



Promoting Intellectual
Property Rights in the
ASEAN Region

Madrid Protocol Operations: Where Applicants Have Difficulties

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AGENDA

1. The Madrid Protocol from the perspective of the Applicant
2. Common issues experienced by Applicants during application, registration and maintenance of an IR
3. Solutions and strategies

Why Applicants Choose to Use the Madrid Protocol

- Cost – filing and post-registration
- Ease of administration
- Subsequent Designations

Applicants' Misgivings about using the Madrid Protocol

- Central attack
- Entitlement to file
- Subsequent freedom to deal with registration
- Registration certificates

Pre-filing Preparations

- **Business considerations are the starting point. Some issues to be considered:**
 - ❖ Holding entity (the Applicant)
 - ❖ Business development plans (IPOs, licensing deals, joint ventures, etc)
- **Pre-filing searches are important for International Applications**
 - ❖ Pre-filing searches in the countries of interest assist in developing a comprehensive filing strategy
 - ❖ Searches help ascertain: (i) inherent registrability; (ii) prior conflicting marks; (iii) if a mark is undesirable according to public policy; (iv) acceptability of intended indication of goods and services
 - ❖ The mark, the indication of goods and services, and even whether to designate a particular Contracting Party, may be adjusted once pre-filing searches have been carried out.

Additional Emphasis on the Basic Application

- The dependence of the International Application on the Basic Application makes a pre-filing search critical for the Basic Application
- Preparing the Basic Application so that it proceeds to registration quickly is important

- WIPO resources: Madrid e-services: Global Brand Database

International Application (MM2) Irregularities

- Rule 11: Other irregularities
- Rule 12: Classification of Goods and Services
- Rule 13: Indication of Goods and Services

Rule 11 Irregularities

To be remedied by OO:

- Official form not used
- Entitlement issues found
- Date or number of the basic application or registration is missing
- Certification is irregular
- Signature of the Office is missing
- Insufficient fees, where Office collects and forwards fees
- Form MM18 is missing

To be remedied by the Applicant:

- Address is insufficient for postal delivery
- Reproduction of the mark is not clear
- Transliteration of the mark is missing
- Description of the mark is in a non-working language
- Insufficient fees, where paid directly by applicant
- Form MM18 is missing

MM2 Irregularities from a Practitioner's standpoint

Often-seen irregularities or omissions in the MM2:

- E-mail address of Applicant (as of 1 February 2021)
- MM18 missing
- Errors in the calculation of filing fees
- Indication that the mark is in standard characters

WIPO resources:

- Madrid Application Assistant (<https://efiling.madrid.wipo.int/application-assistant/>)
- Fee calculator (<https://madrid.wipo.int/feecalapp/>)
- International Application Simulator
(https://www.wipo.int/madrid/en/madrid_simulator/)

Rules 12 and 13 Irregularities

- Rule 12: Classification of Goods and Services
- Rule 13: Indication of Goods and Services
- WIPO issues over 3 times as many Rule 13 irregularity notices than Rule 12 notices (based on 2015 – 2019 data)

Resources:

- WIPO's Examination Guidelines Concerning the Classification of Goods and Services in International Applications under the Madrid System
(https://www.wipo.int/export/sites/www/madrid/en/pdf/madrid_examination_guidelines.pdf)
- WIPO's Madrid Goods & Services Manager
(<https://webaccess.wipo.int/mgs/index.jsp?lang=en>)
- EUIPO's Harmonised Database (<https://euipo.europa.eu/ohimportal/en/harmonised-database>)

Post-registration Management

- Administrative management (e.g. change of name and/or address; renewal; etc)
- Commercial management (e.g. transactional activities like licenses and assignments; ensuring that the trademark portfolio reflects business activity)
- The impact of third party rights on the trademark portfolio (e.g. third party claims of infringement; invalidation actions)

Applicants have difficulties with:

- Scope
- Office of origin vs IB
- Differences in domestic practices of Contracting Parties



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