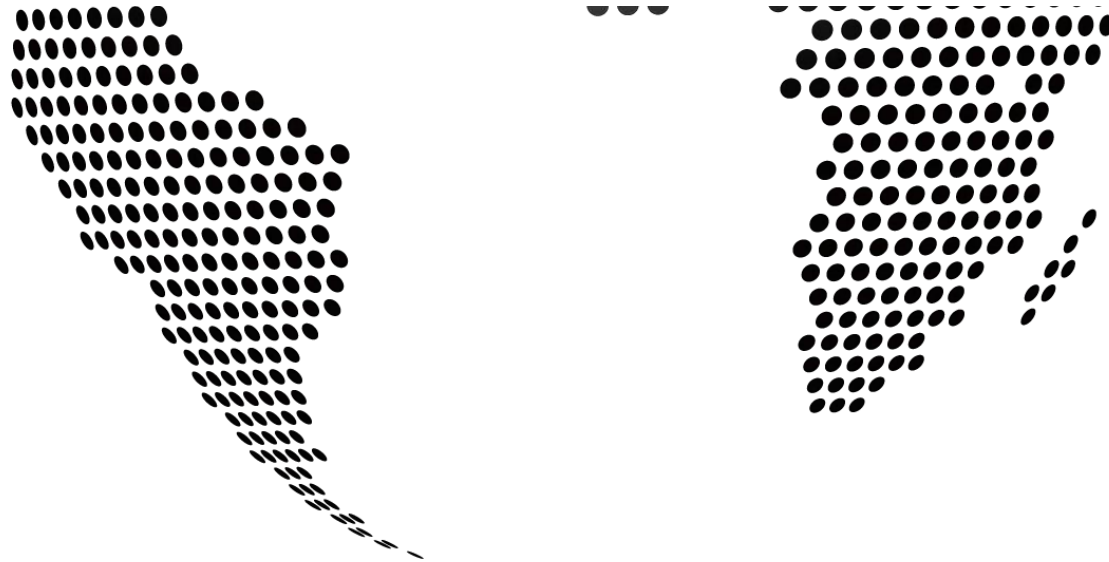


MADRID PROTOCOL

A ROUTE TO GLOBAL BRANDING



OVERVIEW OF MADRID SYSTEM

- Malaysia acceded to the Madrid Protocol on 27 December 2019
 - ☐ Malaysia is the 106th member
 - ☐ The Madrid System is in force in Malaysia beginning on 27 December 2019
 - ☐ Fellow Malaysians now have access to get protection in 122 countries / export markets
- Beginning on 27 December 2019, Malaysia can act as:
 - ☐ The Office of Origin
 - → Malaysian can now designate other countries (exporting market) through Malaysia
 - ☐ Designated Contracting Party
 - → Other international holders can designate Malaysia to obtain protection in Malaysia

OVERVIEW OF MADRID SYSTEM

- This Madrid System replaces the old practice of obtaining
 - protection in Malaysia by international application:
 - ☐ National route
 - ✓ 100% - until 26 December 2019
 - ✓ Optional – beginning 27 December 2019
 - ☐ Madrid System/Route
 - ✓ Optional – beginning 27 December 2019

ADVANTAGES FOR THE TRADE MARK OWNER

- One application, one language, one currency
- Designate all possible members (except Malaysia)
- One Madrid application = bundle of national rights
- One international registration with one renewal date
- Easy management of portfolio

AT THE OFFICE OF ORIGIN

(FROM MYIPO - OUTBOUND TO WIPO)

PREPARING AND FILING INTERNATIONAL APPLICATION

- Shall be filed with WIPO through the Office of Origin (MyIPO)

✓ TMMP1

✓ MM2

Must mirror the basic mark—

- ☐ same applicant, same mark; and
- ☐ the G&S must be within the scope of the basic mark

- Refer: Reg. 62 of TMR 2019

FEES

- Handling fee (TMMP 1) is payable to the Office of Origin (Refer: Reg. 61(6))
 - Fees for IA/IR are payable to WIPO in Swiss Francs –
 - Basic fee
 - Fees for designating DCPs
 - ☐ Standard fees (complementary + supplementary); or
 - ☐ Individual fees, which is opted/declared by Office of Origin
-
- Fee calculator available at:
 - www.wipo.int/madrid/en/fees/calculator.jsp

Common irregularities and remedies during application and registration

- 3 categories of irregularities
 - Rule 11
 - Rule 12
 - Rule 13
- IB will inform the OO and the Applicant
 - Inform of the irregularity
 - Explain how to remedy the irregularity
 - Provide a time limit (3 months) to remedy, and
 - Specify who needs to respond (either the OO or the applicant)

MyIPO consultation, service support to SMEs

- Dedicated team to advise on related procedures
- Training to new users of Madrid Via virtual platform
- Working and collaborating directly with the business association.

TIPS

- **For the applicant who doesn't have the basic mark**

1. **Application For Preliminary Advice And Search (TMA1)**
2. **Request For Expedited Examination (TMA4)**
3. **Make full use of the MGS ...**

- **For The applicant who wants to file abroad**

1. **Study the country profile of the potential designated countries : to avoid PR**
2. **Familiarize and make use of the global brand database to search any possible conflicting marks before filing**

Thank you

for your attention!