

# THE MADRID PROTOCOL

A single trademark registration  
supports regional economic  
integration

– A Case Study –



ASEAN-Australia-New Zealand Free Trade Area (AANZFTA)  
Economic Cooperation Support Program (AECSP)

## The Madrid Protocol: Protecting brands globally

The Madrid System for the International Registration of Marks is governed by the Madrid Agreement Concerning the International Registration Marks (into force in 1891), and the Protocol Relating to that Agreement (or **The Madrid Protocol**), entered into force in 1989. The Madrid Protocol is a system for international registration of a trademark (across multiple countries) in just one application. It allows an applicant to file a single application, in one language, through one national or regional IP Office instead of filing applications in each country where protection is sought.

The Madrid Protocol facilitates international protection of a trademark. Trademark applications<sup>i</sup> reflect enterprises seeking to create global brands and protect their brands globally. They represent new products, new companies and new investment.<sup>ii</sup> The Protocol makes trademark protection more efficient and less costly for business, including in the ASEAN region.

## AECSP Support to AMS' Accession

In 2019 the Madrid Protocol will mark 30 years in operation. A total of 117 Member States are party to it as of 2018.<sup>iii</sup>

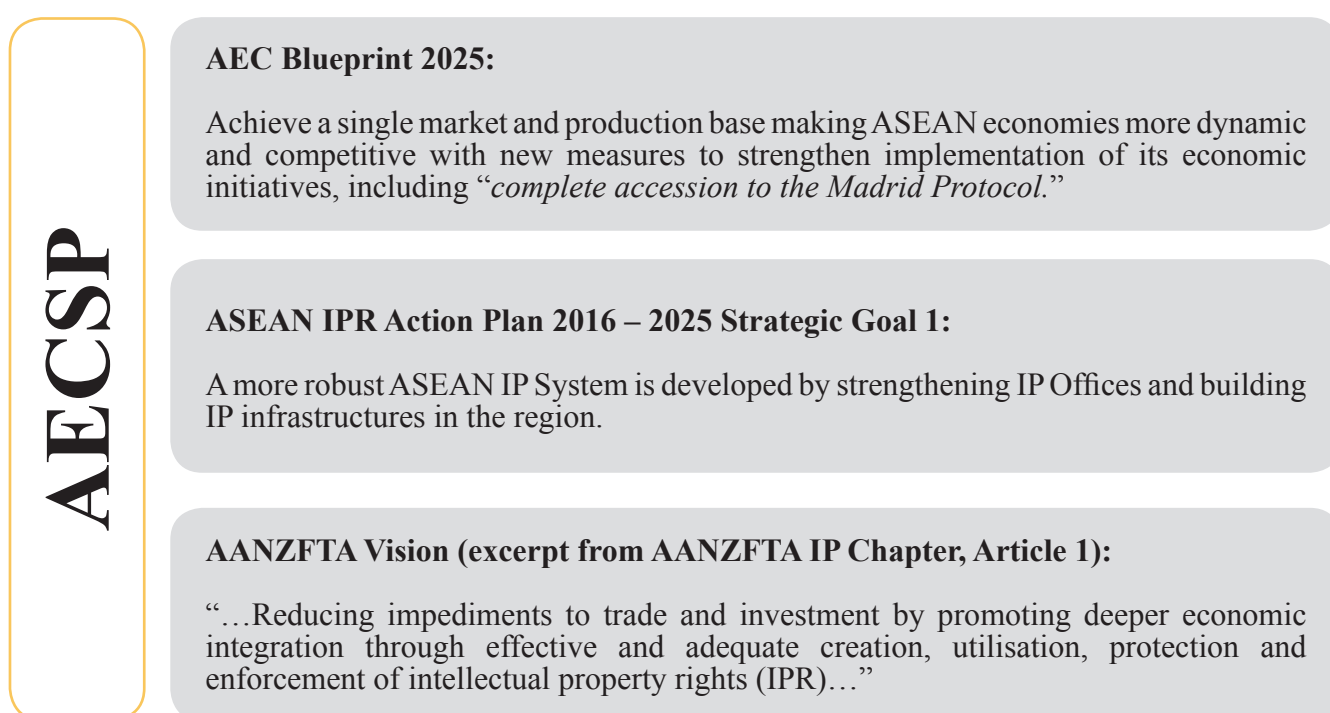
Over six years (2011-2017), the AANZFTA Economic Cooperation Support Program (AECSP) supported ASEAN Member States (AMSs) to accede and/or implement the Protocol.

AECSP support contributed to the:

- **Accession** of five AMSs: Brunei Darussalam, Cambodia, Indonesia, Lao PDR and Thailand.
- **Post-accession** implementation capacity of two AMSs: Philippines and Viet Nam.
- **Pre-accession** activities supporting Malaysia's path to accession, and Myanmar's eventual future accession through development of its national legislative and organisational capability.

The AECSP supported the strategic vision of the ASEAN Economic Community (AEC) Blueprint 2025, the ASEAN Intellectual Property Rights Action Plan (2011-2015, 2016-2025) and AANZFTA commitments. (Figure 1).

Figure 1: Alignment to Strategic Vision



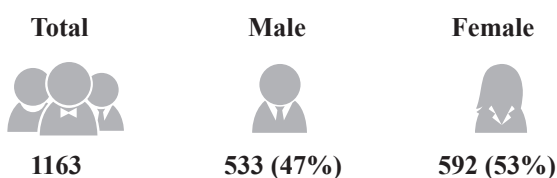


*Training of Trademark Examiners on Madrid Protocol Operations, 4-7 November 2013, Singapore*

The Intellectual Property Office of the Philippines (IPOPHL) took the lead in implementing the AECSP Madrid Protocol project under the guidance of the AANZFTA Intellectual Property Committee and Joint Committee, with support from the AANZFTA Support Unit and the ASEAN Secretariat's Competition, Consumer Protection and Intellectual Property Rights Division.

AECSP supported capacity building activities, delivered based on initial needs assessments but also responsive to National IP Office needs such as the inclusion of Attachment Training for Cambodian officers being seconded to the Philippines. Capacity building activities included regional and subregional training workshops, technical assistance and secondments. Activities delivered by AECSP on Madrid Protocol reached over 1100 participants from AMSs with over half being female (Figure 2).

**Figure 2:** Reach of capacity building activities



In 2011 when the AECSP support was initiated, Australia, Singapore, and Viet Nam were already members of the Madrid Protocol. Of the remaining Parties to AANZFTA, New Zealand and the Philippines were close to completing the accession process.

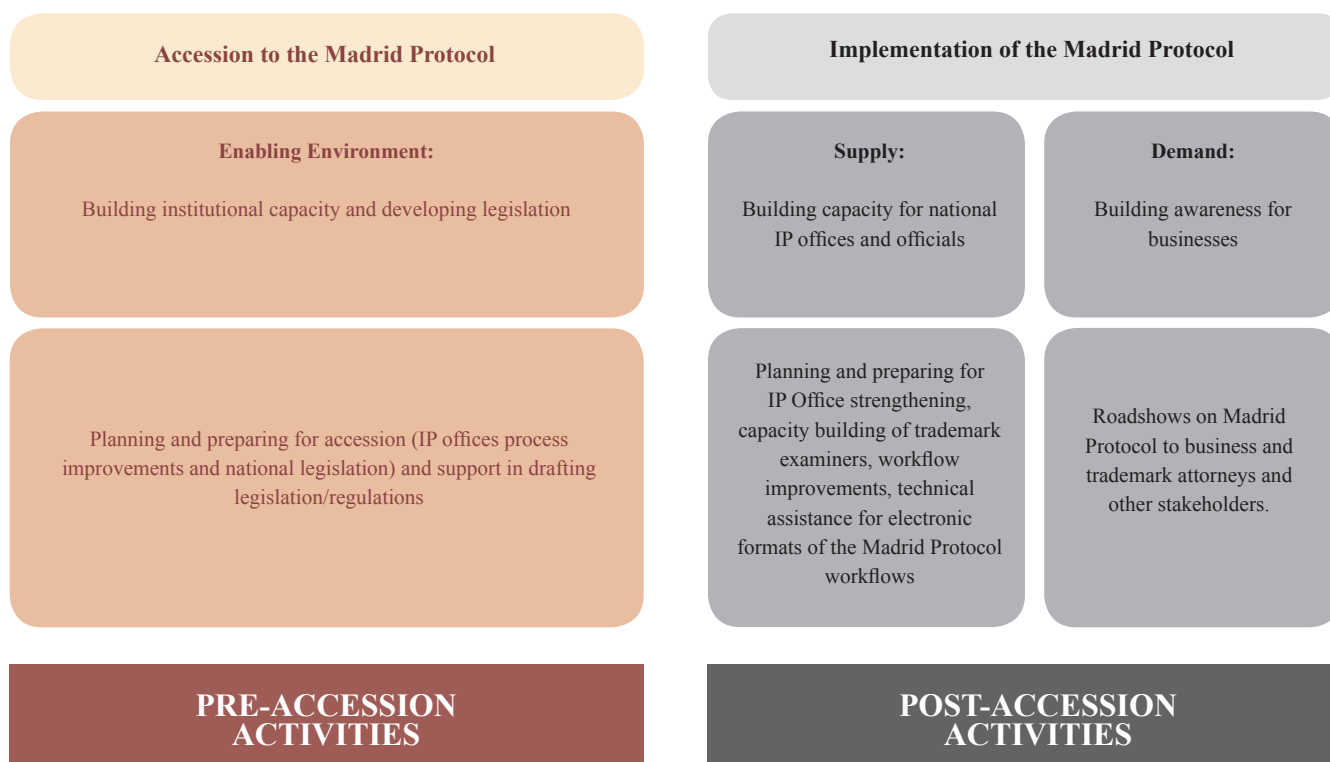
The AECSP took a programmatic approach to address the accession challenges faced by the remaining AMSs. By tackling the enabling environment, and supply and demand side constraints, the AECSP took a holistic view of Madrid Protocol accession and implementation challenges and needs over three phases of support (Figure 3).

### **Key Benefits To Madrid Protocol Accession**

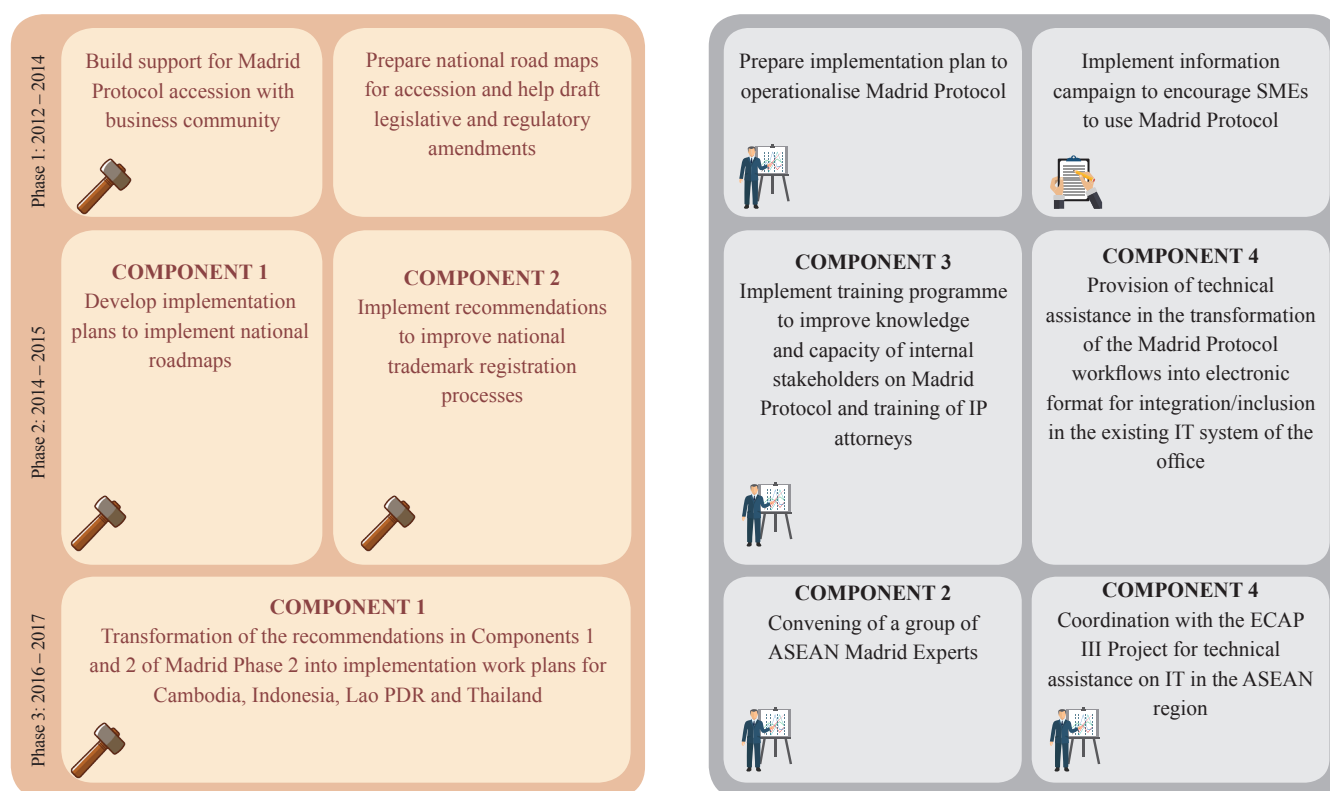
- *Trademark Protection*
- *Increased Public Cost Recovery*



**Figure 3: Programmatic Approach to Pre- and Post- Accession Activities**



2011	A Sub-Regional Workshop on Accession to the Madrid Protocol in Canberra, Australia.
------	-------------------------------------------------------------------------------------



## KEY BENEFITS TO ACCESSION

The immediate benefit of AMS accession to the Madrid Protocol has been easier and cheaper trademark protection for small and medium enterprises (SMEs) in ASEAN, and increased cost recovery for IP offices. Accession also benefits businesses from other Parties to the Madrid Protocol, including Australia and New Zealand, who seek to protect their trademarks in the AMSs.

### ■ Trademark Protection

Data on trademark registrations from two recently acceded countries (Cambodia and Lao PDR) indicate that the accession to the Madrid Protocol has initially resulted in benefits for overseas businesses. Data from Cambodia and Lao PDR IP Offices indicate that:

- In Cambodia, approximately 30% of trademark registrations were designated via the Madrid Protocol three years following accession in 2015. The main countries designating Cambodia are China, USA, Japan, France and Germany followed by other developed countries including Australia.
- In Lao PDR, over 40% of trademark registrations were designated via the Madrid Protocol three years following accession in 2016. China, USA and Japan are the countries of origin that have shown a marked increase in designating Lao PDR under the Madrid Protocol.

Feedback from business to date has indicated an improved cost-effectiveness and efficiency in international markets.

*“Businesses in Brunei have indicated that the Madrid Protocol makes patent applications much easier and cheaper since they don’t have to appoint agents/representatives overseas, and they can track the progress of their applications with the different offices online”*

– interviewee from Brunei Darussalam National IP Office.

*“Whilst some of the AMSs are currently net-importers of IP through the Madrid Protocol, this will likely change over time as the region moves towards the AEC’s single market and production base”*

– IP Australia interviewee.

### ■ Increased Public Cost Recovery

One of the benefits of the Madrid Protocol is the opportunity for increased government revenue through trademark registrations. In some AMSs these help cover the costs of operations under the Madrid Protocol.

- In Lao PDR, there was a 50% increase in fees paid to the IP Office in the year following accession (Lao PDR National IP Office)
- In Cambodia, revenue also increased since the implementation of the Madrid Protocol (Cambodia National IP Office).

## GOOD PRACTICES

• *Sharing of knowledge, skills, and lessons among AMSs*

• *Partnership model: Avoiding duplication and enabling greater resource efficiency*

• *Country Roadmaps*

The AECSP support on Madrid Protocol demonstrated a number of good practices in project design and implementation:

### ■ Sharing of knowledge, skills, and lessons among AMSs

Examples of shared knowledge, skills and lessons between AMS National IP Offices include:

- The placement of Cambodian IP officers in IPOPHL to learn from another AMS that uses a similar system.
- Viet Nam National Office of Intellectual Property’s participation in several programs organised by AECSP to share experiences of the Madrid Protocol membership with other AMSs, such as Lao PDR and Thailand.
- IP experts from Australia and New Zealand also provided training for the Madrid Protocol examiners in the AMS on a range of topics concerning the Madrid Protocol legal framework and procedures, which provided valuable insights on accession and implementation of the Madrid Protocol.



### ■ *Partnership model: Avoiding duplication and enabling greater resource efficiency*

The AECSP actively engaged Dialogue Partners, particularly the European Union (EU) - ASEAN Project on the Protection of Intellectual Property Rights Phase III (ECAP III) and the World Intellectual Property Organization (WIPO), to avoid duplication, reinforce efforts and maximise the efficiency of resources. These Dialogue Partners committed to participate in selected project components.

### ■ *Country Roadmaps*

Country Roadmaps were a centrepiece of AECSP support in Phase I, with Roadmaps prepared for Cambodia, Indonesia, Lao PDR, Malaysia and Thailand. These Roadmaps focused on trademark administration systems, legislative system review and included implementation plans for clearing trademark backlogs as well as reducing turnaround times to meet Madrid Protocol requirements.

Country Roadmaps provided comprehensive status analyses, highlighted the challenges faced by the IP offices and provided key recommendations such as:

- Automating systems for quicker and more accurate IP searches
- Providing intensive skills training for national examiners aligned to international practices
- Updating trademark databases; and
- Capturing data accurately and consistently.

Of international note, the Country Roadmap template developed under AECSP for AMS' accession to the Madrid Protocol was adapted by WIPO and was published as a guide for other countries in the process of accession.

Interviewees from Lao Department of Intellectual Property (DIP) shared:

*“The development of the Country Roadmap for Madrid accession was the most important tool for Lao PDR's accession to the Madrid Protocol as it set out a clear path and activities to be taken for the accession”*

*Seminar on Trademarks and Madrid Protocol, 20-21 May 2015, Yangon, Myanmar*





*“The support provided by AECSP to Laos to implement the activities identified in the roadmap for accession was also a key to success; as each country has a specific roadmap depending on internal conditions, particularly in terms of laws and institutions”*

*“Laos received supports to implement the roadmap step by step”*

## LESSONS LEARNED

Following is a number of key lessons learned through implementing the AECSP support program on the Madrid Protocol.

### ■ *High level AMS engagement and ownership is critical to accession success*

AECSP support had a high level of engagement and ownership by AMSs, in part because the support was tailored to their needs, and aligned to their implementation commitments and work programs under AANZFTA and AEC Blueprints.

The level of engagement and ownership led to in-kind support that maximised the efficiency of the project, as well as engagement between AMSs to share experiences.

### ■ *Holistic and phased programmatic support meets practical AMS needs*

AECSP took a holistic approach when supporting AMS' accession to the Madrid Protocol, working to overcome challenges in the enabling environment as well as both the supply side and demand side.

The phased approach also allowed the AECSP to regularly review the project's performance and identify opportunities to adapt and improve in order to meet the project's objectives.

### ■ *Twin-approach: Regional and Country levels*

The AECSP did not just focus on delivering activities at the regional level, but took a country approach that recognised the specific challenges and opportunities within AMS' national IP offices. This led to opportunities for AMSs to share their experiences and learn from each other, particularly where they operated similar systems.

<sup>i</sup> In 2017 international trademark applications across the countries Party to the Protocol went up by 5% to a total of 56,200. Source: March 21, 2018, WIPO Direct-General: Record International Trademark Filings in 2017.

<sup>ii</sup> March 21, 2018, WIPO Direct-General: Record International Trademark Filings in 2017. [https://www.youtube.com/watch?v=BcrLRbmu\\_Mo](https://www.youtube.com/watch?v=BcrLRbmu_Mo)

<sup>iii</sup> Ibid



## *Thanks to and acknowledging the efforts of the following National IP Offices*



**Australian Government**  
**IP Australia**

**Australia:**

IP Australia (IPA)

[www.ipaustralia.gov.au](http://www.ipaustralia.gov.au)

**Status:** Acceded 11 July 2001



INTELLECTUAL  
PROPERTY OFFICE  
**BRUNEI DARUSSALAM**

**Brunei Darussalam:**

Brunei Intellectual Property Office (BRUIPO)

[www.bruipo.gov.bn](http://www.bruipo.gov.bn)

**Status:** Acceded 6 January 2017



**Cambodia:**

Department of Intellectual Property Rights (DIP)

[www.cambodiaip.gov.kh](http://www.cambodiaip.gov.kh)

**Status:** Acceded 5 June 2015



DIREKTORAT JENDERAL KEKAYAAN INTELEKTUAL  
KEMENTERIAN HUKUM DAN HAK ASASI MANUSIA R.I.

**Indonesia:**

The office of the Directorate General of Intellectual Property (DGIP)

<http://www.dgip.go.id/>

**Status:** Acceded 2 January 2018



**Laos:**

Laos Department of Intellectual Property, Ministry of Science and Technology

<http://www.stea.la.wipo.net/index.html>

**Status:** Acceded 7 March, 2016



**Malaysia:**

Intellectual Property Corporation of Malaysia (MyIPO)

<http://www.myipo.gov.my/en/home/>

**Status:** Continuing preparations to accede



**Myanmar:**

Intellectual Property Section, Ministry of Education

<http://www.moe-st.gov.mm/>

**Status:** Continuing preparations to accede



**New Zealand:**

New Zealand Intellectual Property Office

[www.iponz.govt.nz](http://www.iponz.govt.nz)

**Status:** Acceded 12 December 2012



REPUBLIC OF THE PHILIPPINES

**Intellectual Property Office  
of the Philippines**

**Philippines:**

The Intellectual Property Office of the Philippines (IPOPHL)

<https://www.ipophil.gov.ph/>

**Status:** Acceded 25 July 2012



**Singapore:**

Intellectual Property Office of Singapore (IPOS)

<https://www.ipos.gov.sg/>

**Status:** Acceded 31 October 2000



**Thailand:**

Department of Intellectual Property (DIP), Ministry of Commerce

<http://www.ipthailand.go.th/en/>

**Status:** Acceded 7 November, 2017



**Viet Nam:**

National Office of Intellectual Property of Viet Nam (NOIP)

<http://www.noip.gov.vn/web/noip/home/en>

**Status:** Acceded 11 July, 2006







<http://aanzfta.asean.org>