

# The Role of National IP Offices to Promote the Strategic Use of the Madrid System

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## Barriers faced by Applicants in Using the Madrid System

- Limited knowledge of the ins and outs of the Madrid system
- Limited access to expert advice on the subject matter
- Lack of clarity about its relevance to their business strategy and competitiveness
- Find the system too complex and expensive to use
- Lack of active government support to assist trademark holders in the branding process

# Barriers faced by Applicants in Using the Madrid System



- The costs of branding are generally perceived as one of the greatest barriers for trademark owners who need to take into consideration not only the official fees (including application fees, publication fees, maintenance fees, but also the costs relating to application preparation and prosecution, legal advice and translation costs whenever the applicant intends to apply for protection abroad)
- Delays to obtain a trademark registration
- Long delays for obtaining trademark registration leaves a great degree of uncertainty and delays the possibility of enforcing it or finding potential licensees or partners for exploiting a mark

# Barriers faced by Applicants in Using the Madrid System



- The increasing number of applications at some IP offices has led to an increase in the backlog and therefore an increase in the time required from filing to grant registration of a trademark
- Insufficient information on the Madrid system
- Poorly drafted trademark applications
- Limited access to adequate legal advice
- Lack of resources (human and financial) to follow the application through to the grant stage
- Difficulties that applicants may face in monitoring the use of their rights in the marketplace and in enforcing them

# Barriers faced by Applicants in Using the Madrid System



- Low awareness of the system limits the exposure trademark holders have to the Madrid system and their ability to use all the elements offered by it effectively
- Poor IP management skills by applicants/trademark owners reduce their ability to fully benefit from the system and, therefore, may discourage its use
- Limited access to the necessary human resources and/or accessible legal advice make use of the Madrid system complicated and decrease the chances of success in the application process for registration of trademark rights
- High costs, not just for acquiring and maintaining, but also for monitoring and enforcing trademark rights, particularly for applicants that are operating in a number of geographically dispersed markets

# Role of National IP Offices



- The importance of the global registration system such as the Madrid system must be highlighted by National IP offices as it significantly facilitates procedures and reduces costs for applying for trademark protection in several countries
- To promote the strategic use of the Madrid System, National IP offices should mainly focus on the following aspects:
  - Awareness-raising and Training on the Madrid system
  - Technological Information Services
  - Customized Advisory Services on the Madrid system
  - Assistance for IP exploitation

# Awareness-raising and Training on the Madrid System



- Promoting a wider and more effective use of the Madrid system requires that IP Offices seek to target actual and potential users
- Raising awareness and providing advice on procedural matters concerning the operation and management of the Madrid system
- Improving public awareness of trademark protection and actively publicizing the advantages of the Madrid system
- Knowing public demand and improving the public service system: help applicants to be familiarized with the Madrid system, organize and conduct training seminars, workshops, courses, establish the Madrid system information service platform

# Technology Information Services



- IP Offices should seek to go beyond the awareness-raising and training phase by providing a wide range of technological information services to the users:
  - Trademark documents
  - Trademark databases
  - WIPO web-based tools and services
  - Developing new and improved products and services for improving the chances of success of the business strategy of the users

# Customized advisory services on the Madrid System



- Some IP offices have ventured into providing customized legal and technical support to their customers
- In a number of cases, this has been done through the establishment of decentralized sub-offices of the IP office in order to reach out to the users located far from the headquarters of the national IP office
- This has generally had a strong impact in terms of bringing such IP offices closer to their users
- In other cases, IP offices have contributed to the establishment of IP libraries or other new types of institutional structures, often in partnership with universities, chambers of commerce and industry, trademark agents associations or other new types of institutional structures for improving access of the users to basic legal and procedural advice on how to go about applying for trademark protection

# Assistance for IP Exploitation



- Introduction of electronic filing by many IP offices is likely to make a contribution in reducing the transaction costs faced by applicants in filing their applications
- Improving the quality and efficiency of examination: The prerequisite for enhancing trademark protection is to guarantee the quality and speed of trademark examination and grant
- A number of IP offices have introduced procedures for the accelerated grant of trademarks upon request by the applicant in certain specific circumstances, thus reducing the time required for trademarks to be granted

# Assistance for IP Exploitation cont'd



- Decrease the backlog and therefore decrease the time required from filing to grant of a registration of a trademark since a long delay for obtaining trademark protection leaves a great degree of uncertainty and delays the possibility of enforcing it or finding potential licensees or partners for exploiting a brand
- Assisting the users to become and remain competitive, through a more effective use of the Madrid system, can only be really attained if all the relevant actors in the public, private and civil society sectors in a country party to the Madrid system make sustained efforts to bridge the gap in awareness of, access to, and use of the Madrid system by the users

Thank you

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