



MARQUES

# The Madrid System

Asta Valdimarsdottir  
Director  
Operations Division  
Madrid Registry



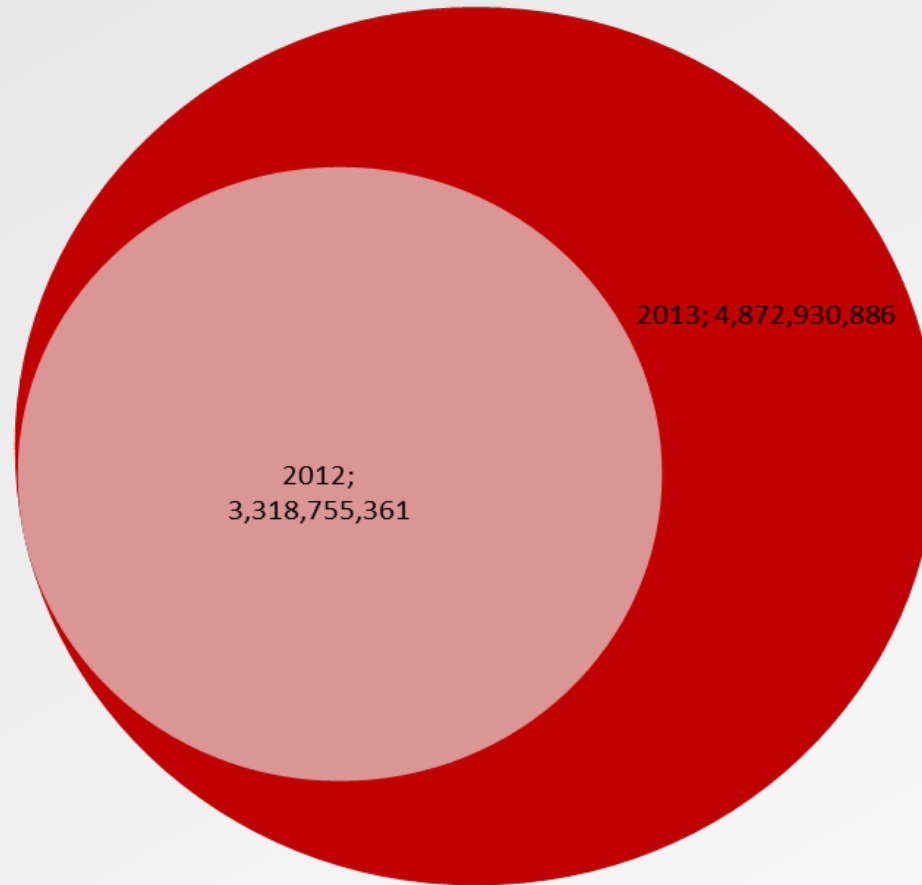
# Main points



- The current landscape
- The reform program
- IT developments
- Legal developments
- Filing trends and operational matters



# Madrid Union Market (inhabitants)

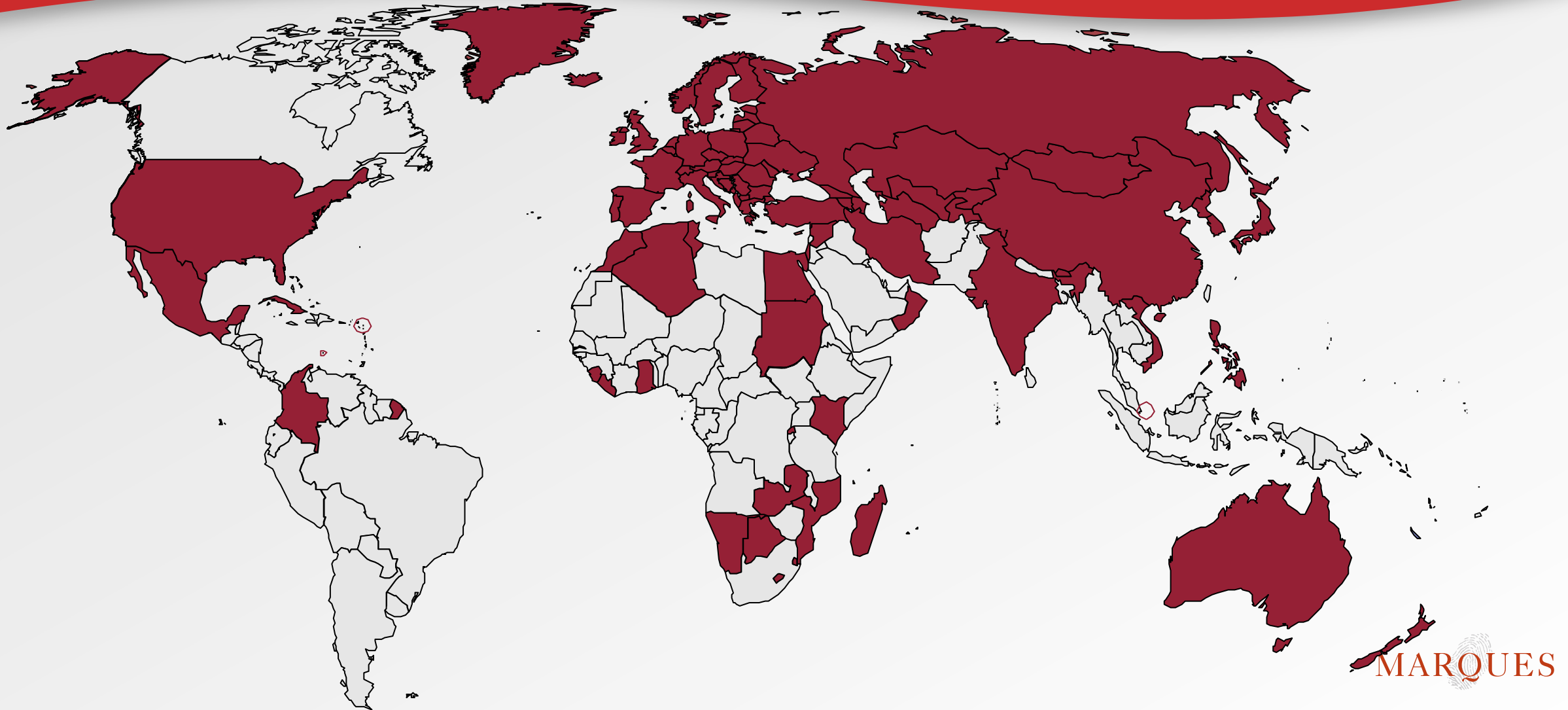




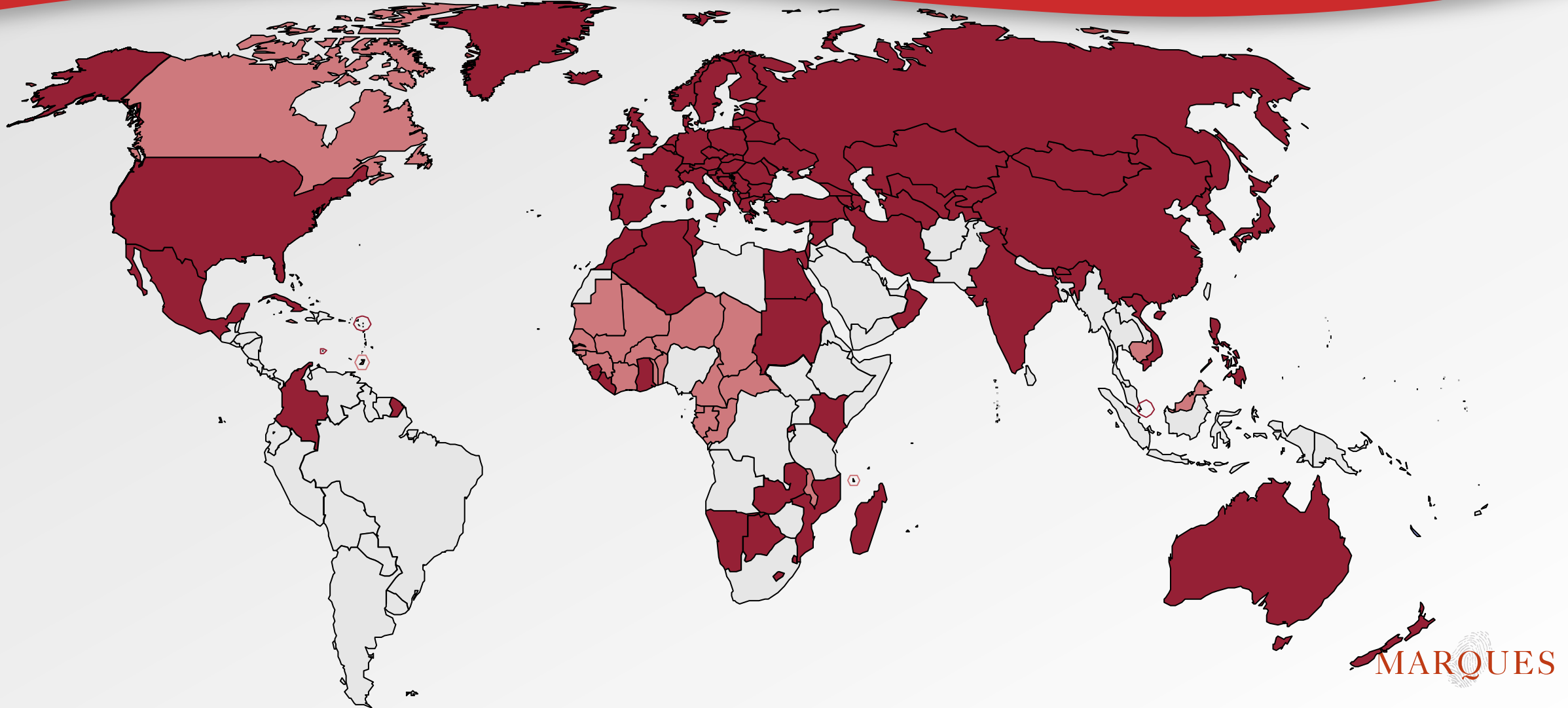
# Challenges



# Madrid Union



# Madrid Union – Future Contracting Parties



# Reform Program



- New internal IT system
- Processes
- Examination documentation and communication
- Fee project
- Customer Service Project

# IT developments

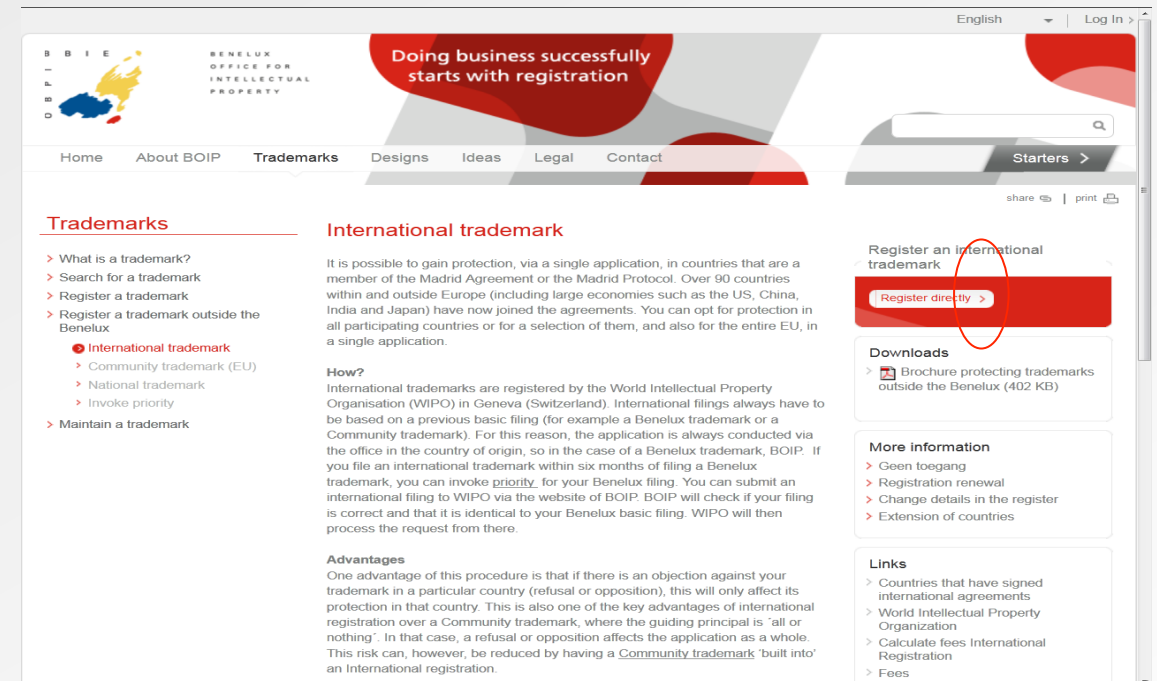


- E – filing
- Web forms and the MPM – Madrid Portfolio Manager
- Information services
  - Global Brand Database
  - MGS – Madrid Goods & Services
  - MRS – Madrid Real Time Status
  - MEA – Madrid Electronic Alert

# E-filing of international applications

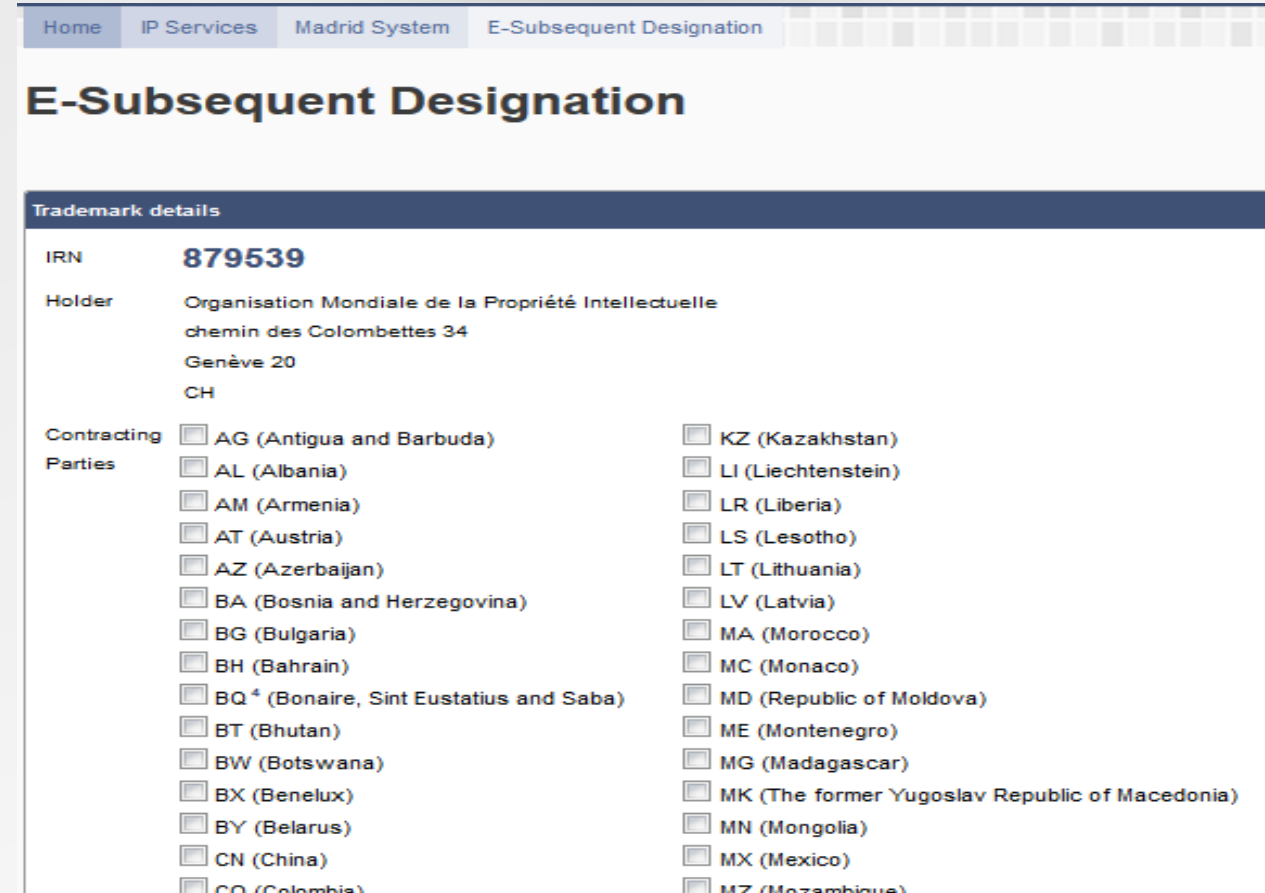


- International Registration Process Integration (IRPI): a pilot project, providing a framework for electronic filing that started in 2012
- E-filing is now available through the Benelux Office for IP
- National and International fees are paid in one set



# Web forms

- E-Subsequent designation:
  - By entering an IRN, most mandatory data elements are provided automatically
  - Easy to use: select the DCP, indicate the G&S and pay the fees by credit card or through a WIPO current account.
  - Immediate acknowledgement of receipt
- Upcoming web forms
  - Change in the name or address of the representative



The screenshot shows the 'E-Subsequent Designation' web form. At the top, there is a navigation bar with links: Home, IP Services, Madrid System, and E-Subsequent Designation. Below the navigation bar, the title 'E-Subsequent Designation' is displayed. Underneath, there is a section titled 'Trademark details' with the following information:

**IRN** 879539

**Holder** Organisation Mondiale de la Propriété Intellectuelle  
chemin des Colombettes 34  
Genève 20  
CH

**Contracting Parties**

<input type="checkbox"/> AG (Antigua and Barbuda)	<input type="checkbox"/> KZ (Kazakhstan)
<input type="checkbox"/> AL (Albania)	<input type="checkbox"/> LI (Liechtenstein)
<input type="checkbox"/> AM (Armenia)	<input type="checkbox"/> LR (Liberia)
<input type="checkbox"/> AT (Austria)	<input type="checkbox"/> LS (Lesotho)
<input type="checkbox"/> AZ (Azerbaijan)	<input type="checkbox"/> LT (Lithuania)
<input type="checkbox"/> BA (Bosnia and Herzegovina)	<input type="checkbox"/> LV (Latvia)
<input type="checkbox"/> BG (Bulgaria)	<input type="checkbox"/> MA (Morocco)
<input type="checkbox"/> BH (Bahrain)	<input type="checkbox"/> MC (Monaco)
<input type="checkbox"/> BQ <sup>4</sup> (Bonaire, Sint Eustatius and Saba)	<input type="checkbox"/> MD (Republic of Moldova)
<input type="checkbox"/> BT (Bhutan)	<input type="checkbox"/> ME (Montenegro)
<input type="checkbox"/> BW (Botswana)	<input type="checkbox"/> MG (Madagascar)
<input type="checkbox"/> BX (Benelux)	<input type="checkbox"/> MK (The former Yugoslav Republic of Macedonia)
<input type="checkbox"/> BY (Belarus)	<input type="checkbox"/> MN (Mongolia)
<input type="checkbox"/> CN (China)	<input type="checkbox"/> MX (Mexico)
<input type="checkbox"/> CO (Colombia)	<input type="checkbox"/> MZ (Mozambique)



# MPM – Madrid Portfolio Manager




- Online access to your international trademark portfolio:
  - WIPO User account linked to an e-mail address
  - International registrations linked to the same e-mail address
- Helpful when submitting new requests for recordal

**Madrid Portfolio Manager**

Portfolio E-Renewal E-Payment Delegation Applications Notifications Upload Contact Log Out

christophe mcoll

Total number of valid IRN : 3  
Total number of expired IRN : 0

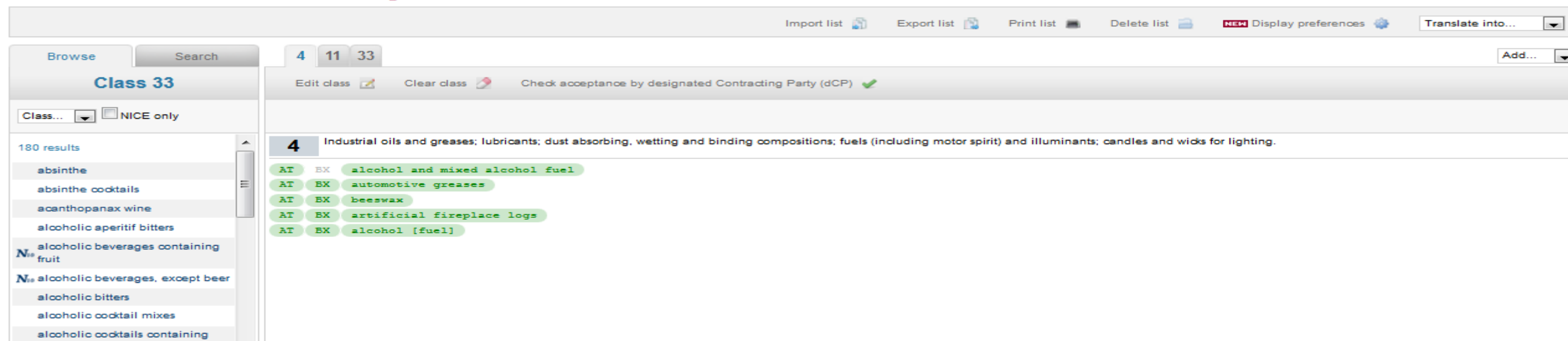
IRN	Expiration Date ▲	Office Origin	Holder	Representative	Mark Name	Last Modified	
✓ 605000	16/06/2013	CH	ORGANISATION MONDIALE DE LA PROPRIÉTÉ INTELLECTUELLE		ROMARIN	10/12/2008	 
✓ 879539	16/06/2013	CH	ORGANISATION MONDIALE DE LA PROPRIÉTÉ INTELLECTUELLE		PATENTSCOPE	29/09/2009	 
✓ 633333	15/03/2015	CH	ORGANISATION MONDIALE DE LA PROPRIÉTÉ INTELLECTUELLE		IPLEX	23/05/2003	 

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# MGS – Madrid Goods & Services

- Useful tool for applicants to prepare the list of G&S in a national, regional or international application
- Nice Classification (updated) + pre-accepted terms by WIPO and many National Offices – to avoid irregularities or refusals
- Madrid languages + 12 other searching languages available

## MGS • Madrid Goods & Services Manager



The screenshot displays the MGS Madrid Goods & Services Manager web application. The interface includes a top navigation bar with options like 'Import list', 'Export list', 'Print list', 'Delete list', 'Display preferences', and a 'Translate into...' dropdown. On the left, a sidebar shows a 'Browse' section with 'Class 33' selected, listing 180 results including 'absinthe', 'absinthe cocktails', 'acanthopanax wine', 'alcoholic aperitif bitters', 'alcoholic beverages containing fruit', 'alcoholic beverages, except beer', 'alcoholic bitters', 'alcoholic cocktail mixes', and 'alcoholic cocktails containing'. The main area shows 'Class 4' selected, with a description: 'Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles and wicks for lighting.' Below this, a list of terms is displayed, each with 'AT' and 'BX' status and a green highlight: 'alcohol and mixed alcohol fuel', 'automotive greases', 'beeswax', 'artificial fireplace logs', and 'alcohol [fuel]'.

# Global Brand Database



- Over 13 million records relating to internationally-protected trademarks, etc.
- Goal is to include all brand-related information from all sources
- Unique in providing **image-based** search
- Currently searches across multiple collections, including:
  - Trademarks registered under Madrid System
  - Appellations of Origin registered under Lisbon System
  - Emblems protected under the Paris Convention 6<sup>ter</sup>
  - Algeria, Australia, Canada, Denmark, Egypt, Estonia, Israel, Morocco, Oman, Singapore, Switzerland, UAE, US – with many more coming soon

WIPO is the global forum for intellectual property services, policy, information and cooperation.

## We deliver global services for protecting IP

File, manage or search patents, trademarks, designs and appellations of origin. Not there yet? Learn all about intellectual property and how to protect it.

### WIPO | PCT

The International Patent System

### WIPO | MADRID

The International Trademark System

### WIPO | HAGUE

The International Design System

## Alternative dispute resolution

Settle IP and technology disputes out of court using the fast, flexible and cost-effective services offered by the WIPO Arbitration and Mediation Center.

## Domain name disputes

Resolve cybersquatting and other disputes relating to trademark domain names.

## We shape international IP rules for a changing world

Follow policy discussions and negotiations on the future development of IP in our standing committees and meetings.

### Next meetings

Standing Committee on the Law of Patents

Jan 27–31

Intergovernmental Committee on IP and Genetic Resources, Traditional Knowledge and Folklore

Feb 3–7

[All upcoming meetings](#)

### FEATURED

## WIPO Assemblies

The **52nd Series of Meetings of the Assemblies** of the Member States of WIPO took place in Geneva from December 10 to 12, 2013.

• [Documents](#) | [Videos on demand](#)

## We provide access to the world's IP information

Search technology and brand-related information in our free global databases. Download our other reference materials: [publications](#), [statistics](#), [economic studies](#) and more.

### PATENTSCOPE

35 million international and national patent documents

### Global Brand Database

11 million international and national records of trademarks, appellations of origin and emblems

### ROMARIN

International marks recorded under the Madrid System

### WIPO Lex

IP laws and treaties

### FEATURED

## World IP Indicators

Latest statistical report shows IP filing activity is extending its run of pre-crisis level growth.

[Download the full Report](#)





# Global Brand Database

NEWS

Search trademark and other brand information by text or image from multiple national and international sources, including trademarks, appellations of origin and official emblems.

## SEARCH BY

Brand

Names

Numbers

Dates

Class

Country

Text

= ▾

☐ Stemming

Logo

=

[lookup]

Goods (All) ▾

=

search 🔍

CURRENT SEARCH

BRAND:arla ✕

## FILTER BY

Source

Image

Status

Origin

App. Date \*

Expiration \*

Display: List ▾

Sort: Value - asc ▾

AE Marks (AETM)	4	AU Marks (AUTM)	8
CA Marks (CATM)	6	CH Marks (CHTM)	1
DK Marks (DKTM)	47	DZ Marks (DZTM)	1
EE Marks (EETM)	1	EG Marks (EGTM)	11
IL Marks (ILTM)	13	MA Marks (MATM)	0
NZ Marks (NZTM)	4	OM Marks (OMTM)	7
PH Marks (PHTM)	5	SG Marks (SGTM)	23
US Marks (USTM)	12	WO A.O. (LIS)	0
US Marks (USTM)	0	WO Marks (MAD)	15

filter +

61 - 90 / 158

TMview 🔗

Sort by

Status - asc ▾

ARLA



ARLA



WO TM (Active)  
990596  
Arla  
2008-09-08 (DK)  
Arla Foods amba



ARLA

ARLA



ARLA  
NATURA

ARLA FOODS



ARLA DELITE

**SEARCH BY** Brand Names Numbers Dates Class Country

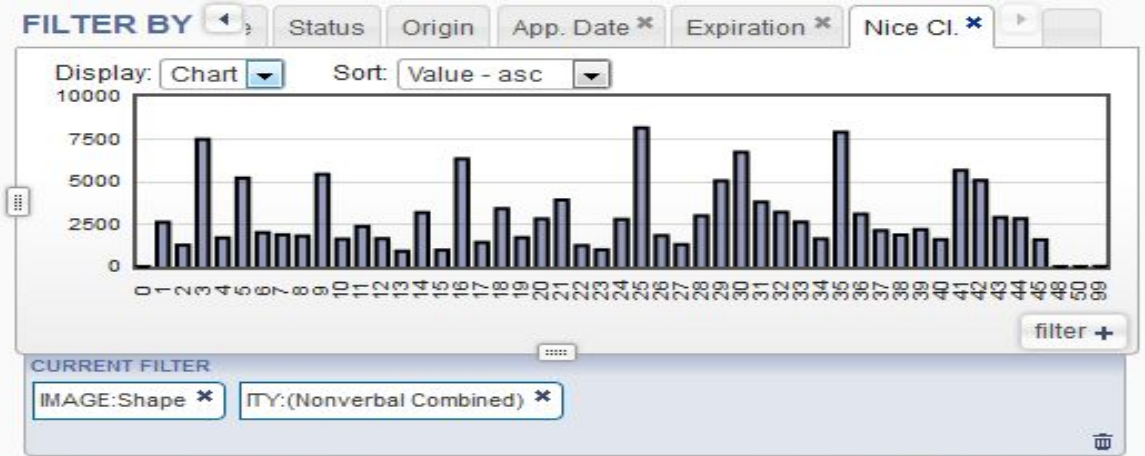
Text =  ☐ Stemming

Logo =  [lookup]

Goods (All) =

search

CURRENT SEARCH  
LOGO:flower ✕



1 - 60 / 55,642

TMview



Display: 60

per page

options

1 / 928

Sort by Score - desc



# Legal developments



# Continued processing

New Rule *5bis* - “continue processing” in case of failure to meet one of the following time-limits:

- Irregularities to be remedied by the applicant (R11(2) and (3))
- Irregularities in relation to a request for the recording of a license (R20*bis*(2))
- Irregularities in relation to a request for subsequent designation (24(5)(b))
- Irregularities in requests for recording of a change and for recording of a cancellation (R26(2))
- In relation to the date by which the second part of the individual fee must be paid (R34(3)(c)(iii))
- Time limit in relation to a request that an international registration continue its effect in the successor State (R39(1))

Continue processing should be requested **within two months** from the expiry of the aforesaid time-limit and a **fee has to be paid**

The applicant/holder would not have to diligence or that failure resulted from *force majeure*

# Partial Renewal

- **Currently:** following a final decision granting partial protection (R 18ter), renewal is **due for all the classes** for which protection was initially requested. To avoid renewal for the refused classes, a limitation of the list of G&S is needed before renewal (Form MM6).
- **From January 1, 2015:** Following a final decision granting partial protection, the holder would be able to renew his international registration only for the G&S **effectively protected** (no need to record a limitation before renewal)

The holder would still be able to renew the entire list, upon express statement and payment of the required fees

# **Possible future developments**

## **Working Group (12<sup>th</sup> session)**

# Proposals for the Working Group



- “Freeze” the Provisions in Articles 6(2), (3) and (4) of the Madrid Agreement and Protocol (Suspend the application of the dependency principle)
- Introduction of *Division* or a *Merger* for international registrations
- Discussion on *Replacement*

# Proposals for the Working Group



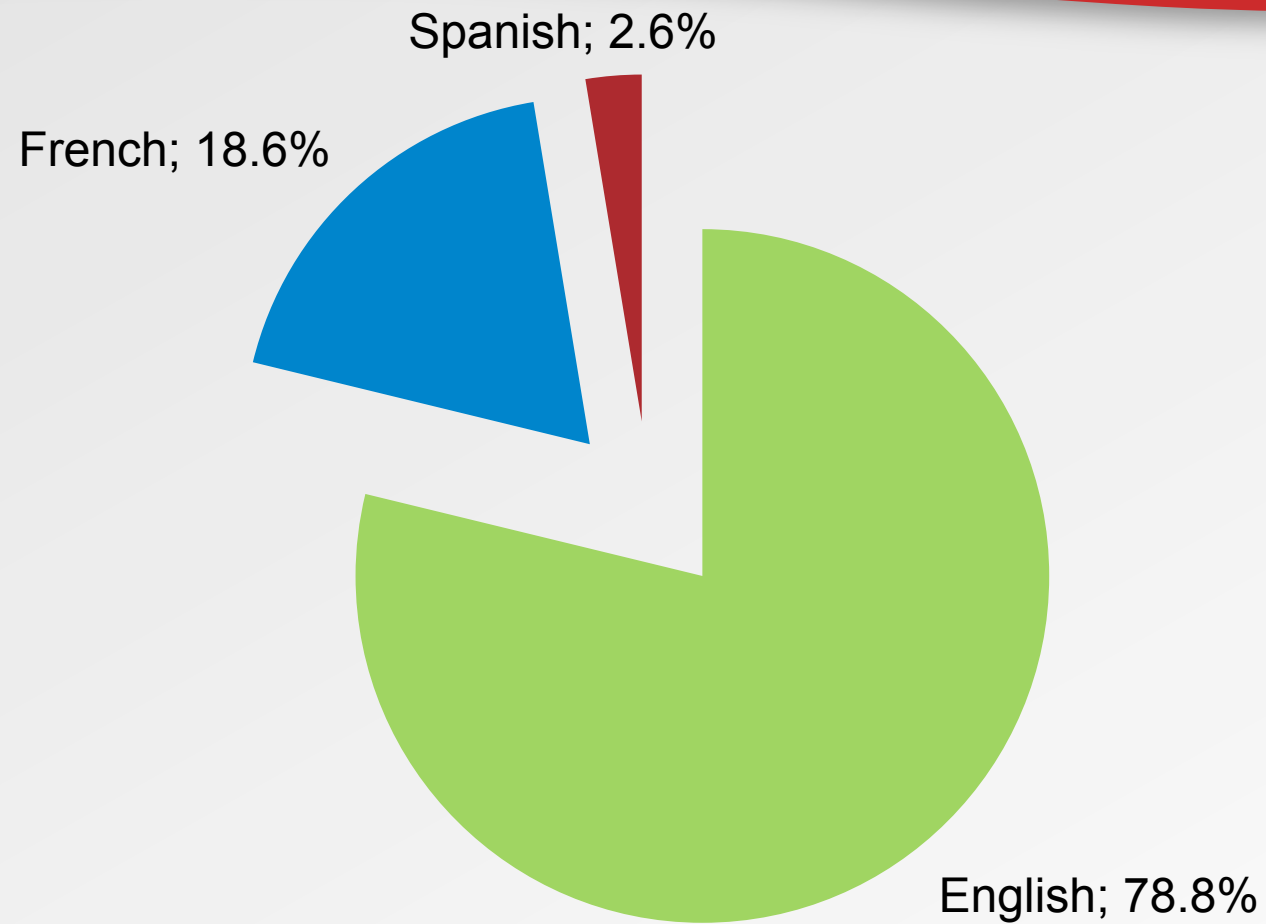
- Proposed amendments to the Common Regulations :
  1. A remedy when failure to meet a deadline to send a communication to the International Bureau results from a disruption in electronic services
  2. Voluntary description of the mark
  3. Offices take note of replacement; and,
  4. Subsequent designations:
    - Examine for a reduced list of G&S
    - Addressing the problem of missing declarations of intention to use the mark
  5. Introduce a fee per limitation in an international registration, as a change or in a subsequent designation
  6. Exemption from fees of certain recordings (Rule 36)
  7. Facilitating the use of e-forms
  8. Identifying designations

# Filing trends



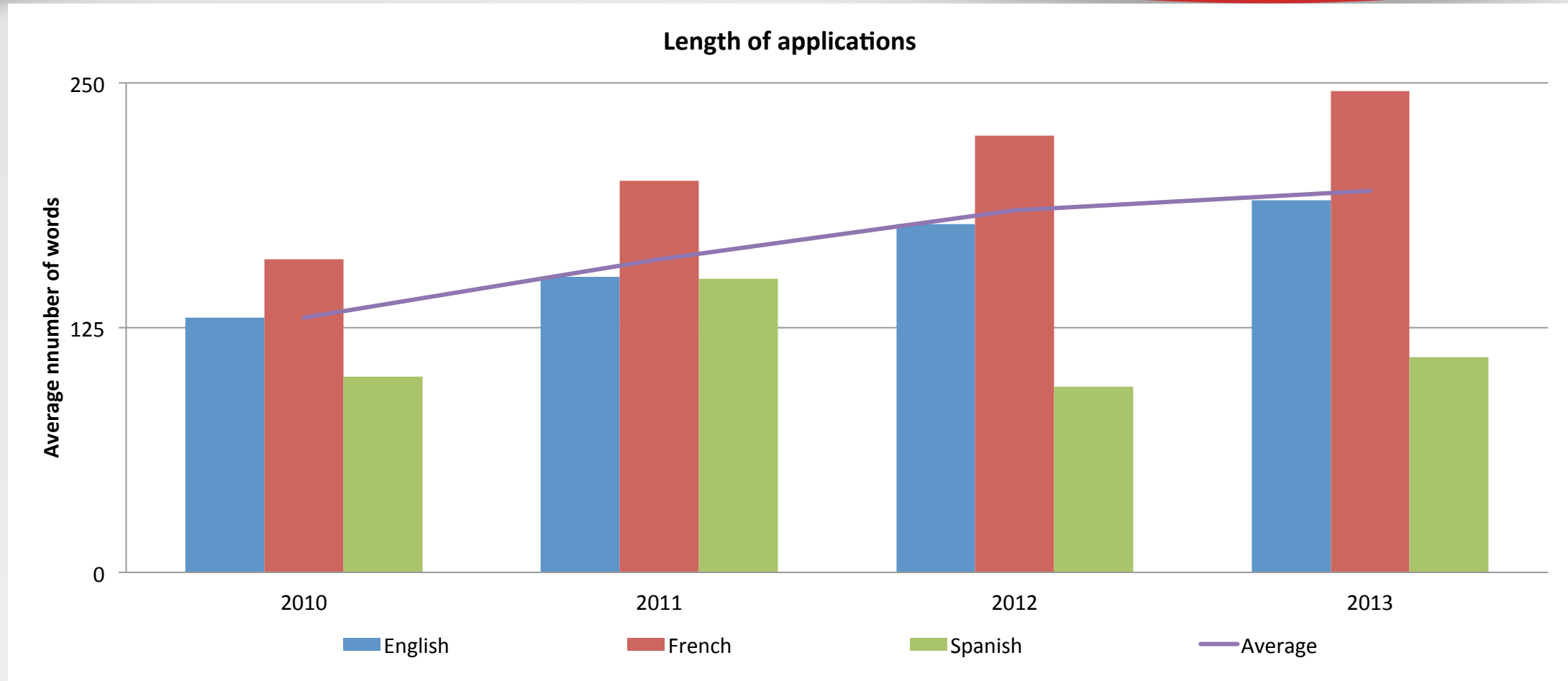
- Languages
- Length of the lists
- Irregularities - Different classification practices
- Limitations
- Refusals
- Grants of Protection
- Fraudulent invoices

# Filing languages

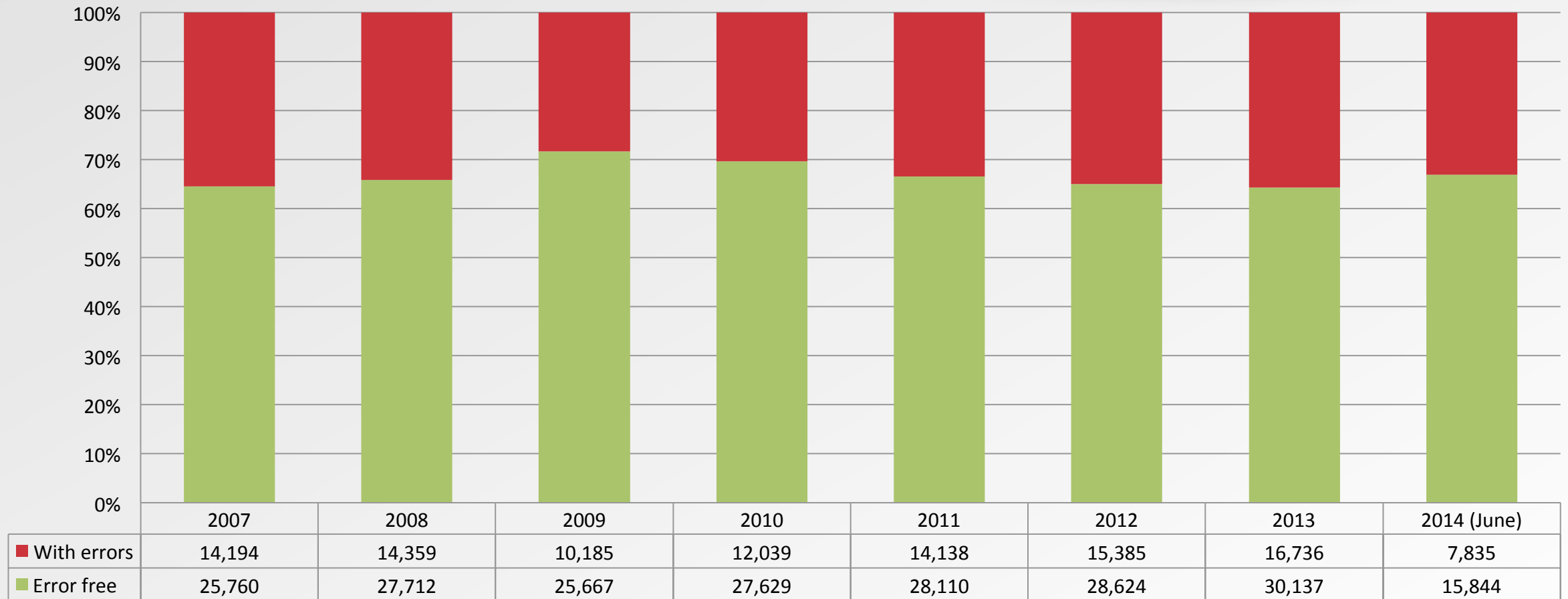




# Length of the lists

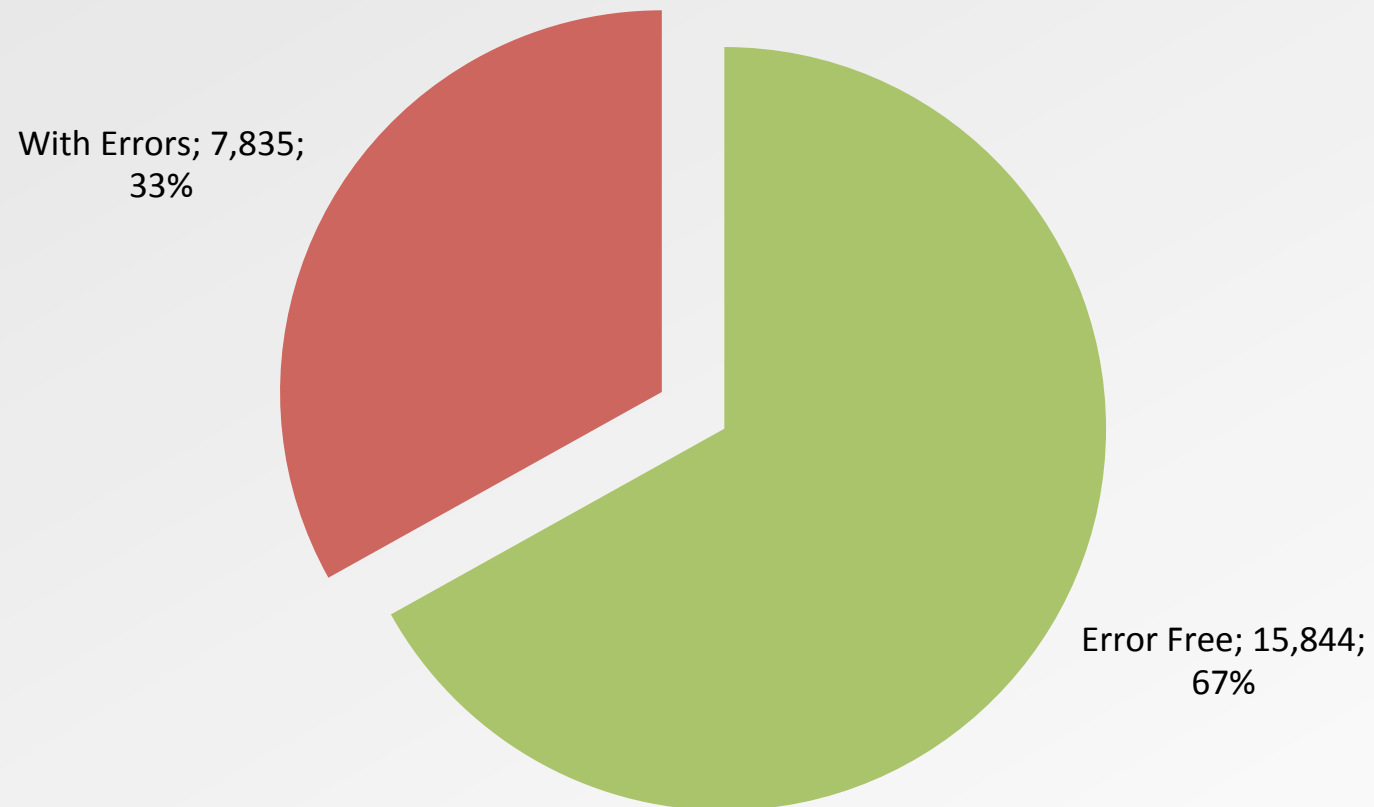


# International Applications - Irregularities



# International Applications - Irregularities

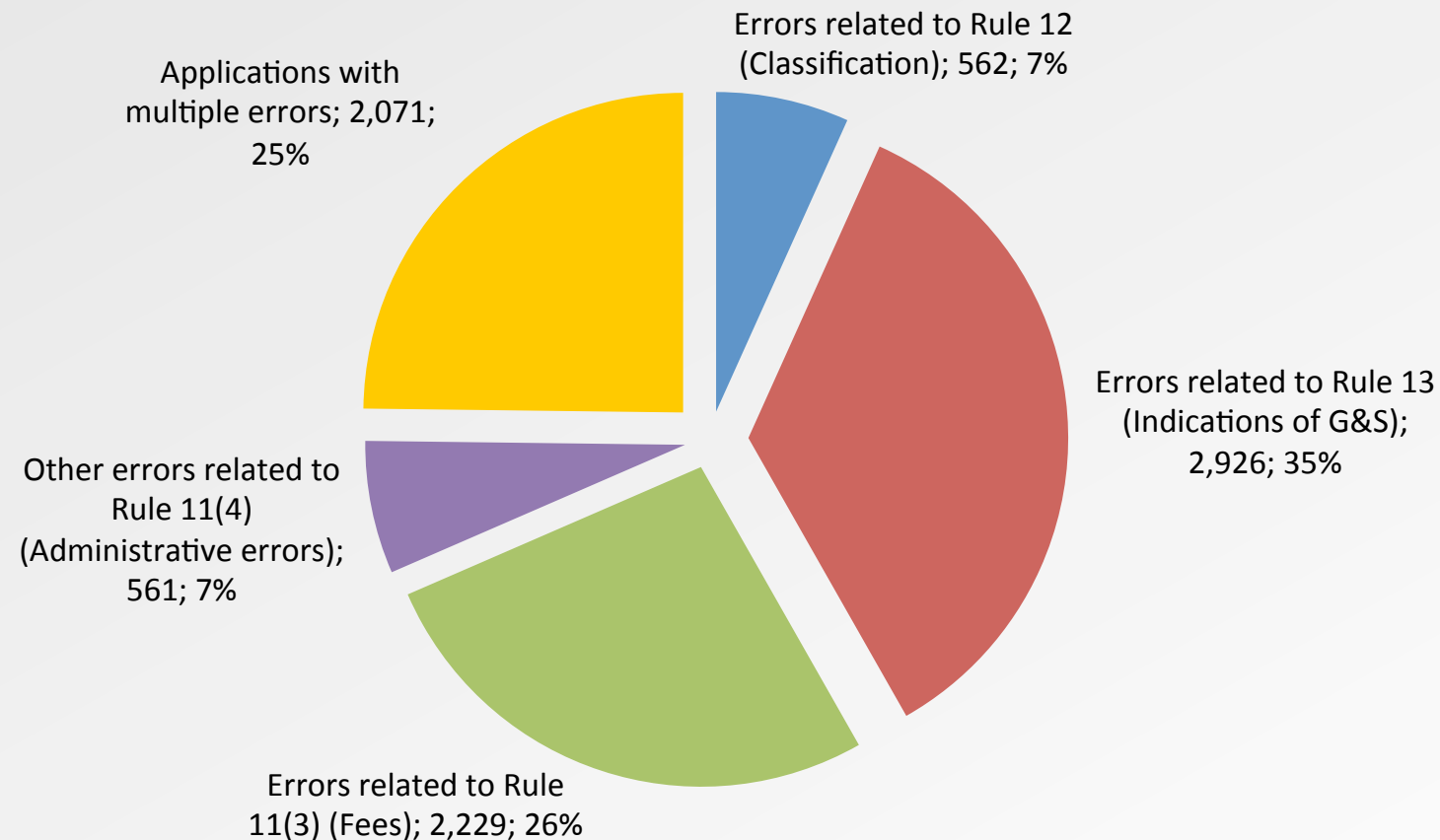
Total Number of International Applications: 31.429 ( January - June 2014)



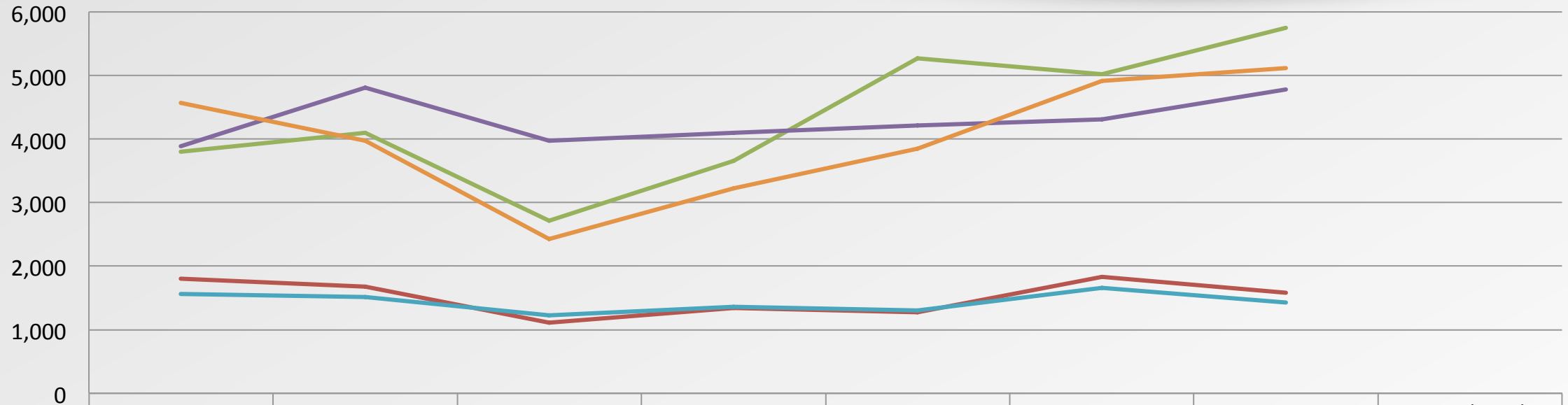
# Breakdown of Irregularity letters in the Madrid system (January – June 2014)



International applications filed	23,679
Total Number of Errors	7,835
Total Number of Irregularity Letters	8,349

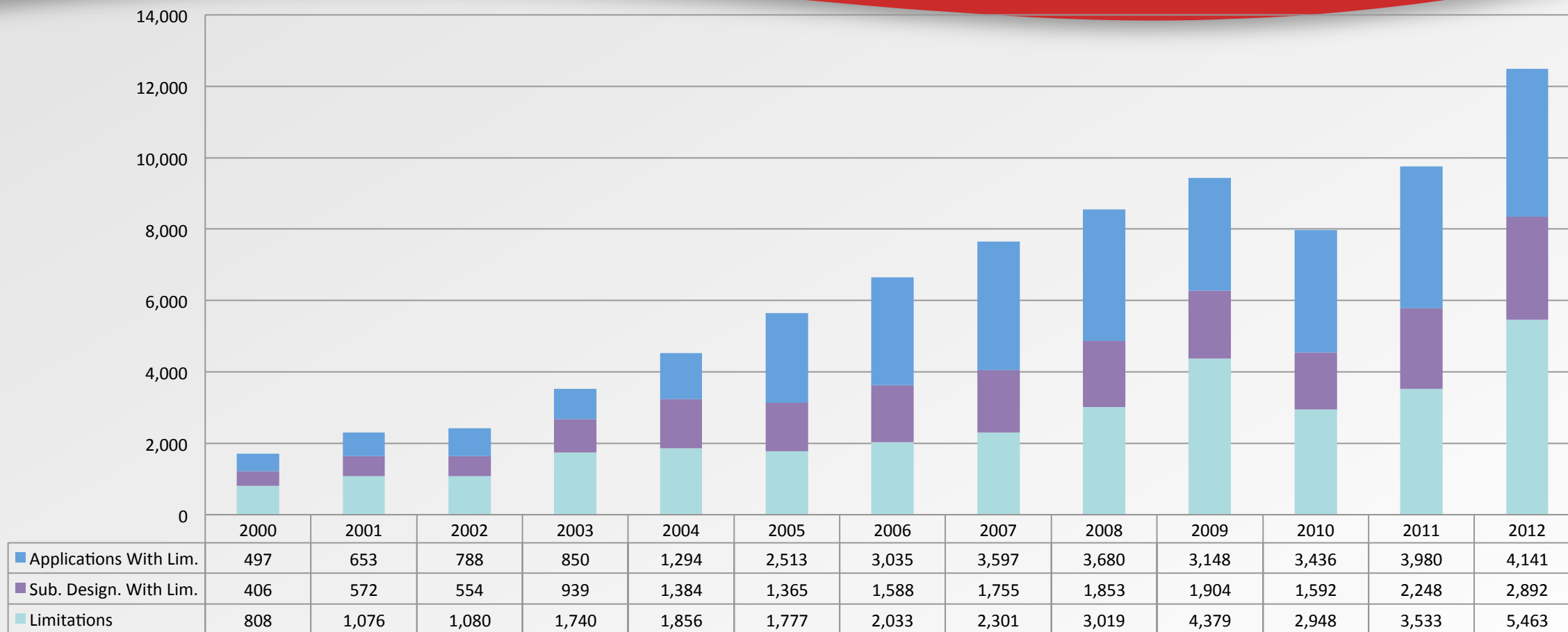


# Breakdown of Irregularity letters in the Madrid system

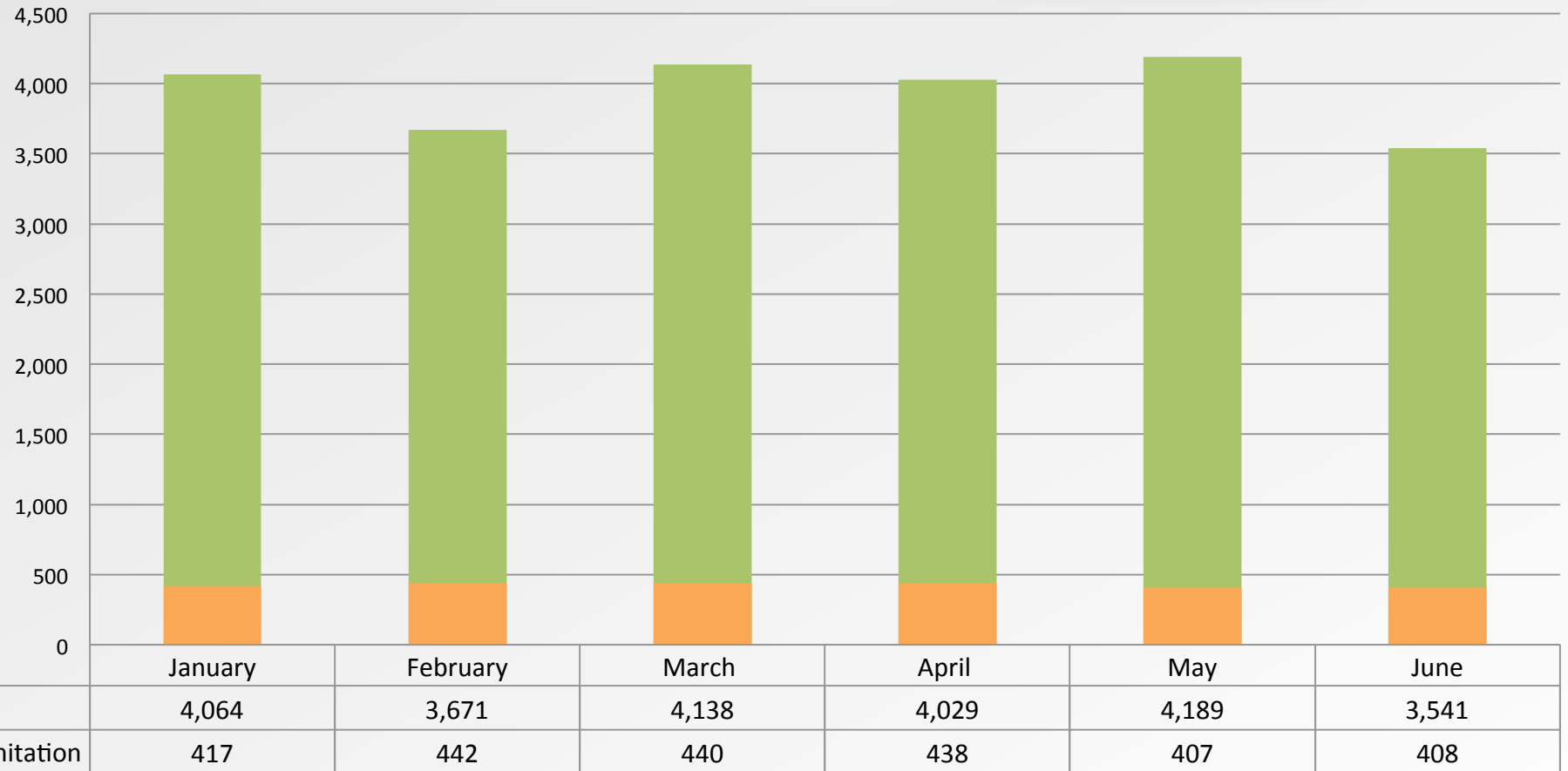


	2007	2008	2009	2010	2011	2012	2013	2014 (June)
Total letters	15,618	16,071	11,456	13,683	15,907	17,738	18,651	8,349
Rule 12	1,799	1,678	1,114	1,342	1,279	1,835	1,585	562
Rule 13	3,801	4,099	2,710	3,659	5,263	5,021	5,750	2,926
Fees	3,888	4,808	3,976	4,098	4,211	4,312	4,778	2,229
Other	1,565	1,514	1,228	1,364	1,307	1,660	1,426	561
Multiple	4,565	3,972	2,428	3,220	3,847	4,910	5,112	2,071

# Limitations 2000 – 2012

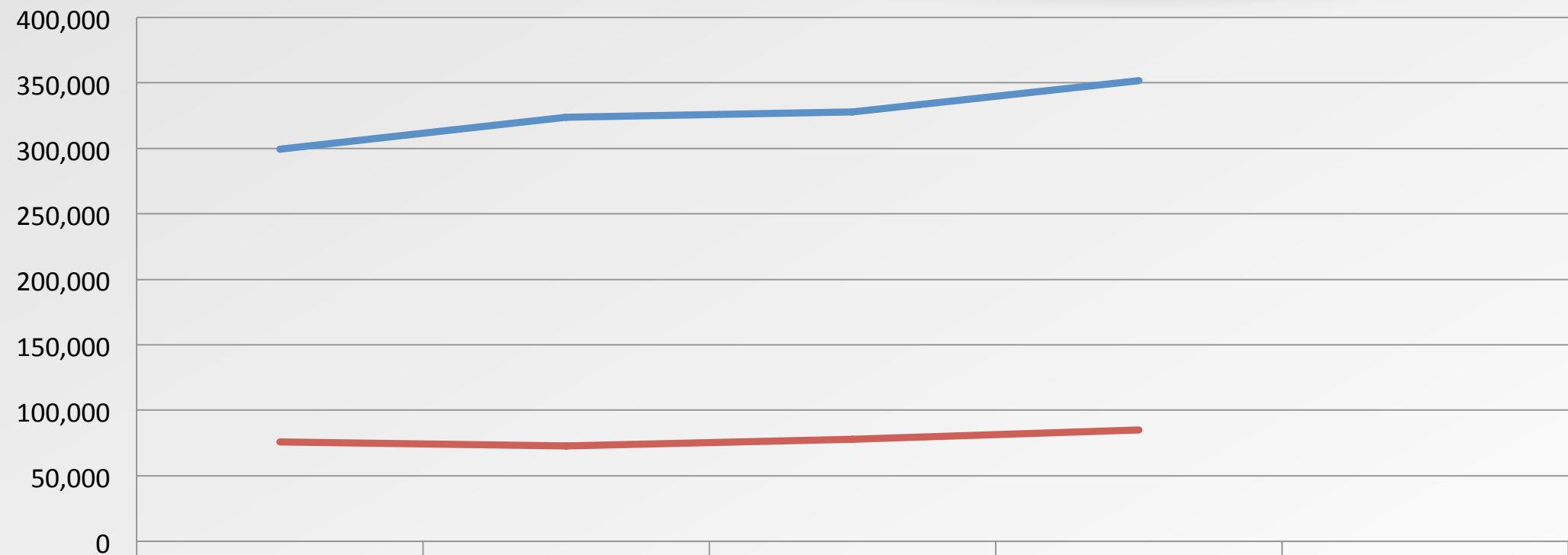


# Limitations





# Refusals



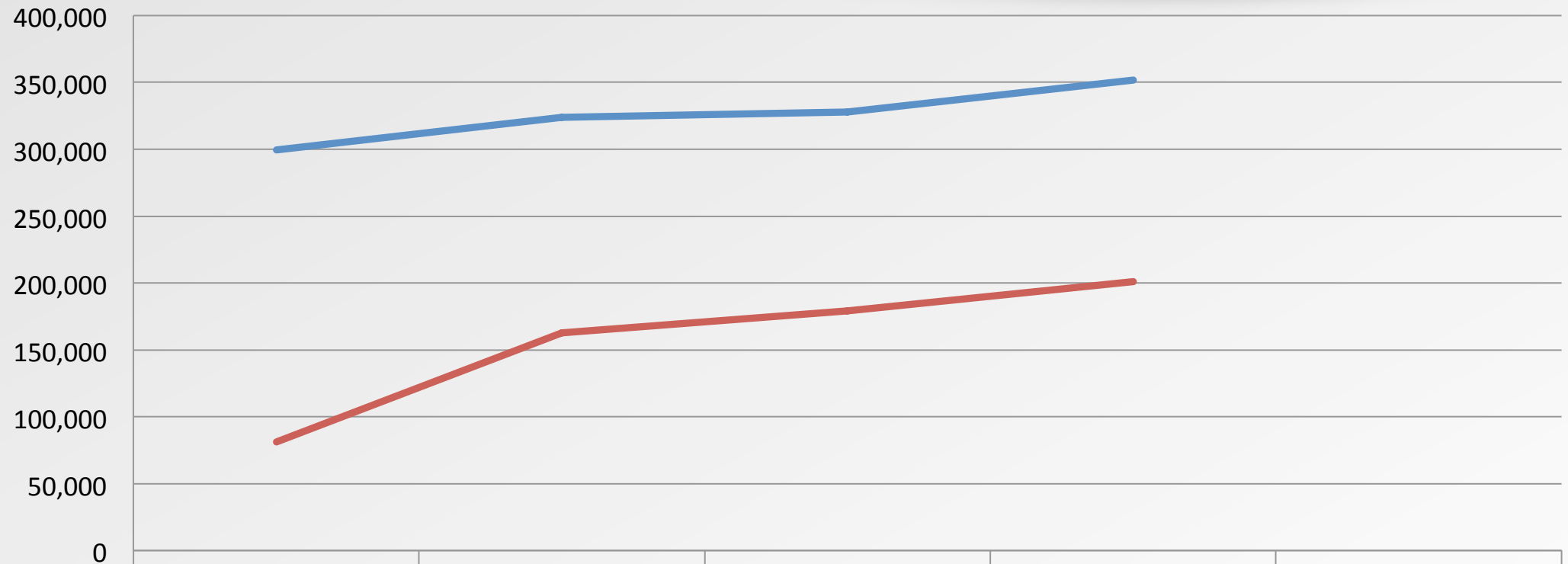
Individual Designations	299,476	323,855	328,022	351,526	162,215
Refusals	75,798	73,051	77,726	84,757	42,522

# Time-limit to reply to a provisional refusal



Top 10 dCP in 2013	N° of designations	N° of provisional refusals	Time limit for provisional refusals	Time limit to respond to an ex-officio provisional refusal
China	20.275	6.435	after the 18-month	15 days, from the date on which the holder/representative, received from the IB the notification of refusal
Russian Federation	18.239	6.765	12 months	6 months, from the date of the notification of provisional refusal sent by the Office to the applicant
European Union	17.598	2.340	18 months	2 months
United States of America	17.322	17.629	after the 18-month	6 months, from WIPO's notification to the holder
Switzerland	13.215	1.808	18 months	5 months in case of provisional refusal on absolute grounds or both absolute and relative grounds and 3 months if only on relative grounds, always from date of issue of notification by the Swiss Office (extendable)
Japan	13.179	7.890	18 months	3 months, from date of issue of notification of provisional refusal (extendable)
Australia	11.675	3.455	after the 18-month	15 months (extendable for further 6 months)
Republic of Korea	10.967	6.478	after the 18-month	2 months (extendable)
Turkey	9.838	2.393	after the 18-month	2 months
Ukraine	9.589	1.272	after the 18-month	3 months, from the date of issue of the notification by the Office (extendable)

# Statements of Grant of Protection



— Individual Designations

2010

299,476

2011

323,855

2012

328,022

2013

351,526

June, 2014

162,215

— Grants of Protection

81,037

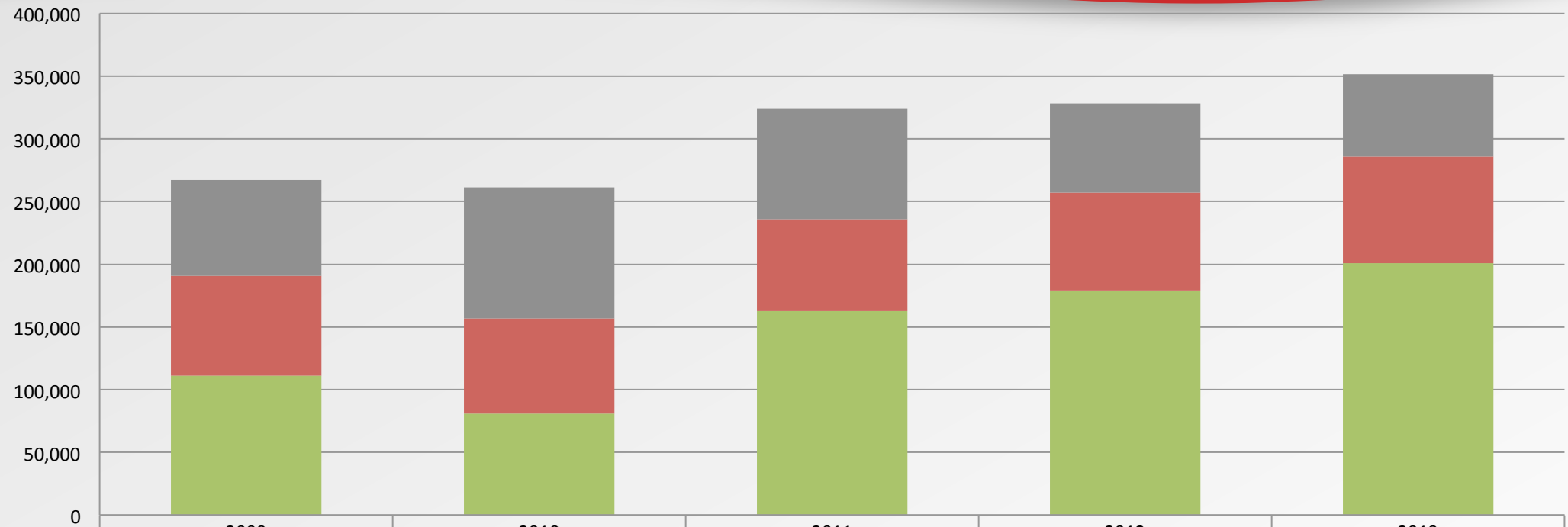
162,569

179,176

200,831

99,796


# Designations, granted and refused



	2009	2010	2011	2012	2013
Designations	267,331	261,105	323,855	328,019	351,526
Pending	76,754	104,270	88,235	71,117	65,938
Refusals (total or partial)	79,336	75,798	73,051	77,726	84,757
Grants of protection	111,241	81,037	162,569	179,176	200,831

# Fraudulent invoices





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## Madrid – The International Trademark System

The Madrid System is a one stop solution for registering and managing marks worldwide.

- Main features of the system
- Members
- Legal texts
- Working Groups and Assemblies



More videos about the Madrid System

### News

WIPO at the 136th INTA Annual Meeting, Hong Kong, China Mar 25, 2014 |  
Making the Most of the Madrid System : Information and Practical Tips on How to Use Specific Forms Mar 13, 2014

All news

### Key resources

ROMARIN | E-payment | E-renewal | Forms | MGS | Fee calculator | MRS | E-subsequent designation

All resources ▾

General information	Legal & procedural information	Online services
<a href="#">Madrid Highlights</a>	<a href="#">Madrid treaties</a>	<a href="#">ROMARIN</a>
<a href="#">Information concerning national or regional procedures before IP offices under the Madrid System</a>	<a href="#">Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol</a>	<a href="#">MGS (Madrid Goods &amp; Services Manager)   Tutorial</a>
<a href="#">FAQs</a>	<a href="#">Information notices</a>	<a href="#">MPM (Madrid Portfolio Manager)   Tutorial</a>
	<a href="#">WIPO Gazette of International Marks</a>	<a href="#">MRS (Madrid Real-time Status)   Tutorial</a>
	<a href="#">Declarations made under the Madrid Agreement and the Madrid Protocol</a>	<a href="#">MEA (Madrid Electronic Alert )   Tutorial</a>
	<a href="#">Offices practices on replacement and survey</a>	<a href="#">E-payment</a>
		<a href="#">E-renewal</a>
		<a href="#">E-subsequent designation   Tutorial</a>
<b>Fees</b>	<b>Statistics</b>	<b>Other</b>
<a href="#">Fees</a>	<a href="#">Annual</a>	<a href="#">Forms   E-forms</a>
<a href="#">Fee calculator</a>	<a href="#">Monthly</a>	<a href="#">Electronic Notification Service</a>
<a href="#">E-payment</a>	<a href="#">In progress</a>	<a href="#">International Application Simulator</a>
<a href="#">How to pay</a>		<a href="#">Translation request</a>
<a href="#">Warning - requests for payment of fees</a>		

MARQUES





**Thank you!**  
Asta Valdimarsdottir  
Director  
Operations Division  
Madrid Registry  
(+41 22 338 9120)  
[asta.valdimarsdottir@wipo.int](mailto:asta.valdimarsdottir@wipo.int)