



The Madrid System

What is the Madrid System?

The Madrid System is a centralised system for the international registration of trade marks. It allows trade mark owners to apply for registration of their mark in a number of jurisdictions simultaneously via a single, central trade mark application to the World Intellectual Property Organisation (WIPO). The application (the “international trade mark application”) is then passed on to the national Trade Mark Offices of the designated jurisdictions.

What are the advantages of filing an international “Madrid” application?

There are a number of advantages to filing a “Madrid” trade mark application:

- it may be more cost-effective than filing national applications separately in several different jurisdictions;
- we can act directly for you provided that no objections are raised – this usually results in a significant cost-saving as it avoids the need for us to instruct local attorneys in each jurisdiction;
- it can be a quicker route to registration in some countries, as each member state is obliged to work to strict time-lines;
- actions such as recording changes of ownership and payment of renewal fees can be dealt with centrally resulting in cost savings; and
- additional jurisdictions can be designated at a later stage.

Important Note:

Whilst there are many potential advantages to utilising the Madrid System for registering a trade mark, it will not result in a “worldwide” trade mark registration and will only have effect in the specific jurisdictions that are designated in the application.



How do I apply for an international trade mark under the Madrid System?

You would firstly need to file a 'home' trade mark application, typically an EU, UK or Irish application. Then, we would file an international "Madrid" application at WIPO, designating the jurisdictions that you wish the application to cover.

WIPO will carry out a basic formalities examination where they will check that your mark meets certain formal requirements, for example that the mark has been presented in the correct format, and that goods and services have been classified correctly. Once this has been completed, an "International Registration Certificate" will issue and WIPO will transmit your application to each of the local Trade Mark Offices in the designated jurisdictions.

Each jurisdiction will then individually examine your application according to local law and practice. Objections to registration in a particular jurisdiction may arise if, for example: there are existing rights for a confusingly similar mark in that country; your mark is not considered to be sufficiently distinctive for registration; or the exact wording of the goods and services of the application do not meet particular local requirements, etc.

The designated jurisdictions have 12-18 months to notify any refusal to WIPO, or else issue confirmation of protection of the trade mark. If a notification of refusal is issued, it is usually necessary to appoint a local agent to file a response to try and overcome it. Or alternatively, the designation can be allowed to lapse.

What official fees apply when filing an international "Madrid" application?

When filing an international trade mark application a number of official fees are payable: there is an application fee payable to WIPO; a transmission fee payable to the Office of your 'home' registration; plus an additional fee for each designated jurisdiction. The fees can vary quite significantly depending on the jurisdiction but filing via the international "Madrid" route will often result in cost savings (compared to filing separate national applications).



Are there any disadvantages of filing an international “Madrid” application?

A particular disadvantage of using the Madrid system is that if your ‘home’ registration ceases to have effect within 5 years of the date of the international registration, the international registration will also be cancelled. This is known as “central attack” and whilst not very common, may be a consideration if you are aware of a particular cancellation risk against your ‘home’ registration (for example, an ongoing trade mark conflict with a third party). In this circumstance it is possible to file separate national/regional applications having the same coverage and claiming the filing date of the international registration, but this will incur further costs.

Would I have the same protection with a registration under the Madrid System as a national/regional registration?

Yes, ultimately a granted registration in a jurisdiction obtained directly via the national/regional route, and a granted registration obtained in that jurisdiction via an international “Madrid” application would have the same protection.

Which jurisdictions are part of the Madrid System?

An up-to-date list of all contracting parties can be accessed at:

https://www.wipo.int/export/sites/www/treaties/en/documents/pdf/madrid_marks.pdf