

WIPO Roving Webinars





WIPO Services and Initiatives

Webinar series in partnership with CIPO Canada

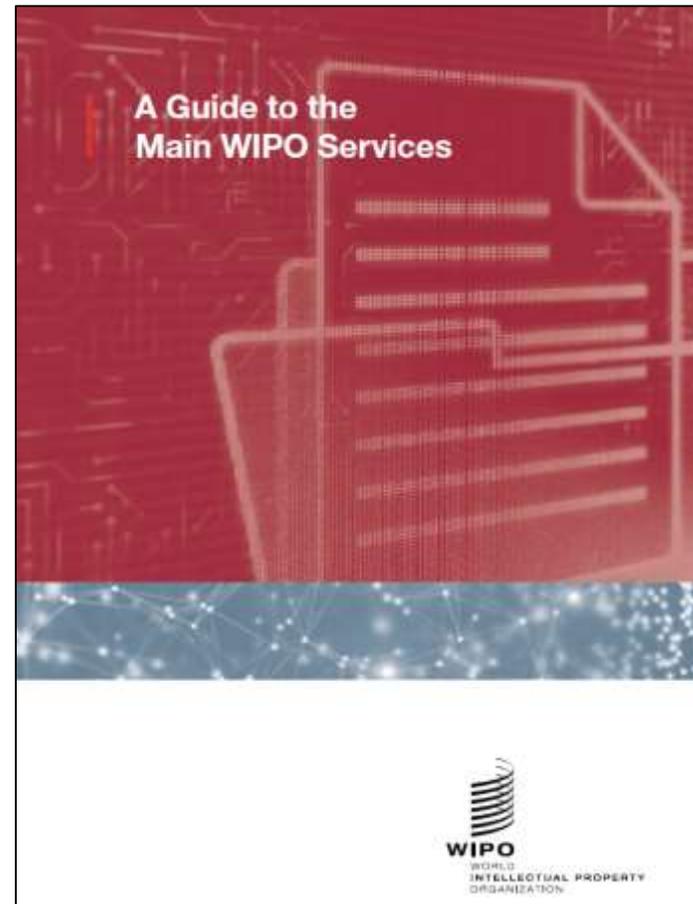


Enter your question →

→ Press 'Send'



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WIPO and CIPO services related to brands and designs, international registration systems



Interaction with WIPO and CIPO experts



- Daren Tang, Director General, WIPO
- Konstantinos Georgaras, Chief Executive Officer, CIPO



Trademarks

- Debbie Roenning
- Stephanie Golden
- Andy Chow

WIPO Roving Webinars



Protecting Your Trademarks Internationally

Roving Webinar on WIPO Services and Initiatives

Debbie Roenning

Director, Madrid Legal Division

debbie.roenning@wipo.int

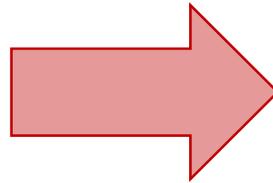


A Trademark

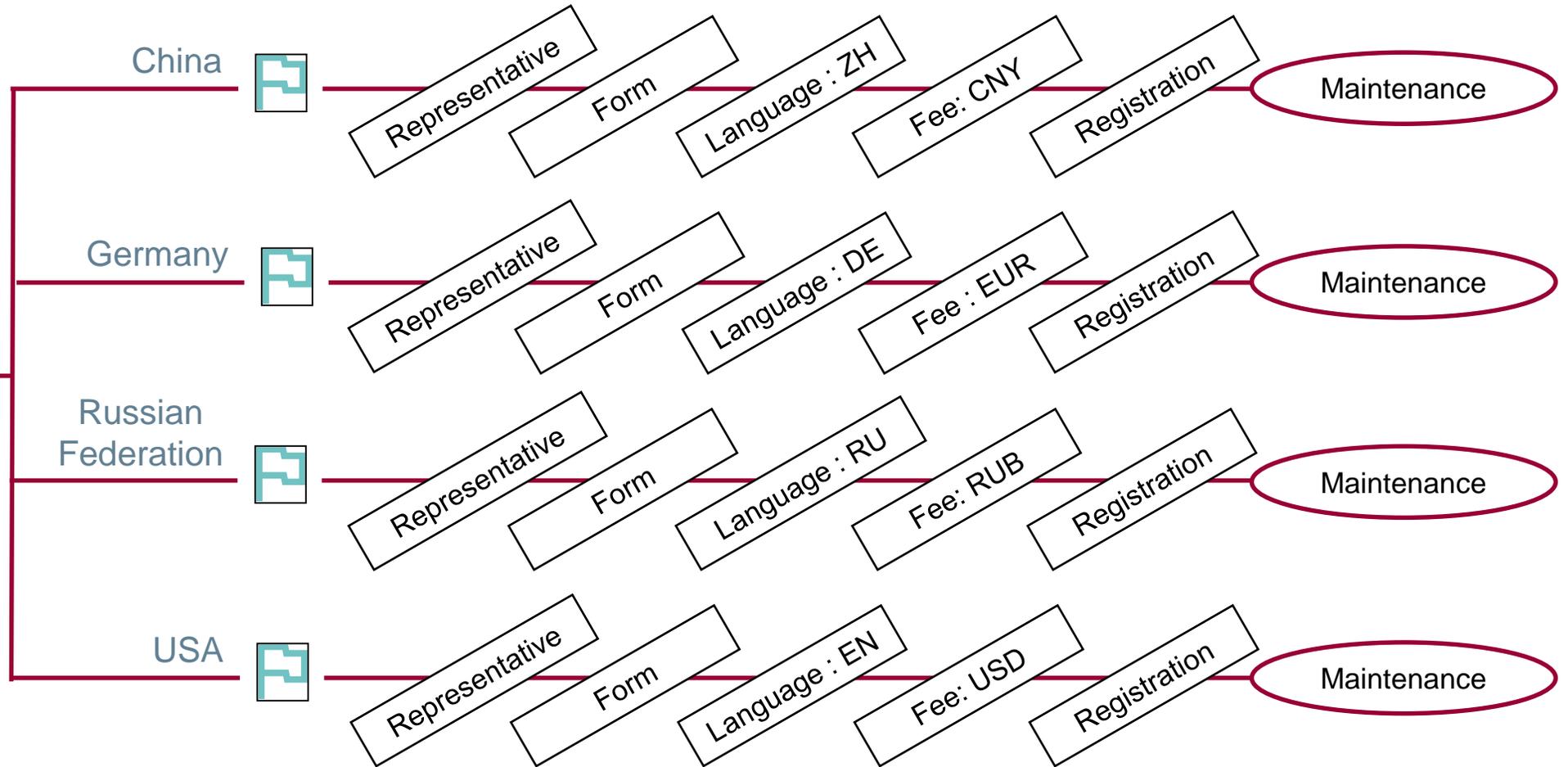


A Brand and a Plan to Export

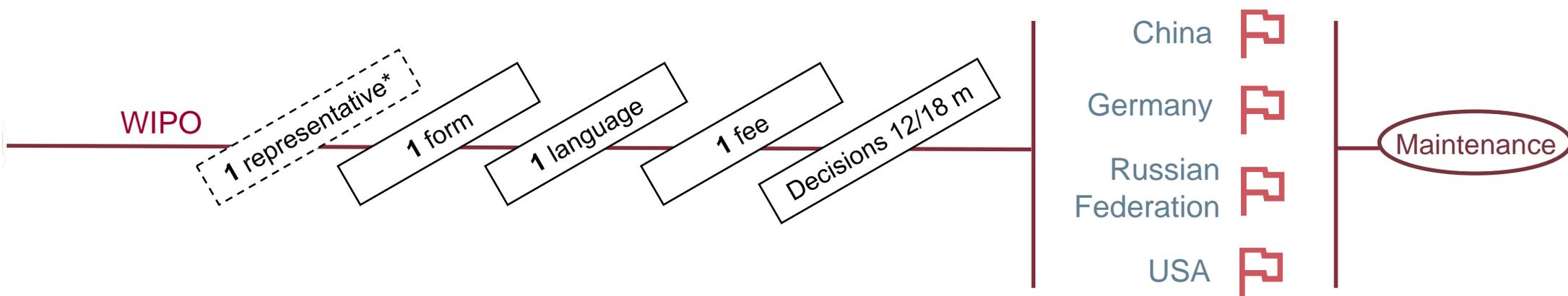
 *By Sally*



Market by Market Filing



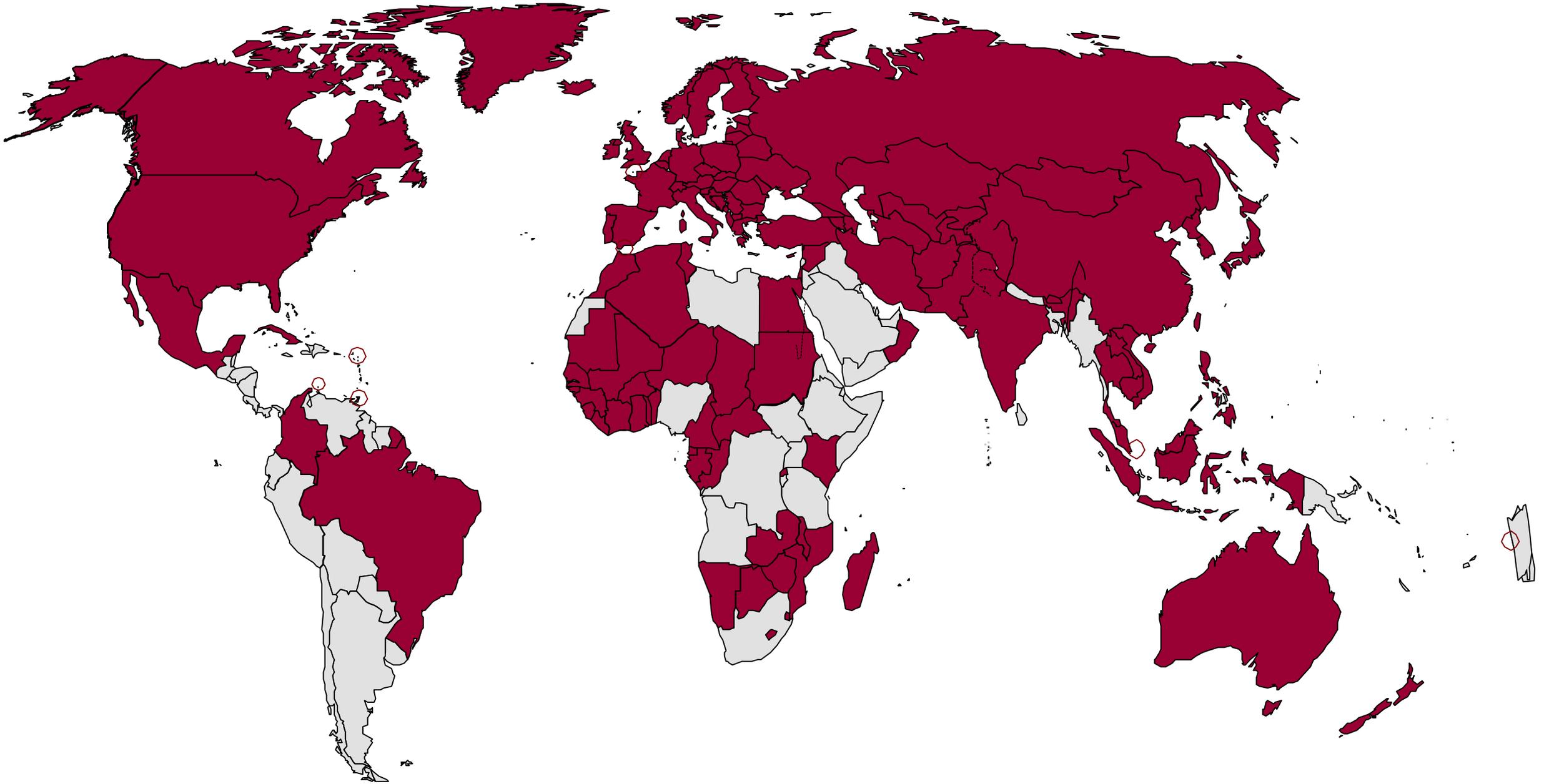
Madrid System



* optional

The Madrid System is Global

- 124 countries covered by 108 members
- Over 80% of world trade
- Recent accessions:
 - Brazil, Canada, Malaysia (2019)
 - Trinidad and Tobago (2020)
 - Expansion to Guernsey and Gibraltar (2021)
 - Islamic Republic of Pakistan (May 24, 2021)



The Madrid System is Convenient

- Centralized filing and management
- One application, one language, one set of fees
- Protection in new markets as business strategy evolves

The Madrid System is Cost-Effective

- One international application saves time and money
- Avoid translations and multiple procedures
- WIPO will renew and record changes to the international registration with effect for all the Contracting Parties concerned

Costs comparison

Madrid System

- Basic fee (mark in b/w or color)
 - Fees for designating members
 - Example: designating CN, DE, RU, US for a mark in color for 2 classes of goods/services
- = CHF 2,397**

National Route

- Official fees for 4 countries
- Additional costs:
 - 3 x translations
 - 4 x local attorney fees

* Applicants from [LDCs](#) pay only 10% of basic fee

Trademark: Madrid Users from Canada



MO SOUP PHO YOU



Don't panic, go organic !



GREEN GRUFF

INFINITY|Q>

BANBURY GREEN RESORT

Madrid Filings in Canada

Year	Madrid Applications	Designations in Canadian international registrations	Designations of Canada
2019 *	287	1,855	10,158
2020	570	4,209	21,071
2021 *	298	2,699	8,438

■ The 5th most designated Contracting Party (after EU, US, CN, UK)

* 6 months

Learn More Now



www.wipo.int/madrid

WIPO Roving Webinars



Protecting your Trademarks Internationally

The Madrid System in Canada

Stephanie Golden

Senior Policy and Legislation Analyst

Trademarks and Industrial Designs Branch
Canadian Intellectual Property Office



Outline

- Canada as the Office of Origin
- Designating Canada
- Useful Resources



Canada as the Office of Origin

- Basic Application or Registration
- *Madrid eFiling System*
- No Fee for Certification
- WIPO Irregularity Process



Canada as the Office of Origin

- What's Next?
 - Managing the International Registration
 - 5-Year Dependency - Ceasing of Effect
- Tips & Lessons Learned:
 - Nice Classification Required on Older Registrations
 - Applicant Email Address is Required



Designating Canada

- Individual Fee:
 - Filing of an Application
 - Renewal
- Examination
 - Substantive Including Relative and Absolute Grounds
- *Canadian Trademarks Act & Regulations*



Designating Canada

- Corresponding with CIPO
- CIPO receives WIPO Notifications
 - Part 2 of the *Trademarks Regulations* (Madrid)
- Madrid Member Profile



Designating Canada

- Tips and Lessons Learned
 - Official Languages Active Offer
 - Courtesy Letter to WIPO Representative
 - Courtesy Copies sent to Applicant or Canadian Trademark Agent



Useful Resources

Madrid Examination and
Procedures Manual
(MEPM)



Madrid Member Profile



madrid@canada.ca



Canada 

WIPO Roving Webinars



Protecting your Trademarks Internationally

The Madrid System in Canada

Andy Chow, SMITHS IP
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604-689-7276



How do I find help?

- <https://ised-isde.canada.ca/cipo-opic/agents/search?lang=eng> (CIPO – IP Agent Search)
- <http://www.ic.gc.ca/cipo/mc-tm/agents.nsf/tmagents-eng?readform> (CIPO – Register of Trademark Agents)
- <https://ipic.ca/find-an-agent> (IPIC – Find an IP Professional)



CIPO – IP Agent Search

IP Agent Search

BETA: This is a new service — your [feedback](#) will help us improve it.

i When accessing Agent Search, you are prompted to share your location. If you agree, your location will be taken into consideration and you will be provided with agents that are within 25 km of your location. If you decide not to share your location, the default location will be 'Canada' and you will be provided with all agents located in Canada.

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Note: IP Agent Search provides a limited list of **registered patent agents** who are open to accepting new clients. If you wish to verify that a patent agent is registered, please contact our [Client Service Centre](#).

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Search

Name

Location



Vancouver, British Columbia, Canada

< 25 km

Individual/Firm [?](#)

Any

Agent type

Any

Search

Clear



Madrid System

- Filing Strategy and Considerations
- Practical Tips



WIPO Roving Webinars





Designs

- Grégoire Bisson
- Maxime Villemaire
- Andy Chow

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The Hague System for the International Registration of Industrial Designs

Grégoire Bisson
Director
The Hague Registry

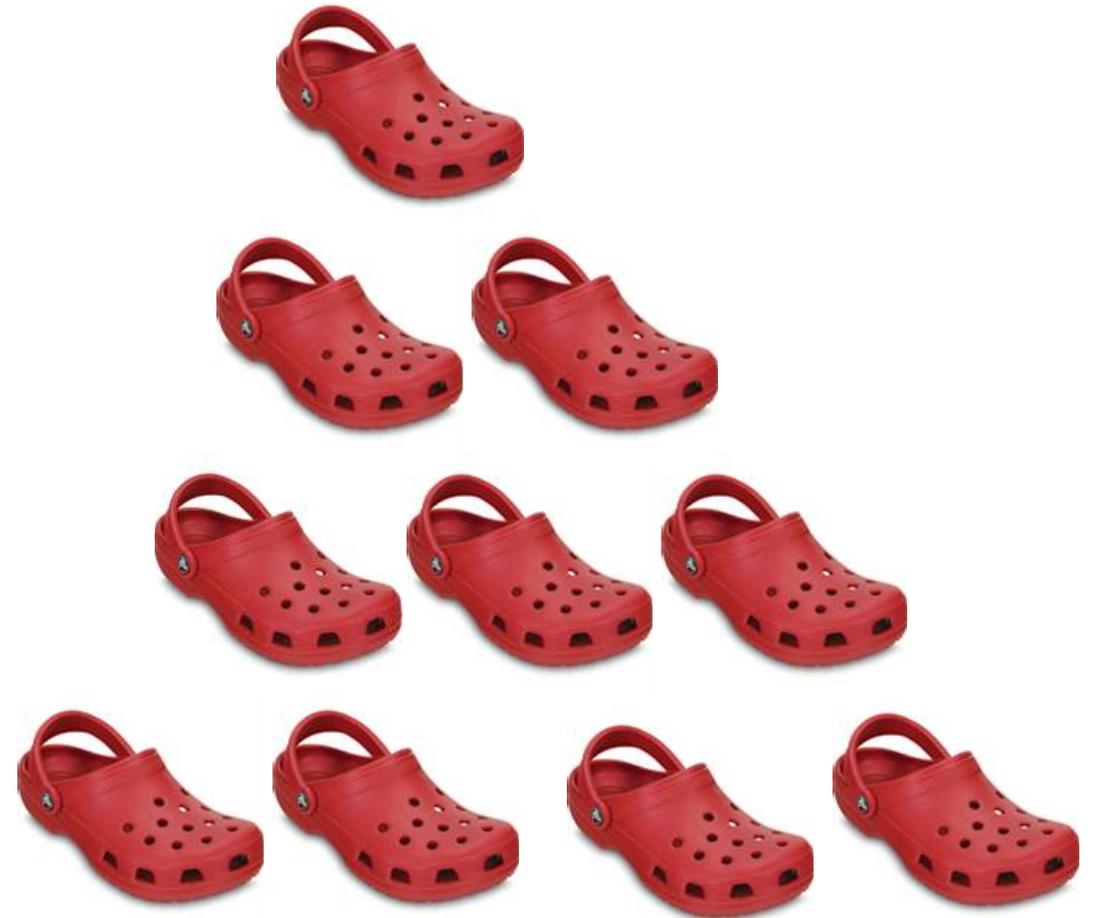
CROCS

- Single-product SME
- Design not protected...



- Why was the design not protected?
- Would it be different today, as Canada is a **Member of the Hague System?**

Copies



What is the Hague System?

- Like Madrid :
 - 1 application for many jurisdictions
 - 1 set of formalities
 - 100 designs (1 class)
- Unlike Madrid - ***It's a true one stop-shop!***
 - Direct e-filing with WIPO
 - No Canadian basic application needed
 - Covering Canada is possible



How Does it Work?

- WIPO does formal examination
- WIPO registers and publishes your designs
- Where applicable, Offices will carry out substantive examination
- your IR has same effect as domestic title
- Your IR centrally renewed & managed with WIPO:

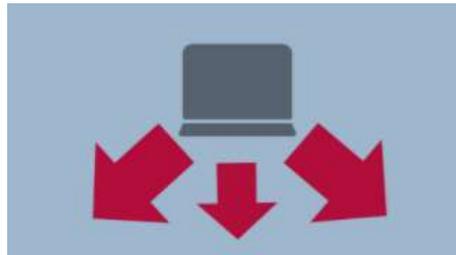
Hague System benefits



Simple



Cost-effective

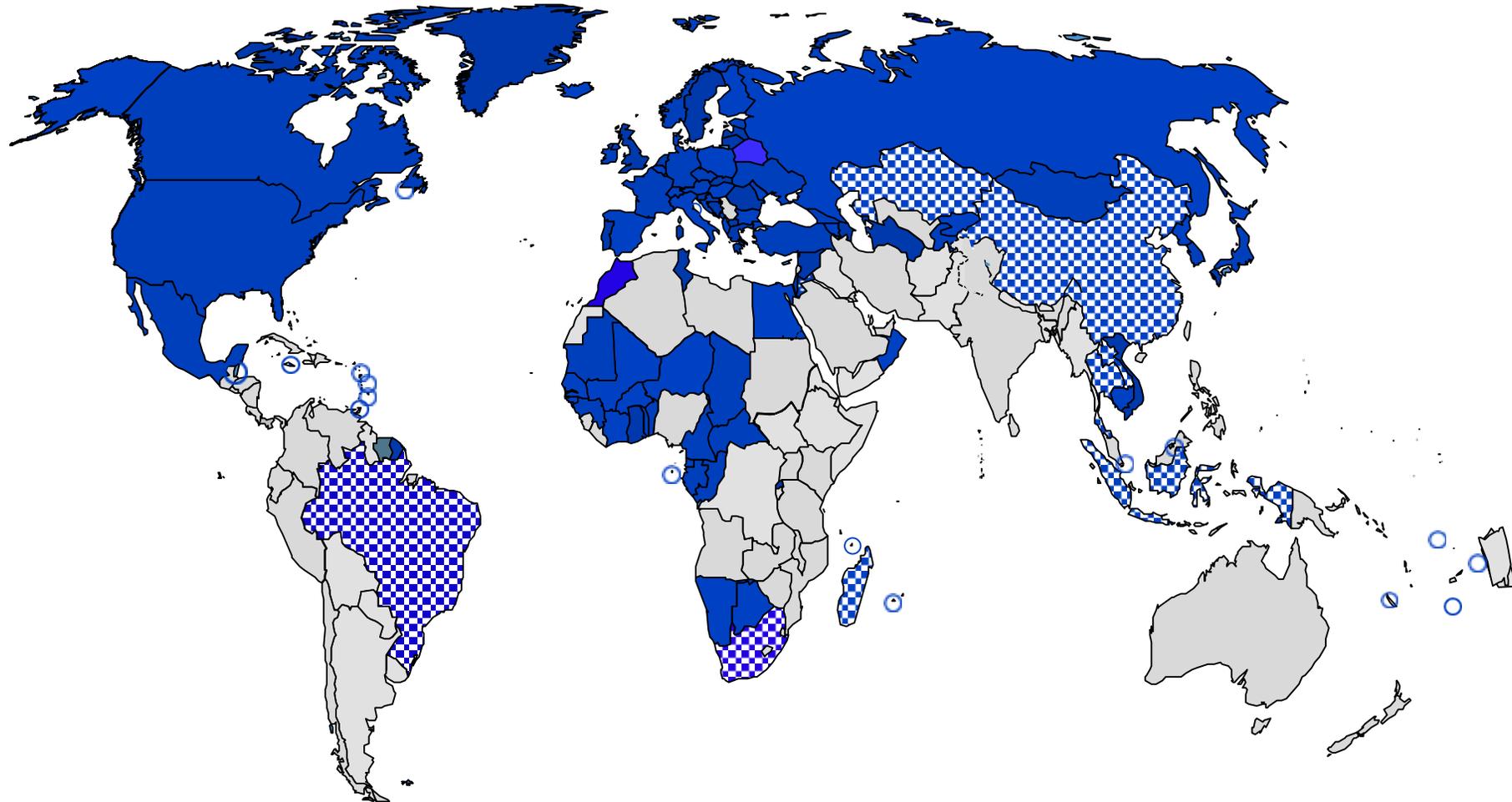


Efficient central management



Global

International design protection made accessible: The Hague System

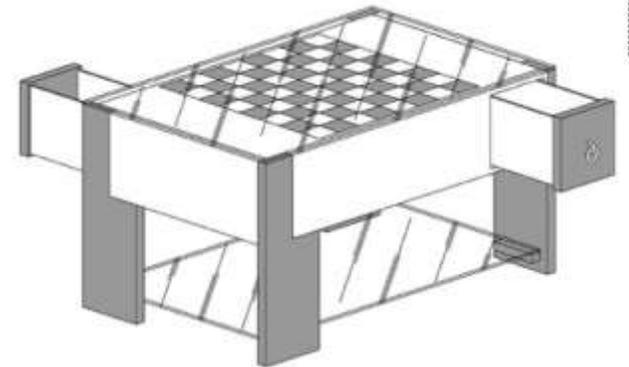
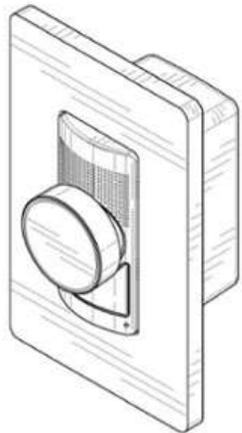
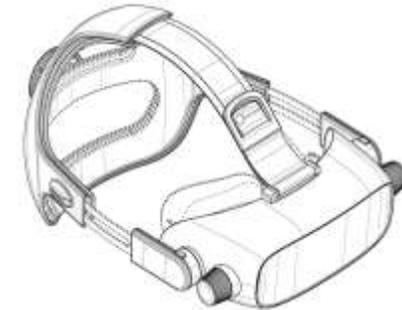
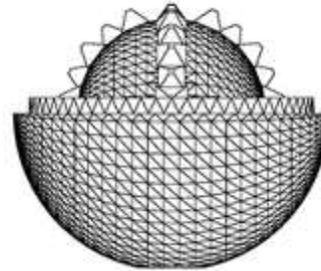
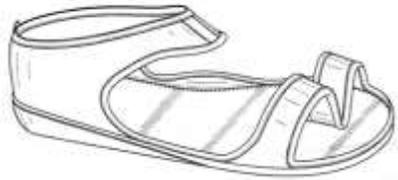


A single application covering 92 countries!



coming soon into the system!

Some Canadian Designs filed under Hague



The Story would be different today



- DM/101 172 by Adam Szoke & Kyle Campbell
- <https://www3.wipo.int/designdb/hague/en/#>
- Covering EU, US, KR

WIPO | HAGUE

Visit us at:

<https://www.wipo.int/hague/en/>



WIPO Roving Webinars



PROTECTING YOUR DESIGNS INTERNATIONALLY

Designating Canada through the Hague System

Maxime Villemaire

Senior Policy and Legislation Analyst

Trademarks and Industrial Designs Branch
Canadian Intellectual Property Office



Outline

- Applying for registration using the Hague System
- The examination of your design
- Specificities and tips from lessons learned



Applying for registration using the Hague System

- Registering your design with CIPO gives you an exclusive right in Canada only. To protect your design internationally, you could:

Apply in each country separately or
Use the Hague System

- What are the initial steps under the Hague System?
 - File an international application
 - Examination of the formalities by WIPO
 - Your international application becomes an international registration
 - Publication of your design in the International Designs Bulletin



The examination of your design

- The publication in the Bulletin acts as a notification to IP offices
- CIPO will conduct a substantive examination. Two outcomes:

✓ Statement of Grant of Protection or Notification of Refusal ✗



- The maintenance of your exclusive right must be done through WIPO



Specificities and tips from lessons learned

- Be mindful of the different disclosure requirements of each country
- Choose a product indication that is specific enough
- The appointment of a representative before WIPO does not mean an agent has been appointed before CIPO
- Be careful not to include a patent claim as the description of your design



Thank you!

For more information:



Industrial Design
Office Practices



Joining the
Hague
Agreement



Industrial
Design Guide



Canada 

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- <https://ipic.ca/find-an-agent> (IPIC – Find an IP Professional)



IPIC – Find an IP Professional

Find an IP Professional

FIND AN IP PROFESSIONAL IN YOUR AREA

By name, firm, company or city

By Province



PATENT AGENT TRADEMARK AGENT LAWYER MEDIATOR ARBITRATOR

 SEARCH



Hague System

- Filing Strategy and Considerations
- Practical Tips



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Your Questions Answered

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