

International Trade Marks Under The Madrid System

The Madrid system for international registration of trade marks allows for registration of a mark in multiple countries via a single trade mark application. The international registration designates individual states (for example China) and regions (for example the European Union).

Once registered, a designation of a state or region in an international trade mark registration has equivalent effect to the corresponding national or regional trade mark right in that territory.

The Madrid system for international registration of trade marks consists of the Madrid Agreement, and the Protocol to the Madrid Agreement. Some countries are signed up to the agreement only, and some are signed up to both the agreement and the protocol.

Together, the Contracting Parties to the Agreement and the Protocol constitute the Madrid Union, which is a Special Union under Article 19 of the Paris Convention for the Protection of Industrial Property.

The nationality and residence of the applicant determines which set of countries or regions can be designated in the international application.

Obtaining foreign registered trade mark protection via the international system is often quicker and more cost-effective than the alternative of filing a bundle of individual national trade mark applications. This applies even where the international trade mark designates as few as two states or regions.

Independent nature of international registration

International trade mark applications must be initially based upon one or more national or regional trade mark registrations. Once registered for five years or more, the international trade mark registration becomes independent of the validity of the base national or regional registration.

What can be protected?

Any mark which is registrable before a national or regional trade mark office can form the basis of an international trade mark registration.

The majority of International trade marks are product names, brand names, and company names. However, there are also registrations for colours, smells, sounds, and three-dimensional shapes, such as bottles, the shape of biscuits or other food items, clothing and a wide range of other articles.

Duration

International registered trade marks are perpetual rights, and remain registered for as long as the maintenance fees are paid, subject to any third party invalidity actions or non - use which may occur. There is no prescribed maximum term or scheduled expiry

Each designated territory in an international registration is maintained separately and independently from the rights in other designated territories of the same international registration. Each designated territory in a national registration needs to be maintained by payment of an official maintenance fee, usually every ten years.

As with the equivalent national or regional trade mark registrations, designations in an international registration are vulnerable to revocation upon application by third parties, if the mark is not been used for an extended period in that designated state or region.

For some countries which have a declaration of use requirement, for example the United States, the trade mark holder must periodically declare genuine use of the mark in that country, in order for the US designation to be maintained.

Scope of protection

For an international registration, the scope of rights is generally different for each individual national state or region designated, according to the corresponding national or regional law.

Whilst broadly speaking, the scope of trade mark rights are similar from state to state or region to region, there are territorially dependant differences. However these differences are only the same as those which apply to the equivalent national or regional trade marks for those territories, and international registrations are treated no differently to the equivalent national or regional registration for that territory.

For example, for the European Union designation of an international registration, the scope of protection throughout the EU is the same as that for an EU registered trade mark, and extends to prevent the use of any identical mark for identical goods or services, or

any similar mark for identical or similar goods or services, where there exists a likelihood of confusion.

Application procedure

International trade mark applications are filed at the national trade mark office depending on the nationality and residence of the applicant, and are subsequently examined by the World Intellectual Property Office (WIPO) in Geneva.

Each application is for a single mark, but the application can specify as many goods or services as the applicant wishes, and can designate as many territories as the applicant wishes within the Madrid system.

An international trade mark registration must be based upon one or more national or regional applications/registrations. In most cases, the international application will be based on a single registration or application which covers the goods and services listed in the international application. However, it is possible to base an international registration on several applications and/or registrations (under the Protocol) which together cover the goods and services to which the international application relates. The base applications and/or registrations must all be in the name of the person filing the international application and must have been made with the same Office.

- An international application must contain a reproduction of the mark (which must be identical with that in the basic registration or basic application) and a list of the goods and services for which protection is sought, classified in accordance with the International classification of Goods and Services (Nice Classification).
- An international application must designate the Contracting Parties in which the mark is to be protected.
- An international application can be filed in any one of the three languages of the Madrid system, namely, English, French or Spanish. The majority of applications are filed in English.

After filing the application, examination by the World Intellectual Property Organisation is restricted to formal matters, such as checking that the international mark is the same as the base national registration on which it is based, checking the goods and services are the same as the base registration, and checking that the fees have been paid.

Assuming examination of these formalities is successful, as is the case with the majority of applications, the mark then proceeds through to registration. Typically the application procedure is quite quick, a matter of a few months, and can be several years faster than the procedure for some equivalent individual national trade mark applications.

Procedure after registration

Once the mark is registered, the intellectual property office of each individual designated state or region is notified of the registration.

The national office of each individual state or region applies the same examination as would apply to the equivalent national trade mark application.

Each individual state or region has the opportunity to make a full or partial refusal of registration for that territory.

A full refusal means that the mark is refused registration for all goods and services, and a partial refusal means that the mark is refused registration for only some of the goods or services, and the registration remain in force for the remaining goods or services.

A full or partial refusal can be raised either by the intellectual property office itself, or as a result of third parties opposing the registration in that individual territory.

If a full or partial refusal is received, there is an opportunity to challenge the refusal according to the National opposition procedure of the individual territory. At that point, the national designation is treated equivalently to an individual national trade mark registration for the purposes of the opposition procedure.

A full or partial refusal received for one designated territory applies only in that territory, and the international registration in other territories is unaffected.

If no refusal is received for a particular designated territory within 12 months of the date of registration (18 months for some states) then the registration cannot thereafter be opposed. Removal of the registration in that territory by a third party thereafter will require recourse to the individual national or regional court of that territory.

Summary

- International trade mark registrations have the same effect as the equivalent national trade mark registration in each territory which they apply to.

- International trade mark registrations must be based upon a base national regional registration.
- In many cases, international registration can be much faster than the equivalent national or regional trade mark registration procedure, in some cases, by several years.
- For international registrations containing as little as one designation can be more cost effective than the alternative equivalent national trade mark procedure.

Instructions

To register your trade mark, we will need the following information:

Details of the mark, whether it is a word, or other graphic sign or logo, including a copy of the sign or logo;

A list of goods and/or services for which you are already using the mark, or intend to use the mark, and for which the mark is to be registered for;

A list of individual countries which you wish your international trade mark to include;

Details of the owner (applicant) including: name, address, type of legal person (limited company, limited liability partnership, individual etc.), country of incorporation, and nationality and residence of applicant/ owner.

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