



Madrid Protocol in Brazil

May 8, 2018

The United States joined the Madrid Protocol in 2003

GE played a pivotal role in lobbying for the US accession to the Protocol and was an early user of the Madrid system



GE Statistics

Total Portfolio Size:

➤ 17,245

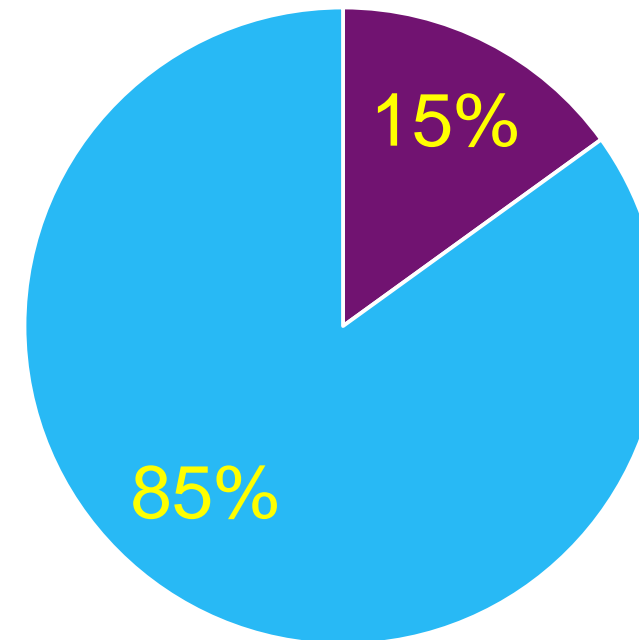
Madrid Portfolio:

➤ 2,594 registrations (extensions of protection) through 336 International Applications

National Registrations:

➤ 14,651 national registrations and applications

Total Portfolio



■ Madrid ■ National

Countries that recently joined Madrid:

- **Colombia:** 159 applications and registrations. Filed 21 applications since Colombia's adherence in 2012 with 16 filings through Madrid.
- **Mexico:** 505 applications and registrations. Filed 133 applications since Mexico's adherence in 2013 with 73 filings through Madrid.

Filing Considerations

Five-Year Dependency Period:

- ❖ Any potential issues identified in clearance searches?
 - ❖ Transformation is possible
 - ❖ Pending proposal to shorten the dependency period to 3 years

Specimen Issues – ITU Applications:

- ❖ Any potential issues with obtaining a proper specimen within a statutory period in the US – e.g. goods with long production cycle/highly specialized goods

Mark's Status:

- ❖ Is it an established mark or new mark?
- ❖ Incontestable?
- ❖ Any potential issues with proving use in the US?

Identification of Goods:

- ❖ A highly-specialized product with a unique description? (e.g. need to use standard descriptions in certain countries such as China)
- ❖ Better to use broader/more general descriptions in some countries?

Cost Comparison Hypothetical

A budget of **\$5,000** can provide the following coverage for one mark in one class:

National Applications:

- EU
- China
- Japan
- India
- Russia

Filing through Madrid Protocol:

- EU
- China
- Japan
- Australia
- Colombia
- South Korea
- Indonesia
- Israel
- India
- Russia
- Kazakhstan
- Vietnam
- Philippines
- Egypt
- Sudan
- Zambia
- Mongolia
- Morocco
- Namibia
- Serbia
- Singapore
- Turkey
- Mexico

Law Firm Considerations

Incoming Applications:

- Office Actions
- Oppositions
- Increase in overall incoming volume due to more filings

Outgoing Applications:

- Direct portfolio management for international filings, with broader coverage
- New stream of work (e.g. notices of irregularity from WIPO)
- Opportunity to offer cost savings to domestic clients, which resonates with GC's and company leadership

