

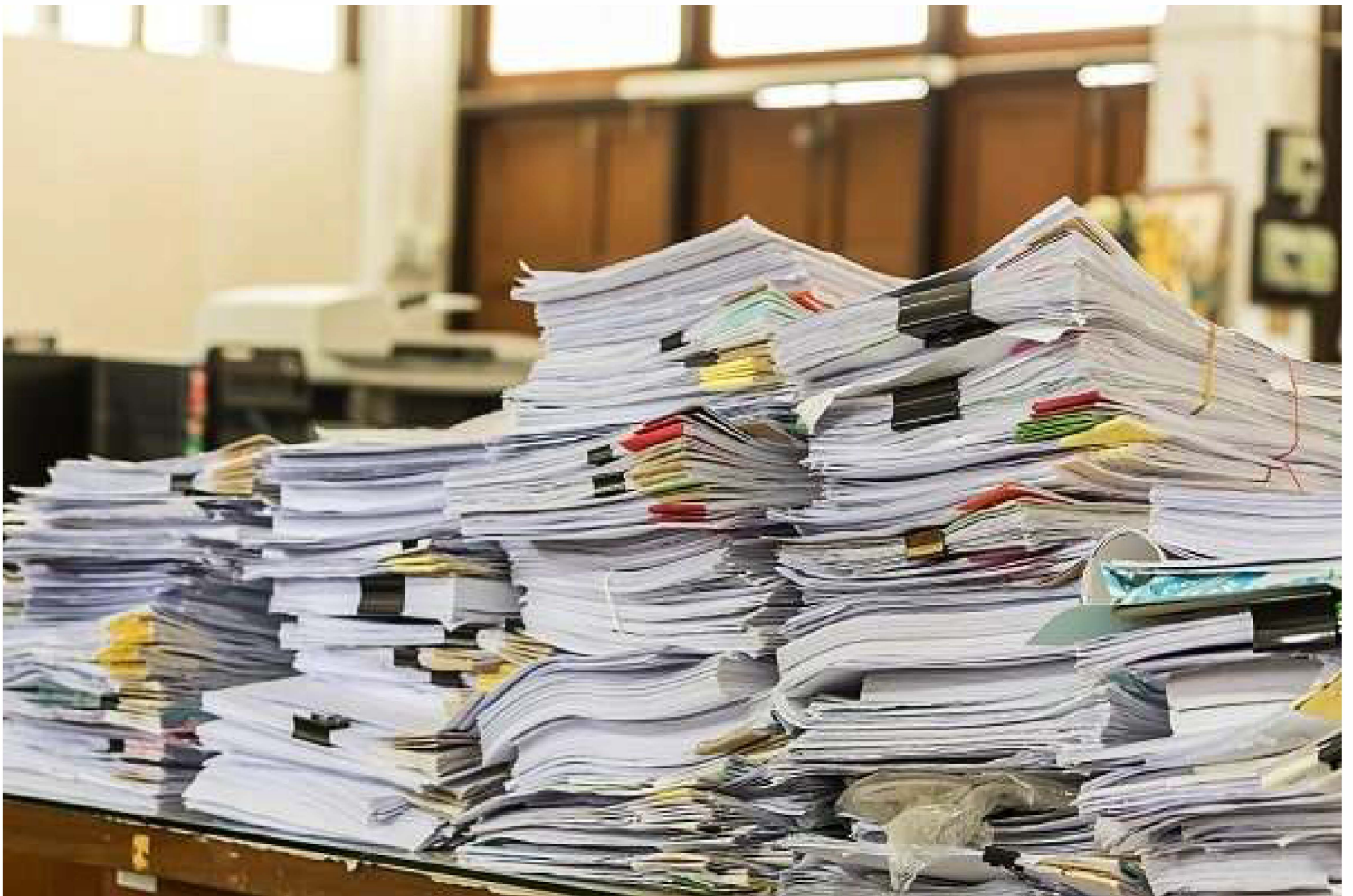
## Trademarks

# Life after Madrid: lawyers reflect on protocol's workflow impact

Counsel in Brazil, Canada and Jamaica weigh what changes in foreign and local trademark filing strategies have meant, or will mean, for their practices

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More and more countries in the Americas and Caribbean are joining the Madrid Protocol.

The system entered force in Brazil and Canada in 2019, will come into effect in Jamaica this March, and

is expected to be in effect in Chile soon.

It's easy to understand why a system that allows users to file a single application and pay one set of fees for protection in up to 126 countries is appealing.

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Lawyers are sometimes a little wary, however, when they learn their countries are contemplating joining, partly because they fear that their foreign clients will use this system and send them less work than before.

This does happen in many cases, but attorneys are also able to tap into new work opportunities through local filers that use the protocol, and foreign filers that need help overcoming office objections.

[Managing IP](#) spoke to counsel in Canada and Brazil about the challenges of adjusting to this protocol and how it has affected their workflows and to one lawyer in Jamaica about its expected impact.

## Canada: an influx of objections

Canadian lawyers have seen increases in certain types of work because of the Madrid Protocol.

Philip Lapin, chair of Smart & Biggar's trademark operations group in Ottawa, says his firm has done more work for Canadian companies than it did before because it has to handle more correspondence with foreign intellectual property offices.

Before Canada joined the Madrid Protocol, the firm asked foreign attorneys to file applications on behalf of its clients, and those lawyers summarised any issues that arose at their local offices. But now, Smart & Biggar must evaluate these issues and then ask its clients if they want the firm to hire more experts.

Canadian clients are filing in more countries because of the protocol, which also increases the firm's communications with foreign IP bureaus, says Lapin.

Sources say that although Canadian firms received fewer initial filing requests from foreign applicants, they've still pulled in a lot of work from these clients.

One reason for this is that CIPO sends letters to foreign representatives saying it won't communicate directly with them – only with the applicant or with Canadian trademark agents. A lot of applicants receive objections in Canada and therefore need to communicate with the IP office.

Shelagh Carnegie, co-head of IP at Gowling WLG in Toronto, adds that an unexpectedly large number of filers designated Canada in their applications, and that she believes the jurisdiction is the fourth most designated country in the Madrid Protocol.

Foreign applicants are therefore relying on Canadian agents to help them overcome these refusals, say sources.

That said, it may be too early to tell how the Madrid Protocol will ultimately affect firms' workflows.

The influx of applications resulted in massive delays at Canada's trademark office, CIPO. Madrid applications have an 18-month deadline, and CIPO took around the full 18 months in many cases.

Carnegie says it still takes a significant amount of time for the incoming international registrations to be examined. The firm is seeing an increasing number of requests to become agents on Canadian-designated international registrations.

“But it's hard to say whether that work will ultimately outweigh the value of national filings and associated work we no longer have,” she adds.

The fact that CIPO took 18 months to examine these applications meant there was a time when Canadian firms received less prosecution work from foreign applicants but weren't yet receiving requests to help these filers overcome refusals.

Lapin says this gap made it difficult for firms to have appropriate staffing because they went from having less work than they wanted to more work than they anticipated.

His firm managed this issue by training a highly specialised group of paralegals in describing goods and services. Canada requires very specific descriptions of goods and services, and Madrid applicants tend to see a lot of objections because their descriptions don't satisfy CIPO.

## **Brazil: divided bar**

In Brazil, lawyers are divided over whether the Madrid Protocol has resulted in less work.

Joana de Mattos Siqueira, partner at Montauray Pimenta Machado & Vieira de Mello in Rio de Janeiro, says the number of applications that were directly filed at Brazil's trademark office actually increased, from 241.711 in 2019 to 268.958 in 2020.

She adds that a lot of foreign companies that have filed through the treaty have relied on local counsel such as her to handle oppositions or respond to office actions.

Others, however, say that the system has resulted in less work for firms.

Flávia Polli Rodrigues, partner at Kasznar Leonardos in São Paulo, says a lot of firms had less work because many foreign filers used the Madrid system and stopped filing directly through the Brazil trademark office, INPI.

She adds that Brazilian companies typically don't have a lot of filings overseas compared to foreign Madrid applicants. As a result, there weren't enough local companies using the system to compensate for the work lost.

Not all Madrid applicants will ask local firms to help them address office actions.

Polli Rodrigues says many Madrid applicants aren't particularly invested in their Brazilian filings, so they may choose to drop the applications rather than spend money overcoming objections.

Having said that, Brazilian lawyers can still adapt and try to get work in other ways.

Polli Rodrigues says her firm is focused on giving clients the best possible experience. It's trying to do more strategic analysis, better manage companies' portfolios and propose better alternatives when clients encounter registration obstacles.

She adds that she ultimately thinks joining the Madrid system was a good idea.

"At the beginning I was very sceptical, but after using the system I can understand how it's good for IP owners and how it's good to have a standardised way of doing things," she says.

## Challenges of changes

Sources say it was difficult for their IP offices to adapt to the Madrid Protocol at first.

Lapin at Smart & Biggar says his firm initially struggled to get answers to some questions from CIPO.

He says, for example, that CIPO doesn't allow Nice classes to be added to Madrid designations. The firm asked CIPO to point it to any regulations or legislation that supported this position. The office seemed uncertain at first, although provided some support three months later.

Trademark offices also have to make sure they meet the Madrid Protocol's deadlines.

The Brazil trademark office used to be quite backlogged, and it took almost 24 months to have a

trademark registered, says de Mattos Siqueira at Montauray. But the office needed to be faster to meet the system's requirements.

This was ultimately a good thing for filers because registration time has now dropped to six months for all applicants, notes de Mattos Siqueira.

## Jamaica: looking ahead

As Brazilian and Canadian attorneys look back and reflect on how the Madrid Protocol has affected their practices, attorneys in Jamaica are looking ahead to gauge what it will mean for theirs.

Kathryn Pearson, partner at Livingston Alexander & Levy in Jamaica, expects that changes in workflow will be a mixed bag. But she notes that not every foreign filer will automatically gravitate towards the new system.

Jamaica is an easy jurisdiction to file and amend trademark applications in, she adds, and some applicants will want to stick with what they know. Foreign filers will still need Jamaican attorneys' services if they face oppositions and refusals.

## Making the most

Attorneys may have mixed feelings when their countries join the Madrid Protocol as they worry about losing out on work from foreign filers. But if lawyers in Canada and Brazil are anything to go by, firms might be able to make the most out of the situation.

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