

Marks&Clerk



A Short Guide

# Trade Marks: The Madrid Protocol

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Over 70 countries, including the USA, China and Japan, have now signed up to the Madrid Protocol. Of major importance to the European market is the fact that the European Union (EU) joined the Madrid Protocol on 1 October 2004. A link was also established with the Community Trade Mark (CTM) system on this date.

## What are the benefits of the Protocol?

The main benefit of the Madrid Protocol lies in its straightforwardness, whereby one filing and one fee triggers a single registration that may cover any or all countries signed up to it. A single blanket renewal fee and centralised administration for assignments, mergers and changes of name are other advantages.

National registries are allowed up to 18 months to accept or reject a Madrid Protocol application and this should lead to quicker registration of trade marks in many countries. Utilisation of the Protocol substantially reduces the cost of registering and maintaining trade marks in a large number of countries, mainly by eliminating the need to appoint local attorneys (unless the application encounters an objection).

It is therefore worth considering the benefits of an international registration as part of your trade mark portfolio protection strategy.

## What is the link between the Madrid Protocol and the CTM?

Since October 2004, there has been a link between the Madrid Protocol and the CTM. This means that owners of CTMs can now extend protection to a large number of other countries at a cost which is often far lower than filing national applications direct. It also means that owners of trade mark

registrations in countries which are a party to the Protocol can designate the EU in an international application.

Organisations that have already taken advantage of the CTM system can now use this registration as the basis of an international registration which extends to those countries that are already party to the Madrid Protocol.

## Who may apply?

Only companies or persons who are a national or domiciled or who have a real and effective commercial establishment in one of the Madrid Protocol member countries.

## What countries are members?

As of March 2009:

Albania; Antigua & Barbuda; Armenia; Australia; Austria\*; Azerbaijan; Bahrain; Belarus; Belgium\*; Bhutan; Bosnia & Herzegovina; Botswana; Bulgaria\*; China; Croatia; Cuba; Cyprus\*; Czech Republic\*; Democratic People's Republic of Korea; Denmark\*; Estonia\*; EU; Finland\*; France\*; Georgia; Germany\*; Ghana; Greece\*; Hungary\*; Iceland; Iran; Ireland\*; Italy\*; Japan; Kenya; Kyrgyzstan; Latvia\*; Lesotho; Liechtenstein; Lithuania\*; Luxembourg\*; Madagascar; Moldova; Monaco; Mongolia; Montenegro; Morocco; Mozambique; Namibia; Netherlands\*; Norway; Oman; Poland\*; Portugal\*; Republic of Korea; Romania\*; Russian Federation; San Marino; Sao Tome & Principe; Serbia; Sierra Leone; Singapore; Slovakia\*; Slovenia\*; Spain\*; Swaziland; Sweden\*; Switzerland; Syrian Arab Republic; The former Yugoslav Republic of Macedonia; Turkey; Turkmenistan; Ukraine; United Kingdom\*; USA; Uzbekistan; Vietnam; Zambia

\*Members of the Community Trade Mark System

## Do I have to file in all countries?

No. An application must be filed in one or more countries. The countries must be designated at the time of filing and the appropriate fees paid for each country designated. Additional countries may be added at any time. An international registration is, generally, not considered cost-effective unless application is made in at least three or four countries.

## How does it work?

A Madrid Protocol application must be based on an existing application or registration in the applicant's home country. The Madrid Protocol application must be the same as the basic application or registration (only the specification can be more restrictive but cannot exceed the protection of the basic mark).

The application is filed at the trade mark registry in the home country and is examined as to form to ensure that it qualifies for acceptance as an international application. If satisfied, the national registry then transmits the application to the World Intellectual Property Organisation (WIPO) who also examines the application as to form. If satisfied, WIPO then transmits details of the application to the national registries of the countries designated in the application. The national registries then have up to 18 months (longer in certain circumstances) to accept or reject the application for protection in their country.

## When and how will I know that my mark is registered?

WIPO publishes the application in its official journal and issues a registration certificate shortly after filing. However, the registration may be rejected in whole or in part in the designated countries up to 18 months from filing. Only at the end of this period can the mark be considered validly registered.

### **How do I deal with any objections?**

If there are any objections, it is usually necessary to appoint a local attorney to try and resolve the objections directly with the local registry.

### **Do I have to use my mark in every country?**

Yes. Once registered the international registration is still subject to national requirements. This means that in most countries the mark must be used within 5 years of registration and use should not be discontinued for a continuous period of more than 5 years.

### **How do I deal with any infringers?**

Because the international registration is subject to national rules, any action for infringement must be taken at the national level. Any relief obtained, including any injunction, is only enforceable in that particular country. It may therefore be necessary to bring several actions against the same infringer in different countries.

### **What happens if there are any changes in my home registration?**

The international registration is linked to the basic home registration for a period of 5 years. Any changes made to the home application or registration within that period will also apply to the international registration in all countries. It is therefore important to ensure that the home registration remains in force and is not limited, cancelled or abandoned within this critical period.

### **What happens if I lose my home registration within those 5 years?**

The international registration will no longer be effective but it will be possible to convert the registration to national applications and still maintain the filing date of the original application.

### **What happens if I want to assign the international registration?**

The only restriction upon assignment is that the assignee must also qualify to hold an international registration. Subject to this requirement, the registration may be assigned for some or all of the goods and services for which it is registered and it may be assigned for some or all countries for which it is registered. Within the initial 5 years, the home registration will also need to be assigned so that the link is maintained.

### **How long does the registration last?**

10 years and it is renewable for further periods each of 10 years.

### **What else do I need to consider?**

There are a number of different points to consider: you need to weigh up the cost and administrative benefits of a Madrid Protocol application against the possibility of losing or having to restrict the home application; the possibility the registration might need to be assigned to a company from a country that is not a member of the Protocol; the likelihood of a rejection in any particular country; and the possible benefits of alternative filing systems such as the Community Trade Mark.

### **How can Marks & Clerk help?**

Marks & Clerk advises on all aspects of intellectual property. For more information and to find out how we can help you register and protect your trade marks and manage your trade mark portfolio, contact your usual Marks & Clerk attorney or a member of our trade mark team at your nearest Marks & Clerk office. Full details are on our website [www.marks-clerk.com](http://www.marks-clerk.com)

The information within this guide is intended to provide a summary of the subject matter. Readers should not act or rely on information contained in this guide without first obtaining specialist professional advice.

