

Madrid System Updates

Madrid System Webinar

Lucy Headington-Horton

Olivier Pierre

February 5, 2025



Our Speakers



Olivier Pierre

Associate Public Education Officer
Madrid Information and
Promotion Division
WIPO



Lucy Headington-Horton

Senior Legal Officer
Madrid Legal Division
WIPO

Membership

Geographical coverage

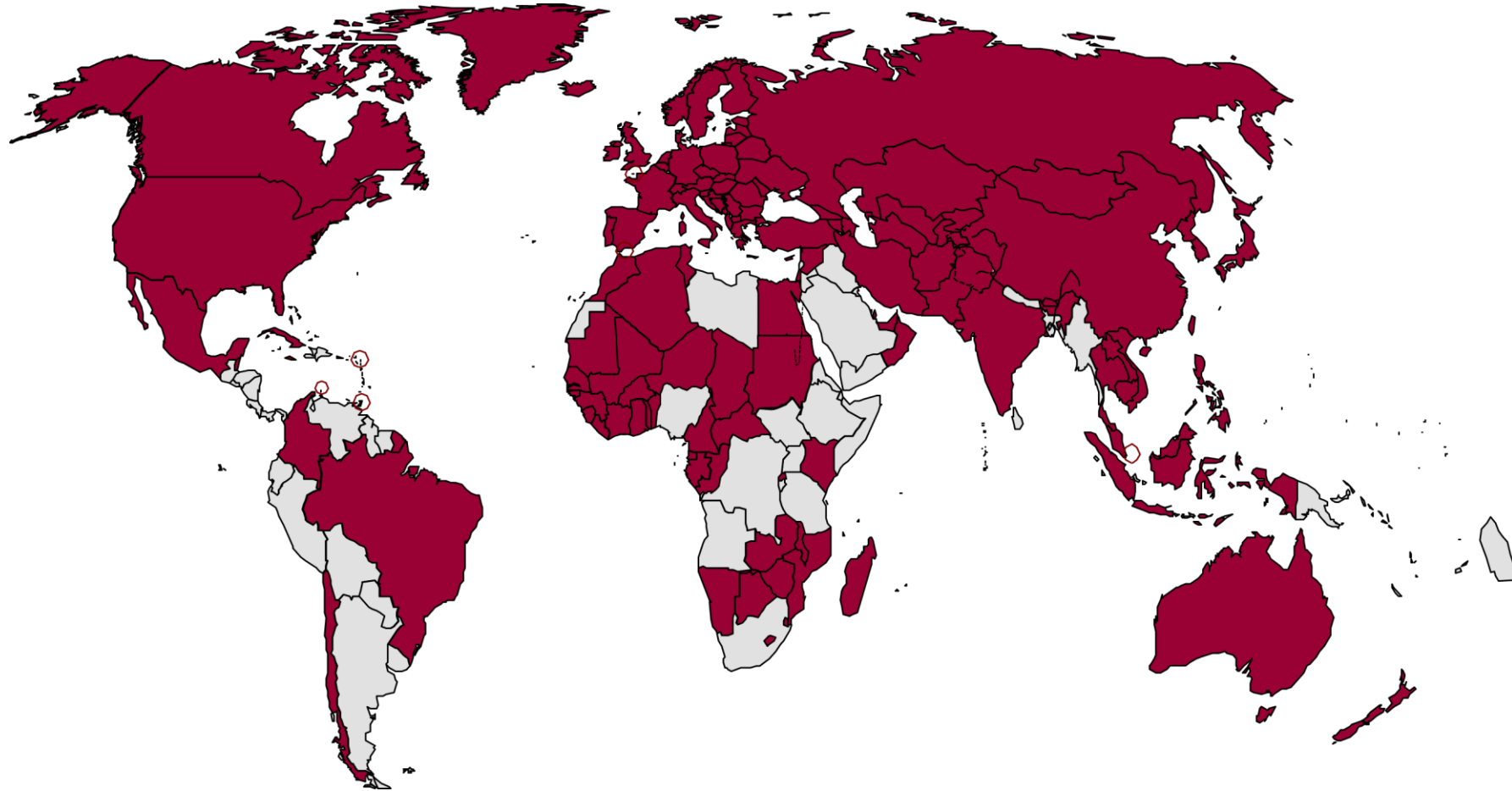
115 members covering 131 countries

Recent accessions:

- 2019: Brazil, Canada and Malaysia
- 2021: Trinidad and Tobago, Pakistan and the UAE
- Expansion to Guernsey and Gibraltar
- 2022: Jamaica, Chile and Cabo Verde
- 2023: Belize and Mauritius
- 2024: Qatar (August 3, 2024)



Members of the Madrid System



115 members (including EU and OAPI) covering 131 countries

Accession outlook: 2025 – 2027



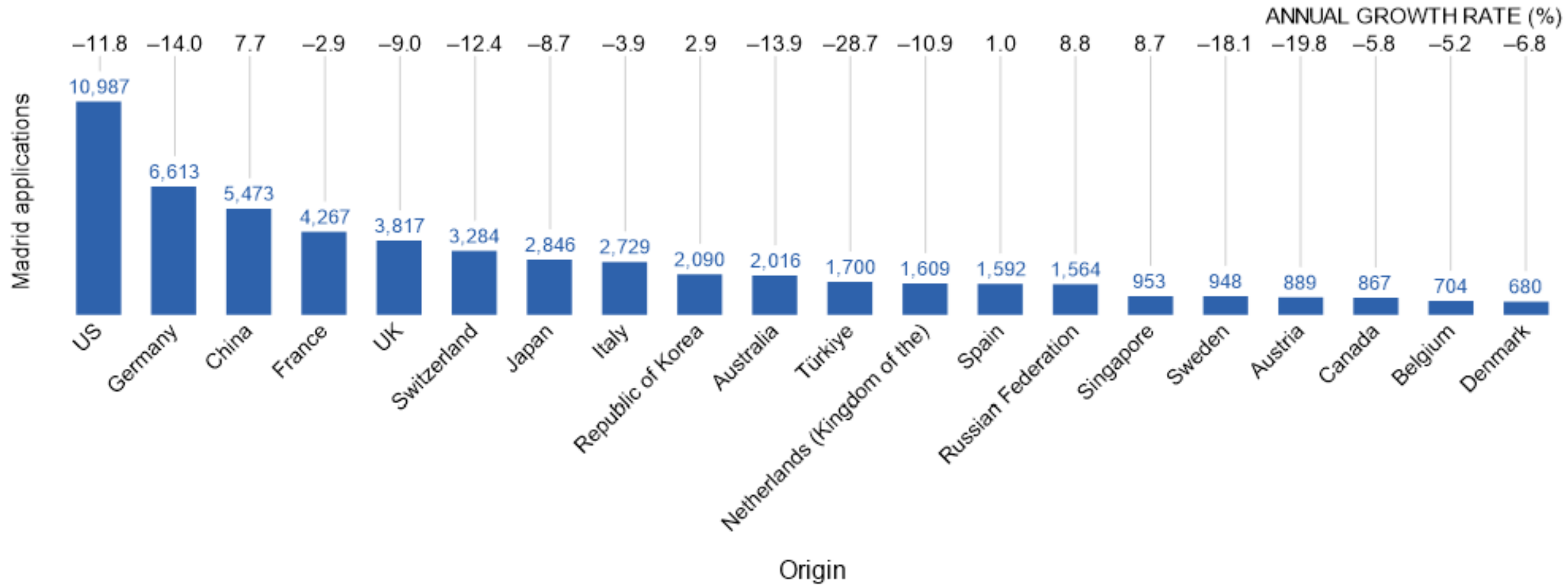
- **Africa:** South Africa
- **Arab Region:** Saudi Arabia
- **Asia / Pacific:** Bangladesh, Papua New Guinea, Sri Lanka, Fiji and Tonga
 - China to extend the Protocol to Hong Kong SAR
- **Europe:** Malta
- **Latin America / Caribbean:** Grenada and St. Vincent and the Grenadines

Use of the Madrid System

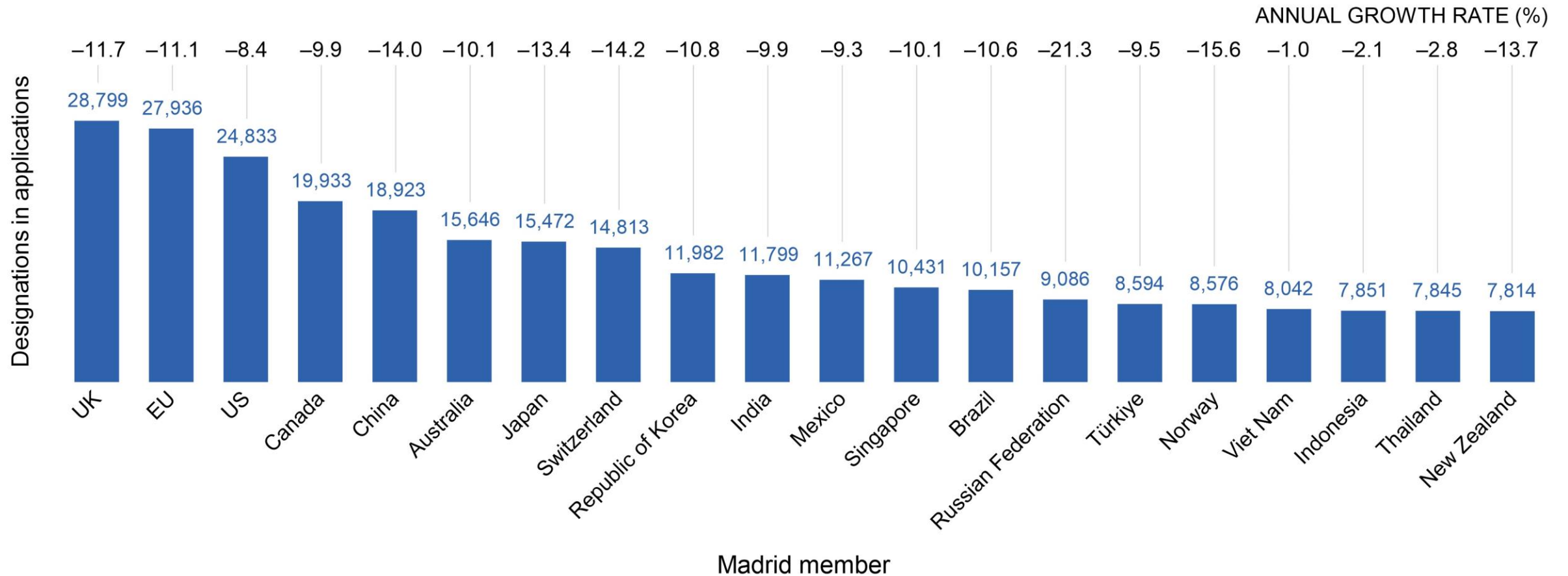
Key numbers for 2023

- International applications: 64,200
- Designations in international applications (IR): 448,340
- International registrations: 63,618
- Average IR: 7 designations and costs CHF 3,983
- Subsequent designations in IR: 64,335
- Renewals of IR: 39,263
- Active IR: 885,464 containing 7,128,390 designations

Top 20 filing origin 2023



Top 20 designations 2023



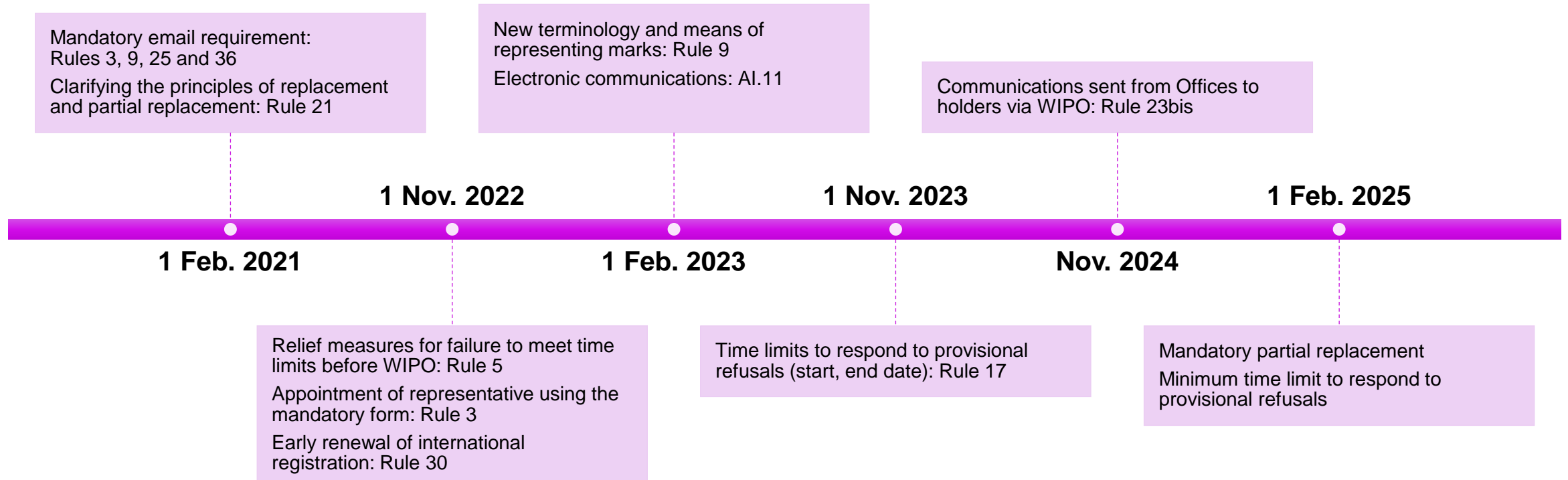
WIPO Statistics Database, March 2024

Top filers 2023

2023 Ranking	Position Changed	Applicant's Name	Origin	2022	2023
1	0	L'Oreal	France	170	199
2	33	Bayerische Motoren Werke Aktiengesellschaft	Germany	39	124
3	1	Euro Games Technology Ltd.	Bulgaria	120	118
4	12	Boehringer Ingelheim International GmbH	Germany	54	110
4	-1	Novartis AG	Switzerland	131	110
6	2828	Berlin-Chemie AG	Germany	3	107
7	-1	Shiseido Company, Ltd	Japan	98	103
8	12	Mizuno Corporation	Japan	51	79
9	1	Huawei Technologies Co., Ltd.	China	80	78
10	14	Apple Inc.	US	47	74
11	6	Richter Gedeon Nyrt.	Hungary	52	64
12	2	Societe Des Produits Nestle S.A.	Switzerland	55	59
13	n/a	Stokomani	France	1	57
14	-3	Nintendo Co., Ltd.	Japan	74	55
15	-3	Merck Sharp & Dohme B.V.	Netherlands (Kingdom of the)	62	54
16	15	Philip Morris Products S.A.	Switzerland	43	52
17	-15	Glaxo Group Limited	UK	136	50
18	37	Egis Gya Gyszergya R Zrt.	Hungary	28	49
19	n/a	Action Service & Distributie B.V.	Netherlands (Kingdom of the)	1	48
20	19	Applied Materials, Inc.	US	35	46

Legal updates

Recent legal updates








February 2021 updates

- Mandatory email requirement (2021)
 - *Representative and holder email address must be different*
- Applicants, holders and their representatives must exchange communications with WIPO by electronic means (2023)
 - *WIPO will send all communications by email to the representative, or if not appointed, to the applicant/holder*
 - *Holder (and representative) will still receive a very limited number of notifications (no change)*



Electronic communication (email address)

Search; notify; update

 CLINIQUE ET LABORATOIRE		 Active	FR	ELCO	131714	1947-07-12	2, 5, 16	
S N R	S N R	 Active	FR	NTN-SNR ROULEMENTS	131696	1947-07-12	7	27.05
PYOREX		 Active	FR	LABORATOIRE BAILLY-CREAT société par actions simplifiée	131713A	1947-07-12	3	
RUGASOL		 Active	CH	Sika Technology AG	131733	1947-07-16	1	

▼ Email Address Status

No email addresses
registered

3,813

-  - WIPO does not have an email address on record for this specific result

November 2023 updates (early renewal)



Now

- Renewal is possible as early as six months before the due date
- WIPO will record the renewal, send the renewal certificate to the holder and notify all designated Offices

Before November 2023

- Renewal possible no earlier than **three months** before the due date
- WIPO will record the renewal, send the renewal certificate to the holder and notify all designated Offices on the date of expiry

CERTIFICATE OF RENEWAL

The International Bureau of the World Intellectual Property Organization (WIPO) certifies that the indications appearing in the present certificate conform to the recording made in the International Register of Marks maintained under the Madrid Agreement and Protocol.

Reproduction of the mark in color under Rule 9.4(a)(vii)



Registration number



Registration date

February 9, 2005

Date of the renewal

February 9, 2025

Date next payment due

February 9, 2035

Name and address of holder



Name and address of the representative



Classification of figurative elements



Colors claimed



List of goods and services NCL(8)

9 Measuring apparatus and instruments, electric and electronic measuring devices, precision measuring devices, dial gauges, thickness gauges, comparator gauges, dial test indicators lever type, parts of the aforementioned goods.

Basic registration



Data relating to priority under the Paris Convention



Designations under the Madrid Protocol

Japan, United Kingdom

Designations under the Madrid Protocol by virtue of Article 9sexies

Austria, China, France, Italy, Switzerland

Declaration of intention to use the mark

United Kingdom



Hongbing Chen
Director, Madrid Operations Division
Madrid Registry
Brands and Designs Sector

Geneva, January 16, 2025



Early renewal (certificate)

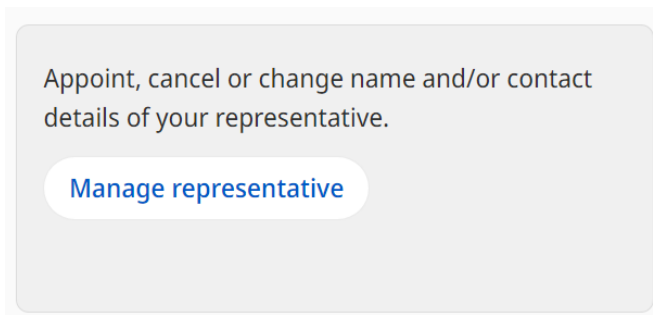
Early renewal (important considerations)

- **!!!** Changes must be recorded before renewal fees have been paid to be taken in account (including limitations, partial cancellation)
- **!!!** Further decisions reducing the scope of protection may not have been notified to WIPO
- Non-renewal reminders sent to holders on expiry date (opportunity for late renewal)
- **!!!** Where subsequent designations are requested after the registration is renewed, but before the new period begins, the holder must request:
 - that the subsequent designation take effect at the start of new period of protection; or,
 - a complementary renewal to pay the renewal fees for the newly designated member



Management of representative

- Official form required: eMadrid “Manage representative”
- **Holder** can appoint, replace, cancel a representative
- **Holder signature** is required
- **Representative** can change contact details of representative, cancel their appointment
- **Representative signature** is required
- If the email address used to access the online form is not the same as the email address on record for the holder/representative, WIPO will send a signature request to that email
- If no signature is received within 14 days, the request will **not** be processed



November 1, 2023: Time limits to respond to refusals

- The Office must provide the start and end date of the time limit
- Exception: where the calculation is from when WIPO sends the refusal to the holder or from when the holder receives the refusal from WIPO
- All Offices must notify WIPO of the length of the time limit and how this is calculated
- [Time Limits to Respond to Notifications of Provisional Refusal \(wipo.int\)](https://www.wipo.int)

Dear Sir or Madam,

In accordance with Rule 17(4) of the Regulations, please find herewith a copy of a notification of provisional refusal of protection concerning the above-mentioned international registration.

Contracting Party whose Office issued the notification : EM
Date on which the notification was sent to WIPO : 05/01/2023
Date of receipt by WIPO : 05/01/2023
Date of notification by WIPO to the holder : 12/01/2023

For further information, please feel free to contact the International Bureau at the following address: www.wipo.int/madrid/en/contact/, or by telephone, at the following number: +41 22 338 86 86.

Yours faithfully,

International Bureau of the World Intellectual
Property Organization (WIPO)

Dear Sir or Madam,

In accordance with Rule 17(4) of the Regulations, please find herewith a copy of a notification of provisional refusal of protection concerning the above-mentioned international registration.

Contracting Party whose Office issued the notification : European Union
Date on which the notification was sent to WIPO : 03/01/2025
Date of receipt by WIPO : 03/01/2025
Date of notification by WIPO to the holder : 13/01/2025

Time limit to reply to the notification : 2 month(s)

Date on which the time limit to respond to the notification begins : 03/01/2025

Date on which the time limit to respond to the notification ends : 03/03/2025

If you have any questions concerning the substance of the refusal (including the time limit, grounds, legal basis, etc.) or the requirements for filing a response, please contact the Office concerned.

13 January 2025

Delivering a world leading IP system

www.ipaustralia.gov.au

ABN: 38 113 072 755

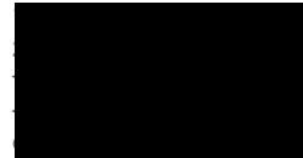
International Bureau, WIPO
34, chemin des Colombettes
P.O. Box 18
1211 Geneva 20,
SWITZERLAND

International registration number:

Australian Trade mark Number:

Trade mark:

Holder's name:



**NOTIFICATION OF TOTAL PROVISIONAL REFUSAL OF AN INTERNATIONAL
REGISTRATION DESIGNATING AUSTRALIA (IRDA)
THIS REFUSAL IS ISSUED IN ACCORDANCE WITH RULE 17(1) TO 17(3)**

The Australian Designation of the International Registration does not meet the requirements of *Trade Marks Act 1995*. The issues currently preventing acceptance of the International Registration are explained in the attached Adverse Examination Report number 1 and where possible, the ways in which the holder may be able to resolve the issues.

The holder has 15 months starting from 13 January 2025 and ending on 13 April 2026 to overcome all the issues otherwise this refusal will take effect.

The holder may respond in writing to this refusal. Please allow time for me to consider any responses by ensuring they are received by this office no later than 20 business days prior to 13 April 2026. For assistance with our online lodgement services please contact **1300 65 10 10**.

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

If you wish to respond in any of these ways, you must do so in writing and supply an address for service in Australia or New Zealand.

The trade mark examiner who produced this report is [REDACTED] and their direct line is +61 [REDACTED]. If you have been unable to reach your examiner directly, another examiner who may be able to assist you can be reached on +61 [REDACTED].

Notification of provisional refusal (start and end date)

Recent minor legal changes

November 1, 2024

- Amendment to Rule 23*bis*
 - Allows all Offices to request that WIPO transmits to holders any communication not covered under the Regulations
- Editorial amendments:
 - Rule 21(3): that a domestic registration shall coexist with the IR
 - Rule 32: that the IB must also publish declarations that a given limitation has no effect

February 1, 2025: Time limits to respond to refusals

- The Office must provide a minimum time limit of **2 months** (60 days)
- It is possible to notify delayed implementation by sending a formal communication to the International Bureau before February 1, 2025
- Failure to do so (minimum time limit or delayed implementation) will result in an irregularity, the provisional refusal will not be recorded, and the Office will have two months to provide a minimum time limit



February 1, 2025: Partial replacement

- The Office must take note of partial replacement (overlapping goods/services)
- Webinar:
https://www.wipo.int/meetings/en/details.jsp?meeting_id=78510



Outcome of the recent Madrid WG Meeting (1/3)

1) E-mail Address as a required indication for selected requests for recording:

- Proposal to amend Rules 3, 20*bis*, 24 and 25 to require holders and representatives who have not yet indicated their email addresses to do so in requests presented under these rules

2) Recalculation of the amounts of the individual fees in Swiss francs

- Proposal to amend Rule 35 so WIPO can initiate recalculation of amounts in individual fees when the exchange rate has remained at least 5% lower for more than 3 consecutive months

These two proposals will be for the formal approval by the Madrid Union Assembly in 2025, with entry into force date of November 1, 2025

Outcome of the recent Madrid WG Meeting (2/3)

3) Various proposals concerning the dependency principle

- Ranging from keeping it as it is, reducing it from 5 to 3 years, 'freezing' dependency, limiting the grounds of ceasing of effect of the basic mark that may impact the IR, or introduce options of declarations for members to make concerning dependency
- Any amendment of Article 6 of the Protocol must be through the convening of a Diplomatic Conference
- No consensus yet – discussions to continue in the next session

Outcome of the recent Madrid WG Meeting (3/3)

4) Possible introduction of new languages in the Madrid System

- Currently, the languages in the Madrid System are English, French and Spanish
- Earlier proposals to introduce Arabic, Chinese and Russian
- Recent proposals to introduce also German, Japanese and Portuguese
- No consensus yet – discussions to continue in the next session



Questions?

Public Education Resources

Public Webinars – 8 Languages

Webinars del Sistema de Madrid

Actualizaciones legales del Sistema de Madrid de 2023: Todo lo que necesita saber

1:03:21
WIPO MADRID

9 MONTHS AGO

Actualizaciones legales del Siste...

Webinars du système de Madrid

Protéger sa marque à l'étranger : Guide sur le système de Madrid de l'OMPI et outils de propriété intellectuelle pour les PME

1:08:24
WIPO MADRID

5 MONTHS AGO

Protéger sa marque à l'étranger ...

马德里体系网络研讨会

中国商标局的马德里申请程序 (2023)

1:09:00
WIPO MADRID

EDUCATION 4 MONTHS AGO

The Madrid Filing Procedure in China Trademark Office

Вебинары по Мадридской системе

Официальные формы: Управление международной регистрацией

59:39
WIPO MADRID

EDUCATION 2 YEARS AGO

Official Forms: Managing an international registration

マドリッド制度に関するWebセミナー

商標の国際登録制度『マドリッド制度』の概要(初級) - 制度を学びたいスタートアップ、中小企業の方にも!

2023年10月26日

1:13:44
WIPO MADRID

EDUCATION 15 DAYS AGO

商標の国際登録制度『マドリッド制度』の概要(初級) - 制度

التحديثات القانونية بشأن نظام مدريد

تحديثات قانونية لعام 2023 وملاحظات الفريق العامل

44:48
WIPO MADRID

8 MONTHS AGO

لعام 2023 آراء ومقترحات الفريق العامل ...

Madrid System Webinars

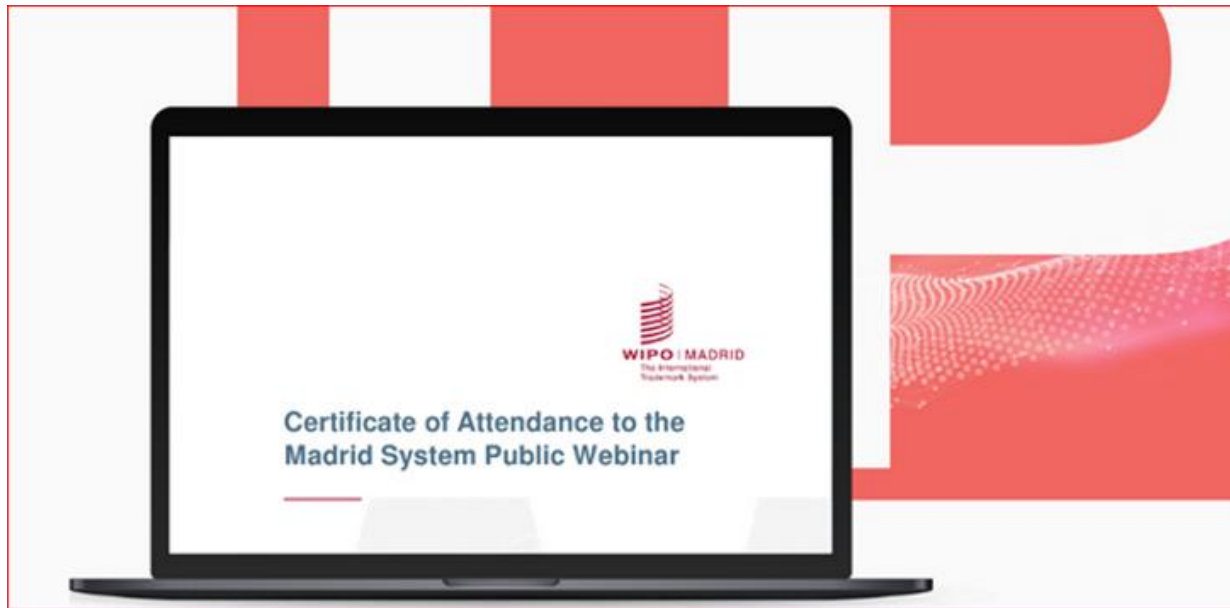
Understanding Procedures at the IP Office of the United Kingdom (UKIPO)

1:06:25
WIPO MADRID

EDUCATION 1 MONTH AGO

Understanding Procedures at th...

Certificates of Attendance



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

Tag WIPO **#MadridSystem**

Video Explainers and Tutorials

Madrid 'How-to' videos



How to extend the protection of an international registration via the subsequent designation

In this tutorial, you will learn how to expand the geographical coverage of your existing international registration by adding additional countries or regions through a subsequent designation. [About subsequent designations.](#)



How to renew international registrations (part 1)

This tutorial will go over the renewal process, modifications to international registrations before and after the renewal and the costs associated to the renewal. [About renewals.](#)



Video: An introduction to the International Trademark System.



Video: Benefits and advantages of the Madrid System.

Distance Learning Course




- Certified and tutored online course
- 6 modules – 16 hours
- Free
- 800 - 1000 participants per session
- With the WIPO Academy
- [DL-303 Specialized Course on the Madrid System for the International Registration of Marks](#)

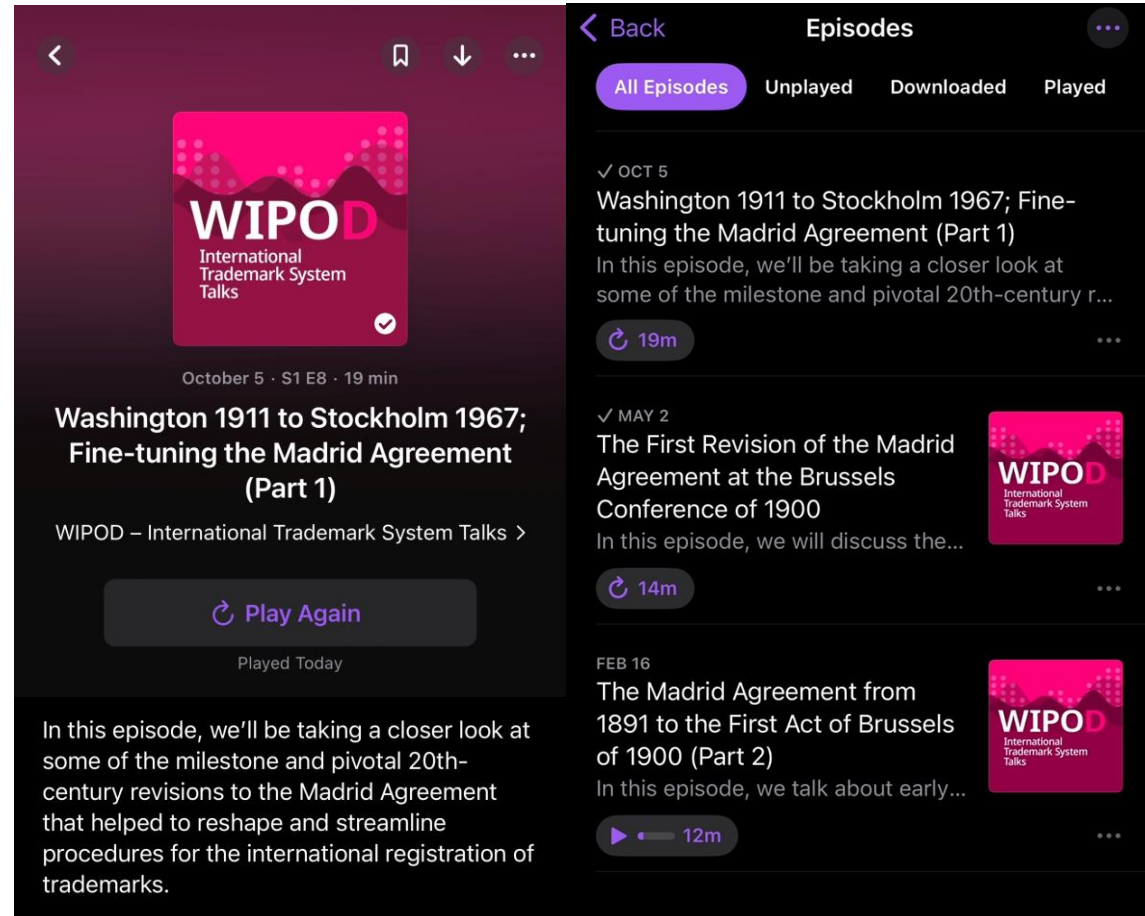


Madrid System Podcast

WIPOD – International Trademark System Talks

10 episodes

- Spotify 
- Apple Podcasts 
- YouTube Podcasts 



WIPO, 2024

Testimonials and Case Studies

Madrid System Success Story: M'Simbi – Spreading Self-Love Globally, One Doll at a Time

July 25, 2023

We have just released a new success story highlighting how the [Madrid System](#) supports innovative entrepreneurs who want their brand to make a difference even beyond their national borders.

What do you do when society tricks you into believing you do not fit in? You carve your own path and you make your voice heard! This is exactly what Maingaila Moono – former biostatistician and now full-time entrepreneur from Zambia – did when she realized that her daughter did not feel like she complied with traditional beauty standards.



In 2022, the [Zambian Association of Manufacturers](#) assigned Maingaila the Game Changers Award, as an acknowledgement of her innovative ideas, her sense of leadership and her positive impact on the manufacturing industry. (Photo: MacLean's Photography)

Her little girl motivated Maingaila to find a way to manufacture Black dolls, and to set up her own business - M'Simbi- whose mission is to teach young girls to be proud of their cultural identity and aware of their own unique beauty.

M'Simbi products now range from dolls to backpacks, and from clothes to hair accessories, and are exported to the United Kingdom and the United States of America.

International trademark protection in those countries through the [Madrid System](#) is what truly allowed M'Simbi to take off, opening up doors to major international e-commerce platforms.

"I would definitely encourage local entrepreneurs to apply for trademark protection both locally and internationally. When [PACRA \(Patents and Companies Registration Agency in Zambia\)](#) told us that you can register your trademark in many countries at once with the [Madrid System](#), it really intrigued us."

— Maingaila Moono

[Access the full success story](#)

Madrid System Success Story: HABIBA Jewellery – Timeless Tunisian Jewelry Takes the International Stage by Storm

September 26, 2023

Entrepreneur Sonia Feki's brand "[HABIBA Jewellery](#)" – created as a tribute to her mother – was quick to win the hearts of women across Tunisia. Despite the challenges of the COVID-19 pandemic, the brands' success grew, spontaneously catching the attention of Egyptian media outlets, in turn raising awareness in the Gulf countries. From there, demand grew in other African countries.

Find out all about Sonia's journey to success, and how the [Madrid System](#) is helping her not just to expand her horizons but also to face the future with confidence.



Sonia's secret to success?

"When I founded [HABIBA Jewellery](#), I projected myself 15 years into the future. Protecting my trademark – first nationally and then internationally – was one of my top priorities."

— Sonia Feki, [HABIBA Jewellery](#)

[Access the full success story](#)

Madrid System User Group

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

[Sign up to our Madrid System User Group](#)





Keep Updated on the Madrid System

Good news! We are now on LinkedIn!

We'll be sharing tips, facts, stories, learning opportunities and much more on WIPO's [Madrid System](#), [Hague System](#) and [Lisbon System](#), as well as trademarks, designs, and geographical indications!

[Follow us](#) now and spread the word!




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