Party' is visible.

[*https://www.wipo.int/madrid/memberprofiles/selectmember#/*](https://www.wipo.int/madrid/memberprofiles/selectmember#/)

Madrid Goods and Services Manager - MGS



The screenshot displays the Madrid Goods and Services Manager (MGS) interface. On the left, there is a search bar with the text 'baked' and a list of search results including 'baking trays', 'baking utensils', 'baked beans', 'baked potatoes', 'baked goods', 'baking chocolate', 'baking powder', and 'baking-powder'. The main area shows a detailed view for class 30, which includes the description: 'Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastries and confectionery; edible ices; sugar, honey powder; salt; mustard; vinegar, sauces [condiments]; spices; ice [frozen water]'. Below this, there are buttons for 'dCP Accepted by dCP' and 'dCP Rejected by dCP', and a row of country codes (AT, AU, BN, BX, BY, CA, CH, CN, CO, DE, DK, EE, EM, FI, GE, GB, IL, IS, IT, JP, KR, LV, MN, MX, NO, NZ, PT). The results show 'bread' accepted in all countries, 'baked' accepted in BN, and 'baked goods' accepted in BN, CO, IL, and NZ.

<https://webaccess.wipo.int/mgs/?lang=en>

Global Brand Database

Global Brand Database

[QUICK SEARCH](#) [BY BRAND NAME](#) [BY BRAND LOGO](#) [BY GOODS AND SERVICES](#) [ADVANCED SEARCH](#) [EXPLORE](#) [DATA COVERAGE](#) [TOOLS](#)

Searching Trademark applications, appellations of origin, emblems and international non-proprietary names. Covering 63,641,467 records from 76 data sources. [Check our data coverage](#)

Brand name	Owner	Number	Combined	
Search by brand name ...				Search
Ex: wipo, wip*, w?po				

GLOBAL BRAND DATABASE

November 1, 2023

SURVEY

Help us improve by taking our less than 5 mins [survey](#).

[Earlier news](#)

<https://www.wipo.int/reference/en/branddb/>

Madrid Monitor

The screenshot shows the WIPO Madrid Monitor website. At the top left is the WIPO logo. A breadcrumb trail reads: Home > Madrid System > eMadrid > Madrid Monitor. The main heading is "Madrid Monitor". Below it is a descriptive paragraph: "Keep up to date with your international registrations. Follow the status of your international application or trademark registration; access detailed information on all trademarks registered through the Madrid System; and keep an eye on competitors' trademarks." An orange callout box contains the text: "New: Use the 'Designation status' tab to easily check the status of protection of your international trademark registration in designated Madrid System Members; download unofficial certificates of protection; and more. Find out more and send us your feedback. Switch to the old version of Madrid Monitor." Below this is a navigation bar with "Search", "WIPO Gazette", and "Support" tabs. The "Search" tab is active, showing a sidebar with "simple search", "advanced search", "realtime search", and "image search" options. The main search area is titled "Search for" and contains a search input field with a dropdown menu on the left and a search icon on the right. Below the search box is a note: "Start your search by entering words, numbers, dates, classes or countries: the most likely search field(s) will be automatically selected for you. If you wish to change the assigned field(s), use the drop down menu next to your term. Leave the search box empty to browse the full collection."

<https://www3.wipo.int/madrid/monitor/en/>

Fee Calculator

Fee Details

Basic fee	903.00	Details
Fees of contracting parties	3,689.00	Details
Complementary fee	100.00	Details
Grand Total (CHF)	4,692.00	

Contracting Party	Calculation	Classes	Amount
GE - Georgia	[Individual fee (international application): 314.00, Individual fee per additional class (international application): 1 x 115.00(Number of classes beyond 1)]	2	429.00
AE - United Arab Emirates	[Individual fee (international application): 1630.00, Individual fee per additional class (international application): 1 x 1630.00(Number of classes beyond 1)]	2	3,260.00
		Total (CHF)	3,689.00

<https://madrid.wipo.int/feecalapp/>

Basic Elements of the Madrid Protocol Application Form

Basic Mark Information

- Multiple trademarks may exist (in different classes or divided under the same mark).
- Trademark / Trademark sample / colored or black and white
- Description (sound mark, 3D mark, color mark, etc.)
- Priority Information

Owner Information

- There can be multiple (each should be authorized to apply).
- Full address
- The entitlement to apply

Goods & Services

- It is possible to be restricted based on the basic mark's coverage but cannot be expanded
- It is possible to be restricted according to the designated countries

CONTACT

Inebolu Sokak No 5 Deris Patent Building/Kabataş/Setüstü 34427 Istanbul Turkey

P +90(212) 252 61 22-23 +90(212) 249 70 10-11 +90(212) 292 60 00 (6 Lines)

F +90(212) 293 76 76 +90(212) 292 59 94 (3 Lines)

E deris@deris.com.tr