



Madrid System Overview and Available Tools

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Legal Framework

Madrid System
Concerning the
International
Registration of Marks

Madrid Agreement (1891)

Madrid Protocol (1989)

Common Regulations (1996)

Administrative Instructions (2002)

National Laws & Regulations

Protection options

- When you have a product and a trademark, then a choice must be made regarding the best way to protect your trademark abroad:
 - The national route: File trademark application with the Trademark Office of each country in which you want protection
 - The regional route: Apply in countries which are members of a regional trademark registration system with effect in all member states (ARIPO, Benelux Trademark Office, EUIPO and OAPI)
 - The international route: File through the Madrid Protocol

What is the Madrid System?

- A system for international registration of trademarks
- A centralized filing and management procedure
- It is convenient:
 - A one-stop shop for trademark holders to obtain and maintain trademark protection in export markets
 - File one application, in one language and pay one set of fees for protection in multiple markets
- It is cost-effective:
 - One international application is equivalent to a bundle of national applications, effectively saving time and money
 - Avoid paying for translations into multiple languages or working through the administrative procedures of multiple IP Offices

The Madrid System offers broad coverage

- Protect your trademark/s simultaneously in the 113 countries covered by the 97 members of the System

- Recent accessions:

- 2012: Colombia, Mexico, New Zealand and Philippines

- 2013: India, Rwanda and Tunisia

- 2014: OAPI and Zimbabwe

- 2015: Cambodia: Algeria, The Gambia, Lao PDR

- 2018: Malawi

- Future accessions:

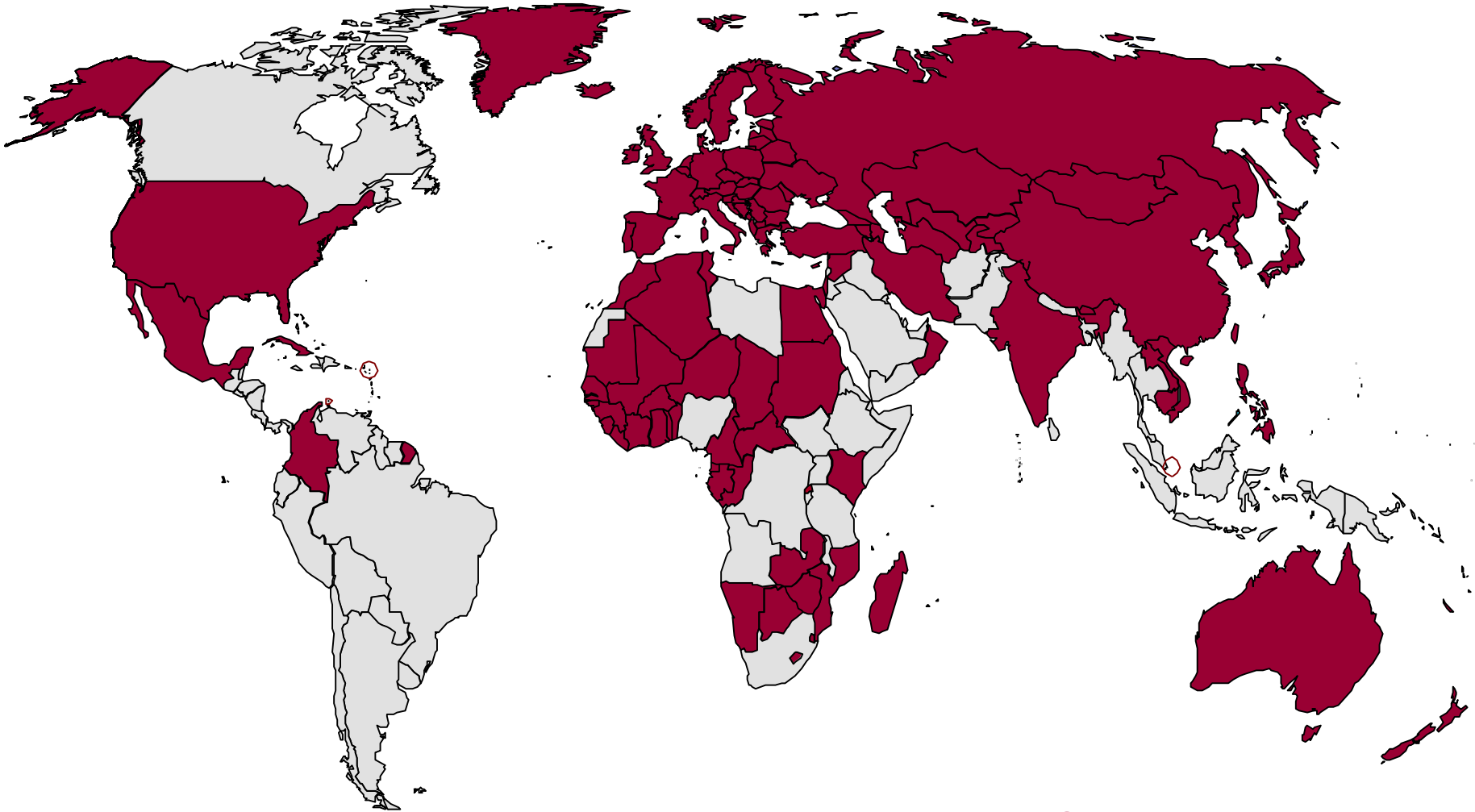
- ASEAN countries

- Latin America and Caribbean countries

- African countries

- Arabic region

Members of the Madrid System



**97 members* (including EU and OAPI)
covering 113 countries**

*All are party to the Protocol, the governing treaty, while 55 are also party to the Agreement

Being a member of the Madrid System

- Being a member of the Madrid System may have an impact on the
 - Local businesses and industries
 - The Office and the Government
 - The local attorneys and agents

Local businesses and industries

- Trademark protection in the country concerned
 - Important to ensure protection in the home market
- Trademark protection abroad
 - Various routes for protecting your trademark
 - 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 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

How the Madrid System works

The International Trademark Registration Process



[Video:](#)



Stage 1: Application through your OO

- To be **entitled to use** the Madrid System, you must:
 - Have a real and effective industrial or commercial establishment in, or
 - Be domiciled in, or
 - Be a national of a member of the Madrid System
- Before filing an international application, you need to have registered or filed an application (**basic mark**) in your Office of origin
- Submit an **international application** through this same IP Office, which will certify and forward it to WIPO

Stage 2: Formal examination by WIPO

- WIPO conducts a **formalities examination** of your international application
- Once approved, the mark is **recorded in the International Register**
- WIPO sends a **certificate of international registration** and notifies the IP Offices, of the **designated Contracting Parties**, in which protection is sought
- The scope of protection is not known at this stage. It is only determined **after substantive examination** and decision by the IP Offices, as outlined in Stage 3

Stage 3: Substantive examination by the designated Contracting Party

- IP Offices make **a decision within 12 or 18 months** in accordance with their legislation. WIPO records the decisions and notifies you
- If an IP Office refuses to protect your mark, it will not affect the decisions of other offices. You can contest a refusal decision before the IP Office concerned
- If an IP Office accepts to protect your mark, it will issue **statement of grant of protection**
- The international registration is **valid for 10 years**. Renew directly with WIPO with effect in the designated Contracting Parties

Key features of the Madrid System

- One registration covering multiple territories
- Fixed time limit for refusal – 12 or 18 months
- Expand protection to new export markets (subsequent designation)
- The IR is depending on the basic mark for 5 years: where the ceasing of effect of the basic mark will impact the IR
 - Possible to transform the IR into national rights
- Tailor the list of goods and services for the different markets
- Centralized management of portfolio

Fees

- Fees payable to WIPO in Swiss francs
- Basic fee* includes 3 classes of goods/services
 - 653 Swiss francs - b/w reproduction of mark
 - 903 Swiss francs - color reproduction of mark
- Fees for designating CPs:
 - Standard fees: Complementary (100 Swiss francs per DCP and supplementary (100 Swiss francs per class beyond 3)
OR
 - Individual fees where this is declared
- Fees collected by WIPO and distributed to DCPs according to the fee regime

WIPO resources and E-Services (1)

- Visit the Madrid Website www.wipo.int/madrid/en
- The Madrid Website provides resources and E-Services to assist you to [search before filing](#), [file an application](#) and to monitor and [manage your registration](#)
- In summary, these resources include...

WIPO resources and E-Services (2)

SEARCH

[ROMARIN](#) – database of international registrations

[Member Procedures](#)

[Global Brand Database](#) – search marks by text and image from national/international sources, including trademarks, appellations of origin and official emblems (over 17,880,000 records)

MONITOR

[Madrid Real-Time Status](#) of international applications and progress of requests being processed by WIPO

[Madrid Electronic Alert](#) monitor changes to international registrations (third party tool)

FILE

[Forms and E-Forms](#)

[Madrid Goods & Services Manager](#) – correct good & service specifications and translation

[International Application Simulator](#)

[Fee Calculator](#)

[E-Payment](#) – online payment system by credit card/[WIPO current account](#)

MANAGE

[Madrid Portfolio Manager](#) access registration documents, uploading of requests for recording, payments

[Forms and E-Forms](#) – [E-Subsequent Designation](#) and [E-Renewal](#)

[Translation request](#) into official Madrid working languages

[Extracts](#) from the International Register

WIPO resources and E-Services (3)

CONSULT

[E-Services overview and tutorials](#)

[Legal texts](#) – Agreement/Protocol, Regulations, Administrative Instructions

[Declarations made under the Madrid Agreement and the Madrid Protocol](#)

[Guide to the International Registration of Marks](#)

[WIPO Gazette of International Marks](#)

[Office practices on replacement](#)

[Statistics](#)

[Making the Most of the Madrid System](#)
– Web publications

[Warning](#) – misleading invoices

UPDATES

[Information Notices](#)

[Madrid Highlights](#) – quarterly newsletter for Madrid System users

[Subscribe](#) to receive news and updates on the Madrid System by e-mail

Online Search Tools

■ ROMARIN

Contains information regarding all IRs recorded under the Madrid System, that are currently in force in the International Register, as well as expired marks. It also includes data relating to pending international applications and subsequent designations at the International Bureau

■ Global Brands Database

Lets you easily search multiple brand-related data sources, including image search

Online Filing Tools

■ [Madrid Application Simulator](#)

The simulator is designed to show you how to use the Madrid System to seek the protection of your mark abroad. At the end of the simulation, it will also help you estimate the cost of registering your mark through the Madrid System

■ [Madrid Fee Calculator](#)

For calculating the cost of an application for IR, subsequent designation or renewal

■ [Madrid e-Payment](#)

A service used to pay fees as notified in irregularity letters or other WIPO communications with regard to international

■ [Goods and Services Manager](#)

A tool to assist trademark applicants and their representatives in compiling the lists of goods and services that they need to submit when filing international applications

Online Monitoring Tools

■ Madrid Real-Time Status

A tool to allow users to determine the current status of their applications and other requests being processed at WIPO

■ Madrid Electronic Alerts

A tool to allow users to register a list of IRs and to be informed by email when any of them change

Online Management Tools

■ Madrid Portfolio Manager

A tool to allow the holders of IRs or representatives to view and modify the IRs for which they are responsible, and includes tailored links to e-renewal and e-payment and e-form

■ Madrid Web Forms

Tools to allow the holders of IRs or representatives to view complete and submit official forms (MM Forms) online

■ Madrid e-Renewal

Online renewal of IRs with payment by credit card or through a current account opened with WIPO

Online Consultation Tools

- [WIPO Gazette of International Marks](#)

The official publication of the Madrid System

- [Madrid Dynamic Statistics](#)

Annual statistical supplement, and year to date statistics, including work in progress

Madrid Monitor Search Tool

- [Madrid Monitor](#) is the new tool for Madrid System users, integrating in one application functionalities and information currently accessible through ROMARIN, the WIPO Gazette of International Marks, Madrid E-Alert and Real-Time Status
- <http://www.wipo.int/branddb/wo/en/>
- First step of E-Madrid, a broader Madrid Registry initiative focused on delivery of an enhanced experience for our customers throughout the lifecycle of their mark

Keep updated on the Madrid System

- Visit the Madrid Website www.wipon.int/madrid/en
- Subscribe to [Madrid Notices](#), our regular legal and news updates via the [WIPO e-newsletter distribution platform](#)
- Sign up to receive our quarterly e-newsletter, [Madrid Highlights](#)

How to become a member of the Madrid Protocol?

Preconditions 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

Assistance 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

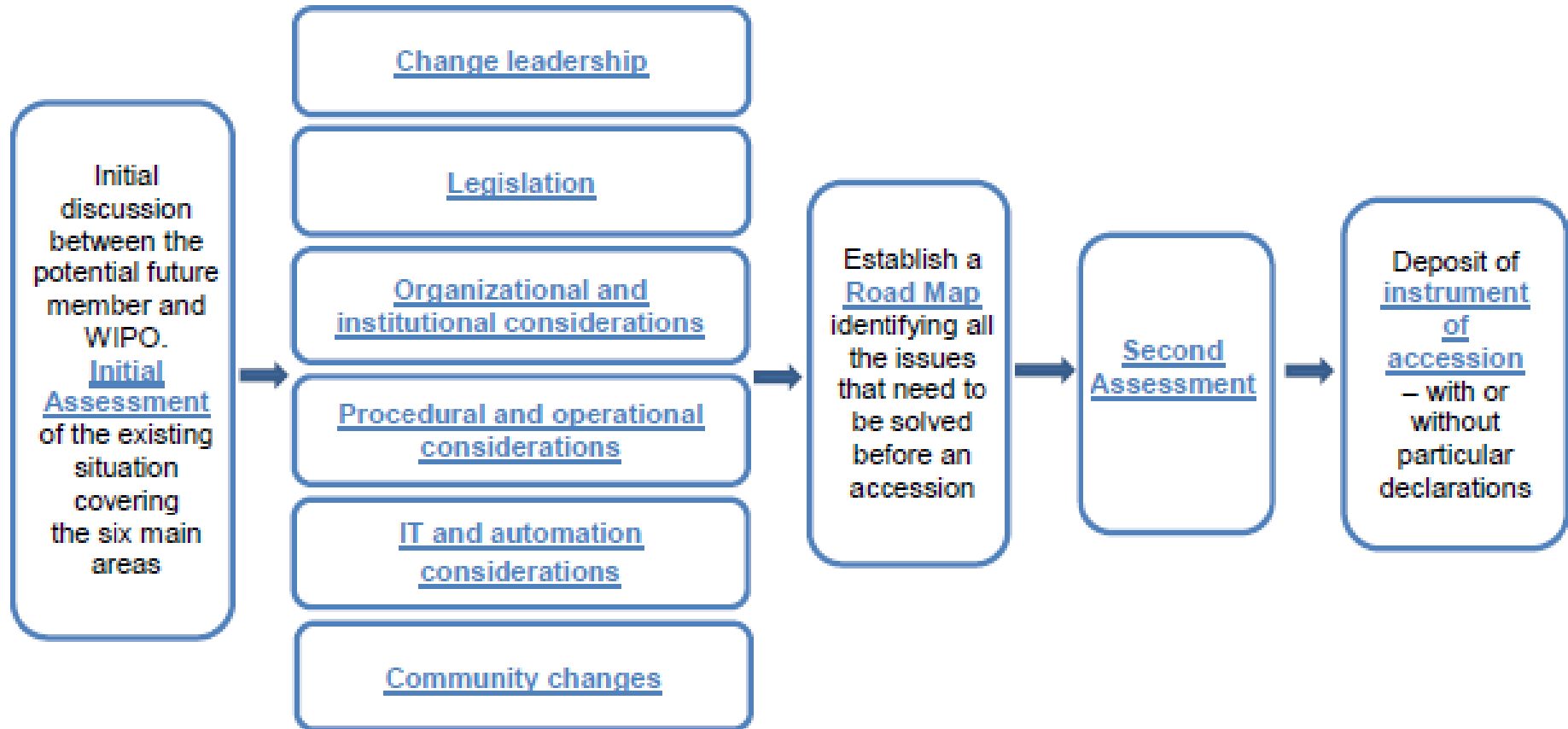
- WIPO provides legal assistance to potential as well as existing members, like providing legal analysis of national legislation (Model Provisions)

- Documentation on the web site

(<http://www.wipo.int/madrid/en/future-members/accession-guide/>): Accession Kit and Overview of Preparatory Work

Prior to an Accession to the Madrid System

Local preparations



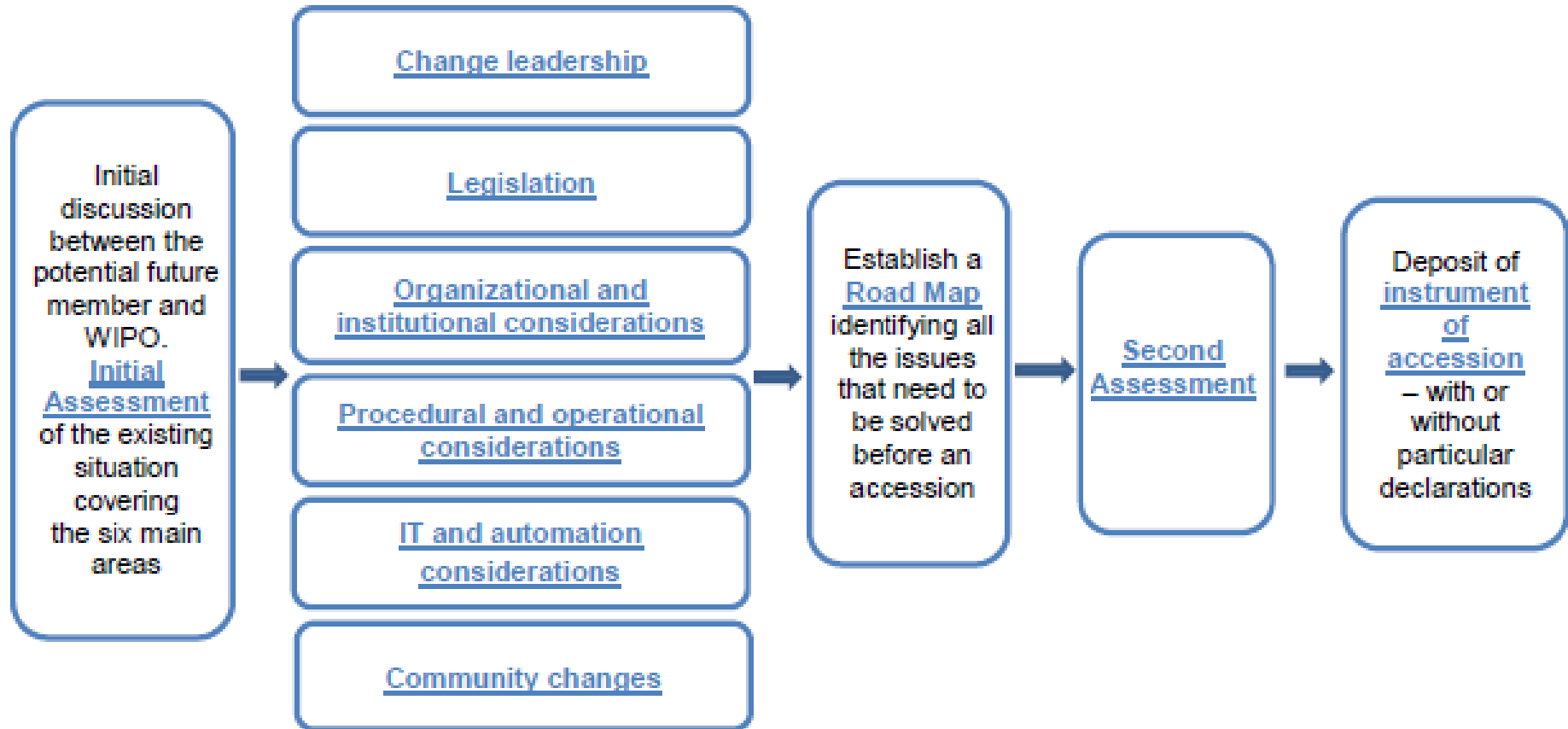
Instrument of accession

- 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 3 months after the accession has been notified by the DG of WIPO
- The instrument of accession may contain declarations

Possible declarations

- Extension to 18 months of the refusal period - Article 5(2)
- Extension to 18 months+ (oppositions) - 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)

Local preparations



Thank you