



**OFFICE FOR HARMONIZATION
IN THE INTERNAL MARKET**
TRADE MARKS AND DESIGNS

National, regional and international protection

The international application system Madrid Agreement / Madrid Protocol

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Cluj-Napoca 20 June 2011



WHAT WE WILL COVER

- Comparison national, regional and international system - Refresh
- International system:
 - Madrid Agreement and/or Madrid Protocol for trade marks
- The registration of international trade marks via the Madrid Protocol
 - The CTM as a basis for an international application
 - Designating the EC in an international application



Comparison of the different systems: Refresh

- National systems
- Community trade mark system
- International system
 - Madrid Agreement (since 1891)
 - Madrid Protocol for trade marks (since 1996)

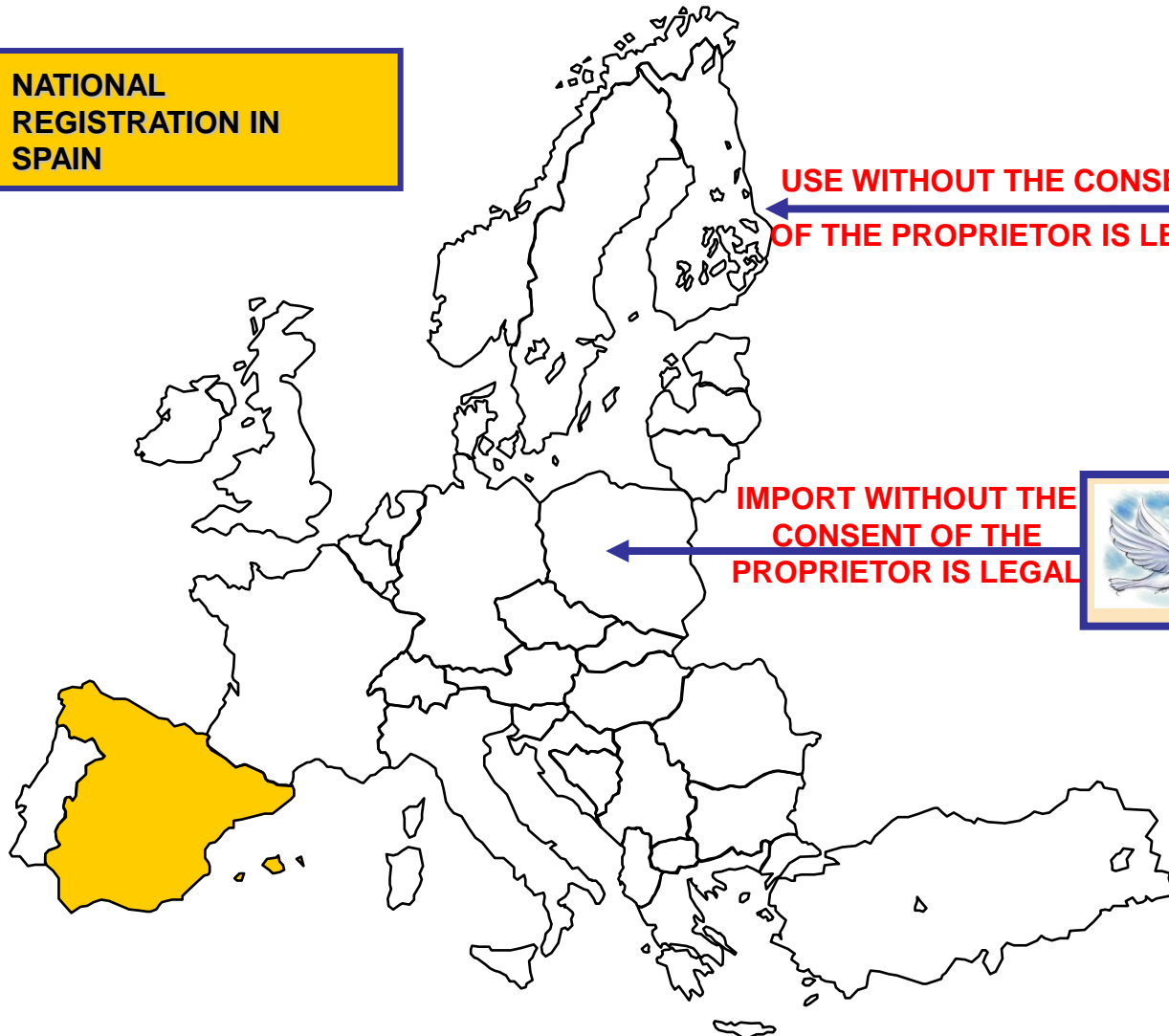
Or a combination of these systems

At the free choice of the applicant.



National protection

 NATIONAL
REGISTRATION IN
SPAIN



**USE WITHOUT THE CONSENT
OF THE PROPRIETOR IS LEGAL**



**IMPORT WITHOUT THE
CONSENT OF THE
PROPRIETOR IS LEGAL**





National protection

- Protection for national territory only
- To be filed in the language of the country
- Representation before the office
- Specific procedures in each country
- Enforcement
 - National courts
 - Border enforcement
- Lower cost



Community protection

- OHIM (Alicante, Spain)
- Uniform protection throughout the whole Community
- Reduced administrative burden
 - Language choice: 22 languages of the EU
 - One date to be observed
 - Only 1 Office to deal with and to decide on registration
- No need for a prior national application
- Enforcement
 - Community trade mark courts
 - Border enforcement
- One set of fees (already reduced twice, on 22/10/2005 and on 1/05/2009)
- Specific for trade marks: Obligation to use easy to be met.

International Trade Marks



 INTERNATIONAL
REGISTRATION IN
DE, AT, CH, FR, IT



**USE WITHOUT THE CONSENT
OF THE PROPRIETOR IS LEGAL**



**IMPORT WITHOUT THE
CONSENT OF THE
PROPRIETOR IS LEGAL**





International protection system

→ WIPO (Geneva, Switzerland)

Trade marks: the Madrid system

- Madrid Protocol
 - 81 Countries party
- Madrid Agreement
 - 56 Countries party



International protection system

- Need for a basic application (or registration)
- One application filed directly to the National or Regional trademark office, the so called Office of Origin.
- Management of multi-national applications Centralized at the WIPO: Reduced administrative burden for filing.
- WIPO languages:
 - Agreement: FR
 - Protocol: EN, FR, ES
- Date of Reception at the Office of Origin
= Registration Date of the International TM



International protection system

- Bundle of national rights: national offices decide on the ultimate registrability
- Enforcement
 - National courts
 - Border enforcement
- Representative before WIPO not compulsory



International protection system

- Usually more economic than the direct route
- Same grant of protection as with national registrations
- Shorter examination period (than in some countries that might take up to 4 years)
- Pre-established examination and refusal period



International protection system

- Obligation to use the trade mark in each individual country,
- otherwise possible loss of right in respective country

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State/IGO	Date on which State became party to the Madrid Agreement ²	Date on which State/IGO became party to the Madrid Protocol (1989)
Albania	October 4, 1995	July 30, 2003
Algeria	July 5, 1972	—
Antigua and Barbuda	—	March 17, 2000
Armenia	December 25, 1991	October 19, 2000 ^{6,10}
Australia	—	July 11, 2001 ^{5,6}
Austria	January 1, 1909	April 13, 1999
Azerbaijan	December 25, 1995	April 15, 2007
Bahrain	—	December 15, 2005 ¹⁰
Belarus	December 25, 1991	January 18, 2002 ^{6,10}
Belgium	July 15, 1892 ³	April 1, 1998 ^{3,6}
Bhutan	August 4, 2000	August 4, 2000
Bosnia and Herzegovina	March 1, 1992	January 27, 2009
Botswana	—	December 5, 2006
Bulgaria	August 1, 1985	October 2, 2001 ^{6,10}
China	October 4, 1989 ⁴	December 1, 1995 ^{4,5,6}
Croatia	October 8, 1991	January 23, 2004
Cuba.....	December 6, 1989	December 26, 1995
Cyprus	November 4, 2003	November 4, 2003 ⁵
Czech Republic.....	January 1, 1993	September 25, 1996
Democratic People's Republic of Korea	June 10, 1980	October 3, 1996
Denmark	—	February 13, 1996 ^{5,6,7}
Egypt	July 1, 1952	September 3, 2009
Estonia	—	November 18, 1998 ^{5,6, 8}
European Union.....	—	October 1, 2004 ^{6,10}
Finland.....	—	April 1, 1996 ^{5,6}
France	July 15, 1892 ⁹	November 7, 1997 ⁹
Georgia	—	August 20, 1998 ^{6,10}
Germany	December 1, 1922	March 20, 1996
Ghana.....	—	September 16, 2008 ^{5,6}
Greece.....	—	August 10, 2000 ^{5,6}
Hungary.....	January 1, 1909	October 3, 1997
Iceland	—	April 15, 1997 ^{6,10}
Iran (Islamic Republic of)	December 25, 2003	December 25, 2003 ⁵

http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/madrid_marks.pdf

Iran (Islamic Republic of)	December 25, 2003	December 25, 2003 ⁵
Ireland	—	October 19, 2001 ^{5,6}
Italy	October 15, 1894	April 17, 2000 ^{5,6}
Japan	—	March 14, 2000 ^{6,10}
Kazakhstan	December 25, 1991	—
Kenya	June 26, 1998	June 26, 1998 ⁵
Kyrgyzstan	December 25, 1991	June 17, 2004 ⁶
Latvia	January 1, 1995	January 5, 2000
Lesotho	February 12, 1999	February 12, 1999
Liberia	December 25, 1995	December 11, 2009
Liechtenstein	July 14, 1933	March 17, 1998
Lithuania	—	November 15, 1997 ⁵
Luxembourg	September 1, 1924 ³	April 1, 1998 ^{3,6}
Madagascar	—	April 28, 2008 ¹⁰
Monaco	April 29, 1956	September 27, 1996
Mongolia	April 21, 1985	June 16, 2001
Montenegro	June 3, 2006	June 3, 2006
Morocco	July 30, 1917	October 8, 1999
Mozambique	October 7, 1998	October 7, 1998

http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/madrid_marks.pdf - Windows Int...

Namibia	June 30, 2004	June 30, 2004 ⁵
Netherlands	March 1, 1893 ^{3,11}	April 1, 1998 ^{3,6,11}
Norway	—	March 29, 1996 ^{5,6}
Oman	—	October 16, 2007 ¹⁰
Poland	March 18, 1991	March 4, 1997 ¹⁰
Portugal	October 31, 1893	March 20, 1997
Republic of Korea	—	April 10, 2003 ^{5,6}
Republic of Moldova	December 25, 1991	December 1, 1997 ⁶
Romania	October 6, 1920	July 28, 1998
Russian Federation	July 1, 1976 ¹²	June 10, 1997
San Marino	September 25, 1960	September 12, 2007 ^{6,10}
Sao Tome and Principe	—	December 8, 2008
Serbia ¹³	April 27, 1992	February 17, 1998
Sierra Leone	June 17, 1997	December 28, 1999
Singapore	—	October 31, 2000 ^{5,6}
Slovakia	January 1, 1993	September 13, 1997 ¹⁰
Slovenia	June 25, 1991	March 12, 1998
Spain	July 15, 1892	December 1, 1995
Sudan	May 16, 1984	February 16, 2010
Swaziland	December 14, 1998	December 14, 1998
Sweden	—	December 1, 1995 ^{5,6}
Switzerland	July 15, 1892	May 1, 1997 ^{6,10}
Syrian Arab Republic	August 5, 2004	August 5, 2004
Tajikistan	December 25, 1991	—
The former Yugoslav Republic of Macedonia	September 8, 1991	August 30, 2002
Turkey	—	January 1, 1999 ^{5,6,8}
Turkmenistan	—	September 28, 1999 ^{6,10}
Ukraine	December 25, 1991	December 29, 2000 ^{5,6}
United Kingdom	—	December 1, 1995 ^{5,6,14}
United States of America	—	November 2, 2003 ^{5,6}
Uzbekistan	—	December 27, 2006 ^{6,10}
Viet Nam	March 8, 1949	July 11, 2006 ⁸
Zambia	—	November 15, 2001
Total: (84)	(56)	(81)



Madrid Agreement / Madrid Protocol

Intl. application has to be based on a <u>registration</u> in Office of Origin	Intl. application <u>may</u> be based on an <u>application</u> in Office of Origin
Communication in French	Communication in French, English, and Spanish
Registration for 20 years, paid in 10 year intervals	Registration for 10 years
12 month period to issue a refusal	Period to issue a refusal <u>may</u> be extended up to 18 months
No transformation of application after a central attack	Transformation of application after a central attack possible
Countries of the Madrid Agreement can be designated	Countries of the Madrid Protocol can be designated



Madrid Protocol: who may file?

- Applicant can file application only in its “home country”
 - National of member country
 - Entity domiciled in member country
 - Entity with a “real and effective industrial or commercial establishment” in member country



Madrid Protocol: Overview Application procedure

- Need of a “Basic application” in Home Country
 - Application or Registration
 - Paris Convention priority available
- International Application Form
 - MM1 (FR), MM2 or MM3 form (EN, FR, ES as from 1/04/2004)
 - A color drawing is required if mark claims a color
 - Filed with the office of country of origin
 - Transmitted to WIPO within 2 months
- Examination
 - By each national trade mark office of the designated countries within 12 or 18 months
 - Opposition period may be longer



Madrid Protocol: Role of WIPO

- Ensures that filing requirements are met, including correct descriptions of goods and services
- Does *not* determine if mark qualifies for protection in designated countries
- Notifies Applicant directly of defects in application and Applicant has 3 months to correct

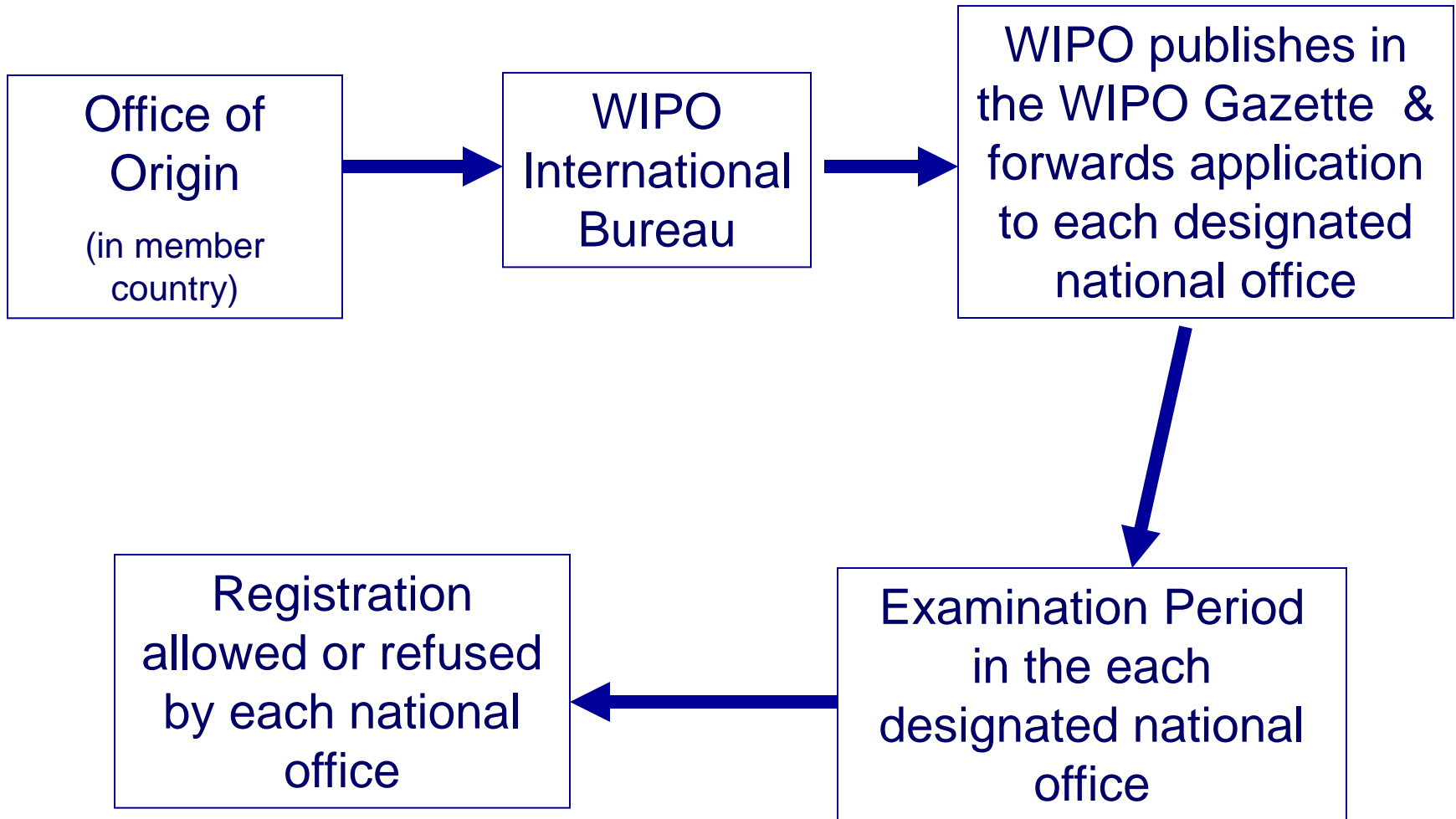


Madrid Protocol: Role of WIPO

- Records the registration in the International Register
- Publishes the registration in the WIPO Gazette of International Marks
 - Paper publication - every 2 weeks (official publication)
 - CD rom publication - every 4 weeks
- Notifies the national offices of International Registrations



Madrid Protocol: Overview Application procedure





Madrid Protocol: Subsequent Designations

- Additional designations may be made at any time to Madrid Protocol countries
 - MM4 form, to be presented to the International Bureau:
 - Through the Office of the Contracting Party of the holder if any of the CP is designated under the Madrid Agreement
 - Directly by the holder or through the Office of origin
 - The first International Application must be registered at WIPO: reg. n° needed
 - Registration date is date of designation
 - Protection terminates at the end of the original Madrid Registration period



Madrid Protocol: WIPO Fees

- Payment in advance directly to the International Bureau in Swiss Francs
 - Offices of Origin may choose to collect and forward that payment.



Madrid Protocol: Additional Fees

- Renewal Fee
 - Same as initial registration fees
 - Paid within 6 months of the expiration of the 10 year term
 - Directly to WIPO
- Change in ownership fee: 150 CHF



Madrid Protocol: Recordals centralized by WIPO

- Assignments and changes of ownership
- Changes in the name and address of the owner
- Limitations of the list of goods/services
- Renunciation of the protection in one or more countries
- Cancellation of the International Registrations

Recordal of licenses is not required but individual countries may have this requirement



Madrid Protocol: Risk of Central Attack

- During the first 5 years of International Registration
 - Cancellation of original registration or application in country of origin results in the cancellation of all International Registrations
 - 3 months to transform into national applications, retaining same Madrid Registration priority date
- After 5 years, the Madrid Registrations are independent of the Office of Origin registration



OHIM and the International System

- Since 1 October 2004 EC is party to the Madrid Protocol
 - Possible to use CTM application or registration as basis for International Application
 - Possible to designate CTM in the International Application



OHIM as Office of Origin



OHIM as Office of Origin

GENERAL FEATURES

- Languages and forms to be used
 - MM2, in any of the 3 WIPO languages
 - EM2, in any of the 22 official languages of the OHIM
 - *When EM2 form is filed in a different lang. than ES, EN or FR, the appl./rep. shall either provide us a translation into 1 of the WIPO lang. or authorize us to use ours.*
- Electronic communication between OHIM & WIPO
- OHIM does not handle WIPO fees



OHIM as Office of Origin

As an office of origin the OHIM:

- Certifies that the international application corresponds to the basic CTM (triple identity rule)
- A transmittal fee of **300 €** is to be paid
- Responses to irregularities from WIPO to be filed through OHIM (except for payment)
- Dependency period of 5 years following the International Registration date: any partial or total cancellation of the scope of protection is to be notify to the WIPO



OHIM as Office of Origin

SUBSEQUENT DESIGNATIONS

- Languages and forms to be used
 - MM4, in any of the 3 WIPO languages
 - EM4, in any of the 22 official languages of the OHIM
 - *Where necessary, when EM4 form is filed in a different lang. than ES, EN or FR, the appl./rep. shall either provide us a translation into 1 of the WIPO lang. or authorize us to use our.*
- No transmittal fee
- Either through OHIM or directly to the International Bureau



OHIM as Designated Office



EC designated in an International Application

- Via MM2 or MM3 forms into EN, FR or ES
- Compulsory to indicate a 2nd language among the 4 officials remaining (EN, FR, ES, DE, IT).
- Publication into the WIPO Gazette
- Delays: between 5 and 7 weeks to inform OHIM about the designation
- Re-publication into Community Trade Mark Bulletin in part M.1.
- 18 months as from notification date to send a refusal



EC designated in an International Application

- Brief formality check:
 - 2nd language
 - Regulation governing the use (for collective mark only)
 - Owner from outside of the EU will be requested to designate a representative ONLY if irregularity is found at any level, *i.e.*, formality, AG or opposition.
- AG check :during the first 6 months as from re-pub.
 - If AG OK: “Interim status of the mark” (*can be issued even when a provisional refusal has been issued*)
- Opposition period: between the 6th and the 9th month as from re-pub.
 - If NO opposition filed: Statement of Grant of Protection to WIPO



USEFUL INFORMATION



Madrid Protocol: Example Fee Calculation

International Registration of Marks - Fee Calculation - Microsoft Internet Explorer provided by OAMI

Address: <http://www.wipo.int/madrid/feecalc/FirstStep?Lang=E&ForDate=20070415&Origin=DE&Classes=1&ServCd=EN&Figurative=Y&CH=Y&CN=Y&EM=Y&KR=Y&US=Y>

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International Registration of Marks - Fee Calculation

For date: 15.04.2007 Office of origin: Germany

Number of classes: 1 Type: Application (Common Regulations)

Colour Collective mark, certification mark, or guarantee mark Includes figurative elements

<input type="checkbox"/> AG	<input type="checkbox"/> AL	<input type="checkbox"/> AM	<input type="checkbox"/> AN	<input type="checkbox"/> AT	<input type="checkbox"/> AU	<input type="checkbox"/> AZ	<input type="checkbox"/> BA	<input type="checkbox"/> BG	<input type="checkbox"/> BH
<input type="checkbox"/> BT	<input type="checkbox"/> BW	<input type="checkbox"/> BX	<input type="checkbox"/> BY	<input checked="" type="checkbox"/> CH	<input checked="" type="checkbox"/> CN	<input type="checkbox"/> CU	<input type="checkbox"/> CY	<input type="checkbox"/> CZ	<input type="checkbox"/> DK
<input type="checkbox"/> DZ	<input type="checkbox"/> EE	<input type="checkbox"/> EG	<input checked="" type="checkbox"/> EM	<input type="checkbox"/> ES	<input type="checkbox"/> FI	<input type="checkbox"/> FR	<input type="checkbox"/> GB	<input type="checkbox"/> GE	<input type="checkbox"/> GR
<input type="checkbox"/> HR	<input type="checkbox"/> HU	<input type="checkbox"/> IE	<input type="checkbox"/> IR	<input type="checkbox"/> IS	<input type="checkbox"/> IT	<input type="checkbox"/> JP	<input type="checkbox"/> KE	<input type="checkbox"/> KG	<input type="checkbox"/> KP
<input checked="" type="checkbox"/> KR	<input type="checkbox"/> KZ	<input type="checkbox"/> LI	<input type="checkbox"/> LR	<input type="checkbox"/> LS	<input type="checkbox"/> LT	<input type="checkbox"/> LV	<input type="checkbox"/> MA	<input type="checkbox"/> MC	<input type="checkbox"/> MD
<input type="checkbox"/> ME	<input type="checkbox"/> MK	<input type="checkbox"/> MN	<input type="checkbox"/> MZ	<input type="checkbox"/> NA	<input type="checkbox"/> NO	<input type="checkbox"/> PL	<input type="checkbox"/> PT	<input type="checkbox"/> RO	<input type="checkbox"/> RS
<input type="checkbox"/> RU	<input type="checkbox"/> SD	<input type="checkbox"/> SE	<input type="checkbox"/> SG	<input type="checkbox"/> SI	<input type="checkbox"/> SK	<input type="checkbox"/> SL	<input type="checkbox"/> SM	<input type="checkbox"/> SY	<input type="checkbox"/> SZ
<input type="checkbox"/> TJ	<input type="checkbox"/> TM	<input type="checkbox"/> TR	<input type="checkbox"/> UA	<input checked="" type="checkbox"/> US	<input type="checkbox"/> UZ	<input type="checkbox"/> VN	<input type="checkbox"/> ZM		

Select All Clear All Calculate

Basic fee where no reproduction of the mark is in color :	653
Complementary fee : 2 x 73.00 CHF	146
European Community	
Individual fee :	2229
Republic of Korea	
Individual fee : 1 x 297.00 (0 classes free)	297
United States of America	
Individual supplementary fee (mixed application) : 1 x 406.00 (0 classes free)	406
TOTAL: (CHF)	3731

- Figurative trade mark
- Office of Origin: DE
- Designating: CH, CN, EM, KR, US
- Total cost: 3.731 CHF



Madrid Protocol: Example Fee Calculation

International Registration of Marks - Fee Calculation - Microsoft Internet Explorer provided by OAMI

Address: <http://www.wipo.int/madrid/feecalc/FirstStep?Lang=E&ForDate=20070415&Origin=EM&Classes=1&ServCd=EN&Figurative=Y&CH=Y&CN=Y&KR=Y&US=Y&PABF=653&PAINCH=450&PAINCN=310&PAINEM=2229&PAINKR=2>

International Registration of Marks - Fee Calculation

For date: 15.04.2007 Office of origin: European Community

Number of classes: 1 Type: Application (Common Regulations)

Colour Collective mark, certification mark, or guarantee mark Includes figurative elements

AG AL AM AN AT AU AZ BG BH BT

BW BX BY CH CN CU CY CZ DE DK

EE ES FI FR GB GE GR HR HU IE

IR IS IT JP KE KG KP KR LI LS

LT LV MA MC MD ME MK MN MZ NA

NO PL PT RO RS RU SE SG SI SK

SL SY SZ TM TR UA US UZ VN ZM

Select All Clear All Calculate

Basic fee where no reproduction of the mark is in color: 653

Switzerland
Individual fee: 450

China
Individual fee: 310

Republic of Korea
Individual fee: 1 x 297.00 (0 classes free) 297

United States of America
Individual supplementary fee (mixed application): 1 x 406.00 (0 classes free) 406

TOTAL: (CHF) 2116

- Figurative trade mark
- Office of Origin: EM
- Designating: CH, CN, KR, US
- Total cost: 2.116 CHF

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OHIM

THE TRADE MARKS AND DESIGNS REGISTRATION OFFICE
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LV	LATVIA	http://www.lrpv.lv/
LT	LITHUANIA	http://www.is.lt/vpb/eng/
LU	LUXEMBOURG	http://www.etat.lu/EC/
HU	HUNGARY	http://www.hpo.hu/
MT	MALTA	http://www.commerce.gov.mt/ipr.asp
NL	NETHERLANDS	http://www.boip.int
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PL	POLAND	http://www.uprp.pl/
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International protection

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