

## INTERNATIONAL (MADRID PROTOCOL) TRADE MARKS

### The Basics

The Madrid Protocol is an international system for obtaining trade mark protection for a number of countries and/or regions using a single application. Protection (an "International Registration") can only be obtained for countries and regions which have joined the system (member countries), and these are listed at the end of this information sheet.

### MEMBER REGIONS

Currently there are two regions which can be designated in an International Registration under the Madrid Protocol.

One is Benelux, this comprises Belgium, The Netherlands and Luxembourg; they are in effect treated as one country - it is not possible to designate them separately.

The other is the European Community (EC): all member states of the European Union (EU) (with Benelux treated as one

- see above), except for Malta (which is not currently in the International Registration system), can be designated separately, in addition or as an alternative.

European Community relates to the single market aspect of the European Union, the latter additionally including common foreign and security policies in its scope. Therefore European Community is the official expression used in relation to the unitary trade mark rights that cover the EU.

#### Who can apply?

Any UK company, or any UK national, may apply if they have a UK or Community Trade Mark application or registration. Others may be able to apply, if they have a connection with a member country/region and have a trade mark application or registration for that country or region.

As a United Kingdom trade mark application is examined in general quite rapidly, it is probably worthwhile waiting for grant to occur before filing an International Application based on it so that any problems arising during application will have been dealt with.

Of course, if there is an appropriate existing UK or Community Trade Mark registration then one would use that.

#### What are the advantages?

- The cost will almost certainly be less than applying separately for registration for each member country/region. However, the costs depend on various factors, including the countries/regions designated, and we will be happy to provide an estimate after discussing your requirements.
- We can handle the application procedure for all countries/regions unless objections arise (as mentioned below). This leads to a further cost saving as we do not generally need to instruct local attorneys.

- Protection for some countries/regions may be obtained more quickly than by using the national route. This is because strict time limits are set under the Protocol.
- Recordal of changes of name and assignments etc., and, for some countries/regions, licences, is carried out centrally via the International Bureau. There is thus a cost saving compared with having to record such events separately in each member country/region.
- An International Registration can replace a corresponding national/regional registration without loss of rights.
- It is usually possible to add extra countries/regions later though these will not have the same date.

#### What can be applied for?

Almost any mark that would be acceptable in the member countries can be applied for. The International Application can include as many classes of goods/services as the home application or registration. It cannot include items that are outside the scope of the goods/services of the home application or registration. Within these parameters, it is possible to have different specifications of goods/services for different designations. For example, the United States will normally require a specification which is more specific than the generally worded specifications which are acceptable for most countries/regions.

## How do I apply?

We can of course handle the application procedure for you.

In brief, the application ("International Application") has to be filed at the Trade Mark Office of the applicant's home country/region ("The Office of Origin"), corresponding to the "home" application or registration upon which the International Application is based.

The Office of Origin checks the details of the applicant's home application or registration and forwards the application to the International Bureau at the World Intellectual Property Organisation, which is located in Geneva.

The application can be filed in English, French or Spanish and can designate any number of the member countries/regions (except the applicant's home country/region, covered by the applicant's home application or registration).

### Examination by the International Bureau

Only a formal examination is carried out by the International Bureau; if the application is in order an International Registration will be granted and details sent to each of the offices of the designated member countries/regions listed in the International Application.

### Examination by the designated member countries/regions

The offices for the designated member countries/regions each examine the International Registration; they can also refuse to accept the registration for their country (or region) in whole or in part on a number of grounds such as: 1) it would conflict with existing rights (in some countries/regions refusal on this ground occurs only if a third party successfully objects); 2) it is not distinctive; 3) it is contrary to morality or public order; 4) it is likely to cause deception.

The designated member countries/regions have a period usually of either 12 or 18 months in which to notify refusal to the International Bureau; if they do not notify refusal, then it can be assumed that the trade mark is protected for that country/region. The 18 month period may be extended where an opposition is filed against the relevant designation.

If objections or oppositions arise and are to be responded to, then local trade mark attorneys have to be appointed if the objections are to be contested; where objections or oppositions arise to the designation of the European Community we, as European Trade Mark Attorneys, can handle these.

### Enforceability in various countries

We are aware that for some countries (in particular Botswana, Ghana, Lesotho, Liberia, Namibia, Sierra Leone, Swaziland and Zambia) have not yet enacted domestic legislation to provide protection for marks designated under the International Registration system. It is therefore doubtful that designations will be enforceable in these countries.

Also although designations of Egypt in International Registrations have been recognized there for many years, no provision is made for them in their domestic law, and so there is some slight doubt as to their enforceability.

### Assignments

It is possible to assign an International Registration either partially or totally, including splitting it by designated countries/regions, but the assignment can only be recorded if the new owner belongs to, or has a connection with, a member country/region. If this does not apply, the assignment cannot be recorded and the International Registration, or the part being assigned, remains in the name of the old owner.

### Licensing

Since April 2002 it has been possible to record licences centrally through the International Bureau in respect of some countries/regions. However some countries have issued declarations that applications to record licences must be made through the national/regional office concerned - these countries are indicated<sup>1</sup> in the list of countries at the end of this sheet.

The national laws of some countries do not provide for the recordal of licences and these countries have issued declarations that such recordals made at the International Bureau are without effect - these countries are indicated<sup>N</sup>, however it is not obligatory for such a declaration to be made.

### What are the disadvantages of International Registrations?

- If within five years from the date of the International Registration the applicant's home application or registration ceases to have effect either in whole or in part, then the International Registration will be cancelled to the same extent.
- If this situation arises, then it is possible to file national/regional applications having the same coverage, claiming a date back to that of the International Registration. The total costs will then be rather greater than had the national/regional applications been filed in the first place.
- It may be some time before it can definitely be assumed that protection exists in a country/region, because many countries/regions often do not advise that they have accepted a designation.

### Madrid Agreement

The Madrid Protocol is, in effect, an updated version of a system called the Madrid Agreement, which started over a century ago. The United Kingdom and the European Community are not parties to the Agreement and so it is not, in general, available to those in the United Kingdom.

### Seeking trade mark protection for the European Union

All the countries in the European Union (EU) except for Malta belong to the Madrid Protocol; leaving aside Malta this gives a choice of four routes for protection for the EU:

- national applications;
- a directly filed Community Trade Mark application;
- the designation of the European Community in an International Application;
- the designation of the individual European Union countries in an International Application.

The Community Trade Mark Office treats the designation of a CTM somewhat differently to applications submitted directly to them; please see our separate information sheet for details.

A particular advantage of designating the EC (over a directly filed Community Trade Mark) is that if the designation of the EC is withdrawn, refused or ceased to have effect (as opposed to the International Registration as a whole), that designation can be converted into subsequent designations of EU member states (except for Malta, and with Benelux counting as one)

which should give substantial cost savings over the other option, conversion to national applications, which is the only option for directly filed Community Trade Mark applications and registrations.

There are various other advantages and disadvantages to the various routes: please see our information sheet *Trade Marks: What Route to Protection?* for further information.

### The future

As the United States has joined the Madrid Protocol, and as applications can now be filed in Spanish, it is hoped that further countries, especially those in Central and South America, most of which are Spanish-speaking, will sign up.

*See overleaf for a list of the member countries and regions of the Madrid Protocol*

## Member Countries and Regions (at 12 July 2010)

Albania	Greece <sup>EL</sup>	Oman
Antigua & Barbuda	Hungary <sup>E</sup>	Poland <sup>E</sup>
Armenia	Iceland	Portugal <sup>E</sup>
Australia <sup>N</sup>	Iran	Romania <sup>E</sup>
Austria <sup>E</sup>	Ireland <sup>E</sup>	Russian Federation <sup>L</sup>
Azerbaijan	Israel <sup>7</sup>	San Marino
Bahrain	Italy <sup>E</sup>	São Tomé and Príncipe
Belarus	Japan <sup>L</sup>	Serbia
Benelux <sup>1E</sup>	Kenya	Sierra Leone*
Bhutan	Kyrgyzstan <sup>L</sup>	Singapore <sup>L</sup>
Bosnia and Herzegovina	Latvia <sup>E</sup>	Slovakia <sup>E</sup>
Botswana*	Lesotho*	Slovenia <sup>E</sup>
Bulgaria <sup>E</sup>	Liberia*	South Korea <sup>L</sup>
China <sup>2L</sup>	Liechtenstein	Spain <sup>E</sup>
Croatia	Lithuania <sup>EL</sup>	Sudan
Cuba	Macedonia	Swaziland*
Cyprus <sup>3E</sup>	Madagascar	Sweden <sup>E</sup>
Czech Republic <sup>E</sup>	Moldova <sup>L</sup>	Switzerland
Denmark <sup>4E</sup>	Monaco	Syria
Egypt*	Mongolia	Turkey
Estonia <sup>E</sup>	Montenegro	Turkmenistan
European Community <sup>5</sup>	Morocco	Ukraine
Finland <sup>E</sup>	Mozambique	United Kingdom <sup>8E</sup>
France <sup>6E</sup>	Namibia*	United States of America
Georgia <sup>L</sup>	Netherlands Antilles	Uzbekistan
Germany <sup>EN</sup>	North Korea	Vietnam
Ghana*	Norway	Zambia

<sup>1</sup> i.e. Belgium, The Netherlands and Luxembourg - are designated as one "member country".

<sup>2</sup> Excluding Hong Kong and Macau.

<sup>3</sup> Only effective in Southern (Greek) Cyprus because of the political situation in that country.

<sup>4</sup> Excluding the Faroe Islands and Greenland.

<sup>5</sup> Automatically covers Gibraltar and Jersey.

<sup>6</sup> Including all Overseas Departments and Territories.

<sup>7</sup> As from 1 September 2010.

<sup>8</sup> Also covers the Isle of Man.

<sup>E</sup> European Union Member.

<sup>L</sup> Local recordal of licences.

<sup>N</sup> Recordal of licences has no effect.

\* See section regarding enforceability in various countries.

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