

# PROTECTING YOUR BRAND ABROAD

## WIPO REGIONAL WEBINAR

**Presented by:**

**Sanjukta Tole**

**Partner | Toronto**

**December 7, 2023**

# HELPING LOCAL CLIENTS

# TO FILE OR NOT TO FILE...

NATIONAL  
REGISTRATION

INTERATIONAL  
REGISTRATION  
(MADRID SYSTEM)

**\$\$\$\$** is a Major Consideration

# COST CONSIDERATIONS

## Madrid System

Basic Registration

+ Home Attorney Fee

+ Basic Fee

+ Designation Fee x

Classes

= TOTAL **FILING** FEE

## National Route

Local Attorney Fee

+ Official Fees x Classes

+ Translation

+ POA

+ Notarization / Legalization

+ Certificate of Good Standing

= FILING FEE **PER COUNTRY**

# ADDITIONAL COSTS

## ■ Currency

- Single currency
- Exchange rates
- Invoicing markups / timing

## ■ Home Attorney Fees

- Fee Quotes v. Fee Calculator

## ■ Admin Fees

- Photocopying, international calls, etc.



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# ADMINISTRATION

- **Conflicts**
- **Choice of Languages**
  - English, French, Spanish
  - Local National Languages
- **Docketing**
  - Correspondence and Reminders
  - Dependence on Local Attorney / Local Databases
  - WIPO Madrid Monitor / WIPO Helpdesk

# FILING PROCESS



# SCOPE OF PROTECTION

## ■ Broad coverage

- Over 130 countries
- 3 Regions (OAPI, EU, Benelux)

## ■ Benefits

- Sourcing associate attorneys
- Quality control and consistency



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# WIPO TOOLS

The screenshot displays the WIPO eMadrid Reference website. At the top, the WIPO logo is visible on the left, and navigation links for 'Help', 'English', and 'IP Portal login' are on the right. The main heading is 'eMadrid Reference', with a sub-link 'Discover eMadrid Reference'. Below this, a section titled 'What is eMadrid Reference?' explains that it provides access to all the supporting tools and resources needed when filing and managing international trademark registrations under the Madrid System.

The 'Services' section features five interactive cards:

- CONSULT MADRID SYSTEM MEMBER PROFILES**: Learn all about the laws and practices of IP Offices of Madrid System members. Includes a 'Get started' button.
- CALCULATE YOUR FEES**: Use the Fee Calculator to estimate the cost of filing and managing an international registration. Includes a 'Get started' button.
- COMPILE AND VERIFY LISTS OF GOODS AND SERVICES**: Use Madrid Goods & Services Manager to select from thousands of terms to build a list of goods and services that will be covered by your international registration. Includes a 'Get started' button.
- SIMULATE INTERNATIONAL PROTECTION**: Access the International Application Simulator to find out how the Madrid System can protect your trademark abroad. Includes a 'Get started' button.
- FIND OUT ABOUT PENDENCY RATES**: Learn all about the pendency times for key Madrid System transactions. Includes an 'Access report' button.

# POST-FILING

## ■ Timing

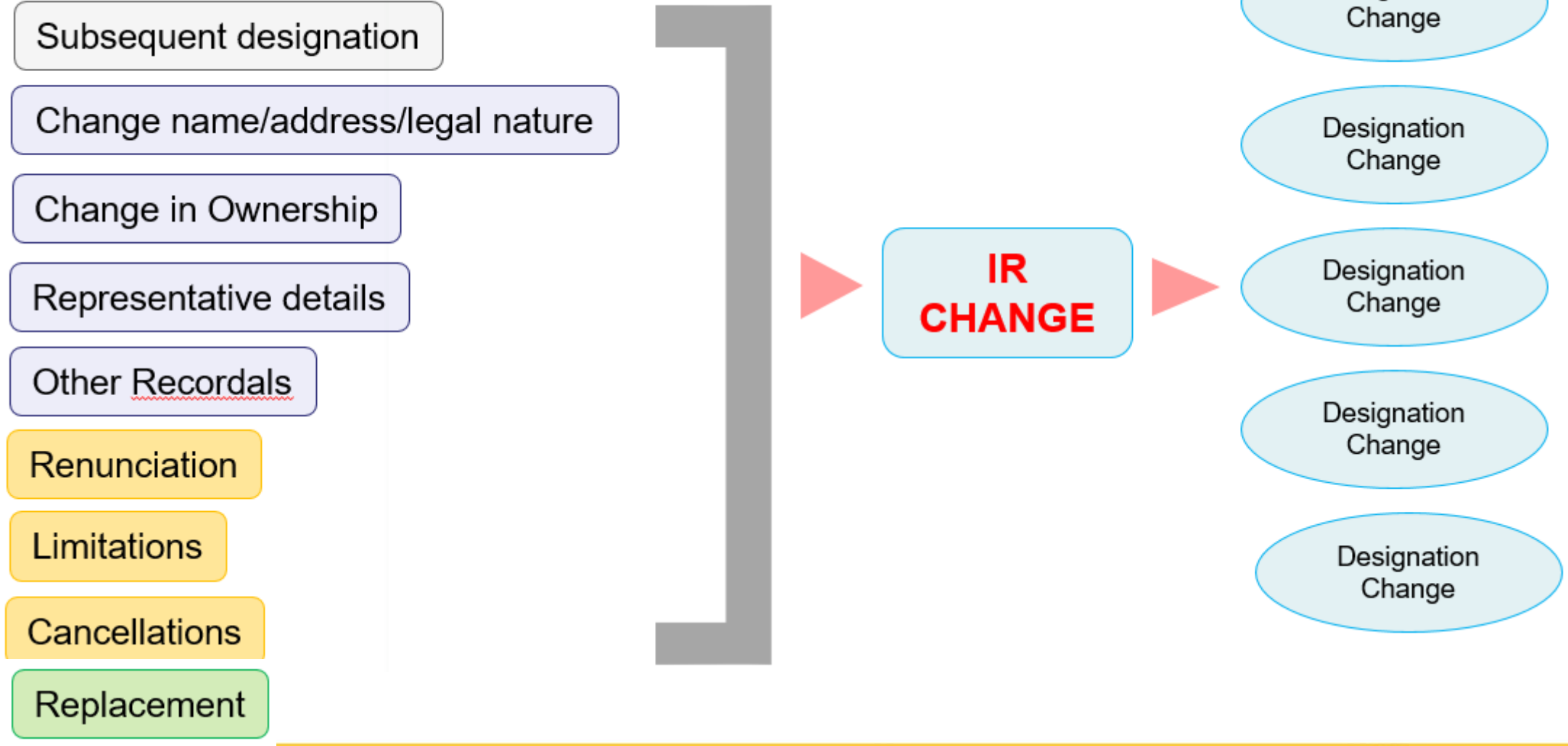
- 12 months v. 18 months
- Local wait time

## ■ Registration Requirements

- Declarations of Use
- Dates of First Use
- Specimens of Use

# CENTRALIZED MANAGEMENT

DW



# PORTFOLIO MANAGEMENT

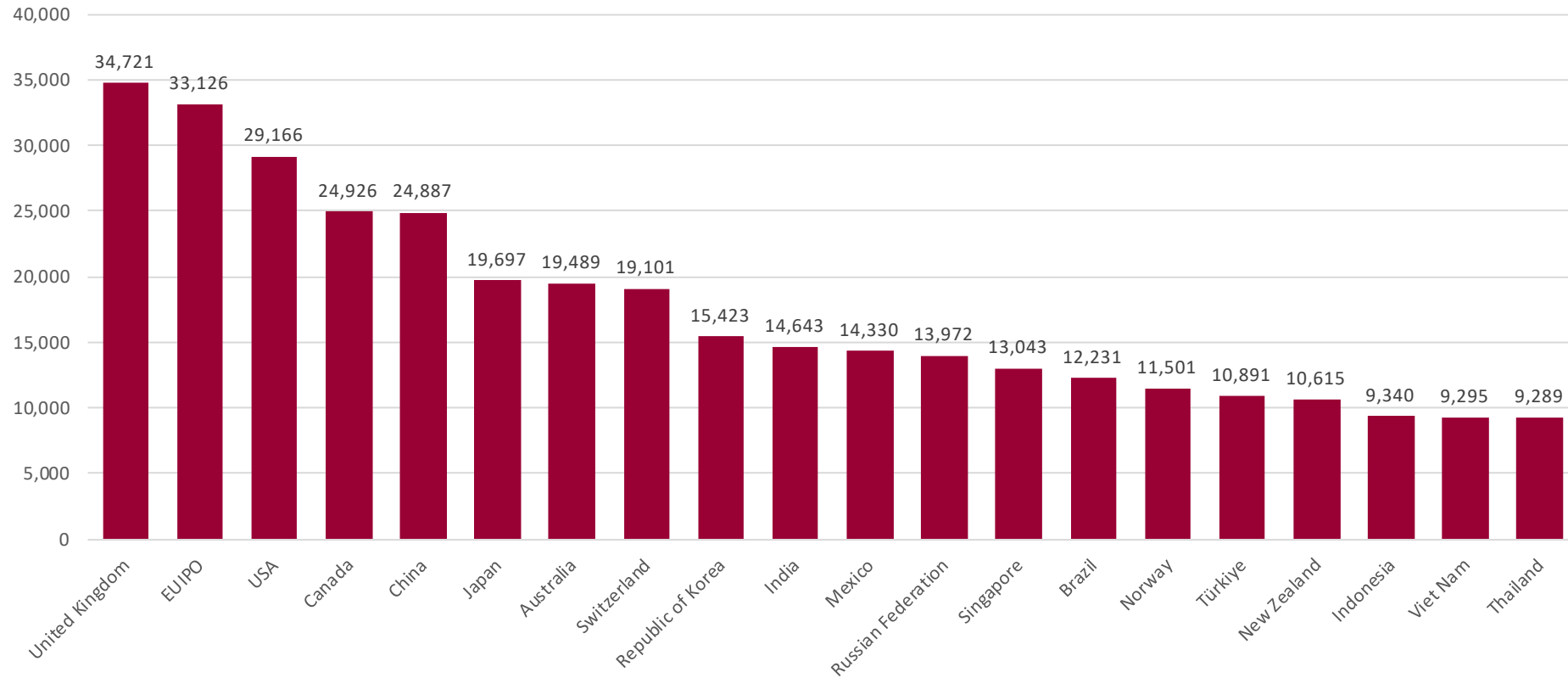
- **Subsequent Designation**
  - Expand protection
  - Subsequent designation fee
- **Renewals**
- **Changes of Name / Address**
- **Assignments**
  - Originals not required
  - Notarization / Legalization

# ENFORCEMENT

- **Effectiveness of Registration**
- **Cancellation**
- **Opposition**

# DESIGNATION CANADA

# 2022 TOP 20 DESIGNATIONS



# CANADIAN STATISTICS

- Breakdown of the filings in Canada tell a story:

Year	Volume of Filings
2018	62,235
2019	69,804
2020	71,887
2021	83,815
2022	72,436
2023	60209 (to Nov 30, 2023) ~ projected to 66,000

← Madrid Protocol adopted

- Consistent increased filings in the last four years compared to pre-Madrid Protocol.

WI



# ADVANTAGES

## ■ Higher Volume

- Cost effective
- Easy to do / More accessible

## ■ Consistency

- Accession to Nice Classification and other treaties

## ■ Smoother Process

- Removal of Notice of Allowance
- Removal of requirement for Declaration of Use

# TIMING

- **Canadian Timing:**  
18-month  
wait to examination

## Dates of Trademark Applications being distributed for Examination

Applications not using the Pre-approved List of Goods and Services: **May 15, 2019**

Applications using the Pre-Approved List of Goods and Services: **March 30, 2022**









Madrid (based on date of WIPO notification of designation): **July 21, 2022**

# IT DEVELOPMENT

- **Online Filings**
  - Updated Goods and Services Manual
- **Other Transactions**
  - Transfers
  - Oppositions / Cancellations

## Trademark E-Services

The following options are available:

 <p><b>New</b> Create a new application</p>	 <p><b>Amend</b> Amend a previously filed application</p>	 <p><b>International</b> Create an application for International Registration</p>	 <p><b>Group</b> Group goods or services (Nice Classification)</p>
 <p><b>Ownership &amp; Representation</b> Ownership changes, agreements, and agent appointments</p>	 <p><b>Registration</b> Search for applications that are available for registration</p>	 <p><b>Renewal</b> Search for registrations that are eligible for renewal</p>	 <p><b>Adjusted renewal fee</b> Search for registrations that require the payment of adjusted renewal fees</p>

# IT DEVELOPMENT

## Document Retrieval System

▼ Documents

All documents **18** Submitted to CIPO **8** Issued from CIPO **9** Other documents **1**

Showing 1 to 20 of 20 entries |

Document name	Type ↑↓	Date ↑↓	Format	File size	Select (All/None)	Actions
<a href="#">Madrid Cancellation partial</a>	Submitted	2023-10-11	PDF	112 KB	<input type="checkbox"/>	
<a href="#">Madrid Correction</a>	Submitted	2023-10-05	PDF	140 KB	<input type="checkbox"/>	
<a href="#">Madrid Correction</a>			TIFF	1 KB		
<a href="#">Research Sheet</a>	Other	2023-09-19	PDF	16 KB	<input type="checkbox"/>	
<a href="#">Amended Application</a>	Submitted	2023-08-01	PDF	65 KB	<input type="checkbox"/>	
<a href="#">2157205-ltr- cipo - oa response- open makes more possible 4893-5321-6618 v.1 4875-0642-1615 v.4.pdf</a>			PDF	378 KB		
<a href="#">Confirmation of Change - Agent</a>	Issued	2023-06-06	PDF	14 KB	<input type="checkbox"/>	
<a href="#">Confirmation of Change - Agent</a>	Issued	2023-06-06	PDF	11 KB	<input type="checkbox"/>	
<a href="#">Appointment of Agent</a>	Submitted	2023-06-05	PDF	56 KB	<input type="checkbox"/>	
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# QUESTIONS?

You Can Reach Me At

T: 416-644-2828

E: [tole@dickinsonwright.com](mailto:tole@dickinsonwright.com)