



**ETiDOP**<sup>®</sup>

Egyptian Trademarks and Industrial  
Designs Office Project

# Guidelines on how to obtain Trademark Protection through the Madrid System





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# Introduction

- Under the international route, you can use your national trademark application to expand your protection internationally, to any country that is a signatory of the Madrid Protocol.
- The reasons to prefer the international route could be:
  - Seek protection in multiple markets, particularly if these are in different regions as part of export strategy
  - Want flexibility to add new markets as export plans are developing
  - Have limited budget and/or time to spend on registration and management of the trademarks



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# Madrid system

The Madrid system of international registration is governed by two treaties:

Madrid Agreement Concerning the International Registration of Marks, which dates from 1891, and

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.



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# Madrid system

- Following a decision in the Madrid Union Assembly in October 2016, the Agreement is now inoperative and the Protocol is 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.
- The legal framework of the Madrid System consists of the **Protocol**, the **Regulations** under the Protocol and the **Administrative Instructions**.
- The international registration system is administered by the International Bureau of the World Intellectual Property Organization, in Geneva, Switzerland.



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# Madrid system

- Egypt became party to the Madrid Agreement on July 1<sup>st</sup>, 1952 and party to Madrid Protocol on September 3<sup>rd</sup>, 2009.
- The Madrid Union currently has 108 members, covering 124 countries.
- These members represent more than 80% of world trade, with potential for expansion as membership grows.
- Last accession 24/02/2021 Pakistan. The Madrid Protocol will enter into force, with respect to Pakistan, on May 24, 2021.



# Close to 1.5 Million International Registrations



The protection of Longines trademark, registered in Switzerland in 1889 was ensured at an international level in 1893 and makes Longines the oldest trademark still valid in its original form in the international registers of the World Intellectual Property Organisation (WIPO).

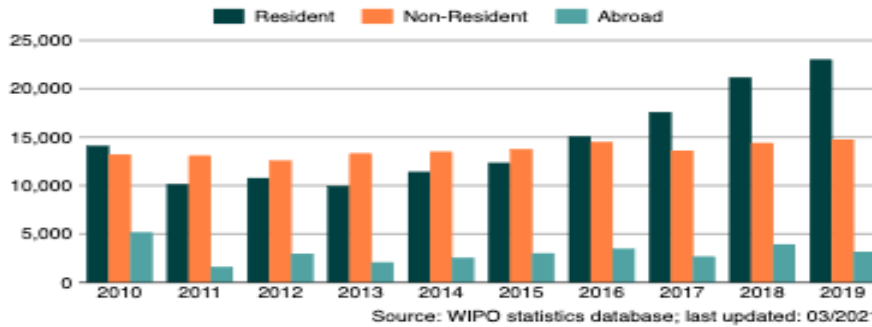


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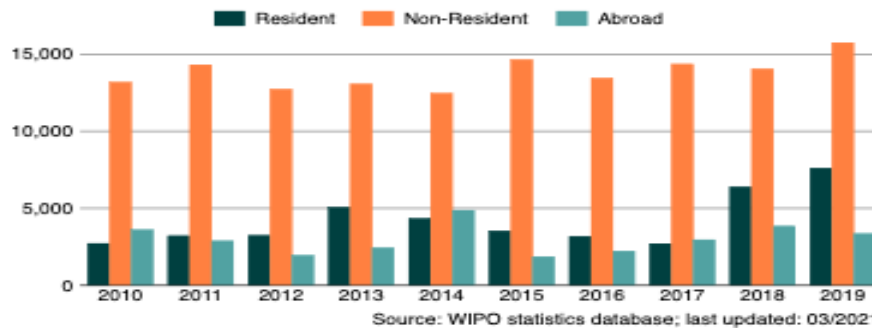


# Statistics Egypt

Trademark Application Class Count



Trademark Registration class count



Madrid Top Applicants	2020
EASTERN COMPANY S.A.E.	2
ADEL AHMED AL NEN & PARTNERS PERTAIA;FOR FOOD PRODUCTS	1
AGRO TRADE COMPANY -LIMITED LIABILITY COMPANY	1
ELMARAE ELKHADRA FOR FOOD INDUSTRIES	1
GIZA COTTON -LLC	1
GOSEPH KAMAL FAHMY	1
HUSSEIN ABBAS AHMED;& MOHAMMED HEMDAN AHMED ;HMTO FOR IMPORT , EXPORT , PACKAGING;AND DISTRIBUTION SOLIDARITY COMPANY	1
MARSEILIA EGYPTIAN GULF REAL;ESTATE INVESTMENT S.A.E	1
MEDLINK COMPANY FOR INVESTMENT AND COMMERCIAL AGENCIES	1
MILANO FOR FOOD INDUSTRIES COMPANY	1

# Key numbers for 2020

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**63,800** (-0.6%)

**Madrid international applications**

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**449,215** (+2.1%)

**Designations in international applications**

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**62,062** (-3.2%)

**Madrid international registrations**

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**55,200** (-3.2%)

**Subsequent designations in international registrations**

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**32,998** (+11.6%)

**Renewals of international registrations**

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**777,158** (+4%)

**Active (in force) international registrations**

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**6,421,100** (+2.8%)

**Designations in active international registrations**



# Key numbers for 2019

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**66,400 (+5.7%)**

**Madrid international applications**

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**433,295 (+3.2%)**

**Designations in international applications**

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**64,118 (+6.7%)**

**Madrid international registrations**

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**57,041 (+3.3%)**

**Subsequent designations in international registrations**

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**29,262 (-8%)**

**Renewals of international registrations**

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**741,619 (+4.6%)**

**Active (in force) international registrations**

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**6,208,277 (+3.3%)**

**Designations in active international registrations**



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# The use of the Nice Classification over time

- The average number of Nice classes specified in a Madrid application: 2.3 in 1990 to 2.5 in 2019.
- The majority of trademark holders have sought brand protection for marketing goods and services that generally fall into no more than two to three classes.
- The average number of words indicated by applicants in their Madrid applications has more than tripled, from around 76 in 1999 to almost 237 in 2019.
- Companies, most of which specify only a small selection of classes in their applications, have been indicating increasingly more goods or services within each Nice class.
- IP offices requiring applicants to be more specific with regard to the goods and services to be protected by a mark; and some Nice classes being vaguer than others, thereby necessitating a more detailed list of words



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## The use of the Nice Classification over time

- Since 1990, demand for trademark **protection for goods covered by class 9** has exceeded that for the goods and services covered by any other Nice class.
- 
- This reflects the importance that many companies operating in numerous industries place on protecting their brands **as they relate to computer hardware, software and electronic devices.**



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# Highlights of statistics on Madrid Applications

- Applicants filed an estimated **64,400 international trademark applications under the Madrid System in 2019**. This is an increase of almost 3,500 on the previous year, resulting in annual **growth of 5.7%** and marking a **10th year of uninterrupted expansion**.
- Trademark holders filed an estimated 63,800 Madrid applications in 2020, only about 370 fewer than in the previous year, resulting in an annual decrease of 0.6% and representing the first dip in applications since 2009 during the global financial crisis.



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# Highlights of statistics on Madrid Applications

- Recording double-digit growth for the second year in a row, applicants based in the U.S. continued to top the list of origins with the greatest number of international applications filed via the Madrid System. A strong year-on-year growth of 14.3% resulted from the estimated 10,087 Madrid applications filed by U.S.-based applicants in 2019. This was followed by applications from Germany (7,700), China (6,339), France (4,437) and Switzerland (3,729).
- Despite one-year declines, applicants based in the United States of America (U.S.) (10,005) and Germany (7,334) continued to file the highest numbers of Madrid applications in 2020 (figure 2). They were followed by those located in China (7,075), France (3,716) and the United Kingdom (U.K.) (3,679). From among the top 10 origins, China (+16.4%) is the only one to have recorded double-digit growth in 2020





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# Madrid Top Applicants in 2019

- With 189 Madrid applications, French personal care and cosmetics company L'Oréal was the top applicant in 2019,
- followed by pharmaceutical company Novartis AG of Switzerland (135),
- technology company Huawei Technologies of China (131) and
- research and advisory company NirSan Connect of India (124).
- This is the first year that applicants based in middle-income Asian countries have appeared among the top five applicants, which prior to 2019 had primarily consisted of European companies.





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# Madrid Top Applicants in 2020

- With 233 Madrid applications, Swiss pharmaceutical company Novartis AG was the top applicant in 2020. WIPO received 104 more applications from Novartis in 2020 than it did in 2019, elevating the company from third position to top spot.
- Novartis AG was followed by Huawei Technologies of China (197),
- Shiseido Company of Japan (130), which produces personal care products,
- Gaming company ADP Gauselmann of Germany (123),
- and French personal care company L'Oréal (115). L'Oréal – the top filer in 2019 – fell to fifth position, filing 78 fewer applications in 2020.
- Thirteen of the top 20 applicants in 2020 were companies based in Europe, three more than in 2019. Four were from Asia, down from six the previous year, and three from North America, which were the technology companies Apple and Microsoft and sporting goods retailer CWI.



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# Most designations in Madrid applications in 2019

- For the third year in a row, the **EU (27,102)**
- followed by **China (24,423)** and
- the **U.S. (23,851)**
- Like China, **nine of the top 20 designated Madrid members were middle-income countries**, notably India (12,414), Mexico (10,715), the Russian Federation (16,090) and Turkey (8,996).
- **U.K. saw the biggest surge in annual growth of 36.4%**, almost 9 percentage points more than its increase in 2018 and occurring during the lead-up to Brexit.
- In addition to the U.K., top designated Madrid members **Indonesia (+20.3%) and Thailand (+13.2)** also saw **double-digit annual increases** in designations received. In contrast, eight of the top Madrid members received fewer designations in Madrid applications in 2019 than they had in 2018, with India (–3.3%) and Turkey (–3.2%) recording the steepest declines.



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# Most designations in Madrid applications in 2020

- For a fifth consecutive year, the 20 most designated Madrid members, combined, received over 60% of all designations made in Madrid applications filed in 2020.
- Including China, nine of the top 20 designated Madrid members were middle-income countries, notably Brazil (9,487), India (12,157), Mexico (10,837), the Russian Federation (15,545) and Turkey (9,000).
- Among the top destinations for international trademark registration via the Madrid System, the U.K. saw the biggest surge in annual growth of 26.2% during the lead-up to Brexit. In fact, the U.K. jumped from the eighth most designated Madrid member in 2019 to fourth spot in 2020, ahead of top designated members Australia, Japan, the Russian Federation and Switzerland, among others.
- In contrast, three-quarters of the top 20 destinations for designations saw one-year decreases, with China (-8.7%), the Republic of Korea (-5.4%) and the Russian Federation (-5%) recording the steepest declines. Canada, which joined the Madrid System in 2019, became the fifth-ranked top recipient of designations in 2020

# How the Madrid system works?







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# Brief description of the stages- Stage 1

## Stage 1 – Application through your National or Regional IP Office (Office of origin)

Before you can file an international application, you need to have already registered, or have filed an application, in your “home” IP office. The registration or application is known as the **basic mark**. You then need to submit your international application through this same IP Office, which will certify and forward it to WIPO.



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# Brief description of the stages-

## Stage 2

### Stage 2 – Formal examination by WIPO

- WIPO only conducts a formal examination of your international application. Once approved, your mark is recorded in the International Register and published in the WIPO Gazette of International Marks. WIPO will then send you a certificate of your international registration and notify the IP Offices in all the territories where you wish to have your mark protected.
- It is important to note that the scope of protection of an international registration is not known at this stage in the process. It is only determined after substantive examination and decision by the IP Offices in the territories in which you seek protection, as outlined in Stage 3.





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# Brief description of the stages- Stage 3

## **Stage 3 – Substantive examination by National or Regional IP Offices (Office of the designated Contracting Party)**

- The IP Offices of the territories where you want to protect your mark will make a decision within the applicable time limit (12 or 18 months) in accordance with their legislation. WIPO will record the decisions of the IP Offices in the International Register and then notify you.
- If an IP Office refuses to protect your mark, either totally or partially, this decision will not affect the decisions of other IP Offices. You can contest a refusal decision directly before the IP Office concerned in accordance with its legislation. If an IP Office accepts to protect your mark, it will issue a statement of grant of protection.



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# Who may use the Madrid system?

The Madrid System may be used only by a **natural person** or a **legal entity** which has a **real and effective industrial or commercial establishment in**, or is **domiciled in**, or is a **national of**, a country which is party to the Protocol, or which has such an establishment in, or is domiciled in, the territory of an intergovernmental organization which is a party to the Protocol or is a national of a member State of such an organization.



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# Who may use the Madrid system?

- The Office of the Contracting Party 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 mark may be the subject of an international registration, if it has been registered, or if its registration has been applied for in the Office of origin.
- An application for international registration must designate one or more Contracting Parties in which the mark is to be protected. It cannot designate the Contracting Party of the Office of origin.
- Contracting Parties may also be designated subsequently.
- The Madrid System cannot be used by a person or entity which does not have the necessary connection, through establishment, domicile or nationality, with a member of the Madrid Union. Furthermore, it cannot be used to protect a trademark outside the Madrid Union.



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# International application

- An international application must be presented to the International Bureau through the 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 contain, *inter alia*, a reproduction of the mark (which must be identical with that in the basic registration or basic application) and a list of the goods and services for which protection is sought, classified in accordance with the International Classification of Goods and Services (Nice Classification).





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# Basic mark requirement

- The Madrid System is founded on the **requirement of a basic national or regional registration or application for registration**. An international application may be based on either a registration with the Office of origin (basic registration) or on an application for registration filed with that Office (basic application). The international application may relate only to goods and services covered by the basic mark.
- In most cases, the international application will be based on a single registration or application, which covers the goods and services listed in the international application. It is, however, **possible to base an international application on several applications and/or registrations under the Protocol, which together cover the goods and services to which the international application relates**. The basic marks must all be in the name of the person filing the international application and must have been made with the same Office.



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# Priority claimed in an international application

Priority of an earlier filing may be claimed under Article 4 of the Paris Convention. That earlier filing will normally be the basic application or the application which resulted in the basic registration. However, it may also be:

- another application made either in a country party to the Paris Convention or in a member of the World Trade Organization (WTO) even if the latter is not a party to the Paris Convention; or
- an application which, under a bilateral or multilateral treaty concluded between countries of the Paris Union, is equivalent to a regular national filing.





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# Priority claimed in an international application

- Where priority is claimed, **the applicant must indicate the name of the national or regional Office** with which the earlier filing was made, together with **the date of filing** and (where available) **the number of the application**. No copy of the earlier filing is needed.
- Where the earlier filing does not relate to all of the goods and services listed in the international application form, the **applicant should indicate the goods and services to which the earlier filing relates**.
- Where several earlier filings with different dates are indicated, the goods and services to which each relates should be indicated.



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# Fees due

- Fees payable for an international application are:
  - **a basic fee** (903 Swiss francs – if color reproduction of mark ; 653 Swiss francs – if b/w reproduction of mark);
  - **a complementary fee in respect of each designated Contracting Party for which no individual fee is payable;** (300 Swiss francs Standard fees – complementary (100 Swiss francs per dCP))
  - **a supplementary fee in respect of each class of goods and services beyond the third** (100 Swiss francs per class beyond 3).
- The amounts of the basic, complementary and supplementary fees are set out in the Schedule of Fees.
- 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 available on this website (<https://www.wipo.int/madrid/feescalculator/>).



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# What Office must certify?

- The Office of origin must certify that **the mark is the same as that in the basic registration or basic application**, that any indications such as a description of the mark or a claim to color as a distinctive feature of the mark are the same as those contained in the basic registration or basic application, and that **the goods and services indicated in the international application are covered by the list of goods and services in the basic registration or basic application**.
- The Office of origin must also certify **the date on which it received the request to present the international application**. This date is important; provided the application is received by the International Bureau within two months of that date (and provided that certain crucial elements are not missing), it is that date that will be the date of the international registration.



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# Registration, Notification and Publication

- The International Bureau checks that the international application complies with the requirements of the Agreement or Protocol and the Common Regulations, including requirements relating to the indication of goods and services and their classification, and that the required fees have been paid.
- The Office of origin and the applicant are informed of any irregularities; these must be remedied within three months, otherwise the application will be considered abandoned.
- Where the international application complies with the applicable requirements, the mark is recorded in the International Register and published in the Gazette. The International Bureau then notifies each Contracting Party in which protection has been requested.





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# Examination by the Office of a Designated Contracting Party; Refusal of Protection

- Each designated Contracting Party has the right to refuse the protection of the international registration in its territory. Such refusal may be based on any grounds that are supported by a provision of the Paris Convention, or that are not prohibited by a provision of that Convention, and any such refusal will generally be subject to review or appeal, depending upon the laws and practice of the Contracting Party concerned.
- If grounds for objection are found during the *ex officio* examination, or if an opposition is filed, the Office has the right to declare that protection cannot be granted to the mark in that Contracting Party.



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# Notification of provisional Refusal of Protection

- Any provisional refusal must be notified to the International Bureau by the Office of the Contracting Party concerned within the time limit specified in the Agreement or Protocol. This 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.





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# Procedure subsequent to the refusal

- 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. Depending upon the outcome of the case, such statement will confirm either that protection for the mark has been totally refused (*Confirmation of Total Provisional Refusal*), or that protection has been partially or totally granted to the mark, as the case may be (*Statement of Grant of Protection Following a Provisional Refusal*). This statement is recorded in the International Register, published in the Gazette and a copy is transmitted to the holder of the international registration.



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## *Statement of Grant of Protection where no Notification of Provisional Refusal has been Communicated*

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.



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# 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 mark in each of the designated Contracting Parties is the same as if the mark 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.



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# Effects of the International Registration

- 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.
- This is in contrast to a unitary regional right such as the European Union trademark, which cannot be refused, limited or transferred with effect for only a part of the territory covered by the right, and which may be enforced by a single legal action covering infringement occurring anywhere in that territory.





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## Dependence on the Basic Mark

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 the Office of origin.

If, and to the extent that, the basic registration ceases to have effect, whether through cancellation following a decision of the Office of origin 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 the Office of origin, it will be cancelled 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.





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# Dependence on the Basic Mark

- The Office of origin 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 Contracting Parties.
- If, within three months of such cancellation, the holder files an application for registration with the Office of a designated Contracting Party, 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 Contracting Party concerned.
- After the expiry of the period of five years, the international registration becomes independent of the basic registration or basic application.



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# 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 mark 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.



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## Subsequent Designation

- The effects of an international registration can be extended to a Contracting Party not covered by the international application by filing a subsequent designation.
- Thus, the holder of an international registration can expand the geographical scope of the protection of his mark 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.



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# Changes in the international Register

- 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 fulfills the conditions (of establishment, domicile or nationality) to be the holder of an international registration above.





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# Changes in the international Register

- 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.





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# Changes in the international Register

- Information concerning such changes, cancellation and licenses is published in the Gazette and notified to the designated Contracting Parties.
- No change may be made in the mark that is the subject of an international registration, 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.



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## Duration of Registration; Renewal

- An international registration is effective for 10 years. It may be renewed for further periods of 10 years on payment 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 must separately request cancellation in respect of those goods and services.



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# Advantages of Madrid system: convenience-simplicity, cost-effectiveness

After registering the mark, or filing an application for registration, with the Office of origin, 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.



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# Advantages of Madrid system: convenience-simplicity, cost-effectiveness

**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.**





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# Advantages of Madrid system: convenience-simplicity, cost-effectiveness

International registration is also to the advantage of trademark Offices.

- For example, when designated, **Offices do not need to examine for compliance with formal requirements, or classify the goods or services, or publish the marks.**
- 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.





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# Conclusions

- Small and Medium Enterprises (SMEs) are most affected by the considerable cost involved in registering and maintaining marks abroad.
- While a large company may afford to devote considerable funds to protect its marks abroad, an SME can ill-afford the registration of marks abroad, due to the high procedural costs.
- The Madrid system is used by one-third of worldwide applicants seeking protection of their marks through the Madrid system. Of these, about 80 per cent may be categorized as an SME, having a small portfolio of one or two marks.



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# Conclusions

- Finally, the Madrid system supports the country's exports to the extent that it simplifies protecting trademarks abroad.
- Furthermore, the facility for individuals and companies to seek protection of the mark in any of the applicable Contracting Parties by merely designating these in the international application, or in a subsequent designation, helps to strengthen the climate for foreign investment.