



WIPO | MADRID

The International
Trademark System

The Madrid System

Overview and Trends

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What is the Madrid System?

- A centralized filing and management procedure
- A one-stop shop for trademark holders to obtain and maintain trademark protection in export markets
- An alternative to the national or the regional route
- The domestic legislations of the designated Contracting Parties set the conditions for protecting a trademark and determine the rights which result from protection

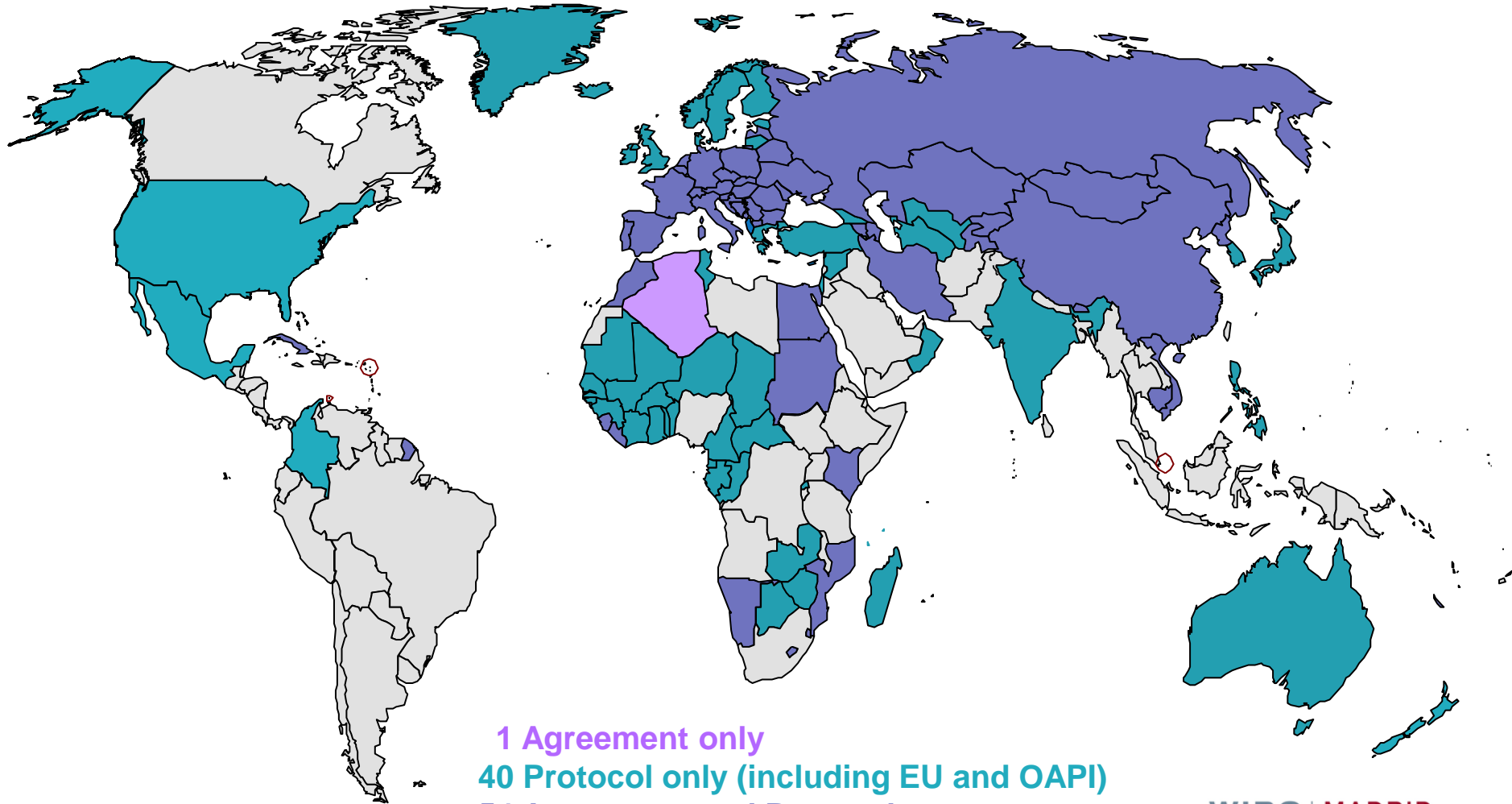


Two Treaties

■ Madrid Agreement: 1891

■ Madrid Protocol: 1989

Madrid Union



1 Agreement only
40 Protocol only (including EU and OAPI)
54 Agreement and Protocol

95 Members

1891 - 1900	Belgium, France, Italy, Netherlands, Portugal, Spain, Switzerland
1901 - 1910	Austria, Hungary
1911 - 1920	Morocco, Romania
1921 - 1930	Germany, Luxembourg
1631 - 1940	Liechtenstein
1941 - 1950	Viet Nam
1951 - 1960	Egypt, Monaco, San Marino
1961 - 1970	
1971 - 1980	Algeria, Democratic People's Republic of Korea, Russian Federation
1981 - 1990	Bulgaria, China, Cuba, Mongolia, Sudan
1991 - 2000	Albania, Antigua and Barbuda, Armenia, Azerbaijan, Belarus, Bhutan, Bosnia and Herzegovina, Croatia, Czech Republic, Denmark, Estonia, Finland, Georgia, Greece, Iceland, Ireland, Japan, Kazakhstan, Kenya, Kyrgyzstan, Latvia, Lesotho, Liberia, Lithuania, Mozambique, Norway, Poland, Republic of Moldova, Serbia, Sierra Leone, Singapore, Slovakia, Slovenia, Swaziland, Sweden, Tajikistan, The former Yugoslav Republic of Macedonia, Turkey, Turkmenistan, Ukraine, United Kingdom
2001 - 2010	Australia, Bahrain, Botswana, Cyprus, European Union, Ghana, Iran (Islamic Republic of), Israel, Madagascar, Montenegro, Namibia, Oman, Republic of Korea, Sao Tome and Principe, Syrian Arab Republic, United States of America, Uzbekistan, Zambia
2011 - 2014	Colombia, India, Mexico, New Zealand, Philippines, Rwanda, Tunisia

Accessions

- 2012: Colombia, Mexico, New Zealand and Philippines
- 2013: India, Rwanda and Tunisia
- 2014: OAPI and Zimbabwe
- 2015: Cambodia

- Future accessions:
 - ASEAN countries by 2015
 - Canada
 - Caribbean countries
 - African countries
 - Latin American countries?

Outlook

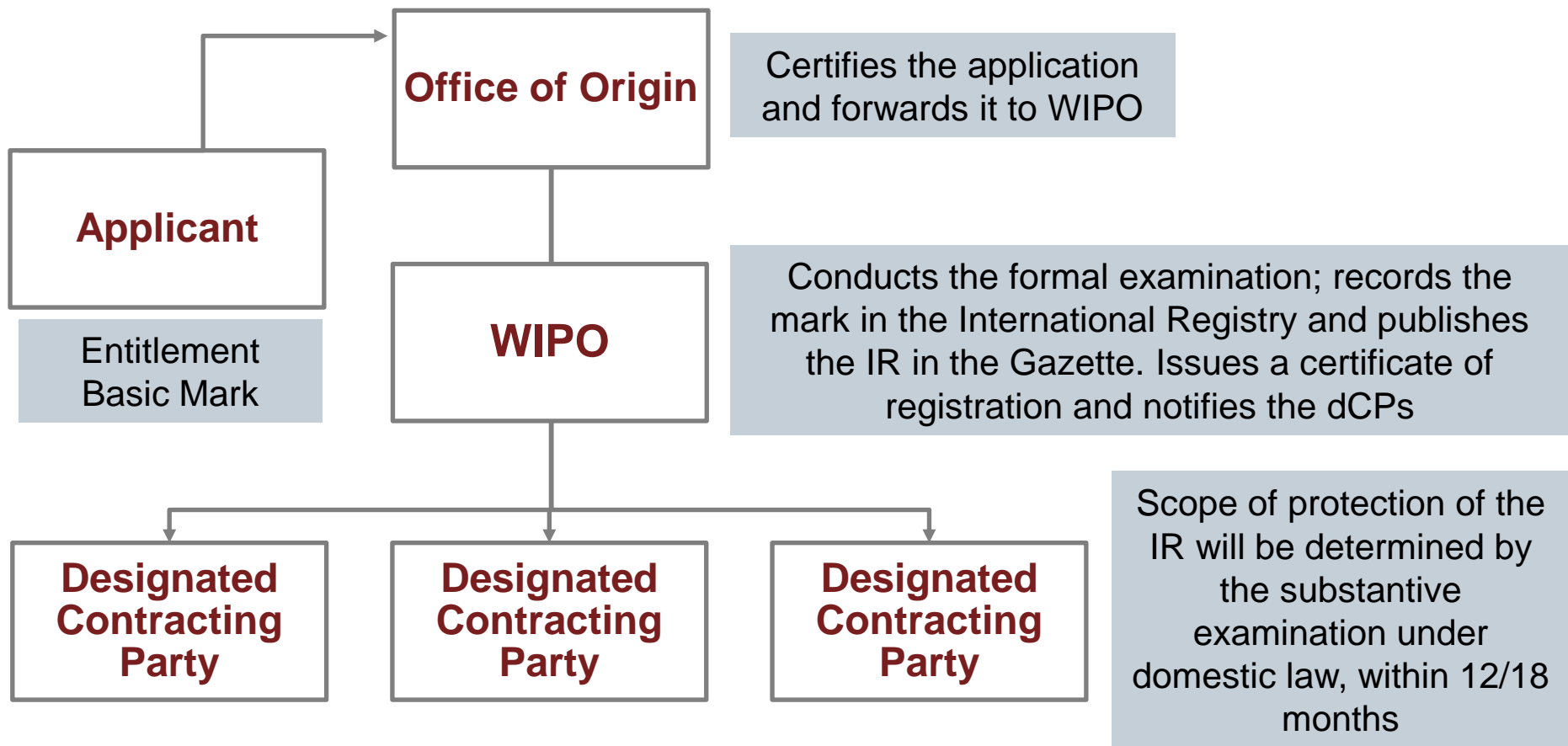


- Respects sovereignty
- Benefit sharing for Offices
- Broader interest in trademarks
- Covers complete lifecycle of right
- Becoming global system

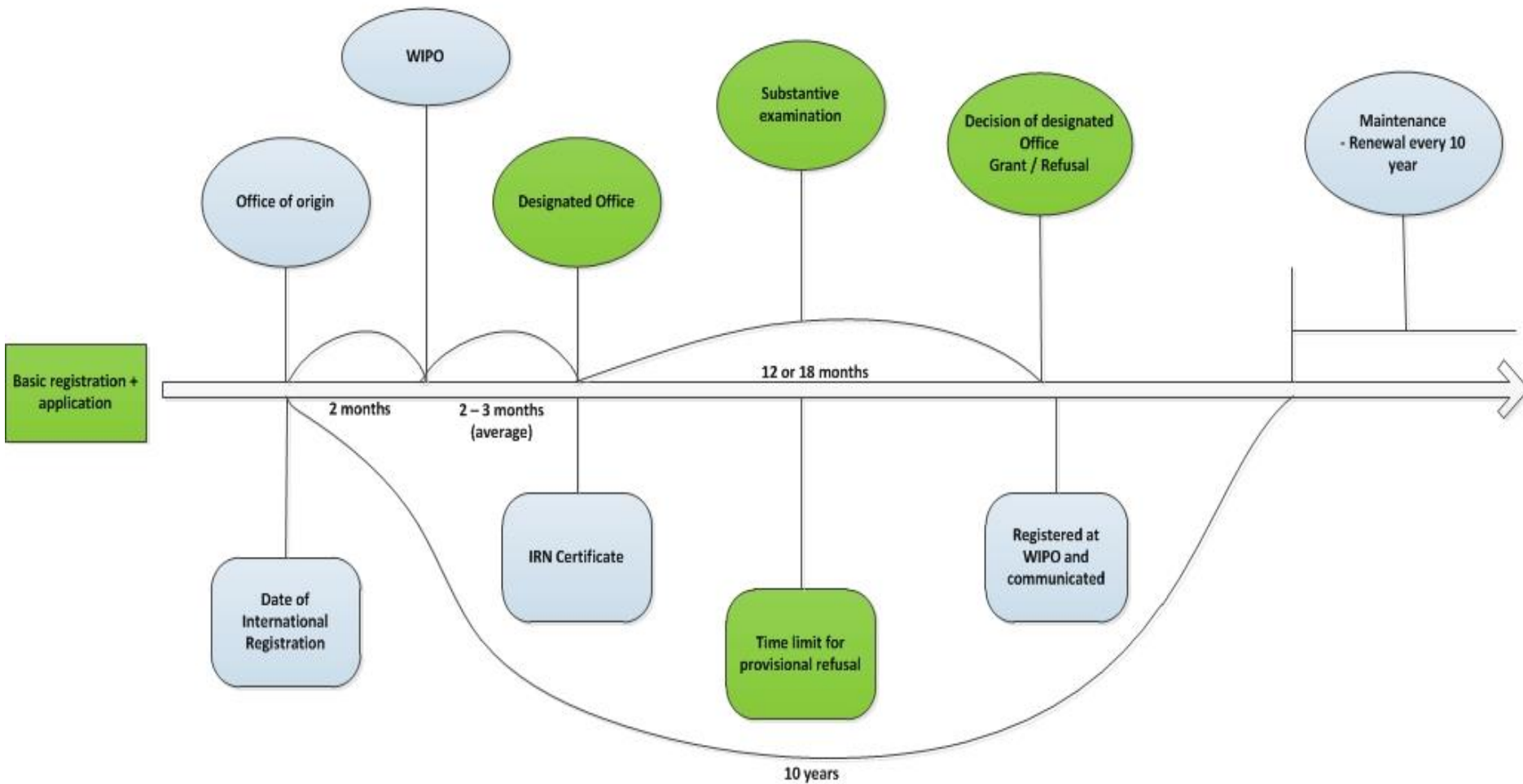
Key features of the Madrid System

- A registration system covering 111 countries
- Entitlement and basic mark (application or registration)
- One application – one language – one set of fees
 - English, French and Spanish
- One registration covering multiple territories
- Fixed time limit for refusal – 12 or 18 months
- The international procedure: Only formal examination by WIPO

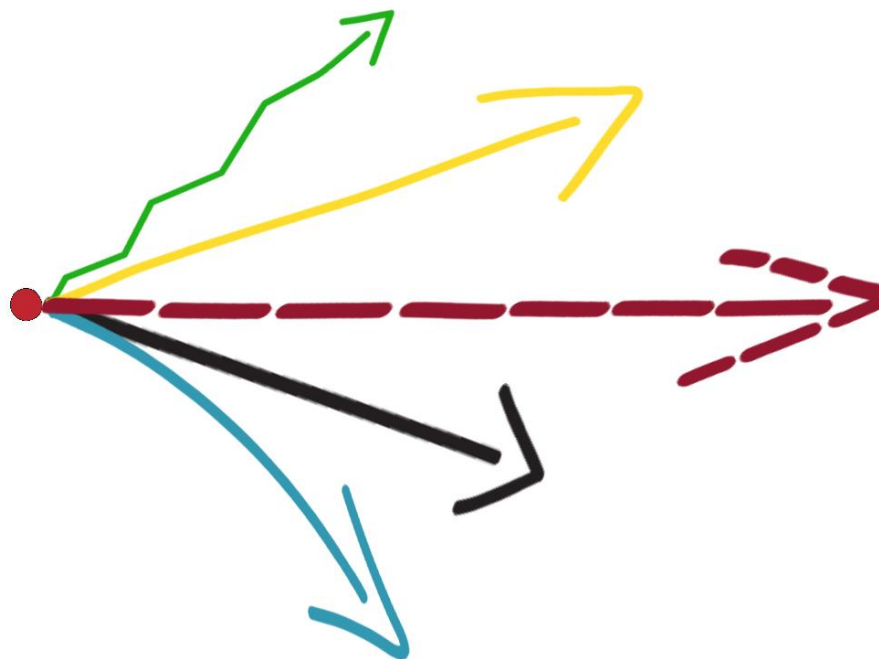
The international procedure



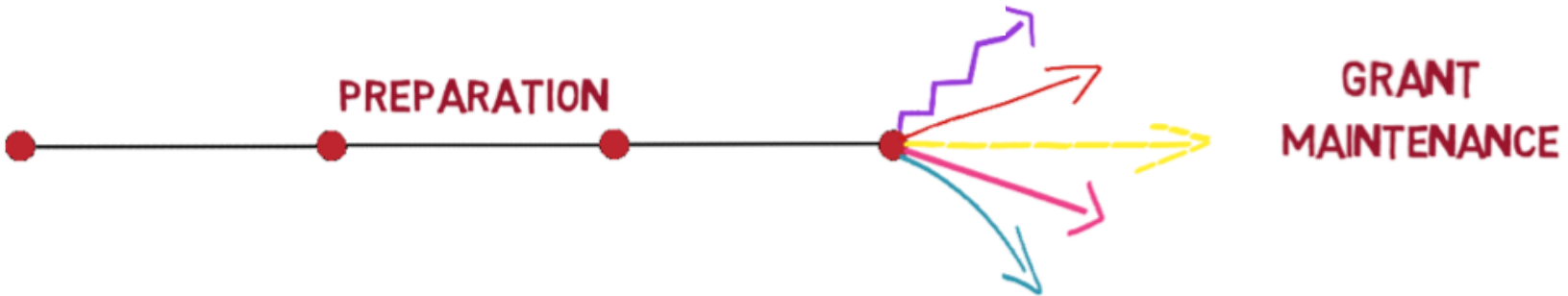
International Registrations – An Overview



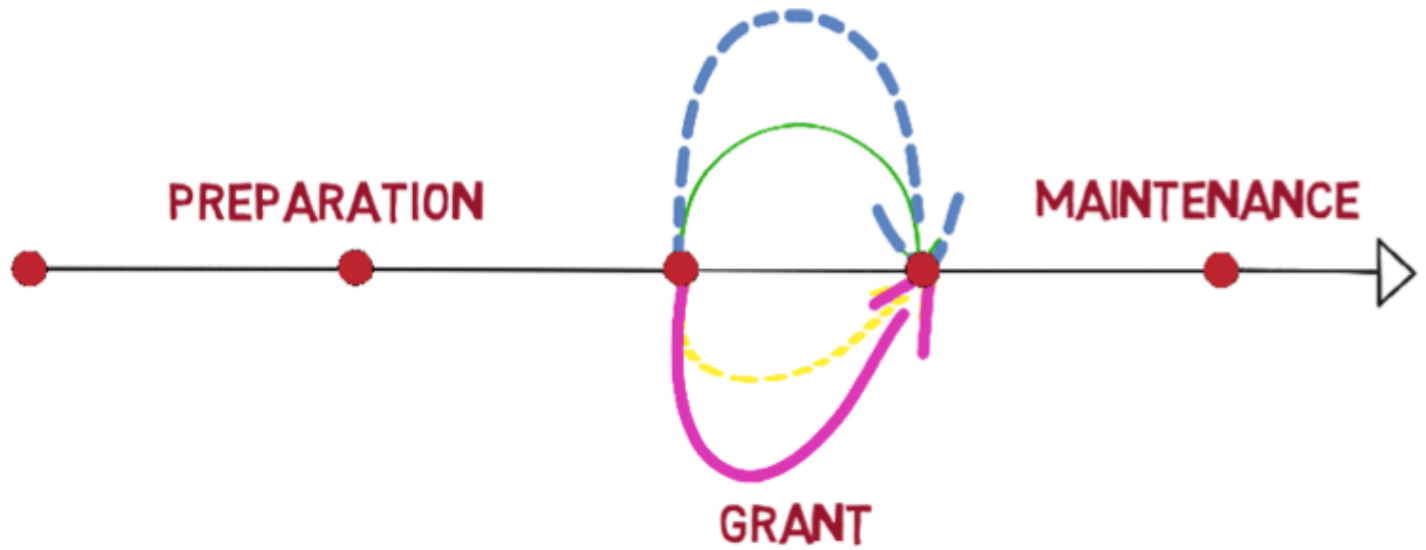
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MADRID HAGUE



Agreement v. Protocol

■ Madrid Agreement

- States
- Basic Registration
- Standard fee
- 12 months refusal period
- 5 year dependency period

■ Madrid Protocol

- States and intergovernmental organizations
- Basic registration or application
- Standard fee or individual fee
- 12, 18 or even 18+ months refusal period
- 5 year dependency period with possible transformation

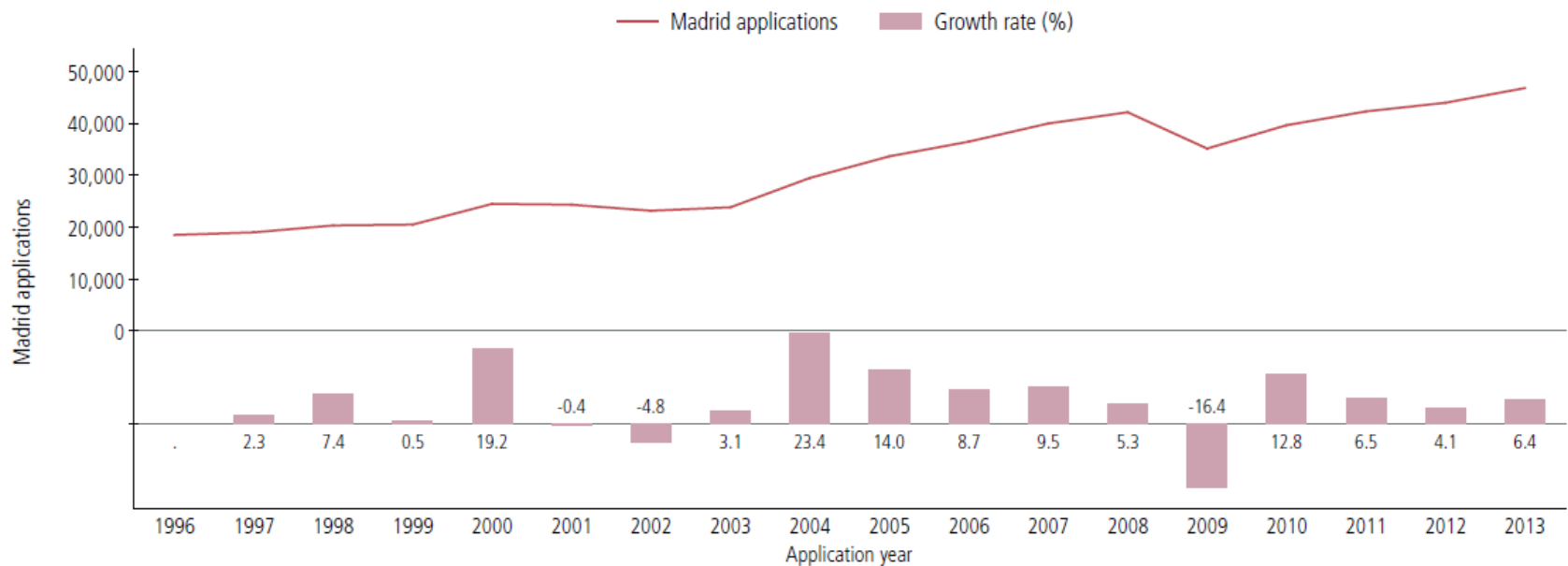
General profile 2013

44,414 International Registrations

Average Number of Designations	6.89
Average Number of Classes	2.46
Average Fee	CHF 3,038
Distribution	70% < 3,000 CHF 20%: 1,000-2,000 CHF 10% < 1,000 CHF

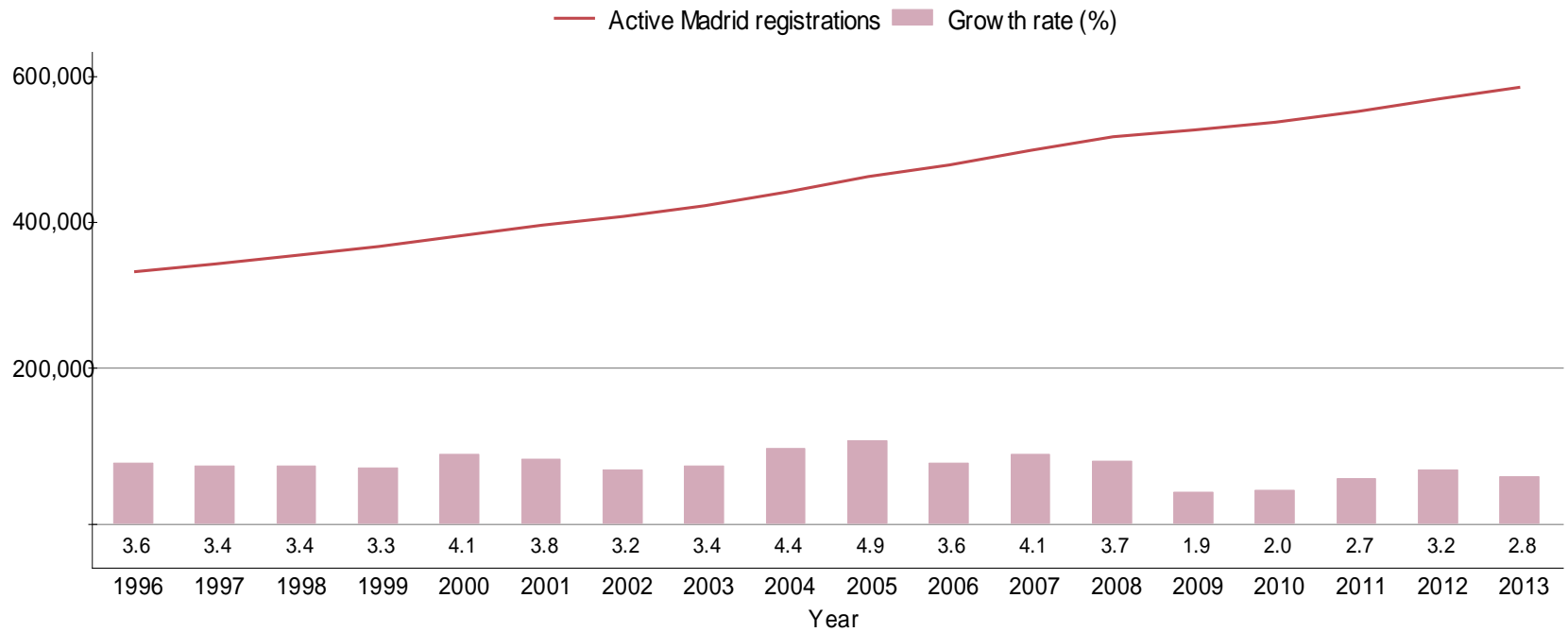
International Applications

Figure A.1.1 International applications

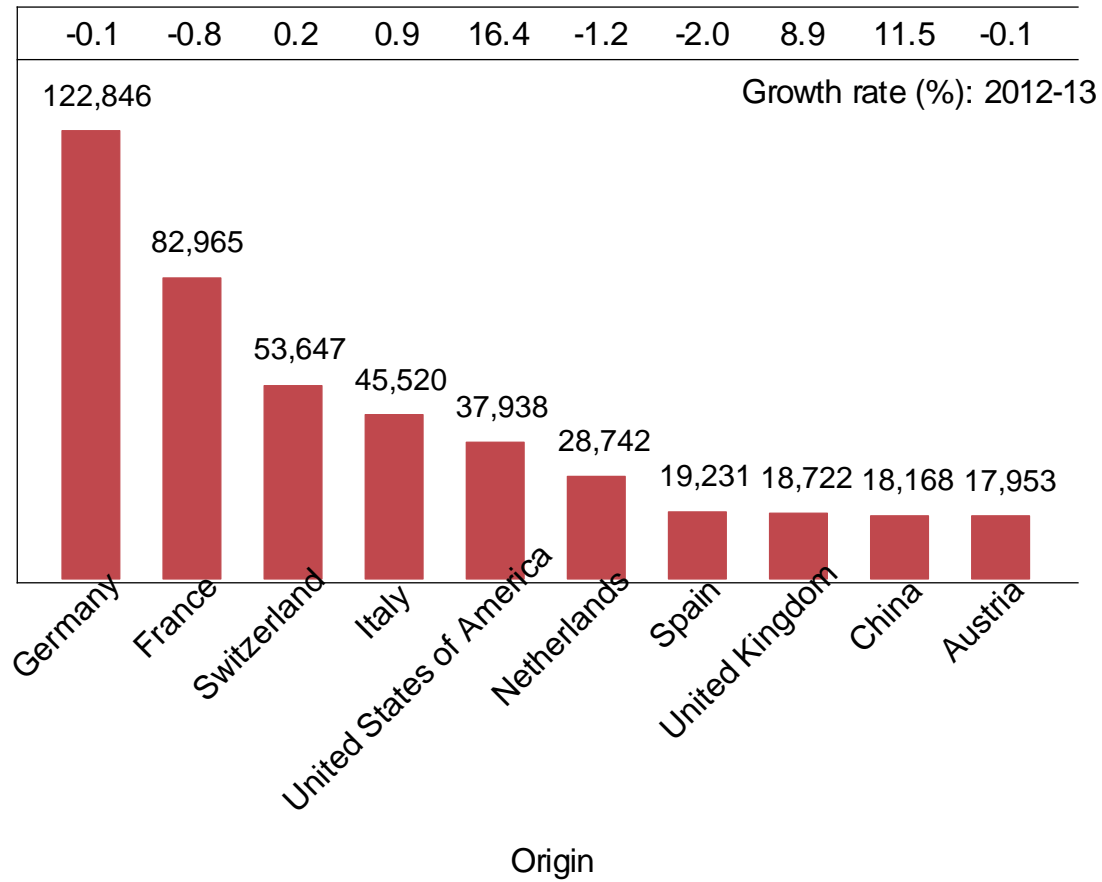


Source: WIPO Statistics Database, March 2014

International Registrations



Origin of International Registrations



Top offices of origin – 2013

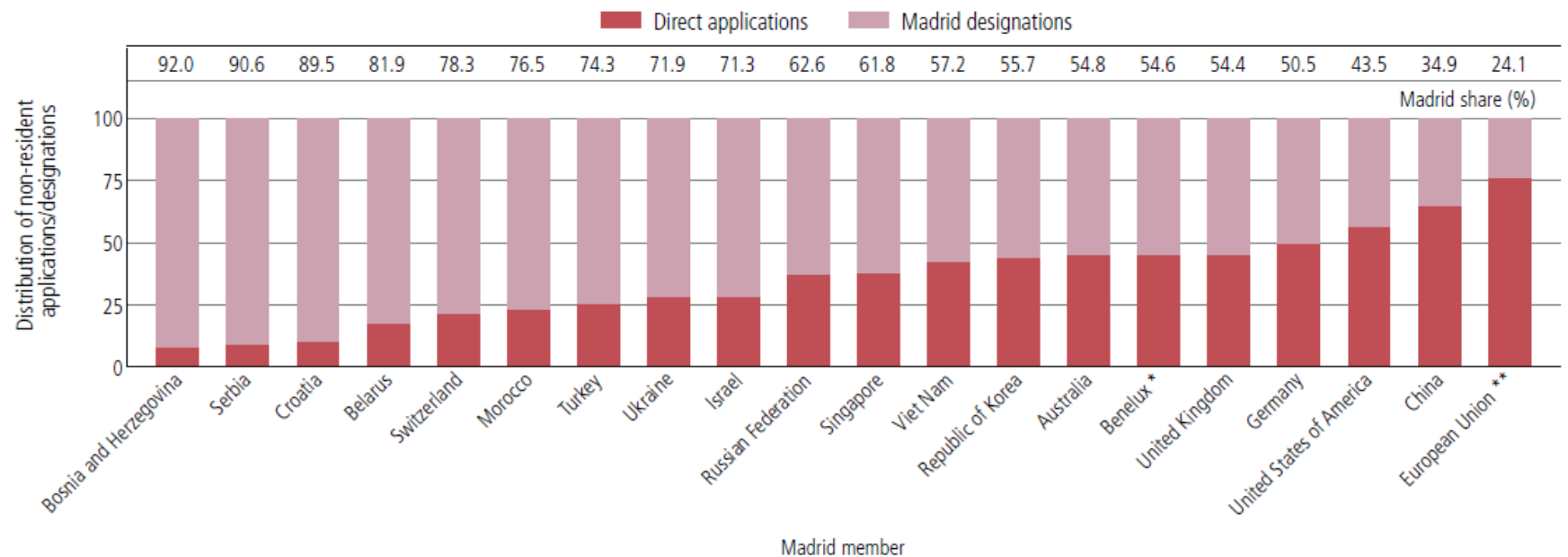
Contracting Parties	2013
European Union	6,814
United States of America	5,893
Germany	4,357
France	3,514
Switzerland	2,885
China	2,455
Italy	2,118
Japan	1,855
Benelux	1,784
United Kingdom	1,580

Top designations – 2013

Contracting Parties	2013
China	20,275
Russian Federation	18,239
European Union	17,598
United States of America	17,322
Switzerland	13,215
Japan	13,179
Australia	11,675
Republic of Korea	10,967
Turkey	9,838
Ukraine	9,589

Market Share

Figure A.1.4.1 Madrid share of total non-resident application class counts for selected top designated Madrid members, 2012



Note: *The Benelux Office for Intellectual Property (BOIP) is the official trademark registration office for Madrid members Belgium, Luxembourg and the Netherlands. **European Union indicates trademark activity occurring at its Office for Harmonization in the Internal Market (OHIM) and not within the IP offices of individual EU member states.

Source: WIPO Statistics Database, March 2014

Top Applicants

2013 Ranking	Applicant's name	Origin	Madrid international applications		
			2011	2012	2013
1	NOVARTIS AG	Switzerland	125	176	228
2	ZENTIVA GROUP, A.S.	Czech Republic	29	65	114
3	EGIS GYÓGYSZERGYÁR	Hungary	57	73	111
4	L'OREAL	France	67	138	109
5	BOEHRINGER INGELHEIM PHARMA GMBH & CO.	Germany	98	160	107
6	BOQUOI HANDELS OHG	Germany	98
7	SOCIÉTÉ DES PRODUITS NESTLÉ SA	Switzerland	80	105	91
8	ACTAVIS GROUP PTC EHF	Iceland	13	16	90
9	KONINKLIJKE PHILIPS ELECTRONICS N.V.	Netherlands	92	83	86
10	HENKEL AG & CO. KGAA	Germany	46	42	79
11	WORLD MEDICINE İLAÇLARI LIMITED	Turkey	3	64	78
12	RICHTER GEDEON NYRT.	Hungary	89	91	72
13	COMITÉ INTERNATIONAL OLYMPIQUE	Switzerland	..	15	71
14	LIDL STIFTUNG & CO. KG	Germany	28	18	63
15	BIOFARMA	France	14	50	61
16	GLAXO GROUP LIMITED	United Kingdom	51	127	60
17	SIEMENS AG	Germany	52	52	54
18	VOLKSWAGEN AG	Germany	27	56	53
19	KRKA	Slovenia	26	48	51
20	GAZPROM NEFT	Russian Federation	7	21	49
21	APPLE INC.	United States of America	50	32	48
21	MICROSOFT CORPORATION	United States of America	15	51	48
23	OAO BRESTSKY MYASOKOMBINAT	Belarus	..	12	44
24	GRIESSON - DE BEUKELAER GMBH & CO. KG	Germany	16	26	40
24	KONDYTERSKA KORPORATSIIA "ROSHEN"	Ukraine	23	21	40

2014 Figures

Benefits for trademark owners

- Streamlined and economical procedure
 - A single set of formalities
 - A single filing Office
 - No need to pay foreign agents for filings
 - No need to pay translation of the paperwork into several languages
- Effective procedure
 - A single international application produces the same legal effect in various countries
 - A fixed deadline for the confirmation or refusal of the legal effects in each designated country
 - A single procedure to maintain rights in multiple jurisdictions

Benefits for the Office and Government

- The Contracting Parties can focus on substantive examination
- The income through the Madrid system is relevant to the number of designations to the specific Contracting Party
- It promotes international trade by contributing to the opening of new markets and assisting in development of export
- It creates a more favorable climate for foreign investment in the internal market

Benefit Sharing

- Office of Origin
 - Handling fee
- Designated Office
 - Standard fee
 - Individual fee
- Member
 - Share in surplus (not since 1994)

Impact on local agents

- The Madrid Protocol is optional and it does not replace the direct filing route
- Applicants would need the services of local agents for filing outgoing applications or at post-registration stage
- Increased designations will create more business opportunities (substantive work), like searches, refusals, oppositions, request for cancellations, dispute settlements, license and assignments contracts, and enforcement
- Post-registration activity may compensate for any reduction in local filing activity
- Expanding of services?

“Madrid has increased our workload in terms of defences, oppositions and trademark availability searches in order to identify and address potential problems before investing in filing and prosecution costs.... Nowadays, our international clients are not only seeking to register their trademarks, but also want comprehensive, complete advice in order to protect their intangible assets. We are also frequently contacted by other international companies – different from our clients – that are seeking our advice in order to avoid rejections to their Madrid trademark applications being issued by the Colombian Trademark Office. In this sense, our legal practice has migrated from trademark prosecution to strategic advice.”

Brigard & Castro, Bogota

World Trademark Review (Issue 54)

Thank you
for your attention

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