

HINDLES

Patent & Trade Mark Attorneys

OBTAINING TRADE MARK PROTECTION AROUND THE WORLD

Trade mark registrations can be obtained in most countries throughout the world by direct applications. In some territories it is possible to seek protection by way of an international registration under the Madrid System. Both options are discussed below.

Direct applications

The possibility of seeking protection for trade marks by way of UK trade mark applications or EU trade mark applications is discussed in our separate information sheets on those topics. We also act for clients in seeking protection around the world, using foreign associate firms of trade mark attorneys.

In most countries it is possible to seek registration by way of a direct application in that country. There are however some supra-national schemes, for example Benelux trade mark registrations, which cover Belgium, the Netherlands and Luxembourg, ARIPO applications which can cover various African states and so forth.

The trade mark application procedure varies substantially around the world. Applications are generally examined to ascertain that they are the type of mark which should be registerable (examination on absolute grounds). The extent to which applications are examined and refused due to the existence of earlier third party rights (examination on relative grounds) varies considerably. Many countries classify goods and services in a similar way to the UK and European Union. Other countries (particularly many Asian and Middle Eastern countries) do not allow multiple class applications or, for example in the case of Canada, have no classification scheme. We can obtain detailed advice on procedures in individual countries where required.

Claiming priority

In most cases, it is possible to file an initial trade mark application in a single territory (e.g. the UK) and file further applications for the same mark in other territories, within six months, and for these later applications to “claim priority” from the initial application.

Where priority is validly claimed, the later application should not be invalid due only to applications filed for the first time by third parties in the intervening six months.

The Madrid System for the international registration of trade marks

As an alternative to filing national trade mark applications, the Madrid system for the international registration of trade marks provides an efficient and cost-effective way of securing international trade mark protection in countries which are members of the Madrid system. Under the Madrid system, a single international registration can provide trade mark protection in multiple jurisdictions throughout the world including the European Union, USA, Japan and China.

International registrations also have administrative advantages. An international application to protect a trade mark in a number of territories is filed through a single trade mark office. In addition, applications to renew an international trade mark, or to record a transaction such as an assignment, in multiple territories can be filed centrally.

The Madrid system is governed by two treaties, the Madrid Agreement and the Madrid Protocol. Countries may be members of the Agreement and/or the Protocol and intergovernmental organisations (e.g. the European Union) may be members of the Protocol.

There are three types of international applications: applications governed by (i) the Agreement only, (ii) the Protocol only, or (iii) both the Agreement and Protocol. As the United Kingdom (UK) and European Union are signatories to the Protocol only, many UK applicants will only be able to file applications governed exclusively by the Protocol and to seek protection in Protocol countries. It is this type of international application which is discussed below.

Who can file an international (Madrid Protocol) application?

Any natural person or any legal entity (e.g. a company) may file an international (Madrid Protocol) application provided that they satisfy the following requirements:

(a) Qualification Requirement

An applicant must (i) have a real and effective industrial or commercial establishment (i.e. genuine business premises) in a contracting party, (ii) be domiciled (i.e. resident) in a contracting party, or (iii) be a national of a contracting party.

(b) Requirement for a Basic Application/Registration

An applicant must also have at least one earlier trade mark application or registration (referred to as a “basic application/registration”) in a contracting party where they fulfil the above qualification requirement. The basic application(s)/registration(s) should cover the same mark and goods/services as the applicant wishes to protect internationally.

For example, a company with business premises in the UK, and UK or EU trade mark application(s)/registration(s), could file an international (Madrid Protocol) application.

Where can an international (Madrid Protocol) application be filed?

An applicant can file an international (Madrid Protocol) application with the trade mark office of any contracting party where they fulfil the qualification requirement, and have at least one basic application/registration. For example, a UK company, with both a UK and an EU trade mark registration, would file through the UK Intellectual Property Office if they wanted to rely on the UK registration as their basic registration. However, if they wished to use their EU trade mark registration as basis, they would file through the European Union Intellectual Property Office (EU IPO).

This trade mark office through which an international application is filed is known as “the office of origin”.

Where can protection be sought?

An applicant may seek protection in any or all of the contracting parties to the Madrid Protocol, except the contracting party whose office is the office of origin. (The applicant must, of course, already have at least one application filed with, or registration granted by, the office of origin in order to be able to file an international (Madrid Protocol) application).

Those contracting parties in respect of which protection is sought should be designated by the applicant in the international application.

Other contracting parties may also be designated later. For example, the holder of an international (Madrid Protocol) registration might wish to make a “subsequent designation” of a contracting party that they had decided not to designate when they filed their international application, or that had not been party to the Protocol when the application was filed.

What is the procedure for obtaining protection?

(a) Filing with the Office of Origin

When an international (Madrid Protocol) application is filed with the office of origin, the office will certify (i) the date on which it was received by them, and (ii) certain facts regarding the relationship between the international application and the basic application(s)/registration(s). The office of origin will then forward the international application to the International Bureau of the World Intellectual Property Organisation (WIPO).

(b) Languages

An applicant may file an international (Madrid Protocol) application in English, French or Spanish (subject to the requirements of the office of origin). They can also decide whether communications originating from WIPO will be in English, French or Spanish. Thus, for example, a UK company with a UK registration could apply to have their trade mark protected internationally in English, and could receive correspondence originating from WIPO in English.

(c) Filing costs

The filing costs for an international (Madrid Protocol) application are paid either directly to WIPO or,

in some circumstances, through the office of origin. The precise amount of the filing fee will depend upon which countries are designated and, in some cases, the number of classes into which the goods/services covered by the application are classified. As long as at least two or three countries are designated, the international filing fee should be less than the filing costs of separate national applications in the relevant countries. As the number of designated countries increases, the Madrid system becomes more and more cost-effective.

(d) Registration by WIPO

When WIPO receives an international application from an office of origin, it will determine whether the formalities are correct, but it will not carry out substantive examination. The limited formalities examination involves checking that (i) the filing requirements are met, (ii) suitable terminology has been used to describe the applicant's goods/services, and (iii) the goods/services are correctly classified.

If WIPO identifies any irregularities in an application, it will notify the office of origin and the applicant. With certain types of irregularities, WIPO will only consider responses that come directly from the office of origin. However, an applicant will usually have an opportunity to make submissions to the office of origin on such issues before the office makes any reply to WIPO.

Once WIPO considers that all the formalities requirements have been met, it will register the mark. Details of the mark will be entered in the International Register, a registration certificate will be issued, and the registration will be published in the International Gazette.

The date accorded to the international registration will be the date on which the international application was filed with the office of origin, provided that the application was received by WIPO within two months of that date (and no essential elements were missing).

(e) Consideration by the trade mark offices of the designated contracting parties

It is important to realise that the grant of an international registration by WIPO does not automatically guarantee that a mark is protected in the contracting parties designated.

Details of an international registration will be sent by WIPO to the trade mark offices of the designated contracting parties, who have the right to refuse protection on the same basis as they would for a national application. For example, an international registration designating the UK will be subject to examination and possible opposition in the same way as any UK national application.

If the trade mark office of a contracting party objects to the protection of an international mark in their territory, they should issue notice of a "provisional refusal" to WIPO, within a prescribed time limit. Depending upon the contracting party concerned, the time limit may be twelve months, eighteen months, or possibly longer if the international registration is opposed.

WIPO will pass on details of any provisional refusal to the holder of the international registration. The holder must then contest the refusal before the trade mark office of the relevant contracting party in the same way that they would if they had filed a local application directly with the trade mark office. Where it is not possible for the holder or his international representative to act directly before the trade mark office, a local representative must be appointed.

Once the appropriate local procedures have been completed, the trade mark office will notify WIPO whether the mark is protected or refused for some or all of the goods/services. The International Register will then be updated, the holder of the international registration will be notified, and a statement will be published in the International Gazette.

If the trade mark office of a contracting party has no objection to the international mark being protected in their territory, they may send a statement of grant to WIPO. However, they have no obligation to do so. Provided that no provisional refusal is issued within the relevant time limit, the international mark will automatically be protected in the contracting party for all the goods/services covered by the international registration.

Where a statement of grant has been issued or the prescribed time limit has passed without a provisional refusal being issued, the International Register will again be updated, a statement will be published in the International Gazette, and the holder of the international registration should be notified.

By the end of this process, the holder of an international registration will know whether his mark is protected in each designated contracting party and, if so, for which goods/services.

How long does an international (Madrid Protocol) registration last?

The initial registration period for an international (Madrid Protocol) registration is ten years from the date of the international registration (which is the filing date). An international (Madrid Protocol) registration may then be renewed every ten years through WIPO.

Dependence of an international registration on the basic application(s)/ registration(s)

For five years from the date of the international registration, the protection resulting from the international registration is dependent upon the basic application(s)/registration(s).

This means that if (i) a basic application is refused or withdrawn in whole or in part, or (ii) a basic registration (or a registration resulting from the basic application) is cancelled, lapsed or surrendered in whole or in part, within five years of the date of the international registration (or as a result of an action commenced within the five year period), the international registration will be cancelled in all contracting parties to the corresponding extent.

In order to avoid the risk of losing protection in all designated contracting parties if a basic application is rejected, it is preferable to base an international registration on a registration rather than an application, where possible.

Generally, UK applicants with both UK and EU trade marks would also be better advised to use a UK rather than Community mark as basis for an international registration. This is because an EU trade mark application may be refused, or EU trade mark registration may be invalidated or revoked, if grounds for refusal/cancellation exist in any one of the twenty-eight European Union member states.

The potential disadvantage to holders of international (Madrid Protocol) registrations which results from this dependency is mitigated to a certain extent by a provision which enables holders to “transform” cancelled international registrations into national applications in any of the designated contracting parties, with the same filing (or priority) date as the international registration. It should also be noted that less than 1% of international registrations have been subjected to “central attack”. Once the five year period has passed, a party seeking to challenge the holder’s rights would need to bring a separate action in each designated contracting party.

For more information:

- ❖ Visit our website
- ❖ Contact one of our attorneys directly
- ❖ Call 0131 243 0660

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