



# Overview of the Madrid System

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



Oval Cambodian Blue Sapphire 4X3mm .22ct avg

# Protection options

- Then a choice must be made regarding the best way to protect your trademark abroad:
  - The national route: File trademark application with the Trademark Office of each country in which you want protection
  - The regional route: Apply in countries which are members of a regional trademark registration system with effect in all member states (ARIPO, Benelux Trademark Office, OHIM and OAPI)
  - The international route: File through the Madrid Protocol



# The Madrid Route

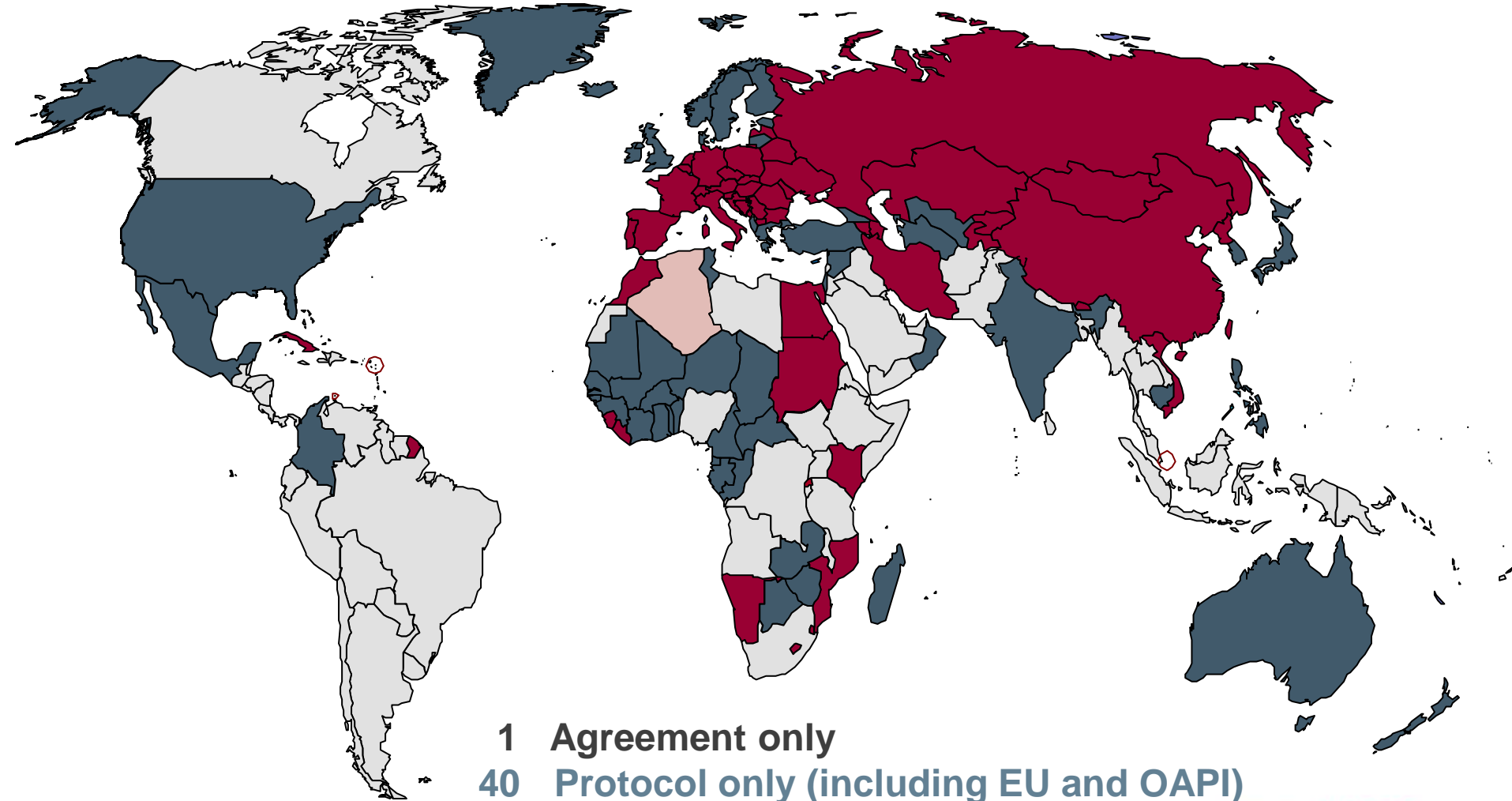
- The international route through the Madrid System may be the preferred option when you:
  - Seek protection in multiple markets, particularly if these are in different regions
  - Want flexibility to add new markets as your export plans develop
  - Have limited budget and/or time to spend on registration and management of your trademarks

# What is the Madrid System?

- A centralized filing and management procedure
- It is convenient:
  - A one-stop shop for trademark holders to obtain and maintain trademark protection in export markets
  - File one application, in one language and pay one set of fees for protection in multiple markets
- It is cost-effective:
  - One international application is equivalent to 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



# Members of the Madrid System



- 1 Agreement only
- 40 Protocol only (including EU and OAPI)
- 54 Agreement and Protocol
- 95 Members covering 111 countries

# Accessions

- 2012: Colombia, Mexico, New Zealand and Philippines
- 2013: India, Rwanda and Tunisia
- 2014: OAPI and Zimbabwe
- 2015: Cambodia
  
- Future accessions:
  - ASEAN countries by 2015
  - Canada
  - Caribbean countries
  - African countries
  - Latin American countries?

# Key features of the Madrid System

- Entitlement and basic mark (application or registration)
- One registration covering multiple territories
- Fixed time limit for refusal – 12 or 18 months
- WIPO examines only for formalities
- Expand protection to new export markets
- Tailor the list of goods and services for the different markets
- Centralized management of portfolio



# How the Madrid System works

## The International Trademark Registration Process



Video:



# Costs

- Fees payable to WIPO in Swiss francs
- Basic fee\* includes 3 classes of goods/services
  - 653 Swiss francs - b/w reproduction of mark
  - 903 Swiss francs - color reproduction of mark
- Fees for designating CPs:
  - Standard fees: Complementary (100 Swiss francs per DCP and supplementary (100 Swiss francs per class beyond 3)

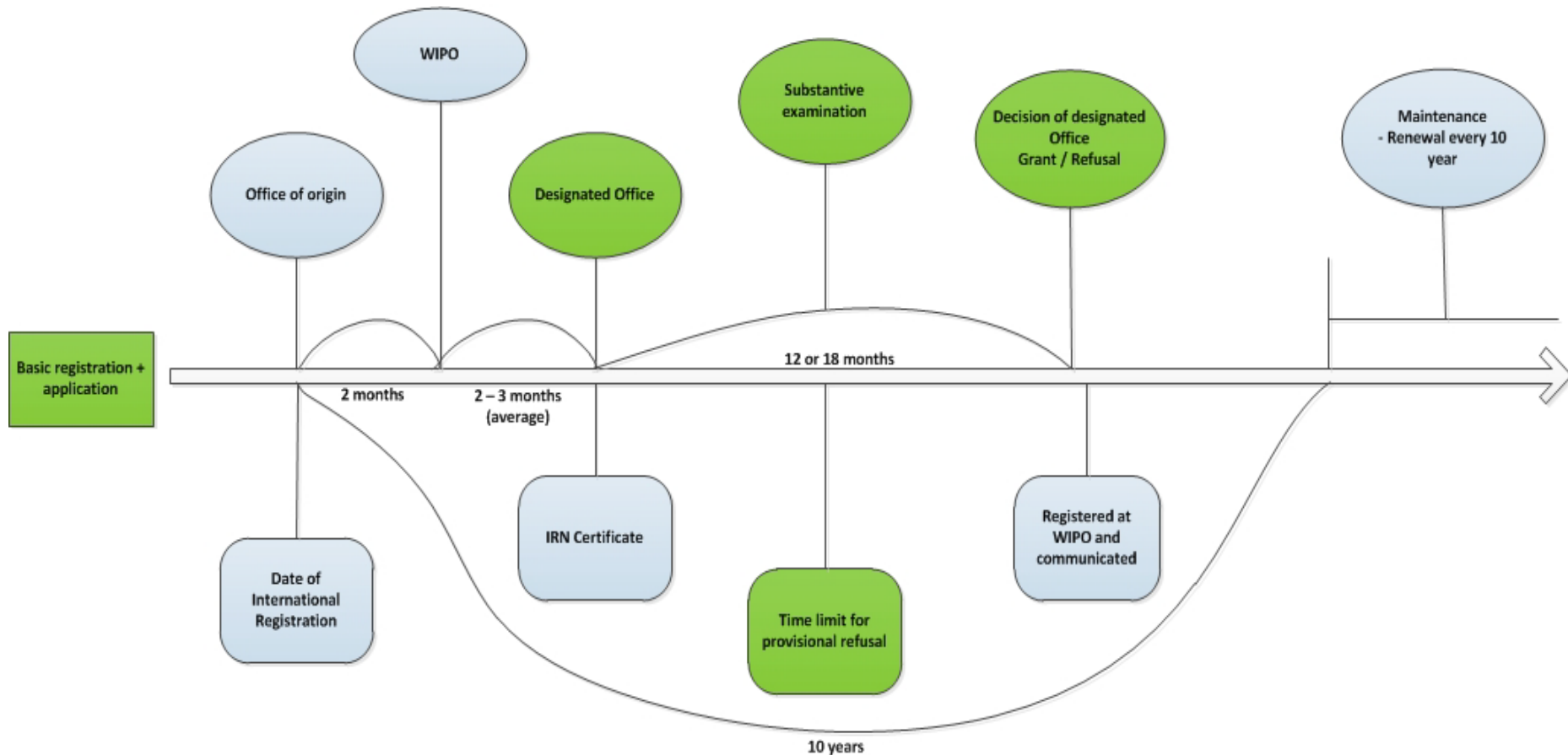
OR

  - Individual fees where this is declared

\* Applicants from Least Developed Countries pay only 10% of the basic fee

# Timeline

## The International Trademark Registration Process



# WIPO Resources and E-Services (1)

- Visit the Madrid Website [www.wipo.int/madrid/en](http://www.wipo.int/madrid/en)
- The Madrid Website provides resources and E-Services to assist you to [search before filing](#), [file an application](#) and to monitor and [manage your registration](#)
- In summary, these resources include...

# WIPO Resources and E-Services (2)

## SEARCH

[ROMARIN](#) – database of international registrations

[Member Procedures](#)

[Global Brand Database](#) – search marks by text and image from national/international sources, including trademarks, appellations of origin and official emblems (over 17,880,000 records)

## MONITOR

[Madrid Real-Time Status](#) of international applications and progress of requests being processed by WIPO

[Madrid Electronic Alert](#) monitor changes to international registrations (third party tool)

## FILE

[Forms and E-Forms](#)

[Madrid Goods & Services Manager](#) – correct good & service specifications and translation

[International Application Simulator](#)

[Fee Calculator](#)

[E-Payment](#) – online payment system by credit card/[WIPO current account](#)

## MANAGE

[Madrid Portfolio Manager](#) access registration documents, uploading of requests for recording, payments

[Forms and E-Forms](#) – [E-Subsequent Designation](#) and [E-Renewal](#)

[Translation request](#) into official Madrid working languages

[Extracts](#) from the International Register

# WIPO Resources and E-Services (3)

## CONSULT

[E-Services overview and tutorials](#)

[Legal texts](#) – Agreement/Protocol, Regulations, Administrative Instructions

[Declarations made under the Madrid Agreement and the Madrid Protocol](#)

[Guide to the International Registration of Marks](#)

[WIPO Gazette of International Marks](#)

[Office practices on replacement](#)

[Statistics](#)

[Making the Most of the Madrid System](#)  
– Web publications

[Warning](#) – misleading invoices

## UPDATES

[Information Notices](#)

[Madrid Highlights](#) – quarterly newsletter for Madrid System users

[Subscribe](#) to receive news and updates on the Madrid System by e-mail



# General profile 2014

## 42,430 International Registrations

Average Number of Designations	6,89
Average Number of Classes	2,52
Average Fee	3,102 CHF
All Fees	70% < 3,000 CHF

# The use of the Madrid System in 2014

- A total of 47,885 international applications received
- At the end of 2014
  - 594,477 international registrations in force
  - Containing 5 615,723 million designations in force
  - Involving 198,027 holders

# Top Offices of origin (OO)

<b>Contracting Parties</b>	<b>2012</b>	<b>2013</b>	<b>2014</b>
European Union	6,256	6,814	6,996
United States of America	5,073	5,893	5,414
Germany	4,553	4,357	3,883
France	3,639	3,514	3,377
Switzerland	2,720	2,885	2,994
Italy	2,332	2,118	2,070
Benelux	1,774	1,784	1,838
China	1,799	2,455	1,738
Japan	1,898	1,855	1,729
United Kingdom	1,274	1,580	1,560

# Top designated Contracting Parties (dCP)

<b>Contracting Parties</b>	<b>2012</b>	<b>2013</b>	<b>2014</b>
China	20,120	20,275	20,309
European Union	16,889	17,598	17,270
United States of America	16,411	17,322	17,268
Russian Federation	16,634	18,239	16,573
Japan	12,493	13,179	12,814
Switzerland	13,464	13,215	12,759
Australia	10,753	11,675	11,533
Republic of Korea	10,090	10,967	10,402
Turkey	9,656	9,838	9,513
Mexico	-	5,095	8,533

# Benefits for trademark owners

- Simple and economical procedure
  - A single set of simple formalities
  - A single filing Office
  - Low registration fees
  - No need to pay foreign agents for filings
  - No need to pay translation of the paperwork into several languages
- Effective procedure
  - A single international application produces the same legal effect in various countries
  - A fixed deadline for the confirmation or refusal of the legal effects in each designated country

# Benefits for the Office and Government

- Simplified examination
  - The designated Office can focus on substantive examination as WIPO examines for formalities
- The Madrid System has a positive effect on economic growth
- It empowers SMEs
- It promotes international trade by contributing to the opening of new markets and assisting in development of export
- It creates a more favorable climate for foreign investment in the internal market



# Benefits for local agents

- The Madrid Protocol is optional and it does not replace the direct filing route
- Applicants would need the services of local agents at filing stage or at post-registration stage
- Increased designations will create more business opportunities (substantive work), like searches, refusals, oppositions, request for cancellations, dispute settlements, license and assignments contracts, and enforcement
- Post-registration activity may compensate for any reduction in local filing activity
- Expanding of services?



Thank you  
for your attention

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