

INTA's Position on the Madrid System for the International Registration of Marks

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What is the Madrid System?

Centralized system to:

- File applications
- Modify ownership
- Renew Trademark Registrations
- Expand global Trademark Portfolio

Who can use the Madrid System?

Individuals and Companies

Either:

- a. be domiciled:
- b. have an industrial or commercial establishment in: or
- c. be a citizen

Of one of the 117 covered by the Madrid System's 101 members.

INTA's Position

INTA strongly supports and encourages governments of WIPO member countries to take all actions necessary to adhere to the Madrid Protocol.

American Countries Already Adhered to Madrid

- Cuba (1989 MA – 1995 MP)
- United States of America (2003 MP)
- Colombia (2012 MP)
- Mexico (2013 MP)

Challenges that must be Addressed prior to Adhering to Madrid

The Association encourages countries to optimize their trademark office operations under the harmonized registration procedures with two main purposes:

1. Reduce burdens for local and international trademark owners; and
2. Reduce costs

The Mexican Experience, 5 years after Joining Madrid

The following facts (among others) should be taken into account when deciding which way to go:

- Whether immediate protection is required.
- Importance of the specific market.
- Possibilities/willing to expand the business in the mid-long term; and
- Budget limitations.

Two Ways to apply for Trademark Protection in Mexico

- A. Through the National System; and
 - B. Through the Madrid System (available since February 19, 2013).
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- There are a few practical and legal issues to consider prior to choosing which venuee to use.

Practical Issues.

Three Particularities of Mexican System

1. Mexican Industrial Property Law (IPL) does not allow for multi-class applications;
2. Acceptance of identifications of goods and services by the TMO is certainly formalistic;
3. Mexican IPL still requires to appoint an attorney/agent for service within the Mexican territory.

Advantages / Disadvantages

1. Multi-class system

National System	Madrid System
<p>An application per class must be filed since the beginning, and each application will be prosecuted under a different serial number, subject to an individual examination and either registered or refused independently per each class.</p>	<ul style="list-style-type: none">• The IR is filed covering several classes.• Once it reaches into a National Stage, it splits into individual national applications.• Prosecution, examination and granting or refusal will occur as in the national system.

Advantages / Disadvantages

2. Rigid criteria for acceptance of identifications of goods and services

National System	Madrid System
<ul style="list-style-type: none">• The ID of goods and services can be reviewed by the local agent prior to filing, being possible to avoid objections during prosecution based on its experience of Mexican practice.	<ul style="list-style-type: none">• Objections to ID of goods and services may arise despite such ID's have been already accepted by WIPO.

Advantages / Disadvantages

3. Need to appoint an attorney/agent for service within the Mexican Territory

National System	Madrid System
<ul style="list-style-type: none">• This is done at the time of filing the application, as it is a legal requirement.• Any cancellation/invalidation action against the achieved registration will be served to the appointed agent for service.	<ul style="list-style-type: none">• Under Madrid system, a local representative will be appointed only in those cases where a provisional refusal is issued, at the time a response is filed.• In all other cases, any cancellation/invalidation action against the achieved registration will be served through a publication in the Official Gazette and a national newspaper, being very difficult to detect.

Important Legal Issues

Date of first use of the Mark
in Mexico

Important Legal Issues

Use declaration for
Renewal purposes

Important Legal Issues

Formalities for recording
changes in ownership



Thank You

www.olivares.mx

Alonso Camargo

alonso.camargo@olivares.mx

+52 55 5322 3000



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Association