
The View From The Tower: Navigating the Madrid Protocol

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**REVOLUTIONIZE YOUR
THINKING ABOUT
DOCKETING!**

Calendaring Our Future Together.™





The View From The Tower





An Aerial Overview

What is the Madrid Protocol?

- The Protocol Relating to the Madrid Agreement Concerning the International Registration of Trademarks
- A set of rules and procedures governing a system
- The What? Why? How? and Who?



The “What?”

The Madrid System

- The Madrid Agreement, concluded in 1891
- The Protocol relating to that Agreement, concluded in 1989
- Together the treaties comprise the **Madrid System**
- A filing treaty



The “Why?”

The Madrid System – Why is it useful?

- The Madrid System for the International Registration of Marks “makes it possible to protect a mark in a large number of countries by obtaining an international registration that has effect in each of the designated Contracting Parties.” (WIPO)



The “How?”

The Madrid System – How is it useful?

- “It provides a cost-effective and efficient way for trademark holders – individuals and businesses – to ensure protection for their marks in multiple countries through the **filing of one application with a single office, in one language, with one set of fees, in one currency.**” (USPTO)



The “Who?”

The Madrid System – Who does all of this?

- “The International Bureau administers the Madrid System and coordinates the transmittal of requests for protection, renewals and other relevant documentation to all members.” (USPTO)



Docketing's Unique Perspective



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Pre-Flight

How can we best serve our teams?

- Visibility
- Understanding the structure and timeline
- Recognizing common points of failure
- Be assertive – this is one area where docketing's experience may supersede that of the teams we serve



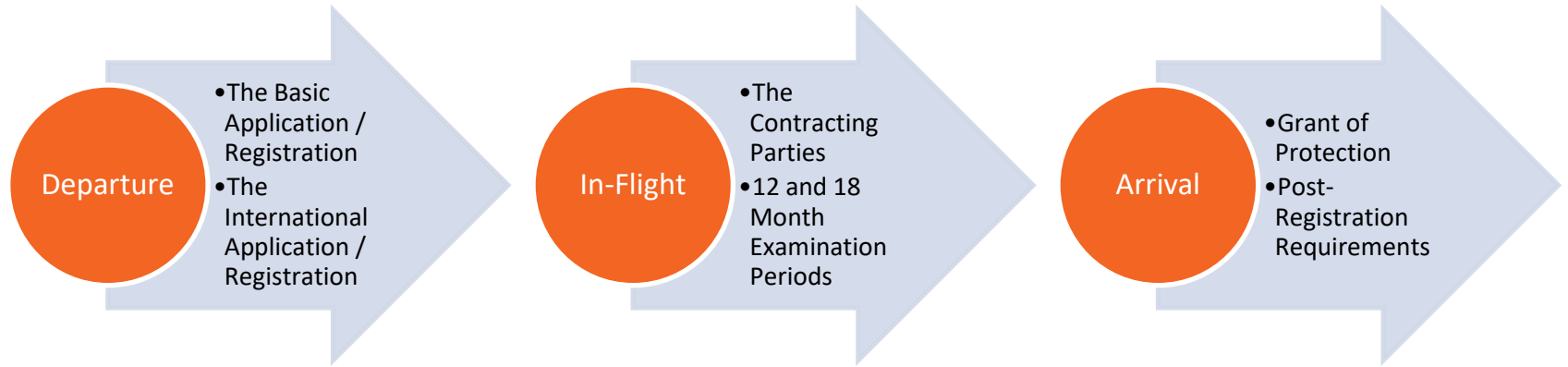
The Flight Plan

Understanding The Structure

- Basic Application / Registration
- International Application / Registration
- Contracting Parties
- Examination Periods
- Grant of Protection
- Post-Registration Requirements



The Flight Plan





Departure





Departure

The Basic Application / Registration

- An existing application or registration (or more) corresponding to the office of origin (e.g., US, GB, CN, etc.)
- Convention priority is possible but not necessary
- May have a combination of priority and non-priority
- Docketing may vary, but in general, we are looking for the oldest matter or the one carrying the earliest priority date



Departure

The International Application – Filing

- Priority claims
- Goods and services – any limitations?
- Designated countries – Spanish v. Spain
- Did we mean to file in North Korea (KR v. KP)?
- Approval of Certification



Departure

The International Application – Formal Examination

- Notices of Irregularity
- Do we have an advanced deadline calendared to respond to our Office of Origin (USPTO)?
- The response goes to the USPTO, but the fees are paid to the IB
- What to do when the team doesn't listen



Departure

The International Registration

- Filing date and registration date will be the same
- Renewal deadline – ten years from filing / registration date
- Confirm accuracy of goods and services
- Dependency period
- Notification Date



In-Flight





In-Flight

Contracting Parties – The Examination Period

- Notification date sets the 12 and 18-month examination periods (“time limit to notify the refusal”)
- Interim Status (e.g., AU, EM, SG, etc.)



In-Flight

Contracting Parties – Substantive Examination

- Provisional Refusals
- All should be treated as urgent, as many have short deadlines (e.g., CN, IN, etc.)
- Partial or total?
- Importance of reading the documents – “base date” for response deadlines varies widely, and country law may change without notice



Arrival





Arrival

Contracting Parties – Grant of Protection

- 18ter(1) or (2)
- 18ter(1) List
- 18ter(1) List late
- Rule 5 Countries – “The refusal period has expired and no notification of provisional refusal has been recorded (application of Rule 5 preserved)”



Arrival

Contracting Parties – Post-Registration Requirements

- The (local) registration date, and its importance
- Confirm accuracy of goods and services
- Fees due? (e.g., CU, BR and JP)
- Post-registration declarations in KH, MX and PH



Helpful Nomenclature

Rule 18bis Documents

- Rule 18bis(1)(a) = Publication
- Rule 18bis(1)(b) = Publication after a refusal (confirm accuracy of goods and services)



Helpful Nomenclature

Rule 18ter Documents

- Rule 18ter(1) = Grant of Protection
- Rule 18ter(2) = Grant of Protection after a refusal (confirm accuracy of goods and services)
- Rule 18ter(3) = Notice of Abandonment (deadline to appeal?)
- Rule 18ter(4) = Notice of Further Decision (e.g., after a CNIPA Review in CN that results in a Grant of Protection)



Additional and Advanced Topics

Further Filings and Other Matters

- Subsequent designations
- Transformation applications after a Ceasing of Effect
- Assignments and “A” number registrations
- Intakes / transfers



Resources

Helpful Links

- The Madrid Monitor

www3.wipo.int/madrid/monitor/en/

- Madrid Monitor Member Profiles

www.wipo.int/madrid/memberprofiles/selectmember

- Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol (Publication Year: 2022)

<https://www.wipo.int/publications/en/series/>



Resources

Helpful Links

- USPTO

www.uspto.gov/trademarks/laws/madrid-protocol

- Local agents for current country law

Thank you!