

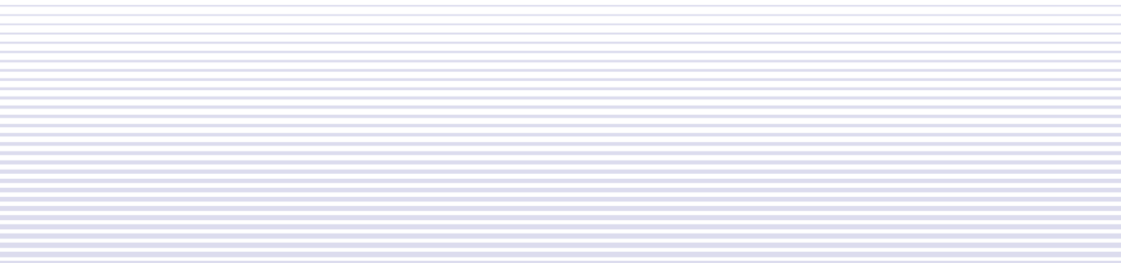


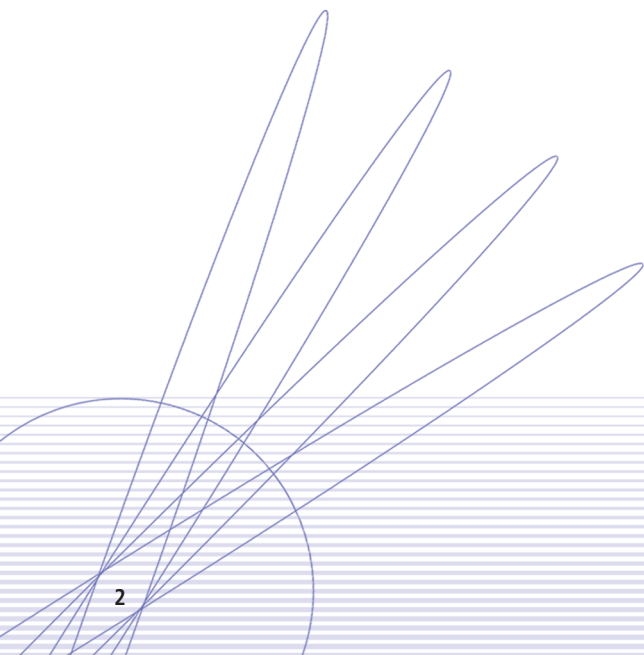
Madrid System

**The Madrid Agreement Concerning
the International Registration
of Marks and the Protocol Relating
to that Agreement: Objectives,
Main Features, Advantages**



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Introduction

1. The system of international registration of marks is governed by two treaties: the Madrid Agreement Concerning the International Registration of Marks, which dates from 1891, and the Protocol Relating to the Madrid Agreement, which was adopted in 1989, entered into force on December 1, 1995, and came into operation on April 1, 1996. Common Regulations under the Agreement and Protocol also came into force on that date. The system is administered by the International Bureau of WIPO, which maintains the International Register and publishes the *WIPO Gazette of International Marks*.

2. Any State which is a party to the Paris Convention for the Protection of Industrial Property may become a party to the Agreement or the Protocol or both. In addition, an intergovernmental organization may become a party to the Protocol (but not the Agreement) where the following conditions are fulfilled: at least one of the Member States of the organization is a party to the Paris Convention and the organization maintains a regional office for the purposes of registering marks with effect in the territory of the organization.

3. States party to the Agreement and/or the Protocol and organizations party to the Protocol are referred to collectively as Contracting Parties. A list of the Contracting Parties can be found at <http://www.wipo.int>. Together, they constitute the Madrid Union, which is a Special Union under Article 19 of the Paris Convention.

4. Every member of the Madrid Union is a member of its Assembly. Among the most important tasks of the Assembly are the adoption of the program and budget of the Union and the adoption and modification of the implementing regulations, including the fixing of fees connected with the use of the Madrid system.



Objectives

5. The objectives of the system are two-fold. Firstly, it facilitates the obtaining of protection for marks (trademarks and service marks). The registration of a mark in the International Register produces, in the Contracting Parties designated by the applicant, the effects described in paragraph 31, below. Further Contracting Parties may be designated subsequently. Secondly, since an international registration is equivalent to a bundle of national registrations, the subsequent management of that protection is made much easier. There is only one registration to renew, and changes such as a change in ownership or in the name or address of the holder, or a limitation of the list of goods and services, can be recorded in the International Register through a single simple procedural step. On the other hand, if it is desired to transfer the registration for only some of the designated Contracting Parties, or for only some of the goods or services, or to limit the list of goods and services with respect to only some of the designated Contracting Parties, the system is flexible enough to accommodate this.

Who May Use the Madrid System?

6. An application for international registration (an “international application”) may be filed only by a natural person or a legal entity which has a real and effective industrial or commercial establishment in, or is domiciled in, or is a national of, a country which is party to the Madrid Agreement or the Madrid Protocol, or who has such an establishment in, or is domiciled in, the territory of an intergovernmental organization which is a party to the Protocol, or is a national of a Member State of such an organization.

7. The Madrid system of international registration cannot be used by a person or legal entity which does not have the necessary connection, through establishment, domicile or nationality, with a member of the Madrid Union. Nor can it be used to protect a mark outside the Madrid Union.

The International Application

8. A mark may be the subject of an international application only if it has already been registered (or, where the international application is governed exclusively by the Protocol, if registration has been applied for) in the Trademark Office of the Contracting Party with which the applicant has the necessary connection, as described in paragraph 6, above, to be able to file an international application. This Office is referred to as the Office of origin.

9. An international application must be presented to the International Bureau through the Office of origin. An international application which is presented direct to the International Bureau by the applicant will not be considered as such and will be returned to the sender.

10. The international application must contain, *inter alia*, a reproduction of the mark (which must be identical with that in the basic registration or basic application) and a list of the goods and services for which protection is sought, classified in accordance with the International Classification of Goods and Services (Nice Classification).

11. An international application may claim priority under Article 4 of the Paris Convention, whether from the application with the Office of origin or from a prior application filed with the Office of another country party to the Paris Convention or with the Office of a Member of the World Trade Organization.

12. An international application must designate the Contracting Parties in which the mark is to be protected. Where the Contracting Party whose Office is the Office of origin is a party to the Agreement but not the Protocol, only other States which are also party to the Agreement may be designated. Where the Contracting Party whose Office is the Office of origin is a party to the Protocol but not the Agreement, only other Contracting Parties which are also party to the Protocol may be designated. Where the Contracting Party whose Office is the Office of origin is a party to both the Agreement and the Protocol, any other Contracting Party may be designated.



13. The Contracting Party whose Office is the Office of origin, cannot be designated in an international application; nor can it be designated subsequently.

14. The designation of a given Contracting Party is made under that treaty (Agreement or Protocol) which is common to the designated Contracting Party and the Contracting Party whose Office is the Office of origin. Where both Contracting Parties are party to both the Agreement and the Protocol, it is the Protocol which governs the designation.

15. There are therefore three kinds of international application:

- an international application *governed exclusively by the Agreement*; this means that all the designations are made under the Agreement;
- an international application *governed exclusively by the Protocol*; this means that all the designations are made under the Protocol;
- an international application *governed by both the Agreement and the Protocol*; this means that some of the designations are made under the Agreement and some under the Protocol.

16. An international application can be filed in any one of the three languages of the Madrid system, namely, English, French or Spanish. The Office of origin may, however, restrict the applicant's choice to only one language, or to two languages, or may permit the applicant to choose between any of the three languages.

17. The international application is subject to the payment of the following fees:

- a basic fee;
- a complementary fee in respect of each designated Contracting Party for which no individual fee is payable;
- a supplementary fee in respect of each class of goods and services beyond the third; no supplementary fee is payable however where *all* the designations are ones in respect of which an individual fee has to be paid.

18. Article 8(7) of the Protocol provides that a Contracting Party may declare that, instead of a share in the revenue produced by the supplementary and complementary fees, it wishes to receive an individual fee. Nevertheless,

Article 9sexies(1)(b) renders inoperative a declaration under Article 8(7) in the mutual relations between Contracting Parties to both the Agreement and Protocol. In other words, where the designated Contracting Party having made the declaration is a party to both the Agreement and the Protocol and the Contracting Party whose Office is the Office of origin is also a party to both treaties, it follows from Article 9sexies(1)(b) that the supplementary and complementary fees, and not the individual fee, are payable. The amount of the individual fee is determined by each Contracting Party; it may not be higher than the amount that would be payable for the registration of a mark in the Office of that Contracting Party. The amounts of the respective individual fees are published in the Gazette and are also available on the WIPO website.

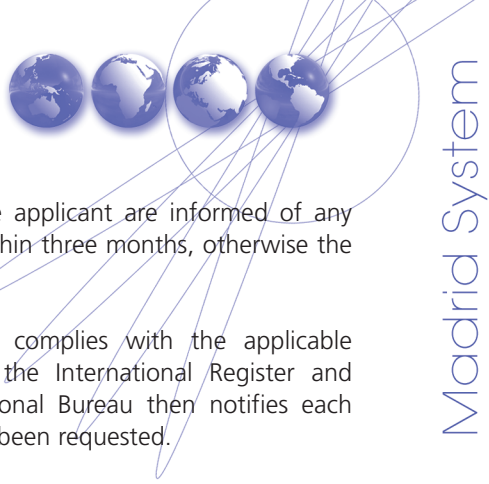
19. For international applications filed by applicants whose country of origin is a Least Developed Country, in accordance with the list established by the United Nations, the basic fee is reduced to 10% of the prescribed amount.

20. These fees may be paid direct to the International Bureau or, where the Office of origin accepts to collect and forward such fees, through that Office.

21. The Office of origin must certify that the mark is the same as that in the basic registration or basic application, that any indications such as a description of the mark or a claim to color as a distinctive feature of the mark are the same as those contained in the basic registration or basic application, and that the goods and services indicated in the international application are covered by the list of goods and services in the basic registration or basic application.

22. The Office of origin must also certify the date on which it received the request to present the international application. This date is important; provided the application is received by the International Bureau within two months of that date (and provided that certain crucial elements are not missing), it is that date that will be the date of the international registration.

23. The International Bureau checks that the international application complies with the requirements of the Agreement or Protocol and the Common Regulations, including requirements relating to the indication of goods and services and their classification, and that the required fees have



been paid. The Office of origin and the applicant are informed of any irregularities; these must be remedied within three months, otherwise the application will be considered abandoned.

24. Where the international application complies with the applicable requirements, the mark is recorded in the International Register and published in the Gazette. The International Bureau then notifies each Contracting Party in which protection has been requested.

***Examination by the Office of a Designated Contracting Party;
Refusal of Protection***

25. The Office of a designated Contracting Party examines the international registration in exactly the same way as an application filed directly. If grounds for objection are found during the *ex officio* examination, or if an opposition is filed, the Office has the right to declare that protection cannot be granted to the mark in that Contracting Party.

26. Any provisional refusal must be notified to the International Bureau by the Office of the Contracting Party concerned within the time limit specified in the Agreement or Protocol. This standard time limit is 12 months. A Contracting Party may however declare that, when it is designated under the Protocol, this time limit shall be replaced by 18 months. A Contracting Party that has made this declaration may further declare that a provisional refusal based on an opposition may be notified even after the expiry of this 18-month period.

27. Notwithstanding the general principle that the Protocol applies between States bound by both the Agreement and the Protocol, subparagraph (1)(b) of Article 9*sexies* of the Protocol renders inoperative a declaration extending the refusal period in the mutual relations between States bound by both treaties. What this means, in effect, is that in the case of an international application where the Office of origin is the Office of a Contracting Party bound by both treaties, a designation of a Contracting Party bound by both treaties will, while being governed by the Protocol, and not the Agreement, nevertheless be subject to the standard refusal regime – that is, the time limit of one year for the notification of a provisional

refusal, notwithstanding that the designated Contracting Party in question may have declared an extended period for notifying a provisional refusal.

28. The provisional refusal is recorded in the international Register and published in the Gazette and a copy is transmitted to the holder of the international registration.

29. Any procedure subsequent to the refusal, such as review, appeal or response to an opposition, is carried out directly between the holder and the Office concerned, without any involvement on the part of the International Bureau. However, once all the procedures before that Office have been completed, the Office must send to the International Bureau a final statement. Depending upon the outcome of the case, such statement will confirm either that protection for the mark has been totally refused (*Confirmation of Total Provisional Refusal*), or that protection has been partially or totally granted to the mark, as the case may be (*Statement of Grant of Protection Following a Provisional Refusal*). This statement is recorded in the International Register, published in the Gazette and a copy is transmitted to the holder of the International Registration.

30. Where, before the expiry of the refusal period, all the procedures before an Office have been completed and the Office has found no grounds to refuse protection, the Office shall, as soon as possible, (and before the expiry of the refusal period), send to the International Bureau a statement to the effect that protection is granted to the mark (*Statement of Grant of Protection where no Notification of Provisional Refusal has been Communicated*)¹. Such statement is recorded in the International Register and published in the Gazette and a copy is transmitted to the holder of the international registration.

Effects of the International Registration

31. From the date of the international registration (or, in the case of a Contracting Party designated subsequently, from the date of that designation), the protection of the mark in each of the designated

¹ Currently, this is not obligatory, but it will become so as from January 1, 2011.



Contracting Parties is the same as if the mark had been the subject of an application for registration filed direct with the Office of that Contracting Party. If no provisional refusal is notified to the International Bureau within the relevant time limit, or if any such refusal is subsequently withdrawn, the protection of the mark in each designated Contracting Party is the same as if it had been registered by the Office of that Contracting Party.

32. An international registration is therefore equivalent to a bundle of national registrations. Although it is a single registration, protection may be refused by some of the designated Contracting Parties, or the protection may be limited or renounced with respect to only some of the designated Contracting Parties. Likewise an international registration may be transferred to a new owner with respect to only some of the designated Contracting Parties. An international registration may also be invalidated (for example, for non-use) with respect to one or more of the designated Contracting Parties. Moreover, any action for infringement of an international registration must be brought separately in each of the Contracting Parties concerned.

33. This is in contrast to a unitary regional right such as the Community trademark, which cannot be refused, limited or transferred with effect for only a part of the territory covered by the right, and which may be enforced by a single legal action covering infringement occurring anywhere in that territory.

Dependence on the Basic Mark

34. For a period of five years from the date of its registration, an international registration remains dependent on the mark registered or applied for in the Office of origin. If, and to the extent that, the basic registration ceases to have effect, whether through cancellation following a decision of the Office of origin or a court, through voluntary cancellation or through non-renewal, within this five-year period, the international registration will no longer be protected. Similarly, where the international registration was based on an application in the Office of origin, it will be canceled if, and to the extent that, that application is refused or withdrawn within the five-year period, or if, and to the extent that, the registration resulting from that application ceases to have effect within that period.

35. The Office of origin is required to notify the International Bureau of facts and decisions concerning such ceasing of effect or refusal and, where appropriate, to request the cancellation (to the extent applicable) of the international registration. The cancellation is published in the Gazette and notified to the designated Contracting Parties.

36. If, within three months of such cancellation, the holder files an application for registration with the Office of a Contracting Party that had been designated under the Protocol, that application will be treated as if it had been filed on the date of the international registration or (as the case may be) the subsequent designation of the Contracting Party concerned. This option is not available in the case of a Contracting Party designated under the Agreement.

37. After the expiry of the period of five years mentioned in paragraph 34, the international registration becomes independent of the basic registration or basic application.

Replacement of a National or Regional Registration by an International Registration

38. An international registration is deemed to replace a national or regional registration for the same mark and the same goods and services recorded in the name of the same person in a designated Contracting Party. The effect of replacement is that, if the national or regional registration is not renewed, the holder of the international registration may continue to benefit from the earlier rights acquired by reason of that national or regional registration. Although replacement takes place automatically, the holder of the international registration may request the Office of the Contracting Party in which the national or regional registration is recorded to take note in its register of the international registration.



Subsequent Designation

39. The effects of an international registration can be extended to a Contracting Party not covered by the international application by filing a subsequent designation. Thus the holder of an international registration can expand the geographical scope of the protection of his mark in line with his business needs. Moreover a subsequent designation may be made in order to extend the protection of the mark to a Contracting Party which was not a party to the Agreement or Protocol at the time of the international application. The principles that determine whether such a designation can be made, and whether it is governed by the Agreement or by the Protocol, are as described in paragraphs 12 and 13, above.

Changes in the International Register; Cancellation; Licenses

40. A change in the name or address of the holder or his representative may be recorded in the International Register on request.

41. Likewise a change in the ownership of an international registration may be recorded, in respect of all or some of the goods and services and all or some of the designated Contracting Parties. A person may not however be recorded as the holder of an international registration in respect of a given Contracting Party if he would not be entitled (in accordance with the principles set out in paragraphs 12 and 13, above), to designate that Contracting Party in an international application. Thus, for example, a person who does not have a connection with a country which is a party to the Agreement may not be recorded as the holder of an international registration in respect of a designated Contracting Party which is a party only to the Agreement.

42. The following may also be recorded in the International Register:

- a *limitation* of the list of goods and services in respect of **all or some** of the designated Contracting Parties;
- a *renunciation* in respect of **some** of the designated Contracting Parties for **all** the goods and services;

- a *cancellation* of the international registration in respect of **all** the designated Contracting Parties for **all or some** of the goods and services;
- a *license* granted in respect of **all or some** of the designated Contracting Parties, and for **all or some** of the goods and services.

43. Information concerning such changes, cancellation and licenses is published in the Gazette and notified to the designated Contracting Parties.

44. No change may be made in the mark that is the subject of an international registration, either on renewal or at any other time. Nor may the list of goods and services be changed in a way that would extend the scope of protection.

Duration of Registration; Renewal

45. An international registration is effective for 10 years. It may be renewed for further periods of 10 years on payment of the prescribed fees. The International Bureau sends a reminder to the holder and to his representative (if any) six months before renewal is due.

46. The international registration may be renewed in respect of all the designated Contracting Parties or in respect of only some of them. It may not however be renewed in respect of only some of the goods and services recorded in the International Register; if therefore the holder wishes, at the time of renewal, to remove some of the goods and services from the international registration, he must separately request cancellation in respect of those goods and services.

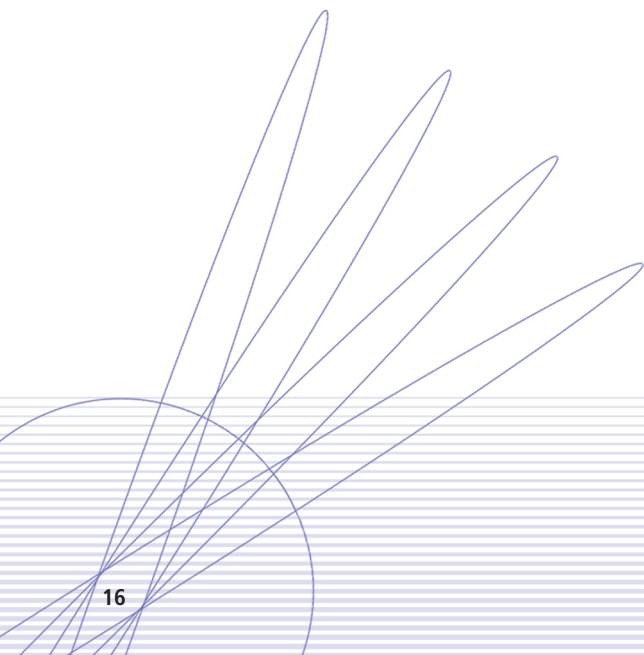


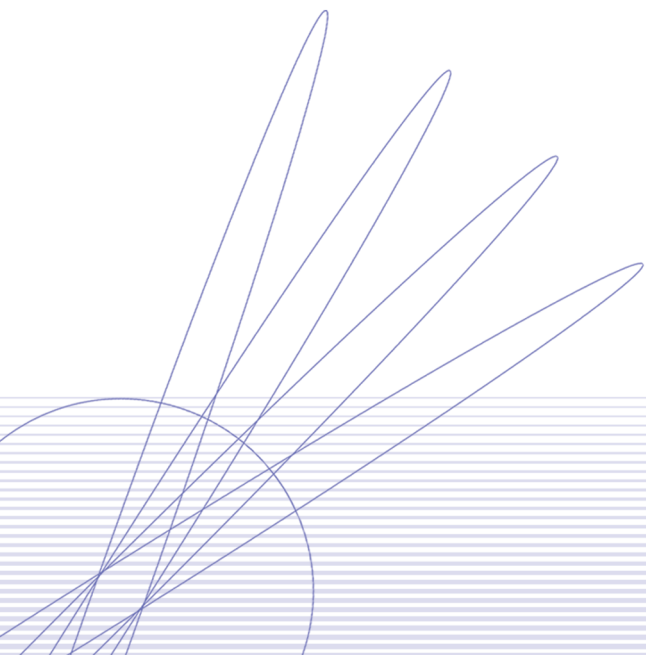
Advantages of the System

47. International registration has several advantages for the owner of the mark. After registering the mark, or filing an application for registration, with the Office of origin, he has only to file one application, in one language, and pay one fee instead of filing separately in the trademark Offices of the various Contracting Parties in different languages and paying a separate fee in each Office. Moreover, the holder does not have to wait for the Office of each Contracting Party in which protection is sought to take a positive decision to register the mark; if no refusal is notified by an Office within the applicable time limit, the mark is protected in the Contracting Party concerned. In some cases, the holder does not even have to wait the expiry of this time limit in order to know that the mark is protected in a Contracting Party, since he may, before the expiry of the time limit, receive a statement of grant of protection from the Office of that Contracting Party.

48. A further important advantage is that changes subsequent to registration, such as a change in the name or address of the holder, or a change (total or partial) in ownership or a limitation of the list of goods and services may be recorded with effect for several designated Contracting Parties through a single simple procedural step and the payment of a single fee. Moreover, there is only one expiry date and only one registration to renew.

49. International registration is also to the advantage of Trademark Offices. They do not need to examine for compliance with formal requirements, or classify the goods or services, or publish the marks. Moreover, they are compensated for the work that they perform; the individual fees collected by the International Bureau are transferred to the Contracting Parties in respect of which they have been paid, while the complementary and supplementary fees are distributed annually among the Contracting Parties not receiving individual fees, in proportion of the number of designations made of each of them. If the International Registration Service closes its biennial accounts with a profit, the proceeds are divided among the Contracting Parties.





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