

# The Madrid Protocol: Key Benefits, Risks and Strategies



# What is the Madrid Protocol?

- International Treaty administered by WIPO
- Simple vehicle to obtain and maintain registration of trademarks in multiple jurisdictions through a single trademark office

# What is the Madrid Protocol?

Allows for:

- Simplified international filing system
- Simplified renewals, assignments, and recordals
- Three official languages

# What is The Madrid Protocol?

Members of the Madrid Protocol:

- Over 80 contracting parties
- Visit [www.wipo.int](http://www.wipo.int) for updated list

# Who May Use the Madrid Protocol?

Any person who:

- Has a real and effective industrial or commercial establishment in a contracting party;
- Is domiciled in a contracting party;
- Is a national of a contracting state; or
- Is a national of a state member of a contracting organization.

# Effects of the International Registration

- A bundle of national / regional rights
- Initially with same list of goods / services
- WIPO may object to wording of goods / services before IR is sent to national offices
- Further objections / refusals possible on national level

# Advantages of the Madrid Protocol

- Centralized filing procedure
- Potentially significant savings

# Advantages of the Madrid Protocol

- Simplified filing requirements
- Simplified maintenance



# Advantages of the Madrid Protocol

- Transformation into national filings

# Risks of the Madrid Protocol

Central attack and mirror effect:

- IR mirrors home application / registration
- Attack on home mark within first 5 years of date of IR results in same limitation / cancellation of protection in countries designated under IR
- IR does not become independent of home registration until after five years

# Risks of the Madrid Protocol

- Requirement for assistance of local agent if objections arise during prosecution or in the context of opposition proceedings may reduce savings

# Searching Strategies

Minimum recommended:

- Full availability search – before filing in home country, to determine if the trademark appears available for use and registration
- Screening search – direct hit / identity search in each other country of interest

# Filing Strategies

- Coined expressions are preferable, as more likely to be inherently registrable
- Descriptive / generic terms may result in objections and eliminate the cost saving advantage

# Filing Strategies

- Consider waiting for home application to clear opposition period before filing international application (risk of central attack)
- If applicant requires single brand in all designated countries, multiple potential marks are recommended because unlikely that one mark will be accepted everywhere

# Filing Strategies

- May not want to use European Community trademark application as home application (heightened risk of opposition)
- US applicants may prefer national or regional route in order to expand scope of protection of mark (more limited base mark)

# Additional INTA Resources

- For more information, visit Global Trademark Resources on [www.inta.org](http://www.inta.org) for:
  - *Practitioner's Guide to the Madrid Agreement and Madrid Protocol*
  - Madrid Protocol and Community Trade Mark and the Madrid Protocol Comparison fact sheets
  - Madrid System Topic Portal