Madrid System in Portugal – an overview

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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


**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)

<table>
<thead>
<tr>
<th>Period</th>
<th>IR designations PT:</th>
<th>IR origin PT:</th>
</tr>
</thead>
<tbody>
<tr>
<td>1977 to 1997 (Agreement)</td>
<td>78930</td>
<td>446</td>
</tr>
<tr>
<td>1997 to 2017 (Protocol)</td>
<td>82440</td>
<td>4211</td>
</tr>
</tbody>
</table>

Source: Madrid Monitor database
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