

GUIDE ON HOW TO OBTAIN TRADEMARK PROTECTION THROUGH THE MADRID SYSTEM

INTRODUCTION

The International Route of Trademark Protection under the Madrid system can be followed by those who would like to use their national trademark application in order to expand their protection internationally. There are several reasons to prefer the international route, such as seeking for protection in multiple markets, especially if these are located in different regions, as part of an export strategy or seeking for flexibility to add new markets, as export plans are developing. Finally, there can be budgetary or time constraints for the registration and management of one's trademarks.

This Guide is intended for potential applicants and holders of international registrations of trademarks under the Madrid System. The purpose of this Guide is to answer to basic questions about how to use the Madrid system for the protection of trademarks internationally, and how to benefit from the customized tools designed to assist potential users of the system in the filing of their applications and the management of their international registrations.

BASIC FEATURES OF THE MADRID SYSTEM

The Madrid system of international registration is governed by two treaties: the Madrid Agreement Concerning the International Registration of Marks, which dates from 1891, and the Protocol Relating to the Madrid Agreement, which was adopted in 1989, entered into force on December 1, 1995, and came into operation on April 1, 1996. The system is administered by the International Bureau ("IB") of the World Intellectual Property Organization ("WIPO"), in Geneva, Switzerland.

Following a decision in the Madrid Union Assembly (the "Assembly") in October 2016, the Agreement became inoperative; the Protocol is now the sole governing treaty under the Madrid System. It is no longer possible for countries to accede only to the Agreement. However, it is possible to accede to both the Agreement and to the Protocol at the same time, in which case the Protocol will prevail.

Egypt became party to the Madrid Agreement on July 1st, 1952 and to the Madrid Protocol on September 3rd, 2009. Consequently, Egypt is a member of the Madrid Union, a Special Union under Article 19 of the Paris Convention for the Protection of Industrial Property and member of its Assembly. Among the most important tasks of the Assembly are the adoption of the program and budget of the Union and the adoption and modification of the implementing regulations, including fixing of fees connected with the use of the Madrid System.

The legal framework of the Madrid System consists of the Protocol, the Regulations under the Protocol and the Administrative Instructions. The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks ("Madrid Protocol") is an international treaty that allows a trademark owner to seek registration in any of the countries or intergovernmental organizations that have joined the Madrid Protocol by submitting a single application, called an international application.

WHO MAY USE THE MADRID SYSTEM?

The Madrid System may be used only by a natural person or a legal entity which:

- a) has a real and effective industrial or commercial establishment in Egypt, or
- b) is domiciled in Egypt, or
- c) is a national of Egypt.

The Trademarks and Industrial Designs Office in Egypt (TIDO) with respect to which a person or entity fulfils one or more of the above conditions is referred to as the "Office of origin". A trademark may be the subject of an international registration, if it has been registered, or if its registration has been applied for in TIDO.

An application for international registration must designate one or more Members of the Madrid Union in which the trademark is to be protected. It cannot designate Egypt. Members of the Madrid Union in which the trademark is to be protected may also be designated subsequently. The Madrid System cannot be used to protect a trademark outside the Madrid Union.

DEPENDENCE ON A BASIC APPLICATION OR A BASIC REGISTRATION

An international application may be based either on a registration by TIDO or on an application for registration filed with TIDO; equally, it may be based on several applications or registrations (or a combination thereof).

For a period of five years from the date of its registration, an international registration remains dependent on the mark registered or applied for in TIDO. If, and to the extent that, the basic registration ceases to have effect, whether through cancellation following a decision of TIDO or a court, through voluntary cancellation or through non-renewal, within this five-year period, the international registration will no longer be protected. Similarly, where the international registration was based on an application in TIDO, it will be canceled if, and to the extent that, that application is refused or withdrawn within the five-year period, or if, and to the extent that, the registration resulting from that application ceases to have effect within that period.

TIDO is required to notify the International Bureau of facts and decisions concerning such ceasing of effect or refusal and, where appropriate, to request

the cancellation (to the extent applicable) of the international registration. The cancellation is published in the Gazette and notified to the designated Members of the Madrid Union.

If, within three months of such cancellation, the holder files an application for registration with the Office of a designated Member of the Madrid Union, that application will be treated as if it had been filed on the date of the international registration or (as the case may be) the subsequent designation of the Member concerned.

After the expiry of the period of five years mentioned above, the international registration becomes independent of the basic registration or basic application.

OVERVIEW OF THE PROCEDURE UNDER THE MADRID SYSTEM



The applicant must submit the international application through TIDO in which the basic application and/or registration is held ("Office of Origin"). An international application which is presented directly to the International Bureau by the applicant will not be considered as such and will be returned to the sender.

The international application must be for the same trademark and must include, inter alia, a reproduction of the trademark (which must be identical with that in the basic registration or basic application) and a list of goods/services that is identical to or narrower than the list of goods/services in the basic application and/or registration. The international application must designate one or more Contracting Parties in which an extension of protection of the international registration is sought.

An international application may claim priority under Article 4 of the Paris Convention, whether from the application with TIDO or from a prior application filed with the Office of another country party to the Paris Convention or with the Office of a Member of the World Trade Organization.

TIDO must certify that the information in the international application corresponds with the information in the basic application and/or registration, and then forward the international application to the International Bureau. If the

International Bureau receives the international application within two months of the date of receipt in TIDO, the date of the international registration is the date of receipt in TIDO. If the International Bureau does not receive the international application within two months of the date it was received by TIDO, the date of the international registration is the date on which the international application is received by the International Bureau.

The holder of an international registration may request protection in additional Contracting Parties by submitting a subsequent designation. A subsequent designation is a request by the holder of an international registration for an extension of protection of the registration to additional Contracting Parties.

Each Contracting Party designated in an international application or subsequent designation will examine the request for extension of protection as a national trademark application under its domestic laws. There are strict time limits for the trademark office of a Contracting Party to refuse a request for extension of protection. The standard time limit is 12 months. A Contracting Party may however declare that this time limit shall be replaced by 18 months. A Contracting Party that has made this declaration may further declare that a provisional refusal based on an opposition may be notified even after the expiry of this 18-month period.

The provisional refusal is recorded in the International Register and published in the Gazette and a copy is transmitted to the holder of the international registration.

Any procedure subsequent to the refusal, such as review, appeal or response to an opposition, is carried out directly between the holder and the Office concerned, without any involvement on the part of the International Bureau. However, once all the procedures before that Office have been completed, the Office must send to the International Bureau a final statement.

Where, before the expiry of the refusal period, all the procedures before an Office have been completed and the Office has found no grounds to refuse protection, the Office shall, as soon as possible, (and before the expiry of the refusal period), send to the International Bureau a statement to the effect that protection is granted to the mark (**Statement of Grant of Protection where no Notification of Provisional Refusal has been Communicated**). Such statement is recorded in the International Register and published in the Gazette and a copy is transmitted to the holder of the international registration.

If the Contracting Party does not notify the International Bureau of a refusal within this time period, the mark is automatically protected. However, the extension of protection may be invalidated in accordance with the same procedures as for invalidating a national registration, e.g., by cancellation.

FEES

The international application is subject to the payment of the following fees:

- a basic fee;
- a complementary fee in respect of each designated Contracting Party for which no individual fee is payable;
- a supplementary fee in respect of each class of goods and services beyond the third.

The amounts of the basic, complementary and supplementary fees are set out in the Schedule of Fees. The amounts of the current fees are available under the heading dedicated to the Madrid System on WIPO's website <https://www.wipo.int/madrid/en/fees/sched.html>.

A fee calculator that takes account of all possible permutations of designations of Contracting Parties and number of classes of goods and services (including limitations in respect of particular Contracting Parties) is also available on this website (<https://madrid.wipo.int/feecalapp/>).

EFFECTS OF THE INTERNATIONAL REGISTRATION

From the date of the international registration (or, in the case of a Contracting Party designated subsequently, from the date of that designation), the protection of the trademark in each of the designated Contracting Parties is the same as if the trademark had been the subject of an application for registration filed directly with the Office of that Contracting Party. If no provisional refusal is notified to the International Bureau within the relevant time limit, or if any such refusal is subsequently withdrawn, the protection of the mark in each designated Contracting Party is the same as if it had been registered by the Office of that Contracting Party.

An international registration is therefore equivalent to a bundle of national registrations. Although it is a single registration, protection may be refused by some of the designated Contracting Parties, or the protection may be limited or renounced with respect to only some of the designated Contracting Parties. Likewise an international registration may be transferred to a new owner with respect to only some of the designated Contracting Parties. An international registration may also be invalidated (for example, for non-use) with respect to one or more of the designated Contracting Parties. Moreover, any action for infringement of an international registration must be brought separately in each of the Contracting Parties concerned.

REPLACEMENT OF A NATIONAL OR REGIONAL REGISTRATION BY AN INTERNATIONAL REGISTRATION

An international registration is deemed to replace a national or regional registration for the same trademark and the same goods and services recorded in the name of the same person in a designated Contracting Party. The effect

of replacement is that, if the national or regional registration is not renewed, the holder of the international registration may continue to benefit from the earlier rights acquired by reason of that national or regional registration. Although replacement takes place automatically, the holder of the international registration may request the Office of the Contracting Party in which the national or regional registration is recorded to take note in its register of the international registration.

SUBSEQUENT DESIGNATION

A subsequent designation is a request by the holder of an international registration for an extension of protection of the international registration to additional Contracting Parties, made after the IB registers the trademark. Thus, the holder of an international registration can expand the geographical scope of the protection of his trademark in line with his business needs, including the extension of the trademark protection to a Contracting Party which was not a member of the Madrid System at the time of the international application. Moreover, where protection has initially been refused, it is possible to later make a subsequent designation if the grounds for refusal no longer apply.

In principle, under the current Madrid System, a holder from any Contracting Party may subsequently designate any other Contracting Party of the System. However, there is an exception to this principle; any Contracting Party may declare that the protection resulting from an international registration effected before the date on which it entered into force, with respect to that Contracting Party, cannot be extended to that Contracting Party. In such case, the only alternative to use the Madrid route for registering a trademark in the territory in question, is to file a new international application designating the Contracting Party which has made the declaration.

CHANGES IN THE INTERNATIONAL REGISTER; CANCELLATION; LICENSES

A change in the name or address of the holder or his representative may be recorded in the International Register on request.

Likewise, a change in the ownership of an international registration may be recorded, in respect of all or some of the goods and services and all or some of the designated Contracting Parties. A change in the ownership may be recorded in the International Register only if the transferee is a person who fulfils the conditions (of establishment, domicile or nationality) to be the holder of an international registration.

The following may also be recorded in the International Register:

- a *limitation* of the list of goods and services in respect of **all or some** of the designated Contracting Parties;
- a *renunciation* in respect of **some** of the designated Contracting Parties for **all** the goods and services;

- a *cancellation* of the international registration in respect of **all** the designated Contracting Parties for **all or some** of the goods and services;
- a *license* granted in respect of **all or some** of the designated Contracting Parties, and for **all or some** of the goods and services.

Information concerning such changes, cancellation and licenses is published in the Gazette and notified to the designated Contracting Parties.

A trademark that is the subject of an international registration, cannot be changed either on renewal or at any other time. Nor may the list of goods and services be changed in a way that would extend the scope of protection.

DURATION OF REGISTRATION; RENEWAL

An international registration may be maintained in force indefinitely by the payment, every 10 years, of the prescribed fees. The International Bureau sends an unofficial reminder to the holder and to his representative (if any) six months before renewal is due.

The international registration may be renewed in respect of all the designated Contracting Parties or in respect of only some of them. It may not however be renewed in respect of only some of the goods and services recorded in the International Register; if therefore the holder wishes, at the time of renewal, to remove some of the goods and services from the international registration, he/she must separately request cancellation in respect of those goods and services.

ADVANTAGES OF THE MADRID SYSTEM FOR THE USERS: **CONVENIENCE-SIMPLICITY, COST-EFFECTIVENESS**

After registering the mark, or filing an application for registration, with TIDO, the applicant has to file only one application in one language (English, French or Spanish) and pay fees to one Office instead of filing separately in the trademark Offices of the various Contracting Parties in different languages and paying a separate fee in each Office.

Another important advantage for owners of marks lies in the fact that all changes subsequent to the international registration, such as a change in name and/or address of the holder, a (total or partial) change in ownership of the holder or a limitation of the list of goods and services in respect of all or some of the designated Contracting Parties, may be recorded and have effect by means of a single procedure with the International Bureau and the payment of one fee.

BENEFITS OF THE MADRID SYSTEM FOR THE TRADEMARKS AND INDUSTRIAL DESIGNS OFFICE IN EGYPT

When designated, TIDO does not need to examine for compliance with formal requirements, or classify the goods or services, or publish the trademarks. Moreover, part of the fees collected by the International Bureau is transferred to the Contracting Parties in which protection is sought. Furthermore, if the International Registration Service closes its biennial accounts with a profit, the proceeds may be divided among the Contracting Parties.

PUBLIC INFORMATION ABOUT INTERNATIONAL APPLICATIONS AND REGISTRATIONS AND REGISTERED TRADEMARKS WORLDWIDE

The following sources of information are available for anyone in need of information about the contents of the International Register, or about registered trademarks worldwide, or about a particular international application or registration, or general information about the operation of the system of international registration of trademarks:

The Gazette

The WIPO Gazette of International Marks is published every week on the Madrid System website. The Gazette contains all relevant data on new international registrations, renewals, subsequent designations and changes as well as other entries affecting international registrations. The bibliographic data is identified by the WIPO INID (“Internationally agreed Numbers for the Identification of Data”) codes, that is, the codes of Standard ST.60 (“Recommendation concerning bibliographic data relating to marks”) and Standard ST.3 (“Recommended standard two-letter code for the representation of States, other entities and international organizations issuing or registering industrial property titles”). The various codes used in the Gazette and the bibliographic data to which they relate are given in each issue of the Gazette.

The Gazette also contains information of general interest such as declarations and notifications made by Contracting Parties under the Protocol or the Regulations regarding particular requirements, the amounts of individual fees under Article 8(7) of the Protocol or information on the days on which the International Bureau is not scheduled to be open to the public. The Gazette can be accessed by Madrid Monitor (<https://www3.wipo.int/madrid/monitor/en/>).

Madrid Monitor

Madrid Monitor is a powerful search tool for trademark attorneys and agents. While every effort is made to ensure that the information in Madrid Monitor accurately reflects the data recorded in the International Register, the only official publication remains the Gazette and the only official statements by the International Bureau regarding the contents of the International Register for a

given international registration remain the certified extracts from the Register established on request by the International Bureau.

One can find in the database of the Madrid Monitor anything about the status of all international registrations in force, including data relating to international applications and subsequent designations under examination by the International Bureau. The database contains the bibliographic data of all international registrations in force and the images of marks registered, which consist of or contain special characters or figurative elements. Madrid Monitor is updated daily and is available to the public, free of charge on the Internet at

<https://www3.wipo.int/madrid/monitor/en/>.

The International Bureau improves continuously the scope of the information available to users of Madrid Monitor. To that end, where relevant, the database contains a statement in respect of the designation of each Contracting Party in an international registration to the effect that, although the time limit for the notification of a provisional refusal has expired, the International Bureau has not recorded any such notification of provisional refusal. The said statement is made available on Madrid Monitor three months after the expiry of the applicable refusal period.

In addition, digitized copies of statements of grant of protection, notifications of provisional refusal, final decisions (statements of confirmation of total refusal or statements of grant of protection following a provisional refusal), further decisions or invalidations are accessible directly by users of Madrid Monitor database in PDF format under the corresponding heading and INID code.

Extracts from the International Register

On payment of the fee prescribed in the Schedule of Fees, anyone may obtain from the International Bureau the following certified documents concerning the contents of international registrations (either in force or expired):

- The detailed extract is an analysis of the situation of an international registration. It consists of a certified copy of the international registration as originally published in the Gazette, with, as the case may be, details of any subsequent change, refusal, invalidation, statement of grant of protection, correction or renewal recorded in the International Register at the time the extract is prepared. The detailed extract is only available in the original language of the application for international registration. However, the cover page of the detailed extract can be requested in English, French, Spanish, Arabic, Chinese or Russian;
- A simple certified extract consists of certified copies of all entries that have been published in the Gazette with regard to a given international registration, together with, as the case may be, any notification of refusal of protection, invalidation or statement of grant of protection received at the time the extract is prepared. The simple certified extract is available

only in the original language of the international registration. However, the cover page of the simple extract can be requested in English, French, Spanish, Arabic, Chinese or Russian;

- An attestation certifies specific information on the current status of an international registration and/or application;
- A copy of a certificate (registration or renewal) consists of a certified copy of a certificate of registration or renewal. It can only be requested by the holder or recorded representative.

A request for an extract should indicate the number and date of the international registration with respect to which an extract is requested and the type of extract requested. The establishment of an extract may be expedited, upon request and on payment of a fee.

Global Brand Database

If a trademark conflicts with the rights of another person or business, it would be impossible to use or register it. Before filing a local or international trademark application, it is important to search for existing trademarks in the target markets, in which protection is to be sought. The Global Brand Database is the gateway to more than 46,350,000 records from some 55 national and international collections, and the first step in researching whether an identical or similar trademark to the one of the potential applicant is already protected in the target markets.

The Global Brand Database (<https://www3.wipo.int/branddb/en/>) is a simple yet powerful tool with the following features and benefits:

- 14 data-field search options, including image search;
- Easy to search U.S. or Vienna image classes by description, and browse by Nice Classification indication number;
- Automatic search suggestions; and
- Downloadable search results and records.

ONLINE SERVICES ASSISTING IN THE FILING OF APPLICATIONS AND MANAGEMENT OF INTERNATIONAL REGISTRATIONS

There are a number of useful customized tools designed by WIPO to assist the trademark applicants during each stage of their trademark's lifecycle.

The International Application Simulator

The International Application Simulator is a tool to use in order to find out if a potential applicant is eligible to use the Madrid System and check whether protection in target markets can be obtained. At the end of the simulation, it would also be possible to estimate the application costs (https://www.wipo.int/madrid/en/madrid_simulator/).

The Madrid Application Assistant

The Madrid Application Assistant is an electronic version of the official MM2 form that applicants may use to file an international application under the Madrid System. This new tool is available to applicants where the Office of origin does not offer the services of Madrid e-Filing or its own online filing solutions. The Madrid Application Assistant records all the information required to complete an international application in an intuitive and linear manner. Once completed, the international application will be made available in a PDF format ready for the applicant to submit to the Office of origin for certification. Information required to fill out the international application may be imported directly from the Office of origin's national/regional trademarks database. This not only saves time and effort, but also reduces the risk of irregularities, thus making the process of filing an international application more efficient and accurate. When using the Madrid Application Assistant, the applicant can check the list of goods and services, and have this translated automatically, by using the integrated Madrid Good and Services Manager.

The fees may be paid by using a current account opened with WIPO (https://www.wipo.int/finance/en/current_account/index.html), by bank transfer or by credit card.

The Madrid Application Assistant is available to the public, free of charge, at <https://www.wipo.int/madrid/application-assistant/>.

Madrid Goods and Services Manager

The Madrid Goods and Services (MGS) is an online tool that provides access to a database of goods and services. It assists trademark applicants in compiling the list of goods and services that must be submitted when filing an international application. The MGS provides terms from the alphabetical list of the International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Classification) as well as a much wider choice of terms that are pre-accepted by the International Bureau and many Intellectual Property Offices in the Madrid System. Using such pre-accepted terms enables applicants to avoid irregularity letters from the International Bureau.

The pre-accepted terms of goods and services are provided in the three languages of the Madrid System as well as in many other languages. The MGS enables users to obtain an instant translation of a list of goods and services from any of those languages into any other one available on the MGS. It also features a function enabling users to check whether the terms of a list of goods and services that are pre-accepted by the International Bureau will be accepted or not by some Contracting Parties of the Madrid System that they wish to designate in an international application, or subsequently, thereby enabling them to avoid provisional refusals and to prepare adequate simultaneous limitations in the international application, or in the subsequent designation.

The MGS is available to the public, free of charge, at <https://webaccess.wipo.int/mgs/>.

Member Profiles Database

The Madrid Member Profiles Database is an online tool that provides access to information concerning the laws and practices of the trademark Offices of Contracting Parties. It helps applicants to understand the rules and procedures in effect in each of the target markets of interest, including time limits to respond to a refusal or opposition, to request a review, or to file an appeal. It also assists applicants to comply with the trademark requirements in the markets of interest and understand the procedures for filing an international application through the Office of origin. The Members Profiles Database is available to the public, free of charge, at <https://www.wipo.int/madrid/memberprofiles/selectmember>.

Madrid Portfolio Manager

The Madrid Portfolio Manager is an online service that allows holders of international registrations and their representatives to access their international trademark portfolios. Trademark holders have a user account which allows them to access the International Register online and view all transactions occurring on their international registrations, in real time. The service also offers the possibility for the trademark holder to manage actions pertaining to the protection of their own international registration(s), such as changes in name and/or address of the holder, presentations of subsequent designation, renewals and payments of fees. Madrid Portfolio Manager is available to trademark holders and their representatives, free of charge, at WIPO IP Portal.

Online Renewal

It is possible to renew an international registration online in the WIPO IP Portal. The payment of renewal fees may be made by credit card or through a WIPO current account.

Online Subsequent Designation

It is possible to expand the geographical scope of an international registration online.

Online Payment

It is possible to pay fees owed with respect to international applications or registrations, as notified in WIPO irregularity letters or any other WIPO communication indicating the amount of the fees due in the relevant time limit. These payments may be made by credit card or through a WIPO current account.

Annual, Monthly and “In Progress” Statistics

The International Bureau publishes on its website, for each calendar year, a statistical report summarizing activity under the Protocol during that year. Furthermore, it also publishes statistics featuring international applications, international registrations, subsequent designations, refusals and renewals, among others, in a dynamic form on an annual, monthly and “in progress” basis. The statistical information may be selected by Office of origin, Office of the Contracting Party of the holder or by designated Contracting Party. Statistics are available at <https://www.wipo.int/madrid/statistics/?lang=en>.

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