



Introducing the Madrid Protocol

**Madrid Protocol Seminars
New Zealand 2012**

What is the Madrid System?

- The Madrid system is a global trademark registration system, enabling trademark owners to obtain protection in several countries by means of a single international application
- One central filing, registration and maintenance procedure producing effects in one or more territories bound by the system
- The Madrid system is simply a centralized filing mechanism, a one-stop approach to obtain broad geographic trademark protection in export markets

Protecting a trademark abroad

- Two options
- The national/regional route: filing applications with the trademark office of each country in which protection of the mark is sought
- The international route: **the Madrid System**

Legal Framework

Madrid System
Concerning the
International
Registration of Marks

Madrid Agreement (1891)

Madrid Protocol (1989)

Common Regulations (1996)

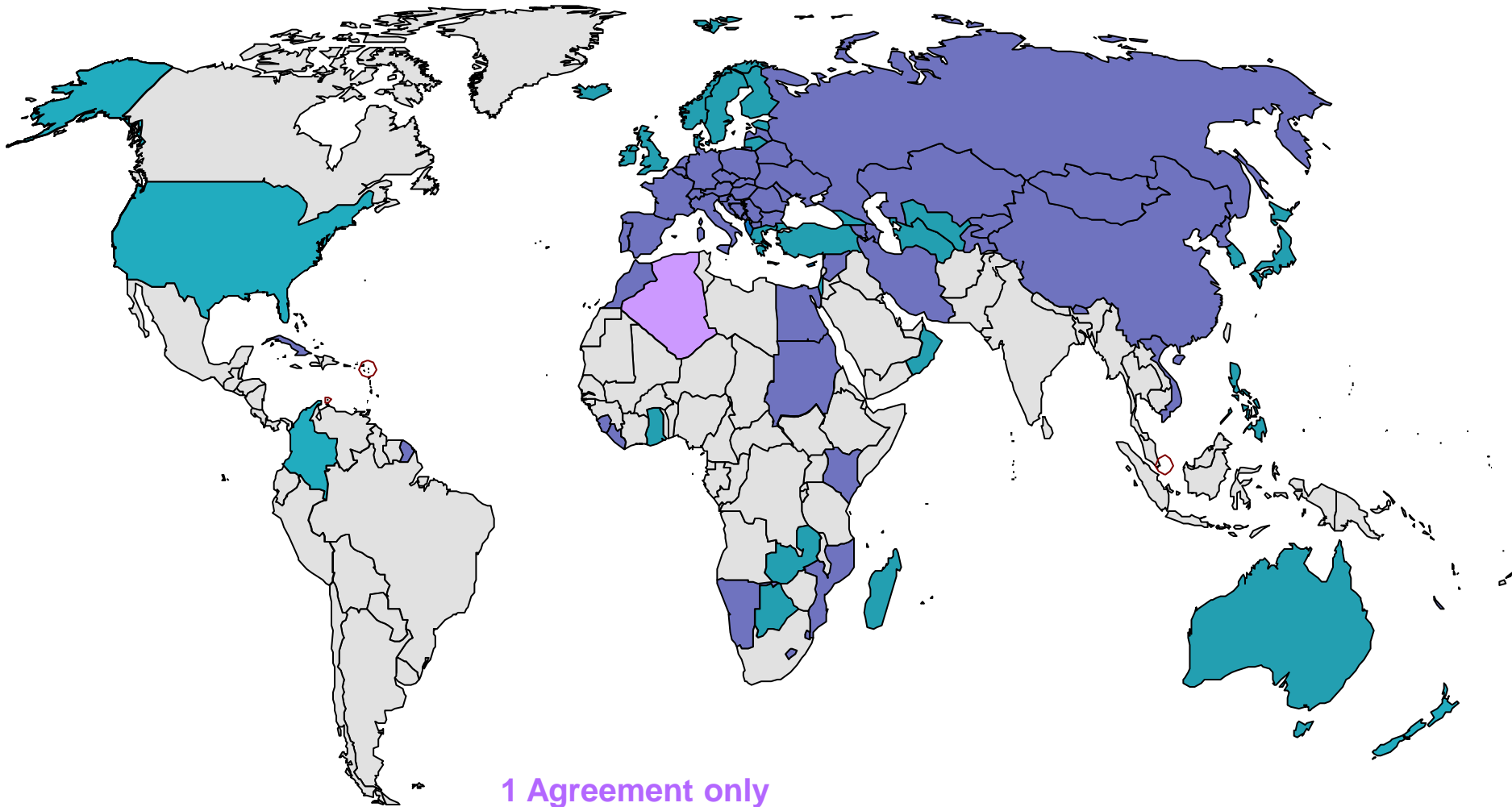
Administrative Instructions (2002)

National Laws & Regulations

The scope of the Madrid System

- The Madrid system of international registration of marks is a purely procedural treaty.
- It does **NOT** determine :
 - the conditions for protecting a trademark
 - the procedure to be applied in order to decide whether a mark may be protected
 - the rights which result from protection
- All these determinations are governed by the domestic legislation in countries where protection is sought

Madrid Union



1 Agreement only

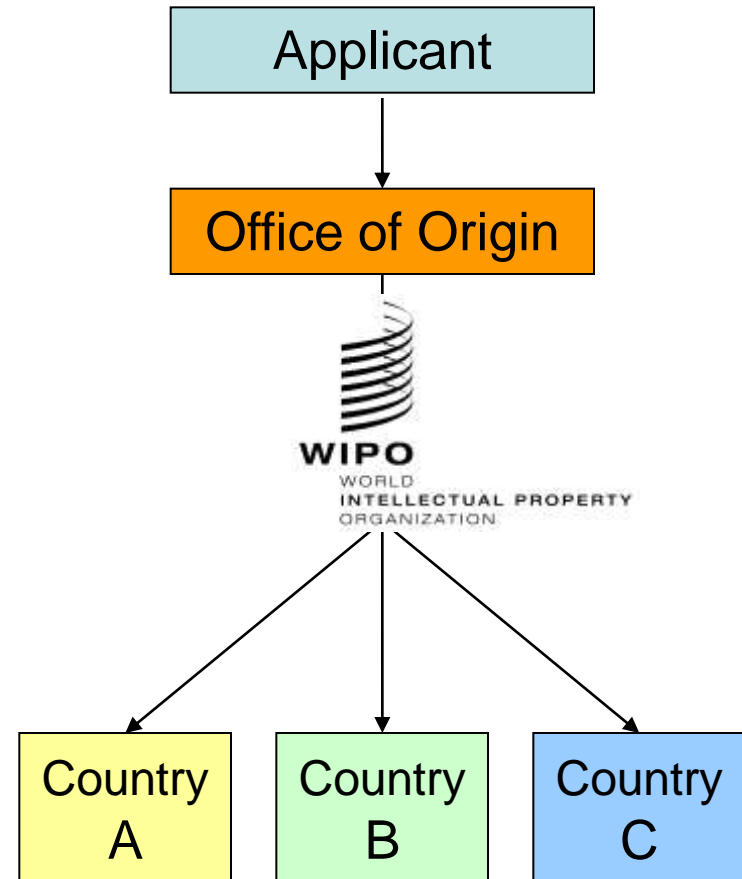
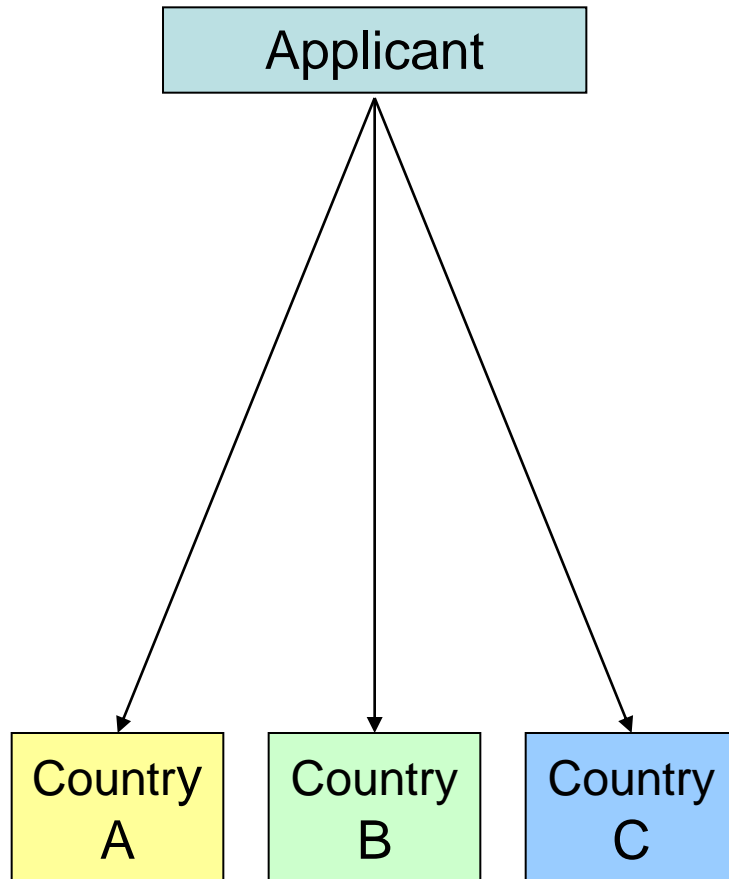
32 Protocol only (including EU)

55 Agreement and Protocol

88 Members

WIPO | MADRID
The International
Trademark System

National Route vs. Madrid Route



The National Route vs. the Madrid Route

- | | |
|---------------------------------------|---|
| ■ Many Offices for filing | ■ One Office for filing |
| ■ Many application forms | ■ One single application form |
| ■ Many languages | ■ One language (E/F/S) |
| ■ Many currencies | ■ One currency (CHF) |
| ■ Many registrations | ■ One international registration |
| ■ Many renewals | ■ One renewal |
| ■ Many modifications | ■ One modification |
| ■ Foreign attorney needed from filing | ■ Foreign attorney only needed in case of refusal |

Who can use the Madrid System?

- **Entitlement:** a natural person or legal entity in NZ that :
 - Has a real and effective industrial or commercial establishment
 - Is domiciled in NZ
 - Is a national of NZ
- **Basic Mark:** applicant must have a domestic registration in NZ, or has filed an application for registration with IPONZ
- **An International Application:** (same holder, same mark, same goods and services or less), must be presented to the International Bureau via IPONZ

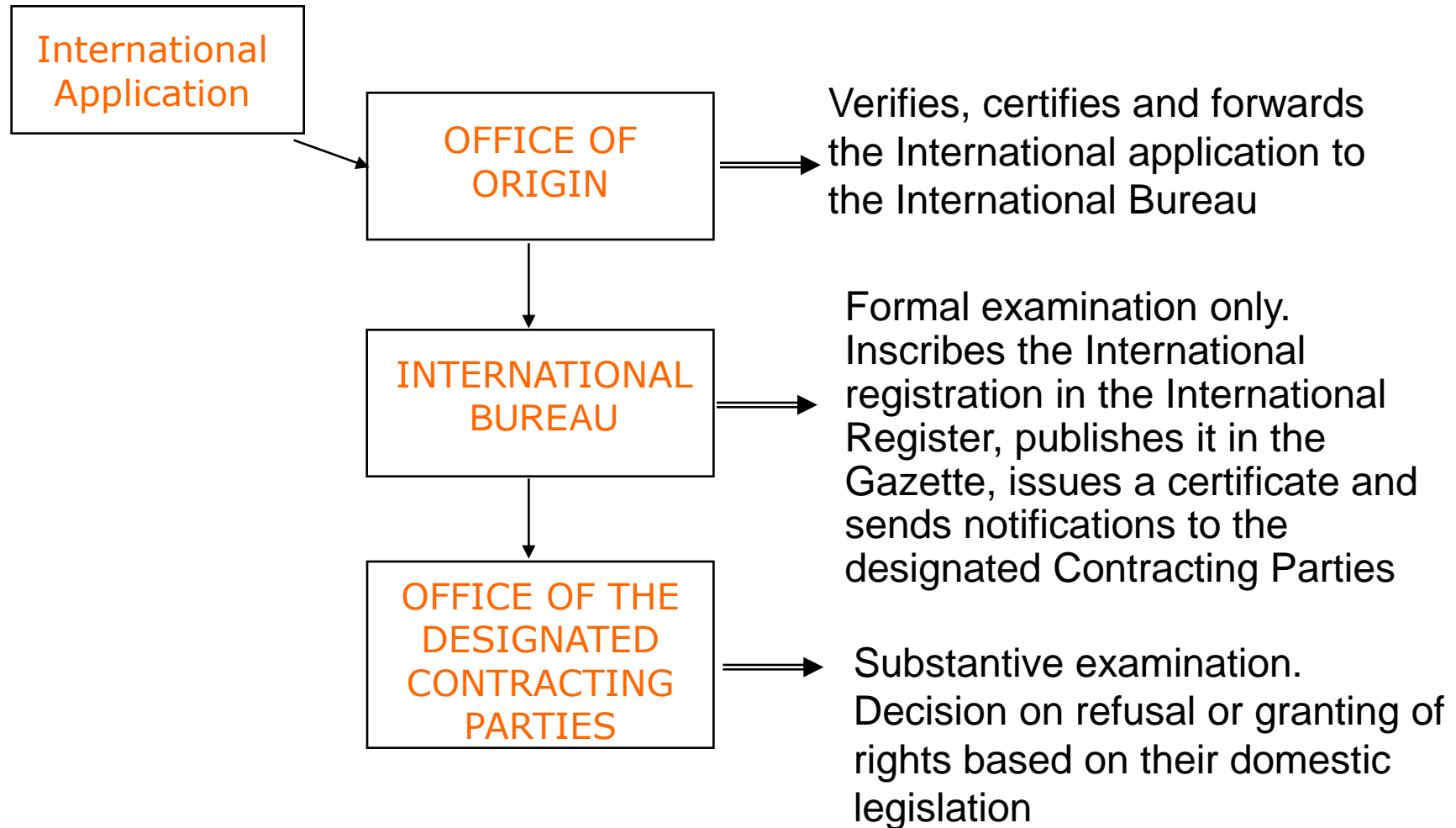
Basic features

- An international application may be based on one or more domestic applications or registrations
- The fees payable in connection with the application
 - The basic fee (CHF 653 or 903)
 - An individual fee for each country for which protection is sought (ie each designated Contracting Party)
- Scope of protection – to be determined by designated Contracting Party
- designated Contracting Party refuses or grants protection within 12/18 months

Basic features

- The 5 years dependency period – the IR is dependant on the basic mark for 5 years – monitored by the Office of origin
- Ceasing of effects (withdrawal, lapse, renunciation, final decision of rejection, cancellation or invalidation)
- Transformation of the IR into national applications
- 10 year terms of protection
- Subsequent designation, and maintenance of the international registration

International Registration Procedure



Effects of the International Registration

- The effects of the international registration extend to the Contracting Parties expressly designated in the international registration
- An international registration can be compared to a bundle domestic applications, with protection as from the date of the international registration
- An international registration can be compared to a domestic registration in the absence of refusal (after 12/18 months)

Managing an International Registration

- Renewal every ten years
 - It may be renewed on payment of the necessary fees with the International Bureau
- Recording of changes by means of a single request which has effect in all or a part of the designated Contracting Parties and for all or part of the goods and services
- Forms for recordal of change in ownership, limitation of the list of goods/services, renunciation, cancellation of the IR, change in name and/or address of the holder or the representative, renewals, appointment of a representative, recording of or amendment to a license

Advantages of the Madrid system

- One international application based on one or more basic applications/registrations
- One language (English, French or Spanish)
- One set of fees in, one currency (CHF)
- One registration number, and one renewal date
- Broad geographic effect

Thank You