

# ■ Global Intellectual Property Systems

Madrid System for the International Registration of Marks

Hague System for the International Registration of  
Industrial Designs

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# MADRID SYSTEM

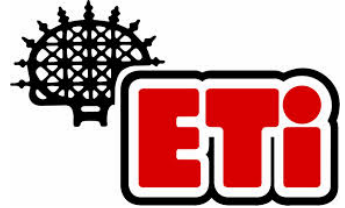
# Outline

- The Madrid System: key benefits
- Geographical scope and accession outlook
- Users of the System
- How the System works
- Use of the System
- Website/ new and improved e-services
- Recent developments
- Focus: Classification Guidelines, WIPO Current Account, Payments
- Keep updated on the Madrid System: new webinars

It begins with a trademark and a plan to export...



ORKA GROUP  
"FASHION IS OUR BUSINESS"



SHISEIDO



sopharma<sup>®</sup>  
PHARMACEUTICALS

MICROMAX

DAIMLER

SONY<sup>®</sup>

syngenta



Microsoft

DZAMA

TREASURY  
WINE ESTATES

# 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 (ARIPO, Benelux Office for IP, 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

# The Madrid System is Convenient

- Access a centralized filing and management procedure
- File one application, in one language and pay one set of fees for protection in multiple markets
- Expand protection to new markets as your business strategy evolves

# The Madrid System is Cost-Effective

- File an international application, which is the equivalent of a bundle of national applications, effectively saving time and money
- Avoid paying for translations into multiple languages or working through the administrative procedures of multiple IP Offices



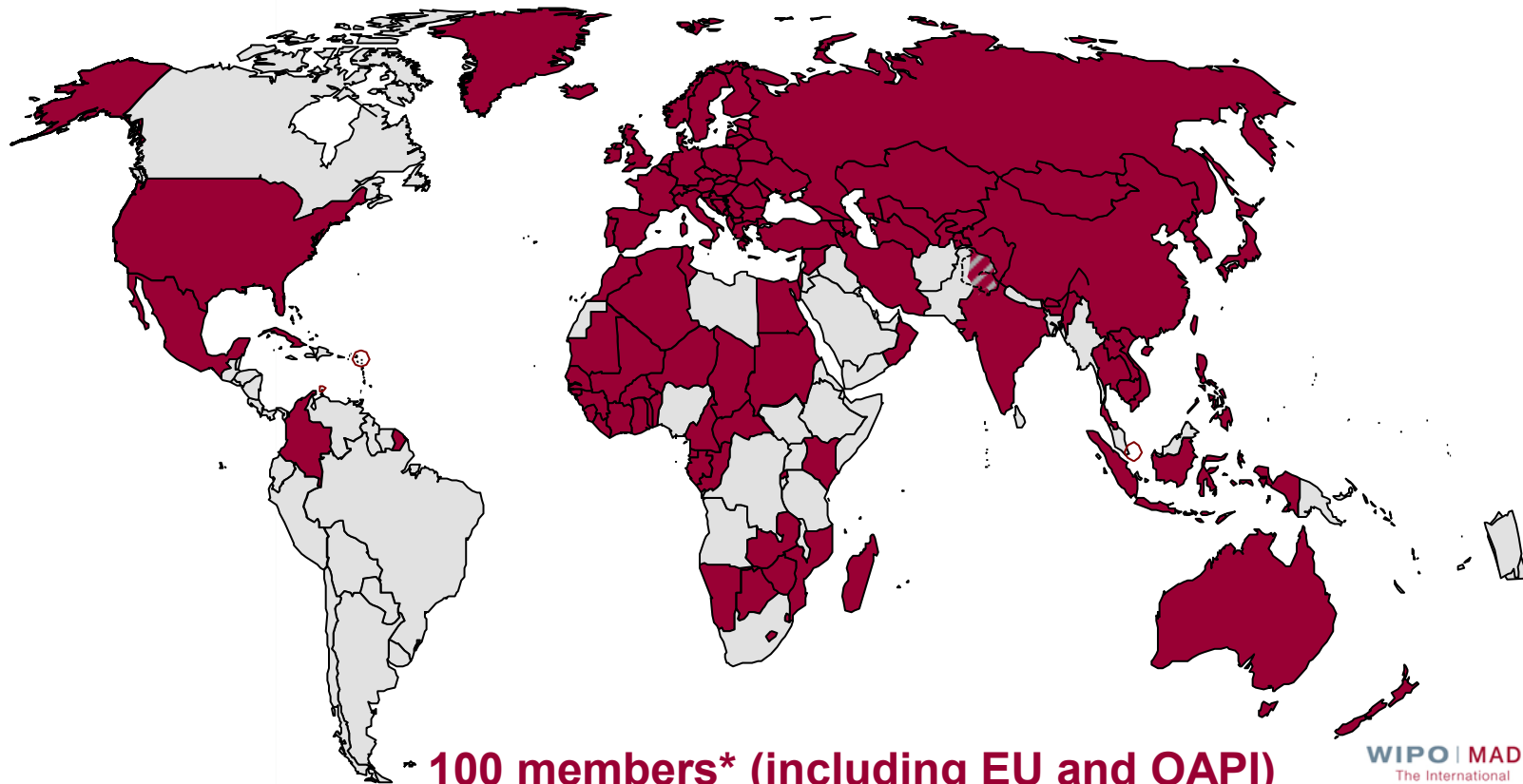
# The Madrid System is Global

- Currently: 116 countries covered by the 100 members
- Markets that represent more than 80% of world trade
- Recent accessions include:
  - 2014: OAPI and Zimbabwe
  - 2015: Algeria, Cambodia, The Gambia and Lao People's Democratic Republic
  - 2016: Brunei Darussalam
  - 2017: Thailand, Indonesia

# Accession Outlook – 2017/19

- **Africa:** Ethiopia, Malawi, Mauritius, South Africa
- **Arab region:** Jordan, Saudi Arabia
- **Asia:** Malaysia, Papua New Guinea, Samoa, Sri Lanka
- **Europe:** Malta
- **Latin America and the Caribbean:** Barbados, Brazil, Costa Rica, El Salvador, Jamaica, Trinidad and Tobago
- **North America:** Canada

# Members



**100 members\* (including EU and OAPI)  
covering 116 countries**

**WIPO | MADRID**  
The International  
Trademark System

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

# Legal Framework

- Madrid Agreement (1891)
- Madrid Protocol (1989)
- Common Regulations
- Administrative Instructions
  
- **Laws and Regulations of each Contracting Party**

See [http://www.wipo.int/madrid/en/legal\\_texts/](http://www.wipo.int/madrid/en/legal_texts/)  
<http://www.wipo.int/madrid/memberprofiles/#/>

# Madrid System Users: Business Sectors

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



# Top Five Classes

Number of classes specified in international applications and share of total



**COMPUTERS  
AND ELECTRONICS**



**12,748**



**9.4%**



**SERVICES  
FOR BUSINESS**



**10,265**



**7.6%**



**TECHNOLOGICAL  
SERVICES**



**8,114**



**6.0%**



**LEISURE, EDUCATION  
AND TRAINING  
SERVICES**



**6,253**



**4.6%**



**CLOTHING**



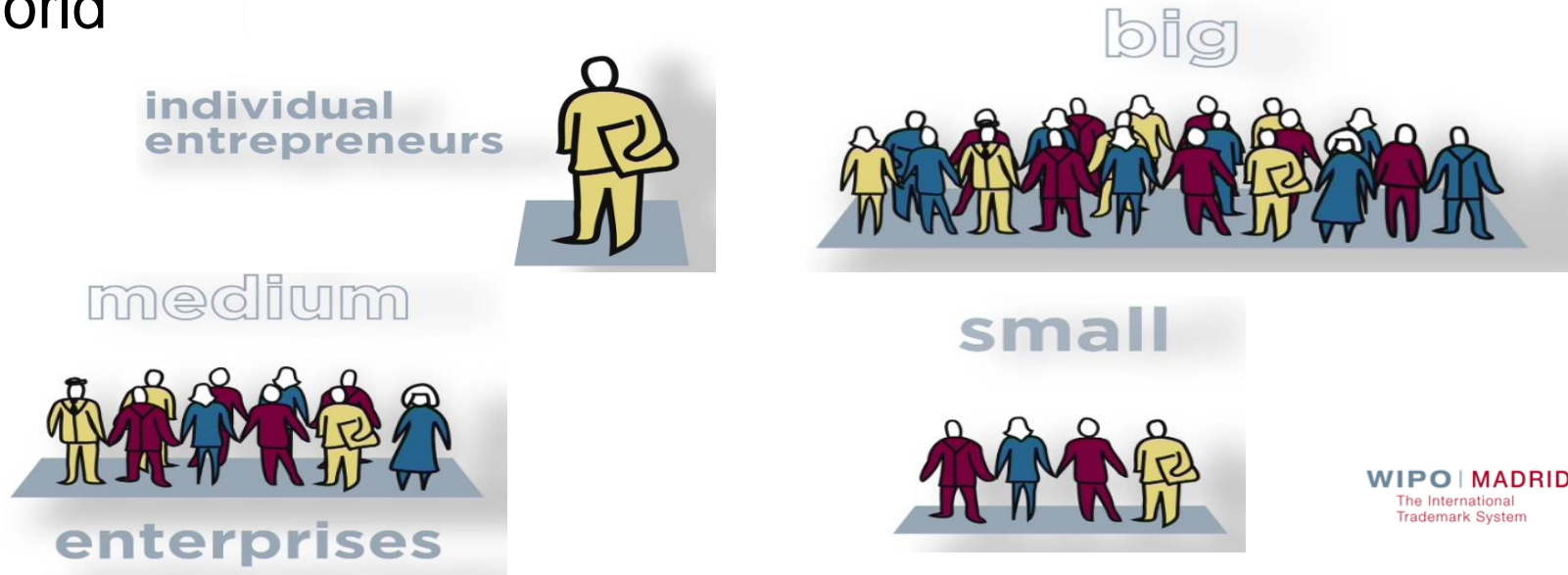
**5,870**



**4.3%**

# 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



# How the Madrid System Works

## The International Trademark Registration Process





# Stage 1

## Application through your Office of origin

- To be entitled to use the Madrid System, you must:
  - Have a real and effective industrial or commercial establishment in, or
  - Be domiciled in, or
  - Be a national of a member of the Madrid System
- Before filing an international application, you need to have registered or filed an application (**basic mark**) in your Office of origin
- Submit an **international application** through this same IP Office, which will certify and forward it to WIPO

# Stage 2

## Formal examination by WIPO

- WIPO conducts a **formalities examination**
- Once requirements have been met, the mark is **recorded in the International Register**
- WIPO sends a **certificate of international registration** to the holder and notifies the IP Offices, of the **designated Contracting Parties (dCP)**, in which protection is sought
- The scope of protection is not known at this stage. It is only determined **after substantive examination** and decision by the IP Offices, as outlined in Stage 3

# Stage 3

## Substantive examination by IP Offices (Office of the dCP)

- IP Offices make **a decision within 12 or 18 months** in accordance with their legislation. WIPO records the decisions and notifies you
- If an IP Office refuses to protect your mark, it will not affect the decisions of other offices. You can contest a refusal decision before the IP Office concerned
- If an IP Office accepts to protect your mark, it will issue **statement of grant of protection**
- The international registration is **valid for 10 years**. Renew directly with WIPO with effect in the dCPs

# Costs

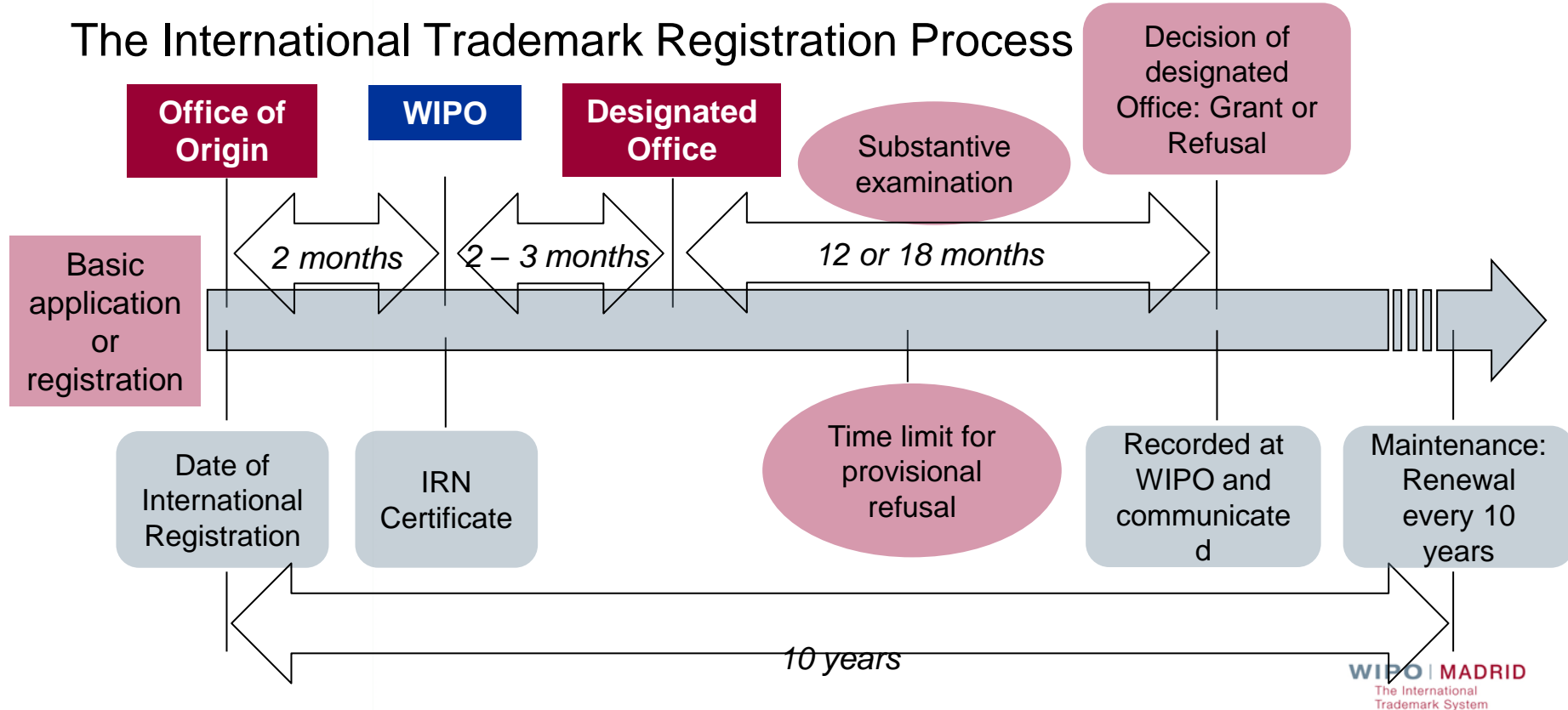
Fees are payable to WIPO in Swiss francs

- Basic fee\*, which includes 3 classes of goods/services
  - 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

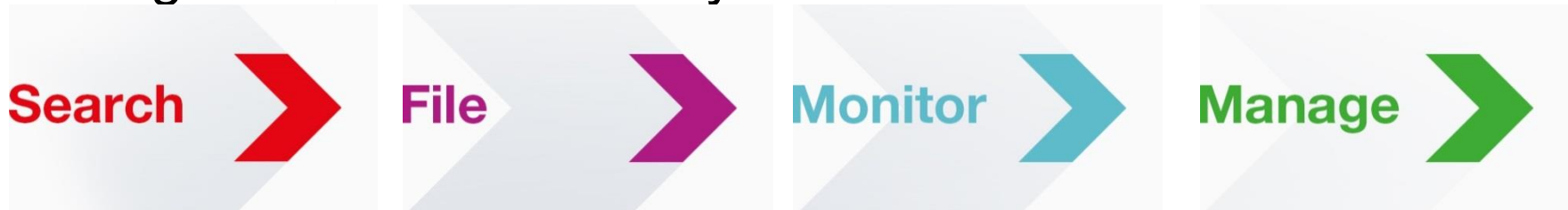
# Timeline

## The International Trademark Registration Process



# Website and E-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 E-Services are available to assist users at each stage of their mark's lifecycle.



# Recent Developments

- Rules Changes in the Common Regulations
- Classification Guidelines
- WIPO Current Account
- Madrid Monitor – integrates ROMARIN, the WIPO Gazette, Madrid E-Alert and Real-time Status
- Member Profiles Database
- New Contact Madrid service

# 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





# NEW – WIPO Current Account Changes

- No minimum number of transactions
- Initial payment of CHF 2,000
- Minimum balance – notification sent to users if balance is less than CHF 200
- A form to open the account available on the website
- Email address required
- Account statement sent by email only

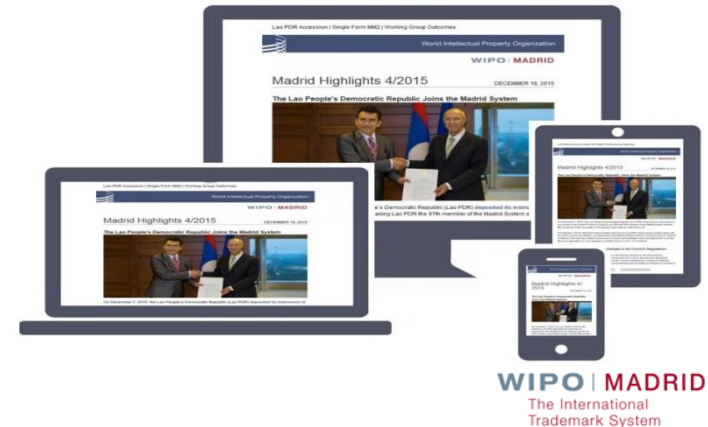
# NEW – Payment Resources

Need information about fee payments under the Madrid System? Browse our new webpages:

- [How to calculate fees](#)
- [How to pay fees and request refunds or cancellation.](#)
- [Payment Methods](#)
- [Guide to the WIPO Current Account](#) (updated terms and conditions)
- [How to locate a WIPO reference number](#)

# Keep Updated on the Madrid System

- Visit the Madrid Website [www.wipo.int/madrid/en](http://www.wipo.int/madrid/en)
- Register to all-new and free [Madrid Webinars](#)
- Subscribe to [Madrid Notices](#), our legal and news updates
- Sign up for [Madrid Highlights](#)



# HAGUE SYSTEM

# Industrial Designs



DM/074502



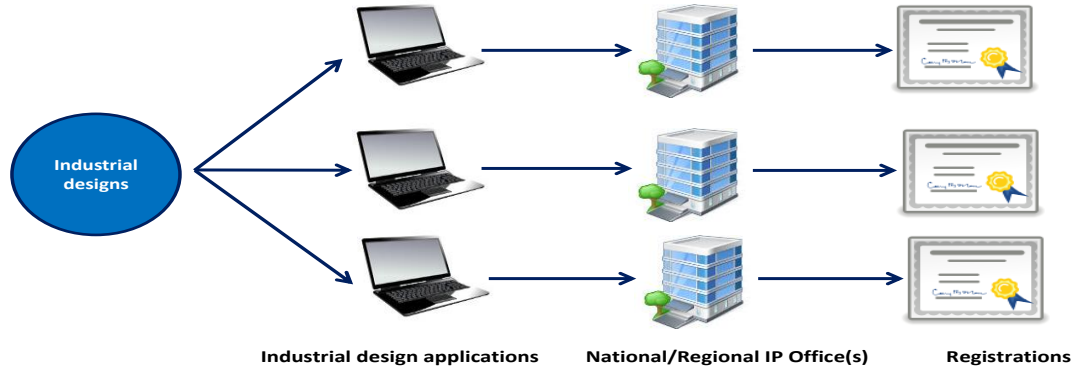
DM/083330



DM/081900

# Independent filings vs. Hague Route

## Direct/Paris Route



## The Hague System



# Hague System: a simple but timeless concept

The centralized acquisition and maintenance of industrial design rights by filing a single international application for a single international registration with effect in one or more designated Contracting Parties



# General Overview of the Hague System



Basic features and advantages



Legal framework



Going global – geographical scope



Some statistics



Latest developments and  
upcoming features





# Basic Features and Advantages of the Hague System

# What is the Hague System?

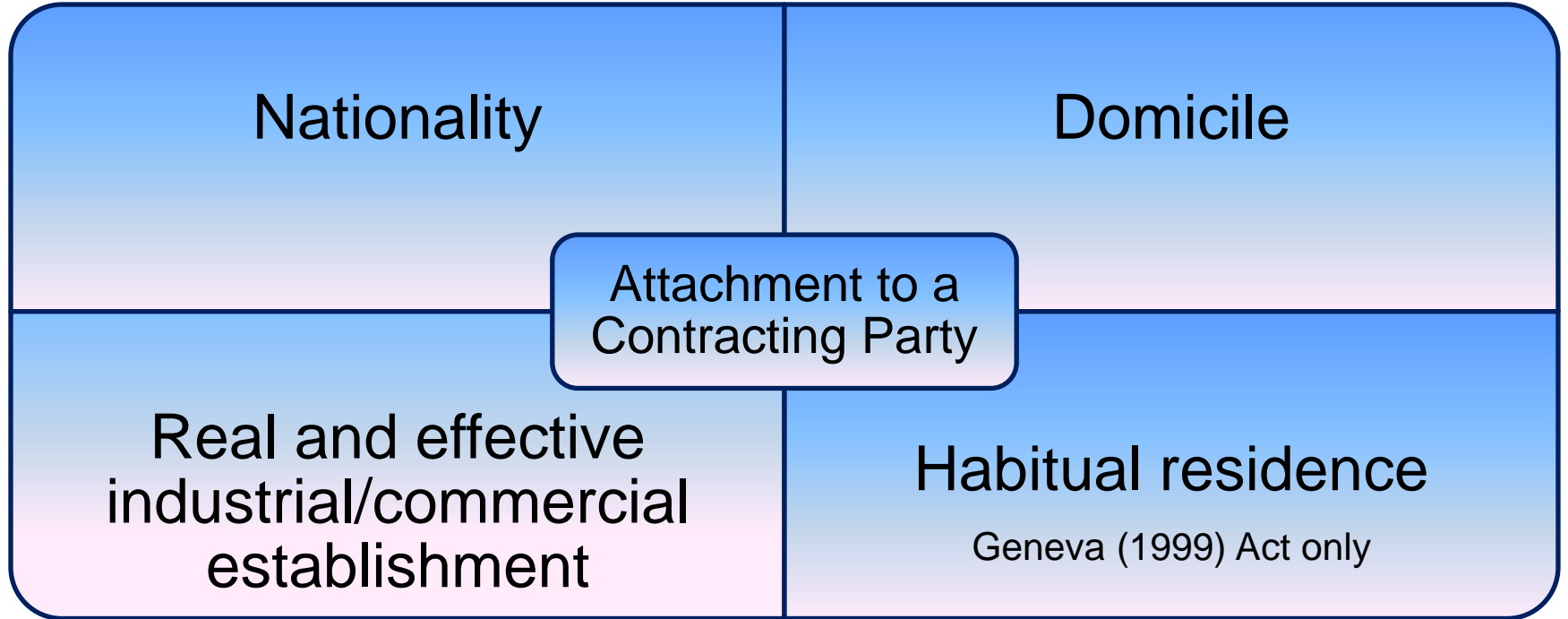
## One to many relationships

- File a single international application for a single international registration in which one or more Contracting Parties are designated

## “Bundle of rights”

- If no refusal, the resulting international registration has the effect of a grant of protection in each designated Contracting Party

# Who Can Use the System?



# The International Application

In English, French or Spanish

May be filed directly with the International Bureau through the E-filing interface but also on paper

May comprise several different designs up to a maximum of 100 if they belong to the same class of the International Classification (Locarno)

One set of fees (in CHF) is to be paid

# The Hague System Procedure: Role of the International Bureau

Formal examination

Recording in the International Register

Sending the certificate to the holder

Publication in the International Designs Bulletin

Notification to members through the publication in the Bulletin

If the International Bureau finds that the international application does not fulfill the applicable requirements, it invites the applicant to make the required corrections within three months from the date of invitation sent by the International Bureau.

International registration has the same effect as a regularly-filed application in all designated Contracting Parties.

# The Hague System Procedure (II)

## Refusal by a designated Contracting Party

on same substantive grounds as for national/regional filings

must be communicated within time limit

effect limited to territory of the member that has refused

## International registration (where not refused)

no refusal = same rights as a local design registration

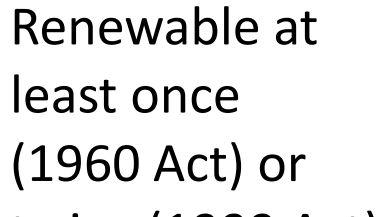

a bundle of independent national/regional rights

advantages of central management

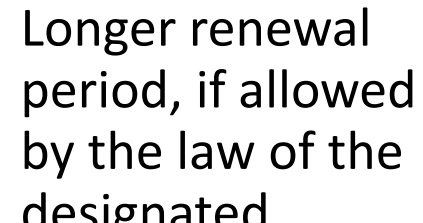

# The Hague System Procedure (III)



Duration of protection:  
five years



Renewable at least once (1960 Act) or twice (1999 Act)



Longer renewal period, if allowed by the law of the designated Contracting Party

# General Advantages of the Hague System



## Hague System (international route)

one Office for filing  
one language  
one currency  
one international registration  
one renewal  
one modification  
foreign attorney or agent  
(first needed if refused)

## National/regional route

many Offices for filing  
many languages  
many currencies  
many registrations  
many renewals  
many modifications  
foreign attorney or agent  
(first needed at filing)



# Key benefits of the Hague System



## Simplicity

The Hague System enables holders to obtain protection for their designs with a minimum of formality



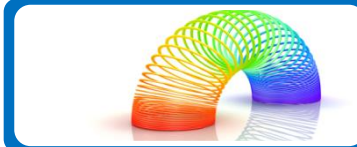
## Cost-effectiveness

Payment of a single set of fees in one currency



## Efficiency

Considerable facilitation of the subsequent management of the registration



## Flexibility

Right holders have more opportunities in targeting national, regional or global markets



# Legal Framework

# Hague Agreement

```
graph TD; A[Hague Agreement] --- B[Hague Act (1960)]; A --- C[Geneva Act (1999)];
```

Hague Act (1960)

Geneva Act (1999)

- **Common Regulations (1996), last revised: January 1, 2017 (in force)**
- **Administrative Instructions (2002), last revised: July 1, 2014**
- **National Laws and Regulations**

# The Hague System is a Procedural Arrangement

Issues such as:



the conditions for protection



the refusal procedure to be applied when deciding whether a design may be protected



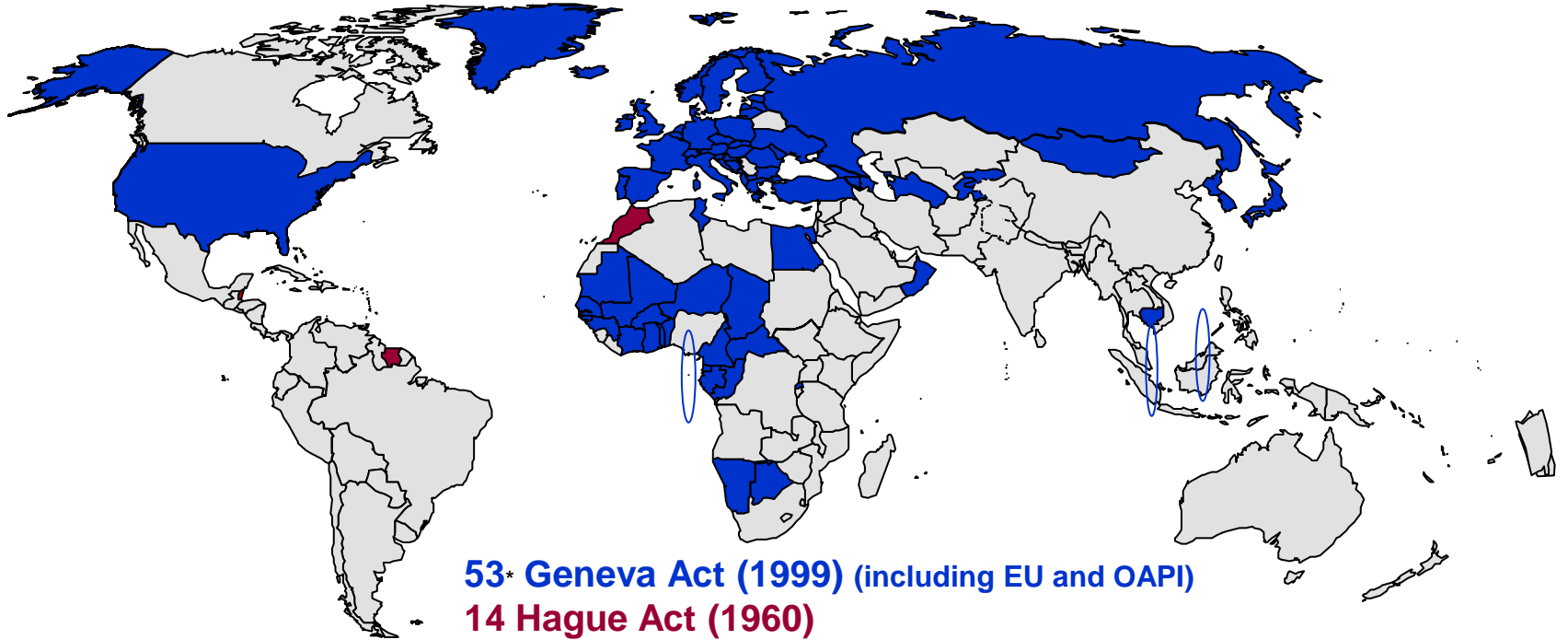
the rights which result from protection

are governed by the law of each Contracting Party designated in an international registration



# Going Global – Geographical Scope of the Hague System

# Hague Union



**53\* Geneva Act (1999) (including EU and OAPI)**

**14 Hague Act (1960)**

**67 Contracting Parties**

\* The Geneva (1999) Act of the Hague Agreement Concerning the International Registration of Industrial Designs will come into force in respect of the Russian Federation on February 28, 2018.

# Hague Union Members according to the most recent applicable Act

## Geneva Act (1999)

- African Intellectual Property Organization, Albania, Armenia, Azerbaijan, Bosnia and Herzegovina, Botswana, Brunei Darussalam, Bulgaria, Cambodia, Croatia, D.P.R. of Korea, Denmark, Egypt, Estonia, European Union, Finland, France, Georgia, Germany, Ghana, Hungary, Iceland, Japan, Kyrgyzstan, Latvia, Liechtenstein, Lithuania, Monaco, Mongolia, Montenegro, Namibia, Norway, Oman, Poland, Republic of Korea, Republic of Moldova, Romania, Russian Federation, Rwanda, Sao Tome and Principe, Serbia, Singapore, Slovenia, Spain, Syrian Arab Republic, Switzerland, Tajikistan, the former Y.R. of Macedonia, Tunisia, Turkey, Turkmenistan, Ukraine and the United States of America (52)

\*

The Geneva (1999) Act of the Hague Agreement Concerning the International Registration of Industrial Designs will come into force in respect of the Russian Federation on February 28, 2018.

## Hague Act (1960)









- Belgium, Belize, Benin, Côte d'Ivoire, Gabon, Greece, Italy, Luxembourg, Mali, Morocco, Netherlands, Niger, Senegal and Suriname (14)

# Geneva Act (1999)

## Recent Accessions

	Russian Federation (November 30, 2017)
	The Kingdom of Cambodia (November 25, 2016)
	D.P.R. of Korea (June 13, 2016)
	United States of America (February 13, 2015)
	Japan (February 13, 2015)
	Republic of Korea (March 31, 2014)

## Potential Accessions

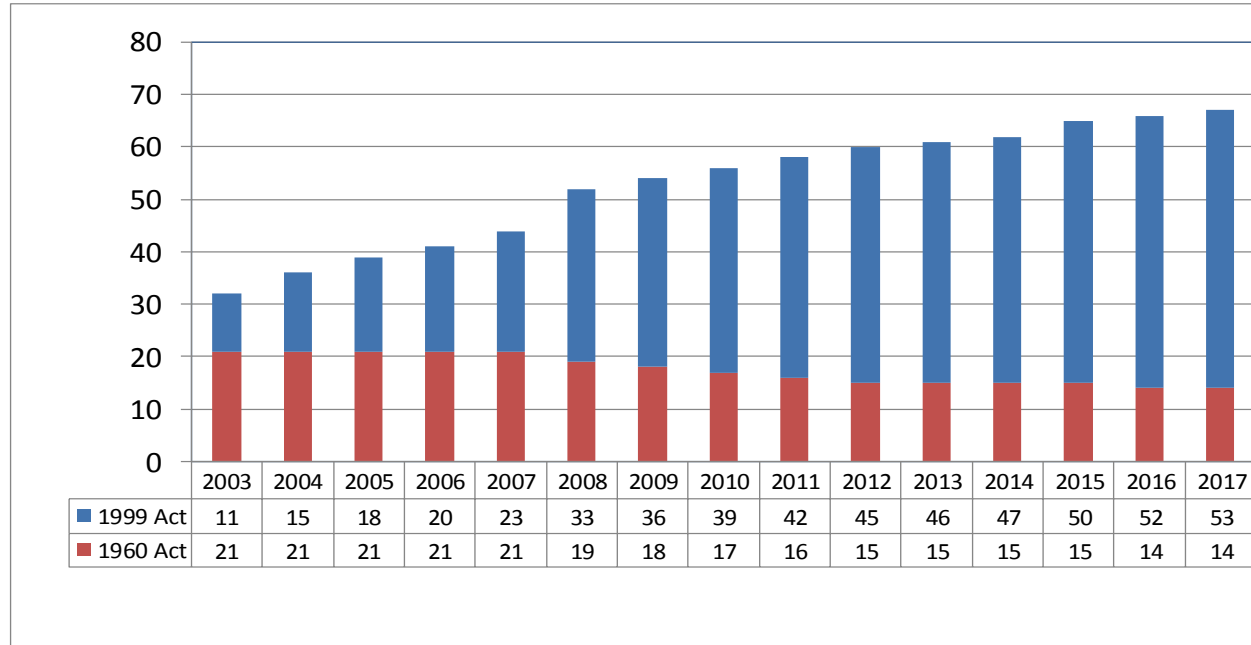
	China
	United Kingdom
	Morocco
	ASEAN countries
	Israel
	Canada
	Mexico
	Madagascar



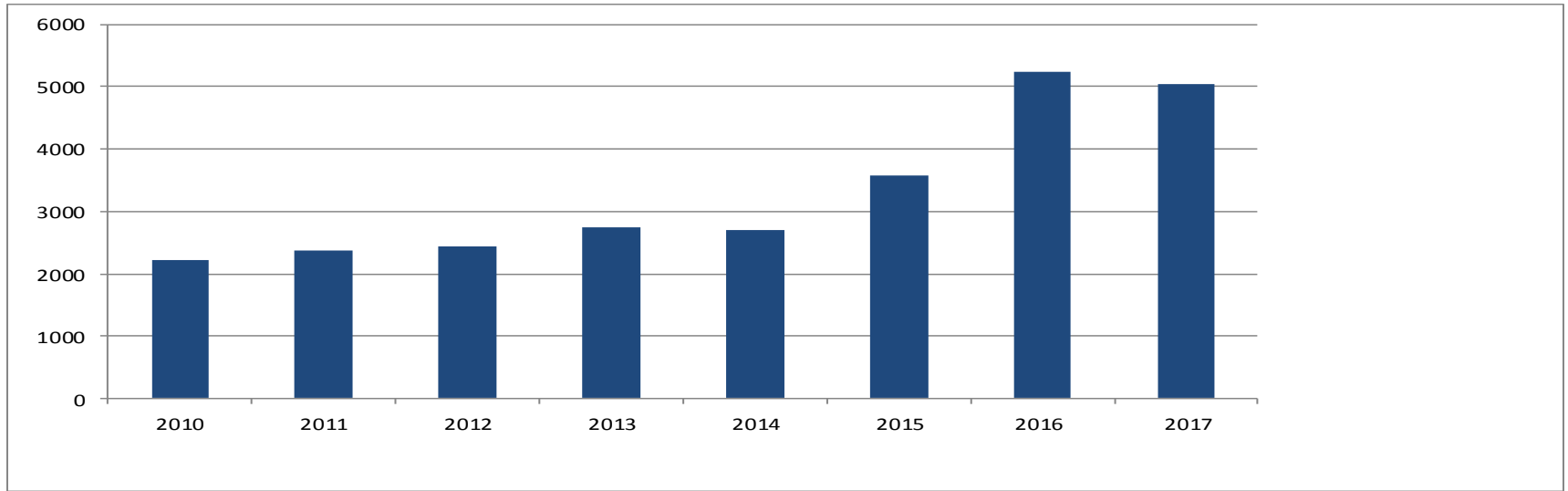


## Some Statistics

# Hague Membership Status as of December 31, 2017 (by most recent Act)



# International Registrations Recorded 2010-2017



International Registrations Recorded

2216      2363      2440      2734      2703      3581      5233      5041

Growth

11.7%      6.6%      3.3%      12.0%      -1.1%      32.5%      46.1%      -3.7%

# International Applications - 2017



5,213 international applications were received containing 19,429 designs (max. 100 designs / application)



6.27 % decrease compared to the respective period in 2016 in the number of applications



3.8% growth compared to the respective period in 2016 in the number of designs

# International Registrations - 2017



5,041 international registrations were inscribed containing 19,241 designs



3.66% decrease compared to the respective period in 2016 in the number of registrations



9.3% increase compared to the respective period in 2016 in the number of designs

# 2017 - Five Most Popular Classes in International Registrations



**Class 14**

**Recording,  
communication or  
information retrieval  
equipment**

**579 registrations (11.5%)**



**Class 12**

**Means of transport or  
hoisting**

**451 registrations (9.0%)**



**Class 6**

**Furnishing**

**368 registrations (7.3%)**



**Class 26**

**Lighting apparatus**

**326 registrations  
(6.5%)**



**Class 10**

**Clocks and watches and  
other measuring  
instruments, checking  
and signaling instruments**

**363 registrations (7.2%)**



# Latest Developments and Upcoming Features

# Latest Developments



Regularization of international applications online  
(since March 2016)



Guidance on reproductions\*



New Hague Express Database since January 2015



Global Design Database launched in 2015



Improvement of E-filing interface



Developments in the legal framework



<http://www.wipo.int/madrid/en/>

[www.wipo.int/hague/en](http://www.wipo.int/hague/en)