

ACCESSION KIT: THE MADRID SYSTEM FOR THE INTERNATIONAL REGISTRATION OF MARKS

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ADVANTAGES OF THE MADRID SYSTEM FOR THE INTERNATIONAL REGISTRATION OF MARKS

1. The Madrid System for the International Registration of Marks (the Madrid System) is a one-stop solution for trademark holders to obtain and maintain protection in multiple markets. Whether you are a small start-up or a large multinational exporter, the Madrid System can help you manage your brand cost-effectively and efficiently.
2. The Madrid System offers many advantages for trademark owners, national and regional economies and governments, as well as for professionals, like agents and attorneys practicing in the field of trademarks.

BENEFITS FOR THE TRADEMARK OWNER

3. The Madrid System provides a streamlined, low-cost and effective means of obtaining and maintaining protection for marks in multiple countries.
4. It is possible to apply for, and maintain protection for trademarks in more than 120 countries by filing one international application with one national or regional Intellectual Property (IP) Office, in one language and by paying fees in one currency. This simplified procedure saves time and costs in comparison to applying for trademark protection directly before each of the various national or regional IP Offices where you seek protection of your mark. If you seek protection by filing directly before each of the IP Offices concerned, you would be required to appoint local attorneys or agents to help you navigate the domestic requirements of those IP Offices, using different forms and administrative procedures, in the various local languages and paying fees in local currencies.
5. An international registration has one number that may include protection in many of the members of the Madrid System and only one renewal date to monitor, which makes it easy to manage the portfolio of rights.
6. It is easy to record changes to your international registration. By taking advantage of the centralized procedure with the International Bureau of the World Intellectual Property Organization (WIPO), you may record changes, such as a change in name and address or ownership, a limitation of goods and services, and renew your mark directly before WIPO. WIPO will inform all the relevant IP Offices in the territories covered by your international registration of the change, saving you the time and expense of carrying out such procedures separately before each of those IP Offices.
7. The main advantage for trademark owners is the simplicity of the international registration system together with the financial savings made when obtaining and maintaining the protection of their marks abroad; incurring no further expenses related to translation, exchange-related fees and fees for local representatives.
8. In the current economic climate, a streamlined, straightforward and low-cost option for global trademark protection is a welcomed advantage for companies and individuals with an export-oriented profile. This is especially beneficial for Small and Medium Enterprises (SMEs), without the time and financial resources needed to protect their marks abroad.

9. The IP Offices of each of the territories designated in the international registration have a fixed time limit to provide a decision on the scope of protection. This means that you should receive confirmation that the mark is either protected or initially refused, in all territories designated in the international registration within 12-18 months, at the latest. If the Office concerned finds grounds to refuse the mark either partially or totally, you will receive a provisional refusal and be given the option to respond. If there are no grounds for refusal, the Office will issue a grant of protection. If the Office has not issued any provisional refusal within the applicable time limit, the mark is automatically protected in the territory of the member concerned. For more information on the various members and their applicable time limits, see the [Madrid Member Profiles Database](#).

BENEFITS FOR THE NATIONAL/REGIONAL ECONOMY, THE GOVERNMENT AND THE IP OFFICES

10. The Madrid System provides benefits for the national/regional economy in general and for the government's finances, in particular.

11. The Madrid System facilitates an easier access to export markets and puts a stronger emphasis on – and supports – the country's export profile. By being a member of the Madrid System, these countries will be seen as more attractive for trademark owners based abroad that are looking at potential export markets for protecting their marks, which will improve and strengthen the climate for foreign investments. This would lead to more filings (both national/regional and designations under the Madrid System), which would result in an increase in revenue and a possible boost of support for local industries.

12. The IP Offices in the territories designated in an international registration also benefit, because they do not need to examine the mark concerned for compliance with formal requirements or to classify the goods or services. As these formalities checks are conducted by WIPO beforehand, the IP Offices concerned can focus on their substantive examination.

13. The IP Offices are compensated for their work. Trademark owners seeking protection of their marks using the Madrid System will pay fees to WIPO for the countries they designate. WIPO collects these fees and will pay these to the countries concerned, following the fee regime they fall under.

BENEFITS FOR PROFESSIONALS – TRADEMARK ATTORNEYS AND AGENTS

14. The Madrid System provides one additional option for protection of trademarks abroad. The options available for trademark owners seeking protection of their marks abroad are:

- the national route, which means they would need to file applications before each of the IP Offices in each territory of interest;
- the regional route, which means they would need to file an application to the IP Office of the regional system concerned (for example, the European Union, where registration would mean protection in the territories covered by that region); or
- the international route – the Madrid System – where a single application can cover +120 territories.

15. It is important for trademark attorneys and agents to guide their clients to the best option of protection for them, taking into account any trademark strategy or protection plan in place, as well as current and future possible export interests.
16. Experience shows that companies and individuals have many different reasons for selecting a particular option for protection. Therefore, the IP Offices will continue to receive applications directly from foreign trademark owners filed through a local representative (agent or attorney), in addition to designations in international registrations under the Madrid System.
17. Local representatives should not expect a significant decrease in work following an accession to the Madrid System. National or regional law governs the effects of the international registration of a mark, as well as all the procedures to exercise and enforce the rights deriving from that registration. Therefore, local representatives can expect not only to advise on the filing of international applications including pre-filing searches, but also on the prosecution of such applications and international registrations, including responding to provisional refusals, raising objections or filing oppositions, requests for annulment or cancellation, dispute settlements, license and assignment contracts, among others.
18. It is likely that the number of marks protected locally would gradually increase because of the accession to the Madrid System, which would result in an increase in the volume of work for local representatives.
19. An accession to the Madrid System offers local representatives new business opportunities. Their local clients would benefit from advice concerning the initial filing of international applications, such as preparing the application form and conducting searches. By making the necessary preparations beforehand, including researching information about the members set out in the [Madrid Member Profiles Database](#), the representative could help reduce the chances of future provisional refusals, and ensure a smooth cost-effective passage for their clients to obtain protection in their chosen export markets. After the international mark has been registered and the designated members have been notified by WIPO, the representative would report and advise on any provisional refusals and coordinate responses to such refusals. Further, the representative would deal directly with WIPO concerning matters related to the international registration, such as recording various changes and attending to renewal.

GENERAL OVERVIEW OF THE MADRID SYSTEM; ITS OBJECTIVES AND MAIN FEATURES

20. Originally, the Madrid System was governed by the Madrid Agreement Concerning the International Registration of Marks (the Agreement), which was adopted in 1891. The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (the Protocol) was adopted in 1989, entered into force on December 1, 1995, and came into operation on April 1, 1996.
21. By a decision in the Madrid Union Assembly in October 2016, the Agreement is now inoperative and the Protocol is the sole governing treaty under the Madrid System. It is no longer possible for countries to accede only to the Agreement, but it is possible to accede to both the Agreement and to the Protocol, in which case the Protocol will prevail.
22. The [legal framework](#) of the Madrid System consists of the Protocol, the Regulations under the Protocol and the Administrative Instructions.

23. The Madrid System is administered by the International Bureau (WIPO) headquartered in Geneva. The International Bureau maintains the International Register and publishes the *WIPO Gazette of International Marks* (the Gazette).

24. Any State which is a party to the Paris Convention for the Protection of Industrial Property (the Paris Convention) may become a party to the Protocol. In addition, an intergovernmental organization may become a party to the Protocol (but not the Agreement); see more on “Accession” below (paragraphs 70 to 78).

25. States and intergovernmental organizations party to the Protocol are referred to collectively as Contracting Parties or members. As of March 1, 2021, the Madrid System has 108 members (106 countries and two intergovernmental organizations (the European Union and the African Intellectual Property Organization (OAPI))). A complete [list of the current Madrid members](#) is available on WIPO’s website.

26. Together, these members constitute the [Madrid Union](#), which is a Special Union under Article 19 of the Paris Convention. 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 OF THE MADRID SYSTEM

27. The objectives of the Madrid System are two-fold. Firstly, it facilitates the obtaining of international protection for marks (trademarks and service marks) in multiple territories around the world by filing one application. The registration of a mark in the International Register produces, in the designated members, the effects described below (see paragraphs 52 to 54). Further members may be designated subsequently to the international registration. Secondly, since an international registration is equivalent to a bundle of national or regional registrations, the management of that protection is made much easier. There is only one registration to renew and changes to the international registration, such as a change in ownership or in the name or address of the holder, are recorded directly with WIPO through a single simple procedural step, with effects for all the members concerned. The Madrid System is also flexible enough to accommodate requests to record a partial change in ownership (for only some of the designated members or for only some of the goods and services), or to limit the list of goods and services with respect to only some of the designated members.

WHO MAY USE THE MADRID SYSTEM?

28. A natural person or a legal entity may file an application for international registration (an international application) providing they are entitled to use the Madrid System. This means that they need to have a connection with a member of the Protocol through nationality, domicile or have a real and effective industrial or commercial establishment within the member, or in the territory of the member where this is an intergovernmental organization.

29. The Madrid System is a closed system; it cannot be used by someone (a person or legal entity) who does not have the necessary connection, nor can it be used to protect a mark in the territory of a country outside the Madrid Union.

THE INTERNATIONAL APPLICATION

30. A mark may be the subject of an international application only if there is a “basic mark”, which means that the same mark has already been registered (basic registration) or protection has been applied for (basic application) in the IP Office of the member with which the applicant has the necessary connection (“entitlement”, see paragraphs 28 and 29). This Office is referred to as the Office of origin.
31. An international application must be presented to WIPO through the Office of origin. An international application presented directly to WIPO by the applicant will be returned to the sender without processing.
32. The particulars of the international application must correspond to the particulars of the basic mark, more specifically the name of the applicant and the mark must be the same, and the list of goods and services in the international application must be covered by the scope of the list of the basic mark.
33. An international application may claim priority under Article 4 of the Paris Convention. The priority may be from the basic 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 (WTO).
34. An international application must designate the members (territories) in which protection is sought. It is not possible to designate the member (territory) of the Office of origin; this is not necessary given that the trademark owner has the basic mark in the home market.
35. An international application can be filed in any one of the three languages of the Madrid System, namely, English, French or Spanish. However, the Office of origin may restrict the applicant’s choice to one only, or to two of those languages, or may permit the applicant to choose between any of the three languages.
36. The international application is subject to the [payment of the following fees](#):
- a basic fee;
 - a complementary fee in respect of each designated member for which no individual fee is declared;
 - a supplementary fee in respect of each class of goods and services beyond the three; however, no supplementary fee is payable where all the designations have declared individual fees.
37. In accordance with Article 8(7) of the Protocol, a member may declare that, instead of a share in the revenue produced by the supplementary and complementary fees, it wishes to receive an individual fee. The amount of the individual fee is determined by each member; it may not be higher than the amount that would be payable for the registration of a mark at the national or regional level in the Office of the member concerned. The amounts of the respective [individual fees](#) are available on WIPO’s website.
38. For countries that are members of both the Protocol and the Agreement, special conditions apply that may have an impact on the applicable fees (see paragraph 51).

39. The basic fee is reduced to 10% for international applications filed by applicants whose country of origin is a [Least Developed Country](#) (LDC), in accordance with the list established by the United Nations.
40. The fees for filing an international application may be paid directly to WIPO or, or through an Office of origin that accepts to collect and forward such fees.
41. The Office of origin must certify that the particulars of the international application correspond to the particulars of the basic mark. This concerns the mark, the name of the applicant, and that the scope of the goods and services indicated in the international application are covered by the list of goods and services in the basic mark.
42. The Office of origin must also certify the date on which it received the international application. This date is important since it will be the date of the international registration providing WIPO receives the international application within two months (and where no substantial elements are missing).
43. WIPO checks that the international application complies with the formal requirements of the Protocol and the Regulations under the Protocol, including requirements relating to the indication of goods and services and their classification, and that the required fees have been paid. WIPO will inform the Office of origin and the applicant of any irregularities, which must be remedied within a given time limit (three months).
44. Where the international application complies with the formal requirements, WIPO will register the mark, record this in the International Register and publish it in the Gazette. WIPO will send a certificate of the international registration to the holder and notify each member in which protection has been requested.

EXAMINATION BY THE OFFICE OF A DESIGNATED MEMBER; REFUSAL OF PROTECTION

45. The Office of a designated member examines the international registration in the same way as an application filed directly with that Office. Where the Office finds grounds for refusal during its *ex officio* examination or if an opposition is filed with the Office, the Office has the right to notify WIPO that protection cannot be granted to the international registration. In this case, the Office must send WIPO a notification of provisional refusal.
46. The Office of a designated member must notify WIPO of any provisional refusal within the applicable time limit specified in Article 5(2) of the Protocol. The standard time limit is one year, but a member may declare that this time limit shall be replaced by 18 months. A member 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.
47. For countries that are members of both the Protocol and the Agreement, special conditions apply that may have an impact on the applicable time limit (see paragraph 51).
48. The provisional refusal is recorded in the International Register, published in the Gazette, made available on WIPO's website (in [Madrid Monitor](#)) and transmitted to the holder of the international registration.

49. WIPO is not involved in any procedure subsequent to the provisional refusal, such as review, appeal or response to an opposition, which would need to be carried out directly between the holder of the international registration and the relevant Office. The holder may be required to appoint a local representative to act on behalf of the holder before the Office concerned. However, once all the procedures before that Office have been completed, the Office must send WIPO a final statement. There is no fixed time limit for the Office concerned to notify WIPO of this 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). Received statements are recorded in the International Register, published in the Gazette, made available on WIPO's website (in [Madrid Monitor](#)) and transmitted to the holder of the international registration.

50. Where, before the expiry of the applicable time limit for issuing a provisional refusal, all the procedures before an Office have been completed and the Office finds no grounds to refuse protection, the Office must send WIPO a statement confirming that protection is granted to the mark (Statement of Total Grant of Protection). Such statement is recorded in the International Register, published in the Gazette, made available on WIPO's website (in [Madrid Monitor](#)) and transmitted to the holder of the international registration. In the absence of any communication concerning a provisional refusal or a statement of grant of protection, the mark is considered automatically protected in the member concerned, for all the goods and services in question. This is due to the principle of *tacit acceptance*.

MEMBERS OF BOTH THE PROTOCOL AND THE AGREEMENT

51. While the Protocol applies to States that are bound by both the Protocol and the Agreement, certain declarations that the members may have made do not apply. This follows from Article 9~~sexies~~(1)(b) of the Protocol which renders inoperative declarations made under Articles 5(2)(b), (c) and 8(7) in the mutual relations between members which are both party to the Agreement and the Protocol. This means that where the Office of origin and the designated member are both members of both the Protocol and the Agreement, the designated member would (regardless of any declarations made under Articles 5(2) and 8(7)) receive the [standard fee](#) only and would need to issue any provisional refusal within a time limit of one year.

EFFECTS OF THE INTERNATIONAL REGISTRATION

52. From the date of the international registration or, in the case of a subsequent designation, from the date of that subsequent designation, the protection of the mark in each of the designated members is the same as if the mark had been the subject of an application for registration filed directly with the Office of that member. If no provisional refusal is notified to WIPO within the relevant time limit, or if a refusal has been notified and has been subsequently withdrawn, the protection of the mark in each designated member is the same as if it had been registered by the Office of that member.

53. An international registration is equivalent to a bundle of national registrations. This is unlike a unitary regional right, such as the European Union Trade Mark (EUTM), that provides protection for all European Union members, which cannot be refused, limited or transferred for only 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.

54. Although an international registration is a single registration recorded in the International Register, each Office of the designated members will independently examine the mark in line with their domestic legislation and practice. This means that some of the designated members may refuse protection while others may grant full (or limited) protection. An owner of an international registration may limit protection or renounce the international registration in respect of one or more members. The owner may also transfer all or some of the designated members to a new owner for some or all of the goods and services covered by the international registration. An international registration may also be declared invalid by a designated member (for example, for non-use of the mark). Further, any action for infringement of an international registration must be brought separately before the relevant authorities in each of the members concerned.

DEPENDENCE ON THE BASIC MARK AND TRANSFORMATION

55. An international registration remains dependent on the basic mark registered or applied for in the Office of origin for a period of five years from the date of the international registration. This means if the basic registration ceases to have effect, for example, following a cancellation decision of the Office of origin or a Court, voluntary cancellation, or through non-renewal within this five-year period, the international registration will be cancelled to the same extent (partially or totally). Similarly, where the international registration is based on an application in the Office of origin, it will be cancelled if that basic application is refused or withdrawn within the five-year period, or if the registration resulting from that application ceases to have effect within that period. The same also applies if the basic mark is withdrawn or renounced after the expiry of the five-year period if the action resulting in the withdrawal or renunciation had begun before the expiry of the dependency period.

56. The Office of origin must notify WIPO of the facts and decisions concerning such ceasing of effect or refusal and, where appropriate, request the cancellation (to the extent applicable) of the international registration. WIPO will record the cancellation in the International Register, publish it in the Gazette and notify the holder and the designated members concerned.

57. It is possible to avoid further loss of rights caused by the ceasing of effect and cancellation of the international registration by transforming the rights of an international registration into national or regional applications. Within a time limit of three months from the date of the recording of the cancellation in the International Register, the holder may file an application for registration with the Office of a member, which was covered by the international registration. That application will then be treated as if it had been filed on the date of the international registration, or the date of the subsequent designation, should this be the case. This process is called transformation.

58. After the expiry of the period of five years from the date of the international registration, the international registration becomes independent of the basic registration or basic application.

59. Any changes made to the basic mark that do not affect the scope of protection (goods and services), for example, change in name of the holder, or change in ownership within the five-year dependency period, have no impact on the international registration.

REPLACEMENT OF A NATIONAL OR REGIONAL REGISTRATION BY AN INTERNATIONAL REGISTRATION

60. To simplify the management of their portfolio of rights, a holder may designate a member in their international registration where they already have protection in a national or regional registration. In such situation, the international registration is deemed to replace the prior national or regional registration, providing the mark is the same, the recorded owner is the same, and there are overlapping goods and services. 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 that national or regional registration; the holder has had continued protection in that member concerned, from the date of the earlier national or regional registration. Although replacement takes place automatically, the holder of the international registration may request the Office of the member concerned, in which the national or regional registration is recorded, to take note in its register of the international registration.

SUBSEQUENT DESIGNATION

61. The effects of an international registration can be extended to further members (territories) by filing a subsequent designation. The Madrid System allows the holder of an international registration to expand the geographical scope of the protection of the mark later in line with their business needs, or to extend the protection to a member that recently acceded to the Protocol. This feature of the Madrid System is beneficial, in particular, to SMEs, allowing them to start small, by designating a few members, and then later add more members to their already existing international registration as their business expands. The date of effect of the international registration in the members designated subsequently would be from the date of the subsequent designation, and not from the initial date of international registration.

CHANGES IN THE INTERNATIONAL REGISTER; CANCELLATION; LICENSES

62. A change in the name, address or the legal nature of the holder, or a change in the name or address of the holder's representative may be recorded in the International Register upon request.

63. 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 members. It is not possible however, to record a new holder of an international registration if they are not entitled (have the necessary connection with a member) to file an international application under the Madrid System.

64. 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 members;
- a renunciation in respect of some of the designated members for all the goods and services;
- a cancellation of the international registration in respect of all the designated members for all or some of the goods and services;
- a license granted in respect of all or some of the designated members, and for all or some of the goods and services.

65. Information concerning such changes, cancellations and licenses is recorded in the International Register, published in the Gazette and notified to the designated members concerned.

66. No change may be made in the mark itself 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 of the main list of the international registration.

DURATION OF REGISTRATION; RENEWAL

67. An international registration is effective for 10 years, from the date of the international registration. It may be renewed for further periods of 10 years on payment of the prescribed fees. WIPO sends a reminder (unofficial notice) to the holder and to the representative, if any, six months before renewal is due.

68. The international registration may be renewed in respect of all the designated members 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 the holder wishes, at the time of renewal, to remove some of the goods and services from the scope of the international registration, the holder must request separately a cancellation in respect of those goods and services, or request the recording of a limitation, prior to the renewal of the registration.

FOR MORE INFORMATION

69. For more information on how the Madrid System works, please visit www.wipo.int/madrid or see the [Guide to the International Registration of Marks under the Protocol](#).

ACCESSION TO THE MADRID SYSTEM

ACCESSION PROCEDURES

70. Any State party to the Paris Convention may become a party to the Protocol. In addition, an intergovernmental organization may become a party to the Protocol, 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.

71. A State or intergovernmental organization may become a party to the Protocol by depositing an instrument of accession.

72. The instrument of accession must be signed by the Head of State, Head of Government or by the Minister of Foreign Affairs, in accordance with the country's legal system. The instrument must be deposited with the Director General of WIPO. Annex I contains a model instrument of accession.

73. The Protocol will enter into force three months after the date on which the instrument of accession has been notified by the Director General of WIPO.

74. The instrument of accession may contain certain declarations. Some declarations can be made only at the time of the accession while others may be submitted later. It would therefore be very useful for the potential member of the Madrid System to discuss possible declarations with WIPO prior to acceding to the Protocol. For a complete list of possible declarations to make in connection with accession, please see:
<http://www.wipo.int/madrid/en/madridgazette/remarks/declarations.html>.

DOMESTIC LEGISLATIVE OR REGULATORY IMPLICATIONS

75. The main substantive obligation deriving from an accession to the Madrid System will be to give effect to Article 4(1) of the Protocol. This means that a mark registered in the International Register, in which the member has been designated, must be protected from the date of international registration (or, in the case of a member designated subsequently, from the date of that subsequent designation), in the same way as if that mark had been applied for directly with the national or regional IP Office. That Office is, however, fully entitled to carry out a substantive examination of the mark and may, within the applicable time limit under Article 5(2) of the Protocol, refuse to grant protection to the mark (either totally or partially). If the Office does not issue a provisional refusal within the applicable period, the mark is deemed to be protected in the same way as if it had been registered directly with that Office.

76. When acceding to the Madrid Protocol, the new member must also be in a position to give full effect to the provisions of the Protocol. If requested to do so, WIPO will provide necessary advice and assistance required for that purpose, for example, WIPO will analyze the domestic legislation and provide comments on its compatibility with the Madrid System. WIPO will also propose provisions specifically tailored to the domestic legislation concerned, to ensure that the applicable legislation is compatible with the Protocol. Please also see the [standard Model Provisions](#) which have been established to provide information and assistance to these potential members.

EFFECTS OF ACCESSION

77. Statistics show that the accession of a new member to the Madrid System would gradually produce an increase in the total number of marks for which protection is requested in that member concerned (resulting from combining the number of domestic direct applications and the number of designations under the Madrid System received internationally). This can be explained by the fact that it is relatively easy and economical for the owner of a mark to designate a country/regional territory in an international application.

78. As regards the workload of the IP Office of the new member concerned, an accession to the Madrid System would not bring an overwhelming number of new applications, but rather a gradual increase in registration activity. There would also be less work for the Office for a designation under the Madrid System compared to a direct domestic application, as WIPO will have already completed the formalities examination for the designations. An increase in total number of filings in the Office concerned would also lead to increase in revenue, some of which may be invested in further resources in the Office (human resources and IT equipment).

MAIN ACTIONS TO BE UNDERTAKEN BY AN OFFICE AS PART OF THE INTERNATIONAL PROCEDURE UNDER THE MADRID SYSTEM

INTRODUCTION

79. The Office of a member to the Protocol will have two distinct roles:

- as the Office of origin for international applications and international registrations originating from the territory of the member, and
- as the Office of the designated member where it has been designated in an international registration.

80. The information below is set out in two parts:

- Part I concerns an Office as Office of origin and
- Part II deals with an Office as the Office of a designated member.

PART I: MAIN ACTIONS TO BE UNDERTAKEN BY THE OFFICE OF ORIGIN

Overview

81. To use the Madrid System, the trademark owner must be entitled, which means that they must have a connection with a member (see paragraphs 28 and 29), and have a basic mark registered or applied for protection with the local IP Office. The trademark owner must file the international application through the local IP Office, which would perform the role as the Office of origin.

82. The main role of the Office of origin is to certify the international application before presenting it to WIPO. In addition, given that the international registration is dependent on the basic mark for the first five years of its existence, the Office of origin is required to notify WIPO of any relevant changes affecting the scope of protection of the basic mark during that period.

Status of “Office of Origin”

83. The Office with which the applicant files an international application must check that it is the correct “Office of origin”. This means ensuring that the applicant has established the necessary connection (by means of nationality, domicile or a real and effective industrial or commercial establishment) with respect to the member concerned. The Office of origin may require the applicant to submit evidence to support their entitlement.

“Basic Mark” in the Country/Regional Territory of Origin

84. The Office of origin must check for the existence of a basic mark, i.e., that the national or regional mark, which is the subject of international application, has already been filed with that Office, or registered in its national or regional register. If so, the Office of origin must verify that the applicant has correctly indicated the number of the basic mark in the international application form.

Certification

85. The Office of origin must certify that the particulars appearing in an international application correspond to the particulars of the basic mark. More specifically, the name of the applicant of the international registration and the owner of the basic mark must be the same, the international mark and the basic mark must be the same, and that the goods and services listed in the international application are covered by the scope of the goods and services appearing in the basic mark. To do this, the Office of origin would need to compare the details of the basic mark and the international application.

86. Should there be any discrepancy between the international application and the basic mark in relation to one or more of the above-mentioned particulars, the Office of origin must require the applicant to amend the international application accordingly.

Indication of Date; Forwarding the International Application to the International Bureau (WIPO)

87. The Office of origin must indicate the date on which it received the international application. The Office should transmit it to WIPO within two months from that date to ensure that the applicant benefits from the date of receipt. The Office of origin would communicate with WIPO by electronic means only.

Irregularities in the International Application

88. Where WIPO, during its formal examination of the international application, finds that it contains irregularities, it will notify both the Office of origin and the applicant of this fact. There are three categories of irregularities; (i) concerning the actual classification of the goods and services, (ii) concerning the indications of the goods and services, and (iii) miscellaneous matters. Some irregularities must be remedied by the Office of origin (for example, any irregularity concerning the goods and services), others may need to be remedied by the applicant (for example, missing or insufficient fees). The details of the irregularities, how and when (time limit) they may be remedied and by whom (whether it is the Office or the applicant to remedy) will be specified in the irregularity notice.

Ceasing of Effect of the Basic Mark

89. If, within a period of five years following the date of the international registration (the “dependency period”), the basic mark ceases to have effect, the Office of origin must inform WIPO and request the cancellation of the international registration in respect of the goods and services affected.

PART II: MAIN ACTIONS TO BE UNDERTAKEN BY THE OFFICE OF A DESIGNATED MEMBER

Overview

90. WIPO will notify each Office of the members designated in the international registration. These Offices will then perform their examination in line with their legislation and practice. Each Office may notify WIPO if it considers that protection can or cannot be granted in the member concerned. Where the Office needs to notify a provisional refusal, it must do so within the applicable time limit (i.e., one year, 18 months or more than 18 months, in the case of a provisional refusal based upon an opposition).

Examination of the International Registration; Provisional Refusal of Protection

91. The Office of a designated member, notified of an international registration or a subsequent designation, should perform the same substantive examination of the mark that would apply to a national or regional application for registration.

Statement of Grant of Total Protection

92. 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 WIPO a statement to the effect that protection is granted to the mark. Such statement is recorded in the International Register, published in the Gazette and transmitted to the holder of the international registration.

Provisional Refusal of Protection

93. Following its examination, the Office may notify WIPO of a provisional refusal of protection if it considers that the international registration does not comply with the provisions of its domestic legislation.

94. Such a refusal (*ex officio* provisional refusal) must be sent within the prescribed time limit of one year, or 18 months if a declaration under Article 5(2)(b) of the Protocol has been made. The provisional refusal may relate to all or only some of the goods and services for which protection is sought.

95. A provisional refusal may also be based on an opposition filed by a third party, objecting to the mark being protected in the member concerned (provisional refusal based on an opposition), within the prescribed time limit of one year, or 18 months or beyond this if the relevant declaration under Article 5(2)(b) and (c) has been made.

96. If the Office takes no action within the applicable time limit, the mark stands protected, i.e., a mark that is the subject of an international registration is protected automatically in a designated member unless protection is actually refused by the Office concerned. This follows from the principle of tacit acceptance.

Confirmation or Withdrawal of Provisional Refusal

97. An Office which has sent WIPO a notification of provisional refusal must, once all procedures before the said Office relating to the protection of the mark have been completed, send WIPO a statement indicating whether the provisional refusal has been confirmed, or totally or partially reversed by that Office. Where an Office has totally or partially reversed the provisional refusal, that Office must send a "Statement of Grant of Protection Following a Provisional Refusal", specifying whether the protection is total or partial. Where the Office confirms a total refusal, it must send a "Statement of Confirmation of Total Provisional Refusal".

Further Decision Concerning the Protection of the Mark

98. Where there is a further decision in the designated member (by the Office or the Court) affecting the protection of the mark, the Office must to the extent that it is aware of that decision, send WIPO a further statement indicating the goods and/or services for which the mark is protected in the member concerned. Such decision may take place where there is no previous provisional refusal (after the expiry of the applicable time limit), or it could be a decision on the appeal of the final decision by the Office or the Registrar, or it could be a decision by the Court cancelling the effects of the international registration due to non-use.

Invalidation of Effects of International Registration

99. An international registration, which has been granted protection in a member, may subsequently be invalidated by the competent authority in line with their domestic legislation. The Office of the member concerned must notify WIPO where it is aware of a final decision invalidating the effects of an international registration in its territory.

Centralized Management; Renewal and Recording of Changes to the International Registration

100. The Madrid System provides centralized management of an international registration, which allows WIPO to record actions concerning an international registration in the International Register with effect in all the designated members concerned.

101. The holder must renew the international registration directly with WIPO, which will collect the fees and forward or distribute these to the designated members concerned. WIPO would then inform the members concerned that the international registration has been renewed – or not renewed, as applicable.

102. The holder may request the recording various changes to their international registration directly with the WIPO, for example, a limitation of the list of goods and services a license or amendment to such license, a change in the name or address of the holder or the representative or a change in ownership.

103. Where such changes are recorded in the International Register, the members concerned will be notified of the changes and these changes will have effect in the members from the date of recording in the International Register.

104. However, the Madrid System does not bind as to the substantive effect of certain changes and the Office of the designated member concerned could declare, on a case-by-case basis, that the recording of certain changes has no effect. This would apply to, for example, a recording of a change in ownership and the recording of a limitation (see Rule 27(4) and (5) of the Regulations under the Protocol).

Replacement of a National or Regional Registration by an International Registration

105. A holder of an international registration may request the Office of a designated member to take note in its Register of Marks that the international registration replaces an older existing national or regional registration. See also paragraph 60, above. It is not a physical replacement, but rather it allows the holder to benefit from the earlier date of protection. 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 that national or regional registration. Where the Office takes note in its Register, it must notify the WIPO accordingly.

Transformation of an International Registration Into a National/Regional Application

106. Following a cancellation of an international registration at the request of the Office of origin under Article 6(4) of the Protocol (i.e., following a ceasing of effect during the five years dependency period), the holder may file a national/regional application for the same mark with the Office of a designated member. See paragraphs 55 to 59, above.

107. The holder may, within a time limit of three months from the date of the recording of the cancellation in the International Register, file an application for registration with the Office of a member in which the international registration had effect. If the required formalities are complied with, the application shall be treated by the Office concerned as though it had been filed on the date of the international registration, or where the member was designated subsequently to the international registration, the date of the subsequent designation.

108. It is up to each member to determine the modalities for giving effect to such transformation into a national or regional application. It may require that such an application comply with all requirements that apply to national or regional applications filed with its Office, including requirements concerning fees. That is, it may require that the full amount of application and other fees be paid; alternatively, and in particular where the Office concerned has already received individual fees in respect of the international registration concerned, it may decide to provide for reduced fees in the case of such an application.

[Annex follows]

ANNEX

MODEL INSTRUMENT OF ACCESSION TO THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

(To be deposited with the Director General of WIPO in Geneva)

The Government of [name of State] hereby declares that [name of State] accedes to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted at Madrid on June 27, 1989.

Done at, [date]

(Signature)*

(Capacity)

[End of Annex and of document]

* This instrument must bear the signature of the Head of State, Head of Government or Minister of Foreign Affairs.