



Protecting your Trademark Abroad

Madrid System Webinar

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Geneva
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Our speaker



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Program

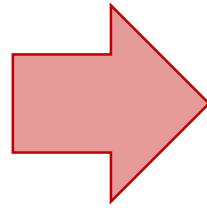
- Presentation + Interactive questions
- Introduction to the Madrid System
- Live demonstration of IP tools for SMEs
- Q&A

Question

- In which region of the world are you currently based?
 - Americas
 - Asia Pacific
 - Europe
 - Middle East & Africa

A trademark and a plan to export

 *By Sally*

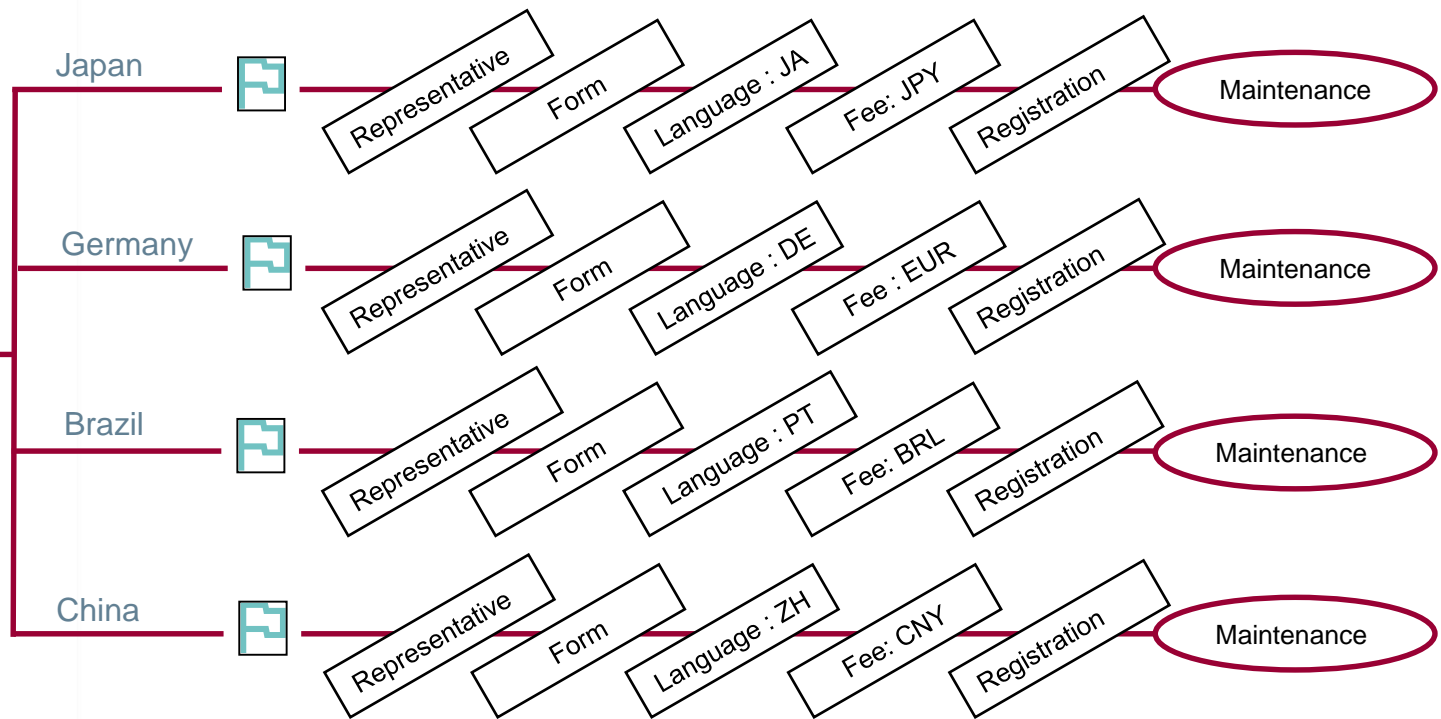


Protection Options

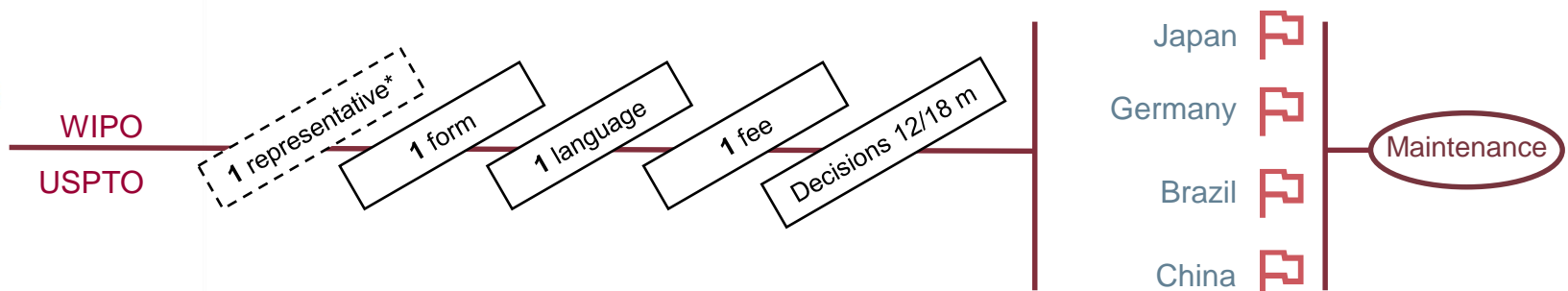
...Then a choice must be made regarding the best way to protect your trademark/s abroad:

- **The national route** – file trademark application/s with the IP Office of each country in which you want protection
- **The regional route** – apply through a regional trademark registration system with effect in all member states (BOIP, EUIPO and OAPI)
- **The international route** – file through the Madrid System

Market by Market Filing

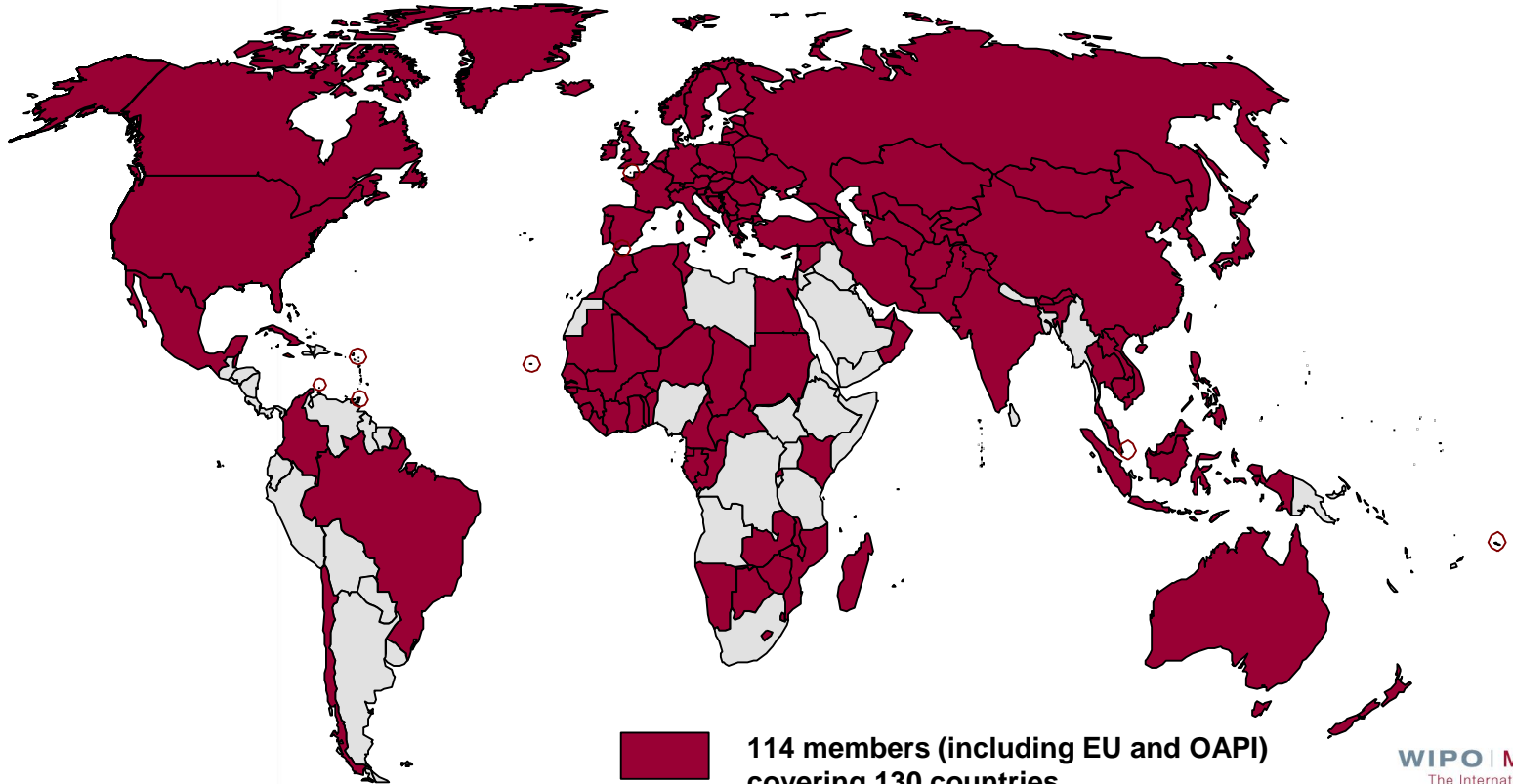


Madrid System



* optional

Members of the Madrid System



Accession Outlook - 2023/24

- **Africa:** South Africa
- **Arab region:** Saudi Arabia
- **Asia:** Bangladesh, Papua New Guinea, Sri Lanka, Fiji
- **Europe:** Malta

Madrid System Users: Business Size

- Individual entrepreneurs, small and large businesses find the Madrid System to be a convenient and cost-effective means to protect marks in key markets throughout the world



**Individual
Entrepreneurs**



**Small & Medium
Businesses**











**Large
Businesses**

The Madrid System: Key Benefits

THE MADRID SYSTEM: PROTECTING TRADEMARKS ABROAD

WIPO | MADRID
The International Trademark System

		ONE-STOP SHOP			
		One application	One set of fees	One filing language	Centralized management
<p>The Madrid System is the convenient and cost-effective way to protect your brand internationally</p> <p>Register and manage your trademarks in multiple countries through one system</p>					
		GLOBAL REACH			
		114 members	130 countries	Over 80% of world trade	And growing
					

Costs comparison - Applications

Madrid System

Designating Brazil, China, Germany and Japan, for a mark in color for 2 classes of goods/services

= CHF 2,116

National Route

- Official fees for 4 countries
- **Additional costs:**
 - 4 x translations
 - 4 x local attorney fees

* Applicants from [LDCs](#) pay only 10% of basic fee

Question

- Can you file your international application directly at WIPO?

- Yes
- No

How the Madrid System Works

The International Trademark Registration Process



IP & INNOVATION ECOSYSTEMS SECTOR (IES)

Department for Economics and Data Analytics

- Data analytics
- GII, WIPR, WIPI
- Economic research (Creative and Innovation Economy)

Judicial Institute

- Judicial Institute
- Case law databases
- Wipo lex

IP for Innovators Department

- TISCs
- Academic support
- Tech Transfer
- Patent Analytics
- Selected CDIP/Regional projects

Office of the ADG

Admin

IP Strategies

IT Focal

Business

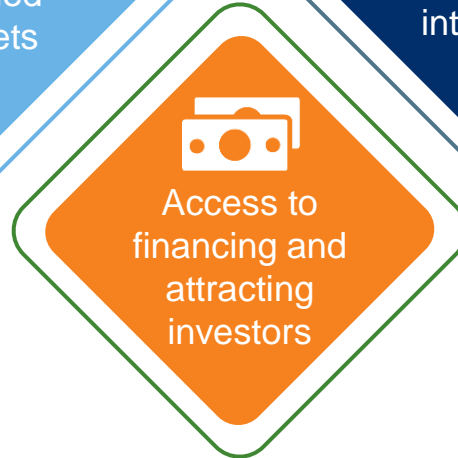
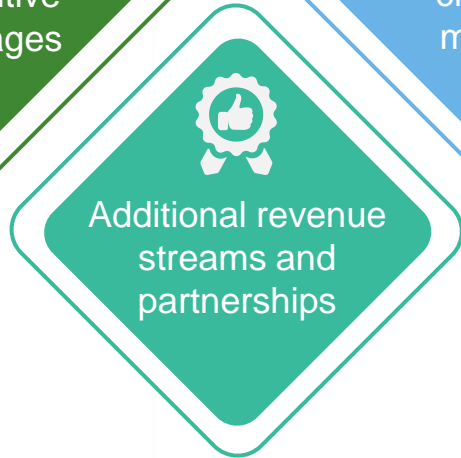
IP for Business Division

- Develop Tools and Materials for Businesses
- Work with SMEs Intermediaries and National IP offices
- IP Management Clinics
- Inventor Assistance Program
- Patent Drafting Programs
- IP Financing & valuation
- IP Commercialization

Arbitration and Mediation Center

- IP Disputes
- Internet IP Disputes
- ADR Collaborations
- ADR Business development

Maximizing your potential through IP



Question

- Have you ever experienced difficulties in identifying your intellectual property assets?
 - Yes
 - No

Protect your competitive edge with IPR

IP Rights give you control, deciding who can do what with your invention, creation, or brand



An invention
patents, utility models
or trade secrets



A creative work
copyright, design
rights

**MY
COMPANY**

Brand name or logo
trademark, copyright,
design rights



Confidential information
trade secrets



A design
design rights,
copyrights,
patents*



Geographical Indications

WIPO IP Diagnostics

- A self-evaluation tool targeting IP strategy for SMEs. It allows you to receive personalized reports instantly on your IP situation.
- Try it for yourself by scanning the QR code !



Background

What is its purpose ?

- Support young enterprises in **developping their capital and strategy in terms of IP.**
- Help expand their **commercial opportunities.**
- Give **preliminary advice on IP assets.**
- Provide **information on business activities** that may be affected by IP.



For whom ?

Any individual or SME that seeks to understand at a glance all the IP components included in its business.

IMPORTANT! The tool does not replace the advice of a specialized legal counsel

How does it work ?

AVAILABLE IN 7 LANGUAGES

Arabic, English, Spanish, French, Chinese, Russian and Japanese and more to come ...

PRE-ASSESSMENT QUESTIONNAIRE

A set of ten basic questions, to best tailor the remaining questions to the users' needs.



USER FRIENDLY AND FREE OF CHARGE

Available on computer and mobile phone. It will take a maximum of one hour to complete the assessment, the users can do it at their own pace, save it and come back as many times as they need to complete it.

A SET OF 10 SECTIONS ON DIFFERENT IP TOPICS

(e.g. innovative products, trademarks, licensing, designs, internationalization, etc.) WIPO IP Diagnostics has ten sections; the users complete only those sections that they consider relevant to their businesses.

Why should I use this tool ?



Understand the IP in your business

- IP rights (patents, trademarks, designs, copyright and trade secrets).
- IP management aspects (maintaining a website, engaging in international trade, dealing with employees, external suppliers and contractors, and licensing, protecting, and defending your IP).



Develop an IP management strategy

- The report can then be used as a starting point for developing an IP management strategy relevant to your business.



Gateway to IP advisory services

- The report can serve as a basis for the discussion with an IP expert on how to protect identified IP assets and integrate an IP Strategy into the users' business.

Hypothetical case



■ By Sally



- ✓ Logo and attractive design
- ✓ Use external providers for certain components
- ✓ Website
- ✓ Employees (15)
- ✓ Intend to sell product locally and internationally
- ✓ Confidential information

STEP 1 – Access the WIPO IP Diagnostics Webpage

Access the page [WIPO IP Diagnostics](#) and click on **start WIPO IP diagnostics**.

No registration required.



WIPO IP Diagnostics

WIPO IP Diagnostics is a free, intellectual property (IP) self-assessment tool that helps businesses identify their IP assets.

After you complete a section, a report that gives you recommendations and further information on IP and business competitiveness will be generated.

- ▶ [How is the IP assessment conducted?](#)
- ▶ [How is the IP Diagnostics report generated?](#)
- ▶ [What does the IP Diagnostics report include?](#)

Find out more: [Brochure PDF](#) | [FAQ PDF](#)

[Start WIPO IP Diagnostics](#)



Video: Helping Your Businesses Identify and Grow with Intellectual Property with the IP Diagnostic Tool

STEP 2 – Pre – assessment questionnaire



Pre-assessment

basic questions regarding your business

Have you developed a product, process, service or a technical modification that you consider new, innovative or unique?

Yes No

Do you generate materials like manuals, pamphlets, labels, or produce videos, software, newsletters, music clips, etc.?

Yes No

Do you use features like patterns, lines, colors or shapes to make the external appearance or the packaging of your product attractive?

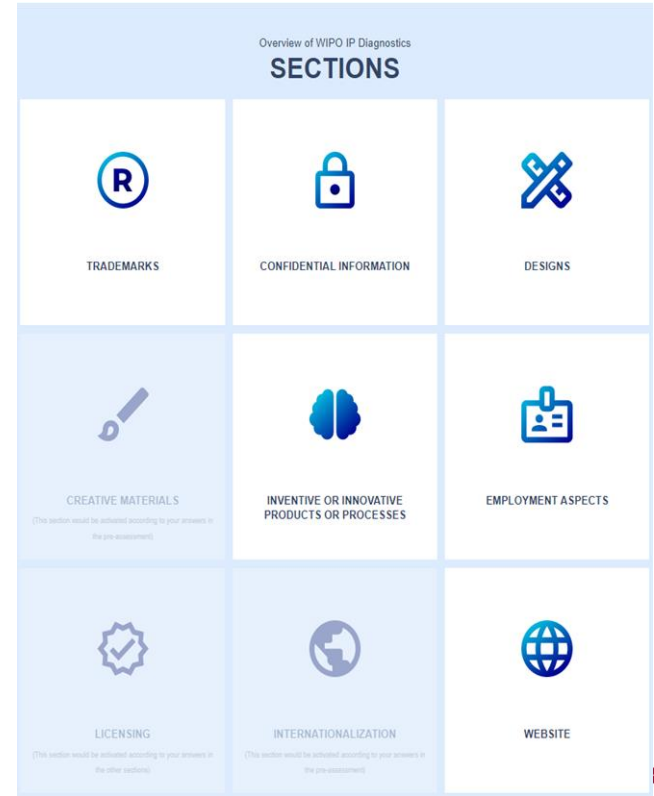
Yes No

- Preliminary assessment
- Personalized questionnaire
- No time limit for use (resume at convenience)
- Max 1h to achieve

STEP 3 – Sections

Sections cover the majority of IP rights.

The tool explores IP in all areas of business activity.



STEP 4 – Download your reports

Web format

- Report for each completed section
- Can be downloaded (PDF)
- Questionnaire to be redone several times
- **IMPORTANT!** The tool does not replace the advice of a specialized legal counsel.

Trademarks

With your answers, you have indicated that you have already a trademark for your business registered at the national or regional intellectual property office or you have applied for one. This means that you have protected or applied to protect a sign that identifies and distinguishes your products and/or services from those of others in the marketplace.

You now have a powerful business asset, it might even be the most powerful asset you own. You can prevent competitors from making unauthorized use of your trademark (that is from marketing identical or similar products under an identical or confusingly similar trademark) and you can use it to build your brand image and reputation allowing you to create a relationship of trust with your consumers and thus establish a loyal clientele and enhance the goodwill of your business. Trademarks are a powerful instrument to capture the consumer's attention and make your products stand out. Consumers are willing to pay more for a product bearing a trademark that they recognize, and which meets their expectations. Trademarks also encourage companies to invest in maintaining or improving the quality of their products in order to maintain or further improve their reputation. Trademarks are one of the most valuable and enduring business assets. They can last a very long time, and thus provide your business with a long-term competitive advantage.

They also have value beyond your core business and offer you the way for the expansion of your business into other products. They may be licensed or merchandised, and so provide an additional source of income through royalties, they are a crucial component of franchising agreements, and they may be sold along with or separately from your business. Trademarks also may be used to provide collateral security in obtaining financing.

However, it is important to remember that it is not enough to obtain protection through trademark registration. The protection may get lost if your trademark is not properly used. A trademark may become generic if it becomes a common name to designate the relevant good or service. In such instances, the trademark will not be registrable and a previous registration for such a trademark may be canceled. For example, Transpore has been ruled generic in the United States of America, so other companies may use that name for an athletic jumping apparatus as well. In most countries, registered trademarks must be used in order to remain valid, otherwise, they may be canceled. Failure to use may mean that the trademark has been abandoned and make the trademark vulnerable to an attack by a third party to have it invalidated for non-use. You indicated that you are using the trademark, so this is not likely to be an issue for your company.

Investors

Your answers suggest that you are interested in attracting investment.

In today's knowledge-based economy, the intangible assets of companies constitute a larger share of the overall value of companies. The physical assets of companies make up an increasingly lower percentage of the share of company value. Therefore, a carefully selected and nurtured trademark is a valuable

PDF format



November 22, 2021

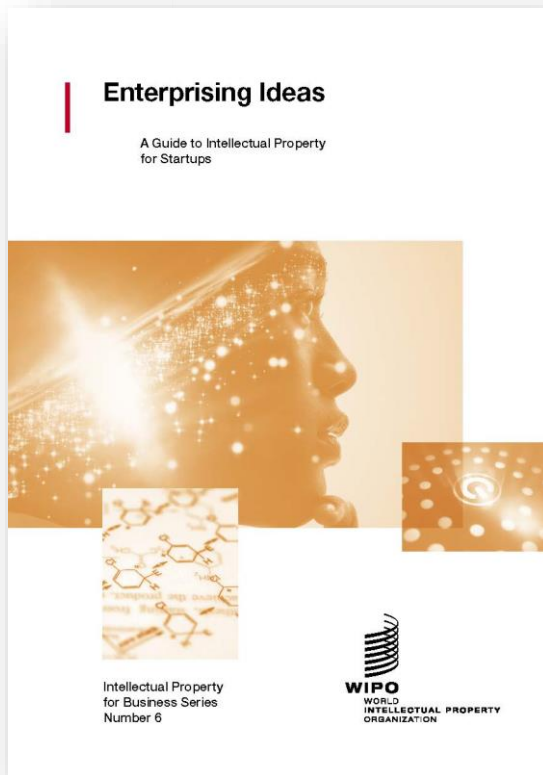
Report of WIPO IP Diagnostics

TRADEMARKS

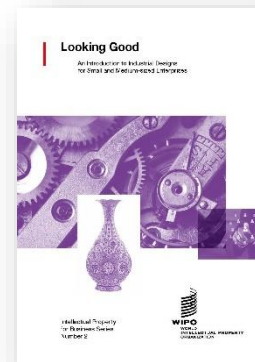
This report has been automatically generated based on your answers.

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You now have a powerful business asset; it might even be the most powerful asset you own. You can prevent competitors from making unauthorized use of your trademark (that is from marketing identical or similar products under an identical or confusingly similar trademark) and you can use it to build your brand image and reputation allowing you to create a relationship of trust with your consumers and thus establish a loyal clientele and enhance the goodwill of your business. Trademarks are a powerful instrument to capture the consumer's attention and make your products stand out. Consumers are willing to pay more for a product bearing a trademark that they recognize, and which meets their



New in 2021



See the entire series at
<https://www.wipo.int/publications/en/series/index.jsp?id=181>



Conclusion and final notes

- A simple and accessible tool
- Pre-assessment that determines the next steps of the analysis
- Individual questionnaires on 10 IP topics applicable to the company
- Immediately downloadable individual reports tailored to the user's information needs
- Capable of responding to different scenarios
- Free of charge
- Enables the establishment of a real IP strategy
- Guides conversation with an advisor

More than 1.5 Million International Registrations

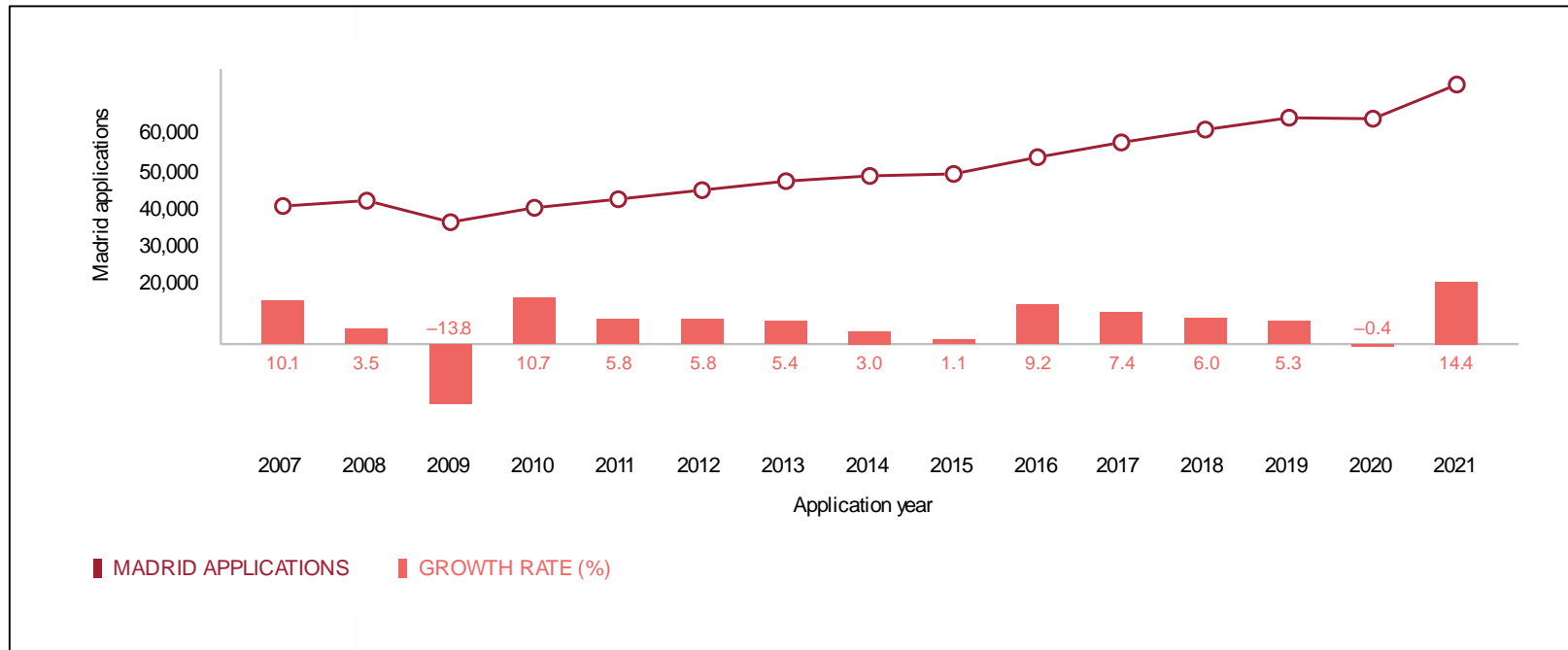


- This LONGINES mark is the oldest trademark still in effect
- Registered in Switzerland in 1889, internationally in **1893**

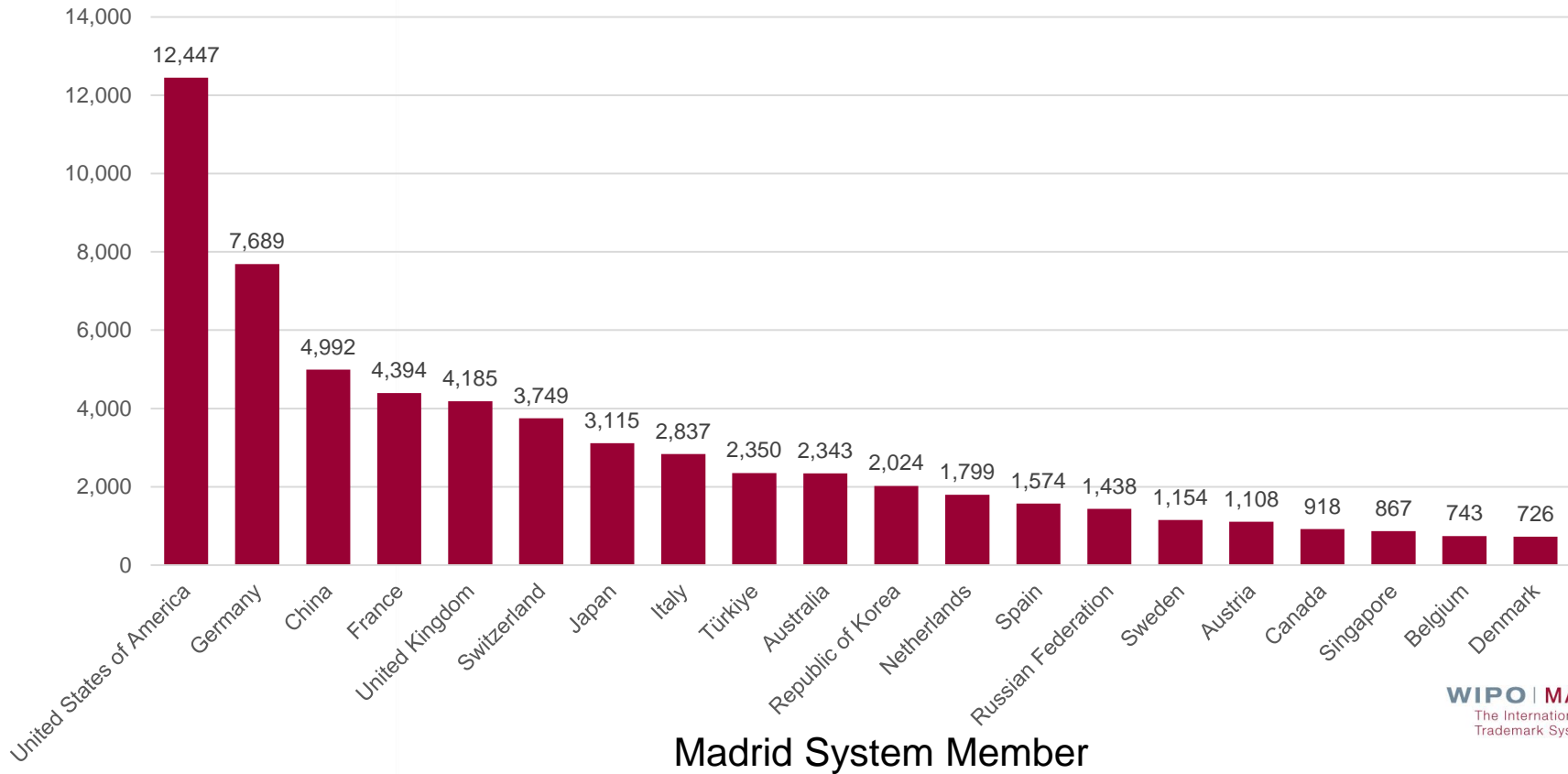


- COLTEJER is international trademark registration 1.5 million
- Registered in Colombia in 2009, internationally in **2019**

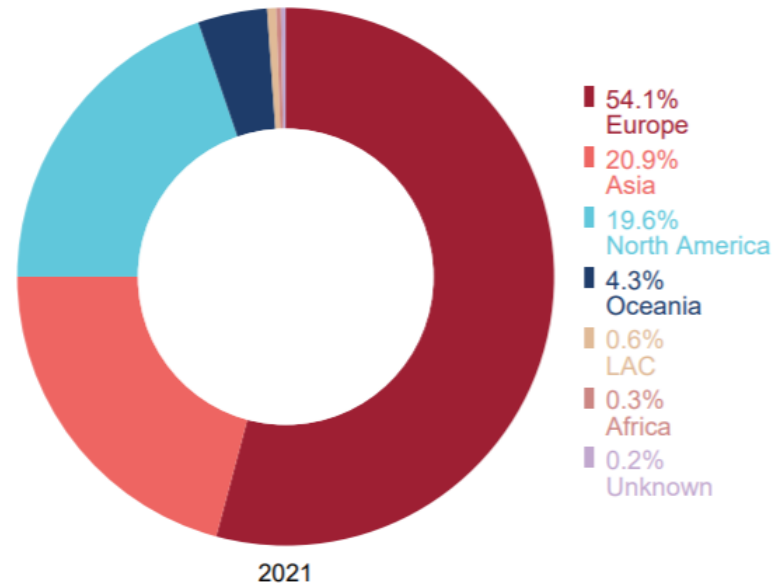
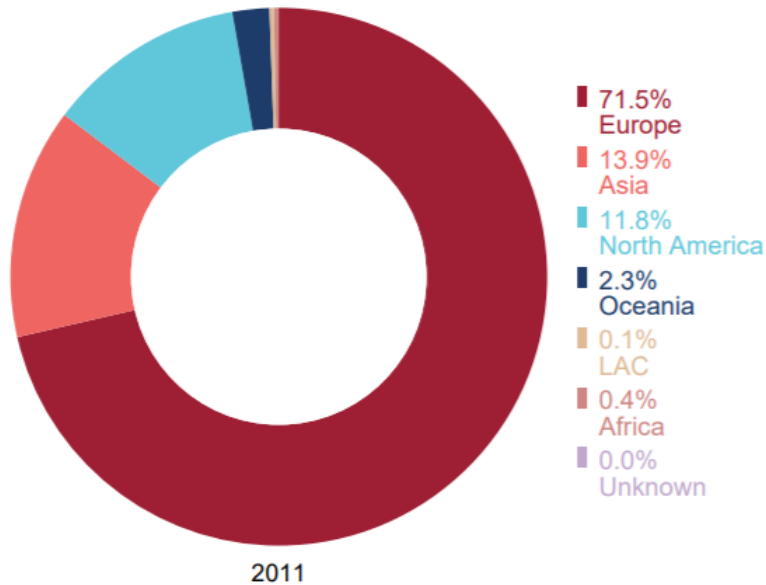
International Applications (2007-2021)



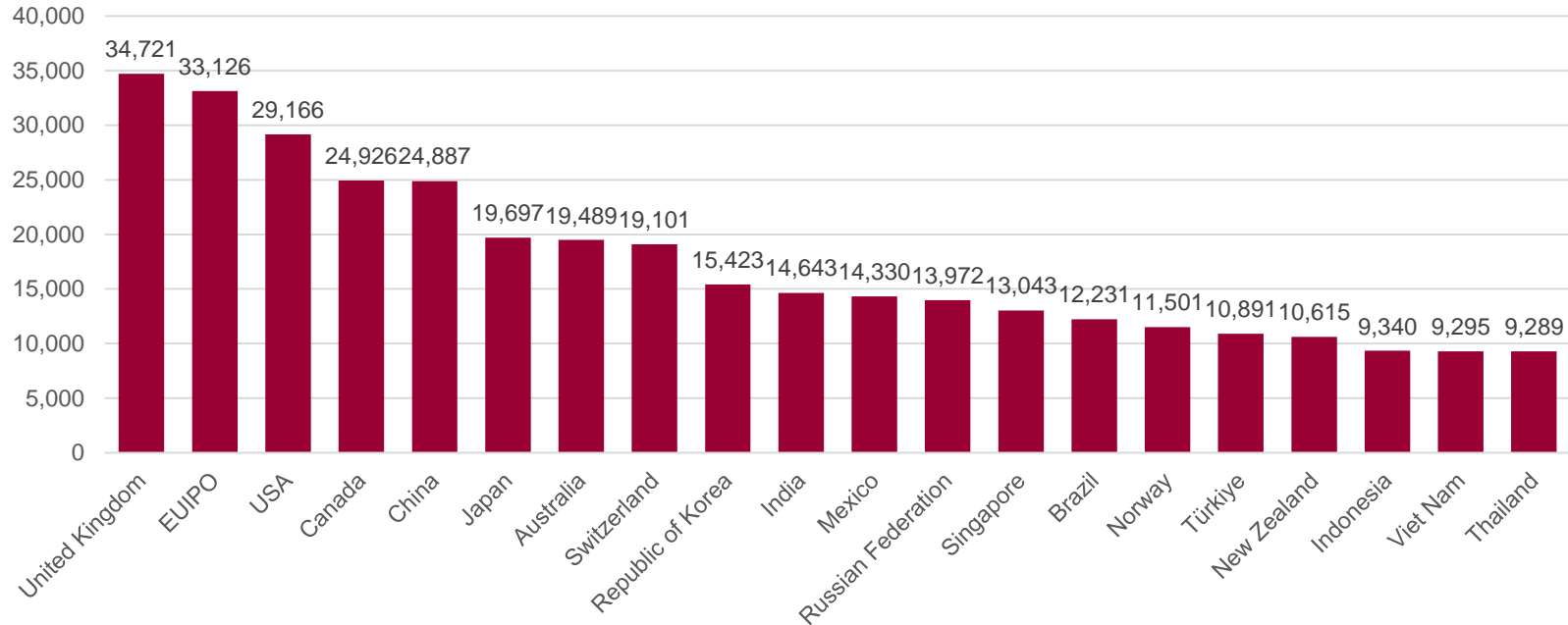
Top 20 Filing Origin 2022



International Applications by Region - 2011 and 2021



Top 20 Designated Madrid System Members 2022



Madrid System Member

Madrid System User Group

Help us shape the future of our Madrid System online services under [eMadrid!](#)

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WIPO | MADRID

The International
Trademark System

■ Questions?

Certificates of Attendance

- Share your certificate on [LinkedIn](#), [Twitter](#) and other social media channel.



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WIPOD – International Trademark System Talks

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Testimonials and Case Studies

Madrid System Case Study Highlight: Panasonic, Branding for Further Growth and Greater Value

October 5, 2021

We continue with our highlights of key case studies giving you practical insights on how companies across various industries use the Madrid System globally to their advantage. Our latest study focuses on [Panasonic, the renowned Japanese electronics corporation](#).

Panasonic provides a wide range of products and services that are used in consumers' daily lives worldwide. These include home appliances, the electronic components used in them, housing and various services.



With more than a hundred years of experience, the company has been thoroughly committed to creating a better life for its users under the brand slogan of "A Better Life, A Better World".

Over the years, Panasonic introduced several business brands to achieve further growth and greater brand value in each area of business. In 2008, the corporation changed its name from the Matsushita Electric Industrial Co., Ltd to the Panasonic Corporation, consolidating its brand identity.

Discover how, with such a varied portfolio and an expansion strategy geared internationally, Panasonic uses the Madrid System to simplify the administrative procedures and greatly reduce costs.

[Read the full Panasonic case study](#)



Micromax on How WIPO's Madrid System Supports its International Growth Strategy

World Intellectual Property Organization – WIPO



MixMediaWorx on the Benefits of Using the Madrid System

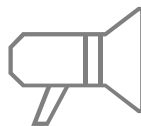
World Intellectual Property Organization – WIPO

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