



WIPO Regional Training Workshop on Online Tools and Services for Industrial Property Administration and Automation

TOPIC 17: ROLES AND OBLIGATIONS OF AN IP OFFICE IN THE MADRID SYSTEM

HARARE, SEPTEMBER 13, 2018

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- ▶ **THE MADRID SYSTEM**
- ▶ **ROLE OF AN IPO AS OFFICE OF ORIGIN**
- ▶ **ROLE OF AN IPO AS OFFICE OF A DCP**
- ▶ **DECISIONS BY OFFICES OF DCPs**

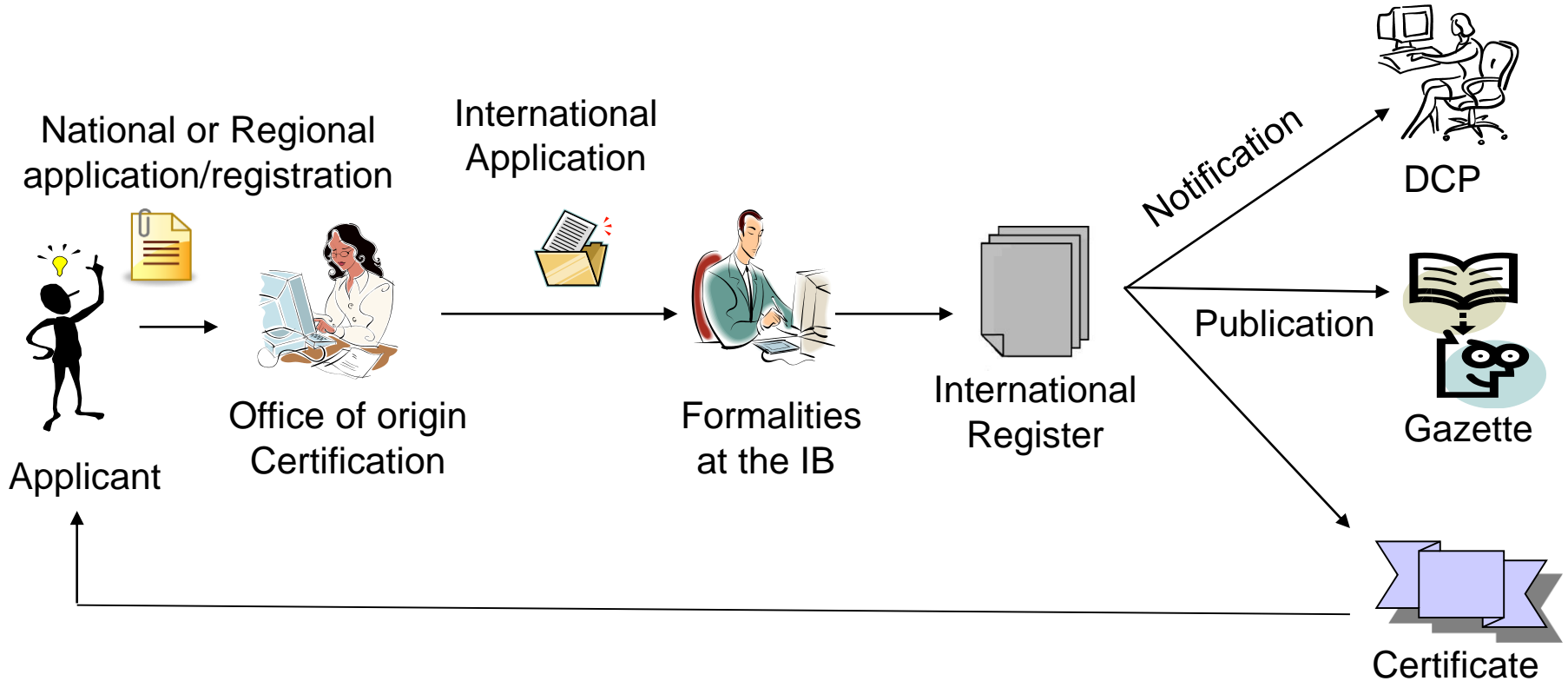
THE MADRID SYSTEM

- ▶ **A SYSTEM FOR INTERNATIONAL REGISTRATION OF TRADEMARKS AND CENTRALIZED MANAGEMENT OF RIGHTS THROUGH A SINGLE PROCEDURE**

- ▶ **LEGAL FRAMEWORK :**
 - **Paris Convention (1883)**
 - **Madrid agreement (1891)**
 - **Madrid Protocol (1989)**
 - **Common Regulations**
 - **Administrative Instructions**
 - **Laws, regulations and practices of each contracting country**

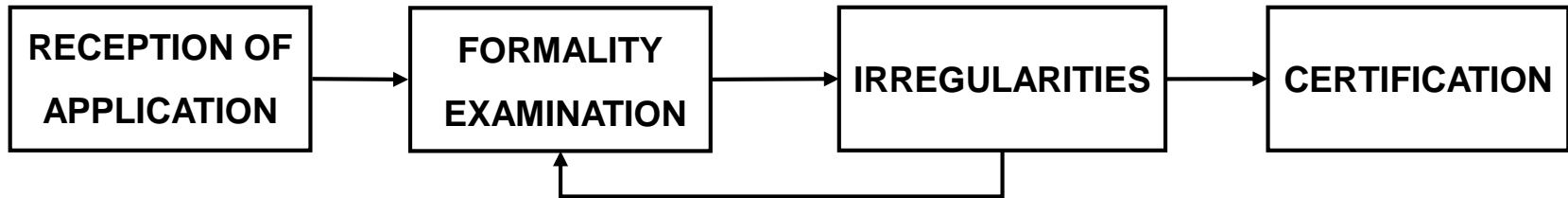
THE MADRID SYSTEM

INTERNATIONAL FILING PROCEDURE



ROLE OF AN IPO AS OFFICE OF ORIGIN

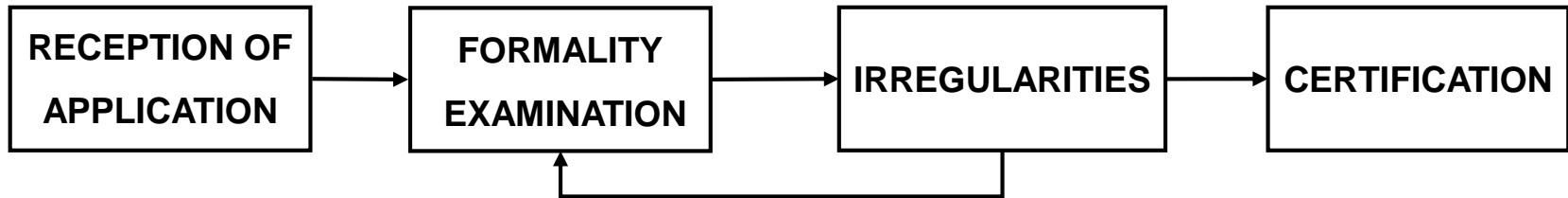
OFFICE OF ORIGIN



- **Inform and support users**
- **Receive, examine, certify and transmit to WIPO the international application within 2 months**
- **Remedy certain irregularities in the international application**
- **Monitor basic mark for the period of 5 years and notify ceasing of effect (dependence period)**
- **Transmit to WIPO requests from holders**

ROLE OF AN IPO AS OFFICE OF ORIGIN

OFFICE OF ORIGIN

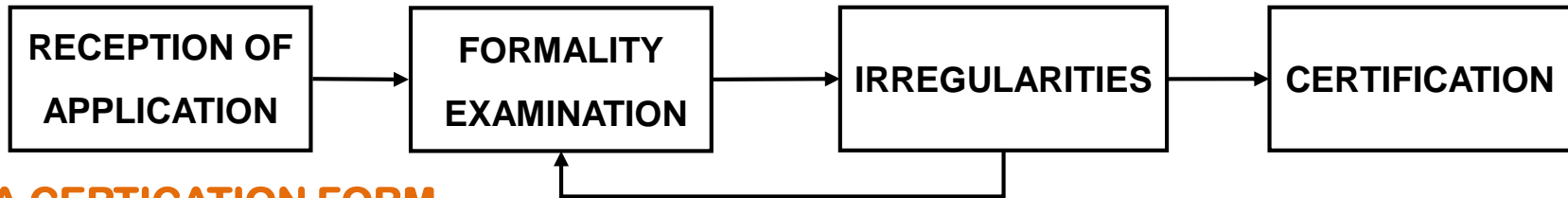


► CERTIFICATION CHECKLIST

- **the name of the applicant is the same in the basic mark**
- **the reproduction corresponds to the basic mark**
- **claims that the mark is a color, 3-D, sound, collective,**
- **certification or guarantee mark appear in the basic mark**
- **colors claimed are also claimed or appear in the basic**
- **mark**
- **Goods and Services are covered by the basic mark**

ROLE OF AN IPO AS OFFICE OF ORIGIN

OFFICE OF ORIGIN



A CERTIFICATION FORM

13 CERTIFICATION AND SIGNATURE OF THE INTERNATIONAL APPLICATION BY THE OFFICE OF ORIGIN

(a) Certification

The Office of origin certifies

(i) that the request to present this application was received on 12/05/2014 (dd/mm/yyyy).

(ii) that the applicant named in item 2 is the same as the applicant named in the basic application or the holder named in the basic registration mentioned in item 5, as the case may be, that any indication given in item 7(d), 9(d) or 9(e) appears also in the basic application or the basic registration, as the case may be, that the mark in item 7(a) is the same as in the basic application or the basic registration, as the case may be, that, if color is claimed as a distinctive feature of the mark in the basic application or the basic registration, the same claim is included in item 8 or that, if color is claimed in item 8 without having been claimed in the basic application or basic registration, the mark in the basic application or basic registration is in fact in the color or combination of colors claimed, and that the goods and services listed in item 10 are covered by the list of goods and services appearing in the basic application or basic registration, as the case may be.

Where the international application is based on two or more basic applications or basic registrations, the above declaration shall be deemed to apply to all those basic applications or basic registrations.

(b) Name of the Office: THE SWEDISH PATENT AND REGISTRATION OFFICE

Kerstin Dullaghan

Name and signature of the official signing on behalf of the Office: 16/05/2014
K Dullaghan

ROLE OF AN IPO AS OFFICE OF ORIGIN

EXAMPLE : OAPI AS OFFICE OF ORIGIN

OMPI Base de données

Non sécurisé | www.wipo.int/branddb/fr/

Désignation = e.g. FR, France


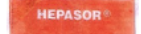



recherche

RECHERCHE EN COURS

OO:OA

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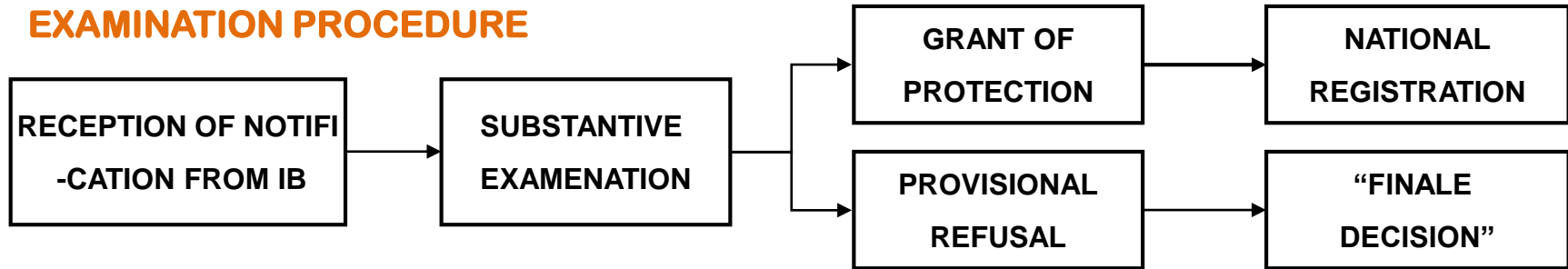
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Marque	Source	Situation	Pertinence	Origine	Titulaire	Numéro	Date Dem.	Cl. d'images	Cl. de Nice	Image
<input type="checkbox"/> Pan-African PMC Project Management Conference	WO TM	Actif	16	OA	PRESCRIPTOR LTD	1379998	2016-07-28	VC.26.04, VC.27.05, VC.29.01	35, 41, 42	
<input type="checkbox"/> HEPASOR	WO TM	Actif	16	OA	LABOTHERA Sarl (LABORATOIRE DE THERAPEUTIQUES APPLIQUEES)	1380213	2016-03-04	VC.26.04, VC.29.01	5	
<input type="checkbox"/> WARI	WO TM	Actif	16	OA	MONSIEUR MBODJE KABIROU	1283425	2015-07-09	VC.26.01, VC.27.05, VC.29.01	36, 38, 41	
<input type="checkbox"/> AIPO	Emblème WO	Actif	16	OA	AFRICAN INTELLECTUAL PROPERTY ORGANIZATION			VC.01.01, VC.15.07, VC.24.03, VC.26.01		
<input type="checkbox"/> Aucun élément verbal	Emblème WO	Actif	16	OA	African Intellectual P			VC.26.02, VC.29.01		
<input type="checkbox"/> ORGANISATION AFRICAINE DE LA PROPRIÉTÉ	Emblème WO	Actif	16	OA	AFRICAN INTELLECTUAL PROPERTY ORGANIZATION	OA4				

1st Madrid Protocol Registration from OAPI

ROLE OF AN IPO AS OFFICE OF A DCP

OFFICE OF A DCP

EXAMINATION PROCEDURE



- ▶ From the date of the international registration or of the subsequent designation, it has the effects of :
 - an application filed with the Office of the designated CPs; and,
 - a registration effected by the Office of the designated CPs where protection is not refused within the applicable time limit or refusal is withdrawn

OFFICE OF A DCP


- ▶ **From the date of the international registration or of the subsequent designation, it has the effects of :**
 - **an application filed with the Office of the designated CPs; and,**
 - **a registration effected by the Office of the designated CPs where protection is not refused within the applicable time limit or refusal is withdrawn**

OFFICE OF A DCP

- ▶ **The role of the DCP Office will be determined by the national legislation which lays down the conditions for protection of a trademark and determines the rights resulting from the protection**
- ▶ **The Madrid system offers the DCPs Office the possibility of issuing decisions relating to the situation of protection**
 - **Provisional refusal (Rules 16, 17 and 18)**
 - **Provisional situation (Rule 18bis)**
 - **Final decision concerning the situation of the mark (Rule 18ter)**
 - **Invalidation (19)**

Provisional refusal

Organisation Africaine
de la Propriété Intellectuelle



African Intellectual
Property Organization

PROTOCOLE DE MADRID
INFORMATIONS RELATIVES A D'EVENTUELLES OPPOSITIONS
Règle 16.1a)

Références de la notification : 5741/2018/OAPI/DG/DGA/DMSD/SSD/Madrid

<p>I. Office qui communique les informations : <i>Organisation Africaine de la Propriété Intellectuelle (OAPI)</i> <i>B.P. 887, Yaoundé - Cameroun</i> <i>Tél : 00 237 222 20 57 00 e-mail: oapi@oapi.int site web: www.oapi.int</i></p>
<p>II. Numéro et date de l'enregistrement international : 1189007 du 15/11/2013</p>
<p>III. Date de désignation de l'OAPI : 23/09/2016</p>
<p>IV. Numéro et date d'enregistrement OAPI : 93890 du 27/10/2017</p>
<p>V. Reproduction de la marque :</p> <p style="text-align: center;">KADALYS</p>
<p>VI. Nom du titulaire (ou autre indication permettant de confirmer l'identité de l'enregistrement international) : <i>SHB SAS</i> <i>2 lotissement Poinsettas Peters Maillets F-97270 SAINT-ESPRIT, France (FR)</i></p>

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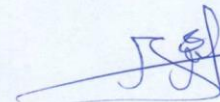
BP: 887 Yaoundé - Cameroun - Tél. : (237) 222 20 57 00 - Email : oapi@oapi.int www.oapi.int

VII. Dates auxquelles le délai d'opposition commence et prend fin :

- Date à laquelle le délai d'opposition commence : 22/02/2018
- Date à laquelle le délai d'opposition prend fin : 22/08/2018

VIII. Signature et sceau officiel de l'Office qui envoie la déclaration :

*P. Le Directeur général de l'OAPI
et par délégation
Le Directeur des Marques
et autres signes distinctifs*



Issoufou KABORE



IX. Date : Yaoundé, le 19/02/2018

DECISIONS BY OFFICES OF DCPs

COMMUNICATION BEFORE THE EXPIRY OF THE REFUSAL PERIOD

- ▶ **STATEMENT OF GRANT OF PROTECTION (MF4 – R.18ter(1))**
 - **Within refusal period**
 - **No grounds to refuse**
 - **All procedures completed**

ROLE OF AN IPO AS OFFICE OF A DCP

GRANT OF PROTECTION

	Organisation Africaine de la Propriété Intellectuelle African Intellectual Property Organization
PROTOCOLE DE MADRID DÉCISION FINALE CONCERNANT LA SITUATION DE LA MARQUE – DÉCLARATION D'OCTROI DE LA PROTECTION –	
(Règle 18ter.1) Références de la notification: 12963/2017/OAPI/DG/DGA/DPI/SSD/Madrid	
I. Office qui communique les informations : Organisation Africaine de la Propriété Intellectuelle (OAPI) B.P. 887, Yaoundé - Cameroun Tél : 00 237 222 20 57 00 e-mail: oapi@oapi.int site web: www.oapi.int	
II Numéro et date de l'enregistrement international : 666536 du 17/04/2015	
III Nom du titulaire (ou autre indication permettant de confirmer l'identité de l'enregistrement international) : CALDERA 1 rue des Frères Lumière, F-67200 ECKBOLSHEIM, France (FR)	
IV La protection est accordée à la marque qui fait l'objet de cet enregistrement international pour tous les produits et/ou tous les services demandés. <i>Le présent enregistrement produit ses effets dans chacun dix-sept (17) Etats membres de l'Organisation, à savoir : Bénin, Burkina Faso, Cameroun, Centrafrique, Comores, Congo, Côte d'Ivoire, Gabon, Guinée, Guinée Bissau, Guinée Equatoriale, Mali, Mauritanie, Niger, Sénégal, Tchad, Togo.</i>	
V. Signature et sceau officiel de l'Office qui envoie la déclaration : <div style="display: flex; align-items: center; justify-content: center;">  <div style="text-align: center;"> <p>Le Directeur Général</p>  <p>Denis L. BOHOUSOU</p> </div> </div>	
VI. Date : Yaoundé, le 08/09/2017	
B.P. : 887 Yaoundé - Cameroun - Tél. : (237) 22 20 57 00 - Fax : (237) 22 20 57 27 - Email : oapi@oapi.int www.oapi.int	

DECISIONS BY OFFICES OF DCPs

COMMUNICATION BEFORE THE EXPIRY OF THE REFUSAL PERIOD

► NOTIFICATION OF PROVISIONAL REFUSAL (MF3A – TOTAL R.17(1))

(MF3B – PARTIAL R.17(1))

- **Provisional refusal (Rules 16, 17 and 18)**
- **Provisional situation (Rule 18bis)**
- **Final decision concerning the situation of the mark (Rule 18ter)**
- **Invalidation (19)**

DECISIONS BY OFFICES OF DCPs

COMMUNICATION FOLLOWING PROVISIONAL REFUSAL

► FINAL DECISIONS (MF5)

- Protection following a provisional refusal Rule 18ter(2)
- Confirmation of a total provisional refusal Rule 18ter(3)

DECISIONS BY OFFICES OF DCPs

COMMUNICATION FOLLOWING PROVISIONAL REFUSAL

- ▶ **MF6 – Confirmation of total refusal under Rule 18ter(3)**

FURTHER DECISION UNDER RULE 18ter(4)

- ▶ **Further decision now**
 - Can be sent only after a final decision under Rule 18ter(2) or (3)
- ▶ **As from November 1, 2017**
 - Can be sent after tacit acceptance, grant of protection under Rule 18ter(1) or final decision under Rule 18ter(2) or (3)
- ▶ **Content :**
 - Scope of the protection

DECISIONS BY OFFICES OF DCPs

DIFFERENCE BETWEEN FURTHER DECISION AND INVALIDATION

► Further decision

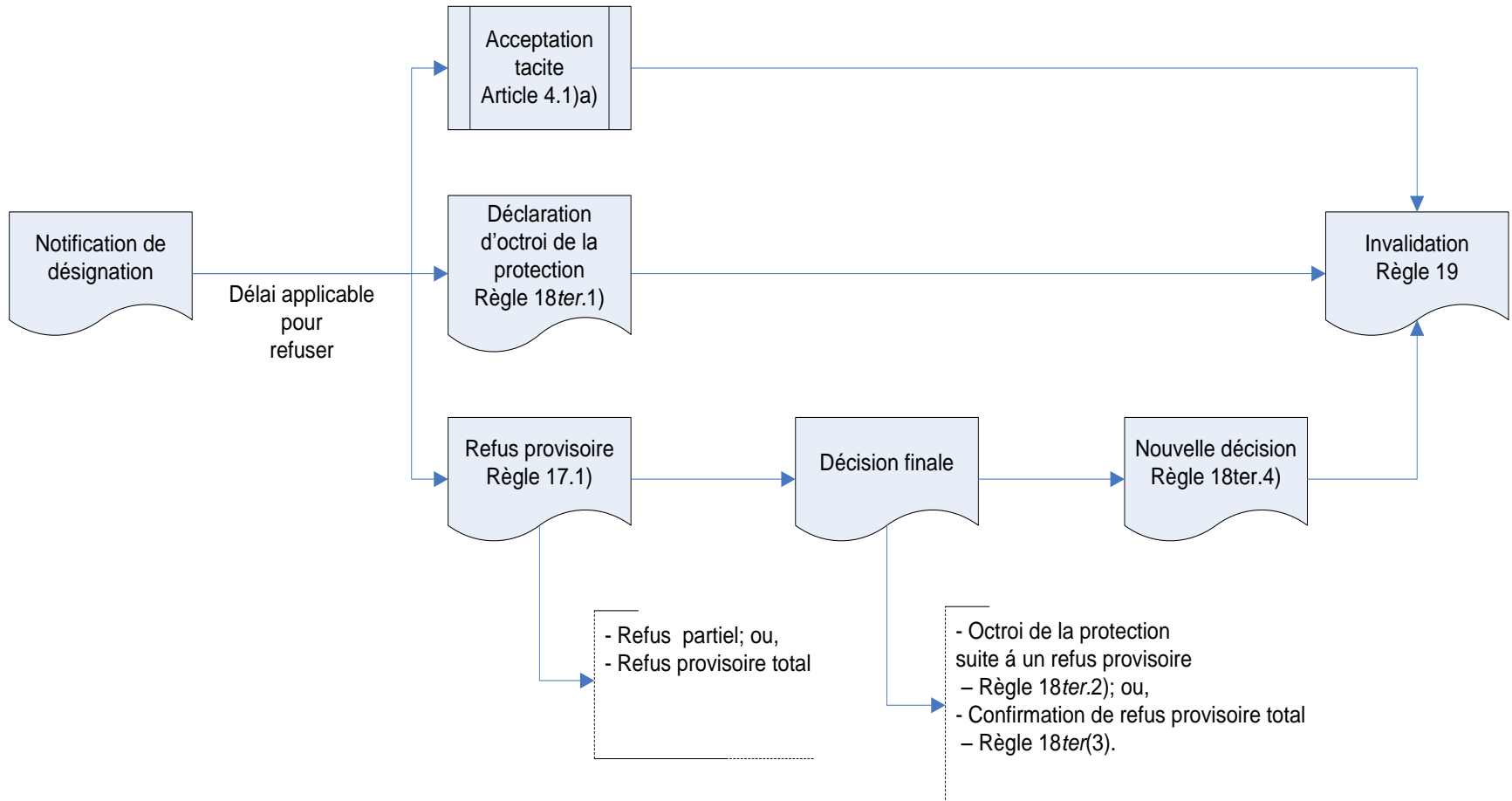
- Can increase or reduce the scope of protection
- Subject to review or appeal
- Can be modified by another further decision
- MF7 – Further decision

► Invalidation

- All or part of the registration no longer has Effect
- No longer subject to appeal
- Registration cannot regain effect; except under a later subsequent designation
- MF10 – Invalidation

DECISIONS BY OFFICES OF DCPs

OVERVIEW





Depuis plus de 50 ans

L'Organisation Africaine de la Propriété Intellectuelle
Apporte son soutien et son expertise aux acteurs économiques

Dans ses 17 Etats membres

www.oapi.int

