

# Protecting Trademarks Internationally with WIPO's Madrid System

Madrid System Webinar

Olivier Pierre

Sarah Nassar

September 11, 2024



# Our Speakers



**Olivier Pierre**

Information Assistant  
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WIPO



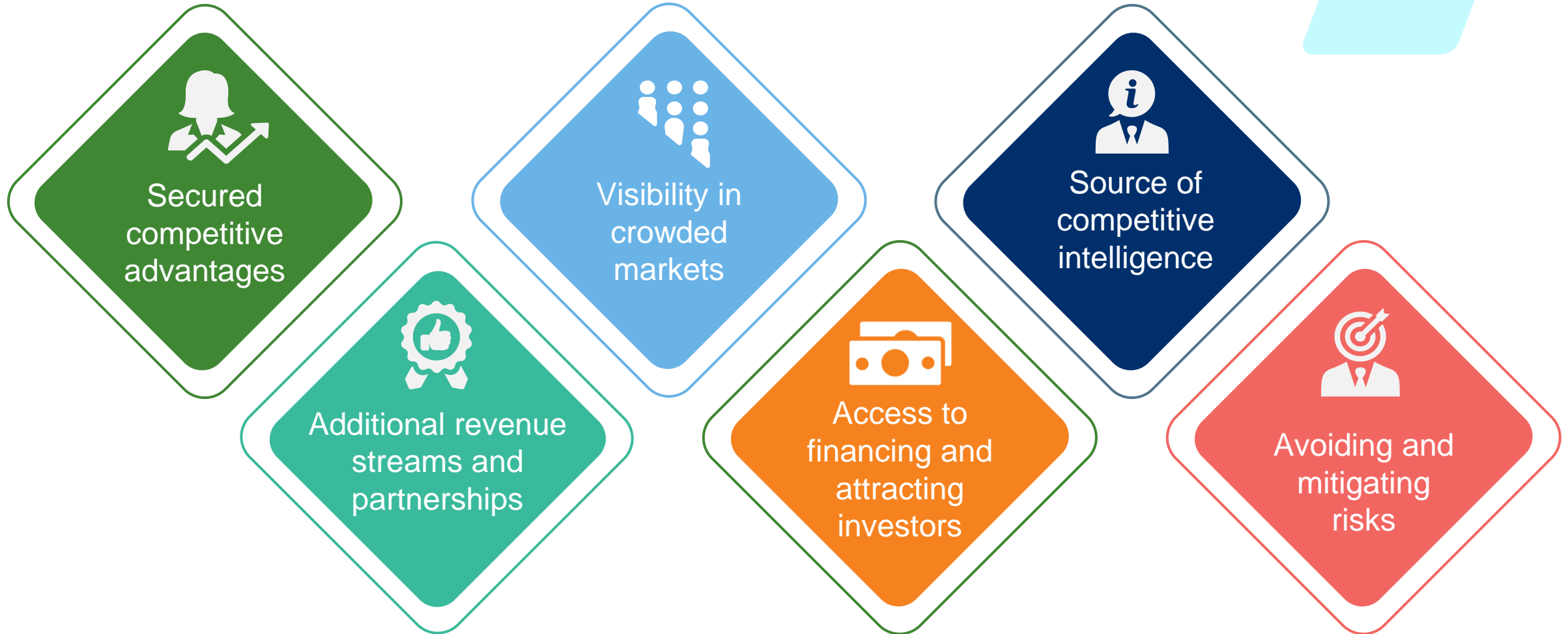
**Sarah Nassar**

Associate Program Officer  
IP for Business Division (IPBD)  
WIPO

# IP & INNOVATION ECOSYSTEMS SECTOR (IIES)



# Maximizing your potential through IP



# Survey

Have you ever experienced difficulties in identifying your intellectual property assets ?

- YES
- NO



# Protect your competitive edge with IPRs

IP rights give you control, deciding who can do what with your invention, creation or brand

1



**An invention**

Patents, utility models or trade secrets

2



**A creative work**

Copyright, design rights

3

**MY  
COMPANY**

**Brand name or logo**

Trademark, copyright,  
design rights

4



**Confidential information**

Trade secrets

5



**A design**

Design rights, copyrights,  
patents

6



**Geographical indications**

# WIPO IP DIAGNOSTIC TOOL

A self-evaluation tool targeting IP strategy for SMEs. It allows you to receive personalized reports instantly on your IP situation.



# Background

## Why ?

- Support young enterprises in developing their capital and strategy in terms of IP.
- Help expand their commercial opportunities.
- Give preliminary advice on IP assets.
- Provide information on business activities that may be affected by IP.



## For whom ?

- **Any individual or SME** that seeks to understand at a glance all the IP components included in its business.

**IMPORTANT!** The tool does not replace the advice of a specialized legal counsel



# How does it work ?

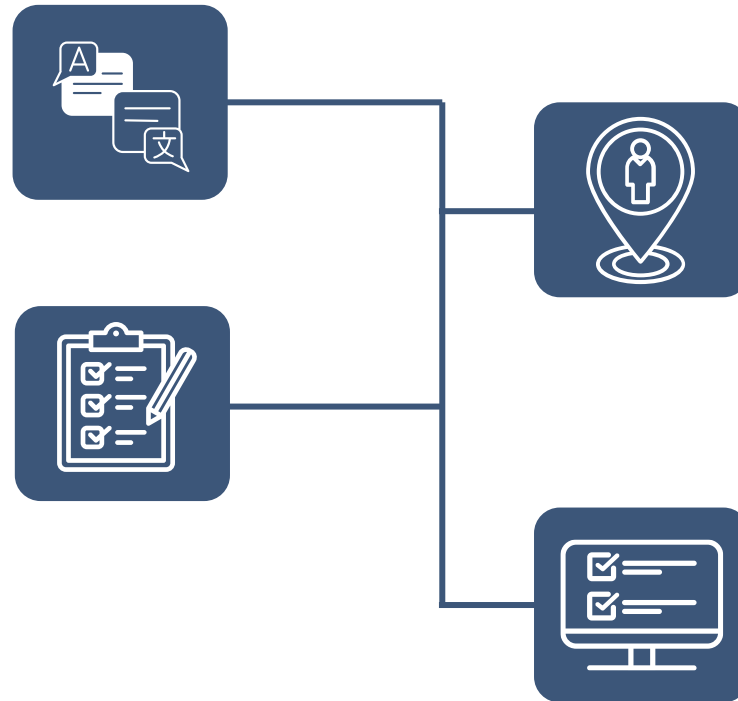
## AVAILABLE IN +15 LANGUAGES

Arabic, English, Spanish, French, Chinese, Hindi, Thai, Kiswahili, Russian and Japanese ...

## PRE-ASSESSMENT QUESTIONNAIRE

A set of ten basic questions, to best tailor the remaining questions to the users' needs.

**IMPORTANT!** The tool does not replace the advice of a specialized legal counsel



## USER FRIENDLY AND FREE OF CHARGE

Available on computer and mobile phone. It will take a maximum of one hour to complete the assessment, the users can do it at their own pace, save it and come back as many times as they need to complete it.

## A SET OF 10 SECTIONS ON DIFFERENT IP TOPICS

(e.g. innovative products, trademarks, licensing, designs, internationalization, etc.) WIPO IP Diagnostics has ten sections; the users complete only those sections that they consider relevant to their businesses.

# Why should we use this tool ?

1

## Understand the IP in your business

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- IP rights (patents, trademarks, designs, copyright and trade secrets).
- IP management aspects (maintaining a website, engaging in international trade, dealing with employees, external suppliers and contractors, and licensing, protecting, and defending your IP).

2

## Develop an IP management strategy

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- The report can then be used as a starting point for developing an IP management strategy relevant to your business.

3

## Gateway to IP advisory services

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- The report can serve as a basis for the discussion with an IP expert on how to protect identified IP assets and integrate an IP Strategy into the users' business.

# Hypothetical case

## By Sally

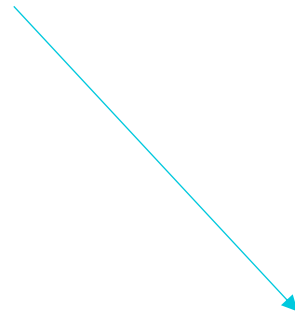
- ✓ Logo and attractive design
- ✓ Use external providers
- ✓ Website
- ✓ Employees (15)
- ✓ Intend to sell product locally and internationally
- ✓ Confidential information



# STEP 1 – Access the WIPO IP Diagnostics Webpage

Access the page [WIPO IP Diagnostics](#) and click on **start WIPO IP diagnostics**.

No registration required.



## WIPO IP Diagnostics

WIPO IP Diagnostics is a free, intellectual property (IP) self-assessment tool that helps businesses identify their IP assets.

After you complete a section, a report that gives you recommendations and further information on IP and business competitiveness will be generated.

- ▶ [How is the IP assessment conducted?](#)
- ▶ [How is the IP Diagnostics report generated?](#)
- ▶ [What does the IP Diagnostics report include?](#)

Find out more: [Brochure PDF](#) | [FAQ PDF](#)

[Start WIPO IP Diagnostics](#)



Video: Helping Your Businesses Identify and Grow with Intellectual Property with the IP Diagnostic Tool

# STEP 2 – Pre – assessment questionnaire



## Pre-assessment

basic questions regarding your business

Have you developed a product, process, service or a technical modification that you consider new, innovative or unique?

Yes  No

Do you generate materials like manuals, pamphlets, labels, or produce videos, software, newsletters, music clips, etc.?

Yes  No

Do you use features like patterns, lines, colors or shapes to make the external appearance or the packaging of your product attractive?

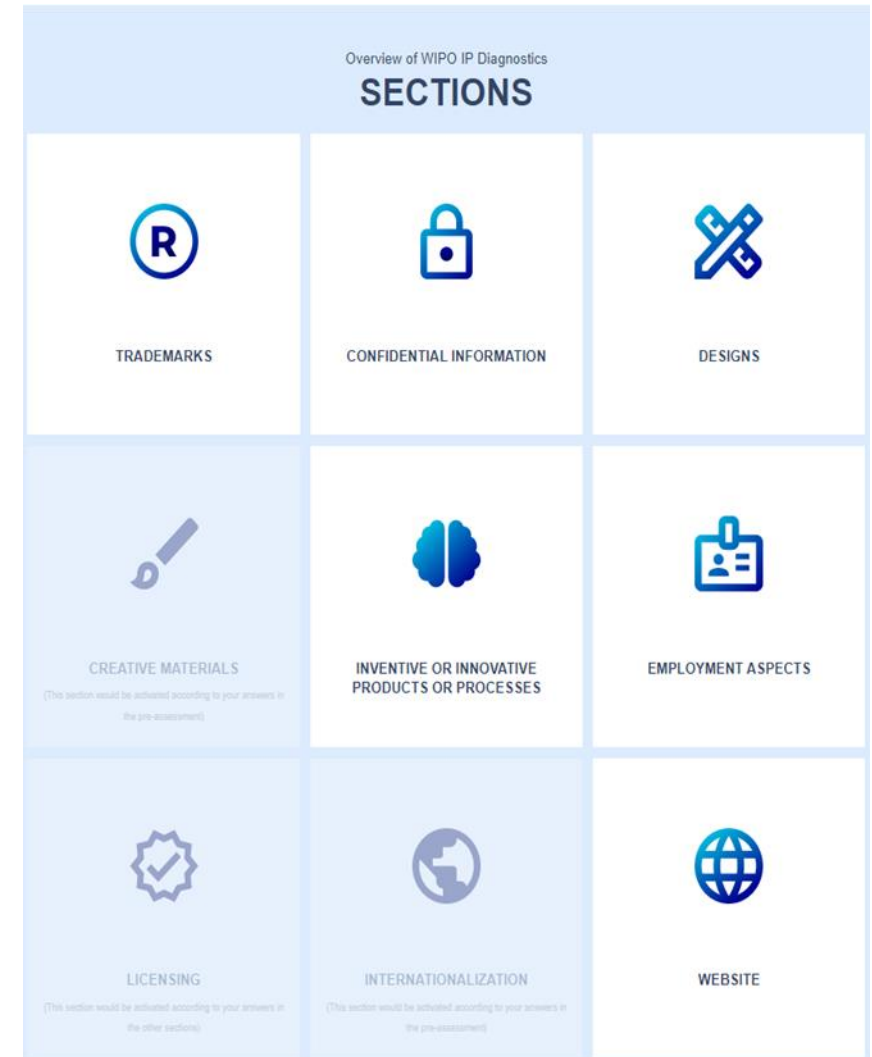
Yes  No

- Preliminary assessment
- Personalized questionnaire
- No time limit for use (resume at convenience)
- Max 1h to achieve

# STEP 3 – Sections

Sections cover the majority of IP rights.

The tool explores IP in all areas of business activity.



# STEP 4 – Download your reports

## Web format

- Report for each completed section
- Can be downloaded (PDF)
- Questionnaire to be redone several times
- **IMPORTANT!** The tool does not replace the advice of a specialized legal counsel.

## Trademarks

With your answers, you have indicated that you have already a trademark for your business registered at the national or regional intellectual property office or you have applied for one. This means that you have protected or applied to protect a sign that identifies and distinguishes your products and/or services from those of others in the marketplace.

You now have a powerful business asset, it might even be the most powerful asset you own. You can prevent competitors from making unauthorized use of your trademark (that is from marketing identical or similar products under an identical or confusingly similar trademark) and you can use it to build your brand image and reputation allowing you to create a relationship of trust with your consumers and thus establish a loyal clientele and enhance the goodwill of your business. Trademarks are a powerful instrument to capture the consumer's attention and make your products stand out. Consumers are willing to pay more for a product bearing a trademark that they recognize, and which meets their expectations. Trademarks also encourage companies to invest in maintaining or improving the quality of their products in order to maintain or further improve their reputation. Trademarks are one of the most valuable and enduring business assets. They can last a very long time, and thus provide your business with a long-term competitive advantage.

They also have value beyond your core business and often pave the way for the expansion of your business into other products. They may be licensed or merchandised, and so provide an additional source of income through royalties, they are a crucial component of franchising agreements, and they may be sold along with or separately from your business. Trademarks also may be used to provide collateral security in obtaining financing.

However, it is important to remember that it is not enough to obtain protection through trademark registration. The protection may get lost if your trademark is not properly used. A trademark may become generic if it becomes so widely used that it becomes a common name to designate the relevant good or service. In such instances, the trademark will not be registrable and a previous registration for such a trademark may be canceled. For example, Trampoline has been ruled generic in the United States of America, so other companies may use that name for an athletic jumping apparatus as well. In most countries, registered trademarks must be used in order to remain valid, otherwise, they may be canceled. Failure to use may mean that the trademark has been abandoned and make the trademark vulnerable to an attack by a third party to have it invalidated for non-use. You indicated that you are using the trademark, so this is not likely to be an issue for your company.

### Investors

Your answers suggest that you are interested in attracting investment.

In today's knowledge-based economy, the intangible assets of companies constitute a larger share of the overall value of companies. The physical assets of companies make up an increasingly lower percentage of the share of company value. Therefore, a carefully selected and nurtured trademark is a valuable

## PDF format



November 22, 2021

## Report of WIPO IP Diagnostics

### TRADEMARKS

This report has been automatically generated based on your answers.

With your answers, you have indicated that you have already a trademark for your business registered at the national or regional intellectual property office or you have applied for one. This means that you have protected or applied to protect a sign that identifies and distinguishes your products and/or services from those of others in the marketplace.

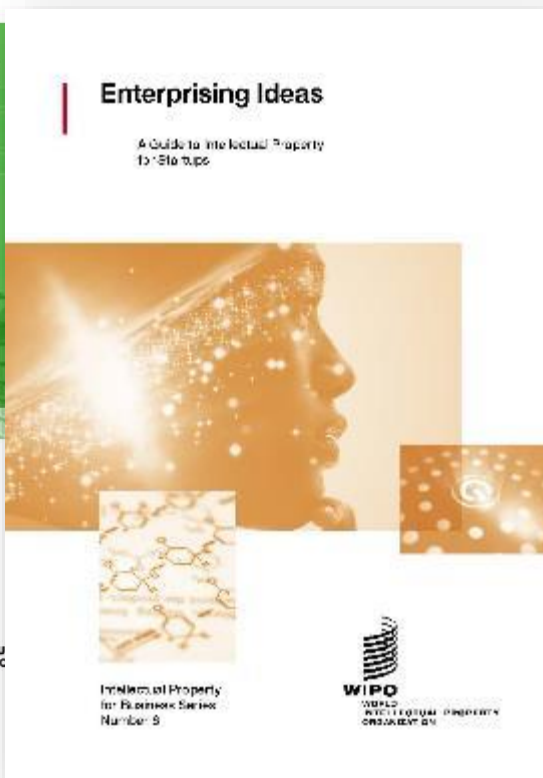
You now have a powerful business asset; it might even be the most powerful asset you own. You can prevent competitors from making unauthorized use of your trademark (that is from marketing identical or similar products under an identical or confusingly similar trademark) and you can use it to build your brand image and reputation allowing you to create a relationship of trust with your consumers and thus establish a loyal clientele and enhance the goodwill of your business. Trademarks are a powerful instrument to capture the consumer's attention and make your products stand out. Consumers are willing to pay more for a product bearing a trademark that they recognize, and which meets their

## Creative Expression

An Introduction to Copyright and Related Rights for Small and Medium-sized Enterprises



Intellectual Property for Business Series Number 4



## Enterprising Ideas

A Guide to Intellectual Property for Start-ups



Intellectual Property for Business Series Number 5



## Making a Mark

An Introduction to Trademarks for Small and Medium-sized Enterprises

Intellectual Property for Business Series Number 7



## Looking Good

An Introduction to Industrial Design for Small and Medium-sized Enterprises

Intellectual Property for Business Series Number 2



## Inventing the Future

An Introduction to Patents for Small and Medium-sized Enterprises

Intellectual Property for Business Series Number 3



## In Good Company

Managing Intellectual Property Issues in HR and Hiring

Intellectual Property for Business Series Number 6



Most recent guides

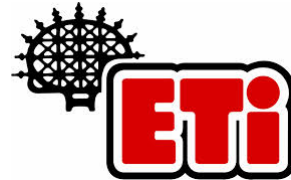


Scan our QR code to see the entire series or follow <https://www.wipo.int/publications/en/series/index.jsp?id=181>



# Basic Features

# It Begins with a Trademark and a Plan to Export...



# 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 (BOIP, 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:

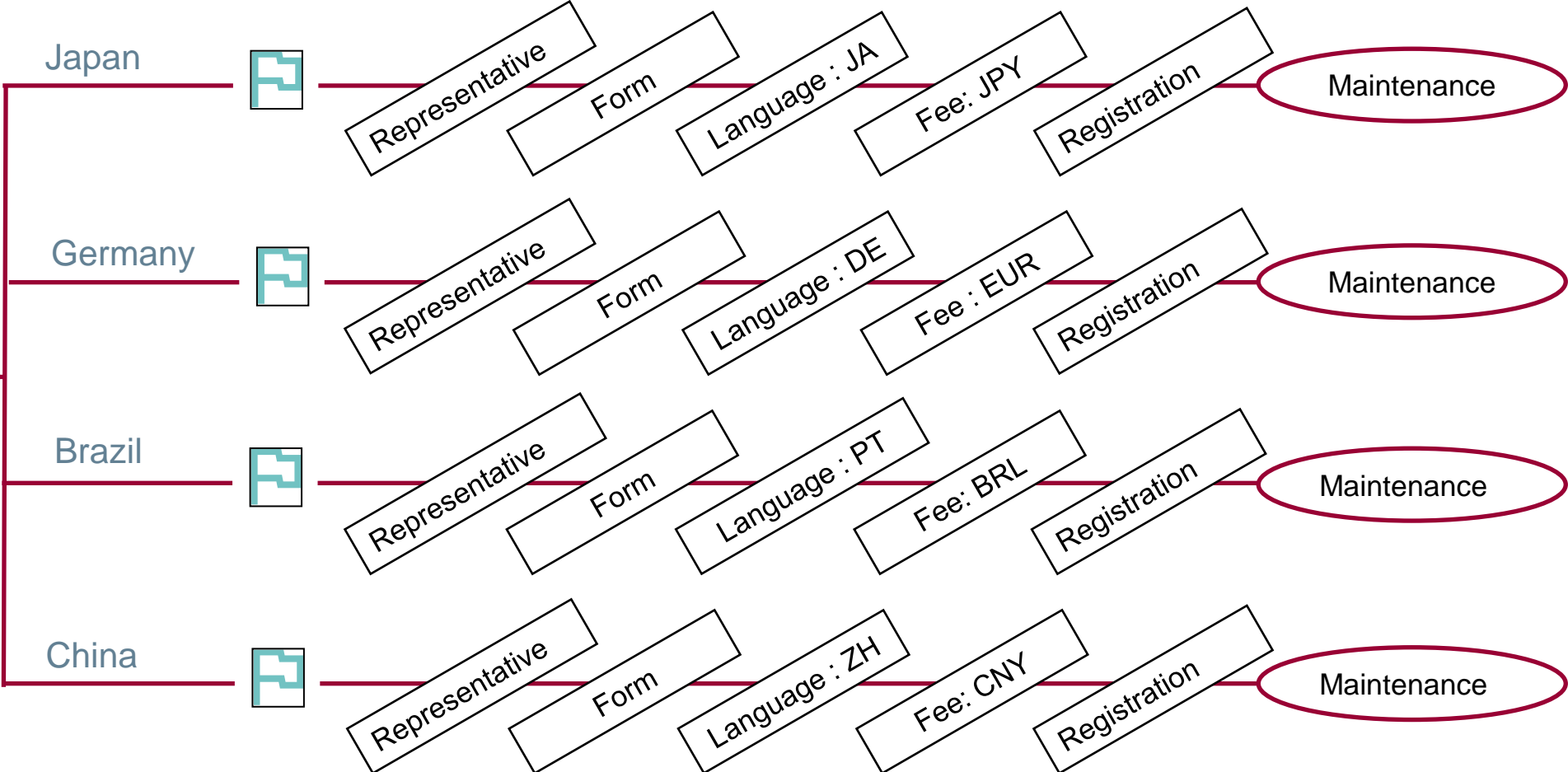
- Seek protection in multiple markets, particularly if these are in different regions
- Want flexibility to add new markets as your export plans develop
- Have limited budget and/or time to spend on registration and management of your trademarks

# A trademark and a plan to export

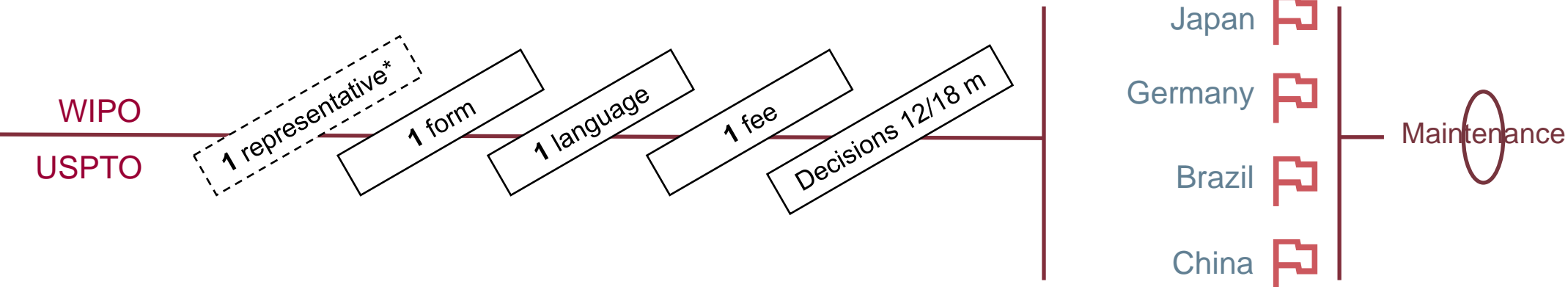
 *By Sally*



# Market by Market Filing



# Madrid System



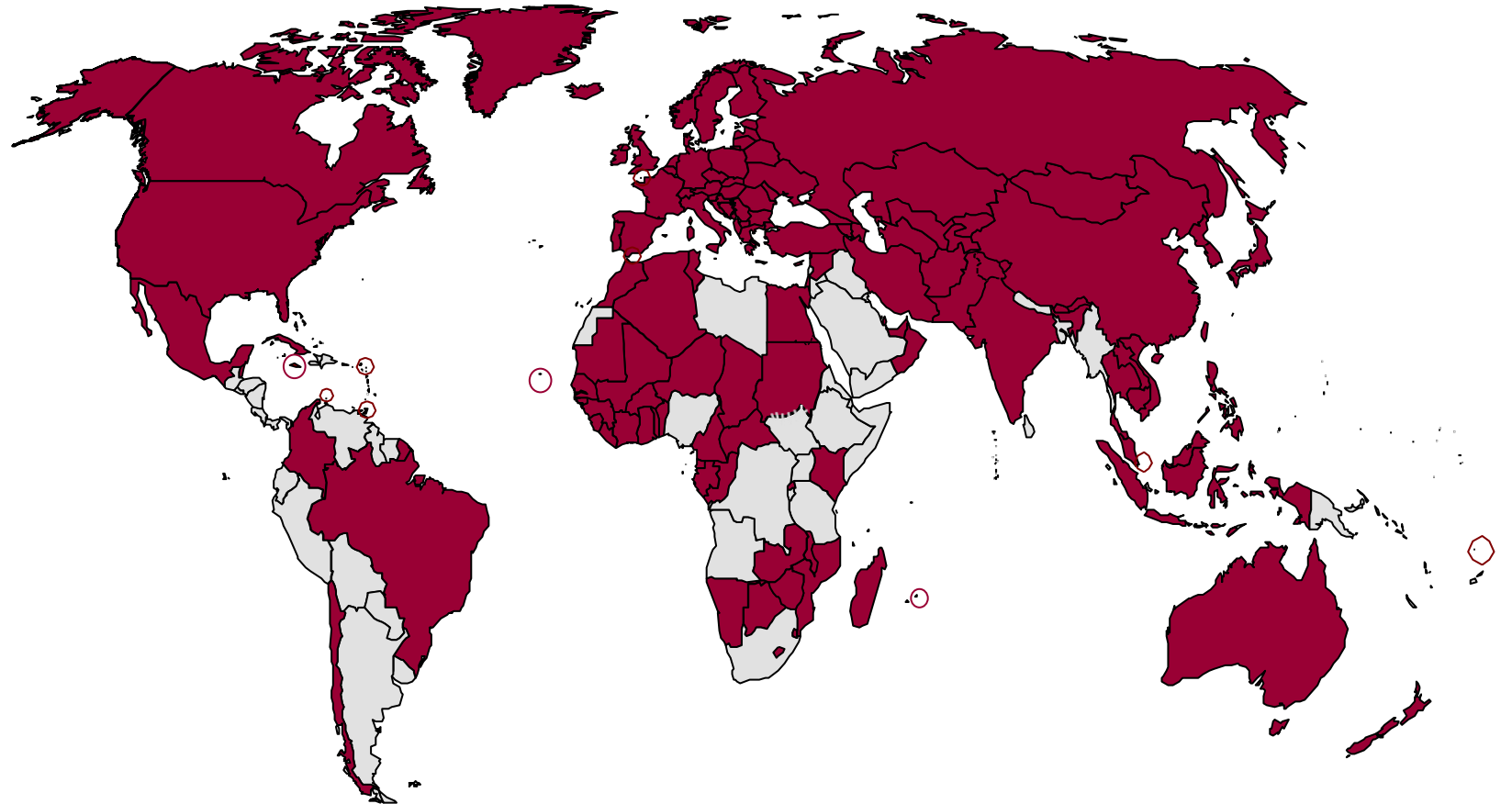
\* optional

# The Madrid System is Global

- Currently: 131 countries covered by the 115 members
- Markets cover more than 80% of world trade
- Recent accessions include:
  - 2021: Islamic Republic of Pakistan, United Arab Emirates, Jamaica
  - 2022: Chile, Cabo Verde and Belize
  - 2023: Mauritius
  - 2024: Qatar



# Members of the Madrid System



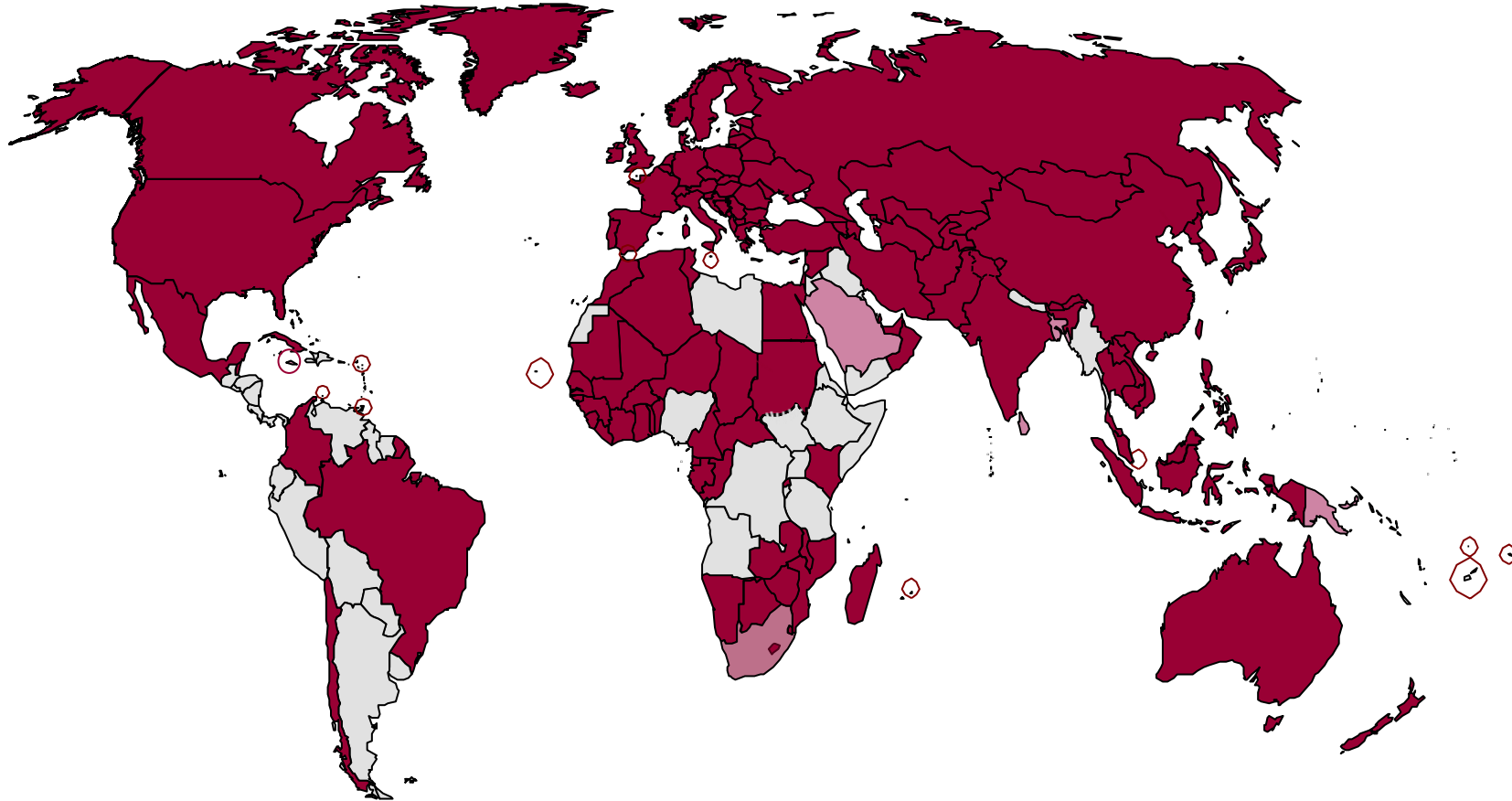
\*Disclaimer on the map

 **115 members (including EU and OAPI)  
covering 131 countries**

# Accession Outlook – 2024/25

- **Africa:** South Africa
- **Arab region:** Saudi Arabia
- **Asia:** Bangladesh, Papua New Guinea, Sri Lanka, Fiji, Tonga  
China to extend the application to Hong Kong SAR
- **Europe:** Malta

# Accession Outlook 2024/25



\*Disclaimer on the map

**115 members (including EU and OAPI) covering 131 countries**  
**8 countries accession outlook**

# 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

# Costs

## Fees are payable to WIPO in Swiss francs (CHF)

- Basic fee\*
  - CHF 653 – b/w reproduction of mark
  - CHF 903 – color reproduction of mark
- Fees for designated Madrid System members
  - Standard fees – complementary (CHF 100 per designations) and supplementary (CHF 100 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

# Users of the System

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



GETTYIMAGES/BUBAONE

# 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**



# More than 1.7 Million International Registrations



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



- COLTEJER is international trademark registration 1.5 million
- Registered in Colombia in 2009, internationally in 2019

TATSA

- TATSA is international trademark registration 1.75 million
- Registered in the US and internationally in 2023

# Question

Where should you send your international trademark application?

- To WIPO directly
- To the IP Office(s) of the countries of interest
- To IP Office of the country of origin (nationality, company HQ, etc..)?

# How the System Works

## The International Trademark Registration Process



# eMadrid

You can access [eMadrid](#) through the [WIPO website](#) or through the [WIPO IP Portal](#) using your WIPO Account

A horizontal banner with a light blue background and a pattern of white dots. The text is centered. On the right side, there is a logo consisting of a red hexagon with a white 'T' and a white circle with a white 'M'.

**eMadrid – Madrid System online services**

Use eMadrid to file your applications and manage your trademark portfolio, in a secure and self-service environment.

[Go to eMadrid](#)

# eMadrid

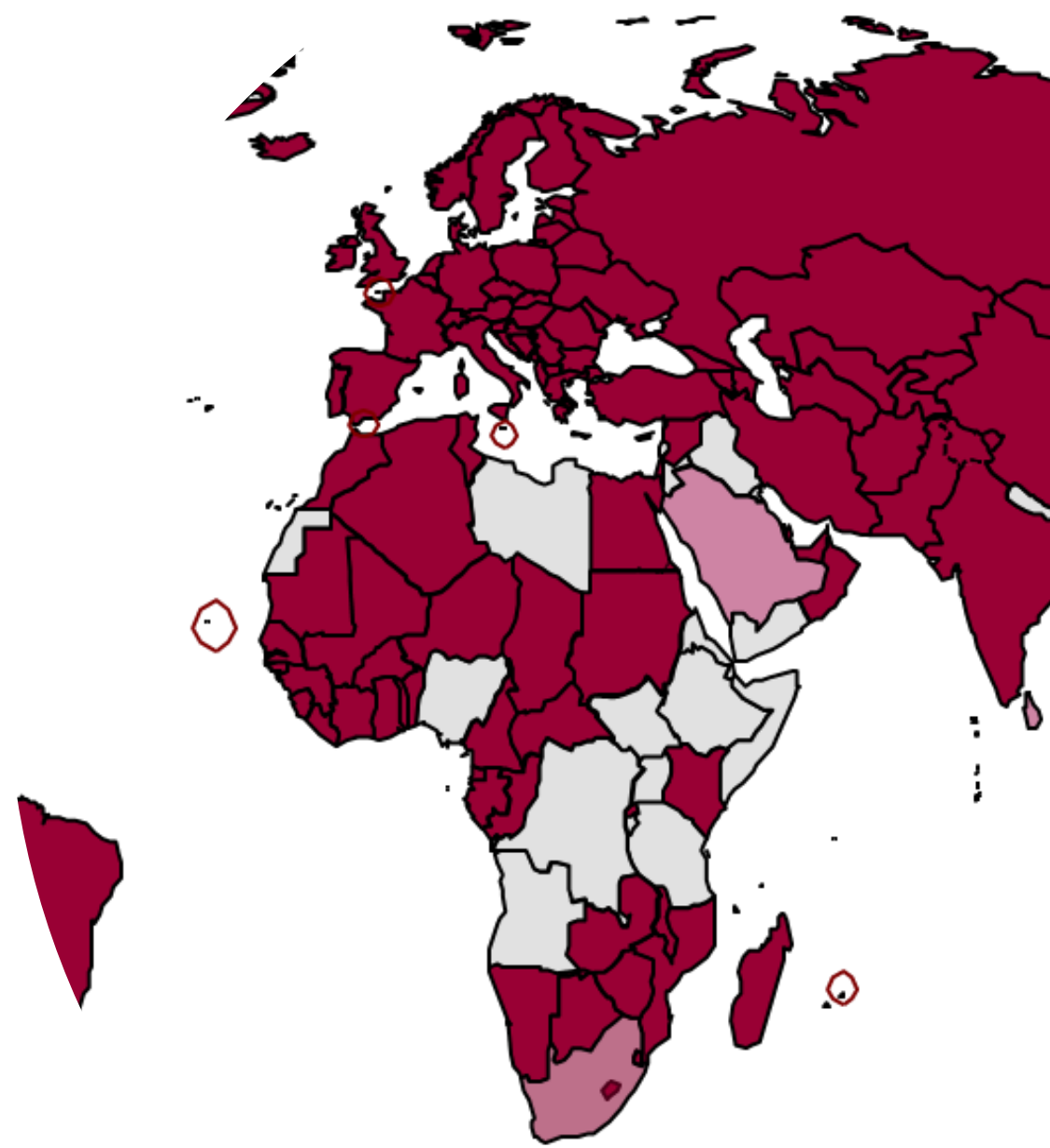
The screenshot shows the WIPO eMadrid website. At the top left is the WIPO logo. In the top right, there are links for 'Help', 'English', and 'IP Portal login', with the latter circled in red. A red arrow points from the bottom left towards the 'Login' button. Another red arrow points from the bottom right towards the 'IP Portal login' link. The main content area features a blue header with 'Welcome to eMadrid' and a navigation bar with 'eMadrid home', 'File an application', 'Manage your trademarks', and 'Find & monitor'. Below this is a section titled 'File and manage your international trademark applications and registrations in multiple countries' with a 'Login' button circled in red and a 'Create a WIPO Account' button. At the bottom, there are three cards: 'File an application' with a 'Prepare your application' button, 'Manage your trademarks' with an 'Access our online services' button, and 'Find and monitor' with a 'Get started' button.

WIPO website, 2024

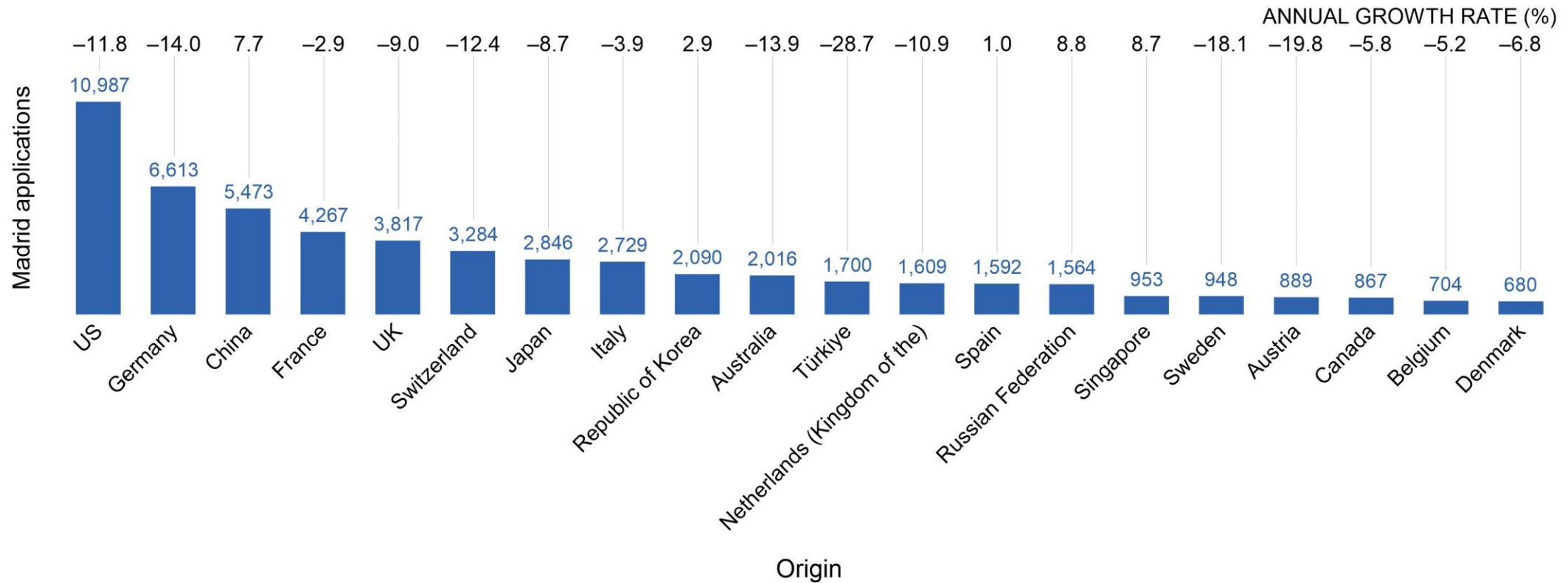
# Recent Developments

# Question

- Which country sent us the most international applications in 2023?
- China
- European Union
- USA
- Australia



# Top 20 Filing Origin - 2023



WIPO Statistics Database, March 2024.

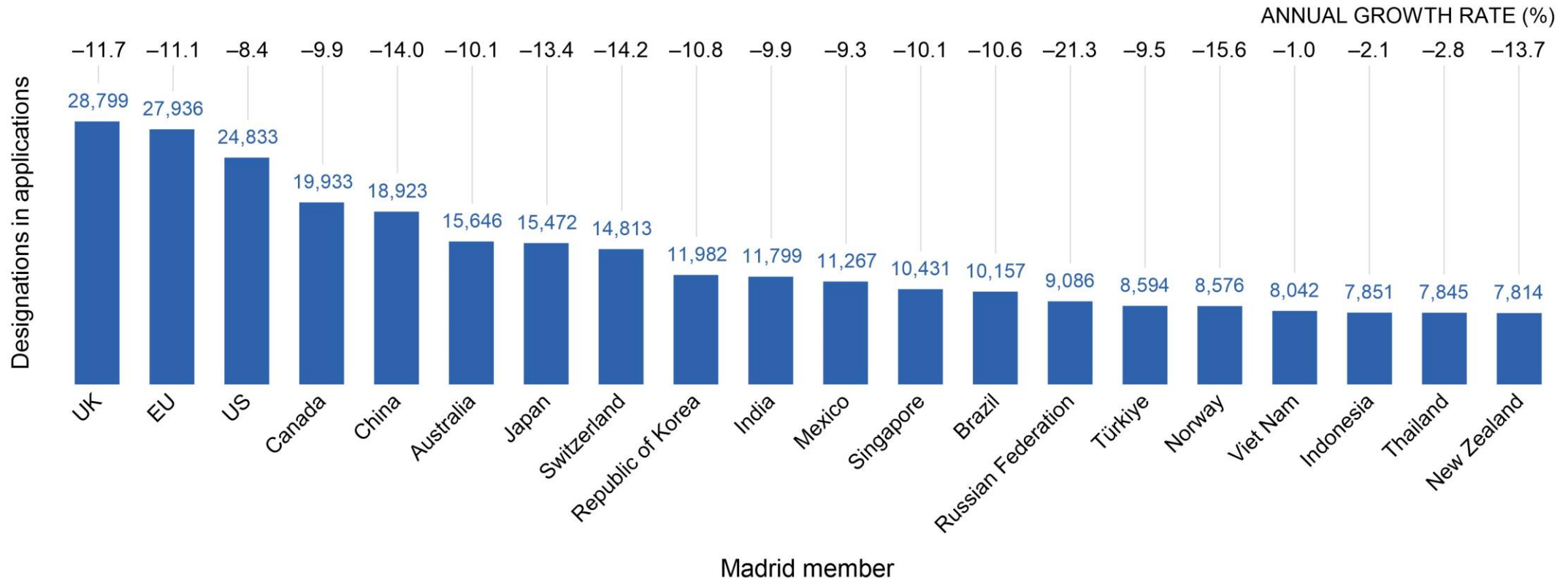


# Question

- Which country was the most designated by applicants in 2023?
- USA
- China
- UK
- European Union



# Top 20 Designations – 2023



WIPO Statistics Database, March 2024.

# Top 10 Applicants – 2023

Rank	Name	Origin	Applications
1	L'OREAL	France	199
2	Bayerische Motoren Werke AG	Germany	124
3	Euro Games Technology Ltd.	Bulgaria	118
4	Boehringer Ingelheim International GmbH	Germany	110
4	Novartis AG	Switzerland	110
6	Berlin-Chemie AG	Germany	107
7	Shiseido Company, Ltd	Japan	103
8	Mizuno Corporation	Japan	79
9	Huawei Technologies Co., Ltd.	China	78
10	Apple Inc.	US	74

WIPO Statistics Database, March 2024.










# Conclusion and final notes



- A simple and accessible tool
- Pre-assessment that determines the next steps of the analysis
- Individual questionnaires on 10 IP topics applicable to the company
- Immediately downloadable individual reports tailored to the user's information needs
- Capable of responding to different scenarios
- Free of charge
- Enables the establishment of a real IP strategy
- Guides conversation with an advisor

# The Madrid System: Key Benefits

**THE MADRID SYSTEM: PROTECTING TRADEMARKS ABROAD** **WIPO | MADRID**  
The International  
Trademark System

<p>The Madrid System is the convenient and cost-effective way to protect your brand internationally</p> <p>Register and manage your trademarks in multiple countries through one system</p> 	ONE-STOP SHOP			
	One application	One set of fees	One filing language	Centralized management
				
GLOBAL REACH				
115 members	131 countries covered	Over 80% of world trade	And growing	
				



Questions?

# Public Education Resources

# Resources

## IP for Business:

- WIPO IP Diagnostics Tool <https://www.wipo.int/en/web/wipo-ip-diagnostics>
- Guides: Intellectual Property for Business <https://www.wipo.int/publications/en/series/index.jsp?id=181>
- A step-by-step IP Strategy Checklist for SMEs <https://www.wipo.int/sme/en/checklist.html>

## Madrid System:

- eMadrid <https://www.wipo.int/web/emadrid/>



# Public Webinars – 8 Languages

Webinars del Sistema de Madrid

**Actualizaciones legales del Sistema de Madrid de 2023: Todo lo que necesita saber**

1:03:21  
WIPO MADRID

9 MONTHS AGO

Actualizaciones legales del Siste...

Webinars du système de Madrid

**Protéger sa marque à l'étranger : Guide sur le système de Madrid de l'OMPI et outils de propriété intellectuelle pour les PME**

1:08:24  
WIPO MADRID

5 MONTHS AGO

Protéger sa marque à l'étranger ...

马德里体系网络研讨会

**中国商标局的马德里申请程序 (2023)**

1:09:00  
WIPO MADRID

EDUCATION 4 MONTHS AGO

**The Madrid Filing Procedure in China Trademark Office**

Вебинары по Мадридской системе

**Официальные формы: Управление международной регистрацией**

59:39  
WIPO MADRID

EDUCATION 2 YEARS AGO

Official Forms: Managing an international registration

マドリッド制度に関するWebセミナー

**商標の国際登録制度『マドリッド制度』の概要(初級) - 制度を学びたいスタートアップ、中小企業の方にも!**

2023年10月26日

1:13:44  
WIPO MADRID

EDUCATION 15 DAYS AGO

商標の国際登録制度『マドリッド制度』の概要(初級) - 制度

التحديثات القانونية بشأن نظام مدريد

**تحديثات قانونية لعام 2023 وملاحظات الفريق العامل**

44:48  
WIPO MADRID

8 MONTHS AGO

لعام 2023 آراء ومقترحات الفريق العامل ...

Madrid System Webinars

**Understanding Procedures at the IP Office of the United Kingdom (UKIPO)**

1:06:25  
WIPO MADRID

EDUCATION 1 MONTH AGO

Understanding Procedures at th...

# Certificates of Attendance



Share your certificate  
on [LinkedIn](#), [Twitter](#) and  
other social media channel.

Tag WIPO **#MadridSystem**

# Video Explainers and Tutorials

## Madrid 'How-to' videos



How to extend the protection of an international registration via the subsequent designation

In this tutorial, you will learn how to expand the geographical coverage of your existing international registration by adding additional countries or regions through a subsequent designation. [About subsequent designations.](#)



How to renew international registrations (part 1)

This tutorial will go over the renewal process, modifications to international registrations before and after the renewal and the costs associated to the renewal. [About renewals.](#)



Video: An introduction to the International Trademark System.



Video: Benefits and advantages of the Madrid System.

# Distance Learning Course




- Certified and tutored online course
- 6 modules – 16 hours
- Free
- 800 - 1000 participants per session
- With the WIPO Academy
- [DL-303 Specialized Course on the Madrid System for the International Registration of Marks](#)

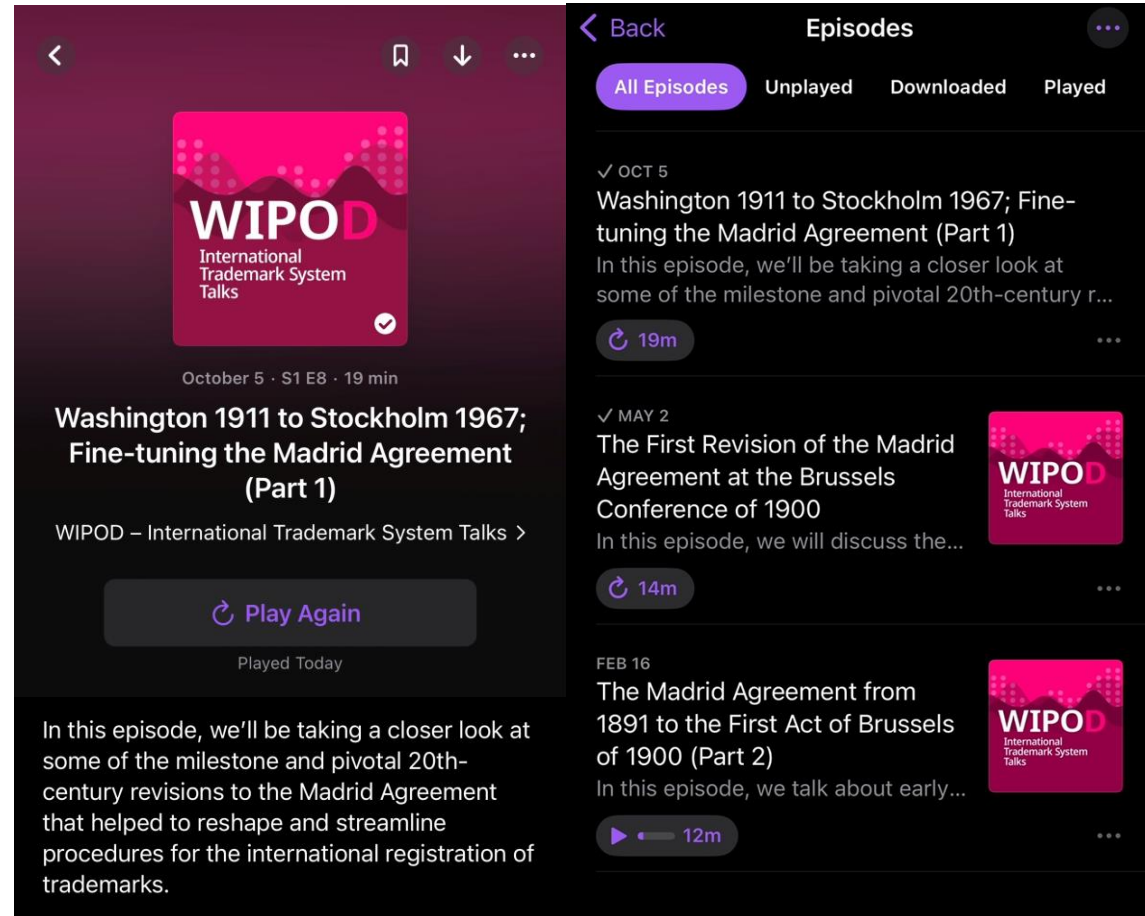


# Madrid System Podcast

## WIPOD – International Trademark System Talks

10 episodes

- Spotify 
- Apple Podcasts 
- YouTube Podcasts 



WIPO, 2024

# Testimonials and Case Studies

## Madrid System Success Story: M'Simbi – Spreading Self-Love Globally, One Doll at a Time

July 25, 2023

We have just released a new success story highlighting how the [Madrid System](#) supports innovative entrepreneurs who want their brand to make a difference even beyond their national borders.

What do you do when society tricks you into believing you do not fit in? You carve your own path and you make your voice heard! This is exactly what Maingaila Moono – former biostatistician and now full-time entrepreneur from Zambia – did when she realized that her daughter did not feel like she complied with traditional beauty standards.



In 2022, the [Zambian Association of Manufacturers](#) assigned Maingaila the [Game Changers Award](#), as an acknowledgement of her innovative ideas, her sense of leadership and her positive impact on the manufacturing industry. (Photo: MacLean's Photography)

Her little girl motivated Maingaila to find a way to manufacture Black dolls, and to set up her own business - M'Simbi- whose mission is to teach young girls to be proud of their cultural identity and aware of their own unique beauty.

M'Simbi products now range from dolls to backpacks, and from clothes to hair accessories, and are exported to the United Kingdom and the United States of America.

International trademark protection in those countries through the [Madrid System](#) is what truly allowed M'Simbi to take off, opening up doors to major international e-commerce platforms.

"I would definitely encourage local entrepreneurs to apply for trademark protection both locally and internationally. When [PACRA \(Patents and Companies Registration Agency in Zambia\)](#) told us that you can register your trademark in many countries at once with the [Madrid System](#), it really intrigued us."

— Maingaila Moono

[Access the full success story](#)

## Madrid System Success Story: HABIBA Jewellery – Timeless Tunisian Jewelry Takes the International Stage by Storm

September 26, 2023

Entrepreneur Sonia Feki's brand "[HABIBA Jewellery](#)" – created as a tribute to her mother – was quick to win the hearts of women across Tunisia. Despite the challenges of the COVID-19 pandemic, the brands' success grew, spontaneously catching the attention of Egyptian media outlets, in turn raising awareness in the Gulf countries. From there, demand grew in other African countries.

Find out all about Sonia's journey to success, and how the [Madrid System](#) is helping her not just to expand her horizons but also to face the future with confidence.



### Sonia's secret to success?

"When I founded [HABIBA Jewellery](#), I projected myself 15 years into the future. Protecting my trademark – first nationally and then internationally – was one of my top priorities."

— Sonia Feki, [HABIBA Jewellery](#)

[Access the full success story](#)

# Madrid System User Group

Help us shape the future of our Madrid System online services under [eMadrid!](#)

[Sign up to our Madrid System User Group](#)





# Keep Updated on the Madrid System



# Good news! We are now on LinkedIn!

We'll be sharing tips, facts, stories, learning opportunities and much more on WIPO's [Madrid System](#), [Hague System](#) and [Lisbon System](#), as well as trademarks, designs, and geographical indications!

[Follow us](#) now and spread the word!




# Stay informed

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