

APAA 51st Council Meeting

WORKSHOP II

The Impact of the Madrid Protocol

New Delhi, November 13, 2005

Luis-Alfonso Durán

**The Madrid system
started 110 years ago (1893)
with
four European and one African countries**

SWITZERLAND

Nº 1

23 janvier 1893

RUSS-SUCHARD & C^{ie}, fabricants
NEUCHÂTEL (Suisse)



Chocolats et cacaos

La marque ci-dessus a été enregistrée en Suisse
le 1^{er} novembre 1880 sous le N° 86

TUNISIA



BELGIUM

N^o 28

7 août 1893

SOCIÉTÉ ANONYME DE LA STÉARINERIE
H. BOLLINCKX

ANDERLECHT-LEZ-BRUXELLES
(Belgique)



Bougies

La marque ci-dessus a été enregistrée en Belgique
le 30 décembre 1880 sous le N^o 836/1256/4283

FRANCE

N^o 34

14 septembre 1893

GEORGE GOULET & C^{ie},
négociants en vins de Champagne

REIMS (France)



George Goulet
Reims

Vins de Champagne

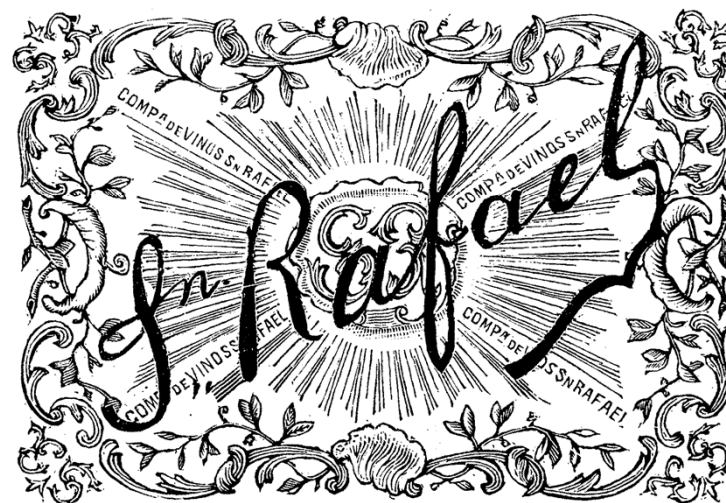
La marque ci-dessus a été enregistrée en France
le 22 juin 1891

SPAIN

N^o 120

20 février 1894

COMPANIA DE VINOS (Société anonyme,
Directeur Francisco Rajel y Rendon)
JEREZ (Espagne)



Vins

La marque ci-dessus a été enregistrée en Espagne
le 21 décembre 1892 sous le N^o 2695

MORE EXAMPLES OF IR

N^o 145

9 avril 1894

H. C. S. SCHALEKAMP (firme Schalekamp frères),
fabricant et marchand
AMSTERDAM (Pays-Bas)



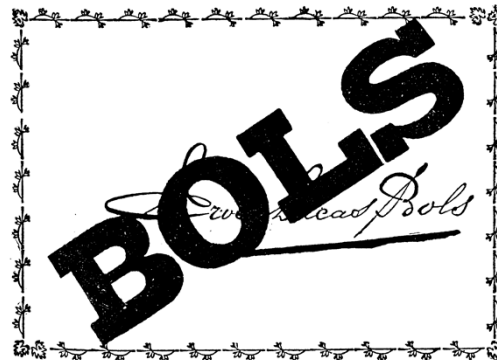
Conserves alimentaires, viandes, fruits et légumes

La marque ci-dessus a été enregistrée aux Pays-Bas
le 22 mars 1894 sous le N^o 10167

N^o 437

6 août 1895

SOCIÉTÉ POUR LA CONTINUATION
DE LA FABRIQUE DE LIQUEURS D'AMSTERDAM
„T LOOTSJE“ DES HÉRITIERS DE LUCAS BOLS
(Société anonyme)
AMSTERDAM (Pays-Bas)



Liqueurs, amers, genièvre et autres boissons distillées

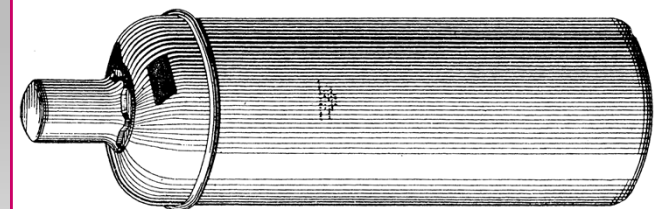
La marque ci-dessus a été enregistrée aux Pays-Bas
le 30 juillet 1895 sous le N^o 11117

N^o 500

14 novembre 1895

COMPAGNIE INDUSTRIELLE DES PROCÉDÉS
RAOUL PICTET

16, rue de Grammont, PARIS (France)



Acide sulfureux anhydre

La marque ci-dessus a été enregistrée en France
le 2 octobre 1895

MORE EXAMPLES OF IR



N^o 300

17 décembre 1894

ARMAND RUEFF & C^{ie},
commissionnaires en marchandises

51, rue de la Chaussée d'Antin, PARIS (France)



Marchandises diverses

La marque ci-dessus a été enregistrée en France
le 25 octobre 1894

N^o 286

26 novembre 1894

COINTREAU, distillateur-liquoriste
ANGERS (Départ. de Maine-et-Loire, France)



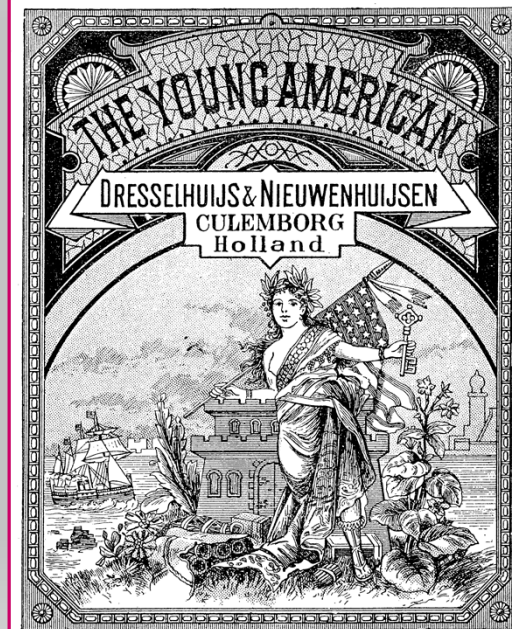
Une liqueur

La marque ci-dessus a été enregistrée en France
le 9 août 1893

N^o 270

25 octobre 1894

DRESSELHUIJS & NIEUWENHUIJSEN, fabricants
CULEMBORG (Pays-Bas)



Cigares

La marque ci-dessus a été enregistrée aux Pays-Bas
le 22 mai 1894 sous le N^o 10327

**The Madrid Protocol started in 1989
(operational as from 1st April 1996)**

Now: 66 countries

MEMBERSHIP (1/5)

* CURRENT EU MEMBER STATES
(.)FROM 15-12-2005



<u>COUNTRIES</u>	<u>AGREEMENT</u>	<u>PROTOCOL</u>	<u>BOTH</u>
Albania	-----	-----	X
Algeria	----- X	-----	-----
Antigua and Barbuda	-----	----- X	-----
Armenia	-----	-----	X
Australia	-----	----- X	-----
*Austria	-----	-----	X
Azerbaijan	----- X	-----	-----
Bahrain (.)	-----	----- X	-----
Belarus	-----	-----	X
*Belgium	-----	-----	X
Bhutan	-----	-----	X
Bosnia and Herzegovina	----- X	-----	-----
Bulgaria	-----	-----	X
China	-----	-----	X
Croatia	-----	-----	X
Cuba	-----	-----	X

MEMBERSHIP (2/5)

* CURRENT EU MEMBER STATES



<u>COUNTRIES</u>	<u>AGREEMENT</u>	<u>PROTOCOL</u>	<u>BOTH</u>
* Cyprus -----			X
Czech Republic -----			X
Dem. People's of Korea -----			X
* Denmark -----		X	
Egypt -----	X		
*Estonia -----		X	
European Community -----		X	
*Finland -----		X	
* France -----			X
Georgia -----		X	
*Germany-----			X
*Greece -----		X	
*Hungary -----			X
Iceland -----		X	
Iran -----			X
*Ireland-----		X	
*Italy -----			X

MEMBERSHIP (3/5)

* CURRENT EU MEMBER STATES



COUNTRIES

AGREEMENT

PROTOCOL

BOTH

Japan ----- X

Kazakhstan ----- X

Kenya ----- X

Kyrgyzstan ----- X

*Latvia ----- X

Lesotho ----- X

Liberia ----- X

Liechtenstein ----- X

*Lithuania ----- X

*Luxembourg ----- X

Monaco ----- X

Mongolia ----- X

Morocco ----- X

Mozambique ----- X

Namibia ----- X

*Netherlands ----- X

MEMBERSHIP (4/5)

* CURRENT EU MEMBER STATES



COUNTRIES

AGREEMENT

PROTOCOL

BOTH

Norway	-----	X	
*Poland	-----		X
*Portugal	-----		X
Republic of Korea	-----	X	
Republic of Moldova	-----		X
Romania	-----		X
Russian Federation	-----		X
San Marino	-----	X	
Serbia and Montenegro	-----		X
Sierra Leone	-----		X
Singapore	-----	X	
*Slovakia	-----		X
*Slovenia	-----		X
*Spain	-----		X
Sudan	-----	X	

MEMBERSHIP (5/5)

* CURRENT EU MEMBER STATES



<u>COUNTRIES</u>	<u>AGREEMENT</u>	<u>PROTOCOL</u>	<u>BOTH</u>	<u>TOTAL</u>
Swaziland -----			X	
*Sweden -----		X		
Switzerland-----			X	
Surian Arab Rep.-----			X	
Tajikistan -----	X			
The former Yugoslav				
Rep. of Macedonia -----			X	
Turkey -----		X		
Turkmenistan -----		X		
Ukraine -----			X	
*United Kingdom-----		X		
United States of America -----		X		
Uzbekistan -----	X			
Viet nam-----	X			
Zambia -----		X		
TOTAL	11	21	45	77
	AGREEMENT PROTOCOL			
	56			

TOTAL UNDER THE SYSTEM?

MADRID SYSTEM BASIC PRINCIPLES



- REQUIRES A BASIC APPLICATION / REGISTRATION IN THE HOME COUNTRY OF THE APPLICANT FOR:
 - FILING
 - KEEPING IR FOR FIRST 5 YEARS
- THE IR NEVER PROTECTS THE MARK IN THE HOME COUNTRY (THIS IS DONE BY THE BASIC APPLICATION / REGISTRATION)
- IR IS FILED BEFORE TRADE MARK OFFICE OF HOME COUNTRY
- THERE IS AN INTERNATIONAL PUBLICATION AND EVENTUAL REPUBLICATIONS IN DESIGNATED COUNTRIES
- THERE IS A FIXED TERM $\left\{ \begin{array}{c} 12 \\ 18 \end{array} \right\}$ MONTHS FOR REPORTING ON OBJECTIONS / OPPOSITIONS IN ALL COUNTRIES - OTHERWISE: REGISTRATION
- IR EQUIVALENT TO NATIONAL REGISTRATIONS IN DESIGNATED COUNTRIES FOR:
 - PROSECUTION UNTIL REGISTRATION / REJECTION
 - INVALIDATION
 - ENFORCEMENT
- APPLICATIONS FOR $\left\{ \begin{array}{c} \text{RENEWAL} \\ \text{CHANGE OF NAME/ADDRESS} \\ \text{ASSIGNMENT} \end{array} \right\} \rightarrow \text{CENTRALLY TO WIPO}$

(151) 27.05.2003

805 100

(180) 27.05.2013

(732) Cornelis Johannes Jozef Pater
Kruisstraat 11
NL-1671 CM Medemblik (NL).



(Voir original en couleur à la fin de ce volume.)

(531) 1.1; 2.7; 9.7; 25.1; 29.1.

(591) Blanc, noir, jaune, doré, gris, rose, ocre, bleu foncé et bleu clair.

(511) NCL(8)

30 Café, thé, cacao, sucre, riz, tapioca, sagou, succédanés du café; farines et préparations faites de céréales, pain, pâtisserie et confiserie, glaces comestibles; miel, sirop de mélasse; levure, poudre pour faire lever; sel, moutarde; vinaigre, sauces (condiments); assaisonnements liquides (dits "dressings"); épices; glace à rafraîchir.

35 Gestion des affaires commerciales; activités promotionnelles; administration commerciale; travaux de bureau.

(821) BX, 26.02.2003, 1027917.

(822) BX, 26.02.2003, 723190.

(300) BX, 26.02.2003, 723190.

(831) DE, FR.

(580) 17.07.2003

RETURN

DIFERENCES BETWEEN MADRID AGREEMENT AND PROTOCOL



AGREEMENT

PROTOCOL

BASIC APPLICATION

GRANTED

PENDING

COUNTRY DESIGNATION FEE

FLAT FEE

INDIVIDUAL FEE

CENTRAL ATTACK (5 YEARS)

YES

YES BUT CONVERSION

TERM TO OBJECT NATIONALLY

12 MONTHS

18 MONTHS

SAFEGUARD CLAUSE

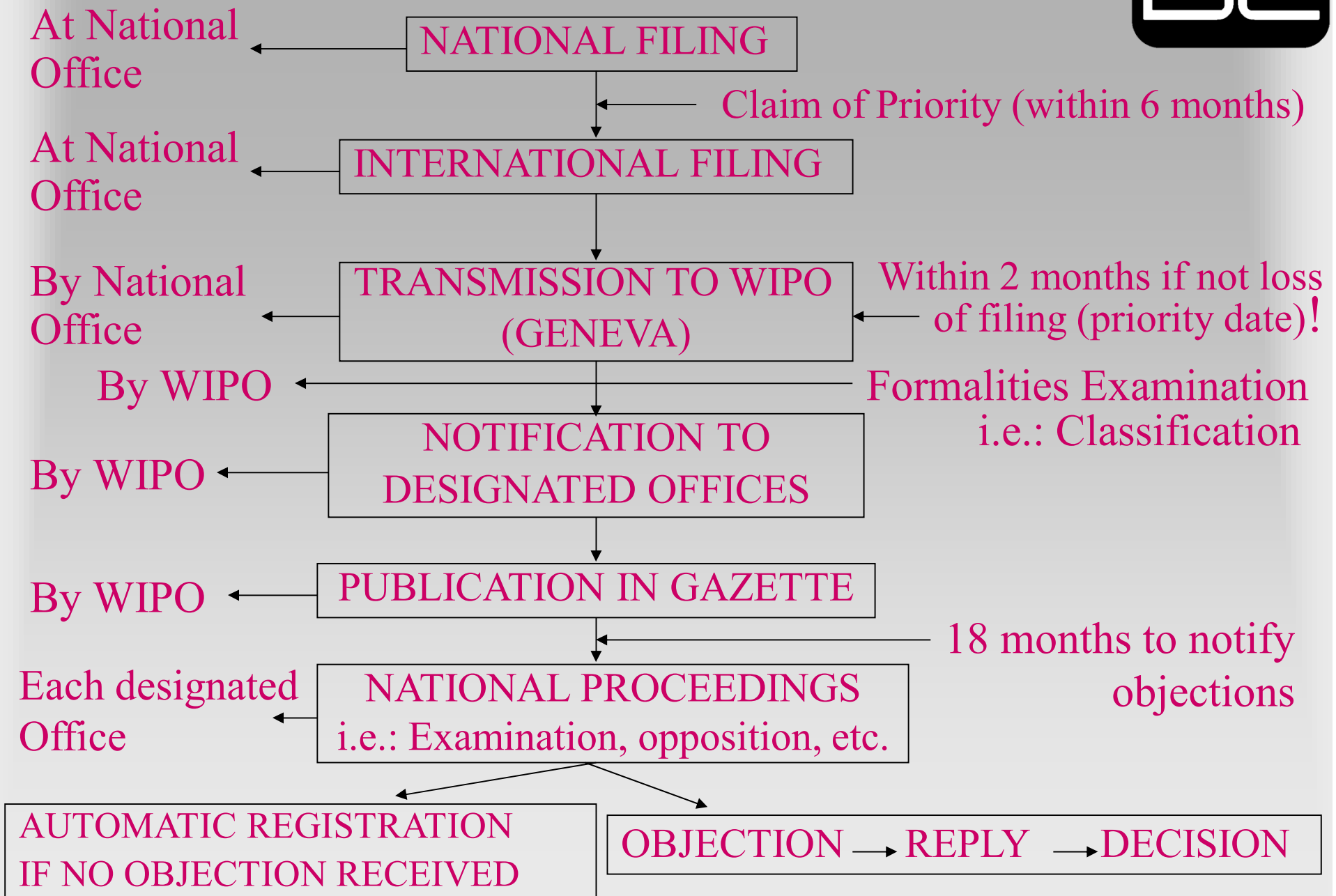
YES

YES

FEES

	<u>SF</u>	<u>US</u>
BASIC FEE (INCLUDING REGISTRATION FEE FOR 10 YEARS) (FOR 3 CLASSES)	653	463
WITH COLOUR	903	641
ADDITIONAL CLASS FEE (PER CLASS)	73	52
DESIGNATION FEE (PER COUNTRY) { Flat	73	52
{ Individual	94/600*	67/426
* JAPAN SPLITS FILING AND REG. { Filing { 1 class	226	161
{ per add. class	171	121
{ Registration (per class)	754	535

MADRID PROTOCOL PROSECUTION



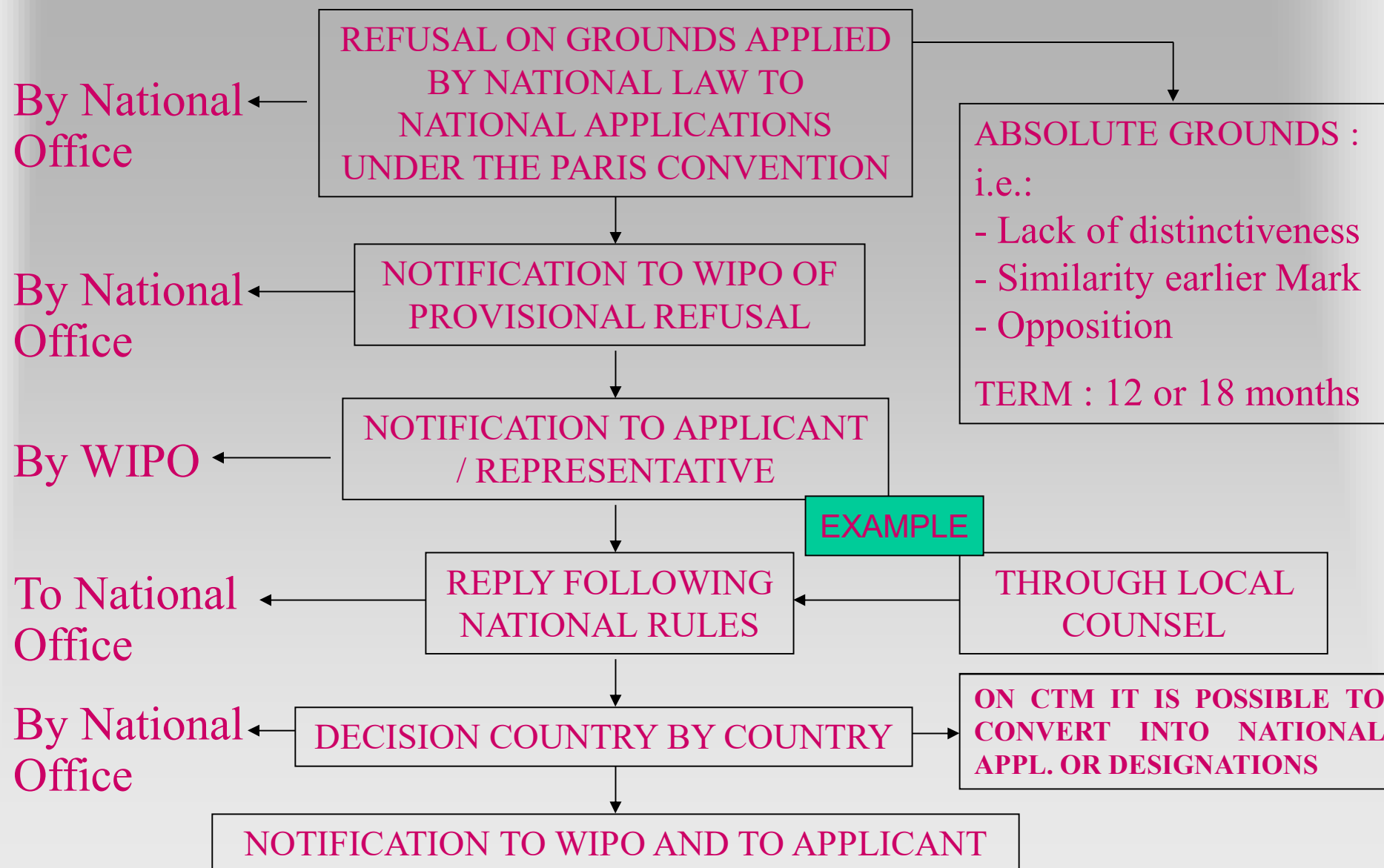
TERRITORIAL EFFECT

- SAME AS A NATIONAL OR REGIONAL APPLICATION / REGISTRATION
- CANNOT EXTEND EFFECTS TO COUNTRY OF ORIGIN (PROTECTED THROUGH BASIC APPLICATION)
- AN INTERNATIONAL REGISTRATION CAN BE EXTENDED AFTER REGISTRATION TO ADDITIONAL COUNTRIES
 - TERRITORIAL EXTENSION:
 - NEW BASIC FEE
 - COUNTRY DESIGNATION FEE
 - PRIORITY → FILING DATE T.E.
 - NEW PROSECUTION FOR NEW COUNTRIES
 - DURATION : WHAT REMAINS FOR ORIGINAL IR
 - RENEWAL TAKES PLACE FOR NEW AND OLD COUNTRIES AT THE SAME TIME

REPLACEMENT OF NATIONAL OR REGIONAL REGISTRATIONS BY IR

- 1) 2 IDENTICAL MARKS
 - NATIONAL / REGIONAL (EARLIER)
 - IR (LATER)
- 2) BOTH SAME APPLICANT
- 3) ALL GOODS / SERVICES OF NATIONAL OR REGIONAL REGISTRATIONS INCLUDED IN IR
- 4) IR REPLACES NATIONAL OR REGIONAL REGISTRATIONS

NATIONAL PROCEEDINGS FOR IR





ORGANISATION MONDIALE
DE LA PROPRIÉTÉ INTELLECTUELLE
34, Chemin des Colombettes, case postale 18, CH-1211 Genève 20 (Suisse)
Compte de chèques postaux OMPI N° 12-5000-8 Genève
N° compte bancaire INT (IBAN) auprès du Crédit Suisse, Genève
CH55 005 1048 7089 8100 0 / Swift Code: CRESCH2212A
Tél. (41-22) 338 9111 Télécopieur : (41-22) 733 5428
E-mail: intreg.mail@wipo.int Internet: http://www.wipo.int



Arrangement de Madrid
et
Protocole de Madrid

Recommandé

Luis-Alfonso DURAN
Córsega, 329 (P° de Gracia/Diagonal)
E-08037 BARCELONA
Espagne

LG

Référence à rappeler : 812/235979301

Genève, le 14/03/2003

Enregistrement international no 789243

Madame,
Monsieur,

Nous vous remettons ci-joint, en application de la règle 17.4) du règlement d'exécution commun à l'Arrangement de Madrid et au protocole relatif à cet Arrangement, la notification d'un refus provisoire/d'un refus provisoire ex-officio de protection concernant l'enregistrement international susmentionné.

Partie contractante dont l'Office
a émis la notification : AU
Date à laquelle la notification
a été expédiée à l'OMPI : 21/02/2003
Date de réception par l'OMPI : 11/03/2003
Date de notification par l'OMPI : 14/03/2003

Bureau international de l'Organisation Mondiale
de la Propriété Intellectuelle (OMPI)

IPA Australia
PATENTS - TRADE MARKS - DESIGNS

21 February, 2003

International Bureau, WIPO
34, chemin des Colombettes
P.O. Box 18
1211 Geneva 20, Switzerland

**NOTIFICATION OF PROVISIONAL REFUSAL OF AN INTERNATIONAL
REGISTRATION DESIGNATING AUSTRALIA (IRDA)**

THIS REFUSAL IS ISSUED IN ACCORDANCE WITH RULE 17(1) TO 17(3)

International Registration No: 789243

Our Reference No: 933204

Applicant: Campomar, S.L.

Trade mark:

Your ref: 223804001

Discovery House, Phillip ACT 2606
PO Box 200, Woden ACT 2606
Australia
Phone +61 2 6283 2999
Facsimile +61 2 6283 7999
Internet http://www.ipaaustralia.gov.au
ABN 38 113 072 755



Examiner: Nathan SINCLAIR

Report No. 1

The above trade mark has been examined and the following attachments explain the matters which at present prevent the International Registration from being accepted and, where possible, the ways in which the holder may be able to resolve the issues. The holder has until 21 May 2004 (15 months) in which to do so. This refusal takes effect after that date.

The holder may respond in writing to this refusal, however, any response must be sent through an address for service in Australia.

Review

This provisional refusal will be reviewed if the holder:

- makes written submissions in support of the claim to protection of the trade mark in Australia; and/or
- submits evidence in support of the claim to protection of the trade mark in Australia, and/or
- applies for a hearing.

1. TRADE MARKS NOT CAPABLE OF DISTINGUISHING - SECTION 41

Grounds for rejecting this International Registration Designating Australia (IRDA) exist under sub section 41(5) of the Trade Marks Act.

To be protected in Australia, your trade mark must be capable of distinguishing your goods/services from the similar goods/services of other traders in the market place.

You have applied to register a shape trade mark consisting of an elongated cylindrical receptacle with a rounded stopper for goods in Class 3. Your IRDA is refused as the trade mark is not capable of distinguishing the specified goods because the perfume and cosmetic industry typically employ a wide variety of different shapes, sizes and colours to the receptacle of these goods. Having considered your mark as a whole, it lacks the requisite capacity to distinguish your goods from those of other traders. Other traders are likely to need to use similar cylindrical shaped containers to indicate their similar goods and/or services.

The refusal applies to

All goods claimed in Class 3

You may respond to this refusal by:

- Making written submissions and/or
- Providing evidence of use showing that the trade mark is capable of distinguishing the goods/services in Australia, and
- Requesting a hearing in this matter.

If you wish to respond in any of the above ways, you **must** do so in writing and supply an address for service in Australia.

I have attached an information sheet that indicates the type of evidence needed.

Before deciding whether to provide evidence you should consider the following:

- Evidence is usually in the form of a statutory declaration giving a history and indication of the extent of the use of your trade mark
- gathering and compilation of this material may be time-consuming and expensive
- the evidence you provide may still be insufficient to overcome the objection

for
REGISTRAR OF TRADE MARKS

Examiner's Telephone Contact: + 61 2 6283 7910

RETURN

DURATION

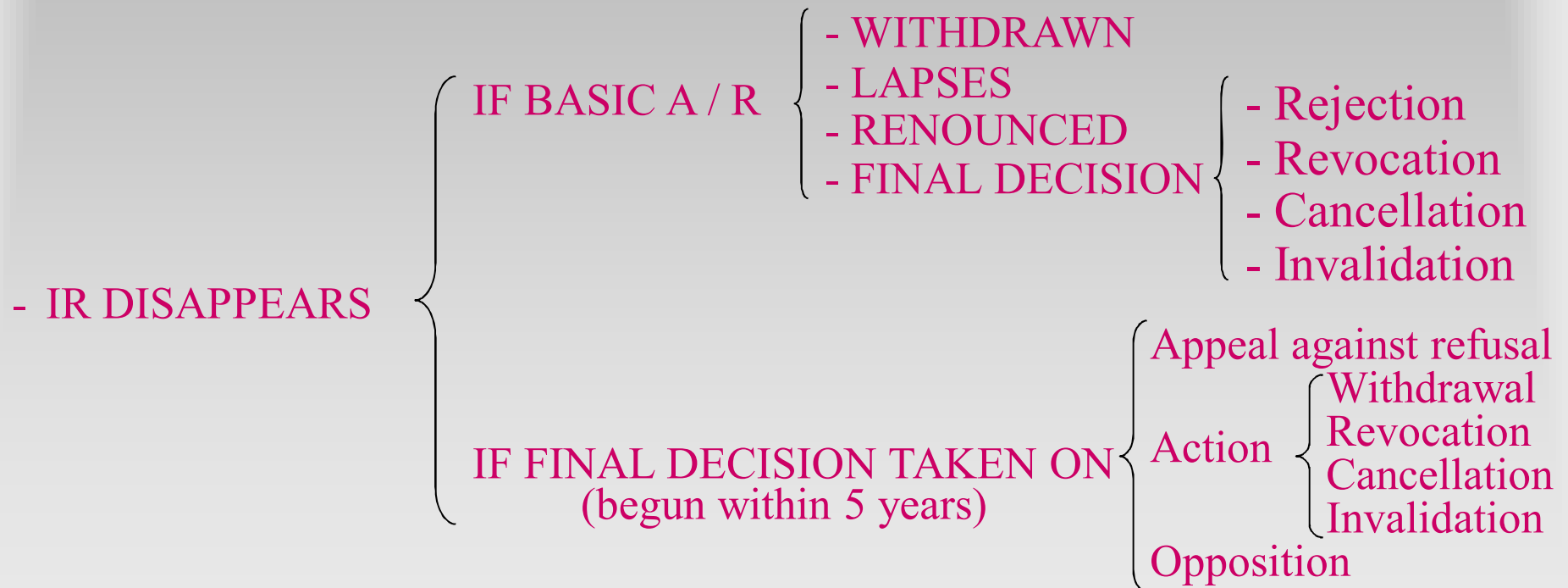


- 10 YEARS FROM FILING

- RENEWALS FOR TEN YEARS PERIOD { 6 months before due date
6 months after (with fine)

DEPENDENCE OF BASIC APPLICATION OR REGISTRATION

- 5 YEARS FROM FILING DATE



- CONVERSION CAN BE FILED IN EACH DESIGNATED STATE WITHIN 3 MONTHS

ASSIGNMENTS, CHANGES OF NAME

- MADE THROUGH A SINGLE REQUEST

LANGUAGES

- AGREEMENT : FRENCH

- PROTOCOL : FRENCH / ENGLISH/SPANISH

PAYMENT OF FEES

DEBITED TO CURRENT ACCOUNT

POSTAL CHEQUE

BANK ACCOUNT

BANK CHEQUE

CASH

COUNTRIES THAT REPUBLISH IR APPLICATIONS



AUSTRALIA

CUBA

DENMARK

ESTONIA

FINLAND

GEORGIA

GREECE

IRELAND

ICELAND

JAPAN

MOZAMBIQUE

NORWAY

POLAND

PORTUGAL

REP. OF KOREA

SERBIA AND

MONTENEGRO

SINGAPUR

SWEDEN

TURKEY

EXAMPLES

**THE OTHER COUNTRIES RELY ON
THE PUBLICATION MADE BY
WIPO**

GREECE



ΔΗΛΩΣΗ ΔΙΕΘΝΟΥΣ ΣΗΜΑΤΟΣ

Αριθ. Διεθνούς Σήματος 625432. Ημερομηνία 3.7.2001.
GAZETTE OMPI No 18/2001

Αριθμός Σήματος 3955

(απεικ) ΔΙΚΑΙΟΥΧΟΣ: «HERMANN BASLER HAAR - KOSMETIK VERSANDHAUS - PRODUKTION», που εδρεύει εις 20, GANSACKER, D-74317 BIETIGHEIM-BISSINGEN, GERMANY. ΠΡΟΪΟΝΤΑ ΠΡΟΣ ΔΙΑΚΡΙΣΗ: Παρασκευάσματα για τον χρωματισμό των μαλλιών, σαμπουάν, λουσόν για το τριχωτό της κεφαλής, παρασκευάσματα για το τριχωτό της κεφαλής, κυρίως λακ για τα μαλλιά, θεραπευτικά παρασκευάσματα για το τριχωτό της κεφαλής, προϊόντα για τα μαλλιά σε μορφή αερολύματος, παρασκευάσματα για περιμανάντ, προϊόντα λεύκανσης και στερέωσης, Σάπωνες, είδη αρωματοποίησης, προϊόντα για την φροντίδα του σώματος και καλλυντικά. Χτένες, σπόνγες και ψήκτρες (εξαιρέσεις των πινέλων), θήκες, τσάντες και βαλιτσάκια για τα ανωτέρω προϊόντα. Τσιμπιδάκια μαλλιών (χτενάκια), φουρκέτες, θήκες, τσάντες και βαλιτσάκια για τα ανωτέρω προϊόντα. Μπικουτί για περιμανάντ. Διακοσμητικές κορδέλες για τα μαλλιά, καθώς και θήκες, τσάντες και βαλιτσάκια για τα ανωτέρω. ΚΛΑΣΕΙΣ ΠΡΟΪΟΝΤΩΝ: 3, 21, 26. Έγινε δεκτό εν μέρει με την υπ' αριθμ. 402/03 απόφαση ΔΕΣ.

(190) 【発行国】日本国特許庁 (JP)
(441) 【公開日】平成12年12月14日 (2000. 12. 14)
【公報種別】公開国際商標公報
(210) 【国際登録番号】740791
(220) 【国際登録日又は事後指定日】平成12年8月1日 (2000. 8. 1)
(540) 【商標】
MASSIMO DUTTI SOFT

【標準文字】
(511) 【商品及び役務の区分並びに指定商品又は指定役務】
3 Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery goods, essential oils, cosmetics, hair lotions; dentifrices.
18 Leather and leather imitations, products in these materials not included in other classes; animal hides; trunks and suitcases; umbrellas, parasols and walking sticks; whips and saddlery.
24 Fabrics and textile products not included in other classes; blankets and tablecloths.
25 Clothes, shoes, millinery.
35 Advertising services; management of commercial business; commercial administration; office tasks; retailing services for businesses.
(511) 【商品及び役務の区分並びに指定商品又は指定役務の訳 (参考)】
第3類 洗濯用漂白剤及びその他の物質、清浄剤、つや出し剤、磨り磨き剤及び研磨剤、せっけん、香料製品、精油、化粧品、ヘアローション、歯磨き
第18類 革及び皮革、他の類に含まれない前記材料の製品、獣皮、トランク及びスーツケース、傘、日傘及びつえ、むち及び馬具
第24類 布地及び織物製品であって他の類に属しないもの、毛布及びテーブルクロス
第25類 被服及び運動用特殊衣服、靴及び運動用特殊靴、婦人用帽子類
第35類 広告サービス、営利事業に関する管理、商業に関する管理、事務処理、事業用の小売りサービス
(821) 【基礎出願】
【出願番号】2. 335. 376
【出願日】平成12年7月26日 (2000. 7. 26)

AUSTRALIA



(210) 949960 (IR 798666)
(220) 4 FEBRUARY 2003
(730) Reinhold Muller of Pischeldorfer Strasse 57 A-9020 Klagenfurt AUSTRIA (AT)
(750) International Bureau, WIPO 34, chemin des Colombettes P.O. Box 18 1211 Geneva 20, Switzerland
(511)(510)

Cl. 3 Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices

Cl. 29 Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats

Cl. 30 Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice

(500) Trade Mark Description: Colour Claimed: WHITE, BLUE, RED, YELLOW, GOLD.

(540)



ESTONIA

(111) Rahvusvah reg nr 2R233658
(210) Rahvusvah reg jrk R200201376
(151) Rahvusvah reg kuup 15.07.2000
(861) Hileisma märkimise kuup 22.01.2002

(540)

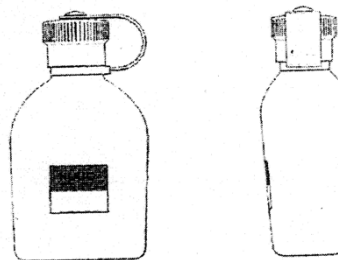


(730) Omanik: S'FILNOVO OROLOGERIA SRL
Via Fermi, 1, VOGHERA (PAVIA) I-27058, IT
(511)⁹ Klass: 14
WIPO Rahvusvah Märkide Dileetääni nr,
kus registreering on avaldatud: 2002/13

FINLAND

(111) 696278
(151) 19.06.1998
(320) 07.05.1998
(330) DE
(310) 398 25 552

(540)



(730) EUROCOS COSMETIC GMBH, Frankfurt am Main, Frankfurt am Main, DE
(554) Ulkoasuarekisteröinti - Märket avser utstyrsel.
(591) Merkin värit ovat punainen ja musta. - Märket är utfört i färgerna rött och svart.
(511) 3

(111) Reg. nr.: MP472944

(800) Design. dato: 2002-10-14



(730) Innehaver: Victorinox AG, Schmiedgasse 57, CH-6438 Ibach, Schweiz
(740/750) International fuidmægtig: Isler & Pedrazzini AG, Postfach 6940, CH-8023 Zürich, Schweiz
(511) Klasse 08: Cutlery items, particularly stainless steel cutting tools of all kinds, of Swiss origin.
(800) International registreringsdato: 1982-10-12
Gazette No.: 22/2002

DENMARK

RETURN

COUNTRIES WITH EXAMINATION ON ABSOLUTE GROUNDS



**ALL COUNTRIES
EXCEPT
LIECHTENSTEIN**

COUNTRIES WITH EXAMINATION ON RELATIVE GROUNDS



ARMENIA
AUSTRALIA
BAHRAIN
BELARUS
BULGARIA
CHINA
CUBA
ESTONIA
FORMER YUGOSLAV REP.
OF MACEDONIA
RUSSIAN FEDERATION
FINLAND
GEORGIA
GREECE
HUNGARY
IRELAND
ICELAND
JAPAN

MOZAMBIQUE
NAMIBIA
NORWAY
POLAND
PORTUGAL
REPUBLIC OF KOREA
MOLDAVIA
POPULAR REP. OF KOREA
CZECH REPUBLIC
ROMANIA
UK
SERBIA AND MONTENEGRO
SINGAPUR
SLOVAK REPUBLIC
SWEEDEN
SYRIA
TURKMENISTAN
UKRAINE

COUNTRIES WHERE IT IS POSSIBLE TO FILE OPPOSITION



<u>COUNTRY</u>	<u>TERM</u>	<u>STARTING FROM</u>
AUSTRALIA	3 MONTHS	OWN PUBLICATION
BAHRAIN	60 DAYS	OWN PUBLICATION
BENELUX	2 MONTHS	WIPO GAZZETTE (TO BE IMPLEMENTED)
CHINA	3 MONTHS	WIPO GAZZETTE
CUBA	60 DAYS	WIPO GAZZETTE
DENMARK	2 MONTHS	OWN PUBLICATION
ESTONIA	2 MONTHS	OWN PUBLICATION
European Union	3 MONTHS	OWN PUBLICATION
FINLAND	2 MONTHS	OWN PUBLICATION
FRANCE	FIRST DAY	FOLLOWING MONTH TO WIPO PUBLICATION
GEORGIA	3 MONTHS	OWN PUBLICATION
GERMANY	3 MONTHS	WIPO GAZZETTTE
GREECE	4 MONTHS	15th OF MONTH FOLLOWING PUBLICATION
IRELAND	3 MONTHS	OWN PUBLICATION
IRAN	30 DAYS	OWN PUBLICATION
ISLAND	2 MONTHS	OWN PUBLICATION
ITALY	3 MONTHS	IDEM FR. (YET TO BE IMPLEMENTED)
JAPAN	2 MONTHS	OWN PUBLICATION
LATVIA	4 MONTHS	WIPO GAZZETTE
MONGOLIA	18 MONTHS	FILING DATE
MOZAMBIQUE	60 DAYS	OWN PUBLICATION

COUNTRIES WHERE IT IS POSSIBLE TO FILE OPPOSITION



<u>COUNTRY</u>	<u>TERM</u>	<u>STARTING FROM</u>
NAMIBIA	2 MONTHS	OWN PUBLICATION
NORWAY	2 MONTHS	OWN PUBLICATION
POLAND	6 MONTHS	OWN PUBLICATION
PORTUGAL	2 MONTHS	OWN PUBLICATION
REP. OF KOREA	1 MONTHS	OWN PUBLICATION
MOLDAVIA	12 MONTHS	WIPO GAZZETTE
POPULAR REP. OF KOREA (NORTH KOREA)	12 MONTHS	FILING DATE
CZECH REP.	3 MONTHS	WIPO GAZZETTE
ROMANIA	3 MONTHS	WIPO GAZZETTE
UK	3 MONTHS	OWN PUBLICATION
SINGAPUR	2 MONTHS	OWN PUBLICATION
SLOVAK REP.	3 MONTHS	IDEM FR.
SLOVENIA	3 MONTHS	WIPO GAZZETTE
SPAIN	2 MONTHS	PUBLICATION NOTICE IN SPANISH GAZZETTE
SWEDEN	2 MONTHS	OWN PUBLICATION
SWITZERLAND	FIRST DAY OF THE MONTH FOLLOWING WIPO GAZZETTE	
TURKEY	3 MONTHS	OWN PUBLICATION

FILING SYSTEMS IN THE EUROPEAN UNION

1) NATIONAL APPLICATIONS

2) CTM APPLICATIONS*



since
April 1,
1996

3) MADRID

AGREEMENT
&
PROTOCOL⁽⁺⁾



⁽⁺⁾since
April 1,
1996

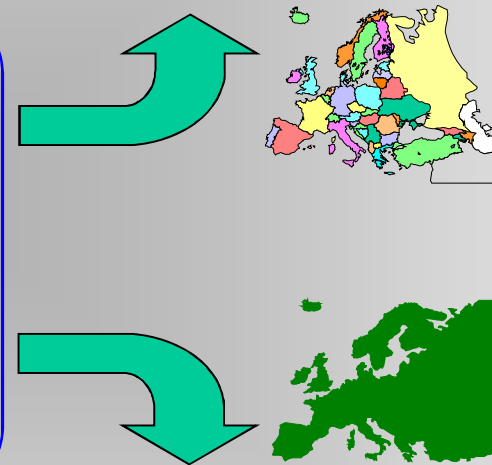
* Can be designed under the Madrid Protocol



A O
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•NATIONAL (*) :
1 PER COUNTRY :



•CTM SYSTEM :
1 PER 15+10=25
COUNTRIES :
UNITARY RIGHT

- FILING
- PROSECUTION
- REGISTRATION
- RENEWAL
- REVOCATION/CANCELLATION
- ENFORCEMENT

(*) Also International Madrid Agreement & Protocol except filing and renewal that is made by a single application.

ADVANTAGES /DISADVANTAGES OF NATIONAL, MADRID PROTOCOL AND CTM SYSTEMS (1/3)



I NATIONAL SYSTEMS	II MADRID PROTOCOL	III CTM
- RESTRICTS INVALIDITY / OPPOSITION TO A COUNTRY PER COUNTRY BASIS	- SAME AS (I)	- EXPANDS RISKS OF INVALIDITY/OPPOSITION TO ANY OF MEMBER STATES (MORE VULNERABLE)
- INDEPENDENT OF HOME REG.	- DEPENDENCY OF BASIC APPLICATION FOR 5 YEARS	-SAME AS (I). (IF NOT FILED THROUGH MADRID)
-IN EXAMINATION COUNTRIES MORE LEGAL CERTENTY	-SAME AS (I)	- NO EXAMINATION ON EARLIER RIGHTS (LESS LEGAL CERTENTY THAN IN EXAMINATION COUNTRIES)

ADVANTAGES /DISADVANTAGES OF NATIONAL, MADRID PROTOCOL AND CTM SYSTEMS (2/3)



I NATIONAL SYSTEMS	II MADRID PROTOCOL	III CTM
- PROFESSIONAL FEES OF LOCAL ATTORNEYS	- SAVING OF PROF. FEES OF LOCAL REPR. AT FILING/RENEWAL/ASSIG. (SAVE OF COSTS)	- ONLY PROF. FEES OF EUROPEAN ATTORNEY AT FILING/REN./ASS. (SAVE OF COSTS) SPLIT OF COSTS : FILING REGISTRATION
- SEE (II)	- NO SENIORITY UNLES CTM DESIGNATED	- SENIORITY PERMITS TO CONSOLIDATE EARLIER RIGHTS (SAVE OF COSTS AND MANAGMENT)
-REQUIRES NEW FILING TO COVER NEW EU COUNTRIES	-REQUIRES TERRITORIAL EXTENSION TO COVER NEW EU COUNTRIES, EXCEPT IF CTM IS DESIGNATED	- AUTOMATIC ENLARGEMENT OF PROTECTION TO NEW EU COUNTRIES

ADVANTAGES /DISADVANTAGES OF NATIONAL, MADRID PROTOCOL AND CTM SYSTEMS (3/3)



I NATIONAL SYSTEMS	II MADRID PROTOCOL	III CTM
-CAN BE ASSIGNED WITHOUT RESTRICTIONS OF NATIONALITY OF ASSIGNEE	- CANNOT BE ASSIGNED TO NON MADRID MEMBERS (NATIONAL OR WITH ESTABLISHMENT)	- CANNOT BE ASSIGNED FOR A PART OF EU MEMBER STATES (UNITARY RIGHT)
- ENFORCEMENT COUNTRY PER COUNTRY	-SAME AS I	-EU-WIDE INJUNCTION

NEW ROLE OF LOCAL COUNSEL UNDER THE PROTOCOL



- ADVISE ON SEARCHING BEFORE FILING.
 - ADVISE AND REPLY ON OFFICIAL ACTIONS/OPPOSITIONS, LETTERS OF CONSENT, SETTLEMENTS, ETC.
 - WATCHING AND FILING OPPOSITION TO NEW
(INCREASINGLY IMPORTANT DUE TO
HIGH NUMBER OF APPLICATIONS AND LOW FILING COSTS).
- { NATIONAL
MADRID
CTM } APPLS.
- ADVISING AND PROSECUTING IN ONFRINGEMENTS.
 - ADVISING IN LICENSING, ASSIGMENTS, ETC.

COMPARISON OF PROCEDURAL STEPS



<u>Process</u>	<u>National</u>	<u>Language</u>	<u>Madrid Protocol</u>	<u>Language</u>
Filing	National Office	Of country	WIPO	EN/FR/SP
Formal Examination	National Office	Of country	WIPO	EN/FR/SP
Publication	National Office	Of country	WIPO (optional republication by national office)	EN/FR/SP
Substantive Opposition	National Office	Of country	National Office	Of Country
Optional Opposition	National Office	Of country	National Office	Of Country
Time Limit (for objections)	NO	Of country	12/18 Months	-----
Time Limit (for deciding)	NO	Of country	No	-----
Decision	National Office	Of country	National Office	EN/FR/SP
Renewals	National Office	Of country	WIPO	EN/FR/SP

EFFECTS OF MADRID PROTOCOL

- FOR NATIONALS OF A DESIGNATED COUNTRY (I)**
- FOR OTHER MEMBERS OF THE PROTOCOL (II)**
- FOR NATIONAL OFFICES (III)**
- FOR THE TRADEMARK SYSTEM AS A WHOLE (IV)**

FOR NATIONALS OF A DESIGNATED COUNTRY (I)



- ADVANTAGES FOR APPLICANTS OF THE COUNTRY EXTENDING MARK ABROAD

- MORE REGISTERED MARKS

→	MORE COMPLEXITY OF SEARCHES
→	MORE DIFFICULT TO ADOPT AND REGISTER NEW MARKS
→	INCREASES WATCHING AND OPPOSITION COSTS

- EVENTUAL DELAYS IN PROSECUTION OF DOMESTIC APPLICATIONS IF TM OFFICE IS UNABLE TO HANDLE IN TIME ALL CASES (MADRID PROTOCOL HAS PRIORITY DUE TO TIME LIMITS)

- IF NATIONAL OFFICE DOES NOT REPUBLISH OR TRANSLATE GOODS / SERVICES	→	THEY ARE NOT TRANSLATED INTO
LOCAL LANGUAGE	→	LACK OF LEGAL CERTENTY

FOR OTHER MEMBERS OF THE **PROTOCOL (II)**



- **EASIER TO PROTECT IN FOREIGN MARKETS**
- **TENDENCY TO OVERPROTECT, JUST IN CASE**
- **PROTECTION APPLIED IN MANY COUNTRIES FOR COST REASONS**
- **ABANDON WHEN AN OBJECTION IS RAISED TO AVOID COSTS**

FOR NATIONAL OFFICES (III)

- MORE PROSECUTION WORK, WITH TIME LIMITS →
- NEED TO APPLY MORE RESOURCES
- WHEN ONLY PART OF MADRID APPLICATIONS
OBJECTED REPLIED → MISUSE OF OFFICE RESOURCES
- MORE REGISTRATIONS
 - INCREASE IN NUMBER OF
OBJECTIONS IN NEW APPLICATION
 - COMPLEXITY OF EXAMINATION

FOR THE TRADEMARK SYSTEM AS A WHOLE (IV)



- FACILITATES INTERNATIONAL PROTECTION AT LOW COST
- PROMOTES OVERPROTECTION
 - ON SCOPE
 - ON GEOGRAPHIC COVERAGE
- OVERCROWDS REGISTERS OF MARKS
- MANY REGISTRATIONS ARE MADE WITHOUT A REAL INTENTION TO BE USED
- COMPLICATES
 - SEARCHING
 - EXAMINATION
 - ADOPTION OF NEW MARKS
 - WATCHING / OPPOSITIONS
- NEED FOR A BALANCE

IMPACT OF MADRID PROTOCOL



- THE MADRID PROTOCOL ONLY CAN BE USED TO FILE TM's ABROAD →
→ NO BENEFITS FOR APPLICANTS THAT ONLY USE MARKS IN DOMESTIC MARKET
- MAKES CHEAPER TO FILE AND RENEW TM's ABROAD FOR THOSE WHO NEED TO DO SO
- BECAUSE IT IS CHEAPER TO EXTEND MARKS IN FOREIGN MARKS MANY FOREIGN APPLICANTS PROTECT MARKS IN OTHER COUNTRIES THAT OTHERWISE WOULD NOT BE PROTECTED EVEN IF THEY DO NOT ACTUALLY NEED IT
- DUE TO LOW COST DESIGNATIONS COVER BROAD LISTS OF GOODS / SERVICES AND MANY CLASSES
- WHEN THESE DESIGNATIONS ARE OBJECTED, PARTICULARLY, OUTSIDE THE MAJOR MARKETS, OFTEN THEY ARE NOT REPLIED
- THE MADRID PROTOCOL AS AN EFFECT TO INCREASE THE NUMBER OF MARKS PROTECTED IN A PARTICULAR COUNTRY