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 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 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