

The Madrid System for Newcomers

Madrid System Webinar

Olivier Pierre

Geneva
April 27,
2022

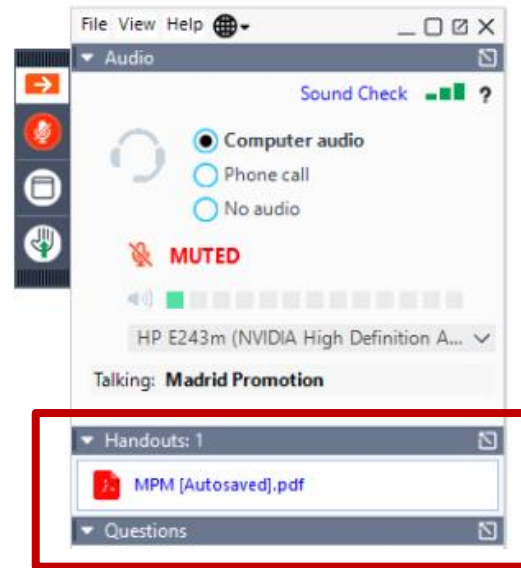
Our expert



Olivier Pierre

Madrid Information and
Promotion Division
WIPO

How to use GoToWebinar



Structure of the Webinar

- Presentation: Interactive questions during the webinar
- Questions and answers session at the end
- Presentation slides available for download
- Recording will be uploaded on the [Madrid Webinar page](#)
- Short survey to provide feedback

Question?

- How would you rate your current knowledge level of the Madrid System
 - Beginner
 - Intermediate
 - Advanced

It Begins with a Trademark and a Plan to Export...



Nestlé



ingelec



ORKA GROUP
"FASHION IS OUR BUSINESS"



sopharma
PHARMACEUTICALS



HUAWEI

SHISEIDO



ETi



TREASURY
WINE ESTATES



Microsoft

MICROMAX

Protection Options

...Then a choice must be made regarding the best way to protect your trademark/s abroad:

- **The national route** – file trademark application/s with the IP Office of each country in which you want protection
- **The regional route** – apply through a regional trademark registration system with effect in all member states (BOIP, EUIPO and OAPI)
- **The international route** – file through the Madrid System

The International Route

The international route through the Madrid System may be the preferred option when you:

- Seek protection in multiple markets, particularly if these are in different regions
- Want flexibility to add new markets as your export plans develop
- Have limited budget and/or time to spend on registration and management of your trademarks

Question?

■ How many countries are currently members of the Madrid System?

■ 195

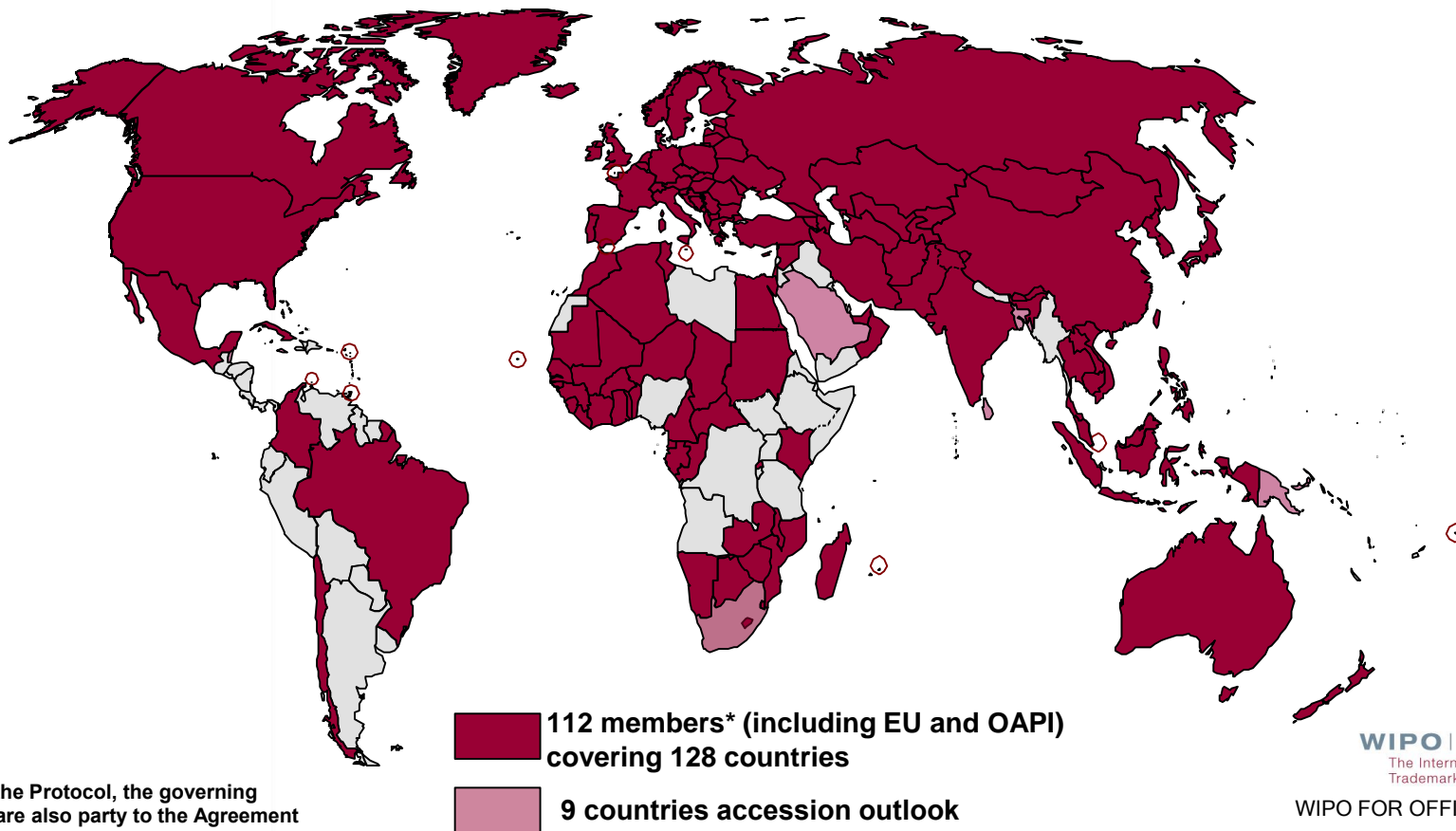
■ 107

■ 128

The Madrid System is Global

- Currently: 128 countries covered by the 112 members
- Markets cover more than 80% of world trade
- Recent accessions include:
 - **2019:** Brazil, Canada, Malaysia
 - **2020:** Trinidad and Tobago
 - **2021:** Islamic Republic of Pakistan, United Arab Emirates, Jamaica
 - **2022:** Chile and Cabo Verde

Accession Outlook 2022/23



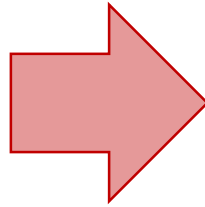
*All are party to the Protocol, the governing treaty, while 55 are also party to the Agreement

Accession Outlook - 2022/23

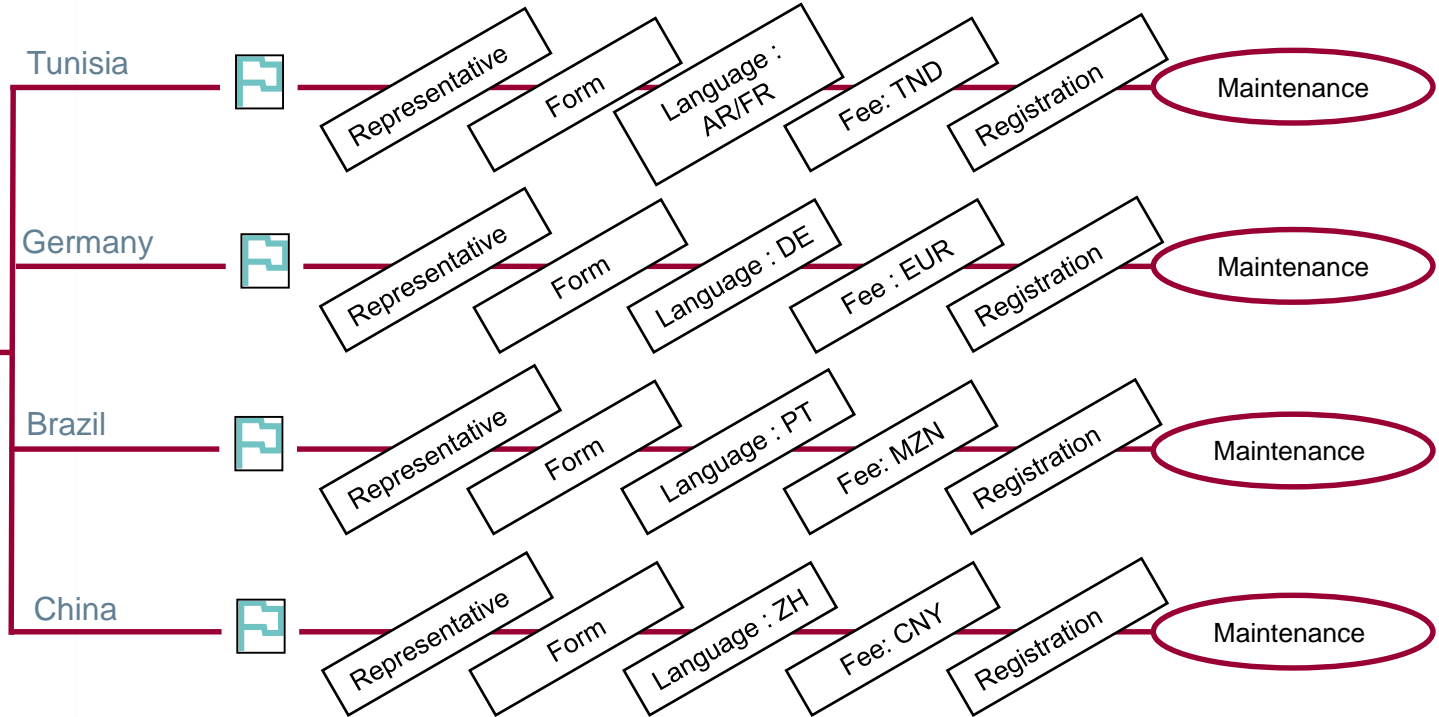
- **Africa:** Mauritius, South Africa
- **Arab region:** Saudi Arabia
- **Asia:** Bangladesh, Papua New Guinea, Sri Lanka, Fiji
- **Europe:** Malta
- **Latin America/Caribbean:** Belize

A Brand and a Plan to Export

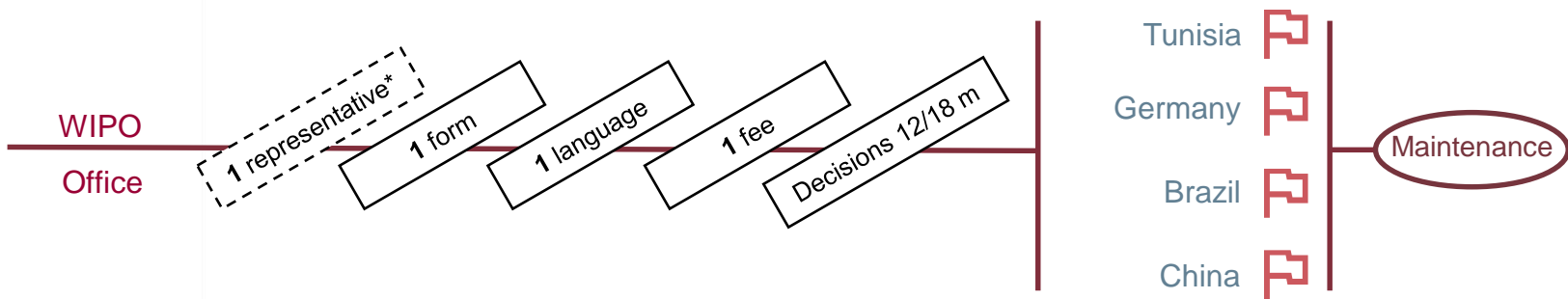
 *By Sally*



Market by Market Filing



Madrid System



* optional

















WIPO | MADRID
The International
Trademark System

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The Madrid System: Key Benefits

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THE MADRID SYSTEM: PROTECTING TRADEMARKS ABROAD

<p>The Madrid System is the convenient and cost-effective way to protect your brand internationally</p> <p>Register and manage your trademarks in multiple countries through one system</p>	<h3 style="margin: 0;">ONE-STOP SHOP</h3> <table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <th style="width: 25%;">One application</th> <th style="width: 25%;">One set of fees</th> <th style="width: 25%;">One filing language</th> <th style="width: 25%;">Centralized management</th> </tr> <tr> <td style="text-align: center; padding: 10px;"></td> <td style="text-align: center; padding: 10px;"></td> <td style="text-align: center; padding: 10px;"></td> <td style="text-align: center; padding: 10px;"></td> </tr> </table>				One application	One set of fees	One filing language	Centralized management				
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	<h3 style="margin: 0;">GLOBAL REACH</h3> <table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <th style="width: 25%;">112 members</th> <th style="width: 25%;">128 countries</th> <th style="width: 25%;">Over 80% of world trade</th> <th style="width: 25%;">And growing</th> </tr> <tr> <td style="text-align: center; padding: 10px;"></td> <td style="text-align: center; padding: 10px;"></td> <td style="text-align: center; padding: 10px;"></td> <td style="text-align: center; padding: 10px;"></td> </tr> </table>				112 members	128 countries	Over 80% of world trade	And growing				
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Question?

■ Can I file an international application directly at WIPO?

■ Yes

■ No

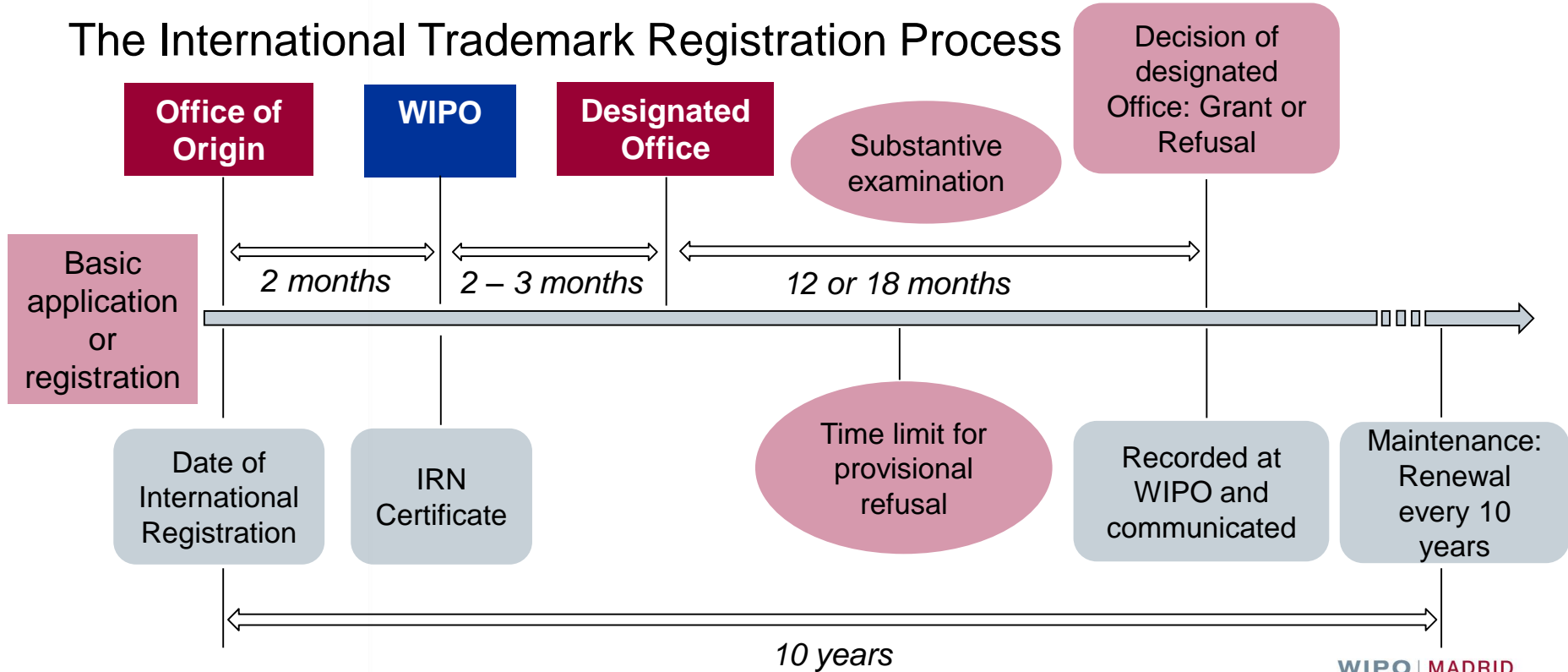
How the Madrid System Works

The International Trademark Registration Process



Timeline

The International Trademark Registration Process



Costs

Fees are payable to WIPO in Swiss francs

■ Basic fee*

- 653 Swiss francs – b/w reproduction of mark
- 903 Swiss francs – color reproduction of mark

■ Fees for designated Contracting Parties (dCP)

- Standard fees – complementary (100 Swiss francs per dCP) and supplementary (100 Swiss francs per class beyond 3)

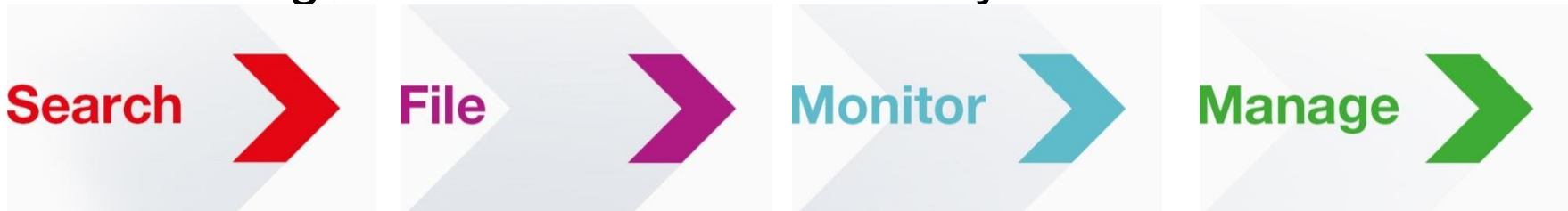
OR

- Individual fees where this is declared

* Applicants from [Least Developed Countries](#) benefit from a 90% reduction in the basic fee

Website and Online Services

- The Madrid Website provides information on how to search before filing, file an application, monitor and manage registrations, and how to pay fees.
- Madrid online services are available to assist users at each stage of their trademark's lifecycle.



Search

Global Brand Database

- Search existing marks from national & international sources
- Trademarks, appellations of origin and official emblems

File

Madrid Application Assistant

Madrid Goods & Services Manager

Madrid Member Profiles database

Fee Calculator

Monitor

Madrid Monitor

- Track real-time status of registration
- Watch competitors' trademarks
- Electronic alerts
- Consult the WIPO Gazette

Manage

- Madrid Portfolio Manager
- Subsequent Designation
- Limitation
- Renewal
- Management of representative
- Change in holder details
- Renunciation
- Online Payment
- Certified documents

Madrid Application Assistant

WIPO IP PORTAL MENU Madrid Application Assistant
HELP ENGLISH LOGIN WIPO

MADRID APPLICATION ASSISTANT

COMPLETING YOUR INTERNATIONAL APPLICATION ONLINE

[Get started](#)

[DISCOVER THE MADRID APPLICATION ASSISTANT](#)

WHAT IS THE MADRID APPLICATION ASSISTANT?

The Madrid Application Assistant is an electronic version of the official MM2 form that you must use to file an international application under the Madrid System.


The Madrid Application Assistant records all the information required to complete an international application in an intuitive and linear manner. Once completed, the international application will be made available in a PDF format ready for you to submit to the Office of origin for certification.

WHY USE THE MADRID APPLICATION ASSISTANT?

Information required for your international application can be imported directly from the Office of origin's national/regional trademarks database. This not only saves time and effort, but also reduces the risk of irregularities, thus making the process of filing an international application more efficient and accurate.


WIPO recommends using the Madrid Application Assistant to complete international applications where online filing is not made available by the Office of origin.

BENEFITS OF THE MADRID APPLICATION ASSISTANT




SIMPLE PROCESS

Retrieve essential information concerning your [basic marks](#) directly from the database of your Office of origin.



FASTER COMPLETION

Fill in your application following our step by step process and ensure accuracy of the captured data.



VALIDATED DATA

Get your list of goods and services checked for classification and translated automatically

Legal Framework

- Madrid Agreement (1891) – *no longer in “operations”*
- Madrid Protocol (1989)
- Regulations
- Administrative Instructions
- Laws and Regulations of each Contracting Party
- Madrid Member Profiles Database

Madrid System Users: Business Sectors

- Madrid System users come from all corners of the globe and represent a broad cross-section of industries



(IMAGE: GETTYIMAGES/BUBAONE)

Madrid System Users: Business Size

- Individual entrepreneurs, small and large businesses find the Madrid System to be a convenient and cost-effective means to protect marks in key markets throughout the world



**Individual
Entrepreneurs**



**Small & Medium
Businesses**



**Large
Businesses**

More than 1.5 Million International Registrations

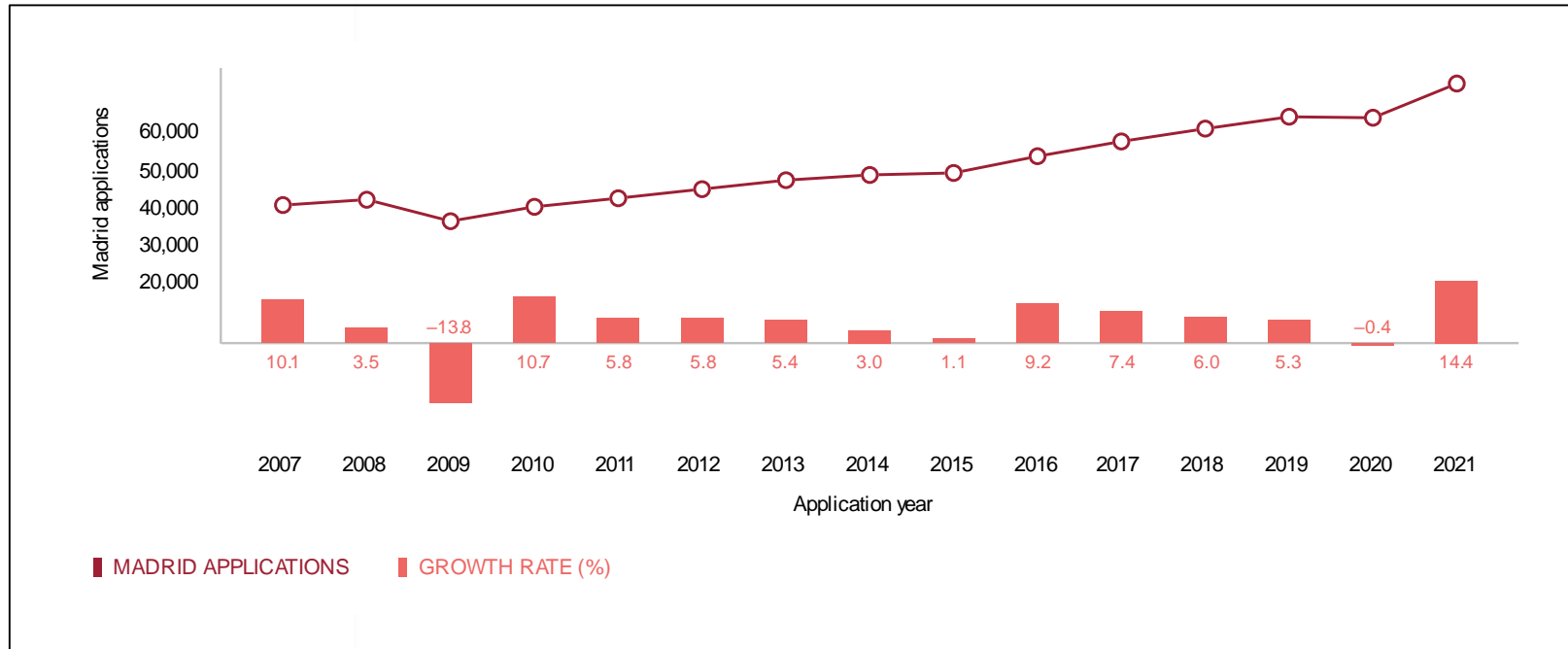


- This LONGINES mark is the oldest trademark still in effect
- Registered in Switzerland in 1889, internationally in **1893**

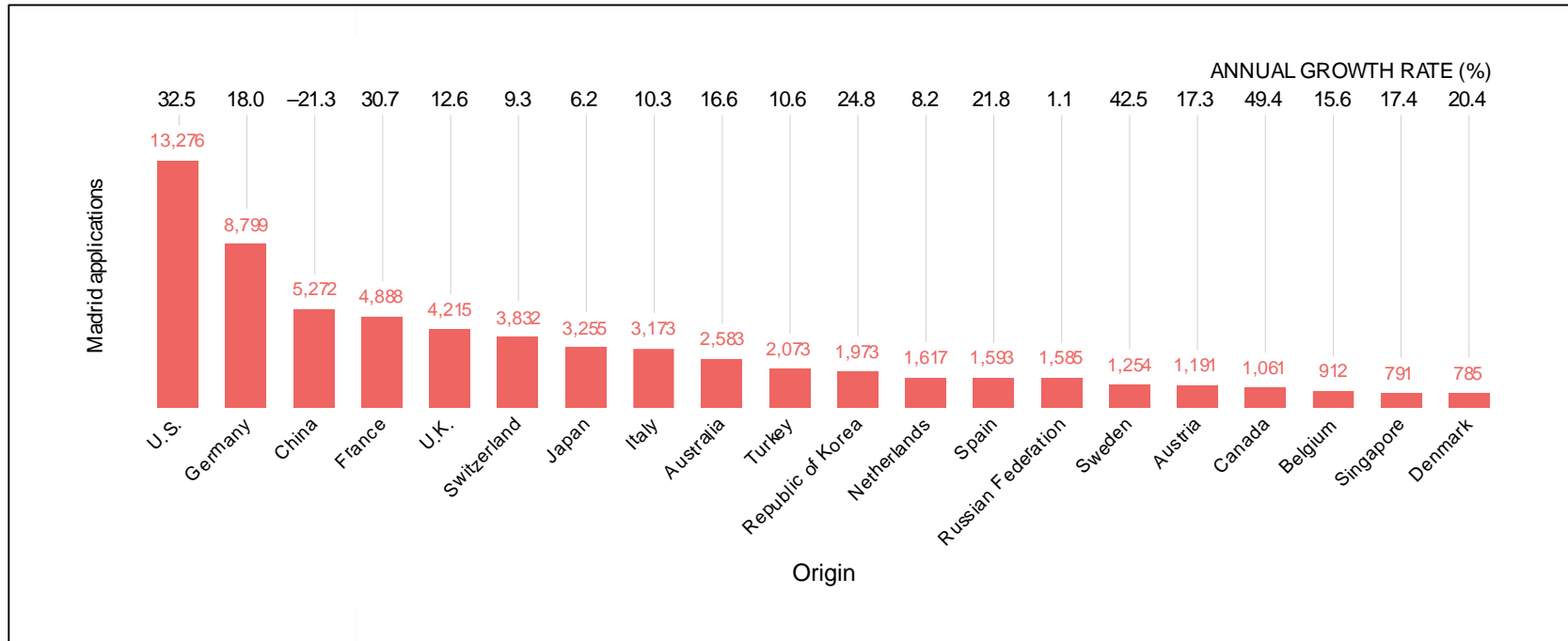
Coltejer

- COLTEJER is international trademark registration 1.5 million
- Registered in Colombia in 2009, internationally in **2019**

International Applications (2007-2021)



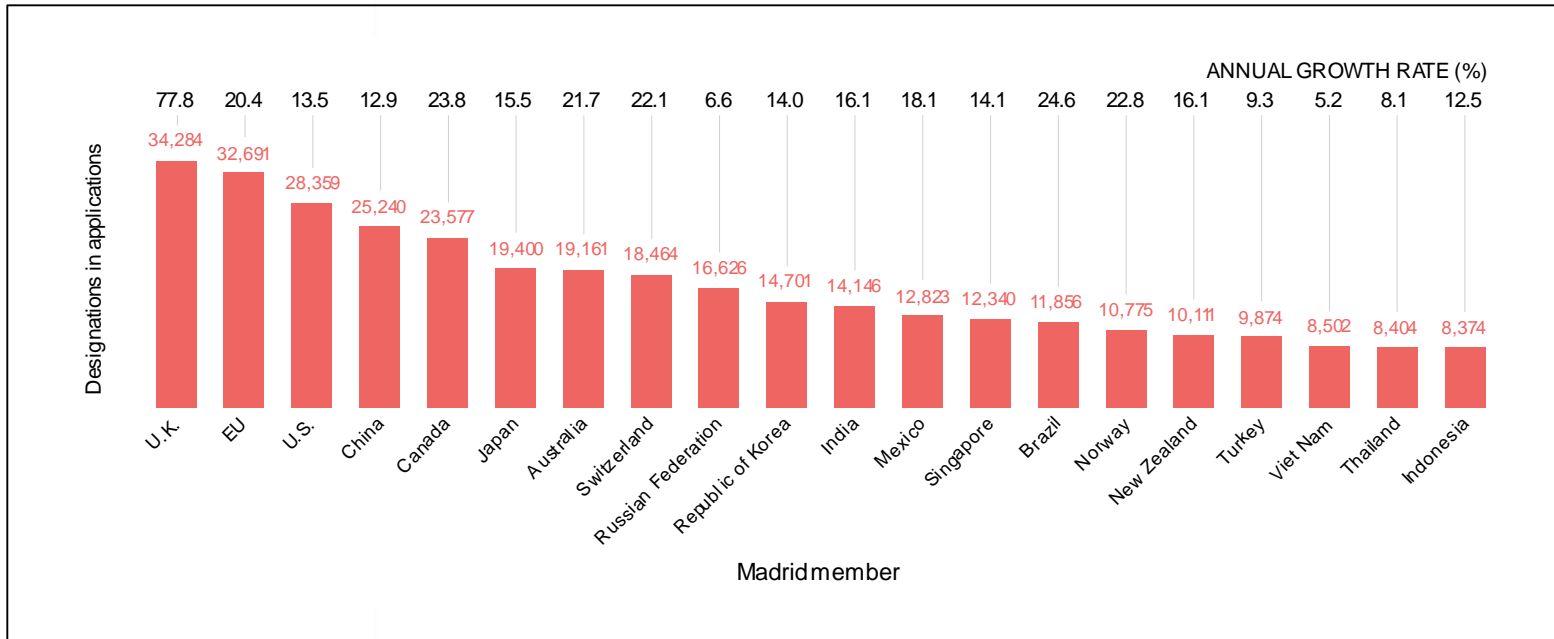
Top 20 Filing Origins (2021)



Question?

- Which country was the most designated in 2021
 - Viet Nam
 - United Kingdom
 - China
 - European Union

Top 20 Designated Contracting Parties (2021)



Top 10 Applicants (2021)

Rank	Name	Origin	Applications
1	L'OREAL	France	171
2	ADP GAUSELMANN GMBH	Germany	120
3	GLAXO GROUP LIMITED	UK	110
4	HUAWEI TECHNOLOGIES CO., LTD.	China	98
5	NOVARTIS AG	Switzerland	94
6	EURO GAMES TECHNOLOGY LTD	Bulgaria	93
7	APPLE INC.	USA	92
8	HENKEL AG & CO KGAA	Germany	90
9	SHISEIDO COMPANY, LTD	Japan	89
10	SYNGENTA CROP PROTECTION AG	Switzerland	85

Top 10 Classes in International Applications (2021)

Rank	Classes	Number of Classes	Growth (%) 2020/2021	Share of Total (%)
1	Class 9: Computer and electronic	20,085	21.8	10.7
2	Class 35: Services for business	15,637	23.0	8.4
3	Class 42: Technological services	14,653	30.1	7.8
4	Class 41: Leisure, education and training services	9,341	23.9	5.0
5	Class 5: Pharmaceuticals	8,460	7.3	4.5

Recent Developments (I)

- Limitation: restrict the list of goods and services online for some or all of the designated Contracting Parties ([MM6](#) form)
- Management of Representative: manage all transactions related to representatives ([MM10](#) and [MM12](#) forms)
- Change in Holder Details: change the name, address, contact details and legal nature of the holder ([MM9](#) form)
- Renunciation: abandon the effects of the international registration for all the goods and services for some (but not all) of the designated Contracting Parties ([MM7](#) form)

Recent Developments (II)

- Madrid Application Assistant: online step-by-step guide to prepare international applications (MM2 form)
- Madrid Monitor: new filter to identify registrations with missing email addresses
- Madrid e-Filing service: now available in 15 IP Offices

Legal Changes (I)

February 1, 2020

- Common Regulations => the Regulations under the Protocol
- Simplified renewal procedure

February 1, 2021

- Replacement and mandatory email address

November 1, 2021

- Appointment of a representative in separate communication
- Address of holder no longer required in subsequent designation

Legal Changes (II)

November 1, 2022

- Appointment of a representative. Appointment will not be recorded if the holder fails to use the MM12 form or the online form.
- Renewal will be possible as early as six months before the due date to coincide with the renewal reminder.
- Editorial Amendment to Rule 5(5) of the Regulations

February 1, 2023

- New means of representation of the mark.
- Applicants, holders and their representatives must exchange communications with WIPO by electronic means.

Mandatory Email Requirement

Amendments to the Regulations, *February 1, 2021*.

Mandatory to indicate an email address for:

- Applicants in international applications
- New holders in requests for recording of a change in ownership
- Appointed representatives in any requests

➡ WIPO will send all communications by email to the representative or, if not appointed, to the applicant or holder

Madrid Working Group : topics

- Provisional refusal : to introduce a minimum time limit to respond and an obligation to indicate the end date
- Dependency : to shorten the dependency period from five to three years
- Limitations : to clarify the role of each Office in the examination of limitations
- Languages : to introduce Arabic, Chinese and Russian in the language regime of the Madrid System

Classification Guidelines

- Purpose - to decrease irregularities
- Describes [WIPO classification practices](#)
- Divided into three sections:
 - General information - Nice Classification and Madrid
 - Classification principles applied by WIPO
 - Practical information on the acceptable format to list indications of goods and services





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■ Questions?

WIPO Academy – Distance Learning

- Last day to register to our most comprehensive online course on the Madrid System!
- **DL303E – DL-303 Specialized Course on the Madrid System for the International Registration of Marks**

Certificates of Attendance

- Share your certificate on [LinkedIn](#), [Twitter](#) and other social media channel.



Tag WIPO **#MadridSystem**

Testimonials and Case Studies

Madrid System Case Study Highlight: Panasonic, Branding for Further Growth and Greater Value

October 5, 2021

We continue with our highlights of key case studies giving you practical insights on how companies across various industries use the Madrid System globally to their advantage. Our latest study focuses on [Panasonic, the renowned Japanese electronics corporation](#).

Panasonic provides a wide range of products and services that are used in consumers' daily lives worldwide. These include home appliances, the electronic components used in them, housing and various services.



With more than a hundred years of experience, the company has been thoroughly committed to creating a better life for its users under the brand slogan of "A Better Life, A Better World".

Over the years, Panasonic introduced several business brands to achieve further growth and greater brand value in each area of business. In 2008, the corporation changed its name from the Matsushita Electric Industrial Co., Ltd to the Panasonic Corporation, consolidating its brand identity.

Discover how, with such a varied portfolio and an expansion strategy geared internationally, Panasonic uses the Madrid System to simplify the administrative procedures and greatly reduce costs.

[Read the full Panasonic case study](#)



Micromax on How WIPO's Madrid System Supports its International Growth Strategy

World Intellectual Property Organization – WIPO



MixMediaWorx on the Benefits of Using the Madrid System

World Intellectual Property Organization – WIPO

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WIPOD – International Trademark System Talks

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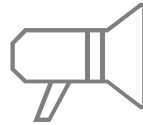


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