MADRID SYSTEM FOR
THE
INTERNATIONAL REGISTRATION OF MARKS

ASST. PROF. EISHA VASHISHTHA
DEPARTMENT OF LAW
SAVITRIBAI PHUE PUNE UNIVERSITY
Introduction

- Registration of trademarks in multiple jurisdictions around the world is governed by two independent treaties:
  
  1. The Madrid Agreement (the Agreement) &

- Together they are called as the Madrid system.

- It is the primary international system for facilitating the registration of trademarks in multiple jurisdictions around the world.

- Madrid now permits the filing, registration and maintenance of trade mark rights in more than one jurisdiction, provided that the target jurisdiction is a party to the system.

- The Madrid system is administered by the International Bureau of the World Intellectual Property Organization (WIPO) in Geneva, Switzerland.

- Madrid Union currently has 100 members, including both States and intergovernmental organizations that are Contracting Parties to the Madrid Protocol, covering the territories of 116 countries.
The Madrid Agreement, concluded in 1891 and revised at Brussels (1900), Washington (1911), The Hague (1925), London (1934), Nice (1957) and Stockholm (1967), and amended in 1979. The Protocol relating to that Agreement, concluded in 1989. States and organizations party to the Madrid system are collectively referred to as Contracting Parties.
OBJECTIVES

▪ It facilitates the obtaining of protection for marks (trademarks and service marks)

▪ Since an international registration is equivalent to a bundle of national registrations, the subsequent management of that protection is made much easier.

▪ In case of transfer of registration for only some of the designated Contracting Parties, or for only some of the goods or services, or to limit the list of goods and services with respect to only some of the designated Contracting Parties, the Madrid System is flexible enough to accommodate it.
INTERNATIONAL APPLICATION

- May be filed only by natural persons or legal entities within a country which is party to the Agreement or the Protocol.
- The Madrid system of international registration cannot be used to protect a trademark outside the Madrid Union.
- An international registration can only be filed for a mark that has already been registered (or, where the international application is governed exclusively by the Protocol, if registration has been applied for) in the Office of origin. An international application must designate one or more Contracting Parties in which the mark is to be protected.
- International applications can be filed in English, French or Spanish, irrespective of which treaty or treaties govern the application.
There are three kinds of international application:

1. An international application governed exclusively by the Agreement; this means that all the designations are made under the Agreement.

2. An international application governed exclusively by the Protocol; this means that all the designations are made under the Protocol.

3. An international application governed by both the Agreement and the Protocol; this means that some of the designations are made under the Agreement and some under the Protocol.
An international application must be presented to the WIPO International Bureau through the Office of origin and must contain at least:

1. A reproduction of the mark (which must be identical with that in the basic registration or basic application)

2. A list of the goods and services for which protection is sought, classified in accordance with the International Classification of Goods and Services (Nice Classification).
FEE PAYABLE

• A basic fee.

• A complementary fee in respect of each designated Contracting Party for which no individual fee is payable.

• Supplementary fee in respect of each class of goods and services beyond the third; no supplementary fee is payable however where all the designations are ones in respect of which an individual Fee has to be paid.
STATEMENT OF GRANT/REFUSAL

- The office of each designated Contracting Party shall issue a statement of grant of protection under Rule 18ter of the Regulations.
- Contracting Parties examine the international registration for compliance with their domestic legislation.
- If some substantive provisions are not complied with, they have the right to refuse protection in their territory.
- Refusal must be communicated to International Bureau within 12 months from the date of notification.
- Refusal is communicated to the holder of the registration or the holder's representative before the International Bureau.
- The procedure subsequent to a refusal is carried out directly by the competent administration and/or court of the Contracting Party concerned and the holder.
INTERNATIONAL REGISTRATION

- International Bureau receives an international application, it carries out an examination for compliance with the requirements of the Protocol and its Regulations.

- This examination is restricted to formalities, including the classification and comprehensibility of the list of goods and/or services.

- If there are no irregularities in the application, the International Bureau records the mark in the International Register, publishes the international registration in the WIPO Gazette of International Marks.
DATE OF REGISTRATION

- If a refusal originally notified by a Contracting Party is subsequently withdrawn, the protection of the mark is, from the date of the international registration, the same as if it had been registered by the office of that Contracting Party.
DURATION OF PROTECTION

- International registration is effective for 10 years and may be renewed for subsequent 10 year periods upon payment of the required fees.
BENEFITS OF MADRID SYSTEM

- Convenient
- Global
- Cost effective
- Simple process/procedure
- Time effective.
LOOPHOLES WITH THE MADRID SYSTEM

- The lack of international acceptance. Many non-member countries, including the United Kingdom, the United States, and Central American, South American and Asian countries, such as Japan, were not adherents, which undermined recognition of the system as a truly "international" regime. Significantly, many of these countries represent the largest numbers of trademark filings and registrations in the world.

- The mere forwarding by the International Bureau of a uniform application to member countries, rather than the registration of the applicable trademark in the national trademark registers, precludes an actual "registration" system.
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