

INTERNATIONAL (MADRID PROTOCOL) TRADE MARKS

Procedure after Registration by WIPO

The World Intellectual Property Office (WIPO) has sent details of your registration or subsequent designation(s) to each of the designated offices. The future procedure is set out below.

Possibility of objection

Objections may be made by the designated office itself, or by third parties for some designations, if there are reasons to object under the law of that designation. If there is an objection for any of the designations, then that objection will be sent to WIPO by the designated office(s). If there are such objections, WIPO will tell us and we will report to you.

If there are no objections for a designation, the designation becomes fully effective.

Time limits for objections

There are time limits of either 12 or 18 months (depending upon the designated office) in which the designated offices have to give notice of the objections. The 18 month period may be extended where an opposition is filed against the relevant designation. The time limit runs from the date of notification which appears on the registration certificate.

Designated offices which have a 12 month time limit include:

Austria, Benelux, Cuba, Czech Republic, France, Germany, Hungary, Moldova, Monaco, North Korea, Portugal, Russian Federation, Serbia and Spain.

Those having an 18 month time limit include:

Australia, China, Community Trade Mark Office, Denmark, Estonia, Eire, Finland, Iceland, Italy, Japan, Lithuania, Norway, Poland, Singapore, South Korea, Sweden, Switzerland, Slovakia, Turkey and the United States.

Advertisement of registration or subsequent designation(s)

The International Registration or subsequent designation(s) will be advertised in the WIPO Gazette of International Marks; we will send you a copy of the advertisement.

Notes:

1. The International Registration is dependent for its first five years upon the basic application/registration remaining valid. If the basic application/registration fails for any reason and it is desired to maintain trade mark protection in any or all of the designated territories, then the new applications will have to be made in the relevant territories. However they will have priority back to the date of the International Registration.
2. A designation of Denmark does not cover either the Faroe Islands or Greenland.
3. A designation of China does not cover Hong Kong or Macau.
4. A designation of France includes all overseas Departments and Territories.
5. A designation of the Community Trade Mark covers Gibraltar and Jersey.
6. A designation of the United Kingdom covers the Isle of Man.

Designation of the European community

The Community Trade Mark Office treats these somewhat differently to directly filed applications; please see our separate information sheet for details.

Direct communications from the designated office

Some designated offices (including the Office for Harmonisation in the Internal Market (the formal title of the Community Trade Mark Office)) will sometimes write directly to the applicant on matters that are advisory (for example reporting publication of the designation) and which consequently do not require a response. Please forward us copies of such letters in order that we can monitor progress of the designation; there is not a mechanism for us to be sent them directly.

Adding designations to the registration

It is usually possible to add additional designations to an existing International Registration, though these designations will have a later date than the original date of the International Registration. For example it may be that a country/region was not a member of the Madrid Protocol at the time the original application was made and so it is decided to add it once it has joined.

Grants of protection

The following designated offices will confirm when protection has been granted:

Armenia, Australia, Benelux, Community Trade Mark Office, Georgia, Hungary, Ireland, Japan, Norway, Singapore, South Korea, Syria, Turkey and United Kingdom.

The United States issues a registration certificate with a United States registration number.

For other designated offices, if no notice of refusal, or the possibility of refusal, has been issued by the expiry of the relevant time limit for objections, it is to be presumed that protection has been granted for that designation.

Maintenance of the registration

The International Registration is due for renewal every ten years on the anniversary of the application date. It is possible to drop designations at renewal, and this will give some cost saving.

If Mozambique is designated then it is additionally necessary to submit a Declaration of Intent to Use on the fifth anniversary of the application, and every successive ten years thereafter: that is, on the fifteenth, twenty-fifth etc. anniversaries of the application date.

If the United States is designated then it is additionally necessary to submit a Declaration of Use/Excusable Reasons for Non-Use between five and six years from the date of issuance of the certificate of protection by the United States Patent and Trademark Office and within six months before each ten year anniversary of the issuance date. We will advise you of these dates when we forward the certificate of protection.

We make it a practice to send reminders before renewals and other maintenance deadlines occur.

This information is simplified and must not be taken as a definitive statement of the law or practice. For more information on Mewburn Ellis LLP and other intellectual property matters, please contact us or visit our website at www.mewburn.com. Mewburn Ellis LLP is a Limited Liability Partnership registered in England (no. OC306749). Registered Office at 33 Gutter Lane, London EC2V 8AS

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