

NAVIGATING
THE MADRID PROTOCOL
FOR YOUR CLIENT

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April 13, 2016



WHY MADRID?



MADRID

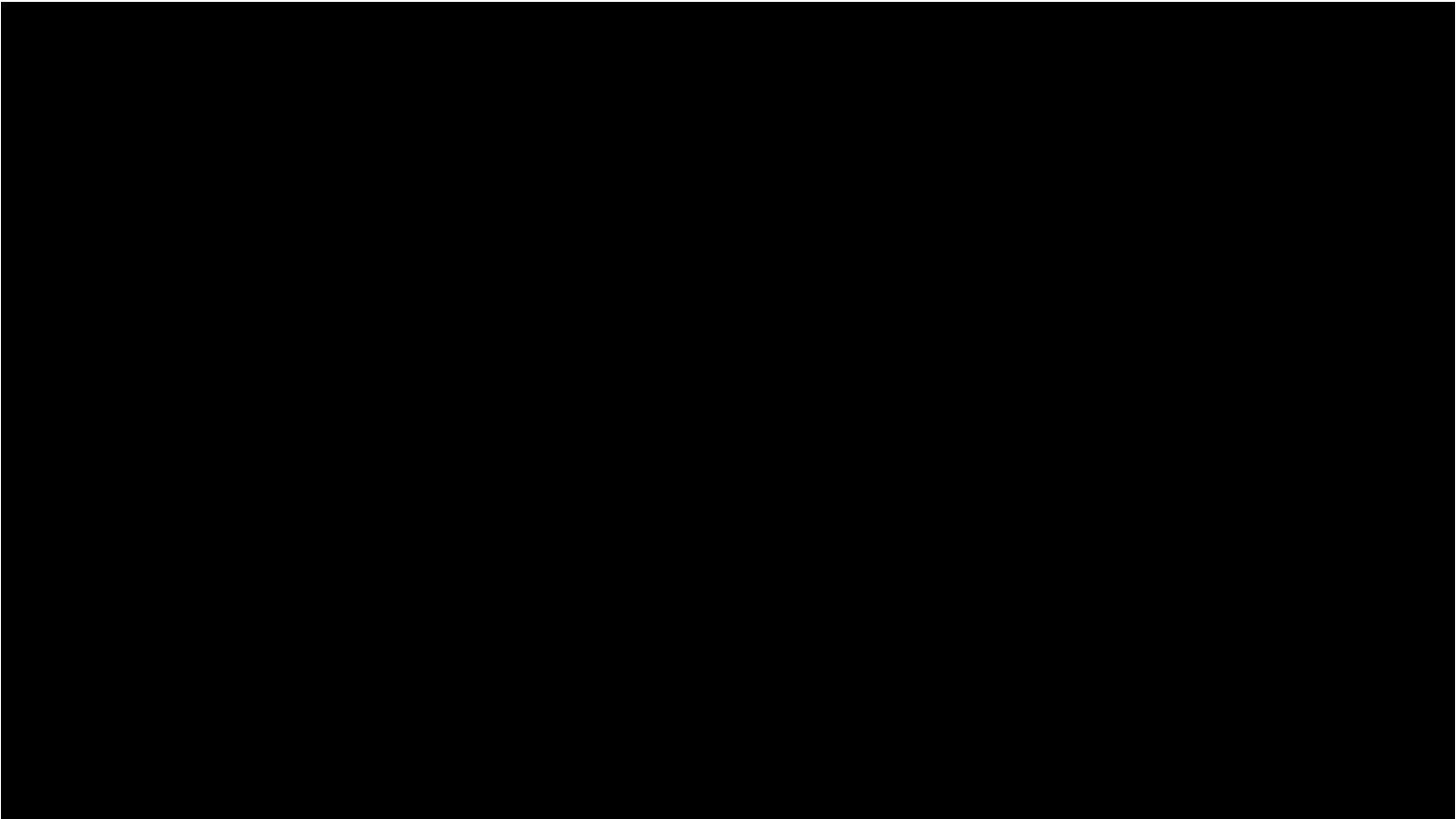
Capitol of Spain



MADRID
Where my son went to study abroad

MADRID

Where the Action Happens



FROM BOURNE ULTIMATUM TO ... **MADRID PROTOCOLS**



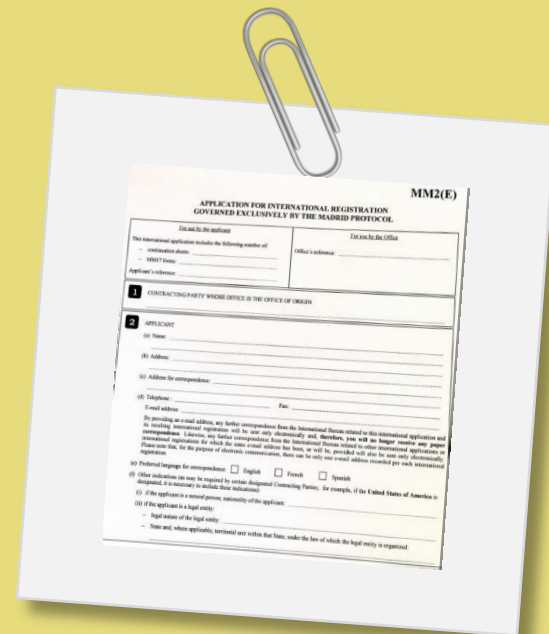
Protects marks in 90+ Countries

United States joined 11/2/2003

European Union joined 10/1/2004

THE MADRID SYSTEM

ALLOWS A TRADEMARK
OWNER TO OBTAIN
TRADEMARK PROTECTION IN
ANY AND ALL MEMBER
STATES BY FILING ONE
APPLICATION IN ONE
JURISDICTION WITH ONE SET
OF FEES AND MAKE CHANGES
AND RENEW REGISTRATION
THROUGH A SINGLE
ADMINISTRATIVE PROCESS



MADRID SYSTEM IS USER FRIENDLY

STEP 1

File trademark application with U.S.P.T.O.

STEP 2

Request the U.S.P.T.O. to submit the application to WIPO.

PRACTICAL TIPS

Consider waiting for home application to clear opposition period before filing international application (risk of central attack).

Note: An international application may be filed electronically using the Trademark Electronic Application System (TEAS) for International Applications. Electronic forms are accessible at <http://teasi.uspto.gov/TEASi>. An international application may also be filed on paper using the official form issued by the International Bureau of the World Intellectual Property Organization available online at <http://www.wipo.int/madrid/en> ([link is external](#)). For further information, please see the Tips for Paper Filers.

WHY USE THE MADRID SYSTEM?

- OBTAIN & MAINTAIN registration of trademarks in multiple jurisdictions through a single trademark office
 - CENTRALIZED filing procedure
 - COST savings
 - SIMPLIFIED filing requirements
 - SIMPLIFIED maintenance
 - THREE official languages, including English



DRAWBACKS OF THE MADRID SYSTEM

- **International Registration (IR) does not become independent of home registration until after 5 years**
- **If the basic application is abandoned or cancelled anytime during the first 5 years after IR is issued, then all foreign applications and registrations based on IR are automatically cancelled.**
- **The owner of the IR cannot transfer ownership of any dependent marks to an owner that is not a resident in a member company. Ex. Marks obtained under Madrid protocol cannot be transferred to Canadian owner without first withdrawing the marks from Madrid System at great expense.**
- **Requirements for assistance of local agent if objections arise during prosecution or in the context of opposition proceedings (could be costly and undermine savings of the system)**

EVALUATING YOUR CLIENT'S TRADEMARK PORTFOLIO

**YOUR CLIENT'S
BUSINESS**

**YOUR CLIENT'S
TRADEMARKS**

**YOUR CLIENT'S
GOALS**





CLIENT 1

ZZ -EAZY BOY BAND

Small enterprise

- Performs locally in Nashville
- Three 20-somethings with Stage Moms (Momagers)
- Just signed with major label after 10 million You-Tube hits
- Want to merchandise signature sneaker with red and white soles
- Have signature sound (like Mockingjay)



CLIENT 2

ZZ BIG TOP CIRCUS

Medium Enterprise

- Family owned business since 1919
- Circus performers
- Perform in the U.S., Canada and Mexico
- Have a trademark, but it is not registered anywhere
- Sell merchandise on line and at events



CLIENT 3

ZZ Mega Power International Global Enterprise

- 10,000 different products
- Over 1 billion products sold everyday
- A product for every moment of everyday, from morning to night and from birth to old age
- 160,000 trademark and design protections worldwide



Thank You

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