



Hey, I've Got a Great Idea !

What About Introducing  
Compulsory Grants of Protection  
into the  
Madrid System ?

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July, 2011

# Agenda

- Who could possibly be against it - it's like motherhood !
- The things we forgot to think about
- The IB's current operational challenges
- The things that we have to live with
- Things might go better next time if .....

# Who could possibly be against it ?

- Surely this must be a good thing
- Applicants get certificates in National procedures don't they ?
- It's an increased level of service to the client right ?
- Doesn't it add certainty for the Holder whereas with tacit acceptance there is always some doubt ?

# The things we forgot to think about

- Whilst there was some recognition of some procedural issues;
  - We delayed introduction of obligation
  - Non compliance leads to no sanction
  - Lists to replace individual documents
- Many Offices treat Madrid applications separately from national applications
- Many offices have embedded procedures that deal only with refusal, and not acceptance

# The things we forgot to think about

- Therefore, GPs are procedurally contrary to tacit acceptance
- Many older offices (often, and more surprisingly, the more developed and more more automated Offices) needed to invest in procedural change in order to comply
- Many such Offices sought IB assistance

# IB's current operational challenges

- Older Offices have embedded processes where they only track objectionable designations
- The IB agreed to accept lists, any form of list
  - Electronic lists (XML) are best
  - Electronic lists (XLS) are next best
  - Electronic Paper (one GP per page) is next best
  - Electronic List (scanned page) is the next WORST
  - Paper List is next best is the WORST
- But lists are NOT NOTIFIABLE
- Global grants (e.g. the BES Islands)

# The things that we now live with

- Paper lists
  - Manual data capture
  - Error prone
  - Heavy
  
- Images Lists
  - OCR data capture
  - Error prone
  - Labor intensive
  
- Electronic Lists
  - XLS and XML are automatable
  - Not noifiable

# The things that we now live with

## XML View

```
<TRANGP>  
<TRAEDAT>20110103</TRAEDAT>  
<OFFREF>W00999177</OFFREF>  
<ORIGLAN>1</ORIGLAN>  
<INTREGN>0999177</INTREGN>  
<NAMEADD>  
<NAMADTY>1</NAMADTY>  
<NAML1>Mejeriforeningen Danish Dairy Board</NAML1>  
<ADDRL1>Sønderhøj 1</ADDRL1>  
<ADDRL2>DK-8260 Viby J</ADDRL2>  
<COUNTRY>DK</COUNTRY>  
<FAXNUM />  
<PHONNUM />  
<LANID>1</LANID>  
<NAT />  
<LEGNATU />  
<PLAINCO />  
<ENTG>  
<ENTAD1 />  
<ENTPC />  
<ENTLIND>3</ENTLIND>  
<ENTCOUN />  
</ENTG>  
<EMAIL />  
</NAMEADD>  
<DOCFILE>742294.tif</DOCFILE>  
</TRANGP>
```





# The things that we now live with

XLS View

Microsoft Excel - 3510.xlsx [Read-Only]

File Edit View Insert Format Tools Data Window Livelink Help Adobe PDF

Arial 10 B I U

A1

	A	B	C	D	E
1					3510
2	<b>N°</b>	<b>N° de marque</b>	<b>Nom de marque</b>	<b>Office of Origin</b>	<b>Registration date</b>
3	1	1041501	STRUCTOFLEX	FR	28/05/2010
4	2	1041502	No verbal elements found	DE	27/11/2009
5	3	1041509	LANCIA DELTA HARD BLACK	IT	14/05/2010
6	4	1041511	Domenico Delucia La natura pratica del gusto	IT	23/03/2010
7	5	1041514	degré k	FR	22/07/2009
8	6	1041515	F-tech	IT	16/12/2009
9	7	1041516	SONALLEVE	BX	25/03/2010
10	8	1041519	GRANULARS Real Stevia	SE	20/04/2010
11	9	1041520	ALBEDO	FR	21/07/2009
12	10	1041523	GTECH	EM	01/02/2010
13	11	1041525	Monopol	DE	08/02/2010
14	12	1041527	uniqueW	EM	18/03/2010
15	13	1041530	DÉLICES DE KERLOCH	FR	17/03/2010
16	14	1041531	RÉGAL DU SUD	FR	17/03/2010
17	15	1041542	YAKKAY	EM	09/04/2010
18	16	1041543	PHYSIO COSMETOLOGY RESULTIME	FR	30/03/2010
19	17	1041544	FARCHIONI Qualità nella Tradizione dal 1780	IT	25/03/2010
20	18	1041545	Smeralda	IT	30/03/2010
21	19	1041548	G FRAME	IT	14/04/2010
22	20	1041549	MYOVISION	AU	09/04/2010
23	21	1041552	No verbal elements found	RU	22/03/2010
24	22	1041558	PRECO	DE	16/03/2010
25	23	1041559	NEXTHEALTH	DE	25/03/2010
26	24	1041563	Solarion	DE	31/03/2010
27	25	1041576	XKSSTEL	CN	07/05/2010
28	26	1041578	ZIBSIO	US	12/05/2010
29	27	1041579	TENREZO	US	12/05/2010
30	28	1041581	lordanov	DE	20/04/2010
31	29	1041589	AGENDIZE	FR	05/05/2010

# The things that we now live with

Paper List  
View

**ARRANGEMENT DE MADRID  
CONCERNANT L'ENREGISTREMENT INTERNATIONAL DES MARQUES  
ET PROTOCOLE RELATIF A CET ARRANGEMENT**

**DÉCLARATION D'OCTROI DE LA PROTECTION**

envoyée au Bureau international de l'Organisation Mondiale de la Propriété Intellectuelle (OMPI)  
conformément à la règle 18ter 1) du règlement d'exécution commun à l'Arrangement et au Protocole de Madrid

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**I. Office qui envoie la déclaration:**      **Office de la propriété industrielle de la République tchèque**  
Antonína Čermáka 2a, 160 00 Praha 6  
République tchèque

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**II. Numéros et noms des enregistrements internationaux:**

735541	PLANTA
1046605	ENERGY SOLUTIONS
1047134	VitaFORCE
1047164	CRISTAL FINISH
1002835	GOOD.BEE
1019687	
1047893	DigoTV
1048720	buzzer +18
1048768	HEAVENS
1048811	FORLLE/D BIOCLINICAL
1048855	B&V
434594	VITROVAC
860681	ATIKER
984555	MONA VIE
1049269	weltplast
1049275	A
1049309	CardApp
955315	FRESH DISCS
1049674	MODE TOUR
1049720	
1049757	ABLE JEANS
1049765	SPAR RÖSTGEMÜSE GEMÜSETRAUM
1049766	SPAR RÖSTGEMÜSE ERDÄPFEL-GEMÜSEMISCHUNG
1049767	S-BUDGET PFANNENGEMÜSE ASIA
1049768	S-BUDGET PFANNENGEMÜSE FEINSCHMECKER
1049769	superhero
1050269	Dong Dong Vodka (Corn Rice Vodka) Since 2000
1050284	ARMORDILLO
1050287	Jet Vodka
1050299	Max San
1050316	LINISI
1050321	Confomap
1050361	Traubisoda Seit 1930 ORIGINAL KELLERKALT
1050362	ESPOIR
1050897	PD-TECH
1050905	NITRASCOPE
1050931	ORNATURA
1050932	SLIMBEL
1050940	AIRIZ
1050972	JURALITH

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Strana 1/2

# The things that we now live with

Paper View

 PRINCIPAUTÉ DE MONACO DÉPARTEMENT DES FINANCES ET DE L'ÉCONOMIE	DIRECTION DE L'EXPANSION ÉCONOMIQUE DIVISION DE LA PROPRIÉTÉ INTELLECTUELLE
<b>ARRANGEMENT ET PROTOCOLE DE MADRID</b> <b>DÉCISION FINALE CONCERNANT LA SITUATION DE LA MARQUE</b> <b>– DÉCLARATION D'OCTROI DE LA PROTECTION –</b> <b>Règle 18ter.1)</b>	
I. Office qui envoie la déclaration : <b>Division de la Propriété Intellectuelle de Monaco</b> 9 rue du Gabian 98000 Monaco	
II. Numéro de l'enregistrement international : <b>1074057</b>	
III. Nom du titulaire (ou autre indication permettant de confirmer l'identité de l'enregistrement international) : <b>Näf Tech AG</b> <b>Wolleraustrasse 41a CH-8807 Freienbach (CH)</b>	
IV. La protection est accordée à la marque qui fait l'objet de cet enregistrement international pour tous les produits et/ou tous les services demandés.	
V. Signature ou sceau officiel de l'Office qui envoie la déclaration :	
VI. Date : <b>21/06/2011</b>	

# The things that we now live with

WORLD INTELLECTUAL  
PROPERTY ORGANIZATION  
34, chemin des Colombettes, P.O. Box 18, CH-1211 Geneva (Switzerland)  
WIPO postal cheque account: No. 12-5000-8 Geneva  
International Bank Account Number (IBAN): Credit Swiss Bank, Geneva  
CH51 0483 5048 7000 8100 0 / Swift Code: CRESCH33BA  
Tel. (41-22) 338 9111 Facsimile (41-22) 740 1429  
E-mail: intreg.mail@wipo.int Internet: http://www.wipo.int  
**Madrid Agreement  
and  
Madrid Protocol**



By registered mail

Philips Intellectual  
Property & Standards  
High Tech Campus 44  
NL-5656 AE Eindhoven  
Netherlands

Our reference: 987/598450301

Geneva, 22/04/2011

Statement of Grant of Protection Issued by an Office where  
no Notification of Provisional Refusal has been Communicated  
within the Applicable Refusal Period

Rule 18ter(1) of the Common Regulations

International registration No. 1027668

Madam,  
Sir,

A statement to the effect that protection is granted to the  
mark that is the subject of the above-mentioned  
International Registration has been sent to the  
International Bureau by the Office of Switzerland, in  
accordance with Rule 18ter(1) of the Common  
Regulations under the Madrid Agreement and the Protocol  
relating to that Agreement.

Since the statement referred to above was sent to the  
International Bureau in electronic form, or in the form of a  
combined list of several International Registration Numbers,  
the International Bureau is not in a position to produce and  
~~provide any further paper documentation in this regard.~~

International Bureau of the World Intellectual  
Property Organization (WIPO)

Notification resulting  
from a list

# The things that we now live with

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 international (IBAN) auprès Crédit Suisse, Genève  
CH51 0483 5048 7060 8100 0 / Swift Code: CRESCHZZBDA  
Tel. (41-22)338 9111 Télécopieur: (41-22) 740 1429  
E-Mail: [intreg.mail@wipo.int](mailto:intreg.mail@wipo.int) Internet: <http://www.OMPI.int>  
**Arrangement de Madrid  
et  
Protocole de Madrid**



Recommandé

EBD Rechtsanwälte  
Rämistrasse 46  
CH-8001 Zürich  
Suisse

## Notification resulting from a Document

Notre référence : 981/610297701

Genève, le 28/06/2011

Objet : Déclaration d'octroi de protection (règle 18ter1)  
Enregistrement international no 1074057 (ANROSAN)

Madame,  
Monsieur,

Veillez trouver ci-joint une déclaration d'octroi de protection relative à l'enregistrement international précité, émise par l'Office de monégasque, conformément à la règle 18ter1) du Règlement d'exécution commun à l'Arrangement et au Protocole de Madrid.

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

# The things that we now live with

- Gazette modification
  - XLS export
  - Flawed solution anyway .....
- The applicants and holders do not actually receive what they expected in the majority of cases

# Preferred format of Grants of Protection

## 1. Electronic with image of document

- XML with image attached
- Document image (with IRN in the file name)

## 2. Electronic lists without image of document

- XML
- XLS

## 3. Paper

## 4. Paper based lists

- Image
- paper

# Things might go better next time If .....

- All the right people are consulted
  - Operations people
  - Logistics people
  - IT people
  - Clients
  
- Comprehensive impact analysis - not just legal
  - Procedural
  - Cost benefit
  - IT
  - Operational





Thank  
You