How to internationally protect your trade mark through the Madrid system?
Welcome to the Webinar

Moderator:

Marta Bettinazzi
IP Business Advisor
South-East Asia IPR SME Helpdesk
Webinar Interaction Tool

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## Overview (CEST)

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<td>10:00 – 10:05</td>
<td>Introduction to the International IPR SME Helpdesks &amp; their Core Services</td>
<td>Marta Bettinazzi, SEA IPR SME Helpdesk</td>
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<td>10:05 – 10:45</td>
<td>How to internationally protect your trade mark through the Madrid System?</td>
<td>Elio De Tullio, IP Expert</td>
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<td>10:45 – 10:55</td>
<td>Q&amp;A session</td>
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Core Services – What We Offer

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Elio De Tullio is an Italian lawyer admitted at the bar of Bari and trade mark attorney. After 10 years of experience in IP matters, he founded in 2005 the law firm De Tullio & Partners, with offices in Rome and Bari and a liaison office in New York. Managing Partner of De Tullio & Partners, he acts as trade mark attorney in the strategic assessment of IP protection and in prosecution and opposition processes at domestic and international level.

He is also a litigation lawyer before the Italian Courts specialized in Intellectual Property. He specializes on trade mark, design and patent issues, from a strategy, business intelligence, competition, filing and prosecution perspective. He has written some articles on Italian and European law on intellectual property rights which have been translated into Chinese and South-East Asia languages.
Agenda

• The importance of trade mark protection

• The international trade mark: protection through the Madrid System

• SMEs: a successful case study

• Take-away messages
Poll Question 1

Question: How many of you are using the Madrid System to protect your own trade mark?

A. The majority of you
B. Few of you: other protection systems are preferred
C. No registration at all is the most widespread strategy
Key numbers for 2019

66,400 (+5.7%)
Madrid international applications

433,295 (-3.2%)
Designations in international applications

64,118 (+6.7%)
Madrid international registrations

57,041 (+3.3%)
Subsequent designations in international registrations

29,262 (-9%)
Renewals of international registrations

741,619 (+4.6%)
Active (in force) international registrations

6,208,277 (+3.3%)
Designations in active international registrations

106 (+3 members)
Contracting Parties (Madrid members)

122 (+3 countries)
Countries covered
4. Top eight Nice classes specified in 2019 Madrid applications, 1990 and 2019


International applications filed under the Madrid System

Who filed the most Madrid trademark applications in 2019?

Total number of applications 64,400 ▲ 5.7%

Top 10 Madrid applicants

<table>
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<th>Rank</th>
<th>Number of Madrid applications</th>
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<td>9</td>
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<tr>
<td>10</td>
<td>69</td>
</tr>
</tbody>
</table>


Top 10 countries
Number of Madrid applications and percent growth since 2018

10,087
U.S.
14.3%

7,700
Germany
2.1%

6,339
China
1.1%

4,437
France
-1.8%

3,729
Switzerland
10.2%

3,460
U.K.
3.2%

3,160
Japan
-1.1%

2,649
Italy
-16.0%

2,094
Australia
2.4%

1,980
Turkey
37.8%

Poll Question 2

Question: Do you consider the Madrid system the best solution for companies that operate globally?

A. Yes, it is the best solution as it is a costly-efficient system
B. It depends on the mark and the countries of interest
C. No, the Madrid system procedure involves high risks
What is a trade mark?

- A trade mark is a sign that is capable of distinguishing the goods or services of one undertaking from those of others.

- In general, it is possible to register as a trade mark:
  - **word marks** consist exclusively of words, letters, numerals and other standard typographic characters;
  - **figurative marks** consist exclusively of figurative elements;
  - **figurative marks containing word elements** are signs with a combination of verbal and figurative elements;
  - **shape marks** consist of a three-dimensional shape;
  - **shape marks containing word elements** are shape marks containing verbal elements;
  - **position marks** protect the specific way in which the mark is placed on or affixed to the product;
  - **pattern marks** are signs where a set of elements are regularly repeated.
... what more?

• Some trade mark systems grant protection to ‘non-traditional’ trade marks. This special category includes marks that differ from the usual concepts, such as (i) colours, (ii) motions, (iii) sounds, (iv) scents and (v) holograms.

• Although non-traditional marks exist across the world, not all countries allow them to be registered.

• The protection of non-traditional marks is particularly difficult due to the lack of widespread uniform standards
The benefits of protecting a trade mark:

- Trade marks are **valuable assets**: they are property assets that can be bought, sold and licensed. Therefore, trade mark protection enables companies to access new markets through licensing, franchising and other contractual arrangements developing overseas manufacturing, marketing and distribution.

- **Protect brand value**: build your business value and reputation

- Trade marks make it **easier for your consumers to find you**

- **Prevent counterfeiting and fraud**
The first step: Check your trade mark availability

• Before filing a trade mark application, it is essential to carry out searches to check if identical or similar marks are already registered in the market of interest.

• Prior availability searches help you to:
  ✓ avoid refusals issued by the IP offices of the countries in which protection is sought
  ✓ reduce the risk of conflicts with third party owners of prior rights (administrative opposition proceedings or legal actions)
  ✓ avoid additional costs related to administrative or legal proceedings.
How to check your trade mark availability:

- The World Intellectual Property Organization (WIPO) and national/regional IP offices make trade mark databases available.

- **WIPO’s Global Brand Database** ([https://www3.wipo.int/branddb/en/]()) is an aggregate search portal; it enables applicants to search for trade marks previously registered under the Madrid system and it also includes many national trade marks. However, don’t forget to check [online database of national/regional IP offices]: the WIPO’s Global Brand Databases does not include national trade marks filed directly with some of the contracting parties.

- Other aggregate search portals are [TMview](https://www.tmdn.org/) and [ASEAN TMview](http://www.asean-tmview.org).
What is the Madrid System?

• The “Madrid system for the international registration of trademarks” is a cost-effective solution for registering trade marks worldwide, in the territories of the contracting parties to the Madrid Agreement and Protocol (the so called Madrid Union”).

• As of today, 122 Countries are members of the Madrid Union (a list thereof is available at WIPO’s official website).

• The system is administered by the International Bureau of the WIPO and allows trade mark owners to protect their marks in several countries by filing one application and obtaining an international registration that takes effect in each of the designated contracting parties. Moreover, through the filing of Subsequent Designations it is possible to add new territories to an international registration that has already been granted.
How does the Madrid System work?

1. **Applicant**
   - Application based on a basic mark

2. **Office of Origin**
   - Certification of the international application and filing with WIPO

3. **WIPO**
   - Formal examination of the international application

4. **IP Offices of designated Contracting Parties**
   - Substantial examination and final decision on the registration in the territory of the designated Contracting Party
The process:

• Main steps of the process:

1. Application filing through a national or regional IP office (Office of Origin)
2. Formal examination of the international application by the WIPO
3. Substantive examination by the IP office of the designated contracting party and final decision
1. Application

• The applicant needs to have already registered the mark, or have filed an application, with the IP Office of Origin. Such trade mark is known as the ‘basic mark’.

• The international application must be submitted through the IP Office of Origin, which will certify it and forward it to WIPO.

• The applicant should classify the list of goods and services in accordance with the International Classification of Goods and Services established by the Nice Agreement (1957) and according to the classification of the basic mark.

• However, don’t forget to check the sub-classification system of goods and services applicable in some countries.
1. Application costs:

• The costs of an international application can be easily estimated through the WIPO Madrid Fee Calculator (https://www.wipo.int/madrid/feescalculator/).

• Generally, the costs include:
  i. a basic fee;
  ii. a ‘complementary fee’ or ‘individual fee’ for each designated contracting party;
  iii. a supplementary fee for additional classes of goods and services (where required).

• Some contracting parties require also the payment of a ‘second part fee’ after the registration of the trade mark in the country (such as Japan, Brazil and Cuba).
2. Formal Examination:

• Once the international application has been submitted, WIPO conducts a formal examination to verify that it complies with the requirements of the Madrid Agreement and Protocol, and their common regulations.

• In the absence of formal irregularities, WIPO registers the mark in the International Register and publishes the international registration in the WIPO Gazette of International Marks.

• A certificate of the international registration is issued by WIPO and a notification is filed to the IP offices of the designated contracting parties.
3. Substantive Examination and Final Decision:

• The IP offices of the designated contracting parties proceed with the substantial examination of the international registration according to the applicable national legislation and issue a decision within the applicable time limit (12 or 18 months from the date of notification by the WIPO).

• The designated IP office can provisionally refuse, totally or partially, the protection of the mark due to nonconformity with national laws or on account of existing prior rights of third parties.

• The applicant can reply to the provisional refusal and this procedure is completely carried out by the competent IP office of the contracting party concerned. The International Bureau is informed about the final decision.
If there is no refusal within the applicable time limit, the protection of the trade mark in each designated contracting party is granted and the international trade mark has the same protection as a national trade mark in each country.

**The protection of the IR lasts 10 years** from the filing date and it is indefinitely renewable directly through the WIPO with the payment of the required renewal fees.

It is possible to file **Subsequent Designations** connected to an international registration that has already been granted.

**What to bear in mind:** for a period of **five years** from the date of the registration, the international registration remains dependent on the basic mark!
Advantages of the Madrid System:

- **Centralized filing**: a single application in one language (English, French or Spanish) through the payment of one set of fees (in Swiss francs), rather than filing different applications in each country where protection is sought.

- **Cost-effective**: the trade mark owner can avoid all the translation- and exchange-related expenses involved in the different national and regional procedures that are conducted in various languages and require fees to be paid in different currencies.

- **One deadline for all the designated countries**. In addition, a single renewal application will be effective in all the designated countries.
Advantages of the Madrid System:

- Once the international trade mark has been granted, it is possible to record a change of name or address through one application, which can be extended to all the designated countries.

- National IP offices do not need to carry out a formal examination or publish the mark.
... Any disadvantages?

- An international registration can only include the classes of goods and services claimed in the basic mark. In some places (such as Mainland China and Thailand) there is a **sub-classification system**. This aspect can make the registration process longer than usual because international registration applications can be refused due to nonconformity with the list of goods and services.

- The Madrid system is a good choice if the identification of goods and services for which protection is sought is **brief and uncomplicated**, as there is lower risks to encounter any issues when it’s extended into other jurisdictions. Differently, when the identification of goods and services is more detailed and complicated, the Madrid system may not be the best option.
... Any disadvantages?

- International trade marks’ applicants need to **be aware of local issues** (such as administrative problems in Indonesia and inconsistency in Thailand) that could affect the protection of the mark. It is recommended to develop an international filing strategy and discuss it in advance with the EU legal counsel and the relevant foreign agents.

- If, within five years of the international registration, the basic mark is amended or revoked in the country of origin due to prior third-party rights, or following a declaration of invalidity, or an office action, the international registration will also be consequently amended or cancelled.
A successful case study:

- Since 1988, an Italian food company has used the Madrid system to register its marks almost everywhere in the world (including Mainland China, Cuba, Laos, Cambodia, and Vietnam). During these years, the company has implemented the protection of its trade marks by filing several Subsequent Designations with contracting parties that have joined the Madrid system.

- **Action taken:** The above described filing activities allow the company to have a registered trade mark to enforce if it detects illicit or unauthorized uses of its IP rights. When a potential infringement is detected, the company may react appropriately.
A successful case study:

• **Outcome:** The ownership of several international registrations, effective almost worldwide, allows the company to promptly react to infringements using a cost-effective IP strategy. Thanks to the marks protected through the Madrid system in Mainland China, for example, it was possible to stop several infringements and to oppose the registration of confusingly similar marks in this country.

• **Lessons learnt:** The ownership of an international registration allows companies to fight illicit conducts and possible infringements as well as to maintain their competitive position in the market, even in those countries that are culturally and geographically distant and apparently unsafe.
• Start protecting your mark **before entering in the market**
• **Develop a strategy** for your trade mark protection
• Carry out **preliminary searches** at worldwide level
• **Take care of your first filing**, even the national one
• **Monitor markets and competitors’ behaviors**
• Activate, through your IP attorney, a **worldwide surveillance system**
• **Monitor IP gazettes and legal actions**
• **Manage your entire portfolio of international trade marks**: modify, expand the geographical coverage, transfer or renew your registration.
COVID-19 Update: Madrid System

May 15, 2020

Originally published March 25, 2020 (edits have been made since)

The World Intellectual Property Organization (WIPO) is continuing operations under the Madrid System for the International Registration of Marks. We are committed to ensuring that any transitional issues experienced by users, intellectual property (IP) offices and any other stakeholders in our processes are kept to a minimum despite these extenuating circumstances. You can monitor WIPO’s operations during the COVID-19 pandemic using the Organization’s online dashboard.

Find out more: WIPO news on COVID-19.

We are mindful that possible disruptions might affect users of the Madrid System due to measures taken against the COVID-19 outbreak. Consequently, we have compiled all relevant information for Madrid users on this page, which will be updated as instructions become available.
## COVID-19 IP Policy Tracker

The WIPO COVID-19 IP Policy Tracker provides information on measures adopted by IP offices in response to the COVID-19 pandemic, such as the extension of deadlines. In addition, the policy tracker provides information on legislative and regulatory measures for access and voluntary actions.

**NOTE:** The tracker relies on contributions made by IP Offices, Member States and other entities. The tracker does not reflect an exhaustive list of all actions taken regarding COVID-19. It might not fully reflect the IP measures taken by countries and organizations in response to COVID-19. WIPO does not assume responsibility for the accuracy or completeness of the information.

### IPO Operations

This table provides a brief overview of operational changes and measures taken by national and regional IP offices. Further detailed information is provided by country or office, or by clicking the view more link in each row.

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Thanks for your attention

Questions?
Check-out brand new Madrid System Guide developed by the International IPR SME Helpdesks

# SEA Helpdesk – Upcoming Webinars

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<td>Thu 23 July</td>
<td><strong>Fintech Trends in South-East Asia: What To Watch Out For</strong></td>
<td>Jonas Lindsay Msci, Marks &amp; Clerk Singapore LLP</td>
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Thank You For Your Attention
Let’s Stay Connected!

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