



WIPO | MADRID

The International
Trademark System

Overview of the Madrid System for the International Registration of Marks

Study visit: Intellectual Property Focal Persons of the African Regional
Economic Communities and Executives Bodies of the African Union

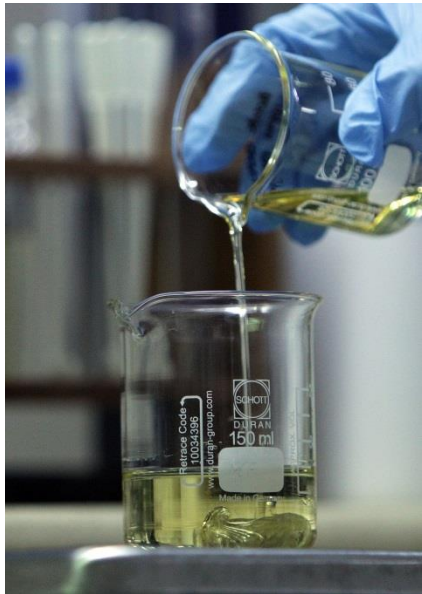
Juan Rodriguez
Senior Legal Officer
Madrid Registry
Brands & Designs Sector

Geneva, May 18, 2016

Options for international protection

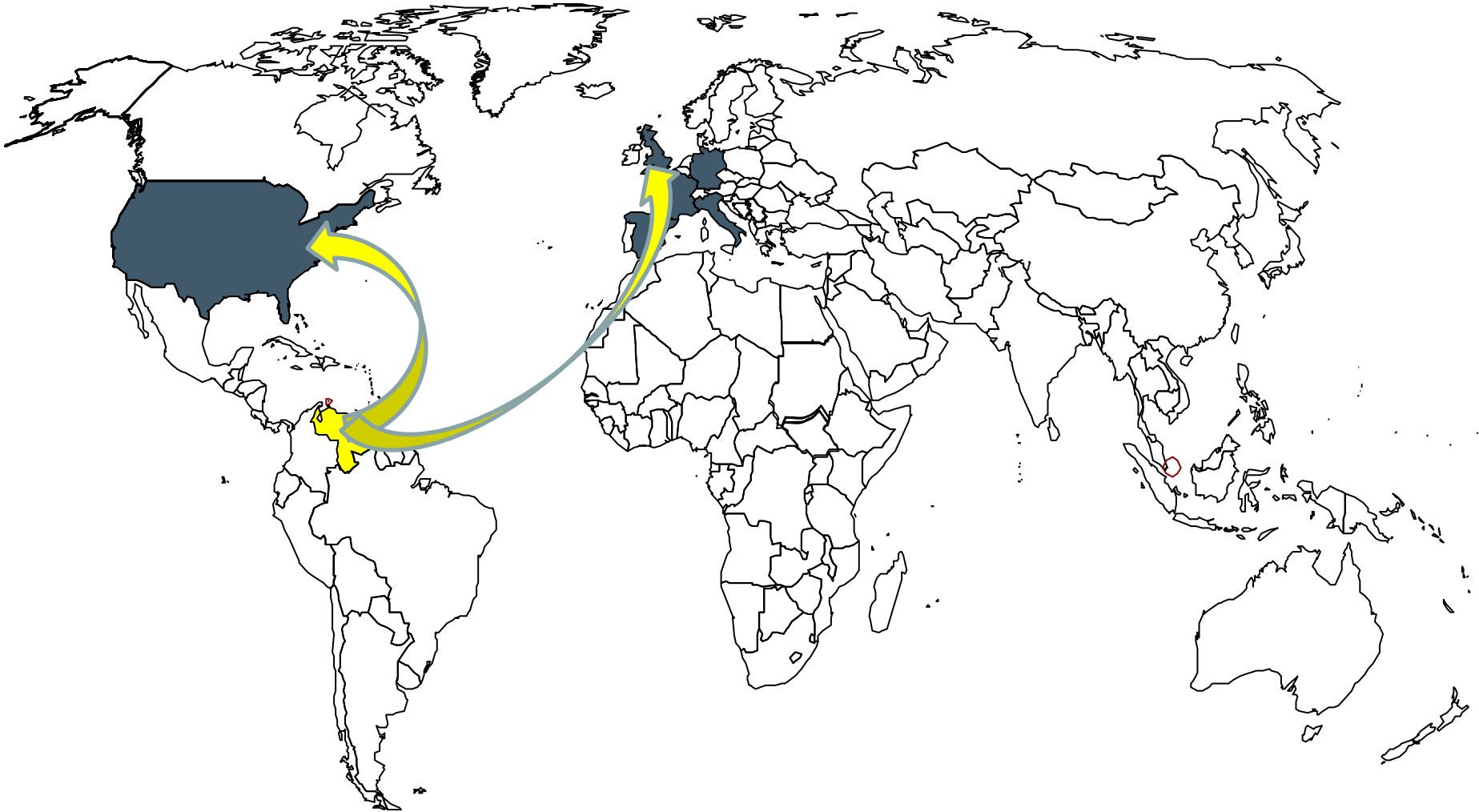
Protection options

- The national route: File trademark application with the Trademark Office of each country in which you want protection
- The regional route: File with the Office 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



- Incorporated in 1996
- Natural extracts for cosmetics and food
- 10 employees
- USD 300 revenue
- European strategy 2012-16

How to obtain protection from Colombia in :
Germany, Italy, France, Spain, United Kingdom and United States



Class 03: Soaps, perfumery, oils, cosmetics for skin care and beauty,
hair lotions

The national route

- Germany (DPMA) : EUR 300
- Italy (UIPM) : EUR 101
- France (INPI) : EUR 250
- Spain (OEPM) : EUR 144.58
- UK (IPO) : GBP 200
- USA (USPTO) : USD 375
- 6 national Offices
- 6 applications
- 6 registrations
- 5 languages (English, French, German, Italian, Spanish)
- 3 currencies (EUR, GBP, USD)
- Fees CHF 1,523.44
- Other costs?



The regional route

■ EU(EUIPO) :
EUR 1,050

■ USA (USPTO) :
USD 375



- 2 Offices
- 2 applications
- 2 registrations
- 1 language (English)
- 2 currencies (EUR, USD)
- Fees CHF 1,519.86
- Other costs?

The international route

- One international application
- In one language (Spanish)
- One international registration with effects in Germany, France, Italy, Spain, the United Kingdom and the United States
- One currency
- Fees CHF 1,861



NEYBER - IRN 1204623

November 5, 2013



CERTIFICADO DE REGISTRO

La Oficina Internacional de la Organización Mundial de la Propiedad Intelectual (OMPI) certifica que las indicaciones que figuran en el presente certificado se corresponden con la inscripción efectuada en el Registro Internacional de Marcas mantenido en virtud del Arreglo de Madrid y del Protocolo concerniente a ese Arreglo.

Reproducción de la marca en color bajo la Regla 9.4(a)(vii)



Registro Internacional	1 204 623
Fecha del registro	5 de noviembre de 2013
Fecha de vencimiento del próximo pago	5 de noviembre de 2023
Nombre y dirección de titular	NEYBER S.A.S. Carrera 97 No. 21-51, Bogotá D.C. (Colombia)
Naturaleza jurídica del titular (persona jurídica) y lugar de constitución	SOCIEDAD POR ACCIONES SIMPLIFICADAS (SAS)
Nombre y dirección del representante	Mariano Fiori Melo, Calle 93 No. 11A 28, Oficina 601, Bogotá (Colombia)
Clasificación de elementos figurativos	5.3; 27.5; 29.1
Indicación relativa a la naturaleza y tipo de la marca	Las palabras que componen la marca no tienen significado alguno.
Lista de productos y servicios NCL(10-2013)	3 Jabones, perfumería, aceites, cosméticos para el cuidado y belleza de la piel, lociones para el cabello.
Solicitud de base	Colombia, 15.02.2013, 1330805
Registro de base	Colombia, 13.08.2013, 477383
Designaciones en virtud del Protocolo de Madrid	Alemania, España, Estados Unidos de América, Francia, Italia, Reino Unido
Declaración de la intención de utilizar la marca	Estados Unidos de América, Reino Unido

- Protected in :
Germany, France,
Italy, Spain and the
UK.
- Provision refusal for
further specification in
: US

The Madrid System

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 (E/F/S) 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

125 years of experience; close to 1.3 million registrations



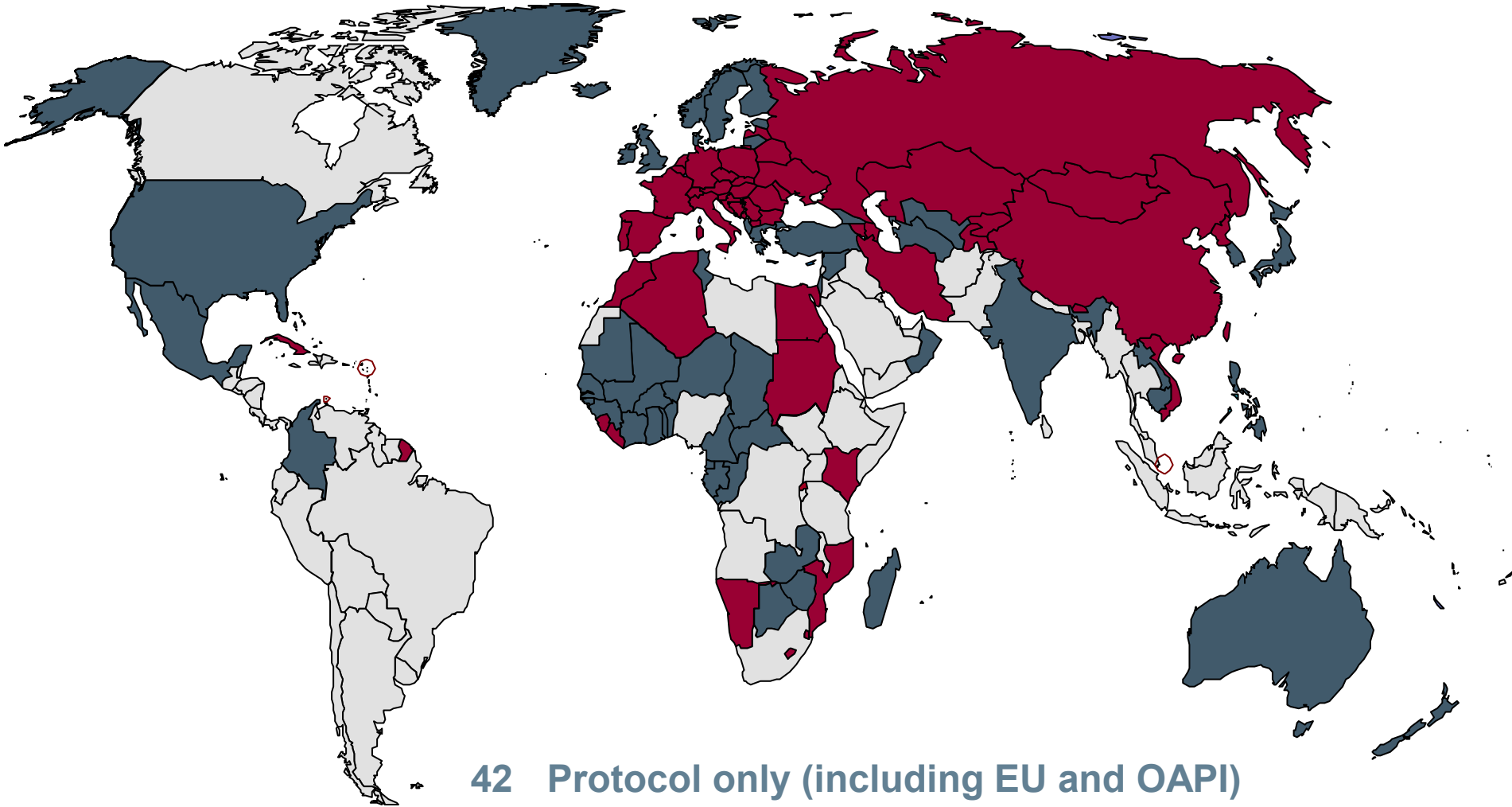
- *Longines* is the oldest registration in force
- Registered in Switzerland in 1889, in the International Register since 1893.



PARADE

- *Parade* is the registration number 1 298 400.
- Applied in the France in September 2015, in the International Register since December 2015

Members of the Madrid System

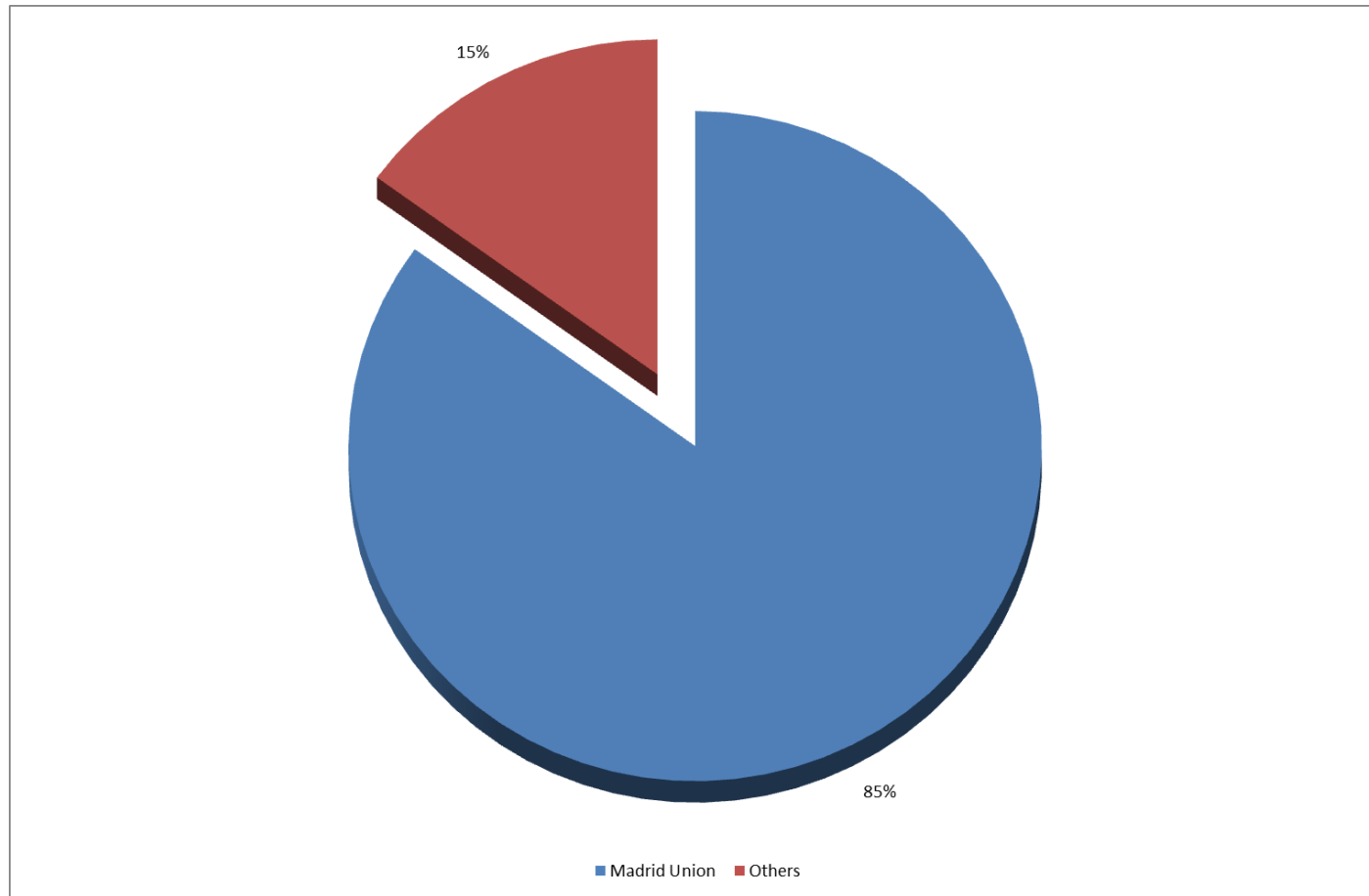


42 Protocol only (including EU and OAPI)

55 Agreement and Protocol

97 Members covering 113 countries

Exports – 2014 (UN COMTRADE)



Membership in the region

- OAPI (2015)
- Botswana (2006)
- Gambia (2015)
- Ghana (2008)
- Kenya (1998)
- Lesotho (1999)
- Liberia (1995)
- Mozambique (1998)
- Namibia (2004)
- Rwanda (2013)
- Sierra Leone (1998)
- Sudan (1984)
- Swaziland (1998)
- Zambia (2001)
- Zimbabwe (2015)

How the Madrid System works

The International Trademark Registration Process



[Video:](#)



Costs

- Basic fee* includes 3 classes of goods/services
 - 653 CHF- b/w reproduction of mark
 - 903 CHF - color reproduction of mark

- Fees for designating CPs:
 - standard fees:
 - complementary (100 CHF per DCP) and
 - supplementary (100 CHF per class beyond 3)
 - OR
 - individual fees, where this is declared

* Applicants from LDCs benefit from 90% reduction of the basic fee

Registration general profile 2015

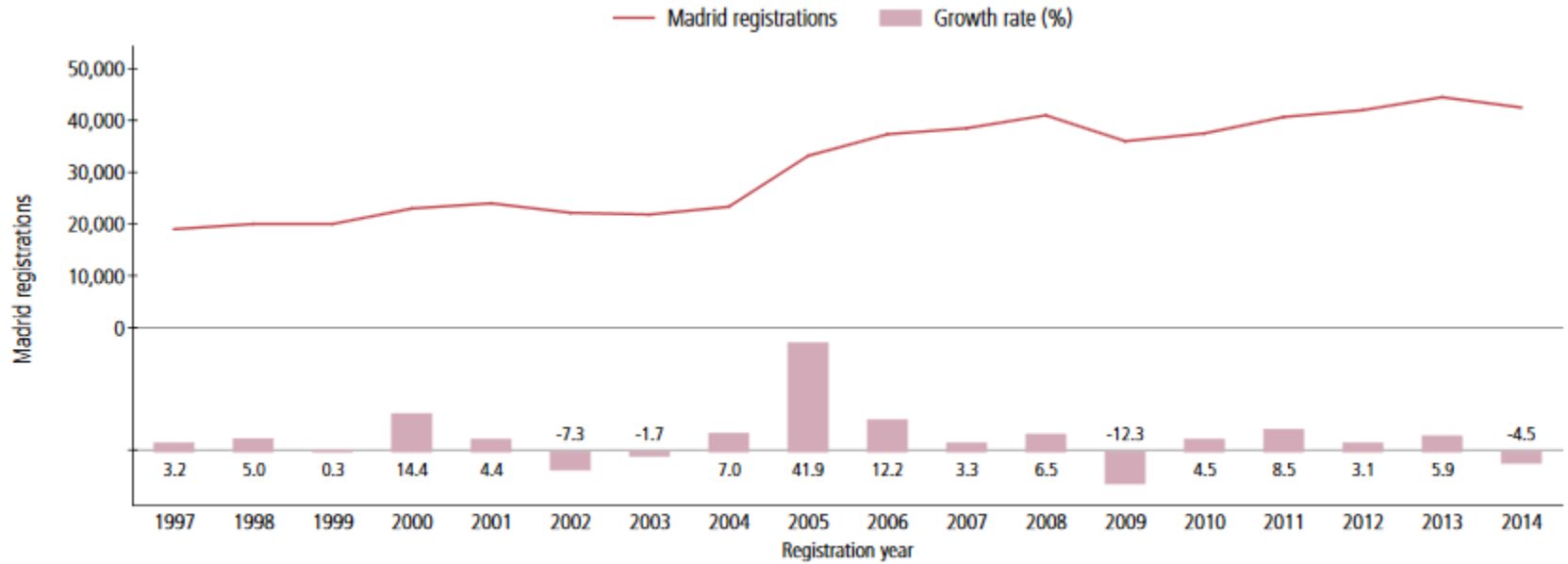
51,938 International Registrations

Average Number of Designations	6,75
Average Number of Classes	2,49
Average Fee	3,102 CHF
All Fees	70% < 3,000 CHF

Decisions recorded in 2015

■ Designations recorded	350,760
■ Grants of protection	219,623
■ Provisional refusals	110,650
■ Final decisions	77,251

Trend in international registrations



Source: WIPO Statistics Database, March 2015.

The International Register

On December 31, 2015

■ Active registrations	615,323
■ Number of right holder	506,492
■ Active designations (in millions).....		5.66

Advantages of the Madrid System

Being a member of the Madrid System

Being a member of the Madrid System may have an impact on the

- Local businesses and industries
- National trade policies
- 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

National trade policies

- When local businesses file abroad it may:
 - Empower local industry, in particular SMEs
 - Facilitate access to export markets
 - Promote trade and further development of export
- When foreign businesses file at home it may:
 - Simplify examination for the TM Office
 - Result in more TM filings and business opportunities
 - Open local market for foreign trademark holders
 - Foster a more favorable climate for foreign investment

Local attorneys and agents

- The Madrid System is an option for trademark protection
- 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
 - File oppositions, cancellation actions
 - Develop trademark strategies for the local businesses

Cooperation and Resources

Technical Assistance and Cooperation

- Technical assistance during the accession process
 - Initial assessment of the legal framework and of the processes and practices of the TMO
 - Support to establish a roadmap
 - Training TMO staff and other relevant stakeholders
 - Readiness assessment of the TMO

- Cooperation after accession, support for
 - Capacity building and dissemination activities
 - Participation in Assembly and Working Group
 - Periodical training of TMO staff

WIPO Resources and E-Services

- 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](#)

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](#)

Thank you

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