



WIPO | MADRID

The International
Trademark System

Overview of the Madrid System

Roving Seminar on WIPO Services and Initiatives

organized

by the World Intellectual Property Organization

in cooperation with

the Finnish Patent and Registration Office

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Outline

- The Madrid System: key benefits
- Geographical Scope and Accession Outlook
- Users of the System
- How the System Works
- Website and Online Services
- Use of the System
- Recent Developments
- Legal Developments
- Focus: Classification Guidelines, WIPO Current Account, Payments, Contact Madrid
- Keep Updated on the Madrid System

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

**SUP
ERC
ELL**

TM/1204607
Supercell

posti

TM/1273154
Posti Group

ANGRY BIRDS

TM/1034096
Rovio Entertainment



TM/1023384
Metsä Tissue



TM/1009997
Saunalahti Group

HALTI 

TM/676765
Halti Technologies



TM/1428297
Nokia Technologies

trademark system

LOOKBOOK BY LUMENE

TM/1046946
Lumene

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

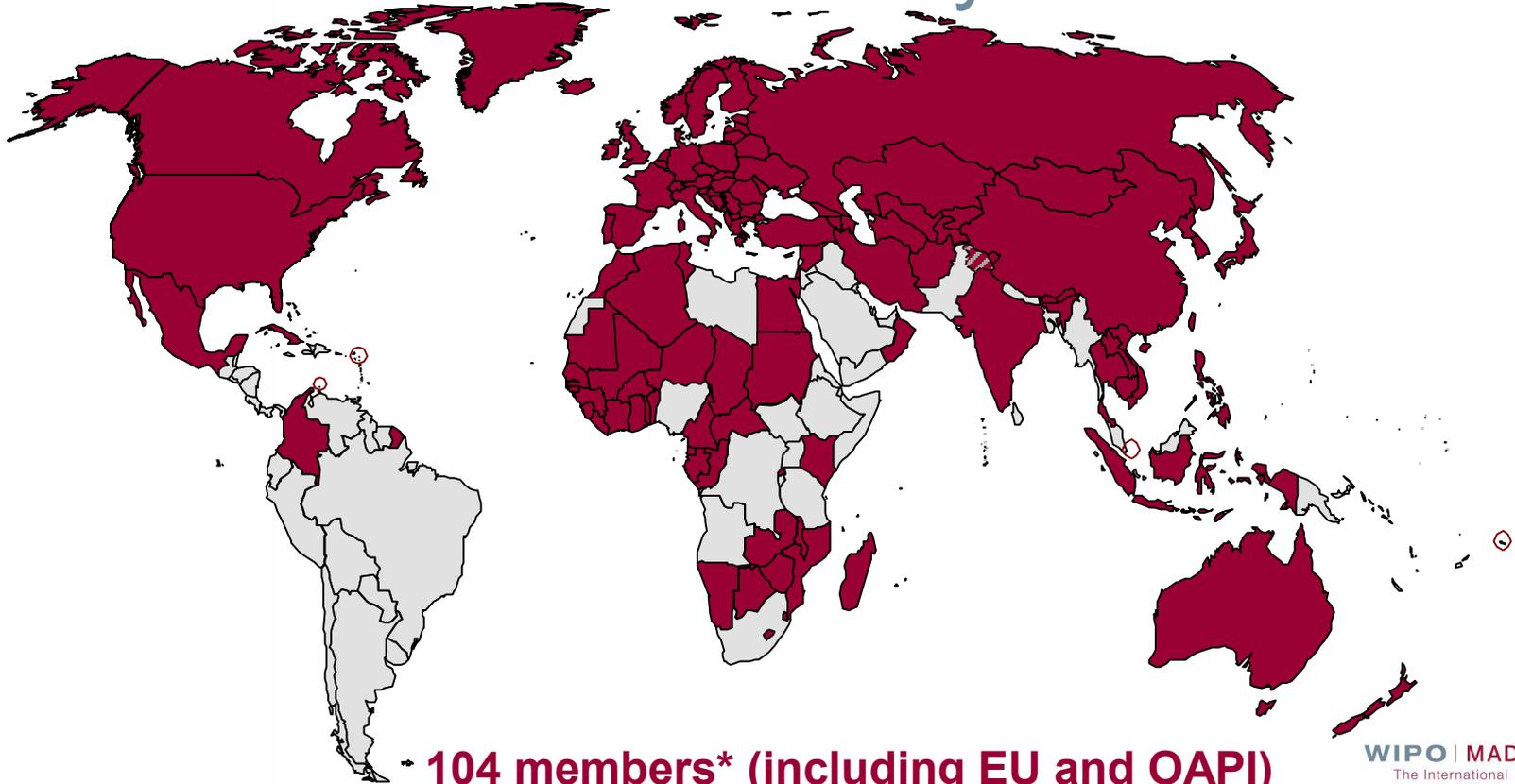
The international route through the Madrid System may be the preferred option when you:

- 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 Global

- Currently: 120 countries covered by the 104 members
- Markets cover more than 70% of the world population
- Recent accessions include:
 - 2017: Thailand, Indonesia
 - 2018: Afghanistan, Malawi, Samoa
 - 2019: Canada

Members of the Madrid System

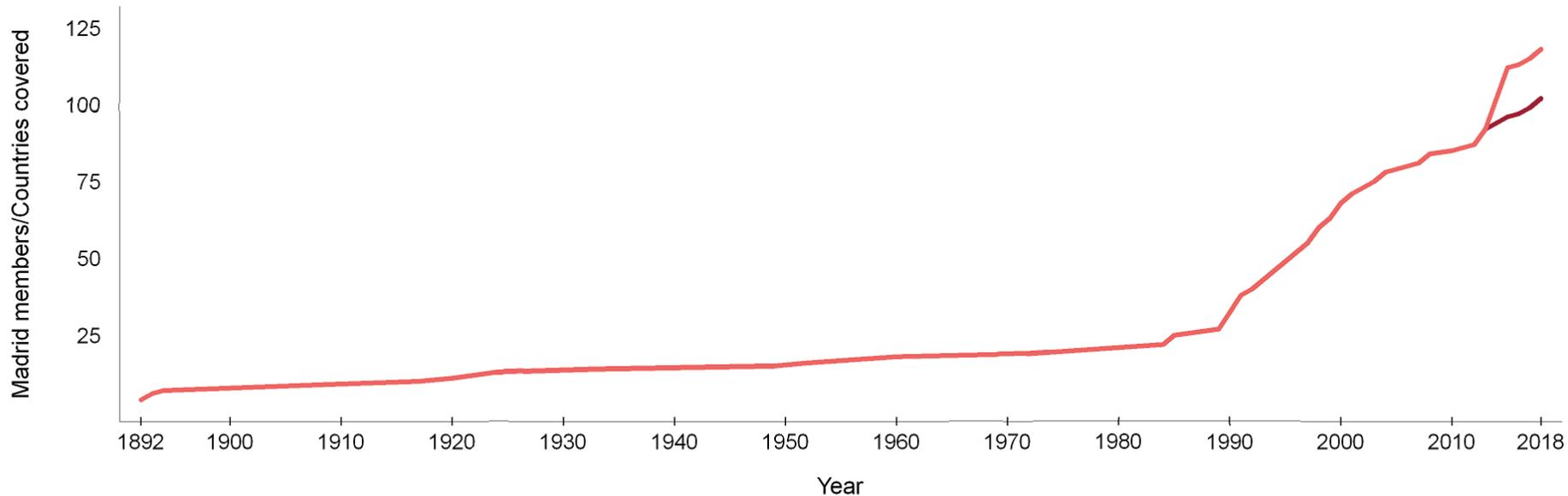


104 members* (including EU and OAPI)
covering 120 countries

WIPO | MADRID
The International
Trademark System

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

Madrid Members Growth Trend



■ TOTAL MADRID MEMBERS ■ TOTAL COUNTRIES COVERED

Accession Outlook – 2019/20

- **Africa:** South Africa
- **Arab region:** Jordan, United Arab Emirates, Qatar.
- **Asia:** Malaysia, Bangladesh, Pakistan, Papua New Guinea, Sri Lanka
- **Europe:** Malta
- **Latin America and the Caribbean:** Brazil, Chile, Trinidad and Tobago

Legal Framework

- Madrid Agreement (1891) – *no longer in “operations”*
- 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/memberprofiles/#/>

Madrid System Users: Business Sectors

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



(IMAGE: GETTYIMAGES/BUBAONE)

Top Five Classes (2018)

Number of classes specified in international applications and share of total

15,033

Computers and electronics



10.1%

11,892

Services for business



8.0%

9,887

Technological services



6.7%

7,065

Leisure, education and training services



4.8%

6,315

Clothing



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



**Individual
Entrepreneurs**



**Small & Medium
Businesses**



**Large
Businesses**

Top 10 Applicants (2018)

Number of Madrid applications

174



Novartis AG

169



L'Oréal

129



Daimler AG

87



Apple Inc.

86



Henkel AG

84



Richter
Gedeon Nyrt.

79



Shiseido
Company

75



Nintendo Co.

73



Samsung
Electronics

68



Brillux GmbH

Close to 1.5 Million International Registrations



- This LONGINES mark is the oldest trademark still in effect
- Registered in Switzerland in 1889, internationally in **1893**



- BODYJAMA is international trademark registration 1.4 million
- Registered in France in 2017, internationally in **2018**

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*

- 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)

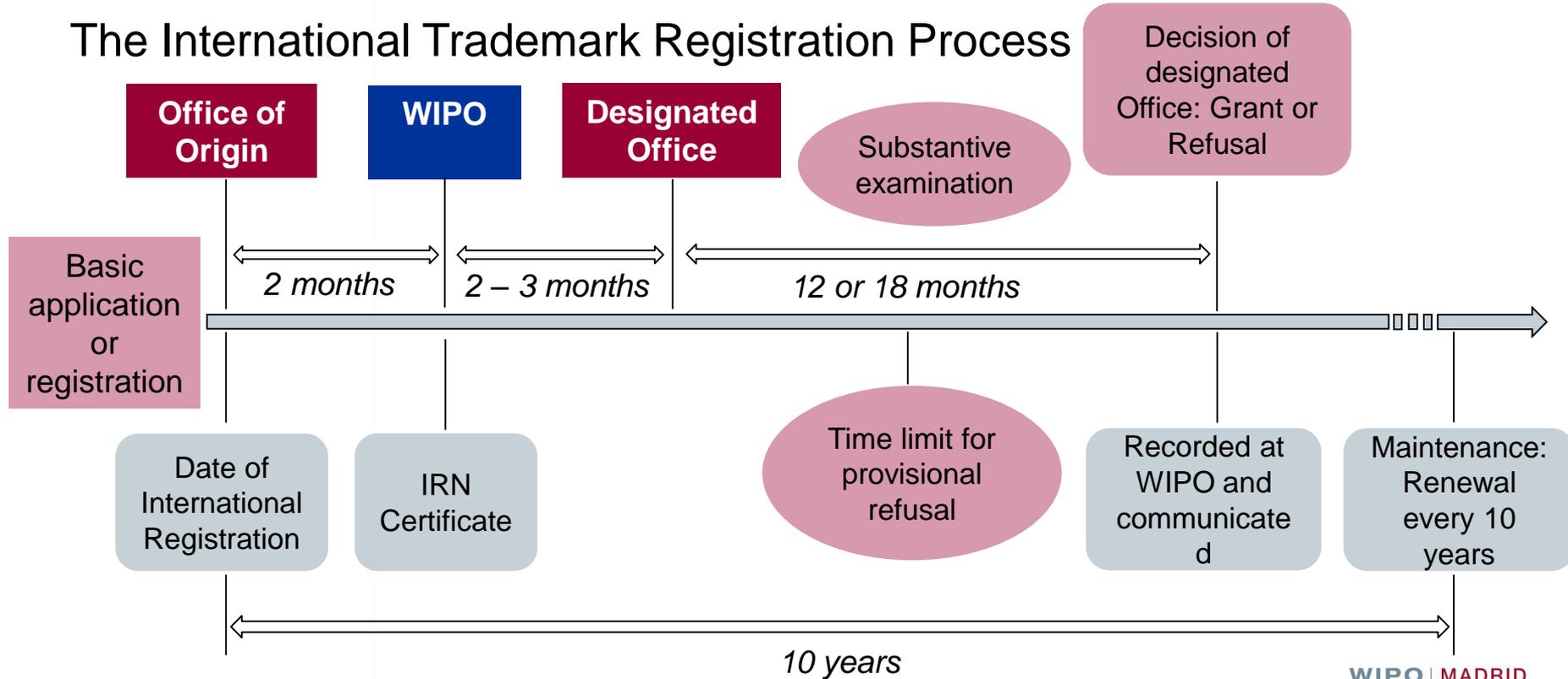
OR

- Individual fees where this is declared

* Applicants from [Least Developed Countries](#) benefit from a 90% reduction in the basic fee

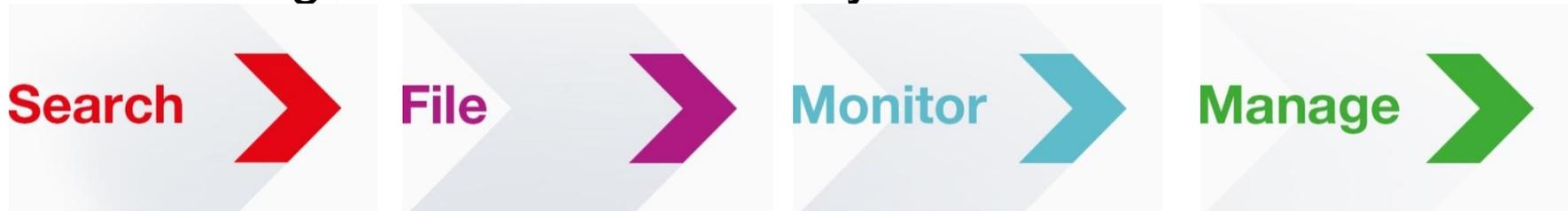
Timeline

The International Trademark Registration Process



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



Search 

Global Brand Database

- search existing marks from national & international sources
- trademarks, appellations of origin and official emblems

File 

Madrid Goods & Services Manager

- compile a list of approved goods & services terms in 20 languages

Member Profiles Database

Fee Calculator

Monitor 

Madrid Monitor

- track real-time status of registration
- watch competitors' marks
- e-alerts
- consult the WIPO Gazette

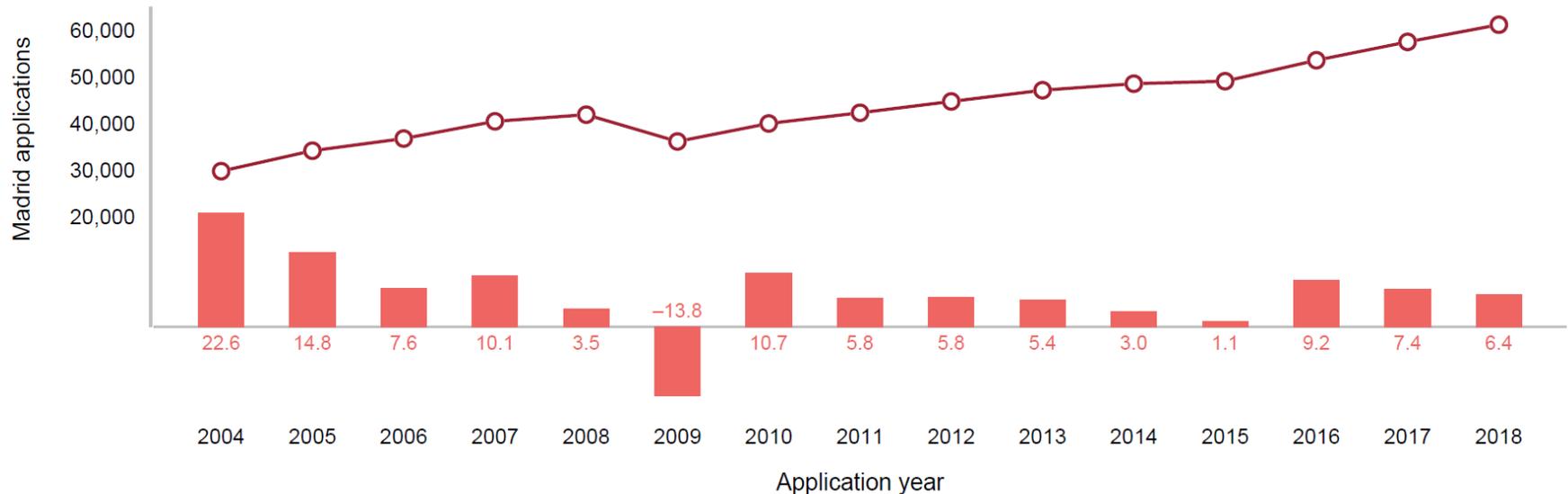
Manage 

Madrid Portfolio Manager

- access documents
- request changes
- modify, designate & renew
- pay fees
- obtain extracts

International Applications

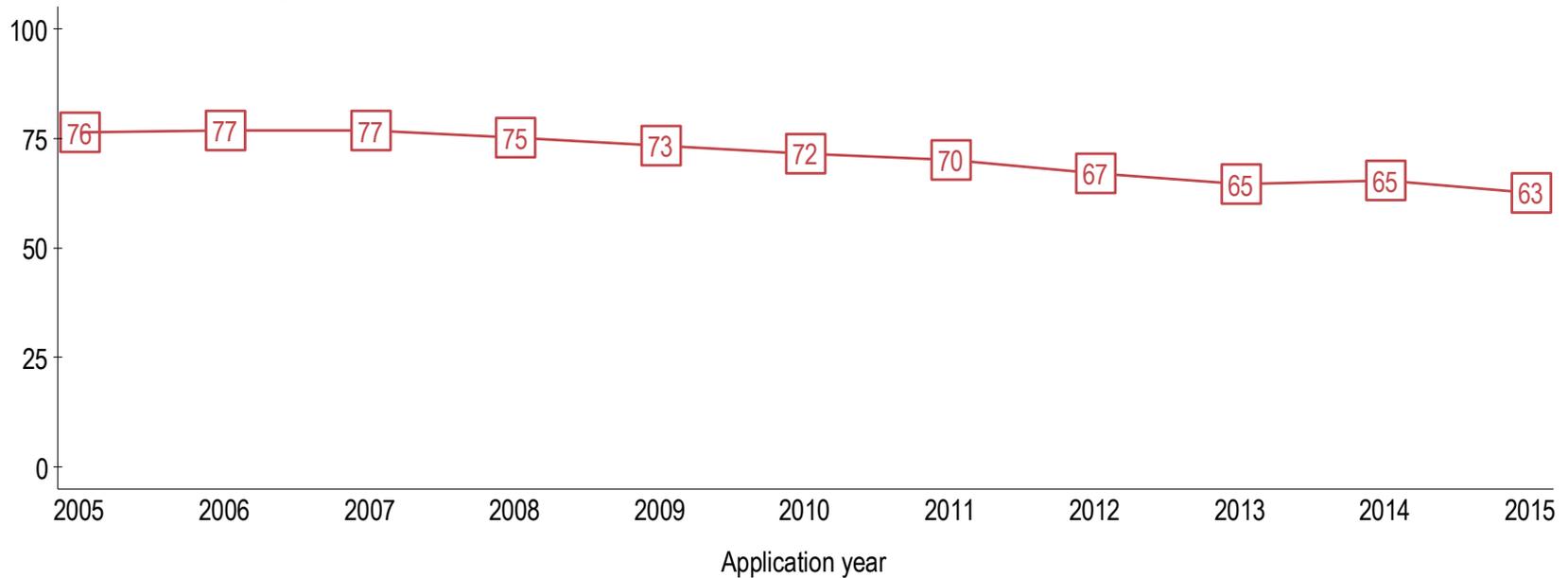
Figure A.1.1 Trend in international applications (2004-2018)



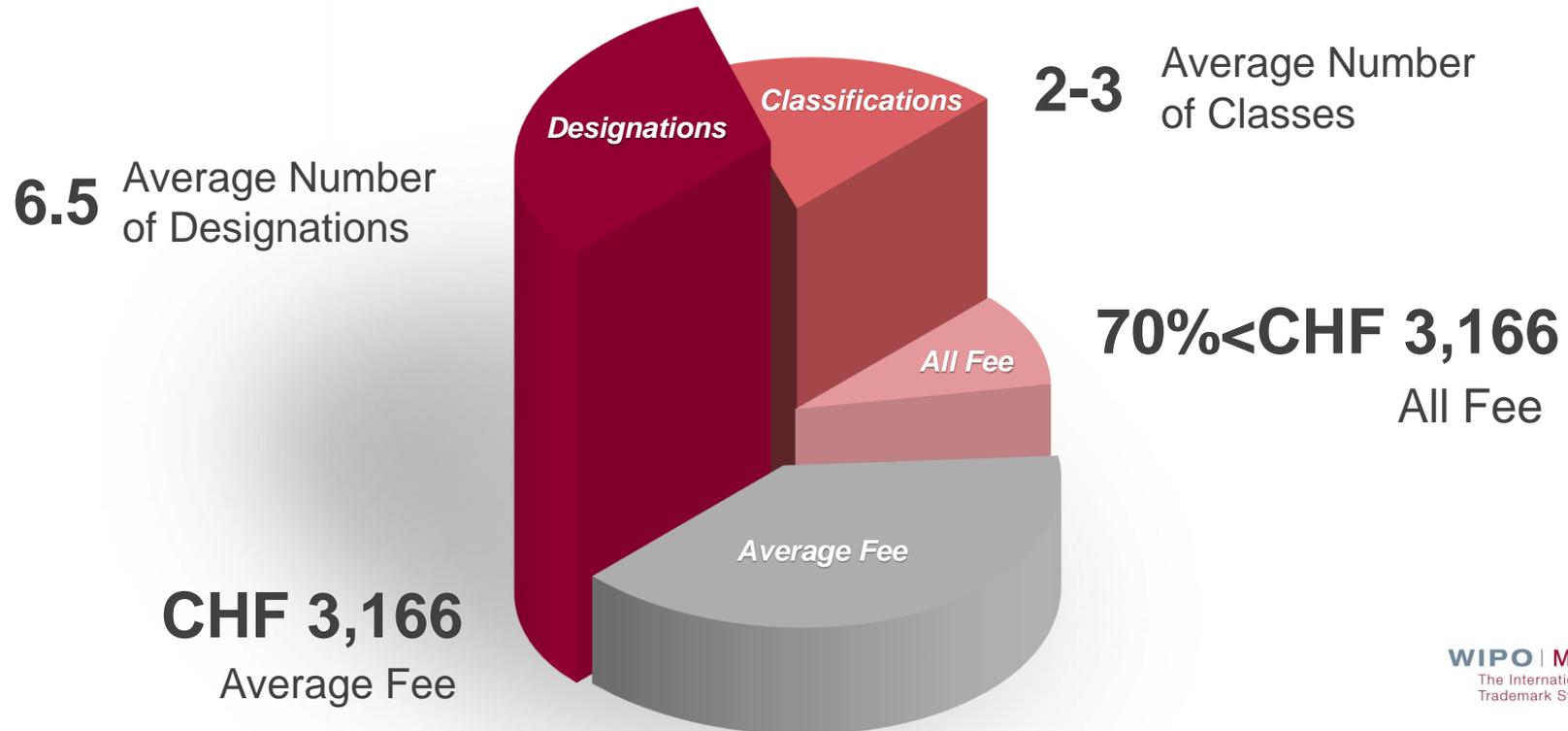
■ MADRID APPLICATIONS ■ GROWTH RATE (%)

Market Share (2005-2015)

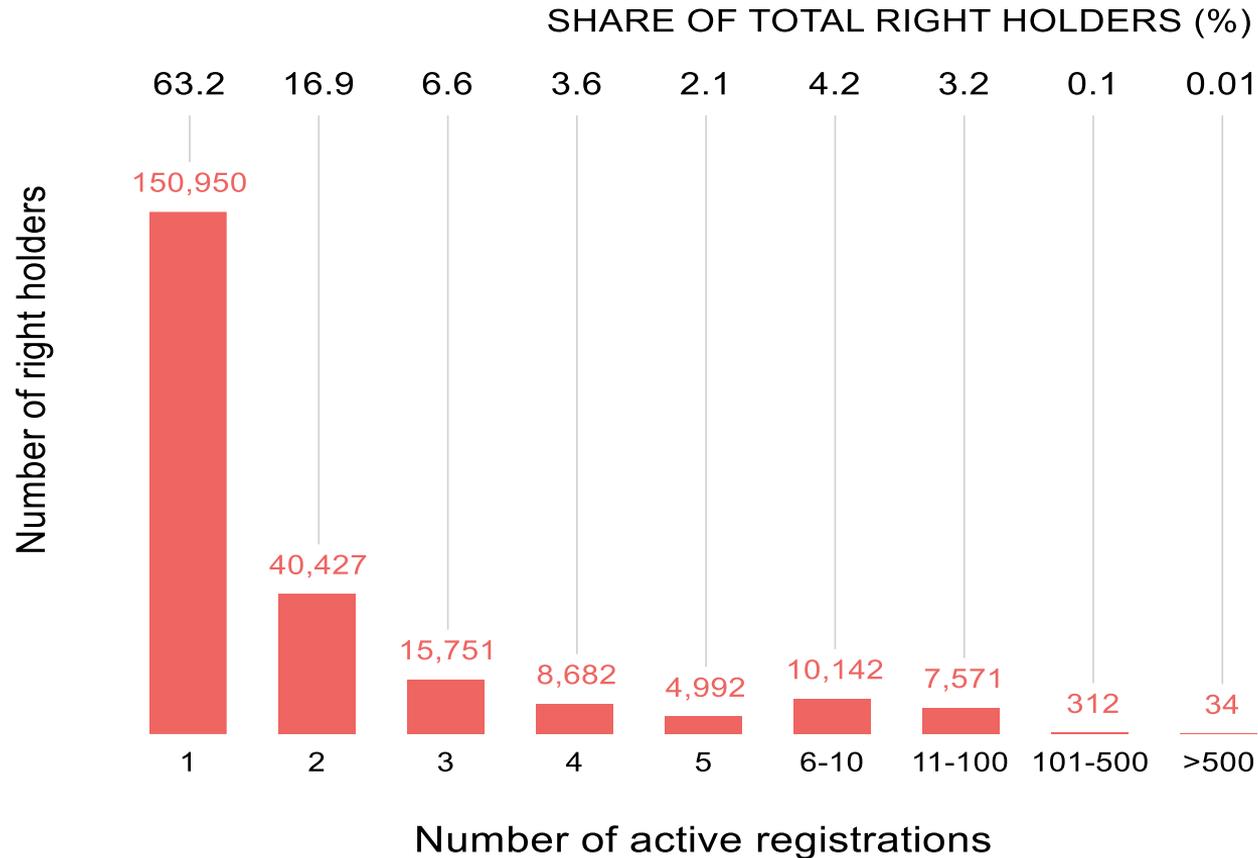
Figure A.16 Trend in use of the Madrid route for Madrid origins only



General Profile 2017

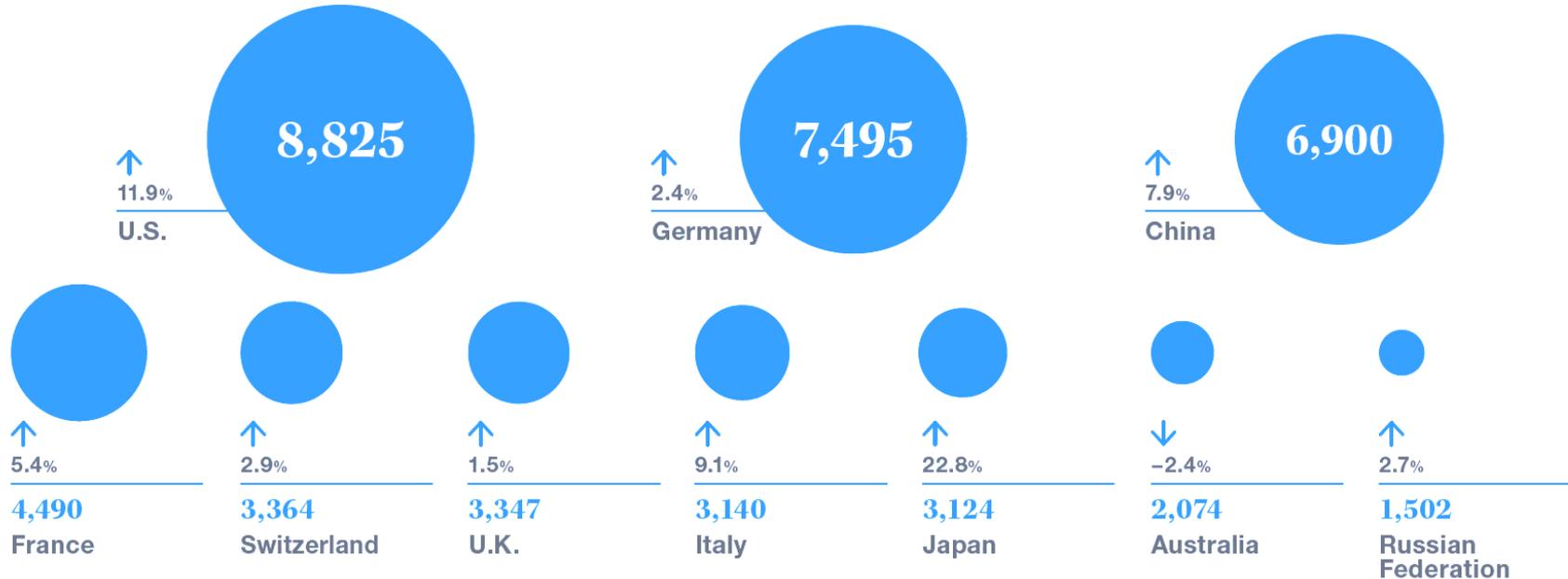


Right-Holders (As of 2017)

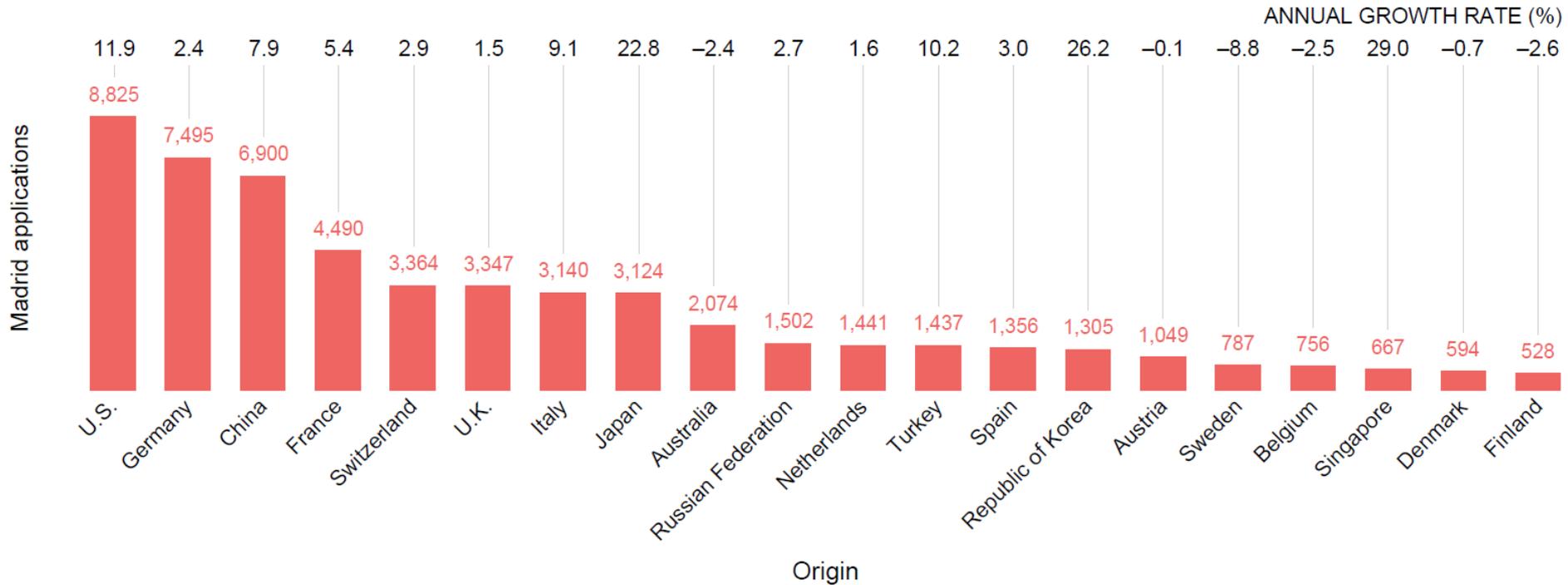


Top 10 Filing Origins (2018)

Number of Madrid applications and percent growth since 2017



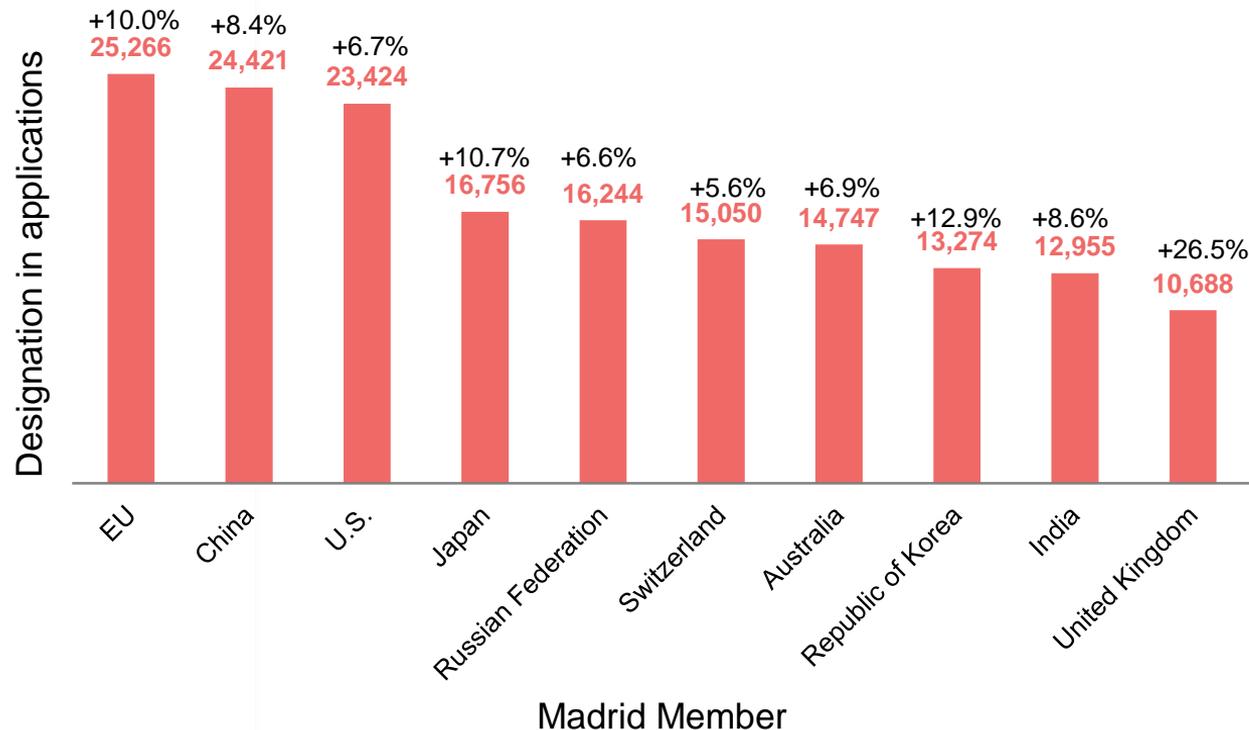
Top 20 Filing Origins (2018)



International applications filed in 2018

- Finland: 528 IAs filed (20th in the top filers' list)
- Sweden: 782 IAs (16th)
- Denmark: 594 IAs (19th)
- Norway: 333 IAs

Top 10 Designated Contracting Parties and Growth Rate (2018)



Designations of Finland in IRs in 2018

- Finland: 929 designations
- Norway: 8716 designations (non-EU member)
- Sweden: 1272 designations
- Denmark: 1152 designations

Recent Developments

- Madrid Portfolio Manager
 - Certificates
 - New E-renewal
 - New look & features
- Madrid “How to” Videos
- Madrid E-filing is available in 5 countries

Legal Developments

Rules Changes in the Common Regulations – *February 1, 2019*

■ Introducing division of IRs before the dCPs and the possible later merger of divided IRs (new Rules 27bis and 27ter)

Madrid System Working Group – topics to be discussed

■ Replacement, new types of marks, languages and changes to the Common Regulations

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



Payment Methods

Option 1 **WIPO Current Account**

Option 2 **Bank/Postal Transfer**

Option 3 **Credit Card Payment**

WIPO Current Account

- [Guide to the WIPO Current Account](#) (updated terms and conditions)
- No minimum number of transactions
- Initial payment of at least CHF 2,000
- Minimum balance – notification sent to users if balance is less than CHF 200
- Only required a [WIPO Account](#) (email address)
- Account statement sent by email only

Contact Madrid

■ <http://www.wipo.int/madrid/en/#contact>

The screenshot shows the top navigation bar of the WIPO website with links for Media, Meetings, Contact Us, My Account, and English. Below this is the WIPO logo and the text 'WORLD INTELLECTUAL PROPERTY ORGANIZATION'. A secondary navigation bar contains links for IP Services, Policy, Cooperation, Knowledge, About IP, and About WIPO, along with a search bar labeled 'Search WIPO'. The breadcrumb trail reads 'Home > IP Services > Madrid System'. The main heading is 'Contacts', followed by the text 'Madrid Customer Service opening hours: Monday - Friday, 9:00 a.m. to 6:00 p.m. (Geneva time)'. Two columns of links are provided: 'Enquiries / submitting forms' and 'Extracts from the International Register', each with a 'Contact Madrid' link and a telephone number.

Media | Meetings | Contact Us | My Account | English ▾

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Home > IP Services > Madrid System On this page ▾

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Enquiries / submitting forms	Extracts from the International Register
<ul style="list-style-type: none">• Contact Madrid• Tel: +41 22 338 86 86	<ul style="list-style-type: none">• Contact Madrid• Tel: +41 22 338 8484

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Kiitos!

