

# International Trade Marks



► **Inside**

Territorial Limits of Trade Marks  
Regional Protection  
International Protection



## Introduction

Whilst there is no single trade mark registration that covers the entire world, knowledge of the various regional and international filing systems means that global protection can be achieved with greater ease and less expense than filing national trade mark applications in each country.

## Territorial Limits of Trade Marks

In an ideal world brand owners would like to register a single trade mark that provides them with global trade mark protection. Unfortunately, this type of trade mark does not exist.

As each country has its own trade mark register, the general position is that separate applications need to be filed in each territory in which protection is required. This can be both an expensive and administratively burdensome exercise, particularly since most countries will require that a local law firm is instructed to handle matters in that country.

However, whilst there is no 'global' trade mark, there are a number of filing systems whereby a single application can cover a number of separate countries. These often provide a simpler, more streamlined and cost effective way of obtaining protection in relevant countries.

## Regional Protection

A number of systems have been developed whereby a single application can lead to protection being obtained in a variety of regionally connected countries. These include:

EUTM (European Union Trade Mark): A single application that covers all 27 EU territories

OAPI filings: Covers 17 countries located in North and West Africa

ARIPO filings: An alternative African system which covers 10 African territories

Many brandowners looking for protection in the EU apply for Community trade marks instead of national trade marks as the cost of an EUTM is approximately the same as two national filings. If you require further information on EUTMs then please contact us for our dedicated Client Guide on this subject.

## 'International' Protection

The Madrid Agreement ("Agreement") and the Madrid Protocol ("Protocol") are two systems that offer coverage that is the closest to an 'international' trade mark. These systems cover many of the key global economic powers and can be very cost effective when compared to separate national filings.

Both the Agreement and Protocol are international conventions allowing a person resident, domiciled or with a real and effective place of business in one convention country to file a single 'international' application covering a number of other convention countries. Whilst these are commonly referred to as 'international applications' they are in reality a bundle of separate national applications.

The main differences between the two conventions are as follows:-

- The conventions cover different, but often overlapping, territories
- Work on different timetables
- The Protocol tends to have higher fees
- A Protocol application can be based on an application for a Base Mark (see below) whereas an Agreement application has to be based on a registered Base Mark
- The EUTM system is linked to the Protocol. This allows EUTM applications/registrations to be used as a Base Mark and also for the EU to be designated as a territory within an application when there is no EUTM Base Mark.

As many key commercial markets such as the UK, US and Japan are only party to the Protocol, this guide focuses on Protocol applications. Should specific advice be required in relation to the Agreement then this can be provided on request.

Before a Protocol application can be filed the applicant must already hold an earlier trade mark application or registration in a convention country ("Base Mark").

The life of the International application and subsequent registration is dependant upon the success or failure of the Base Mark. This means that if the Base Mark is limited, fails to achieve registration or is cancelled post-registration, then the international application/registration is similarly affected. This period of mutual dependence lasts for the first 5 years of the life of the International application/registration.

To use an EUTM as a Base Mark, applicants must be domiciled, have an industrial or commercial establishment or be a citizen in an EU Member State.



Once the Base Mark has been identified the applicant can designate as many additional convention territories as it wishes subject to payment of the requisite fees.

The international application is filed at the UK Intellectual Property Office (“UKIPO”) if the Base Mark is a UK application/registration, or at the EUIPO where the Base Mark is an EUTM. The application is checked to ensure that it complies with the formalities and is then forwarded to the World Intellectual Property Office (WIPO) in Switzerland for processing. WIPO examines the application and, if it is acceptable, it is then forwarded to the relevant national registries to be assessed under local law.

## Benefits of an International Application

**Costs** – Not only are significant savings made on both official application and professional fees, they are also made when renewing or recording subsequent dealings with the trade mark. For example:

- Even though an international registration may cover, say, 20 countries it only requires one central renewal fee to be paid. National marks require separate fees to be paid in each country, each requiring local lawyers to be instructed.
- If the international registration is assigned or the address of the proprietor is changed then instead of dealing with local lawyers in each territory to record changes at the national trade mark office, the proprietor merely needs to notify WIPO.

**Simplicity** – Filing applications with a number of national registries will require the execution of various documents for each country such as application forms, powers of attorney and the provision of translations and certified copies of supporting documents, all of which takes time and money. The international application, a single document which can be filed in English, overcomes many of these inconvenient formalities.

Similarly, for renewal purposes it provides a convenient one stop simplified process for renewing the mark in as many or as few countries as may be desired.

**Agents** – When filing overseas national applications local attorneys need to be instructed in each territory to file and prosecute the applications. This process is expensive and repetitive correspondence with different attorneys can be time consuming. With an international application local agents should only need to be instructed if the international application encounters objections in a particular country from the local registry or a third party.

## Disadvantages of an International Application

**Central attack** – An international application must be based on an application or registration in the applicant’s home territory. If this application fails, or if the registration is cancelled within five years, then the registration is cancelled in all designated countries.

This is why it is preferable wherever possible to base an international registration on a secure national registration rather than an application which may be subject to many challenges before it achieves registration.

That stated, if an international application is successfully attacked then the applications/registrations in those territories that are not subject to the attack can be converted into national applications/registrations upon payment of the relevant national fee.

**Specification** – Countries such as the US which only permit trade marks to remain on the register where specific use can be proven, often require far more detailed specifications than, for example, their European counterparts. This may mean that even a basic specification such as ‘furniture’ may be objected to in the US as this description covers a variety of different items. If such objections are received then a local attorney has to be appointed in the country where the objection was raised to deal with that objection. These instructions start to erode the cost savings made in the filing.

**Assignment** – It should be noted that an international mark may only be assigned to a third party that is resident, domiciled, or with a real and effective place of business in a Protocol territory.

## Closing remarks

The cost effectiveness and relative procedural simplicity of international marks means that they are often an attractive filing strategy for brandowners. However, specialist advice is required as to whether the desired strategy is both achievable, given the brandowners circumstances, and appropriate for their business needs. We can provide this strategic advice through our deep experience of these regional and international processes and can prepare estimates for filing programmes on request.

## Madrid Protocol Territories

Albania

Antigua and Barbuda

Armenia

Australia

Austria

Azerbaijan

Bahrain

Belarus

Belgium

Bhutan

Bosnia and Herzegovina

Botswana

Bulgaria

Canada (June 2019)

China

Colombia

Croatia

Cuba

Cyprus

Czech Republic

Democratic People’s Republic of Korea

Denmark

Egypt

Estonia

European Union

Finland

France	Netherlands	Turkey
Georgia	New Zealand	Turkmenistan
Germany	Norway	Ukraine
Ghana	Oman	United Kingdom
Greece	Philippines	United States of America
Hungary	Poland	Uzbekistan
Iceland	Portugal	Viet Nam
India	Republic of Korea	Zambia
Iran (Islamic Republic of)	Republic of Moldova	
Ireland	Republic of Macedonia	
Israel	Romania	
Italy	Russian Federation	
Japan	Rwanda	
Kazakhstan	San Marino	
Kenya	Sao Tome and Principe	
Kyrgyzstan	Senegal	
Latvia	Serbia	
Lesotho	Sierra Leone	
Liberia	Singapore	
Liechtenstein	Slovakia	
Lithuania	Slovenia	
Luxembourg	Spain	
Madagascar	Sudan	
Mexico	Swaziland	
Monaco	Sweden	
Mongolia	Switzerland	
Montenegro	Syrian Arab Republic	
Morocco	Tajikistan (the former Yugoslav Republic of Macedonia)	
Mozambique		
Namibia	Tunisia	

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