

# Madrid System in Portugal – an overview

Ficpi Vienna Open Forum 2019

António Corte-Real



# **An overview of the Madrid System in Portugal**

## **Outline**

1. Brief historic note
2. Practical operation of the Madrid system
3. Main advantages of Madrid Protocol
4. Challenging issues / uncertainties

## Madrid System - landmarks Portugal

**1893** – Portugal signs on October 31 - Madrid Agreement Concerning the International Registration of Marks (1891)

National law recognition of **International Trademarks**:

- Industrial Property Regulation, 1895
- IP Law, 1938
- IP Codes 1940, 1995, 2003

Oldest IR from PT alive: 130727, **OFFLEY**, 30.04.1947

Oldest designation PT alive: 130283, **ELSOL**, 27.03.1947

Source: WIPO Madrid Monitor



## Madrid System - landmarks Portugal

**1997** – Portugal joins the Madrid Protocol (1989) on 20 Mar.

**2004** – European Union joins the Madrid Protocol on 1 Oct.

**2008** – Repeal of “safeguard clause” takes effect on 1 Sep

## Practical operation of Madrid System – two different periods

- **Madrid Agreement period (since 1895 until 1997)**
- **Protocol period (since 1997)**

	<u>Source: Madrid Monitor database</u>
1977 to 1997 (Agreement)	IR designations PT: <b>78930</b> IR origin PT: <b>446</b>
1997 to 2017 (Protocol)	IR designations PT: <b>82440</b> IR origin PT: <b>4211</b>

## Practical operation of Madrid System – two different periods

- **Madrid Agreement period** (until 1997) – “not interesting”
  - Unbalanced residents / non-residents
  - Priority claim problem for applicants from Portugal
  - National TM was seen as less cost efficient than International TM
    - Single class v. Multiclass (basic filing fee for 3 classes)
    - Duration: 10 years v. 20 years

## Practical operation of Madrid system

### ▪ Madrid Agreement period

Amendments to national law over the years

1980 Declaration of Intention to Use (Decree Law 176/80, 30 May 1980)

- *Bringing effectiveness to the use obligation by removing non-used marks from the Register*
- Periodical obligation, filing DIU 5 years after registration or renewal
- If not filed: presumption of non-use; need to file evidence of use.
- Ex officio cancellation or upon request
- Revoked in 2008

## Practical operation of Madrid system

### ▪ Madrid Agreement period

Amendments to national law over the years

#### 1995 Special expedited national application

- Registered basic mark required by M. Agreement
- Smaller opposition period, expedited examination
- Granting in 4-5 months
- Cancellation if applicant does not apply for IR
- Revoked in 2003



## Practical operation of Madrid system

- **Madrid Protocol period (since 1997)**
  - Innovations introduced by Madrid protocol: expand international system
  - No need for basic “registration”
  - 18 months for refusal (instead of 12 months)
  - Individual fee system
  - Softens dependency/central attack provision: transformation

## Protocol – main advantages for multi jurisdiction registration of trademarks

- **Wide territorial coverage** (105 members, 121 countries)
  - Covers world top 20 economies, including US, CN, EU, etc.
  - Much wider than Madrid Agreement (55 members only)
  - Expanding geographical coverage
  - Flexibility

## Protocol – main advantages

- **Cost savings**
  - Costs involved in national representation and national official fees
  - Potential costs with translation of list of G/S
  - Potential costs with granting fees and certificates of registration
  - Costs with renewals and post-registration recordals

## Protocol – main advantages

- **Simplicity**
  - Filing formalities
  - Electronic tools WIPO
  - Centralized registration management

## Protocol – challenging issues

- **Pre-application issues**
  - Estimation of costs, Fee calculator
  - Country individual fees
  - Basic mark

## Protocol – challenging issues / uncertainties

- **Post-filing issues**

- Certificate of International Registration; statements of grant
- Deadlines for dealing with notifications
- Dependency and Central Attack

## Protocol – challenging issues / uncertainties

- **...post-filing issues**
  - Use related obligations (DIU in some countries)
  - Renewal notices
  - Changes in national laws

## Final word

- **Essential tool for multi jurisdiction registration**
- **Filing and maintenance**
- **Professional approach changes**
- **Alternative and competing registration procedure**