

## Deep Dive: the Madrid System web resources

Madrid System Webinar

Geneva February 26, 2020

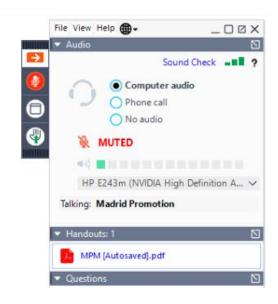
Julia Makoy

Lucía J. Yanguas

Madrid Information and Promotion Division

### How to use GoToWebinar







### Structure of the Webinar

- Presentation: Interactive questions during the webinar
- Question and answer session
- Presentation slides and recordings on the <u>Madrid</u> <u>Webinar page</u>
- Short survey



# How to access the Madrid System website

- From the WIPO Homepage (wipo.int)
  - Navigation bar
    - IP Services Madrid



### How to access the Madrid System

### website

- From the WIPO Homepage (wipo.int)
  - IP Services Madrid



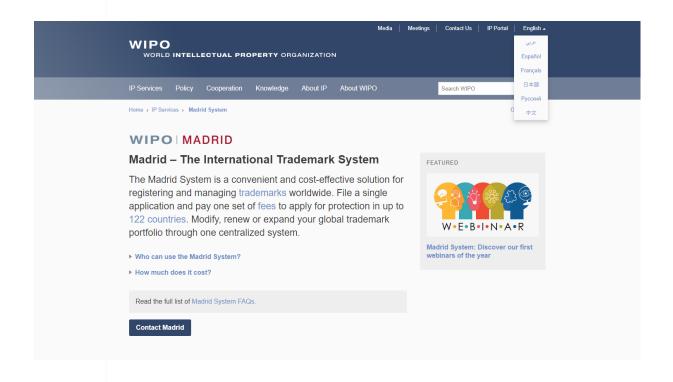


# In what languages is the Madrid System website available?

- Arabic, Chinese, English, French, Russian, Spanish, Japanese
- Arabic, Chinese, English, French, German, Russian, Spanish
- English, French and Spanish



### **Madrid Website**





### Trademark

#### **Trademarks**

#### What is a trademark?

A trademark is a sign capable of distinguishing the goods or services of one enterprise from those of other enterprises.

Trademarks are protected by intellectual property rights.

- ▶ How can I protect my trademark?
- ▶ What rights does trademark registration provide?
- ▶ How long does trademark protection last?
- ► What kinds of trademark can be registered?



Read the case study about the NODOKA trademark (Photo: NODOKA)



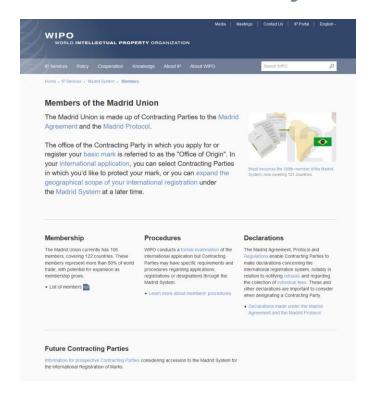
### Who can use the Madrid Systrem?

#### ▼ Who can use the Madrid System?

You can use the Madrid System if you have a personal or business connection to one of the System's members. This means you must either: be domiciled, have an industrial or commercial establishment in, or be a citizen of one of the 122 countries covered by the Madrid System's 106 members. Find out what users say about the Madrid System.



### Members of the Madrid System





### How much does it cost?

#### ▼ How much does it cost?

The cost of an international trademark registration includes the basic fee (653 Swiss francs; or 903 Swiss francs for a mark in color\*), plus **additional costs** depending on **where** you want to protect your mark, and how many **classes** of goods and services will be covered by your registration.

For example, to register a trademark on February 16, 2018, with no color elements in India and the European Union, for one class of goods, the total cost will be 1'698 Swiss francs [653 basic fee + 148 (one class in India) + 897 (one class in the European Union)].

After obtaining an international trademark registration, additional fees apply to expand the geographical scope of coverage, modify or renew your trademark portfolio.

#### Learn more about fees | Estimate your fees

\* If you file your application in the IP Office of a Least Developed Country (LDC), your basic fee will be reduced by 90% (to 65 or 90 Swiss francs).



### Fees

Home > IP Services > Paying for IP Services

On this page •

#### Fees and Payments - Madrid System

#### Types of fees

The fees payable in connection with an application for international registration under the Madrid System comprise:

- the basic fee
- . a complementary fee for each Contracting Party designated; and
- . a supplementary fee for each class of goods and services in excess of three.

For certain contracting parties, the complementary fee is replaced by an "individual fee". To confirm whether or not a Contracting Party applies the individual fee (and the amount of such fee), check the list of Individual Fees.

Warning - misleading invoices

#### Resources

- Fee Calculator
- Transaction codes
- Request to open a Current Account at WIPO
- Bank/postal transfer details (IBAN)

#### Fee amounts

Before filing your application, use the Fee Calculator to estimate the amount of fees payable. For an overview of the basic, complementary, and supplementary fee amounts, see the Schedule of Fees. All fees must be paid in Swiss francs.

Warning – Fee Calculator results are based on information you have provided and the Schedule of Fees in effect at the time the estimate is generated. The estimate is provided for information purposes only. For the most accurate estimate, consult the Fee Calculator immediately before you submit a request or your payment order.

If your Office of origin is in a Least Developed Country (LDC), in accordance with the list established by the United Nations, you benefit from a 90 percent reduction in the basic fee for your international application.

- Individual fees under the Madrid Protocol
- Fee reduction for applications originating from least developed countries

#### Where to submit fees

In general, all international trademark registration fees should be submitted to WIPO. However, for certain Contracting Parties, you may submit application fees directly to the Office of Origin; the Office will then forward the fees to WIPO.

For a list of Contracting Parties that will collect and forward your application fees to WIPO, refer to the Declarations made by Contracting Parties of the Madrid System (declaration (m) [Rule 34(2)(b)].

Warning – Failure to pay your fees in full will result in the issuance of an irregularity notice. The notice will contain a payment deadline (typically 3 months), after which the application will be deemed abandoned.

Contact the relevant IP Office to determine how to submit fees directly. Contact information is available through the Member Profiles Database

#### Payment methods

There are four ways to submit your fees to WIPO: Current Account at WIPO, credit card (in certain cases), bank transfer, or postal transfer (within Europe only).

- ➤ Option 1: Current Account at WIPO
- ► Option 2: credit card payments
- ▶ Options 3 and 4: bank or postal transfer

#### Payment follow-up

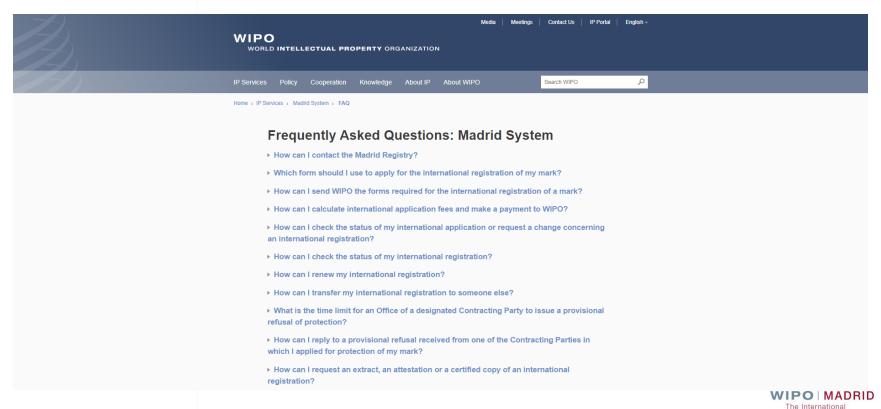
If you do not receive a payment acknowledgement within 10 days of submitting your payment, please contact us.

#### Refund request

To request a refund, please fill in the refund form.

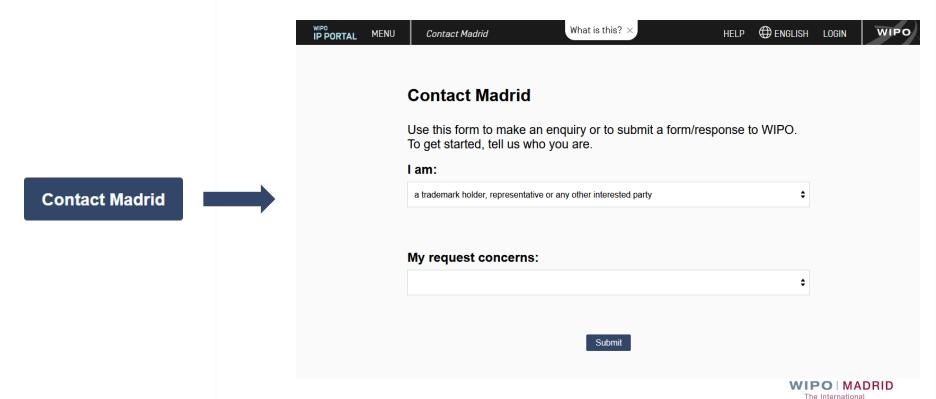


### Madrid FAQ



Trademark System

### **Contact Madrid**



Trademark System

### News

News

All news

Survey on WIPO's New Digital IP Service

February 18, 2020

Madrid System: Discover our First Webinars of the Year

February 4, 2020

**Brexit Agreement: Implications for Madrid System Users** 

January 30, 2020

Email updates

- Madrid Highlights Articles, tips, statistics and publications on the Madrid System (issued quarterly)
- Madrid Notices Legal Information Notices, news and updates on developments in the Madrid System

Sign up

| All WIPO newsletters



### Madrid e-services

#### Madrid e-services

Madrid System online tools and resources to support trademark owners at each stage of the international trademark registration lifecycle. Madrid e-services brochure.



**File** 



**Monitor** 



Manage



**Global Brand Database** 

Madrid Goods & Services Manager

Member Profiles Database

**Fee Calculator** 

International Application Form (MM2)

PDF

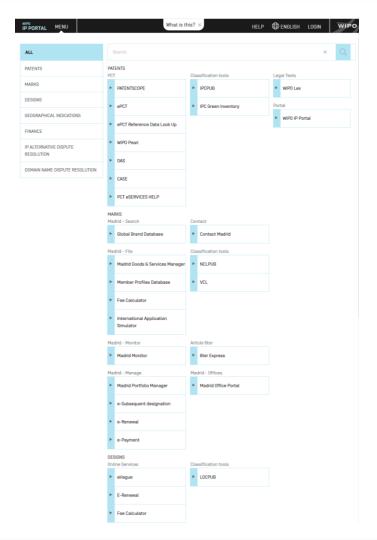
**Madrid Monitor** 

#### **Madrid Portfolio Manager**

- e-Subsequent Designation
- e-Renewal
- e-Payment
- Madrid System forms



### **IP Portal**





### Madrid e-services

#### Madrid e-services

Madrid System online tools and resources to support trademark owners at each stage of the international trademark registration lifecycle. Madrid e-services brochure.



**File** 



**Monitor** 



Manage



**Global Brand Database** 

Madrid Goods & Services Manager

Member Profiles Database

**Fee Calculator** 

International Application Form (MM2)

PDF

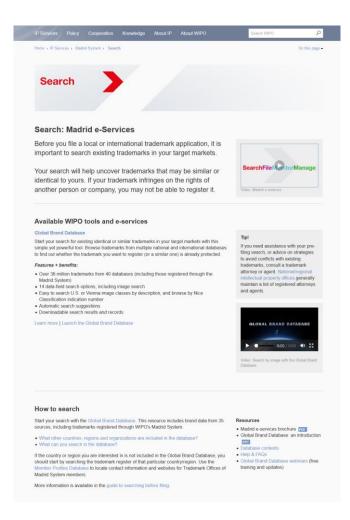
**Madrid Monitor** 

#### **Madrid Portfolio Manager**

- e-Subsequent Designation
- e-Renewal
- e-Payment
- Madrid System forms

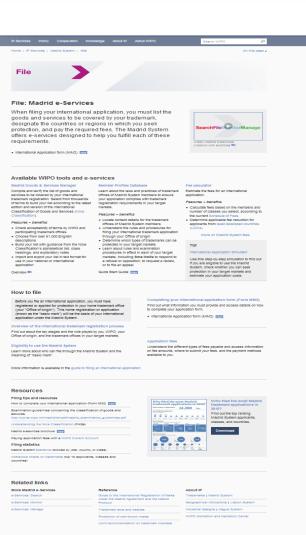


### Search





### File



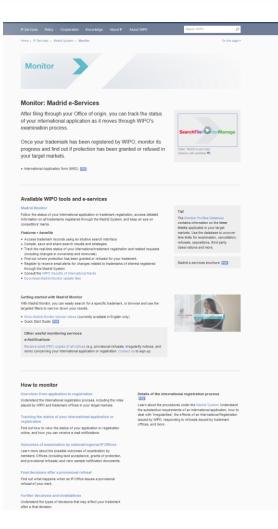


### Monitor: Question

- Do you need to log in to your WIPO account to use Madrid Monitor?
  - Yes
  - No



### **Monitor**





### Manage





### Using the Madrid System

#### **Using the Madrid System**

The Madrid System supports you throughout the lifecycle of your trademark, from application through to renewal. Use these guides to find out more about how to search for existing trademarks before you apply for protection, how to file an international application, and how to manage your international trademark registration.

#### Learn more

- . How the Madrid System works | Benefits of the Madrid System
- Making the Most of the Madrid System PDF (how to complete your international application and other forms)





Home > IP Services > Madrid System

#### **How the Madrid System Works**

#### The International Trademark Registration Process



Stage 1 - Application through your National or Regional IP Office (Office of origin)

Before you can file an international application, you need to have already registered, or have filed an application, in your "home" IP office. The registration or application is known as the **basic mark**. You then need to submit your international application through this same IP Office, which will certify and forward it to WIPO.

#### Stage 2 - Formal examination by WIPO

WIPO only conducts a formal examination of your international application. Once approved, your mark is recorded in the International Register and published in the WIPO Gazette of International Marks. WIPO will then send you a certificate of your international registration and notify the IP Offices in all the territories where you wish to have your mark protected.

#### ▶ More

Stage 3 – Substantive examination by National or Regional IP Offices (Office of the designated Contracting Party)

The IP Offices of the territories where you want to protect your mark will make a decision within the applicable time limit (12 or 18 months) in accordance with their legislation. WIPO will record the decisions of the IP Offices in the International Register and then notify you.



#### ▶ More

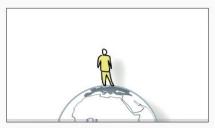
#### Moving forward

If you wish to proceed to file an application, refer to:

- · How to search before filing
- How to file an application
- How to monitor an application and registration
- How to manage a registration

#### Find out more





Video: How to use the Madrid System.



### How to

#### How to

#### Search before filing

Before filing an international application, you should search to find out if identical or similar marks already exist in your target markets. Use this guide to find out how to search WIPO's Global Brand Database before filing your application, as well as how to locate the trademark registers of national and regional trademark Offices.

### File an international application

In order to file an international application PDF, you must have already registered or applied for a mark in your "home" IP Office. Learn more about the process, including your eligibility to use the Madrid System, how to complete your application form, required fees, and how to track the status of your application as it moves through the examination process.

### Monitor an international application or registration

Once you've filed an international application with your "home" trademark office, it will be certified and sent to WIPO for examination. Learn more about the stages of the international registration process (including the roles played by WIPO and each national/regional trademark office) – including a preview of the types of documents you may receive along the way.

#### Manage your trademark registration

You can easily manage your international trademark registration through our centralized system. Find out how to renew or cancel, extend the geographical scope of protection, transfer ownership or appoint a representative, and learn more about the forms required for your requests.



### How to Search

Home > IP Services > Madrid System > How to > Search before filing

#### How to Search Before Filing: Overview

#### Overview

Why search?

Global Brand Database

National and regional IP Office databases and registers

If you discover a similar or identical mark

Related links

Before filing an international application through the Madrid System, you should search to find out if identical or similar marks already exist (or are pending) in your target markets.

Use this guide to find out how to search WIPO's Global Brand Database before filing your application, and how to locate the trademark registers of national and regional trademark Offices.



### How to File

Home > IP Services > Madrid System > How to > File your application

#### How to file your international application: Overview

# Overview Basic requirements How to file Fees Track your application e-services for filing Other related links

In order to file an international application, you must have already registered or applied for a mark in your "home" IP Office.

This guide explains more about the process, including your eligibility to use the Madrid System, how to complete your application form, required fees, and how to track the status of your application as it moves through the examination process.

#### The International Trademark Registration Process





### How to Monitor

Home > IP Services > Madrid System > How to > Monitor your International Application and Registration

#### How to Monitor your International Application: Overview

#### Overview

The international registration process

Possible outcomes of examination by members' Offices

Final decisions after a provisional refusal

After a final decision - further decisions and invalidations

Tracking your international application or registration

Other related links

Once you've filed an international application with your "home" trademark office, it will be certified and sent to WIPO for examination.

Use this guide to learn more about the stages of the international registration process (including the roles played by WIPO and each national/regional trademark office), preview the types of documents you may receive throughout the process, understand the possible outcomes of examination, and learn how to track your application or registration.



### How to Manage

Home > IP Services > Madrid System > How to > Manage your international registration

#### How to Manage your International Registration: Overview

#### Overview

Locating a WIPO reference number

Subsequent designation

Change in the holder's name, address or contact details

Change in the legal nature of the holder

Change in ownership

Representatives

Limitation

Renunciation

Cancellation

Renewal

License

Requesting a correction

Continued processing

Extracts

Fee payment methods

e-services for managing your registration

Other related links

Once your mark has been recorded in the International Register, the Madrid System makes it possible for you to manage your international registration via a single centralized system.

For instance, a single submission is sufficient to (totally or partially) transfer or renew your international registration in multiple countries/regions, or to appoint a (new) representative before WIPO. You can also record changes to the holder's name and address, request a change in ownership, or restrict the scope of your international registration.

For additional information on potential changes to your international registration, refer to the list of Madrid System forms, Making the Most of the Madrid System PDF (a guide to completing your forms), and the Guide to the International Registration of Marks under the Madrid Agreement and Protocol.



### Resources for trademarks user

#### Resources for trademark users

| Legal resources                                  | Training resources     | Other resources                                    |
|--|------------------------|--|
| Legal texts on trademarks                        | Madrid webinars        | Madrid System forms                                |
| Declarations made under the Madrid System        | Madrid seminars        | Examination Guidelines for classification of goods |
| Guide to the International Registration of Marks | Madrid video tutorials | & services PDF                                     |
| WIPO Gazette of International Marks (in Madrid   | Distance learning      | Office practices on replacement                    |
| Monitor)   | Distance learning      | Madrid System statistics                           |
| Alternative dispute resolution                   |                        | Madrid System pendency rates PDF                   |
|  |                        | Certified documents from the Madrid Registry       |
|  |                        | Warning – misleading invoices                      |



### Legal Resources

#### Legal resources

Legal texts on trademarks

Declarations made under the Madrid System

Guide to the International Registration of Marks

WIPO Gazette of International Marks (in Madrid Monitor)

Alternative dispute resolution



### Training resources

#### **Training resources**

Madrid webinars

Madrid seminars

Madrid video tutorials

Distance learning



### Other resources

#### Other resources

Madrid System forms

Examination Guidelines for classification of goods & services PDF

Office practices on replacement

Madrid System statistics

Madrid System pendency rates PDF

Certified documents from the Madrid Registry

Warning – misleading invoices



### Certified Documents: Question

- Say you would like to learn more about requesting certified documents. What other resources can you use to do so?
  - Contact Madrid and How to Manage page
  - Contact Madrid, How to Manage page or the Madrid e-Services page under Manage



### Resources for IP offices

#### Resources for IP offices

#### **Current members**

Current members of the Madrid Union have duties as both an Office of Origin and an Office of a designated Contracting Party. Learn more about members' obligations, as well as helpful tools like Madrid System statistics, model forms and provisions.

International applications and subsequent designations in progress

Madrid Office Portal

#### **Future members**

Becoming a member of the Madrid Union requires preparation. WIPO is available to help prospective members get ready for accession to the Madrid Protocol. Find out more about the preparatory work required and access tools developed specifically to help new members through the accession process.

#### **Working Group and Madrid Assembly**

Members of the Madrid System meet annually in the Working Group and the Madrid Union Assembly to discuss various matters, with the aim to improve the Madrid System for all users. Find out more about past and upcoming meetings.



### **Contact: Question**

- How can you contact the Madrid Customer Service?
  - By phone only
  - By phone and by using the Contact Madrid
  - By phone, by using Contact Madrid and by fax



### Contact

#### **Contacts**

Madrid Customer Service is on hand to answer your questions and guide you through trademark transactions and Madrid services.

Opening hours: Monday - Friday, 9:00 a.m. to 6:00 p.m. (Geneva time).

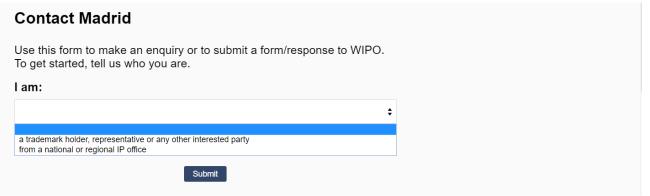
Enquiries / Form submissions / Certified documents from the Madrid Registry

- Contact Madrid
- Tel: +41 22 338 86 86



### **Contact: Question**

If you are a lawyer or attorney working in an IP office (law firm), which of those would you select?



- A trademark holder, representative or any other interested party
- From a national or regional IP office



### Related links

#### Related links

| Trademarks                 | Reference                             | Other IP services                       |
|----------------------------|---------------------------------------|---|
| Meetings on trademarks     | Laws & Treaties                       | Hague System (industrial designs)       |
| Trademark statistics       | Nice Classification                   | Article 6ter (emblems)                  |
| Case studies on trademarks | Vienna Classification                 | Lisbon System (appellations of origin)  |
|                            | Standards (country codes, INID codes) | PCT System (patents)                    |
|                            | IP Office directory                   | Alternative dispute resolution services |
|                            |                                       | Domain name disputes                    |





### Q&A Session about the Webinar

Julia Makoy

Lucía J. Yanguas

Information and Promotion Division

### Keep Updated on the Madrid System

- Visit the Madrid Website
- Access <u>Madrid Webinar</u> recordings and stay tuned for new topics
- Play our <u>Madrid 'How-to'</u> videos
- Subscribe to <u>Madrid Notices</u>
- Contact us: Contact Madrid



